

Design Patents: Alternative Protection for Articles of Manufacture¹

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U.S. LEGAL STANDARD FOR THE GRANT OF A DESIGN PATENT

Generally stated, design patents are available to an inventor for any "new, original and ornamental design for an article of manufacture." 35 USC 171. Thus, it is the appearance of an article of manufacture to which design patents are directed. Stated differently, it is the shape, surface ornamentation, or a combination of each, which is embodied in or on an article of manufacture that is proper subject matter of a design patent application. See 35 USC 171; *see also Gorham Mfg. Co. v. White*, 81 U.S. 511, 525 (1872); *In re Blum*, 153 USPQ 177, 180 (CCPA 1967). However, it should be noted that mere ornamentation, apart from an article of manufacture, is not statutory subject matter.

FUNCTIONAL DESIGNS

Further, primarily "functional" designs of articles or products are not "ornamental" designs and hence not protectable by design patents. *See e.g. Best Lock Corporation v. ILCO Unican Corp.*, 40 USPQ2d 1048 (Fed. Cir. 1996) (key blade design patent deemed invalid because the design was functional rather than ornamental). This is not to say that only non-functional features are encompassed within the scope of design patents. Rather, because design patents are directed to the design of an article of manufacture, it is recognized that the design necessarily serves a utilitarian purpose. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 25 USPQ2d 1913, 1917 (Fed. Cir. 1993). It is only when that design *is dictated* by the use or purpose of the article that the functionality of the design becomes problematic. "A design is not dictated solely by its function when alternative designs for the article of manufacture are available." *Best Lock*, 40 USPQ2d at 1050.

Functionality of a design cannot be shown by demonstrating that each element serves some function; the design at issue must be viewed in its entirety. "[F]or, the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article." *L.A. Gear Inc. v. Thom McAn Shoe Co.*, 25 USPQ2d 1913, 1917 (Fed. Cir. 1993) (*citing Lee v. Dayton-Hudson Corp.*, 5 USPQ2d 1625, 1627 (Fed. Cir. 1988)). For example, in *L.A. Gear*, the court noted that elements of the patented design such as the side mesh and delta wing provide support for the foot, nonetheless that "does not mean that the specific design of each element, and the combination of these elements into the patented design, is dictated by primarily functional considerations." *L.A. Gear*, 25 USPQ2d at 1917. Further, "[w]hen there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose." *L.A. Gear*, 25 USPQ2d at 1917 (*citing Avia Group International, Inc. v. L.A. Gear California, Inc.*, 7 USPQ2d 1548, 1553 (Fed. Cir. 1988)).

Examples of design patents granted on utilitarian products were listed by Judge Newman in the dissent of *Best Lock* in order to illustrate the mixture of functional and nonfunctional features protectable by design patents. *Best Lock*, 40 USPQ2d at 1050. The exemplary products granted design patents include: a steering wheel lock, a massage device, a tubeless tire changer, a liquid dispenser container, a tire tread design, an eyeglass display rack, a spice bottle container, a roof shingle, a concrete block for a retaining wall, a femoral hip stem prosthesis, a bottle cap, an armchair, a microwave oven, and a concrete mixer truck. *Best Lock*, 40 USPQ2d at 1050, J. Newman, dissenting.

One notable exception to the myriad of products capable of design patent protection may be car body parts such as body panels. This has been attributed to a public policy rationale concerning the immense spare parts market and a potential monopoly associated with design patents thereon. Others reason that it is when the functionality of the product overrides its ornamentality that design patent protection is not available. In any event, at

least one court has deemed the design of car body panels "primarily functional" and thus not ornamental. See *Chrysler Motors Corp. v. Auto Body Panels of Ohio*, 12 USPQ2d 1493 (S.D. Ohio 1989) (fender designed to functional and performance consideration in contrast to ornamental considerations).

CLAIMING

Typically, a design patent is "claimed" by illustrating surfaces seen in use. Thus, the drawings typically include a perspective view, a side elevation view, as well as front, rear and top views. If the product is not seen by the public at some point in its life, protection will generally be denied. See e.g. *C & M Fiberglass Tanks, Inc. v. T&N Fiberglass Manufacturing Co.*, 214 USPQ 159 (DC SC 1981)(underground septic tank concealed in normal and intended use not capable of "ornamentality" under 35 USC 171); *but see In re Webb*, 16 USPQ2d 1433 (Fed. Cir. 1990) (artificial hip viewable at time of sale is visible to viewing public during some point in its life).

As the drawings (or photographs) are substantially "the claims" in a design patent application, all illustrated elements or features can be limiting to the scope of the patent. See generally, Perry J. Saidman, *Design Patentees: Don't Get Unglued by Elmer*, 78 JPTOS No. 5, p. 311-344 (May 1996). However, an important tool in design patent application drawings is the use of a broken line. The broken line indicates that portion of the drawing is not claimed. Further, the entire product does not need to be claimed; indeed, only the novel portion of a product needs to be claimed by showing the remainder of the product in broken line. Additionally, the claimed invention can be shown in its intended environment of use by indicating the environment in broken lines. See *In re Zahn*, 204 USPQ 988 (CCPA 1980). However, if only a portion of the article of manufacture is claimed then the title should correspondingly recite a portion of the article of manufacture which is desired to be claimed. For example, the title for a motorcycle with wheels in solid lines is properly "motorcycle"; the title for a similar product with the wheels in broken line is a "motorcycle frame".

As discussed above, design patents are typically limited to that embodiment illustrated in the figure(s). Therefore, it can be advantageous to include multiple embodiments, each illustrating different levels of detail in order to broaden the scope of the patent. Id., Saidman, 78 JPTOS No. 5, pp. 320-343 (May 1996). For example, in *Ex parte Daniels*, an original design patent application was filed on a leech trap illustrating a product configuration as well as surface ornamentation thereon. A subsequent application removed the surface ornamentation and attempted to base priority on the earlier application. However, the Board of Patent Appeals and Interferences stated that the design of the leech trap with the surface ornamentation was not the same design as the one without the ornamentation, because "surface ornamentation on the leecher... contributes to the overall appearance and manifestly gives different impression from the leecher without the ornamentation." *Ex Parte Daniels*, 40 USPQ2d, 1394, 1405 (BPAI 1996). Notably, if the original application had included two drawings, one with surface ornamentation and one without, the priority problem or new matter issue would not have arisen, although a divisional application might have had to have been filed.

DRAWINGS, PHOTOGRAPHS

Drawings are preferred because it is typically easier to show the novel, claimed elements in solid lines and to show the non-essential elements in dotted lines. However, photographs, both black and white and color, can be submitted as informal drawings to obtain a filing date. Further, black and white photographs are now acceptable as formal drawings. A petition and associated fee requesting that the photographs be accepted as formal drawings, pursuant to 37 CFR 1.184(b) (1), must be submitted along with the photographs (on specified paper) in triplicate.

If photographs were submitted as informal drawings in the original application, drawings can be submitted formally in lieu thereof, but the drafts person must be careful to illustrate

the features shown in the photographs or risk a new matter rejection. Alternatively, photographs can be submitted with the original application, i.e., where non-essential elements are descriptively disclaimed in the original specification.

Color photographs (and drawings) can be submitted as informal drawings to obtain a filing date. However, the color presents potentially greater limitations and potentially will likely be more difficult to express in ink drawing format due to the expression of color. Thus, when submitting color photographs as informal design patent application drawings consider specifically disclaiming the color in the original disclosure.

OBVIOUSNESS

The obviousness inquiry for design patents under 35 USC § 103 is "whether one of ordinary skill [in the design of the articles involved] would have combined teachings of the prior art to create the same overall visual appearance as the claimed design." *Durling v. Spectrum Furniture CO., Inc.*, 40 USPQ2d 1778, 1790 (Fed. Cir. 1996) (citing *In re Borden*, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996)). The first step in an obviousness evaluation for design patents requires a finding of a proper "base reference." *In re Rosen*, 213 USPQ 347, 349 (CCPA 1982); *Durling* at 1790 (Fed. Cir. 1996)(reversing invalidity judgment for lack of a primary reference). Thus, before combining prior art references, there must be a single reference or "a something in existence, the design characteristics of which are basically the same as the claimed design." *In re Rosen*, 213 USPQ at 350. Only if a primary reference is found can other references be used to modify it and only if the secondary references are "so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other." *Durling* at 1790 (citing *In re Borden*, 39 USPQ2d at 1526-1527). The focus of the inquiry in an obviousness determination involving design patents is on the **appearance** rather than the design **concept**. *Durling* at 1791 (citing *In re Harvey*, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993)(emphasis added).

In *Durling*, the court agreed that the cited prior art designs created a different visual image than the design at issue. The suit involved sectional sofas with built in tables. The Federal Circuit states that the trial court must give a verbal description of the invention and the prior art and when properly done "the verbal description should evoke the visual image of the design." *Durling* at 1790, FN2; *In re Harvey*, 29 USPQ2d 1206, 1208. The Federal Circuit then found that the trial court had focused on the design concept. Accordingly, the description given by the trial court represented the general concept of a sectional sofa with integrated end tables. *Durling* at 1791. The Federal Circuit then went on to descriptively describe the claimed "design's visual appearance,

"a contiguous three-piece sectional sofa group containing two sofa sections at approximately right angles to each other with a triangular corner table at their juncture. On the sides away from the corner table, each sofa section has rounded corners and includes a bolster pillow as an armrest. In addition, each sofa section has a double front rail that begins at the end adjacent to the corner table, follows along the bottom of the sofa towards the other end, and curves upwardly (i.e., sweeps upward) through a 90 degree angle to truncate at a horizontal plane upon which the end table rests."

Id.

The court found that the visual appearance of the cited reference was of a three-piece contiguous sofa sectional group and two linear sofa sections are positioned at approximately right angles to the other, as in *Durling's* design. However, the Court noted,

"instead of having a triangular corner table at their juncture. On the Schweiger model [the cited base reference] contains a third, curved sofa section that lies between the other two sofa sections. When the three sofa sections are joined, the appearance is that of a rounded right angle. As in

Durling's design, the Schweiger model has rounded ends, bolster pillows, and a double front rail. In the Schweiger model, however, the double front rail curves upward slightly, and then curves outward in a horizontal direction to wrap around the end tables."

Durling at 1791.

The Court went on to define the differences of the front rail and found that there were significant differences between the design at issue and the reference and these significant differences precluded the reference from creating the same visual impression and as such it could not be a primary reference. *Id.* Thus, in design patent obviousness analysis, a proper base reference must be found such that the design is fundamentally similar to the base reference; then, the query is whether a skilled designer in the art would have had a suggestion to combine the cited references.

INFRINGEMENT

The standard for infringement of a design patent is whether an ordinary observer, giving such attention as a purchaser usually gives finds the alleged design to be substantially similar to the patented design. See Robert L. Hannon, *Patents and The Federal Circuit* §2.4, p. 39 (2d ed. 1991).

For primarily non-functional "ornamental" designs, beware claiming functional features. See *Best Lock Corporation v. Ico Unican Corporation*, 40 USPQ2d 1048 (Fed. Cir. 1996) (lock flank inherently functional, patentee did not claim entire key). It generally helps to have an array of different designs available which will perform the same function to more clearly *illustrate* that the chosen design *is not dictated* by function and thus is primarily nonfunctional.

Further, as discussed hereinabove, what you show is what is claimed unless a written disclaimer is in the disclosure, or unless the unclaimed" portions of the product are shown in broken lines in the drawing(s).

RECENT GUIDELINES FOR DESIGN PATENTS FOR COMPUTER ICONS

Recently, the PTO published step by step guidelines on how to prepare design patents for computer generated icons. Previously, icons and typefaces were not deemed to be articles of manufacture and thus were not protectable by design patents. See e.g., *Ex pane Strijland*, 26 USPQ2d 1259, 1262 (BPAI 1992)(computer icon alone is merely surface ornamentation). Currently, however, the designs on these items can be claimed by stating that the design is displayed on an article of manufacture. For example, a computer generated icon embodied in a computer display. The drawing can illustrate the display in dotted line or solid line. See 61 Federal Register 11380-11382 (March 20, 1996), 51 BNA-PTCJ 624-626 (March 21, 1996). Also, due to the visual nature of the subject matter, consider adding a copyright notice in the disclosure to provide notice for designs capable of both copyright and design patent protection. See 37 CFR 1.84(s); 37 CFR 1.71(e).

MULTIPLE LEGAL AVENUES OF PROTECTION

Interestingly, some designs may be subject matter eligible for three-way protection; namely, by trademark, copyright, and (design) patent law. These are three separate and independent avenues of legal protection. One does not preclude the other. Copyright law protects against copying, but does not protect against independent authorship.

Trademark law protects consumers against the likelihood of confusion; as such, it may not protect against the use of the alleged mark in non-overlapping channels of trade. Design patents protect the patented design against all subsequent designs of the product which are "substantially similar" for the specified term of the patent grant. Thus, each regime can complement the others to more broadly protect the basic design. Due to the recent

guidelines allowing design patents for computer icons, this subject matter may be eligible for this type of three-way protection.

OVERVIEW OF ADVANTAGES OF DESIGN PATENTS

(1) Presently, design patent applications will pass to issuance faster than co-filed utility patents. The USPTO Design Group has been selected as the pilot program for office streamlining procedures. This Group has established a goal of a First office action issued within 2-4 months of filing if filed with a complete set of filing documents. Thus, if an infringing situation is likely to occur, design applications can issue as patents much faster and yield enforceable protection against infringers in a much more expeditious manner than a co-filed utility patent application.

(2) Design patents can help fight a functionality defense assertion for product configurations and designs which claim a trademark or trade dress violation for the product configuration or surface treatment. See *generally*, Julie Hauschild Richardson, Examining Trademark Registrability and Protectability of Product Configurations, 7 NCBA IP Links No. 3, p. 1 (March 1996).

(3) Unlike copyrights, when a design infringes, there is no need to prove access or copying; design patents, like utility patents, can provide protection even against independent (subsequent) inventors.

(4) Currently, design patents, unlike trademarks and utility patents, are exempt from maintenance fees.

CONCLUSION

Product designs are important business assets in today's marketplace. Design patents can play a role in helping to protect competitors from copying these assets. The USPTO has stated it wishes to see more Design applications submitted and has initiated a faster working group directed to facilitating this goal. Also of interest is a home page set up to provide IP developments on the subject of industrial design law. See <http://www.fryer.com> Copyright 1996, W.T. Fryer III.

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