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## Design Patent Evolution: From Obscurity to Center Stage

Andrew Beckerman-Rodau

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**DESIGN PATENT EVOLUTION:  
FROM OBSCURITY TO CENTER STAGE**

**Andrew Beckerman-Rodau<sup>†</sup>**

*In light of the renewed interest in design patents and recent case law that has lowered the bar for infringement, this article examines the history, subject matter and judicial treatment of design patents, including the effect of recent United States Supreme Court decisions and the America Invents Act. Limitations on design patent rights and the tests for novelty, non-obviousness and infringement, as well as the existing overlap between design patent law, copyright law and trademark law will be presented. Finally, extension of the fair use doctrine, recognized under both copyright and trademark law, will be examined.*

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## INTRODUCTION

The recent legal sparring between Apple Computer and Samsung focused the attention of both business people and attorneys on the potential value of U.S. design patents.<sup>1</sup> In one dispute, a jury found that some specific Samsung products had infringed several of Apple's utility and design patents.<sup>2</sup> The jury verdict included substantial damages due to the fact that the appearance of Samsung's popular Galaxy S4G smartphone (*see* Fig. 1) infringed Apple's U.S. Design Patent No. D593,087 (*see* Fig. 2).<sup>3</sup> After the jury initially awarded over one billion dollars as infringement damages,<sup>4</sup> numerous academic programs on design patent law quickly appeared.<sup>5</sup> New scholarship directed to design patents was also published,<sup>6</sup> effectively ending a dearth of academic writing on design patents which extended back several decades.<sup>7</sup>

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1. *See* Apple, Inc. v. Samsung Electronics, Co., 920 F. Supp. 2d 1079 (N.D. Cal. 2013) (list of attorneys and law firms involved in this case encompasses almost five pages).

2. *Id.* In Apple Inc. v. Samsung Electronics Co., 786 F.3d 983, 989 (Fed. Cir. 2015), the court upheld the jury's damages award for patent infringement but vacated and remanded the damages award for trade dress dilution. The court also provides an overview of the litigation including identifying the three infringed design patents.

3. *See generally* Florian Mueller, 13-03-01 *Apple v Samsung Final Order on Damages*, Scribd (2013), <https://www.scribd.com/doc/128003420/13-03-01-Apple-v-Samsung-Final-Order-on-Damages>. *See also* Florian Mueller, *Retrial Jury Awards Apple \$290 Million*, Foss Patents (Nov. 21, 2013), <http://www.fosspatents.com/2013/11/retrial-jury-awards-apple-290-million.html> (total damages, which exceeded \$900 million, included an amount for infringing the '087 design patent).

4. *See* Florian Mueller, *Apple's Billion-Dollar Win Over Samsung*, FOSS PATENTS (Aug. 24, 2012), <http://www.fosspatents.com/2012/08/apples-billion-dollar-win-over-samsung.html>.

5. *See, e.g.*, Stanford Law School, *Design Patents in the Modern World Conference*, (April 5, 2013), [https://law.stanford.edu/events/?tribe\\_paged=1&tribe\\_event\\_display=list&tribe-bar-date=2013-04-05](https://law.stanford.edu/events/?tribe_paged=1&tribe_event_display=list&tribe-bar-date=2013-04-05). *See also* Jeri Zeder, *Law School Hosts Design Patents Conference*, SUFFOLK UNIVERSITY LAW SCHOOL (Dec. 19, 2013), <http://www.suffolk.edu/law/explore/27950.php#.VG0qffnF-Sp> (discussing conference held at Suffolk University Law School entitled "Design Patents: Modernizing an Old Property Interest," on Nov. 22, 2013).

6. *See, e.g.*, Michael Risch, *Design Patents in the Modern World Symposium: Functionality and Graphical User Interface Design Patents*, 17 STAN. TECH. L. REV. 53 (2013).

7. *See, e.g.*, Matthew Nimetz, *Design Protection*, 15 COPYRIGHT L. SYMP. (ASCAP) 79 (1967); Barbara A. Ringer, *The Case for Design Protection and the O'Mahoney Bill*, 7 BULL. COPYRIGHT SOC'Y U.S.A. 25 (1959-60).



Fig. 1

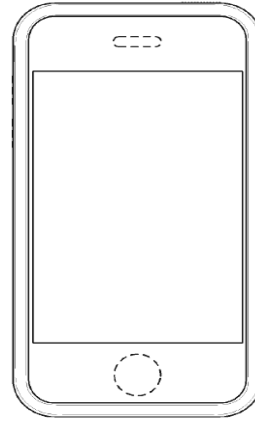


Fig. 2

## I. HISTORY OF DESIGN PATENTS

The oldest type of U.S. patent is a utility patent which was created by the first patent statute passed in 1790.<sup>8</sup> These patents typically protect useful inventions,<sup>9</sup> such as machines, electronic components, pharmaceuticals and chemical processes, which perform a function. Design patents, in contrast to utility patents, protect the non-functional or “ornamental” appearance of something.<sup>10</sup> One court has stated that the goal of design patents is to facilitate the commerce in manufactured products by incentivizing designers to make such products aesthetically pleasing to potential consumers.<sup>11</sup>

8. See JANICE MUELLER, PATENT LAW (Wolters Kluwer eds., 3rd ed. 2009) (discussing subsequently enacted statutory law authorizing issuance of plant patents to protection for certain types of new plants); 7 U.S.C. §§ 2321 et seq. (codification of Plant Variety Protection Act, administered by the U.S. Department of Agriculture, which provides “patent-like” protection for certain sexually reproduced plants). See also Plant Variety Protection Act of 1970, 7 U.S.C. §§ 2321-2582. See generally J. THOMAS MCCARTHY, ROGER E. SCHECHTER, & DAVID J. FRANKLYN, MCCARTHY’S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 452-56 (3rd ed. 2004) (discussing plant patents granted for newly invented or discovered asexually reproduced plant variety); 35 U.S.C. §§ 161-64 (codification of Plant Patent Act).

9. See 35 U.S.C. § 101 (invention must be “useful”).

10. See 35 U.S.C. § 171(a) (Design patents protect “ornamental design for an article of manufacture.”). See generally Molly Wood, *Video Feature: Design Gains Importance as Devices Get More Personal*, N.Y. TIMES (March 19, 2013), available at <http://www.nytimes.com/2015/03/19/technology/personaltech/video-feature-design-gains-importance-as-devices-get-more-personal.html> (discussing how modern electronic devices must have both a well-designed appearance and well-designed functionality).

11. *Smith v. M & B Sales and Manufacturing*, 13 U.S.P.Q.2d 2002, 2003 (N.D. Cal. 1990). See also *Gorham Co. v. White*, 81 U.S. 511, 524 (1872) (discussing law granting design

Design patent subject matter, also called industrial design,<sup>12</sup> has long been protected in European nations.<sup>13</sup> In urging Congress to adopt the first U.S. system of design patent protection the U.S. Commissioner of Patents wrote the following in 1841:

The justice and expediency of securing the exclusive benefit of new and original designs for articles of manufacture, both in the fine and useful arts, to the authors and proprietors thereof, for a limited time, are also presented for consideration.

Other nations have granted this privilege, and it has afforded mutual satisfaction alike to the public and to individual applicants. Many who visit the U.S. Patent Office learn with astonishment that no protection is given in this country to this class of persons. Competition among manufacturers for the latest patterns prompts to the highest effort to secure improvements and calls out the inventive genius of our citizens. Such patterns are immediately pirated, at home and abroad. A pattern introduced at Lowell, for instance, with however great labor or cost, may be taken to England in 12 or 14 days, and copied and returned in 20 days more. If protection is given to designers, better patterns will, it is believed, be obtained, since the impossibility of concealment at present forbids all expense that can be avoided. It may well be asked if authors can so readily find protection in their labors, and inventors of the mechanical arts so easily secure a patent to reward their efforts, why should not discoverers of designs, the labor and expenditure of which may be far greater, have equal privileges afforded them?

The law, if extended, should embrace alike the protection of new and original designs for a manufacture of metal or other material, or any new and useful design for the printing of woolens, silk, cotton, or other fabric, or for a bust, statue, or bas-relief, or composition in alto or basso-relievo. All this could be effected by simply authorizing the Commissioner to issue patents for these objects, under the same limitations and on the same conditions as

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patents to encourage development of decorative arts).

12. See *What is an Industrial Design?*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, available at <http://www.wipo.int/designs/en/> ("In a legal sense, an industrial design constitutes the ornamental or aesthetic aspect of an article."). Unlike the U.S. which engages in an examination process before determining whether to grant a design patent, other countries provide a registration process for such designs which does not involve a lengthy examination process. See MCCARTHY, *supra* note 8, at 162-63.

13. Thomas B. Hudson, *A Brief History of the Development of Design Patent Protection in the United States*, 30 J. PAT. & TRADEMARK OFF. SOC'Y 380 (1948) (designs protected in France as early as 1737 and as early as 1787 in England).

govern present action in other cases.<sup>14</sup>

In 1842, design patent legislation was enacted into law<sup>15</sup> in response to New England textile and other manufacturers who sought protection for industrial designs produced via mass production techniques.<sup>16</sup>

U.S. design patents were and continue to be treated in a manner similar to utility patents. To obtain a design patent the creator of a new design has to file a design patent application with the U.S. Patent and Trademark Office (PTO).<sup>17</sup> That application is subject to the same general prosecution procedure used for utility patents. The ornamental design must be both novel and non-obvious.<sup>18</sup> Although the issuance of a design patent occurs more quickly than the issuance of a utility patent<sup>19</sup> it still takes, on average, about fifteen months for a design patent to be granted.<sup>20</sup> Once granted, the design patent owner has “the right to exclude others from making, using, offering for sale or selling”<sup>21</sup> the design in the U.S. or importing it into the U.S.<sup>22</sup> for a fifteen year period.<sup>23</sup>

From the beginning, the U.S. design patent system differed from most systems used elsewhere. In most countries an industrial design registration system is used under which a design is registered without any examination of the design by a governmental agency.<sup>24</sup> This approach allows a designer to assert her rights relatively quickly. By

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14. *Id.* at 380-81.

15. Barbara A. Ringer, *The Case for Design Protection and the O’Mahoney Bill*, 7 BULL. COPYRIGHT SOC’Y U.S.A. 25 (1959-60) (design patent law became effective August 29, 1842).

16. *Id.*

17. See generally *Design Patent Application Guide*, U.S.P.T.O. (Aug. 13, 2012), available at <http://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide> (overview of procedures and rules for filing U.S. design patent applications).

18. 8 Donald S. Chisum, CHISUM ON PATENTS § 23.03 (2014).

19. Dennis Crouch, *Patent Application Pendency (Timing from Priority Date)*, PATENTLYO (May 26, 2014), available at <http://patentlyo.com/patent/2014/05/application-pendency-priority.html> (average pendency for utility patents is over three years).

20. *Design Patents Report Jan. 1, 1991 – Dec. 31, 2015*, U.S.P.T.O. (March 2016), <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/design.pdf>. See also Dennis Crouch, *Design Patent Pendency*, PATENTLYO (Dec. 13, 2011), available at (noting 54% of design patents issue in less than one year).

21. See 35 U.S.C. § 154(a)(1).

22. *Id.*

23. See 35 U.S.C. § 173 (Design patent term recently changed from fourteen year term to fifteen year term from the date of the patent grant; design patents filed on or after May 13, 2015 are entitled to the new fifteen year term.).

24. MCCARTHY, *supra* note 8, at 162.

contrast, design protection in the U.S. only arises after a lengthy examination process, which culminates in the grant of a design patent.

## II. DESIGN PATENT SUBJECT MATTER

U.S. patent law includes a general statutory subject matter provision which states: “Whoever invents or discovers any new and useful *process, machine, manufacture, or composition of matter*, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”<sup>25</sup> (*Emphasis added*)

An additional statutory provision, shown below, narrows the subject matter eligible for design patent protection to an “article of manufacture:” “Whoever invents any new, original and ornamental design for an *article of manufacture* may obtain a [design] patent therefor, subject to the conditions and requirements of this title.”<sup>26</sup> (*Emphasis added*)

### A. Article of Manufacture Requirement

A manufacture is one of the five categories of patent eligible subject matter for a utility patent<sup>27</sup> and the sole category of statutory subject matter eligible for a design patent.<sup>28</sup> Although the phrase “an article of manufacture” is not statutorily defined, it has been the subject of case law explanation. The Supreme Court has defined it as “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.”<sup>29</sup>

In light of this definition, which has been broadly construed by courts, almost any tangible object or article, including machines,

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25. 35 U.S.C. § 101.

26. 35 U.S.C. § 171(a).

27. See 35 U.S.C. § 101 (Categories are “process, machine, manufacture, or composition of matter, or any . . . improvement thereof.”). See also MPEP § 2106(I) (9th ed. Rev. 1, March 2014) (discussing the various categories).

28. 35 U.S.C. § 171(a). The reference to an “article of manufacture” in 35 U.S.C. § 171(a) includes a “manufacture” in 35 U.S.C. § 101. Hence, the broad definition of a manufacture for utility patent subject matter is likewise applicable to design patent subject matter. See Chisum, *supra* note 18.

29. *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (*quoting* *Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)). Likewise, the Patent and Trademark Office guidelines for patent examiners refer to this Supreme Court statement. MPEP 2106 § (I)(iii) (9th ed. Rev. 1 March 2014). See also *In re Nuijten*, 500 F.3d 1346, 1356 (Fed. Cir. 2007), which concludes that an article of manufacture is a tangible article or commodity resulting from a manufacturing process.

satisfies this requirement.<sup>30</sup> However, some recent Supreme Court decisions may have narrowed what should qualify as an article of manufacture. The Supreme Court has often noted the delicate balance performed by patent law,<sup>31</sup> between the underlying goal of increasing the public storehouse of knowledge by incentivizing creativity and innovation<sup>32</sup> and hindering innovation by extending patent protection too far.<sup>33</sup> Recent decisions have focused on what subject matter is eligible for utility patent protection under patent law section 101.<sup>34</sup> Whether those decisions should be applied by analogy to the subject matter eligible for design protection under patent law section 171 depends upon the underlying logic of the judicial opinions.

In *Alice Corp. v. CLS Bank*,<sup>35</sup> the Supreme Court examined the eligibility of software for utility patent protection under patent law section 101.<sup>36</sup> It held that merely implementing an abstract idea on a computer was insufficient to convert the idea from unpatentable subject matter into a patent-eligible invention.<sup>37</sup> The Court's underlying concern was that virtually any unpatentable abstract idea could potentially be rendered patent eligible by carrying it out on a generic computer.<sup>38</sup> Furthermore, the idea involved in *Alice*, which

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30. Although a "machine" is a separate category of patent-eligible subject matter listed in 35 U.S.C. § 101, machines have generally been treated as coming within the definition of an "article of manufacture" for the purpose of determining what is eligible subject matter for a design patent. *See, e.g.*, U.S. Design Patent D641,436 (filed Oct. 4, 2010) (titled "Exercise Machine"); U.S. Design Patent D640,521 (filed Sept. 5, 2008) (titled "Machine Vise"); U.S. Design Patent D638,476 (filed April 20, 2010) (titled "Vending Machine for Liquids"). *See generally* MPEP § 2106(I)(ii) (9th ed. Rev. 1 March 2014) ("Machine – a concrete thing, consisting of parts, or of certain devices and combination of devices. *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570, 17 L. Ed. 650 (1863). This includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. *Corning v. Burden*, 56 U.S. 252, 267, 14 L. Ed. 683 (1854)."). *See also* *In re Koehring*, 37 F.2d 421, 422 (C.C.P.A. 1930) ("Since it is clear that Congress meant the design patent law to apply to tools and mechanisms of utilitarian character, it follows, we think, that it had in mind the elimination of much of the unsightly repulsiveness that characterizes many machines and mechanical devices which have a tendency to depress rather than excite the esthetic sense.").

31. *See, e.g.*, *Mayo Collaborative v. Prometheus Labs*, 132 S.Ct. 1289, 1305 (2012) (exclusive rights provided by a patent can create monetary incentives that promote creativity but such exclusive rights can also impede such creativity).

32. *Id.*

33. *Id.* at 1293. *See also* *Alice Corp. v. CLS Bank International*, 134 S.Ct. 2347, 2354 (2014).

34. *Mayo*, *supra* note 31, at 1293. *See also* *Alice*, *supra* note 33.

35. *Alice*, *supra* note 33 at 2347.

36. *Id.* at 2351-52.

37. *Id.* at 2352.

38. *See id.* at 2357-58.



required keeping track of financial transactions, could only be utilized realistically by implementing it on a computer.<sup>39</sup> Hence, issuance of a patent on the computer implemented idea would really amount to gaining patent rights on the idea itself because it had no real economic use standing alone. Both the *Alice* court and prior decisions have referred to this as a preemption issue. They reason that to grant a patent would be to preempt all economically practical use of an unpatentable idea for the entire patent term.<sup>40</sup> Nevertheless, if an abstract idea is only capable of being implemented on a specially programmed computer or a computer utilizing unique hardware, the result may be different.

One way to understand the Supreme Court's concern at a policy level is to recognize that the court was concerned about granting patents on subject matter that amounted to the basic building blocks of science.<sup>41</sup> Such information should be available to the public because granting property rights for it would hinder innovation by others.<sup>42</sup> In the court's view, mere ideas fall within the of building blocks of science category.<sup>43</sup> Moreover, *Alice* can be viewed as the court's attempt to prevent someone from obtaining patent rights on subject matter such as abstract ideas that are clearly ineligible for such protection.<sup>44</sup>

Although *Alice* dealt with utility patents, there exists an analogous concern with regard to the extension of design patent rights. For example, the position of the PTO is that computer screen icons are protectable via design patents.<sup>45</sup> However, the icon standing alone is not design patent eligible<sup>46</sup> because the patent law expressly protects only the "ornamental design for an article of manufacture"<sup>47</sup> and a computer icon is not an article of manufacture. Such an icon standing alone is a creative work that is within the domain of copyright law and appropriately protected by that body of law.<sup>48</sup> The PTO relies on the theory that the article of manufacture

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39. *See id.* at 2352.

40. *See id.* at 2354-55; Mayo, *supra* note 32, at 1294.

41. Mayo, *supra* note 31, at 1293.

42. *Id.*

43. *Id.*

44. *Id.*

45. *See* MPEP § 1504.01(a) (9th ed. Rev. 1, March 2014) (titled "Guidelines for Examination of Design Patent Applications For Computer-Generated Icons").

46. *Id.*

47. 35 U.S.C. § 171(a).

48. *See generally* 17 U.S.C. § 101 (definition of copyrightable "pictorial, graphic, and

requirement is met because the icon is displayed on a generic computer monitor.<sup>49</sup> This approach is inconsistent with the underlying policy expressed by the Supreme Court. Computer icons are designed for display and use on a computer screen and they have only limited, if any, value if not displayed on a computer screen of some type. Granting design patent protection for such icons amounts to protecting freestanding graphical designs, and therefore should not be design patent eligible.

### *B. Ornamental Design Requirement*

The statutory subject matter protectable by a design patent must be an “ornamental design for an article of manufacture”<sup>50</sup> or an ornamental design for a limited portion of the article of manufacture.<sup>51</sup> The design alone or separated from an article of manufacture is not protectable via a design patent,<sup>52</sup> nor are the functional aspects of the article protected.<sup>53</sup> It is the ornamental or visual appearance of the article, as opposed to the functional aspects of the article, that is protected by a design patent.<sup>54</sup> This protected subject matter typically falls into one of three categories.<sup>55</sup> Surface ornamentation is the first category. This usually involves the application of an ornamental design to the surface of a functional or

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sculptural works”).

49. *Id.*

50. 35 U.S.C. § 171(a).

51. *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1566 n. 2 (Fed. Cir. 1996) (citing *In re Zahn*, 617 F.2d 262, 267 (C.C.P.A. 1980)).

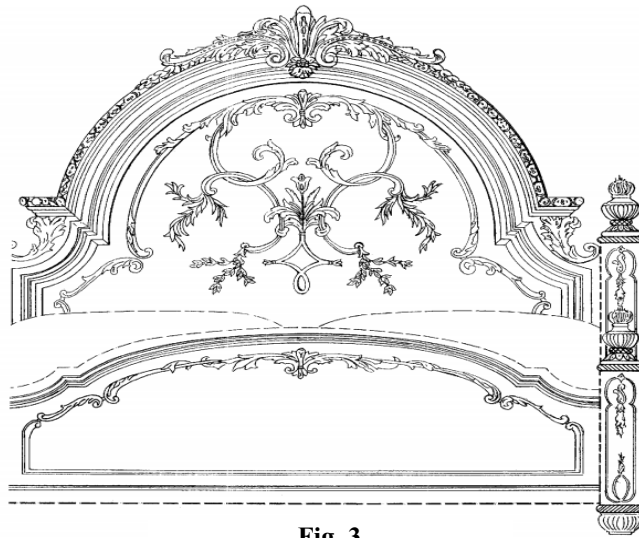
52. *See generally* Smith, *supra* note 11 (“Federal law authorizes issuance of design patents specifically for items of manufacture, not for art per se.”). If the surface ornamentation is capable of existing separately from the article of manufacture, that separated design may be eligible for copyright protection as a pictorial, graphic or sculptural work. *See* 17 U.S.C. § 101 (Definition of “pictorial, graphic and sculptural works” indicates that the design of a useful article is copyright-eligible subject matter if the design can be identified separately from, and is capable of existing independently from, the utilitarian aspects of the useful article it is applied to. “[U]seful article” is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”).

53. *See* *Safco Products Co. v. Welcom Products*, 799 F. Supp. 2d 967, 975 (D.Minn. 2011).

54. *See* *Park B. Smith, Inc. v. CHF Indus.*, 811 F. Supp. 2d 766, 780 (S.D.N.Y. 2011).

55. A design for an ornament, impression, print, or picture applied to or embodied in an article of manufacture (surface indicia); a design for the shape or configuration of an article of manufacture; or a combination of the first two categories. MPEP § 1504.01(a) (9th ed. Rev. 1, March 2014) (titled “Guidelines for Examination of Design Patent Applications For Computer-Generated Icons”). *See also* *Arner v. Sharper Image Corp.*, 39 U.S.P.Q.2d 1282, 1291 (C.D. Cal. 1995).

useful product. (*see* Fig. 3).<sup>56</sup> Second, the shape, appearance or configuration of a functional product, provided the purpose of that shape, appearance or configuration is primarily ornamental or non-functional, can be protected. (*see* Fig. 4).<sup>57</sup> And, third, a design can include a combination of surface ornamentation and the shape of the functional product.<sup>58</sup> (*see* Fig. 3).<sup>59</sup>



**Fig. 3**

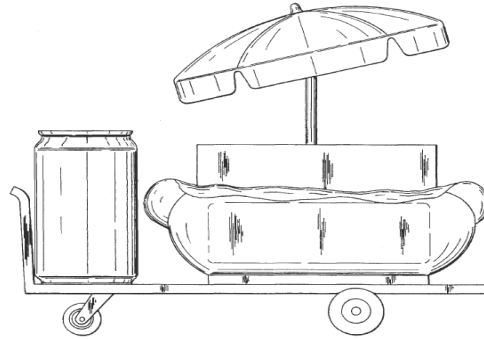
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56. Fig. 3 shows U.S. Design Patent No. D471,732 (filed Sept. 28, 2000) (surface ornamentation applied to bed).

57. Fig. 4 shows U.S. Design Patent No. D383,280 (filed April 25, 1996) (ornamental shape of a hot dog cart).

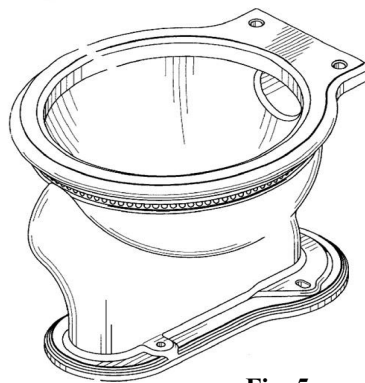
58. MCCARTHY, *supra* note 8, at 161.

59. Fig. 5 shows U.S. Design Patent No. D534,254 (filed Jan. 10, 2005) (titled Toilet Bowl, the visual design comprises the overall shape of the toilet bowl plus surface ornamentation in the form of beads located below the rim).



**Fig. 4**

Precisely defining the scope of the patented or protected design raises an important question regarding novelty and infringement analyses. Although the design is not protected as a freestanding design,<sup>60</sup> is protection limited to the article of manufacture in the issued patent or does protection extend to use of the patented design on other articles of manufacture? For example, if the picture of the toilet shown in Fig. 5, below, is reproduced on a t-shirt would that infringe the design patent covering the toilet? Arguably, the design patent was issued for the ornamental appearance of a toilet, not a shirt. So to extend the patent's protection to the use of a likeness of the patented design on a t-shirt would be akin to allowing protection on the design per se.



**Fig. 5**

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60. Chisum, *supra* note 18.

Two recent cases support the argument that a design patent only protects the design as applied to the product shown in the patent. In *Kellman v. Coca-Cola Co.*,<sup>61</sup> a design patent was obtained for a novelty hat shaped as a wing nut and created to be worn by Detroit Redwings hockey fans.<sup>62</sup> The patent owner brought an infringement action alleging that the Redwings made t-shirts showing a picture of the patented hat<sup>63</sup> and alleging that Coca-Cola Enterprises, Inc. printed a picture of the hat on soda bottle caps.<sup>64</sup> The court noted a dearth of authority on the issue<sup>65</sup> and provided only minimal analysis. The court dismissed the case after concluding that the two dimensional depictions of the hat on dissimilar products would not cause any customer confusion and hence there was no infringement.<sup>66</sup>

In a subsequent case,<sup>67</sup> the owner of a design patent on the ornamental appearance of an electrical stun gun sued a video game maker for design patent infringement. The patent owner claimed that the video game allowed a player, via an avatar, to access a weapon that emitted an electrical charge by clicking a screen icon. The patentee asserted that the icon incorporated an image that infringed the design patent. Additionally, the patentee argued that the actual weapon used in the video game infringed the design patent. The court, relying in part on *Kellman*, dismissed the patent infringement action. The court stated that a reasonable person would not purchase the video game under the belief they were actually purchasing the plaintiff's stun gun.<sup>68</sup>

Analogous to copyright law, a distinction must be made between the design which is protected by a design patent and the underlying idea which is outside the scope of a design patent. For example, a design patent for a watch face showing a caricature of a well-known politician was not anticipated<sup>69</sup> by a watch face showing a caricature

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61. *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670 (E.D. Mich. 2003).

62. *Id.* at 672.

63. *Id.* at 673.

64. *Id.*

65. *Id.* at 679-80.

66. *Id.* The patent owner also brought a claim for copyright infringement which the court did not dismiss. *Id.* at 678.

67. *P.S. Prods. v. Activision Blizzard, Inc.*, 2014 U.S. Dist. LEXIS 184913 (E.D. Ark. Feb. 21, 2014). See also Omer Salik & Neil Yang, *An Important Win For Video Games In Design Patent Case*, LAW360 (MAY 14, 2014), available at <http://www.law360.com/articles/537858/an-important-win-for-video-games-in-design-patent-case> (discussing *P.S. Prods.*).

68. *P.S. Prods.*, *supra* note 67, at \*11.

69. "Anticipation" is a word of art in patent law which indicates that an invention lacks novelty because the same invention previously existed. MCCARTHY, *supra* note 8, at 22-24.

of a different figure.<sup>70</sup> Although the prior art watch may have provided the idea of showing the political figure on a watch the caricatures were distinctly different.<sup>71</sup> Hence, the prior art design did not anticipate the later design because it is the appearance of the watch face designs per se that are compared.<sup>72</sup> The idea of putting a caricature of a politician on the watch face is not protected by a design patent.

A functionality test is not expressly embodied in the statutory requirement for obtaining design patent protection. Nevertheless, a judicially developed functionality test or limitation provides courts with a method of assessing whether the subject matter of a design patent satisfies the ornamental requirement.<sup>73</sup> The Supreme Court stated that “a design must present an aesthetically pleasing appearance that is not dictated by function alone.”<sup>74</sup> The aesthetic appearance necessary to satisfy the ornamental requirement is not limited to designs that have a certain degree of beauty such as might be found in the fine arts. Such a test would be highly subjective. Consequently it would be difficult to draw a line between what is and is not beautiful or within the category of fine art.<sup>75</sup> To avoid this difficulty, courts have utilized the more objective standard of functionality.

Articles of manufacture eligible for design patent protection are typically articles or products which have a functional or utilitarian purpose. This purpose may render the article eligible for utility patent protection.<sup>76</sup> Nevertheless, non-functional surface ornamentation applied to the article or a non-functional shape of the article may be independently protectable via a design patent.<sup>77</sup> Courts

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70. In re Yardley, 493 F.2d 1389 (C.C.P.A. 1974).

71. *Id.* at 1392 (noting similarity of concept does not necessarily mean similarity of design).

72. *Id.* at 1392-94.

73. 35 U.S.C. § 171(a) (design patent covers an “ornamental design for an article of manufacture”).

74. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989).

75. Some state statutes have attempted to draw this line. *See, e.g.*, MASS. ANN. LAWS ch. 231, § 85S (LexisNexis).

76. *See* 35 U.S.C. § 101 (utility patent covers “useful” inventions; this requirement, commonly called the utility requirement, is satisfied by an invention that performs a function).

77. For example, a uniquely shaped baby bottle with a central opening that acts as a handle enables a baby to hold the bottle with his or her hand. This functional aspect of the bottle was protected by a utility patent. U.S. Patent No. 4,570,808 (filed April 6, 1984) (titled “Baby Bottle with Integral Handle”). The bottle could be made in different configurations that would still support its function. This enabled the inventor to also obtain a design patent on one of those

use several rules to identify whether something is sufficiently functional such that it fails to satisfy the ornamental requirement. If the appearance or design is dictated solely by function then the ornamental requirement is not satisfied even if the appearance is aesthetically pleasing.<sup>78</sup> Often, however, the appearance or configuration of a product will simultaneously exhibit both ornamental and functional characteristics. In such a case, the question is whether it is primarily functional or primarily ornamental.<sup>79</sup> The existence of alternate design choices provides an indication that the appearance is primarily non-functional and hence primarily ornamental.<sup>80</sup> Other relevant factors compiled by the Federal Circuit include whether the 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>81</sup>

The above rules are illustrated by judicial review of a design patent which was issued for a portion of a blank key.<sup>82</sup> Blank keys (*see* Fig. 6) are used by locksmiths and others to make copies of existing keys by cutting grooves in blanks. The shape of the blank is dictated by the shape of the keyhole slot into which it is inserted. In light of this, the federal circuit invalidated this design patent because the claimed shape (*see* Fig. 7)<sup>83</sup> was dictated by the shape of the keyhole. Hence, the shape was functional therefore it failed to satisfy the ornamental requirement.<sup>84</sup>

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configurations of the bottle. U.S. Design Patent D286,911 (filed August 6, 1984) (titled “Baby Bottle”).

78. *In re Carletti*, 328 F.2d 1020, 1022 (C.C.P.A. 1964), (although “[m]any well-constructed articles of manufacture whose configurations are dictated solely by function are pleasing to look upon . . . the resulting design is not patentable as an ornamental design for the simple reason that it is not ‘ornamental’ – was not created for the purpose of ornamenting.”). *See* *Best Lock*, *supra* note 51.

79. *See* *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993); *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 238 (Fed. Cir. 1986); *Barofsky v. G.E. Corp.*, 396 F.2d 340, 342 (9th Cir. 1968).

80. *Best Lock*, *supra* note 51.; *L.A. Gear*, *supra* note 79.

81. *PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1366 (Fed. Cir. 2006).

82. U.S. Design Patent D327,636 (filed March 29, 1991) (titled “Portion of a Key Blade Blank”).

83. *Id.* (only the appearance of the portion of the key that would be inserted into a lock was claimed).

84. *Best Lock*, *supra* note 51, at 1563.

In contrast, a design patent for the shape of an automobile mirror (see Fig. 8)<sup>85</sup> would be ornamental if the mirror could be made in a variety of shapes which would not necessarily affect the function of the mirror, to allow the driver to see other vehicles. Unlike the shape of the above key blank, the configuration of this mirror is not dictated totally by functional requirements. Many different shapes would still enable the mirror to perform its intended function, so shape serves an aesthetic purpose and satisfies the ornamental requirement.

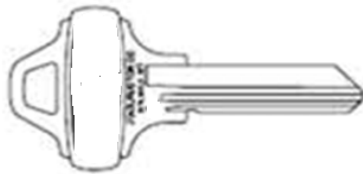


Fig. 6

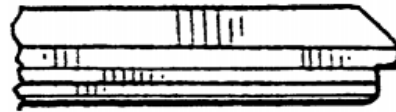


Fig. 7

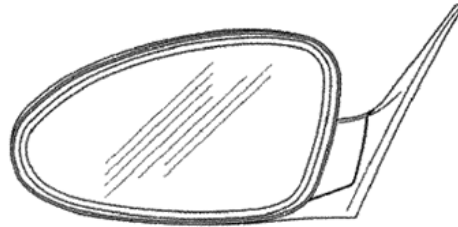


Fig. 8

A functionality test is also used in other areas of intellectual property law, such as copyright<sup>86</sup> and trademark law,<sup>87</sup> to prevent expressive content protection from improperly extending to ideas and useful objects.

85. U.S. Design Patent D681,524 (filed Jan. 26, 2011) (titled “Automotive Side View Mirror”).

86. Under the “merger doctrine” copyright protection is barred if the copyrightable form of expression of a work of authorship is merged or inseparable from the underlying idea such that protection of the copyrightable aspect will unavoidably protect the idea. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1359-60 (Fed. Cir. 2014). Likewise, the design of a useful article is only copyrightable if the design is separable from and capable of existing independently of the utilitarian aspects of the article. See 17 U.S.C. § 101 (definition of “[p]ictorial, graphic and sculptural works” and definition of “useful article”).

87. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65 (1995) (“The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”).



The copyright law statutorily recognizes that some things are clearly functional in nature and are therefore outside the domain of copyrightable subject matter. This limitation is codified in copyright law section 102(b) which states: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”<sup>88</sup>

In addition to this general principle, copyright law specifically identifies useful articles as “[a]n article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article.’”<sup>89</sup> Under this definition, a map is not a useful article, because its function is to provide information. A work of fine art intended to be placed in a museum is likewise not a useful article because its function is to portray its appearance. Therefore, both the map and the work of fine art are eligible for copyright protection as pictorial, graphic or sculptural works.<sup>90</sup> In contrast, a creatively shaped container used to hold salad dressing or some other food product typically sold in a supermarket would be a useful article because it has a utilitarian function as a container. Such a container is also an article of manufacture and its non-functional aspects are eligible for design patent protection.<sup>91</sup> Copyright law would also recognize that the container comprised both functional and non-functional aspects and it would only provide protection for such non-functional aspects.<sup>92</sup> However, unlike design

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88. 17 U.S.C. § 102(b). This statutory section applies to functional things such as processes or methods which are patent-eligible subject matter. *See* 35 U.S.C. § 101 (lists categories of subject matter eligible for utility patent protection). Copyright law section 102(b) also covers ideas, concepts and principles which are not patent-eligible subject matter and are generally not subject to property-based protection schemes once available to the public. *See generally* *Bilski v. Kappos*, 561 U.S. 593, 601 (2010) (laws of nature, abstract ideas and physical phenomena not patent-eligible subject matter). Ideas, concepts and principles may be protectable pursuant to trade secret law if they are maintained and used in secret. *See generally* *Altavion, Inc. v. Konica Minolta Systems Laboratory, Inc.*, 226 Cal. App. 4th 26, 42 (2014) (noting that almost all states have adopted the Uniform Trade Secrets Act which can protect all types of information including ideas that are maintained as confidential).

89. 17 U.S.C. § 101 (definition of useful article).

90. *Id.* (definition of pictorial, graphic and sculptural works).

91. *See* 35 U.S.C. § 171(a) (ornamental design of an article of manufacture eligible for design patent protection).

92. *See* 17 U.S.C. § 101 (definition of pictorial, graphic and sculptural works which notes that the “design of a useful article” is protectable as “a pictorial, graphic or sculptural work” but the “mechanical or utilitarian aspects” are not protectable).

patent law, copyright protection would only apply to the non-functional aspects if they can be identified separately<sup>93</sup> from the functional aspects of the container, and only if they are capable of existing independently from the functional aspects of the container.<sup>94</sup>

Trademarks are used in the commercial arena to establish the origin or source of a product or service.<sup>95</sup> They provide a quick method of enabling consumers to identify known products and services by distinguishing them from similar or competing products or services. This protects consumers from being confused, mistaken or subject to deception in commercial transactions.<sup>96</sup> Likewise, the ability of a trademark owner to develop a brand which can be extended to additional products or services is preserved.<sup>97</sup>

Trademarks can be simple words, phrases or designs such as COKE, PEPSI or BIG MAC. They can also be virtually anything that acts as a trademark by identifying and distinguishing the goods or services provided by one party from goods or services provided by another party.<sup>98</sup> This means that characteristics of a product such as

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93. The legislative history of the Copyright Act indicates that the purpose of the “separable” requirement was to draw a dividing line between works of applied art that are copyrightable and works of industrial design that are not copyrightable (but are potentially within the domain of design patent law). *See generally* H.R. REP. NO. 1476, at 55 (1976), *reprinted in* 1990 U.S.C.C.A.N. 5959, 5668. Nevertheless, courts have struggled to develop a test for ascertaining if the separable requirement is satisfied. *See* Darren Hudson Hick, *Conceptual Problems of Conceptual Separability and the Non-Usefulness of the Useful Articles Distinction*, 57 J. COPYRIGHT SOC’Y 37, 40 (2009-10). *See also* *Masquerade Novelty v. Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990) (“Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article’s utilitarian function.”).

94. Copyright Act, 17 U.S.C. § 101 (definition of a pictorial, graphic, and sculptural works), states that “the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from [commonly called conceptual separability], and are capable of existing independently of [commonly called physical separability], the utilitarian aspects of the article.”

95. The term trademark is often used to refer to all types of marks. However, trademark actually refers to marks used to identify goods while marks used to identify services are called service marks. *See generally* MCCARTHY, *supra* note 8, at 608 (discusses different types of marks). *See also* 15 U.S.C. § 1127 (defining “trademark” and “service mark”).

96. *See In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A. 1974). *See generally* 15 U.S.C. § 1052(d) (federal trademark registration can be denied if mark sought to be registered resembles a mark used by another when such registration would likely cause consumer confusion).

97. *See generally id.* (trademark law protects “the integrity of the trademark owner’s product identity”).

98. *See* 15 U.S.C. § 1127 (definition of a “trademark”). *See also* Qualitex, *supra* note 87, at 162 (noting federal trademark law takes a very broad approach to what can qualify as a

its color, smell, feel, surface ornamentation or even its shape can qualify as a trademark.<sup>99</sup> For example, the shape of a product may become so well-known that consumers instantly associate it with a particular product. However, if the particular shape is necessary for the proper functioning or use of the product it can be viewed as having two purposes. First, the shape is acting as a trademark by identifying the product to consumers. Second, it is fulfilling a utilitarian function. The first purpose is consistent with the goal of trademark law but the second purpose is unrelated to trademark law. Nevertheless, allowing trademark protection in this situation will have the effect of protecting a utilitarian or functional characteristic of the product which is more appropriately the subject matter of utility patent law.<sup>100</sup> To avoid this problem, courts developed the trademark functionality doctrine which denies otherwise available trademark protection if granting such protection would inhibit competition by enabling a trademark owner to control a functional or useful characteristic of a product.<sup>101</sup>

The above discussion of functionality demonstrates how it is used to limit design patent, copyright or trademark protection. This is necessary to prevent protection of expressive content from extending into the realm of protecting functional or utilitarian aspects of a product which can hinder competition.

### III. ORIGINALITY, NOVELTY & NON-OBVIOUSNESS

In addition to satisfying the article of manufacture and ornamental requirements, a design must satisfy the originality,

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trademark).

99. Qualitex, *supra* note 87, at 162. See generally Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 897-98 (1988) (noting that virtually anything can be a trademark including container shapes, product configurations, the shapes of buildings and trade dress). Trade dress is the total image or overall impression created by a product. *Gateway, Inc. v. Companion Products, Inc.*, 384 F.3d 503, 507 (8th Cir. 2004). Trade dress can include product packaging and labeling as well as the shape and design of the product. MCCARTHY, *supra* note 8, at 605-08.

100. Qualitex, *supra* note 87 (“It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time . . . after which competitors are free to use the innovation. If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).”).

101. Qualitex, *supra* note 87, at 164 (“The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”).

novelty and non-obviousness requirements that apply to utility patents in order to receive design patent protection.<sup>102</sup>

### A. Originality

A patent applicant must be the actual inventor or designer of the subject matter for which patent protection is sought.<sup>103</sup> Essentially that means an applicant is barred from receiving a patent on an invention or design conceived by another person.<sup>104</sup> This is usually referred to as the derivation requirement<sup>105</sup> to distinguish subject matter that was conceived by an inventor from something he or she derived from someone else. Prior to the adoption of the America Invents Act,<sup>106</sup> the patent law included a general requirement applicable to all patents that stated “[a] person shall be entitled to a patent unless... he did not himself invent the subject matter sought to be patented.”<sup>107</sup> Additionally, a separate originality requirement applied to design patents.<sup>108</sup>

The America Invents Act deleted the above general requirement from the patent law but left the original requirement for design patents untouched.<sup>109</sup> Nevertheless, it can be strongly argued that this left the law unchanged. The law related to patents generally, and design patents specifically, still expressly requires or limits the grant of patents to individuals who are inventors.<sup>110</sup>

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102. See 35 U.S.C. § 171(b) (requirements of the patent law statute apply to design patents unless the statute states otherwise).

103. See *Illinois Watch Case Co. v. Hingeco Mfg. Co.*, 81 F.2d 41, 45 (1st Cir. 1936) (Originality and use of inventive faculties are necessary for a design patent to be valid just as they are for a utility patent.).

104. See 1 Donald Chisum, CHISUM ON PATENTS § 2.01 (2015) (only actual inventor satisfies originality requirement and is entitled to patent); see also Jackie Hutter, *A Definite and Permanent Idea? Invention in the Pharmaceutical and Chemical Sciences and the Determination of Conception in Patent Law*, 28 J. MARSHALL L. REV. 687, 695 (1995).

105. *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993) (“claim that a patentee derived an invention addresses originality—who invented the subject matter”).

106. See generally Leahy-Smith America Invents Act, 112 Pub. L. No. 29, 125 Stat. 284 (2011).

107. 35 U.S.C. § 102(f) (repealed by America Invents Act).

108. 35 U.S.C. § 171(a).

109. It can be argued that the meaning of “original” is not the same in the context of patent law and copyright law. In patent law it requires the inventor to be the person who actually conceived of the subject matter at issue. In contrast, in copyright law it requires that the author is an independent creator of copyrightable subject matter and additionally that the subject matter demonstrates at least a minimal degree of creativity. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (U.S. 1991).

110. See 35 U.S.C. § 101 (limits all patents to “[w]hoever invents or discovers”); see also *id.* § 171(a) (limits design patents to “[w]hoever invents”).

Moreover, it is arguably a constitutional requirement which would supersede any elimination of an originality requirement by statute.<sup>111</sup>

### *B. Novelty*

Novelty requires an invention to be new. Hence, a functional invention eligible for a utility patent or a design eligible for design patent protection is only anticipated by a single device, patent or other reference that fully discloses the invention or design at issue.<sup>112</sup> For a utility patent the single reference must fully disclose the claimed functionality of the invention. For a design patent the claimed ornamental appearance must be disclosed. The oft quoted rule “that which infringes, later, would anticipate, if earlier”<sup>113</sup> stands for the proposition that the same test must be used for both an infringement and for an anticipation analysis.<sup>114</sup> In the context of design patents, therefore, the question of anticipation<sup>115</sup> and infringement is based on the view of the ordinary observer.<sup>116</sup> Finally, it should be kept in mind that a design patent is granted for the design of an article of manufacture not for the design standing alone. Therefore, the question is whether the combination of the manufacture and the design is novel.<sup>117</sup>

The America Invents Act,<sup>118</sup> which changed the U.S. from a first to invent patent system to a first inventor to file system,<sup>119</sup>

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111. Univ. of Colo. Found. v. Am. Cyanamid Co., 105 F. Supp. 2d 1164, 1175 (D. Colo. 2000); Rivka Monheit, *The Importance of Correct Inventorship*, 7 J. INTELL. PROP. L. 191 (1999). The clause in the U.S. Constitution which grants Congress the power to enact copyright and patent law states that exclusive rights can only be given to “Authors and Inventors.” Someone who obtains an invention from the work of someone else is not an inventor. *See generally* U.S. CONST, art. 1, § 8, cl. 8.

112. Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1312 (Fed. Cir. 2001).

113. International Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1239 (Fed. Cir. 2009) (*quoting* Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889)).

114. *Id.*

115. Anticipation is a word of art in patent law which means that your invention or design lacks novelty because the same invention or design previously existed. *See* Illinois Tool Works, Inc. v. Continental Can Co., 273 F. Supp. 94, 105-06 (N.D. Ill. 1967). *See also* MUELLER, *supra* note 8, at 138.

116. International Seaway, *supra* note 113, at 1239-41. In contrast, for a utility patent both infringement and anticipation is analyzed through the eyes of a person having ordinary skill in the relevant technology area. *See* MUELLER, *supra* note 8, at 152-53.

117. Nat’l Presto Indus. v. Dazey Corp., 18 U.S.P.Q.2d (BNA) 1113, 1116 (N.D. Ill. Nov. 19, 1990).

118. Leahy-Smith America Invents Act, *supra* note 106.

119. *See* CRAIG ALLEN NARD, THE LAW OF PATENTS 323 (Wolters Kluwer, eds., 3<sup>rd</sup> ed. 2014).

primarily altered the novelty analysis for both utility and design patents by changing the type and amount of prior art available. Geographical restrictions on some types of prior art were eliminated in favor of making anything available to the public worldwide potentially prior art.<sup>120</sup> Additionally, the one-year grace period which allowed a first inventor the right to file a patent application up to a year after the inventor or a third party put the invention into the public domain was narrowed. The grace period no longer applies when a third party injects the invention into the public domain. Such action now destroys novelty if it occurs prior to the inventor's patent application filing date.<sup>121</sup> The grace period, however, continues to apply to inventor conduct.<sup>122</sup>

### C. *Non-Obviousness*

An obviousness analysis insures that even if the invention is novel it represents a sufficient inventive advance from a qualitative perspective to be eligible for a patent.<sup>123</sup> The invention is compared to one or more pieces of prior art that existed prior to the patent application filing date.<sup>124</sup> For a design patent, based on judicial decisions, a single primary or basic reference is initially identified.<sup>125</sup> Such a reference must show design characteristics which are essentially the same as the claimed design.<sup>126</sup> Secondary references can be used to modify the primary reference to show it has the same overall appearance as the claimed design.<sup>127</sup> Ultimately, the question is whether a designer of ordinary skill who designs articles of the type at issue would have found the claimed design obvious in light of the primary reference, or would have combined both the primary and secondary references to create something having the same visual appearance as the claimed design.<sup>128</sup> Analogous to a non-obviousness analysis of an invention subject to a utility patent, secondary considerations are relevant to

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120. *See id.* 279 & 282.

121. 35 U.S.C. § 102(a)(1).

122. *Id.* § 102(b)(1).

123. *See* 35 U.S.C. § 103.

124. *Id.*

125. *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996); *In re Harvey*, 12 F.3d 1061, 1063 (Fed. Cir. 1993). *See also Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1383 (Fed. Cir. 2009).

126. *Borden*, *supra* note 125.

127. *Titan Tire*, *supra* note 125, at 1381-83.

128. *Id.* at 1380-81. *See also In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001).

inferring whether an ornamental design is non-obvious.<sup>129</sup>

The America Invents Act merely changes the statutory section controlling non-obviousness by requiring the analysis to be done at the time a patent application is filed rather than at the time of invention.<sup>130</sup> Nevertheless, case law dealing with the test for non-obviousness for utility patents has changed the analysis. Previously, obviousness required a finding that something in the prior art taught, suggested or motivated a person of ordinary skill in the relevant art to combine the prior art references at issue.<sup>131</sup> Without such a finding, the references could not be combined to support an obviousness rejection.<sup>132</sup> Subsequently, the Supreme Court made clear in a utility patent case that this test, commonly called the TSM test, was not a prerequisite to finding an invention obvious.<sup>133</sup> The Court noted the Federal Circuit had applied the test too rigidly, rendering it inconsistent with Supreme Court case law.<sup>134</sup>

This arguably affects design patents which are generally subject to the same legal rules as utility patents unless the statute expressly states a different result.<sup>135</sup> The patent law does not provide any special rules for design patents with regard to obviousness. Consequently, the design patent cases that appear to apply the TSM test<sup>136</sup> may no longer be good law at least with regard to their obviousness analysis.

#### IV. SIMULTANEOUS PROTECTION UNDER DESIGN PATENT, COPYRIGHT AND TRADEMARK LAW

The current view of the PTO and the U.S. Copyright Office is that simultaneous protection under both design patent law and

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129. See generally L.A. Gear, *supra* note 79, at 1124 (commercial success and third party copying of patented design very relevant to non-obviousness determination).

130. See 35 U.S.C. § 103.

131. See NARD, *supra* note 119, at 373. See also KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 407 (2007) (discussing lower court requirement that a finding of obviousness required that prior art taught, suggested or motivated an inventor to combine the prior art references at issue).

132. See KSR, *supra* note 131.

133. See *id.* at 415-19.

134. See *id.* at 419-22.

135. See 35 U.S.C. § 171(b) ("The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise stated.")

136. See, e.g., Durling v. Spectrum Furniture Co., Inc., 101 F.3d 100, 103 (Fed. Cir. 1996) (must be suggestion in prior art to combine references for obviousness); Oscar Mayer Foods Corp. v. Sara Lee Corp., 15 U.S.P.Q.2d 1204, 1210 (W.D. Wis. 1990) (obviousness determination requires finding prior art that teaches combining existing prior art elements).

copyright law is permissible.<sup>137</sup> Likewise, simultaneous design patent and trademark protection is allowable.<sup>138</sup> It can be argued that simultaneous protection of subject matter via both design patent and copyright law can interfere with the policies embedded in the Patent Copyright clause of the Constitution.<sup>139</sup> For example, it has often been stated by courts that when the term of a patent expires the protected subject matter should enter the public domain and be free for anyone to use.<sup>140</sup> The underlying policy is that patent rights under this clause are granted to incentivize creativity but the ultimate objective is that such creative works enter the public domain and are free for anyone to use upon expiration of the patent.<sup>141</sup> This recognizes that the ultimate goal of the clause is to increase the creative products available in the public sphere.<sup>142</sup> However, this goal is frustrated by copyright law because the term of copyright protection<sup>143</sup> is significantly longer than the term provided by a

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137. MPEP § 1512 (9th ed. Rev. 1, March 2014) (“There is an area of overlap between copyright and design patent statutes where the author/inventor can secure both a copyright and a design patent.”). PAUL GOLDSTEIN & R. ANTHONY REESE, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 1073 (6th ed. 2008) (U.S. Copyright Office allows copyright registration of a work without regard to whether it was previously protected by a design patent). See also Yardley, *supra* note 70 (concluding work can be simultaneously protected via both design patent and copyright law).

138. See DAVID L. LANGE, MARY LAFRANCE, GARY MYERS & LEE ANN W. LOCKRIDGE, INTELLECTUAL PROPERTY CASES AND MATERIALS 693 (4th ed. 2012). See generally GOLDSTEIN, *supra* note 137, at 1036 (“Works of industrial design may be protected by design patent, copyright, trademark and unfair competition law.”).

139. See generally Viva R. Moffat, *The Copyright/Patent Boundary*, 48 U. RICH. L. REV. 611, 611-12 (2014) (industrial design which is protected by both design patent and copyright law should not be protectable under copyright law); Laura A. Heymann, *Design Patents in the Modern World Symposium: Overlapping Intellectual Property Doctrines: Election of Rights Versus Selection of Remedies*, 17 STAN. TECH. L. REV. 239 (2013) (discussing issues that arise from the fact that most courts currently allow overlapping protection today); Mark P. McKenna, *Boundaries of Intellectual Property Symposium: Crossing Boundaries: An Alternate Approach to Channeling?*, 51 WM. & MARY L. REV. 873, 884-85 (2009) (arguing that overlapping intellectual property protection is problematic from an economic perspective).

140. See, e.g., *Bonito Boats*, *supra* note 74, at 152 (“We have long held that after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law.”). See also *Lucien Lelong, Inc. v. Lander Co.*, 164 F.2d 395, 398 (2d Cir. N.Y. 1947) (“expiration of a design patent effects a dedication of that design to the public”). But see *Honeywell*, *supra* note 96, at 1348-49 (noting trademark protection for the appearance of a product can continue to exist after design patent on appearance of product expires).

141. Heymann, *supra* note 139, at 244 (dominant policy underlying patent and copyright law is incentivizing creativity which ultimately benefits public).

142. *Bonito Boats*, *supra* note 74, at 151 (“ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure”).

143. 17 U.S.C. § 302(a) (typical copyright term is author’s life plus 70 years). However, certain copyrights may last for 120 years. *Id.* at (c).



design patent.<sup>144</sup> Hence, upon expiration of a design patent the ornamental design may be prevented from fully entering the public domain due to continuation of copyright protection.

Moreover, it can be argued that copyright provides less protection than design patent law because a prima facie element of copyright infringement is that the copyrighted work must be actually copied.<sup>145</sup> In contrast, copying is not an element of design patent infringement.<sup>146</sup> This distinction is often only theoretical, however, because it is typically inferred that a work was copied in a copyright infringement action once it is shown that the copied work is accessible to the public, and that the alleged infringing work is substantially similar to the copied work.<sup>147</sup> The result is that a non-functional design may be withheld from the public domain under copyright law for many decades beyond the fifteen-year term provided by a design patent. This is inconsistent with the ultimate goal, as noted above, of the Patent Copyright clause of the Constitution.

Two possible solutions to this problem could be adopted either legislatively or judicially. First, the creator or author of expressive content eligible for either design patent or copyright protection would have to elect one type of protection.<sup>148</sup> Such an election would foreclose subsequently seeking protection under the non-elected body of law. A second approach could focus on whether the design for which protection is sought is separable from the article that embodies it. If the design is separable it should be subject to copyright protection but not design patent protection. This is consistent with copyright protection that is available for the design of useful articles. If the design is not separable from the article it is not entitled to copyright protection,<sup>149</sup> and hence such a design should be within the domain of design patent law. Limiting design patents to designs that

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144. See 35 U.S.C. § 173 (current term of design patent is 15 years).

145. *T-Peg, Inc. v. Vt. Timber Works, Inc.*, 459 F.3d 97, 108 (1st Cir. 2006); *Nicholls v. Tufenkian Import/Export Ventures, Inc.*, 367 F. Supp. 2d 514, 520 (S.D.N.Y. 2005).

146. See 35 U.S.C. § 271(a) (unauthorized use of patented product is infringement). See also ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS* 461 (1st ed. 2008). See generally *SRI Int'l v. Advanced Tech. Lab.*, 1994 U.S. App. LEXIS 36220 at \*5 (Fed. Cir. 1994) (patent rights are exclusive so infringement action can be brought against innocent infringer).

147. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000) (Despite lack of evidence of actual copying, infringement can be proven by facts showing defendant had access to plaintiff's work and the works are substantially similar).

148. See generally Heymann, *supra* note 139, at 250-51 (noting some commentators favor this election approach).

149. See *supra* notes 93 & 94.

are not separable is also consistent with the design patent statute which was enacted to protect ornamental designs for industrial products rather than free-standing designs that exist separately from the article of manufacture.<sup>150</sup>

The overlap between trademark law and design patent law raises different issues because trademark law, unlike patent law, is not based on the Patent Copyright clause of the Constitution.<sup>151</sup> Trademark law traces its roots to unfair competition law which is a species of tort law.<sup>152</sup> Consequently, trademark law is aimed at commercial marketplace behavior rather than encouraging creative design.<sup>153</sup> Trademarks are used to create mental associations between consumers and products or services available in the marketplace.<sup>154</sup> They enable a company to establish a brand that distinguishes their products from competitors.<sup>155</sup> Trademark infringement is not based on copying a trademark. Instead it is based on using the same or a similar trademark in commercial transactions in a way which is likely to confuse or deceive purchasers.<sup>156</sup> Hence, rights in a trademark can potentially last forever provided they continue to create the appropriate mental association in consumers.<sup>157</sup> Additionally, if a trademark's use becomes so pervasive that "it is widely recognized by the consuming public in the United States" as a trademark, the law provides additional protection via dilution law.<sup>158</sup> This protection protects the trademark from commercial use by others even in the

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150. See MPEP, *supra* note 46.

151. Federal trademark law (Lanham Act) is statutorily based on the Commerce Clause of the U.S. Constitution. SCHECHTER, *supra* note 146 at 561. A separate body of state trademark law that is common law based also exists. *Id.* at 550.

152. See GOLDSTEIN, *supra* note 137, at 167; see also *Moseley v. Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003).

153. See generally *Honeywell*, *supra* note 96 (design patent law encourages creation of new designs in contrast to trademark law which seeks to prevent public confusion with regard to purchasing decisions and to protect a trademark owner's brand).

154. See 15 U.S.C. § 1127 (definition of "trademark"). See generally *Brooks Bros. v. Brooks Clothing of California, Ltd.*, 60 F. Supp. 442, 449 (S.D. Cal. 1945) ("A trademark is merely a method used by a person to designate his goods.").

155. See *Brooks Bros.*, *supra* note 154.

156. *Sportvision, Inc. v. Sportsmedia Tech. Corp.*, 2005 U.S. Dist. LEXIS 22682, \*6-7 (N.D. Cal. Aug. 4, 2005) (trademark infringement requires plaintiff to show she has a valid trademark and that defendant's use of the same or similar mark is likely to cause consumer confusion).

157. *Chrysler Corp. v. Vanzant*, 44 F. Supp. 2d 1062, 1069 (C.D. Cal. 1999).

158. 15 U.S.C. § 1125(c)(2) (federal dilution action). For an overview of dilution law see MARY LAFRANCE, UNDERSTANDING TRADEMARK LAW § 3.05 (2nd ed. 2009).

absence of consumer confusion, competition or actual economic damages.<sup>159</sup>

The non-functional configuration of a product or its package, which can potentially serve as a trademark forever,<sup>160</sup> can also be protected by a design patent.<sup>161</sup> Trademark law, like copyright law, provides less protection for expressive content than design patent law. Design patent law prohibits use of a patented design for almost any purpose while trademark law generally only applies when the conduct at issue creates marketplace confusion among consumers with regard to the source of goods or services.<sup>162</sup> Nevertheless, if the non-functional shape or configuration of a product is protected by a design patent it should enter the public domain and be free for anyone to use upon patent expiration given the underlying purpose of the Constitution's Patent Copyright clause.<sup>163</sup> However, such use is curtailed if the product shape or configuration is generally recognized by consumers and is likely to cause consumer confusion as to the source of the product. Additionally, if the mark is a very well known mark, third party use of it could violate dilution rights even if no consumer confusion is likely to occur.<sup>164</sup>

Resolving the overlap issue arising from simultaneous protection via design patent law and trademark law is more problematic than simultaneous protection under design patent and copyright law. Both design patent and copyright law originate from and are based on the Patent Copyright clause and hence both are premised on the same underlying policy of encouraging the development of creative products that will flow into the public domain.<sup>165</sup> In contrast, trademark law with its roots in unfair competition law is based on the underlying policy of regulating certain types of market

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159. 15 U.S.C. § 1125(c)(1).

160. See generally SCHECHTER, *supra* note 146, at 606-10 (Product packaging or product configurations under trademark law typically come within a category known as trade dress which can be defined as the overall visual image or impression presented to consumers). See also *Gateway, Inc. v. Companion Prods., Inc.* 384 F.3d 503, 507 (8th Cir. 2004).

161. See generally Andrew Beckerman-Rodau, *The Problem with Intellectual Property Rights: Subject Matter Expansion*, 13 YALE J.L. & TECH. 84-88 (2010) (discussing examples of products simultaneously protectable via trademark law and design patent law).

162. See *Sportvision*, *supra* note 156.

163. See *supra* note 148.

164. See *supra* note 159.

165. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 432 (1984) (“ultimate aim [of copyright law] . . . to stimulate artistic creativity for the general public good”); *Bonito Boats*, *supra* note 74, at 151 (“ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure”).

conduct to protect consumers.<sup>166</sup> The question therefore involves how to balance these two different policies.

One approach is broadening the previously discussed functionality doctrine in trademark law so it applies beyond the distinction between functional and non-functional aspects of a product.<sup>167</sup> This has already occurred in some judicial decisions which have recognized that the doctrine should bar enforcement of trademark rights when such rights have the potential to interfere with non-reputational based competition.<sup>168</sup> Under this approach, the owner of trademark rights in the non-functional shape or configuration of a product or its container would be barred from asserting those rights whenever the result would be a significant interference in marketplace competition due to something other than the strength of the trademark.<sup>169</sup>

## V. INFRINGEMENT

The grant of a patent gives the patent owner the right to exclude others from making, using, offering for sale or selling the invention in the U.S., or importing the invention into the U.S.<sup>170</sup> Infringement occurs without regard to whether the infringer copies the patented invention, or whether he or she is even aware of the existence of the patent.<sup>171</sup>

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166. See *supra* note 153.

167. See *Qualitex*, *supra* note 87.

168. See, e.g., *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1072 (9th Cir. 2006) (“[T]he test for functionality proceeds in two steps. In the first step, courts inquire whether the alleged ‘significant non-trademark function’ [is] . . . ‘essential to the use or purpose of the article [or] affects [its] cost or quality’ . . . If this is the case, the inquiry is over—the feature is functional and not protected. . . . In the case of a claim of aesthetic functionality, an alternative test inquires whether protection of the feature as a trademark would impose a significant non-reputation-related competitive disadvantage.”).

169. See *generally* *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85 (S.D. Iowa 1982), where the John Deere Company sold tractors and tractor attachments to farmers that were painted a distinctive green color. The color was well-recognized by farmers as indicating John Deere as the source of the tractors and equipment. Farmhand made tractor attachments for use with John Deere tractors which it painted in John Deere’s distinctive green color. Although the green color didn’t affect the functionality of the equipment the court concluded that Farmhand could use the distinctive green color on its equipment sold to farmers for attachment to John Deere tractors. The court relied on an aesthetic functionality argument based on the factual finding that it was important to farmers that the color of their tractors and tractor attachments matched. Therefore, Farmhand would be at a significant competitive disadvantage if it could not paint its equipment John Deere green.

170. 35 U.S.C. § 154(a)(1).

171. *Chiuminata Concrete Concepts, Inc. v. Cardinal Indus.*, 1998 U.S. Dist. LEXIS 17288 at 13 (C.D. Cal. Sept. 3, 1998) (patent infringement is a strict liability action so court is

### *A. Infringement Analysis*

A patent infringement analysis for a design patent typically follows the same approach as an infringement analysis for a utility patent. The first step is called claim construction, and involves construing or interpreting the claim to ascertain its scope and meaning.<sup>172</sup> Second, the claim is compared to the allegedly infringing product to determine if all the elements and limitations contained in the claim are present in the allegedly infringing product.<sup>173</sup>

The same two steps are applied in a design patent infringement analysis,<sup>174</sup> however they are modified to accommodate the different subject matter protected by a utility patent and a design patent, and the different types of information disclosed in each type of patent. The first step of construing the scope and meaning of a design patent claim differs from analyzing a utility patent claim because the types of claims used differ greatly. A utility patent claim is based on a peripheral claiming technique which uses words to define the periphery or outer boundary of the claimed invention.<sup>175</sup> Understanding the claim in an infringement action typically involves a dispute over the meaning of a single word or phrase in the claim.<sup>176</sup> However, a design patent generally contains only a single claim that usually states “the ornamental design for a [article of manufacture] as shown and described.”<sup>177</sup> Such a claim is interpreted as referring to the ornamental appearance of the invention that is disclosed in the patent drawings.<sup>178</sup> Therefore, the drawings in the design patent rather than the words in the claim provide the best description of the

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required to award compensatory damages without regard to infringers intent, culpability or motivation), *rev'd on other grounds*, 1 Fed. Appx. 879 (Fed. Cir. 2001).

172. Key Mfg. Group, Inc. v. Microdot, Inc., 925 F.2d 1444, 1448 (Fed. Cir. 1991).

173. *Id.* at 1449.

174. Harel v. K.K. Int'l Trading Corp., 994 F. Supp. 2d 276, 278-79 (E.D.N.Y. 2014).

175. See Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 27 (1997) (peripheral claims describe the outer limits of the claimed invention); see also William T. Ralston, *Foreign Equivalents of the U.S. Doctrine of Equivalents: We're Playing in the Same Key But It's Not Quite Harmony*, 6 CHI.-KENT J. INTELL. PROP. 177, 185 (2007) (peripheral claims state the metes and bounds of the invention).

176. See, e.g., Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (meaning of term “baffles” in claim); Unique Concepts v. Brown, 939 F.2d 1558 (Fed. Cir. 1991) (meaning of term “preformed” in claim).

177. See Yardley, *supra* note 70, at 1390; see also L.A. Gear, *supra* note 79, at 1122-23; MPEP § 1503.01 (9th ed. Rev. 1, March 2014) (discussing proper form of design patent claim).

178. Harel, *supra* note 174. See generally Giro Sport Design Inc. v. Pro-Tec Inc., 16 U.S.P.Q.2d 1968, 1969 (W.D.WA. 1990) (scope of design patent claim only includes features shown in patent drawing).

claimed design.<sup>179</sup> The second step involves comparing the patent drawings with the allegedly infringing design.<sup>180</sup> However, the comparison does not involve an element-by-element comparison as undertaken in a utility infringement analysis.<sup>181</sup> It is the overall ornamental appearance of the patent drawings that are compared to the allegedly infringing design in order to determine if they are the substantially the same.<sup>182</sup> In the event that a patented design includes both functional and non-functional features, a prima facie case of infringement must show that the overall ornamental visual impression of the design – based on the ornamental features of the design – is substantially similar to the allegedly infringing design.<sup>183</sup>

The Supreme Court adopted the following test for design patent infringement which states:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.<sup>184</sup>

Although a line of lower court decisions subsequently added a second requirement to the above test,<sup>185</sup> the Federal Circuit

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179. *Egyptian Goddess Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc).

180. Harel, *supra* note 174, at 279.

181. See *Key Mfg. Group*, *supra* note 172, at 1449.

182. See generally, *Spotless Enterprises, Inc. v. A & E Products Group*, 294 F.Supp.2d 322, 343-44 (E.D.N.Y. 2003) (design patent claim covers overall appearance or visual impression of patented product).

183. *OddzOn Prods. v. Just Toys*, 122 F.3d 1396, 1405 (Fed. Cir. 1997). In *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293-1294 (Fed. Cir. 2010), the court noted that if a design is primarily functional it is not eligible to be protected by a design patent. But a design which is primarily ornamental may be eligible for a design patent despite the fact that it may still contain some functional aspects. However, the design patent's scope is limited to those ornamental aspects and it doesn't cover any functional elements of the patented article of manufacture. *Id.* at 1294. See also *L.A. Gear*, *supra* note 79 (“The elements of the design may indeed serve a utilitarian purpose, but it is the ornamental aspect that is the basis of the design patent.”).

184. *Gorham Co. v. White*, 81 U.S. 511, 528 (1871). *Richardson*, *supra* note 183, at 1295 (to demonstrate infringement “[t]he patentee must establish that 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.”).

185. E.g., *Contessa Food Prods. v. Conagra*, 282 F.3d 1370, 1377 (Fed. Cir. 2002) (design patent infringement can only be found if both the ordinary observer test and the point of novelty test are satisfied. “The ‘point of novelty’ test is distinct from the ‘ordinary observer’ test and requires proof that the accused design appropriates the novelty which distinguishes the patented design from the prior art.”); *Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.*, 2009 U.S. Dist. LEXIS 20948, 6 (N.D. Tex. Mar. 16, 2009) (the court noted that the federal circuit had subsequently eliminated the point of novelty test as a requirement for design patent

sitting en banc<sup>186</sup> eliminated that additional requirement and held the above test, which has become known as the “ordinary observer test,”<sup>187</sup> is the sole test for determining design patent “infringement.”<sup>188</sup>

The ordinary observer test, as stated by the Supreme Court, requires some additional amplification to understand how it has been understood and applied by courts. First, the ordinary observer is an average person who is familiar with the prior art but not an expert in the design of the product at issue.<sup>189</sup> Under the test, the question is whether such a person viewing the patented ornamental design as shown in the patent drawings and the allegedly infringing device would be likely to think they were the same or substantially the same.<sup>190</sup> Despite the test’s reference to deception that induces a purchase, it is not necessary to show any evidence of actual deception.<sup>191</sup> An expert opinion that an ordinary purchaser is likely to mistake the allegedly infringing design for the patented design is sufficient.<sup>192</sup> Additionally, it is unnecessary for the patentee to have “progressed to the manufacture and distribution of a ‘purchasable’ product for its design patent to be infringed by another’s product.”<sup>193</sup> Procedurally, the construction or meaning of the claim is a question of law<sup>194</sup> while the ultimate question of infringement is a question of fact.<sup>195</sup> Nevertheless, courts routinely find either infringement or non-infringement as a matter of law when it is clear that the designs are substantially similar or dissimilar, respectively.<sup>196</sup>

The ordinary observer test, noted above for design patent infringement, appears on its face to be somewhat analogous to the likelihood of confusion standard for trademark or trade dress

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infringement.).

186. Egyptian Goddess, *supra* note 179, at 670.

187. *Id.*

188. *Id.* at 678.

189. *Id.* at 677.

190. Harel, *supra* note 174 at 279.

191. *See* Apple, *supra* note 2, at 999.

192. *Id.*

193. Unette Corp. v. Unit Pack Co., 785 F.2d 1026, 1029 (Fed. Cir. 1986).

194. Harel, *supra* note 174 at 279.

195. *See id.* *See also* Richardson, *supra* note 183 at 1295.

196. *See, e.g.,* Minka Lighting, Inc. v. Craftmade Int’l, Inc., 2002 WL 1331883, at \*4 (N.D. Tex. June 14, 2002) (holding no design patent infringement as a matter of law because overall visual impression of patented ceiling fan design and allegedly infringing design not substantially similar).

infringement.<sup>197</sup> However, design patent infringement focuses on whether sufficient similarity exists between the patented ornamental design and the allegedly infringing design such that an ordinary consumer would think the infringing design is actually the patented design.<sup>198</sup> Actual copying, an intent to confuse consumers, or an intent to pass off one's goods as coming from another party are not requisite elements of design patent infringement.<sup>199</sup> In contrast, unfair competition<sup>200</sup> and trademark infringement<sup>201</sup> typically focus on marketplace behavior that would mislead or confuse a consumer. Therefore, intent to deceive or confuse consumers, intentional copying and other surrounding facts and circumstances are relevant.

For example, use of a conspicuous disclaimer may negate confusion in the context of an unfair competition or trademark infringement action. However, such factors are not directly relevant to design patent infringement.<sup>202</sup> This reflects the fact that anyone is free to copy a design that is unprotected via patent or copyright law but they are not permitted to engage in marketplace conduct that would cause source confusion among consumers.<sup>203</sup> Moreover, rights under trademark law require use of a mark in commerce, which creates a mental association with certain goods in the target consumer market for those goods.<sup>204</sup>

In contrast, patent law does not mandate making the patented product or engaging in any commercial activity related to the product as a prerequisite to asserting patent rights.<sup>205</sup> Similarities also

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197. *But see* Unette, *supra* note 193, at 1028-29 (likelihood of confusion test used in trademark infringement analysis is not the proper test for design patent infringement).

198. *See generally* Minka, *supra* note 196 at \*5-6 (finding no substantial similarity in design patent suit despite consumer survey showing substantial similarity).

199. *See* L.A. Gear, *supra* note 79, at 1126 (“Design patent infringement . . . does not require proof of unfair competition in the marketplace.”). *See also* Jack Schwartz Shoes v. Skechers U.S.A., 2002 U.S. Dist. LEXIS 25699, at 39 n. 8 (S.D.N.Y. 2002) (*quoting* L.A. Gear, *supra* note 79, at 1117).

200. *See generally* L.A. Gear, *supra* note 79, at 1131-32 (Lanham Act, 15 U.S.C. § 1125(a) only prohibits copying a product design if a likelihood of consumer confusion occurs.).

201. *See* 15 U.S.C. § 1114(1).

202. *See generally* L.A. Gear, *supra* note 79, at 1126 (labeling which may negate an unfair competition action by eliminating confusion does not avoid design patent infringement); Jack Schwartz Shoes, *supra* note 200, at 39 n. 8 (S.D.N.Y. 2002) (*quoting* L.A. Gear, *supra* note 79, at 1117).

203. L.A. Gear, *supra* note 79, at 1131.

204. *See* Brooks Bros., *supra* note 154.

205. Unette, *supra* note 193. *See generally* MCCARTHY, *supra* note 8, at 668-69 (although many countries require patents to be actually used within a certain time period the U.S. has never



exist between the tests for design patent infringement and copyright infringement. Both typically require a finding of substantial similarity between the protected work and the allegedly infringing work.<sup>206</sup> However, in the context of copyright infringement a showing of access to the copyrighted work coupled with substantial similarity to the copyrighted work infers that the allegedly infringing work was copied from the copyrighted work.<sup>207</sup> This is critical because copyright rights can only be violated by actual copying<sup>208</sup> of the protected work whereas design patent law does not require copying.<sup>209</sup>

### *B. Damages*

The patent law includes a general statutory provision which entitles a patent owner to compensatory damages resulting from infringement.<sup>210</sup> Typically, this requires the patentee to demonstrate actual losses due to the infringement.<sup>211</sup> Alternatively, the minimum damages for infringement are a reasonable royalty for the infringer's use of the patented invention.<sup>212</sup> Consequently, if an infringer makes substantial profits from his or her infringing activities the patent owner would not be entitled to those profits unless he or she can demonstrate that they would have actually earned those profits but for the infringement.<sup>213</sup> Although these rules apply to

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made use of a patent a requirement for asserting patent rights).

206. Harel, *supra* note 174 at 279 (patented design and allegedly infringing design must be substantially the same for infringement). Stewart v. Wachowski, 574 F. Supp. 2d 1074, 1084 (C.D. Cal. 2005) (copyright infringement requires copying a protected work and such copying can be shown by evidence of access to the work coupled with substantial similarity between the protected work and the copied work).

207. See Three Boys Music, *supra* note 147.

208. See 35 U.S.C. § 173

209. See generally *supra* notes 146 & 171.

210. 35 U.S.C. § 284. Under limited circumstances, such as willful infringement, the trial court has discretion pursuant to section 284 to increase damages up to three times the amount of the actual damages based on a punitive damages theory. See Sharper Image Corp. v. Honeywell Int'l Inc., 222 F.R.D. 621, 628 (N.D. Cal. 2004). See also 35 U.S.C. § 285 ("The court in exceptional cases may award reasonable attorney fees to the prevailing party."). See generally Pacific Furniture Mfg. Co. v. Preview Furniture Corp., 626 F. Supp. 667 (M.D.N.C. 1985) (Court awarded treble damages and attorney fees for willful and deliberate infringement of two design patents.).

211. See Nike Inc. v. Wal-Mart Stores, 138 F.3d 1437, 1442 (Fed. Cir. 1998) (noting Supreme Court interpreted 35 U.S.C. § 284 as only allowing recovery of patent owner's actual losses rather than equitable award of infringer's profits).

212. 35 U.S.C. § 284.

213. The so-called Panduit test is often used to establish a prima facie case of lost profits due to infringing sales. "The Panduit test requires that a patentee establish: (1) demand for the

both utility and design patent infringement the following separate statutory section provides an additional remedy only for design patent infringement:

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...<sup>214</sup>

This section gives a design patent owner the right to recover all the profits earned by an infringer without requiring an apportionment of the profits arising from the infringement.<sup>215</sup> Nor does the patentee have to show he or she could have earned those profits absent the infringing conduct.<sup>216</sup> Arguably, this remedy is equity based because it requires the infringer to forfeit any profits earned from the use of another party's property.<sup>217</sup> Although the statute clearly indicates this remedy is in addition to any other remedy provided by the patent law it prohibits duplicative recovery of the infringer's profits.<sup>218</sup>

Damages available for infringement of a design under copyright law include actual damages due to the infringement<sup>219</sup> plus any profits made by the infringer from the infringement that are not

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patented product; (2) absence of acceptable non-infringing substitutes; (3) manufacturing and marketing capability to exploit the demand; and (4) the amount of the profit it would have made." *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1545 (Fed. Cir. 1995).

214. 35 U.S.C. § 289.

215. *See generally* MUELLER, *supra* note 8, at 497 n. 77 (discussing special damage remedy available for design patents but not for utility patents).

216. *Id.*

217. *See generally* *Kleier Advertising Co. v. James Miller Chevrolet, Inc.*, 722 F. Supp. 1544, 1545 (N.D. Ill. 1989) (noting in the context of copyright infringement that actual damages suffered by copyright owner are based on a compensatory theory; and recovery of the infringer's profits are based on an equity theory whose goal is to prevent an infringer from unfairly gaining a monetary benefit from using another person's property). It could also be argued that allowing a design patent owner to recover the infringer's profits includes a punitive component because the design patent owner is not required to establish what portion of an infringer's profit was the result of the patented design. *Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 2014 U.S. Dist. LEXIS 117489 at 31 (M.D. Fla. Aug. 22, 2014).

218. 35 U.S.C. § 289. *See Catalina Lighting v. Lamps Plus*, 295 F.3d 1277, 1291 (Fed. Cir. 2002) (noting design patent owner can elect his actual damages due to infringement or recovery of the infringer's profits but not both).

219. 17 U.S.C. § 504(b).

included in computing the actual damages.<sup>220</sup> However, copyright law provides a somewhat unique alternate remedy.<sup>221</sup> The copyright owner can opt to receive statutory damages in lieu of actual damages.<sup>222</sup> Statutory damages do not require a showing of actual damages or lost profits. Once infringement is established the court awards damages within a preset statutory range<sup>223</sup> based on what “the court considers just.”<sup>224</sup>

Actual damages available for trademark infringement under federal law are similar to the damages available for copyright infringement. Trademark damages include the infringer’s profits<sup>225</sup> plus the trademark owner’s actual damages.<sup>226</sup> However, the statute notes that the total recoverable damages “shall constitute compensation and not a penalty”<sup>227</sup> which suggests that the total of the profits and the actual damages should not include duplicative amounts. Finally, statutory damages analogous to such damages under copyright law are permitted under federal trademark law in lieu of actual damages and profits in limited circumstances.<sup>228</sup>

The typical damage remedies for design patent, copyright and trademark infringement are somewhat analogous. Each body of law allows recovery of actual damages under a compensatory theory. Additionally, the infringer’s profits are also recoverable which represents an equity based remedy or an unjust enrichment theory premised on the underlying concept that a third party should not be permitted to earn revenue by using someone else’s property without permission. Finally, each body of law disallows duplicative recovery of the infringer’s profit. Hence, theoretically the minimum total recovery would be the actual damages—such as profits from lost

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220. *Id.* Under limited circumstances the court may award reasonable attorney fees to the prevailing party. *Id.* at §505.

221. *Id.* at § 504(a) (copyright owner can seek actual damages or statutory damages).

222. *Id.* at § 504(c)(1).

223. *Id.* (range of statutory damages is \$750 to \$30,000 for all infringements of a particular work). The court has discretion to reduce the damages to not less than \$200 for innocent infringement; and to increase damages up to \$150,000 for willful infringement. *Id.* at § 504(c)(2).

224. *Id.* at § 504(c)(1).

225. 15 U.S.C. § 1117(a).

226. *Id.*

227. *Id.*

228. *Id.* § 1117(c) (statute provides for statutory damages in the range of \$1,000 to \$200,000 for the use of counterfeit marks; the upper limit can be increased to \$2,000,000 for willful use of a counterfeit mark); *id.* at § 1117(d) (statute provides for statutory damages in the range of \$1,000 to \$100,000 for certain types of cyberpiracy).

sales—suffered by the intellectual property owner due to infringement. The owner would then be able to also recover the profits made by the infringer provided that any amount of such profits that formed part of the actual damages must be subtracted from the profits. This is necessary to insure that the total recovery does not include a portion that represents duplicative recovery of the infringer's profits.<sup>229</sup>

But patent, copyright and trademark law do not address the question of stacking damages by simultaneously pursuing separate and distinct claims under each body of law. For example consider the following hypothetical:

Ann owns a design patent that covers a portion of the ornamental appearance of the roof on a baby stroller. She also satisfies the separability requirement and registers a copyright in the appearance of that same portion of the roof. Further, after selling the stroller for several years the same portion of the roof develops acquired distinctiveness and as a result she claims trademark rights in that portion of the roof. Subsequently, Bob sells identical copies of the stroller. Ann sues Bob for design patent infringement, copyright infringement and trademark infringement. Pursuant to her patent infringement claim Ann recovers the total profit made by Bob arising from his design patent infringement (\$50,000). Can Ann also recover the damages and/or Bob's profits due to his copyright and trademark infringement?

It can be argued that three separate and distinct causes of action exist and therefore damages plus the infringer's profits should be available for violation of each right. Additionally, it could be viewed as incongruous to recognize valid property rights and then withhold a monetary remedy for infringement of such rights. However, in light of the remedies provided by statute it seems clear that recovery under each body of law is primarily based on a combination of a compensatory theory (actual damages) and an unjust

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229. See 35 U.S.C. § 284 (Court shall award "damages adequate to compensate for the [patent] infringement."); 17 U.S.C. § 504 (copyright owner entitled to actual damages due to copyright infringement in addition to infringer's profits arising from the infringement); 15 U.S.C. § 1117(a) (Generally, damages for trademark infringement "shall constitute compensation and not a penalty."). Arguably, increased damages authorized by specific statutory sections which have limited applicability may allow duplicative recovery based on a punitive rather than a compensatory model. See, e.g., 17 U.S.C. § 504(c)(2) (Copyright infringement damages may be increased for willful infringement); 15 U.S.C. § 1117(b) (Damages can be trebled for trademark infringement involving counterfeit marks); 35 U.S.C. § 284 (Court may increase damages based on willful patent infringement).

enrichment theory (infringer profits). Hence, the combined amount of recovery under all three actions should not exceed an amount that goes beyond compensating Ann for her total damages plus any profits earned by Bob from his selling infringing strollers. Therefore, if Ann in the above hypothetical recovers Bob's profits of \$50,000 for his design patent infringement it can be argued that she should not receive any additional monetary damages that would be duplicative.<sup>230</sup> Hence, to avoid duplicative recovery Ann's \$50,000 award for design patent infringement should prevent any additional damages or profits from being awarded for either copyright or trademark infringement.<sup>231</sup> Additionally, this result may be mandated by the fact that it may be impossible as a practical matter to separate or allocate the damages among the three different causes of action.

The following hypothetical raises an analogous but slightly different scenario where different claims are pursued at different times rather than simultaneously:

Ann owns a design patent that covers a portion of the ornamental appearance of the roof on a baby stroller. She also satisfies the separability requirement and registers a copyright in the appearance of that same portion of the roof. Further, after selling the stroller for several years the same portion of the roof develops acquired distinctiveness and as a result she claims trademark rights in that portion of the roof. Subsequently, Bob sells identical copies of stroller. Ann sues Bob for design patent infringement and she recovers the total profit made by Bob arising from his design patent infringement (\$50,000). Two years later, after the design patent expired, Bob again began selling the stroller which would have infringed the patent but for the fact that it has expired. Ann now sues Bob for copyright infringement asserting damages of \$10,000 which represents her lost sales due to Bob's

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230. See generally *Catalina Lighting*, *supra* note 218, at 1290-92 (Fed. Cir. 2002) (Patent owner recovered all infringer's profits for sale of lamp covered by design patent under 35 U.S.C. §289; this prevented recovery for utility patent infringement for same sales of lamp because recovery for both utility and design patent infringement arising from sales of same product by same infringer would amount to duplicative recovery.); *Contour Chair Lounge Co. v. True-Fit Chair, Inc.*, 648 F. Supp. 704, 719 (E.D. Mo. 1986) (Finding both utility patent and trade dress infringement from sale of chairs; however, court declined to award monetary damages for trade dress infringement because monetary recovery for patent infringement fully compensated plaintiff.).

231. Common law remedy theory may also support this result. Under the one-satisfaction rule "a plaintiff is only entitled to one recovery for a particular harm, and that plaintiff must elect a single remedy if the jury has awarded more than one." BLACK'S LAW DICTIONARY 1117 (7th ed. 1999).

commercial activity after the design patent expired. Can Ann recover the \$10,000 despite her earlier award of \$50,000?

In this second hypothetical, Ann should be able to recover the additional \$10,000 for copyright infringement despite the prior \$50,000 damage award for design patent infringement. This second award represents different damages than those previously compensated for in the prior design patent infringement award and therefore they are not duplicative.

### *C. Fair Use*

Intellectual property rights protect inventions, information and expressive content under a variety of regimes. Utility patent law allows a patent owner to prevent others from making using or selling the patented invention in return for placing information about how to make and use the invention into the public domain.<sup>232</sup> Trade secret law allows virtually any non-public information that provides a competitive advantage to be protected provided it is maintained in reasonable secrecy.<sup>233</sup> Neither of these bodies of law typically raises free speech issues.<sup>234</sup>

In contrast, both copyright law and trademark law provide significant protection for speech and other expressive content that can limit third party use of such content. This protection often conflicts with the broad free speech protection afforded to the public by the First Amendment. This conflict has been mediated by judicial creation of a fair use doctrine<sup>235</sup> and statutory exemptions<sup>236</sup> that

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232. 35 U.S.C. § 154(a)(1).

233. See ELIZABETH A. ROWE & SHARON K. SANDEEN, *CASES AND MATERIALS ON TRADE SECRET LAW* 1-2 (1st ed. 2012).

234. See *DVD Copy Control Assn., Inc. v. Bunner*, 31 Cal. 4th 864, 887 (Cal. 2003) (preliminarily enjoining trade secret disclosure not a prior restraint in violation of the First Amendment). *But see Ford v. Lane*, 67 F. Supp. 2d 745, 746 (E.D. Mich. 1999) (preliminarily enjoining person who likely misappropriated a trade secret from publicly disclosing the secret would be prior restraint in violation of the First Amendment). See generally, Andrew Beckerman-Rodau, *Prior Restraints and Intellectual Property: The Clash Between Intellectual Property and the First Amendment from an Economic Perspective*, 12 *FORDHAM INTELL. PROP., MEDIA & ENT. L.J.* 1 (2001) (discussing interaction of First Amendment with the various bodies of intellectual property law).

235. *Iowa State Univ. Research Foundation, Inc. v. American Broad. Cos.*, 621 F.2d 57, 60 (2d Cir. N.Y. 1980) (copyright fair use doctrine created by court decisions). Copyright fair use subsequently codified. 17 U.S.C. § 107. *Playboy Enters. v. Terri Welles, Inc.*, 78 F. Supp. 2d 1066, 1073-1074 (S.D. Cal. 1999) (Federal trademark law also recognizes a fair use defense). See also 15 U.S.C. §§ 1115 (b)(4) (fair use defense for trademark infringement action) and 1125(c)(3)(A) (fair use defense for trademark dilution action).

236. See, e.g., 17 U.S.C. § 110(1) (teaching exemption); *id.* at §110(3) (religious

enables courts to balance the competing interests and permit free speech concerns to trump copyright and trademark rights in certain circumstances.<sup>237</sup>

A similar fair use doctrine has not been recognized via case law or statute for design patents even though such patents protect the ornamental appearance of objects which may come within the domain of First Amendment free speech protection.<sup>238</sup> Nevertheless, it could be argued that such a doctrine is constitutionally required in light of the fact that design patents explicitly cover expressive content in the form of an ornamental design applied to a product or the ornamental shape of a product.

Despite the theoretical need for a fair use doctrine for design patents one reason it may not have developed either by case law or statute is because of a dearth of actual disputes involving free speech issues with regard to third party use of a design patent. According to the leading patent law commentator, in virtually every reported design patent infringement decision the patented article and the allegedly infringing article were of the same type.<sup>239</sup> Hence, the litigated disputes do not appear to have involved unauthorized uses of the patented article that would trigger free speech concerns.

This result may be a function of the test for design patent infringement which obviates the need for a fair use doctrine. Merely copying the patented product is not enough for infringement. Likewise, even if an ordinary consumer would recognize an association between the allegedly infringing product and the patented product that would not be infringement. Infringement only occurs if the ordinary buyer would realistically believe that the allegedly infringing product or article was the same or sufficiently similar to the patented article such that the consumer would be deceived into believing he or she was actually buying the patented article.<sup>240</sup> Conversely, if an ordinary buyer would not believe they were buying the patented article no infringement has occurred. As a result of this test it is unlikely that most activity that would require First

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performance exemption for certain literary and musical works); *id.* at § 115 (compulsory license for copies of certain musical works).

237. Iowa State, *supra* note 235 (“The doctrine of fair use . . . permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”).

238. Heymann, *supra* note 139, at 250.

239. Chisum, *supra* note 18.

240. *See id.* at §23.05[3].

Amendment protection would not be otherwise infringing.

#### CONCLUSION

The renewed interest in design patents presents both opportunities and challenges. In addition to reliance on copyright and trademark law, a company can now add design patents to its arsenal of intellectual rights for protecting the distinctive appearance of its products. The requirements for each type of protection, the duration of the protection and the damages for infringement vary based on the type of rights involved. For example, design patents now provide fifteen years of exclusive protection after the patent is granted. In contrast, copyright protection only prohibits actual copying but those rights can last for up to a century or more. Finally, commercial use of a distinctive non-functional visual aspect of a product that is likely to cause consumer confusion is actionable under trademark law and such rights can potentially last indefinitely.

The differing requirements for each type of protection can be beneficial for an intellectual property owner. For example, copyright protection for the aesthetic aspects of a useful article requires a showing that the aesthetic aspects are separable from the utilitarian aspects of the article. This is often a difficult requirement to satisfy and failure to meet this requirement defeats copyright protection. Typically, this is an issue with clothing, and copyright protection is usually denied on this basis. However, a separable requirement doesn't exist for design patent protection. Therefore, clothing is routinely granted design patent protection.

The current view among courts, that simultaneous protection under these different bodies of law can be obtained, enables a company to pursue different damage remedies at the same time. Typically, damages are based on a compensatory model. However, copyright law provides the alternative of statutory damages, which gives the court wide discretion to determine damages even in the absence of any evidence of injury. Likewise, a design patent owner has the option of recovering all the profits earned by the infringer, which is essentially an equitable theory rather than a compensatory theory.

Recent Supreme Court decisions narrowing what can be protected by utility patents may affect the domain of design patents because utility patent law in general applies to design patents unless the patent law states to the contrary. Hence, one ongoing challenge



will be whether those decisions restrict the subject matter eligible for design patent protection. As discussed, the granting of design patents for computer icons under the theory that the computer monitor on which the icon appears is the article of manufacture may be improper. Obviousness determinations for design patents based on requiring satisfaction of the TSM test may no longer be good law. Finally, despite the current lack of a fair use doctrine with regard to the use of a patented design subsequent disputes are likely to assert the need for a fair use doctrine as a defense to design patent infringement in certain circumstances.