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THE PATENTED DESIGN

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THE PATENTED DESIGN

SARAH BURSTEIN*

The design patent system is over 170 years old; however, the law of design patents is woefully underdeveloped and undertheorized. One particularly important open question has to do with the very nature of the protected subject matter—what, exactly, is “the patented design”? Accordingly, it is not clear whether the use of a claimed shape on a different type of product or a visual representation of a patentee’s commercial embodiment constitutes infringement. This Article argues that neither use should be deemed to be infringing because the patented design should be conceptualized as the design as applied to a specific type of product—not as something akin to a copyrighted “work” (a concept this Article will refer to as a “design per se”). Accordingly, particular shapes and configurations—even those that are patented—would remain free to be adapted to different types of products. This conclusion is supported by the nature of product design and policy goals including the promotion of the decorative arts and protection of free expression. This analysis also has implications for the larger policy debate over how designs should be protected as intellectual property.

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INTRODUCTION

In a recent lawsuit, a stun-gun manufacturer sued the makers of the video game *Call of Duty: Black Ops II*.¹ The company alleged that the appearance of certain in-game weapons—specifically, the “Combat Suppression Knuckles” and “Galvaknuckles”—infringed its design patent for the “Zap Blast Knuckle” brass-knuckles-style stun gun.² Although this claim was quickly dismissed, it presented an interesting question—can a video game infringe a design patent for a stun gun? And, as a more general matter, does a visual representation of a product embodying a patented design infringe the design patent?

Although the U.S. design patent system is over 170 years old,³ it does not provide clear answers to these questions.⁴ To infringe a design patent, a defendant must make, use, sell, offer to sell, or import the claimed invention, which will be referred to in this Article as “the patented design.”⁵ But it is not at all clear what “the

1. See First Amended Complaint, *P.S. Products, Inc. v. Activision Blizzard, Inc.*, No. 4:13-cv-00342 (E.D. Ark. Sept. 13, 2013), ECF 20.

2. *Id.* ¶ 16 (“The Plaintiffs’ product, the *Zap Blast Knuckle*® embodies the US D561, 294 S design patent.”).

3. The first U.S. design patent act was enacted in 1842. See Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 (1842).

4. Indeed, design patent law as a whole is seriously underdeveloped. This seems to be due, at least in part, to the fact that design patents were decidedly out of vogue for most of the twentieth century. But the phenomenon of design patents getting insufficient attention appears to go back even further. See Hector T. Fenton, *Preface* to HECTOR T. FENTON, *THE LAW OF PATENTS FOR DESIGNS* iii (1889) (“So little attention has been given to the subject of Design Patents by text writers on Patents for Inventions, that the author need scarcely apologize for his attempt to prepare a useful but brief treatise on the principles governing protection for such inventions . . .”). And past Patent Office practice appears to have been chronically inconsistent. See William Edgar Simonds, *Preface* to WILLIAM EDGAR SIMONDS, *THE LAW OF DESIGN PATENTS* (1874) (“The decisions in the Patent Office [on design patents] have been conflicting, and the court cases are not altogether harmonious.”); WILLIAM L. SYMONS, *THE LAW OF PATENTS FOR DESIGNS* 2 (1914) (“Relative to many questions of design practice what Commissioner Fisher said in 1869 is true today. ‘The practice of this Office has not been uniform, and the true practice is still to be adopted and followed.’” (quoting *Ex parte Bartholomew*, 1869 Dec. Comm’r Pat. 103, 105)); *id.* (“At the present time much doubt and confusion exists as to what is proper subject matter for a design patent; nor is the practice in this class of patents well settled.”).

5. See *infra* Section I.B.3. The phrase “the patented design” is taken from the design patent disgorgement provision, 35 U.S.C. § 289 (2012). This Article will use “the patented design” as a useful shorthand to describe the invention protected by a design patent.

patented design” actually is. Based on the statutory language alone, it could be anything from a “design *per se*”—i.e., something akin to a “work” in copyright law—to a particular design embodied in the particular product as sold in a particular market.⁶

Because we do not have an established concept of the precise nature of the protected invention, some important issues remain open, including the issue raised directly in the *Call of Duty* case—namely, can a design patent be infringed by a visual representation of a real-world product? Another issue is whether the use of a claimed shape or image on a totally different type of product constitutes infringement.⁷ For example, could the brass-knuckles-style stun gun design patent from the *Call of Duty* case be infringed by a pair of brass knuckles? By a similar-looking piece of jewelry? A high-end designer clutch?⁸ What about a smartphone case with a handle that looks like a set of brass knuckles?⁹

Defining the scope of the patented design is important for at least three reasons. First, parties are raising these issues in litigation.¹⁰ The issue of visual representations, in particular, will only increase in importance with the continuing rise of digitization and virtual worlds. Second, in the wake of the blockbuster verdict in

6. See generally Pascale Chapdelaine, *The Property Attributes of Copyright*, 10 BUFF. INTEL. PROP. L.J. 34, 58 (2014) (“While copyright requires a work to take a fixed physical form to exist, the material embodiment of the work (e.g. copies of books, musical recordings, films, etc.) is an entity separate from copyright.”).

7. See 8 DONALD S. CHISUM, CHISUM ON PATENTS (MB) § 23.05[2] (2014) [hereinafter CHISUM ON PATENTS] (“Whether a patent on the design on a certain article of manufacture is infringed by use of the identical design on a different article is a long-standing problem that has never been satisfactorily resolved.” (citing SYMONS, *supra* note 4, at 70–71)).

8. Cf. Philip Weber, *Take Cover, She Has a Purse!*, TSA NEWS (Aug. 6, 2012), <http://tsanewsblog.com/4576/news/take-cover-she-has-a-purse/> (showing a picture of an Alexander McQueen “Knuckle-Duster” clutch). See also Beatrice Siu, *Bags of Trouble*, THE STANDARD, June 3, 2013, at 2 (“Ladies be warned: the trendy McQueen handbag with a knuckle-duster clutch you bought from an upmarket boutique could land you in jail. The bags, costing from HK\$11,000 to HK\$40,000, are not illegal—but carrying a knuckle-duster is.”).

9. Cf. U.S. Patent No. D651,205 (issued Dec. 27, 2011). It appears that commercial embodiment of this design is sold under the brand name KNUCKLECASE. See *The Original Knucklecase for iPhone 5 & 5s*, KNUCKLECASE, <http://www.knucklecase.com/products/original-knucklecase-iphone5-silver> (last visited Dec. 21, 2015). See also *iPhone Knuckleduster Made Popular by Rihanna Is Banned by eBay in Case It Is Used as a Weapon*, DAILY MAIL (Feb. 28, 2013, 4:46 PM), <http://www.dailymail.co.uk/news/article-2286189/iPhone-knuckleduster-popular-Rihanna-banned-eBay-case-used-weapon.html>.

10. See *infra* Sections II.B.3, IV.B.2.

Apple v. Samsung, design patents are more popular than they've been at any time in recent history.¹¹ So even though litigants have not brought these types of claims frequently in the past, that could—and likely will—change.¹² Finally, there is a recent trend in European design law toward protection of designs *per se*.¹³ And arguments about intellectual property (“IP”) policy tend to waft their way across the Atlantic as litigants urge U.S. courts to follow European decisions and reasoning.

This Article argues that the patented design should be conceptualized as the design as applied to a specific type of product, not as a design *per se*. This conclusion is supported by the nature of product design and important policy goals. This analysis is not limited to the precise nature or principles of the U.S. patent system and, therefore, may have implications for the larger policy debate over how designs should be protected—if at all—using IP laws. In particular, it suggests that IP regimes that grant *per se* rights may be particularly ill-suited to this particular subject matter.

This Article proceeds in four parts. Part I provides a brief background to design patents. Part II examines the relevant statutory provisions, cases, and rules. It concludes that there is no clear answer to the question of what, exactly, is “the patented

11. See Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. (forthcoming 2016) (manuscript at 5), <http://ssrn.com/abstract=2627065> [hereinafter Burstein, *Costly Designs*] (discussing Amended Verdict Form at 15, *Apple, Inc. v. Samsung Elecs. Co., Ltd.*, No. 5:11-cv-01846 (N.D. Cal. Aug. 24, 2012), ECF 1931 (awarding Apple \$1,049,393,540.00)). This verdict was later reduced by the judge. See Order re: Damages at 26, *Apple*, No. 5:11-cv-01846 (N.D. Cal. Mar. 1, 2013), ECF 2271 (striking \$450,514,650 from the jury's award and granting partial retrial on certain damages issues). It will be further reduced on retrial following remand from the Federal Circuit. See *Apple, Inc. v. Samsung Elecs. Co., Ltd.*, 786 F.3d 983, 1005 (Fed. Cir. 2015) (“We remand for immediate entry of final judgment on all damages awards not predicated on Apple's trade dress claims . . .”).

12. See generally Burstein, *Costly Designs*, *supra* note 11 (manuscript at 35) (predicting an increase in abusive design patent claims); Robert J. Walters, *Is Design Patent Litigation Headed for a Turnaround?*, BNA'S PATENT, TRADEMARK & COPYRIGHT JOURNAL – DAILY EDITION (Feb. 11, 2013) (“Design patents, long an overlooked weapon for enforcing intellectual property rights, have received a large amount of attention in recent months in the wake of Apple Inc.'s effective use of them in litigation against Samsung Electronics Co.”).

13. See Lionel Bently, *Designs Untethered (?)*, THE FUTURE OF DESIGN PROTECTION, (Conference Proceedings, Nov. 3, 2012) (presentation available at <http://www.civil.law.cam.ac.uk/activities/DesignsUntethered.pdf>). See also Peter Arrowsmith, *The Relevance of the Product in the Scope of Registered Designs*, 8 J. INTEL. PROP. L. & PRAC. 876, 876 (2013) (arguing that “the actual product produced by the applicant should not be relevant in determining scope of protection”).

design.” Part III argues that the patented design should be conceptualized as the design as applied to a specific type of product and considers some potential objections to that argument. Part IV considers the implications of this argument for several areas of design patent law and for larger issues of design law and policy.

I. BACKGROUND

A. *Design*

To determine what constitutes “the protected design,” we must first determine what we mean by “design.” The word “design” is mercurial; it has multiple meanings that have ebbed and flowed over time.¹⁴ It is “derived from the Italian *disegno* and the French *dessin*, both meaning ‘a drawing.’”¹⁵ But in contemporary usage, it “is a verb as well as a noun; the word can refer to a process as well as an object.”¹⁶ It also “occurs in many contexts: a design, graphic design, fashion design, interior design, engineering design, architectural

14. See Victor Margolin, *Design History or Design Studies: Subject Matter and Methods*, in THE DESIGN HISTORY READER 287 (Grace Lees-Maffei & Rebecca Houze eds., 2010) (“[D]esign’ does not signify a class of objects that can be pinned down like butterflies. Designing is an activity that is constantly changing.”). See also Sarah Burstein, *Moving Beyond the Standard Criticisms of Design Patents*, 17 STAN. TECH. L. REV. 305, 308–09 (2013) [hereinafter Burstein, *Standard Criticisms*] (“[T]he variable meaning of the word ‘design’ . . . can be illustrated by a seemingly nonsensical sentence: ‘Design means designers design designs by means of designs.’” (quoting John Heskett, *Industrial Design*, in DESIGN HISTORY: A STUDENTS’ HANDBOOK 112 (Hazel Conway ed., 1987))); Scott Stropkay, *What Is Industrial Design? A Primer for Beginners*, IDSA (July 6, 2011, 1:32 PM), <http://www-old.idsa.org/what-industrial-design-primer-beginners> (“The first thing to know about design is that it’s a huge category with lots of definitions.”).

15. Penny Sparke, *Design*, in THE GROVE ENCYCLOPEDIA OF AMERICAN ART 57 (Joan Marter ed., 2011).

16. Grace Lees-Maffei, *Introduction [to Section 8]*, in THE DESIGN HISTORY READER, *supra* note 14, at 303. See also ADRIAN FORTY, OBJECTS OF DESIRE: DESIGN AND SOCIETY SINCE 1750 6–7 (1986) (“In everyday speech, the word [‘design’] has two common meanings when applied to artefacts. In one sense it refers to the look of things The second, more exact use of the word ‘design’ refers to the preparation of instructions for the production of manufactured goods, and this is the sense meant when, for example, someone says ‘I am working on the design of a car.’ It might be tempting to separate the two meanings and deal with them independently, but this would be a great mistake, for the special quality of the word ‘design’ is that it conveys both senses, and their conjunction in a single word rightly expresses the fact that they are inseparable: the way things look is, in the broadest sense, a result of the conditions of their making.”).

design, industrial design, product design, corporate design, design methods.”¹⁷ Moreover, “histories and theories of design are . . . exceptionally diverse, representing a wide range of beliefs about what design is, how it should be practiced, and for what purpose.”¹⁸

While the word “design” is used to describe a wide range of artifacts and activities,¹⁹ “[i]t is not immediately obvious that a common essence underlies all these different usages.”²⁰ Indeed, it appears that the category of things we now describe as “design” was delineated mostly as an accident of history. Paul Greenhalgh traces the evolution of the category “decorative arts” to “design” by noting that, in the nineteenth century:

The decorative arts steadily congealed into a *salon de refuse* of genres that cohered only by virtue of their exclusion [from the category of fine arts]. Outside the fine arts, there was no fixed nomenclature or hierarchy. Various—and interchangeably—known as the decorative, useful, industrial, applied or ornamental arts, they struggled to maintain a place in intellectual life²¹

17. John A. Walker, *Design History and the History of Design*, in THE DESIGN HISTORY READER, *supra* note 14, at 280. See also Stropkay, *supra* note 14, (noting that “design” includes industrial design, fashion design, textile design, graphic design, landscape architecture, architecture, service design, and user experience design).

18. Richard Buchanan, *Rhetoric, Humanism, and Design*, in DISCOVERING DESIGN: EXPLORATIONS IN DESIGN STUDIES 23 (Richard Buchanan & Victor Margolin eds., 1995); see also *id.* at 24 (“Similarly, designers and design theorists present a seemingly endless array of special procedures and maxims required for what they believe to be effective designing. And . . . design critics, as well as historians, designers, and theorists, offer a great variety of incompatible, if not contradictory, principles and slogans to explain what designer should and should not seek to accomplish through their work.”).

19. See, e.g., Walker, *supra* note 17, at 280 (noting that the word “can refer to a process (the act or practice of designing); or to the result of that process (a design, sketch, plan or model); or to the products manufactured with the aid of a design (designed goods); or to the look or overall pattern of a product (“I like the design of that dress”)”).

20. *Id.*

21. Paul Greenhalgh, *The History of Craft*, in THE DESIGN HISTORY READER, *supra* note 14, at 329; *id.* (explaining that during the Enlightenment, under the auspices of the Academies, “the system of the five fine arts, of painting, sculpture, architecture, music and poetry, was formulated and brought to maturity”). It appears that Greenhalgh is alluding to the *Salon des Refusés*, an exhibition of paintings that had been rejected (*refusé*) by the judges of the official 1863 Paris Salon. See generally GARY TINTEROW & HENRI LOYRETTE, ORIGINS OF IMPRESSIONISM xi (1994)

In the latter part of the nineteenth century, a division occurred between the practice of “craft” and “the world of large-scale manufacturing.”²² The latter came to be referred to as “design.”²³

The idea of “a designer as a professional who saw an entire process of manufacture through from drawing-board to finished artefact” did not develop until the twentieth century.²⁴ By 1987, designers had become strongly “associated with mass production, or at least highly-mechanized production.”²⁵ So on its own, the word “design” could cover anything from designs *per se* to particular designs for particular products.

Debates about IP protection for “designs” in the United States, however, tend to focus on a particular subset of designs—namely, designs for the configurations of “useful articles,” as that term is defined in the Copyright Act:²⁶

A “useful article” is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a “useful article.”²⁷

Designs for the configurations of useful articles unquestionably qualify as design patent subject matter.²⁸ They do not, however, usually qualify for cheap, easy-to-obtain copyright protection.²⁹

(discussing the *Salon des Refusés*).

22. Greenhalgh, *supra* note 21, at 333.

23. *Id.*

24. *Id.*

25. *Id.* See also Sparke, *supra* note 15, at 57 (“[F]rom the 20th century, it has been used in a wider sense to describe the aesthetic and functional characteristics of an object. It has become increasingly identified with product design for industry and mass production and is seen as an essential part of the process of making, marketing and selling mass-produced goods.”).

26. Burstein, *Standard Criticisms*, *supra* note 14, at 312.

27. 17 U.S.C. § 101 (2012).

28. See 35 U.S.C. § 171(a) (Supp. I 2013); *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980) (stating Section 171 covers “ornamental designs of all kinds including surface ornamentation as well as configuration of goods”).

29. Burstein, *Standard Criticisms*, *supra* note 14, at 312. This is due to the Copyright Act’s separability requirement. See Sarah Burstein, *Not (Necessarily) Narrower: Rethinking the Relative Scope of Copyright Protection for Designs*, 3 IP THEORY 114, 115 (2013) (“Most designs qualify as ‘useful articles’ under the Copyright Act and, thus, are protected ‘if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” (citing 17 U.S.C. § 101) (footnote omitted)).

Therefore, this subset of designs lies at the heart of “design protection” debates in the United States.³⁰ Accordingly, this Article will focus mainly on designs for the configurations of useful articles.³¹

This subset of designs generally corresponds to the category of “industrial design.”³² “Industrial design,” like “design,” is a term whose meaning has shifted over time. In the early twentieth century, it was a popular buzzword, “[b]ut nobody knew just exactly what industrial design meant. Among industrial designers there had been not too few but too many prophets.”³³

In 1940, designer Harold Van Doren wrote *Industrial Design: A Practical Guide*, which “was probably the first textbook on industrial design.”³⁴ Van Doren defined “industrial design” rather narrowly, writing that “[i]ndustrial design is concerned with three-dimensional products or machines, made only by modern production methods as distinguished from traditional handcraft methods.”³⁵ According to Van Doren, “[t]he job of an industrial designer is to interpret the function of useful things in terms of appeal to the eye; to endow

30. Burstein, *Standard Criticisms*, *supra* note 14, at 312.

31. Therefore, unless otherwise noted or used in a quotation, the word “design” will be used for the rest of this Article to refer to a design for the configuration of all or part of anything that qualifies as a “useful article” under the Copyright Act.

32. It would however, also include fashion design.

33. *Both Fish and Fowl*, FORTUNE MAGAZINE 40 (Feb. 1934). This article first appeared without an author listed; however, it has since been attributed to George Nelson. See, e.g., George Nelson, FIDSA, IDSA, <http://www.idsa.org/george-nelson-fidsa> (last visited Dec. 22, 2015) (“Nelson became assistant editor of *Architectural Forum* in 1933, and in 1934 wrote an anonymous February article in *Fortune magazine* [sic], ‘Both Fish and Fowl,’ that had a dramatic impact on the new field of Industrial Design.”).

34. Carma Gorman, *Preface to HAROLD VAN DOREN, “The Designer’s Place in Industry,” in THE INDUSTRIAL DESIGN READER 142* (Carma Gorman ed., 2003) (referring to HAROLD VAN DOREN, *INDUSTRIAL DESIGN: A PRACTICAL GUIDE* (1940) [hereinafter VAN DOREN]).

35. VAN DOREN, *supra* note 34, at 3 (italics omitted). Van Doren specifically distinguished the design of textiles and wallpaper from his definition of industrial design. *Id.* at 5 (“The designer of textiles or wallpaper will likewise find little to interest him here. His is a one-man job, his design problems are two-dimensional. The industrial stylist, on the other hand, can accomplish nothing without the close collaboration of experimental men, engineers, and production specialists, and his design problems are almost exclusively three-dimensional.”). See also *id.* xvii (referring to the enterprise of “industrial design” as “designing merchandise for appearance” (emphasis added)).

them with beauty of form and color; above all to create in the consumer the desire to possess.”³⁶

Over time, however, the definition of “industrial design” has broadened significantly.³⁷ In the 1970s, the Industrial Designers Society of America (“IDSA”) defined it as “the professional service of creating products and systems that optimize function, value and appearance for the mutual benefit of both user and manufacturer,” a definition the organization uses to this day.³⁸

Even though the definition of “design” is fluid and the definition of “industrial design” is ever-changing, it is still possible to identify some constant themes. Design has always, fundamentally, been about blending form and function. And it has always been a product-focused activity.³⁹ Drawing a beautiful picture or sculpting an

36. *Id.* at xvii. See also *How has industrial design changed over the past 50 years?*, BEYOND DESIGN (Mar. 10, 2014), <http://www.beyonddesignchicago.com/industrial-design-changed-past-50-years/> (copy of post on file with the author) (“Fifty years ago, industrial design consisted of designers sitting at a desk and sketching with a paper and pencil. It was solely about making things more beautiful by improving the aesthetics, ergonomics, and functionality of a product.”).

37. See, e.g., DESIGN DICTIONARY: PERSPECTIVES ON DESIGN TERMINOLOGY 212 (Michael Erlhoff & Tim Marshall eds., Laura Bruce & Steven Lindberg trans., 2008) (“[I]ndustrial design may encompass a broad range of design activities, including decoration, engineering, material selection, and ergonomics”).

38. CARROLL GANTZ, THE INDUSTRIALIZATION OF DESIGN: A HISTORY FROM THE STEAM AGE TO TODAY 242 (2011) (quoting this language and noting that the “revised comprehensive definition of industrial design developed by IDSA in 1978 . . . is still in use today”); *What Is Industrial Design?*, IDSA, <http://www.idsa.org/education/what-is-industrial-design> (last visited Dec. 22, 2015).

39. See, e.g., GANTZ, *supra* note 38, at 1 (defining “industrial design” as “the external design of *products of mass production* to make them more attractive, useful, and appropriate to human sensitivities” (emphasis added)); VAN DOREN, *supra* note 34, at 3 (“[T]he designer’s chief task is to make useful things more useful still. Beauty as such, instead of being his primary concern, is rather the end product of a blending of texture, shape, and color with *the particular function the machine performs.*” (emphasis added)); BUREAU OF LABOR STATISTICS, U.S. DEPT OF LABOR, *Industrial Designers, OCCUPATIONAL OUTLOOK HANDBOOK*, (Jan. 8, 2014) <http://www.bls.gov/ooh/arts-and-design/industrial-designers.htm> (“Industrial designers develop the concepts for manufactured *products*, such as cars, home appliances, and toys. . . . Industrial designers focus on the user experience in creating style and function for a *particular gadget or appliance.*” (emphasis added)); *Industrial Designers Society of America (IDSA) Fact Sheet*, IDSA, <http://www.idsa.org/sites/default/files/IDSAFactSheet2013.pdf> (last visited Dec. 22, 2015) (“The industrial designer’s unique contribution places emphasis on those aspects of *the product or system* that relate most directly to human characteristics, needs and interests.” (emphasis added)); Stropkay, *supra* note 14 (stating that the design process starts when designers “[h]elp define the problem they are solving by

attractive shape without any application in mind is an act of art, not an act of design. As previous commentators have noted:

[T]he application of the design to the underlying article is an inextricable part of the value that [industrial] designers provide. ‘Designing’ products necessarily involves working within the particular degree of freedom for each product, because not every old design feature can work with and look good in a new product.⁴⁰

One designer has even gone so far as to say that “[t]he idea of designing industrially without having the marketplace in mind would be both unethical and/or ineffective.”⁴¹

B. Design Patents

1. Requirements for Design Patentability

The Patent Act states that “[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”⁴² And “[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”⁴³ A patentable design must therefore satisfy the general requirements for patentability, such as novelty and nonobviousness,⁴⁴ and also be “ornamental”⁴⁵ and “original.”⁴⁶ Like

researching and learning about the people who use *the product or service*, their needs and goals” (emphasis added). See also Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 914 (1988) (“Industrial designs are product-specific. That is, each design is generally prepared for a single product and no other.”).

40. Janice M. Mueller & Daniel Harris Brean, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 481 (2011).

41. RAYMOND LOEWY, *INDUSTRIAL DESIGN* 8 (1979).

42. 35 U.S.C. § 171(a) (Supp. I 2013).

43. *Id.* § 171(b).

44. See 35 U.S.C. §§ 102–103; see also 35 U.S.C. § 171 (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”); Sarah Burstein, *Visual Invention*, 16 LEWIS & CLARK L. REV. 169, 175 (2012) [hereinafter Burstein, *Visual Invention*] (discussing the requirement of novelty in the context of design patents).

45. 35 U.S.C. § 171. The Federal Circuit, however, has seriously eroded this requirement. See Burstein, *Costly Designs*, *supra* note 11 (manuscript at 44–46).

46. 35 U.S.C. § 171. While there is no binding case law defining what it means for a design to be “original,” the Federal Circuit has suggested in *dicta* that while

other patents, a design patent must be substantively examined by the U.S. Patent and Trademark Office (“PTO”).⁴⁷ Once issued, a design patent lasts for 14–15 years.⁴⁸

2. Design Patent Claims

Design patents can be directed to “at least three kinds of designs,” namely: (1) “a design for an ornament, impression, print, or picture applied to or embodied in an article of manufacture (surface indicia);” (2) “a design for the shape or configuration of an article of manufacture”; or (3) “a combination of the first two categories.”⁴⁹ In other words, a patentable design may consist of two-dimensional

“[t]he purpose of incorporating an originality requirement is unclear[,] it likely was designed to incorporate the copyright concept of originality—requiring that the work be original with the author” *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009) (citing 1–2 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.01 (2005)).

47. 35 U.S.C. § 131 (“The Director [of the PTO] shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.”).

48. Design patents that mature from applications filed on or after May 13, 2015 have a term of fifteen years; design patents that matured from applications filed prior to that date have a term of 14 years. See Patent Law Treaties Implementation Act of 2012 (“PLTIA”), Pub. L. No. 112-211, § 102(7), 126 Stat. 1527 (2012) (amending 35 U.S.C. § 173 “by striking ‘fourteen years’ and inserting ‘15 years’”); PLTIA § 103(a) (“The amendments made by this title shall take effect on the later of—(1) the date that is 1 year after the date of the enactment of this Act; or (2) the date of entry into force of the treaty with respect to the United States.”); PLTIA § 381(a)(1) (“[T]he term ‘treaty’ means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999”). The United States ratified the Geneva Act on February 13, 2015. See *United States of America, Japan Join International Design System*, WIPO (Feb. 13, 2015), http://www.wipo.int/pressroom/en/articles/2015/article_0001.html. Therefore, the Geneva Act went into effect for the United States on May 13, 2015. See THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS: GENEVA ACT OF JULY 2, 1999, Art. 28(3)(b), http://www.wipo.int/treaties/en/text.jsp?file_id=285214 (last visited Dec. 22, 2015).

49. U.S. PATENT & TRADEMARK OFFICE, *MANUAL OF PATENT EXAMINING PROCEDURE* § 1504.01 (9th ed., Rev. 07.2015, Nov. 2015) [hereinafter “MPEP”], available at <http://www.uspto.gov/web/offices/pac/mpep/> (citing *In re Schnell*, 46 F.2d 203 (C.C.P.A. 1931); *Ex parte Donaldson*, No. 92-0456, 26 U.S.P.Q.2d 1250, 1258 (B.P.A.I. 1992)). See also *In re Zahn*, 617 F.2d 261, 267 (C.C.P.A. 1980) (“[A] design for an article of manufacture may be embodied in less than all of an article of manufacture”).

decoration, three-dimensional configuration, or a combination of both.⁵⁰

Unlike a utility patent, a design patent can have only one claim.⁵¹ That claim must state “in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.”⁵² A design is “shown” using drawings or photographs.⁵³ The claimed design must be shown in solid lines.⁵⁴ Broken or dotted lines may be used to indicate unclaimed portions of a design to “disclose the environment related to the claimed design” and “to define the bounds of a claimed design . . . when the boundary does not exist in reality.”⁵⁵

3. Design Patent Infringement

The general patent infringement provision, 35 U.S.C. § 271, applies to design patents.⁵⁶ Section 271(a) provides that, “[e]xcept as otherwise provided in this title, whoever without authority makes,

50. *See id.*

51. 37 C.F.R. § 1.153(a) (2015). That claim may, however, have more than one embodiment if those embodiments “involve a single inventive concept according to the obviousness-type double patenting practice for designs.” MPEP, *supra* note 49, § 1504.05 (citing *In re* Rubinfeld, 270 F.2d 391, 394 (C.C.P.A. 1959)). If an application “contains more than one patentably distinct design,” the examiner will issue a mandatory restriction requirement. *Id.*

52. 37 C.F.R. § 1.153(a).

53. MPEP, *supra* note 49, § 1503.02. “No description, other than a reference to the drawing, is ordinarily required.” *Id.* § 1503.01 (quoting 37 C.F.R. § 1.153). The PTO does, however, allow—and in some cases require—applicants to include certain additional verbal descriptions to help clarify the drawings. *See, e.g., id.* § 1503.02(III) (“Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”); *see also id.* (“A statement similar to the following shall be used to describe the broken lines on the drawing . . . The broken line showing of [1] is for the purpose of illustrating [2] and forms no part of the claimed design.”).

54. *Id.* § 1503.02(III) (“The ornamental design which is being claimed must be shown in solid lines in the drawing.”).

55. *Id.* For more on the PTO’s rules for design patent drawings, *see* Sarah Burstein, *Applying for Design Protection*, in RESEARCH HANDBOOK ON DESIGN LAW (Henning Hartwig ed.) (forthcoming) (manuscript on file with the author).

56. *See* 35 U.S.C. § 171(b) (Supp. I 2013) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”); CHISUM ON PATENTS, *supra* note 7, § 23.05 (“The general provisions of the Patent Act relating to infringement, including Section 271 on direct and contributory infringement, apply to design patents.”).

uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”⁵⁷ But while a utility patent is infringed by making, using, selling, offering to sell, or importing a patented “process, machine, manufacture, or composition of matter, or . . . improvement thereof,”⁵⁸ a design patent is infringed by making, using, selling, offering to sell, or importing the patented design.⁵⁹

To prevail on a claim for design patent 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.”⁶⁰ The ordinary observer is a hypothetical person, like the “reasonable person” in tort law.⁶¹

Although the ordinary observer is deemed to be familiar with the prior art, that does not mean the court (or jury) must always consider it.⁶² As the U.S. Court of Appeals for the Federal Circuit, which has exclusive appellate jurisdiction over design patent cases,⁶³ has explained:

57. 35 U.S.C. § 271(a) (2012).

58. *See id.* § 101 (setting forth the categories of utility patent subject matter).

59. *See id.* § 271(a); *see also id.* § 171(b) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

60. *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010) (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 681 (Fed. Cir. 2008) (en banc)). This “ordinary observer” test can be traced back to the 1871 Supreme Court case *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871); *see infra* Section II.B.1. There is no separate test for infringement by equivalents; this “test by its nature subsumes a doctrine of equivalents analysis.” *Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, 93 F. App’x. 214, 217 (Fed. Cir. 2004) (citing *Lee v. Dayton–Hudson Corp.*, 838 F.2d 1186, 1189–90 (Fed. Cir. 1988)).

61. *See generally Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1321 (Fed. Cir. 2007), *overruled on other grounds by Egyptian Goddess*, 543 F.3d at 671 (“This test requires an objective evaluation of the question of whether a hypothetical person called the ‘ordinary observer’ would find substantial similarities between the patented design and the accused design, so as to be deceived into purchasing the accused design believing it is the patented design.” (citing *Gorham*, 81 U.S. (14 Wall.) at 528)).

62. *See Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1337 (Fed. Cir. 2015) (“[C]omparing the claimed and accused designs with the prior art is beneficial only when the claimed and accused designs are not plainly dissimilar.” (citing *Egyptian Goddess*, 543 F.3d at 678)).

63. *See* 28 U.S.C. § 1295(a) (2012).

In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear ‘substantially the same’ to the ordinary observer, as required by *Gorham*. In other instances, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art⁶⁴

Therefore, the prior art may be used in some circumstances to narrow a design patent’s scope. But if the claimed design and accused product appear to be “plainly dissimilar,” then the prior art may not be used to broaden the claim.⁶⁵

II. AN OPEN QUESTION—WHAT IS THE PATENTED DESIGN?

An examination of the relevant statutory language, cases, and PTO decisions reveals that there is not yet a clear answer as to what, precisely, design patents protect. All of these sources of authority will be discussed in detail below.

A. *The Statute*

Congress has authorized the PTO to issue design patents to those who invent “any new, original and ornamental design for an article of manufacture.”⁶⁶ But Congress has not defined the word “design.” And, as discussed above, the word “design” is a fluid term that has been used to describe a wide range of objects and activities.⁶⁷ So Congress’ use of the word “design” does not, in and of itself, provide helpful guidance as to what, precisely, Congress wanted to protect.⁶⁸

64. *Egyptian Goddess*, 543 F.3d at 678.

65. See *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1337 (Fed. Cir. 2015) (rejecting Ethicon’s attempt to, in effect, broaden the scope of its claims using the prior art).

66. 35 U.S.C. § 171(a) (Supp. I 2013).

67. See *supra* Section I.A.

68. It could be argued that Congress meant to capture this fluidity and protect anything that might be deemed to constitute “design” in the future. However, that does not appear to be the case, mainly because Congress included the term “design” in the larger phrase “design for an article of manufacture.” And I have not seen any evidence indicating that Congress was aware of the history of the word “design” when it was added to the statute.

Section 171 does specify that the patented design must be a “design for an article of manufacture.”⁶⁹ This suggests that the patented design must be applied to—or, at least, be capable of being applied to—an “article of manufacture.” This language could, theoretically, support a wide spectrum of concepts—anything from a design *per se* to a very narrow conception of the patented design as protecting only the design as embodied in the particular product sold by the patentee. So the language of the statute provides little help in determining what Congress meant to protect.

B. Cases

The case law, like the statute, does not provide a clear answer about what the patented design might be. Nor does it definitively answer our questions about visual representations or the use of similar appearances on different products.⁷⁰ There is little relevant case law, probably because “[i]n virtually all the reported cases, the accused article is of the same nature as the patented one.”⁷¹ Nonetheless, this section will examine the relevant case law and explain why it does not definitively answer our questions.

1. The Fountainhead: *Gorham v. White*

Although it was decided over 100 years ago, *Gorham v. White*⁷² is still a leading design patent case.⁷³ The few district courts that have dealt with questions of design patents involving images of products and the use of designs on different products have relied heavily on *Gorham*—and, specifically, on its formulation of the infringement test—in their analyses.

In *Gorham*, the plaintiff alleged infringement of a design patent for “a new design for the handles of tablespoons and forks.”⁷⁴ Justice Strong described the issue before the Court as follows: “The sole

69. 35 U.S.C. § 171(a) (Supp. I 2013) (emphasis added).

70. Cf. CHISUM ON PATENTS, *supra* note 7, § 23.05[2] (“Whether a patent on the design on a certain article of manufacture is infringed by use of the identical design on a different article is a long-standing problem that has never been satisfactorily resolved.” (citing SYMONS, *supra* note 4, at 70–71)).

71. *Id.*

72. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871).

73. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (“The starting point for any discussion of the law of design patents is the Supreme Court’s decision in *Gorham Co. v. White*.”). The U.S. Supreme Court has not considered an issue of substantive design patent law for over 100 years.

74. 81 U.S. (14 Wall.) at 512.

question is one of fact. Has there been an infringement?"⁷⁵ At the time, the statute provided the owner of a patented design with "an exclusive property or right . . . to make, use, and sell, and vend the same [design] or copies of the same to others, by them to be made, used, and sold."⁷⁶ In determining the proper test for infringement, the Court therefore focused on whether the accused design was "the same" as the patented one.⁷⁷ The Court held that:

[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.⁷⁸

Read in isolation, this language suggests that design patents are product-specific, because who would be deceived into buying one product when they meant to buy a totally different type of product? However, when read in context, it is clear that *Gorham's* test is one of visual similarity, not a test of actual deception or trademark-like likelihood of confusion.⁷⁹ Indeed, that is how it has been read and interpreted by the Federal Circuit.⁸⁰

75. *Id.* at 524.

76. *See id.* at 511–12 (quoting Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 (1842)); *id.* at 512 (noting that "[a] subsequent act, that of March 2d, 1861, re-enacts in substance the same things apparently, and makes some changes in the term of duration of the patent" (referring to Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861))).

77. *See, e.g., id.* at 524 ("The sole question [in this case] is one of fact. Has there been an infringement? Are the designs used by the defendant *substantially the same* as that owned by the complainants?" (emphasis added)).

78. *Id.* at 528 (emphasis added).

79. *See id.* at 524 ("The sole question [in this case] is one of fact. Has there been an infringement? Are the designs used by the defendant *substantially the same* as that owned by the complainants?" (emphasis added)); *id.* at 526 ("We are now prepared to inquire what is the true test of identity of design. Plainly, it must be *sameness of appearance . . .*" (emphasis added)); *id.* at 527 (concluding that "identity of appearance, or . . . sameness of effect upon the eye, is the main test of substantial identity of design . . ."); *id.* at 529 ("Comparing the figure or outline of the plaintiffs' design with that of the White design of 1867, it is apparent there is no substantial difference."); *id.* at 531 ("[W]hatever differences there may be between the plaintiffs' design and those of the defendant in details of ornament, they are still the *same in general appearance and effect*, so much alike that in the market and with purchasers they would pass for the same thing—so much alike that even persons in the trade would be in danger of being deceived." (emphasis added)).

80. *See Unette Corp. v. Unit Pack Co., Inc.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986) ("Likelihood of confusion as to the source of the goods is not a necessary or

To the extent that the *Gorham* test focuses on whether “two designs are substantially the same,”⁸¹ the larger question still remains—i.e., what is the relevant “design”? In *Gorham* itself, it did not matter whether the protected design was a design *per se* or as applied because plaintiff and defendant both made, and used the disputed design on, the same products—forks and spoons.⁸² The issue of product-specificity was not before the Supreme Court. Moreover, *Gorham* was interpreting and applying different statutory language on the issue of infringement.⁸³ Therefore, *Gorham* alone does not provide a satisfying answer about what, exactly, is “the patented design.”

But *Gorham* supplies some clues. In addition to its holding on the proper test for infringement, the Supreme Court stated that:

The acts of Congress which authorize the grant of patents for designs . . . contemplate not so much utility as appearance, and that, *not an abstract impression, or picture, but an aspect given to those objects mentioned in the acts. . .* The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is *the new thing, or product*, which the patent law regards.⁸⁴

This strongly suggests that, at least in the view of the *Gorham* Court, design patents do not protect designs *per se*. It also suggests that patented designs are, in fact, product-specific. However, the Court appears to have made this statement in response to the lower

appropriate factor for determining infringement of a design patent.”). See also Matthew A. Smith, Design Patents 29 (Dec. 17, 2012) (unpublished manuscript), available at /media/docs/2012/12/2012-12-17_design_patents.pdf (“[A]lthough the term ‘deception’ is still used [in the context of design patent infringement], the test has been clarified to focus on a comparison of the patented design and claimed design, regardless of other product features that may remove a trademark-esque likelihood of confusion.”).

81. *Gorham*, 81 U.S. at 528.

82. See *id.* at 512 (“*Gorham & Co.*, in July, 1861, obtained a patent for a new design for the handles of tablespoons and forks In the year 1867 one White obtained a patent for a design which he alleged to be original with him for the same things; the handles, namely, of forks and spoons.” (emphasis omitted)).

83. Compare Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861) (defining infringement then), with 35 U.S.C. § 271 (2012) (defining infringement today).

84. *Gorham*, 81 U.S. at 524–25 (emphasis added). See also *id.* at 525 (“[T]he acts of Congress embrace only *designs applied, or to be applied*, they must refer to finished products of invention rather than to the process of finishing them, or to the agencies by which they are developed.” (emphasis added)).

court's erroneous conclusion that "[a] patent for a design, like a patent for an improvement in machinery, must be for the means of producing a certain result or appearance, and not for the result or appearance itself."⁸⁵ So while this passage from *Gorham* makes it clear that design patents do not protect processes, it does not clearly and authoritatively answer the questions of how the law should deal with visual representations of patented product designs or with the use of a patented design on an entirely different product.

2. The C.C.P.A. & Federal Circuit Cases

The Federal Circuit has not directly addressed the question of what, exactly, is "the patented design"; however, cases from the Federal Circuit and the Court of Customs and Patent Appeals ("CCPA") provide clues. These cases will be discussed together because the Federal Circuit has adopted the case law of the CCPA as precedent.⁸⁶

a. In re Schnell

Schnell applied for a design patent and submitted drawings showing "an automobile body door handle, composed of two parts—a plate to be fastened to the inside of the door and a movable handle which fits into the plate."⁸⁷ According to the CCPA, "[t]he handle resemble[d] the ordinary door knocker handle in appearance."⁸⁸ In his application, Schnell sought to claim: "The ornamental design for an interior fitting of an automobile body or similar article, substantially as shown."⁸⁹

The examiner and the Board of Appeals of the United States Patent Office rejected the claim for being "too generic and indicat[ing] a wider range of embodiment of the design than the specific article illustrated in the drawing."⁹⁰ The design was otherwise patentable, so the examiner suggested—and the Board

85. *See id.* at 524 (quoting *Gorham Co. v. White*, 10 F. Cas. 827 (C.C.S.D.N.Y. 1870)).

86. *South Corp. v. United States*, 690 F.2d 1368, 1369 (Fed. Cir. 1982) (en banc) ("We hold that the holdings of our predecessor courts, the United States Court of Claims and the United States Court of Customs and Patent Appeals, announced by those courts before the close of business September 30, 1982, shall be binding as precedent in this court.")

87. *In re Schnell*, 46 F.2d 203, 204 (C.C.P.A. 1931).

88. *Id.*

89. *Id.*

90. *Id.*

approved—an alternate title, “automobile door handle or similar article.”⁹¹

Schnell appealed, arguing that he was entitled to the broad scope he had originally claimed.⁹² The CCPA disagreed.⁹³ The court did not categorically rule out the possibility that a single design patent claim could cover multiple articles of manufacture.⁹⁴ The court suggested that if Schnell had designed “an ornament, impression, print, or picture” that “could be appropriately applied to interior fittings of an automobile body other than a door handle,” his proposed claim language might have been acceptable.⁹⁵

The CCPA also rejected the PTO Solicitor’s argument that there was a “uniform practice of the Patent Office for many years” requiring “that design patents must be for a single article of manufacture.”⁹⁶ According to the court:

[N]o such uniform practice in the Patent Office in this respect is shown to have prevailed for a very long period of time. Certainly such rulings have not been sufficiently uniform for such a period of time as to justify this court in refusing to construe the language of the statute, when the question is squarely presented, and presented for the first time to any tribunal other than those of the Patent Office.⁹⁷

And while “[q]uestions quite similar, if not identical with the one at bar, have been frequently ruled upon in the Patent Office,” the CCPA found many of those rulings to be “in direct conflict with others.”⁹⁸

So the court went back to first principles, providing a helpful typology of designs:

[A]n inventor may invent, we will say for the purposes of this case, at least three kinds of designs for articles of

91. *Id.*

92. *Id.* at 210 (“The argument of appellant in this court would indicate that, if he is allowed his claim on the drawing submitted, he will be entitled to such a construction of the same as will protect him on this design when applied to all the interior fittings of an automobile body or similar articles.”).

93. *Id.* at 211.

94. *Id.* at 210.

95. *Id.* at 209–10. *See id.* at 209 (referring to “class 1”); *see also id.* at 209 (defining the “first class” of potentially patentable designs as “a design for an ornament, impression, print, or picture to be applied to an article of manufacture”).

96. *Id.* at 204–05.

97. *Id.* at 205.

98. *Id.* at 204.

manufacture. First, a design for an ornament, impression, print, or picture to be *applied to* an article of manufacture; second, the design for a shape or configuration for an article of manufacture; third, a combination of the first two, that is, a design which consists of the shape or configuration of an article plus additional ornamentation.⁹⁹

According to the CCPA, an applicant claiming a design in the first class "should be permitted to make his claim sufficiently broad to entitle him to the exclusive use of the ornament upon more than one article, if the ornament when applied answers the requirements of the law."¹⁰⁰ And while "the design must be shown not to be the mere invention of a picture,"¹⁰¹ "[t]he mere fact . . . that [the patentee] shows his design for glassware by a drawing of the same upon a saucer only, does not . . . limit the scope of his patent and his protection under it to its use on saucers."¹⁰²

The second class of designs, however, would be "subject to a narrower limitation."¹⁰³ An applicant "would not be entitled to claim the configuration and shape applicable to the handle of a pocketknife and [verbally] disclose that he proposed to apply it to a chair or table."¹⁰⁴ However:

[I]f he discloses that he has invented a design for a pocketknife handle or similar article, and discloses by his drawing the manner of application to a knife handle or other similar article, he has reduced his invention to practice and has defined the scope of the same we think sufficiently. He should not be permitted to disclose by his drawing the application of his configuration design to a pocketknife handle and so word his claim as to make the same applicable to any article of manufacture.¹⁰⁵

Schnell's claim fell into the third class of designs.¹⁰⁶ The court noted that Schnell sought a design patent that would "protect him on this design when applied to all the interior fittings of an

99. *Id.* at 209 (citing WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 206 (1890)).

100. *Id.*

101. *Id.*

102. *Id.*

103. *Id.* at 210.

104. *Id.*

105. *Id.* (emphasis omitted).

106. *Id.*

automobile body or similar articles."¹⁰⁷ However, there was not enough information in the record to support such a claim:

If [Schnell's] design belonged to class 1 and could be appropriately applied to interior fittings of an automobile body other than a door handle, and otherwise met the requirements of the law, he should be permitted to so word his claim as to bring this fact out, but we are not prepared to say that appellant's design, being in part the configuration of a door handle, can be applied to any other interior fitting. It may be that it can. We feel sure that the combined design of configuration and ornamentation of appellant's disclosure would not apply to a great many articles embraced in the term "interior fittings of an automobile body."¹⁰⁸

Therefore, the court affirmed the Board's rejection of Schnell's claim as, essentially, being overbroad.¹⁰⁹

As previous commentators have noted, *Schnell* "provides helpful insight into what a design really is."¹¹⁰ It recognizes that certain types of surface designs—specifically, an "ornament, impression, print, or picture"—are created with the intention of being applied to multiple related items, such as the glassware example discussed above.¹¹¹ In that case, a design patent need not include drawings of the design as applied to each related article in order to obtain protection for those applications.¹¹² But product configuration designs are different. Under *Schell*, while an applicant could claim a configuration design that would cover multiple articles, such a claim would have to be supported with visual disclosures showing how the configuration would apply to different types of articles.¹¹³

b. *Neo-Art, Inc. v. Hawkeye Distilled Prods. Co.*

This case involved U.S. Patent No. D260,432, entitled "Combined Stand and Container for Storing Liquids."¹¹⁴ The design resembled "a standard I.V. unit" with a short stand:¹¹⁵

107. *Id.*

108. *Id.*

109. *Id.* at 211.

110. *See, e.g.,* Mueller & Brean, *supra* note 40, at 480.

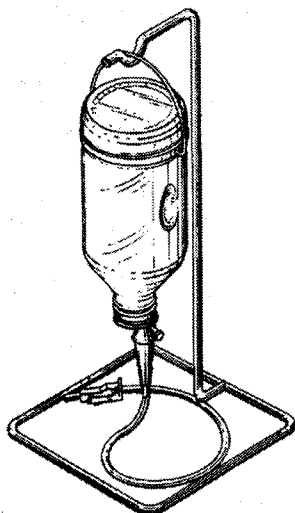
111. *Schnell*, 46 F.2d at 209.

112. *Id.* at 209-10.

113. *See id.* at 210.

114. *Neo-Art, Inc. v. Hawkeye Distilled Prods. Co.*, 12 U.S.P.Q. 1572, 1573 (Fed. Cir. 1989); U.S. Patent No. D260,432 (issued Aug. 25, 1981).

115. *Neo-Art*, 12 U.S.P.Q. at 1574.



The plaintiff sold a commercial embodiment of the design as a vodka dispenser.¹¹⁶ The district court granted summary judgment that the design was invalid as obvious, in light of “the combination of references disclosing a standard I.V. unit and a conventional table top stand.”¹¹⁷

The Federal Circuit affirmed in an unpublished opinion.¹¹⁸ The court stated, in relevant part, that:

Neo-Art’s contention that there is no “prior art” because Neo-Art was the first to promote an I.V. bottle as a novelty liquor dispenser is without merit. The design of the dispenser is not affected by the particular use for which the claimed design has been commercially promoted and does not change the relevance of prior art designs. Neo-Art’s arguments on secondary considerations are similarly unpersuasive. For example, Neo-Art has failed to prove a nexus between its commercial success and the claimed invention. Rather, the commercial success seems to be based upon its novel use, not its design. In sum, that Neo-Art promoted the article made in accordance with the design as a dispenser of vodka or other liquor is irrelevant to the non-obviousness of the design.¹¹⁹

116. *Id.*

117. *Id.*

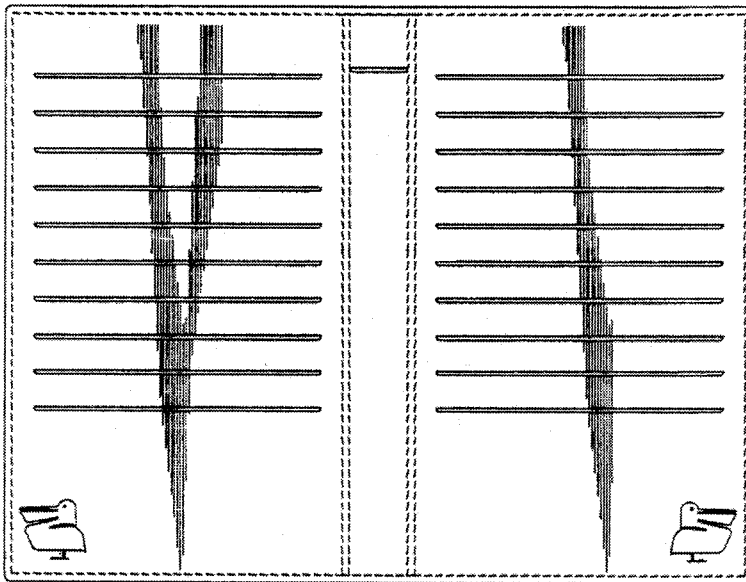
118. *Id.*

119. *Id.* (internal citations omitted).

Although this case was about nonobviousness, not anticipation or the scope of a design patent *per se*, it could be read as indicating that design patents are not product-specific. But the way a product is used is not the same as what the product is. And in this case, the design patent and the prior designs were all directed to the same basic type of product—liquid dispensers. At most, this case indicates that the scope of a design patent should not be limited only to identical sub-types of products—i.e., for products that are advertised, sold, and used for identical purposes.

c. *Blankenship v. Barnett Bank, N.A.*

In *Blankenship*, the plaintiff accused a bank of infringing a design patent for a “Credit Card Wallet”:¹²⁰



The *pro se* plaintiff's only evidence of infringement was “an advertisement in which Barnett Bank offered a home equity line of credit.”¹²¹ The plaintiff attached this image of the accused advertisement to his complaint:¹²²

120. *Blankenship v. Barnett Bank, N.A.*, 232 F.3d 912, 2000 WL369672, at *1 (Fed. Cir. 2000) (unpublished opinion); see U.S. Patent No. D336,780 figs. 1, 7 (issued June 29, 1993).

121. *Blankenship*, 2000 WL 369672, at *1; see also *Blankenship v. Barnett Bank, N.A.*, No. 3:98-cv-00435, 1999 U.S. Dist. LEXIS 21618, at *2 (N.D. Fla. May 14,

Shopping Card \$70/mo. Credit Card \$45/mo. Credit Card \$60/mo.

Shopping Card \$160/mo. Shopping Card \$112/mo.

Gas Card \$50/mo. Credit Card \$45/mo. Credit Card \$30/mo.

**All This Can Cost You \$572 A Month.
Or \$165. Take Your Choice.**

**Home Equity
Line Of Credit**
As low as Prime + 1% A.P.R.

Exactly how much you can save depends on your situation, but you get the idea. Just borrow using the equity in your home, with

no closing costs.* Then pay off all your other loans and credit cards. Save hundreds every month, thousands

over the years. If you own your home, why would you borrow any other way?

Barnett.

Come by or call 1-800-Barnett 24 hours a day, 7 days a week.

Variable APR as of 1/15/99 at Prime plus 1% was 5.50% and is subject to change but not exceed 18%. APR is subject to credit qualifications and is based on loan-to-value of up to 90%. *Required closing costs waived up to \$300 with a minimum initial outstanding balance of \$10,000. Otherwise, estimated closing costs are an average \$36,200 for a \$425,000 property and final amounts may be required. The example is based on \$11,000 outstanding balance on home equity line of credit. Barnett Bank, N.A. is a wholly-owned subsidiary of BancSouthBank Corporation, Equal Housing Lender.

The district court granted the bank's motion to dismiss the design patent claim, stating:

Plaintiff's claim that Defendant's advertisement, depicting a common credit card wallet with fourteen slots and holding eight credit cards, infringes on his design patent is without

1999).

122. Complaint, Blankenship v. Barnett Bank, N.A., No. 3:98-cv-00435 (N.D. Fla. Nov. 4, 1998). Neither the Federal Circuit nor the District Court included images of the advertisement in their opinions.

merit. In this case, Defendant does not manufacture, sell or promote a credit card wallet. The fact that a credit card wallet is pictured in Defendant's advertisement does not constitute patent infringement. Plaintiff does not own an exclusive intellectual property right to credit card wallets.¹²³

The Federal Circuit affirmed the district court in an unpublished opinion.¹²⁴

The district court's opinion could be read as support for the proposition that design patents are product-specific.¹²⁵ However, this does not appear to be a case where the issues were fully and comprehensively fleshed out before the courts.¹²⁶

3. The New District Court Trilogy

In a recent line of cases, three district courts ruled that a design patent was not (or could not be) infringed by the use of a similar appearance on a different product or by a visual representation of the patentee's product. Read together, they strongly suggest that design patents are, in fact, product-specific. But they do not authoritatively answer the question of how to conceptualize the patented design because: (1) as district court decisions, they are not binding authority; and (2) due to their sparse reasoning, they lack significant power as persuasive authority.

a. Vigil v. Walt Disney Co.

In this case, *pro se* plaintiff Mark Vigil alleged that Disney had infringed two of his design patents.¹²⁷ One of the patents-in-suit

123. *Blankenship*, 1999 U.S. Dist. LEXIS 21618, at *3-4.

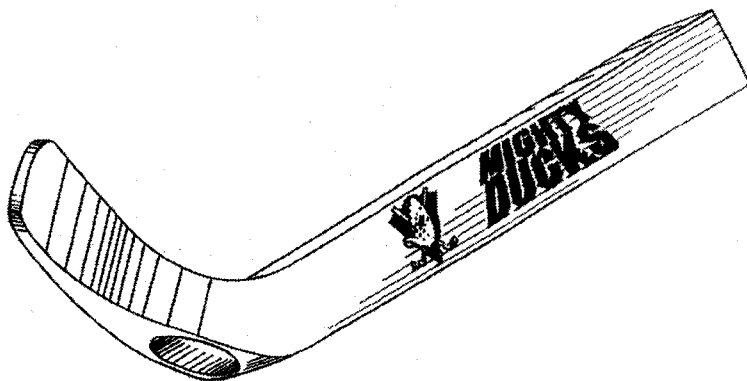
124. *Blankenship*, 2000 WL 369672, at *1.

125. See Brief in Support of Defendants Coca-Cola Co. & Coca-Cola Enterprises, Inc. to Dismiss at 7, *Kellman v. Coca-Cola Co.*, No. 2:03-cv-71542 (E.D. Mich. June 13, 2003), ECF 19 [hereinafter "Coca-Cola Brief"] (citing *Blankenship* for the proposition that mere visual resemblance is "not enough to support a claim of design patent infringement").

126. See, e.g., *Blankenship*, 2000 WL369672, at *1 ("Mr. Blankenship argues that the district court erred by misinterpreting the law and disregarding the evidence. He does not direct us to any such errors, and we discern none."); *id.* (noting that when the district court requested that Blankenship identify the novel parts of his design, he had not responded).

127. *Vigil v. Walt Disney Co.*, No. 3:97-cv-04147, 1998 U.S. Dist. LEXIS 22853, at *5 (N.D. Cal. Dec. 1, 1998) ("Plaintiff argues (1) that his tubular duck call is infringed by Disney's duck call of different ornamental design and (2) that a different hockey shaped duck call is infringed by Disney's hockey stick shaped key chain.").

claimed this design for a “Novelty Duck Call” in the shape of a stylized hockey stick:¹²⁸



Vigil claimed that this design patent was infringed by a Disney key chain.¹²⁹ The court dismissed this claim.¹³⁰ The court’s analysis was, however, disappointingly short and conclusory:

See also Vigil v. Walt Disney Co., 232 F.3d 911, 2000 WL 353148, at *1 (Fed. Cir. Apr. 5, 2000) (unpublished disposition) (identifying the patents-in-suit as U.S. Patent Nos. D381,972 and D395,021).

128. U.S. Patent No. D395,021 fig.7 (issued Jun. 9, 1998). As this illustration shows, the patents include Disney’s “Mighty Ducks” logo as surface decoration. As the court explained:

In 1992, Disney released a movie about a fictional hockey team known as The Mighty Ducks. Defendant subsequently acquired the Anaheim, California franchise of the National Hockey League, and named the team the Mighty Ducks of Anaheim. In conjunction with the words “Mighty Ducks,” defendant began using a logo which depicts a hockey mask shaped like a duck’s bill with two crossed hockey sticks (“logo”).

Vigil, 1998 U.S. Dist. LEXIS 22853, at *1–2. The PTO allows applicants to include other peoples’ trademarks in their design patent claims. MPEP, *supra* note 49, § 1512(IV)(C) (“When a trademark is used in the drawing disclosure of a design application, the specification must include a statement preceding the claim identifying the trademark material forming part of the claimed design and the name of the owner of the registered trademark.”). The PTO “assumes that the proposed use of a trademark is a legal use under federal trademark law.” *Id.* § 1512(IV)(A).

129. *Vigil*, 1998 U.S. Dist. LEXIS 22853, at *5.

130. *Id.* at *12.

Plaintiff's hockey stick duck call is . . . not substantially the same as Disney's hockey stick key chain. Significantly, plaintiff's duck call is not even an analogous article of manufacture when compared with Disney's key chain. The similarity between the two items arises from the fact that both are in the shape of a hockey stick and nothing more. This mere similarity in appearance between plaintiff's hockey stick duck call and Disney's hockey stick key chain is not enough to claim a design patent infringement.¹³¹

Although the court suggested that the accused product looked similar to the patented design, that was not enough.¹³² The court clearly deemed it significant that the title of the design patent referred to a "duck call" and that the accused product was not "an analogous article of manufacture."¹³³ But it did not explain *why* that was significant—or cite any authority in support of that point.¹³⁴

On appeal, the Federal Circuit did not provide any more clarity. It affirmed the dismissal of Vigil's design patent claims in an unpublished opinion, with no analysis or explanation.¹³⁵

b. Kellman v. Coca-Cola Co.

The plaintiffs in this case claimed that they "came up with the brilliant and completely original idea for a product that would symbolize the passionate devotion of the [Detroit] Red Wings' fan base," namely, "a novelty foam hat in the shape of a wing nut, which fans of the team could wear to show that they were literally 'nuts'

131. *Id.* at *9 (citing *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984)). Unfortunately, the court did not include any illustrations of the accused products in its opinion.

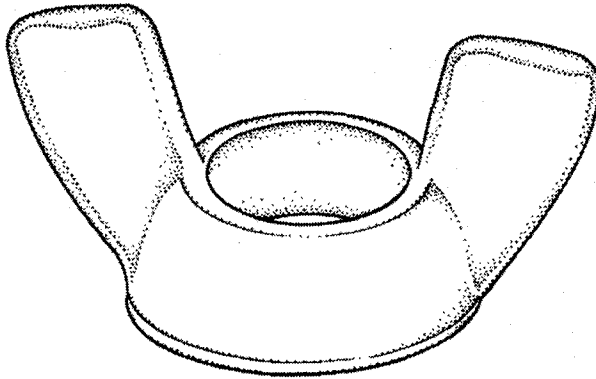
132. *Id.*

133. *Id.* ("Significantly, plaintiff's duck call is not even an analogous article of manufacture when compared with Disney's key chain.")

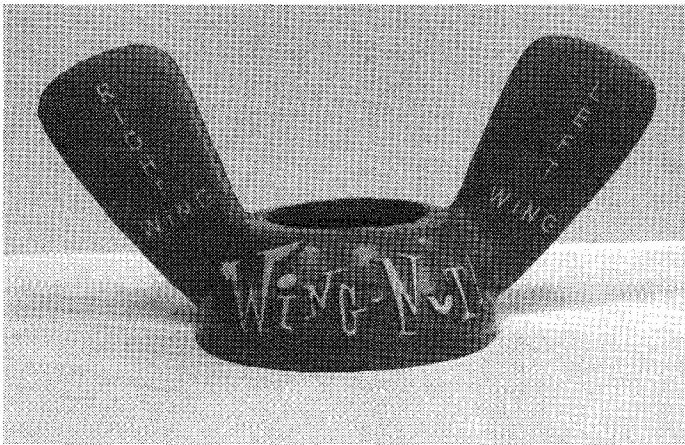
134. *See id.* The court also summarily stated that "Disney's key chain does not appropriate any novelty of plaintiff's duck call." *Id.* This appears to be alluding to the now-defunct "point of novelty" test. *See generally* CHISUM ON PATENTS, *supra* note 7, § 23.05[3][c] ("Soon after its creation in 1982, the Federal Circuit embraced a 'point of novelty' requirement. In *Litton Sys., Inc. v. Whirlpool Corp.* (1984), it held that the requisite similarity between a claimed design and an accused design must be such as would be apparent to an ordinary observer and also must reside in the novel aspects of the claimed design." (footnote omitted)). In 2008, the court held "that the 'point of novelty' test should no longer be used in the analysis of a claim of design patent infringement." *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc).

135. *Vigil v. Walt Disney Co.*, 232 F.3d 911, 2000 WL 353148, at *1 (Fed. Cir. Apr. 5, 2000) (unpublished disposition).

about the ‘wings.’”¹³⁶ They applied for and obtained a design patent.¹³⁷ One of the illustrations from the patent-in-suit is shown below:¹³⁸



The plaintiffs sold a commercial embodiment of their design that appeared substantially as shown below:¹³⁹



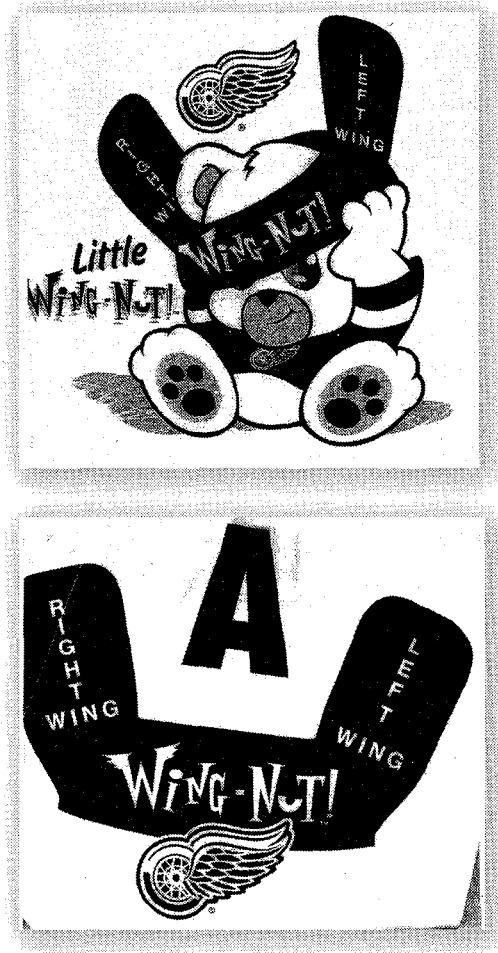
136. Plaintiffs’ Brief in Response to Defendants’ Motions to Dismiss at 1, *Kellman v. Coca-Cola Co.*, No. 2:03-cv-71542 (E.D. Mich. July 18, 2003), ECF 26 [hereinafter *Kellman Brief*].

137. *Id.* (referring to U.S. Patent No. D387,541).

138. Hat, U.S. Patent No. D387,541 fig.1 (issued Dec. 16, 1997).

139. The author purchased one of these hats from detroitwingnut.com in 2015. Mark Kellman, who runs the site, stated that the hat “[h]asn’t changed much” since the lawsuit. E-mail from Mark Kellman to Sarah Burstein (Feb. 1, 2015, 18:06 CST) (on file with author).

The plaintiffs claimed that the Red Wings infringed their design patent by selling “two versions of a T-shirt bearing a design that is an exact reproduction of, and/or substantially similar to, the designs depicted in the Kellmans’ Wing Nut . . . Patent.”¹⁴⁰ The plaintiffs attached the images of the accused t-shirts to their amended complaint, which were decorated with the images shown below:¹⁴¹



As these illustrations show, the accused t-shirts do appear to depict the plaintiffs’ product, not just any wingnut.

140. Kellman Brief, *supra* note 136, at 3.

141. First Amended Complaint, Exhibit F, *Kellman*, No. 2:03-cv-71542 (E.D. Mich. May 8, 2003), ECF 6.

The plaintiffs also claimed that The Coca-Cola Co. and Coca-Cola Enterprises, Inc. (“Coca-Cola”) infringed the design patent by selling bottles of soda with “[a]n exact reproduction of the designs depicted in the Kellmans’ Wing Nut . . . Patent” printed on the bottle caps.¹⁴² The plaintiffs attached the following image of the accused bottle cap to their amended complaint:¹⁴³



Unlike the t-shirts, the accused bottle cap did not clearly depict the plaintiffs’ product; instead, it depicted what appears to be a stylized wing nut emblazoned with the hockey team’s logo.

Coca-Cola and the Red Wings both moved to dismiss.¹⁴⁴ Coca-Cola argued that because the accused bottle cap was a “completely different type[] of article[] of manufacture,” it could not infringe the plaintiffs’ design patent.¹⁴⁵ In support of this argument, Coca-Cola

142. *Id.* ¶¶ 30, 32.

143. *Id.* at Exhibit F.

144. Coca-Cola Brief, *supra* note 125, at 2; Defendant Detroit Red Wings’ Motion to Dismiss Counts VI & VII of Plaintiffs’ First Amended Complaint, *Kellman v. Coca-Cola Co.*, No. 2:03-cv-71542 (E.D. Mich. June 16, 2003), ECF 21 [hereinafter Red Wings Brief].

145. Coca-Cola Brief, *supra* note 125, at 6 (“[T]he Coca-Cola Bottle Cap and

cited *Vigil* and quoted *Chisum on Patents* for the proposition that “[u]sually, a change in the nature of the article results in a substantial change in the appearance of the design, thus avoiding any question of infringement.”¹⁴⁶ Coca-Cola also argued that:

The nature of the designs themselves are also distinctly different. The wing nut design on the Coca-Cola Bottle Cap is a two-dimensional drawing of a common, everyday wing nut that is displayed on the flat surface of an article of manufacture. Plaintiffs’ wing nut design, in contrast, is a three-dimensional foam sculpture that embodies the article of manufacture—a hat—for which it was designed.¹⁴⁷

According to Coca-Cola, “[n]o ‘ordinary observer’ could possibly be induced to purchase the Coca-Cola soft drink products at issue in the mistaken belief that they were purchasing Plaintiffs’ novelty hat, or vice versa.”¹⁴⁸

The Red Wings made similar arguments about the accused t-shirts.¹⁴⁹ According to the Red Wings, the design patent claims should be dismissed because the “T-shirts do not resemble Plaintiffs’ patented hat design so as to induce an ordinary observer into purchasing the T-shirts supposing them to be a hat.”¹⁵⁰ Like Coca-Cola, the Red Wings relied on *Vigil* as persuasive authority.¹⁵¹

In response to the motions to dismiss, the plaintiffs argued that their patent was “not restricted to a three-dimensional form” because it did not contain any such express verbal claim limitation¹⁵²

Plaintiffs’ Wing Nut Hat are completely different types of articles of manufacture: one is a bottle cap (sold in connection with a soda bottle) and the other is a hat. This undisputed fact alone makes the two designs so different that no reasonable fact finder could find they are ‘substantially the same.’”)

146. *Id.* (citing *Vigil v. Walt Disney Co.*, No. 3:97-cv-04147, 1998 U.S. Dist. LEXIS 22853, at *8–9 (N.D. Cal. Dec. 1, 1998) and quoting 1 DONALD S. CHISUM, CHISUM ON PATENTS § 1.04[4][b] (2003)).

147. *Id.* at 7.

148. *Id.* at 8.

149. Red Wings Brief, *supra* note 144, at 13, 16–17.

150. *Id.* at 13.

151. *Id.* at 17 (“The obvious difference in the nature of the articles at issue (a foam hat versus T-shirts) results in a substantial change in the appearance of the two designs. This fact, alone, justifies dismissal of this count.” (citing *Vigil*, 1998 U.S. Dist. LEXIS 22853, at *8)).

152. Kellman Brief, *supra* note 136, at 23 (“Plaintiffs described their ‘Claim’ in the Wing Nut Patent as ‘[t]he ornamental design for a hat, as shown and described’ in five accompanying two-dimensional drawings of different perspectives of a hat shaped like a wing nut. Nowhere does the Wing Nut Patent describe the design of

and that “their invention was not only the foam novelty hat, but also the visual pun that this hat represents.”¹⁵³ They also argued that the fact that the accused products were different types of products was immaterial, relying on two main sources of legal authority.

First, they quoted a passage from the 1959 case *In re Rubinfeld* where the Court of Customs and Patent Appeals stated that “[i]t is well settled that a design patent may be infringed by articles which are specifically different from that shown in the patent” and that “[i]t seems evident . . . that the inventive concept of a design is not limited to the exact article which happens to be selected for illustration in an application or patent.”¹⁵⁴

Second, the plaintiffs pointed to the fact that the design patent disgorgement provision, 35 U.S.C. § 289, uses the phrase “any article of manufacture,” arguing that “[i]f patent infringement were restricted, as Defendants claim, to cases involving the same articles of manufacture, this statutory provision would have used express language of limitation.”¹⁵⁵

The plaintiffs also attempted to distinguish *Vigil*, arguing that:

The plaintiff in that case claimed the patented design for his hockey stick duck call had been infringed by the defendant’s hockey stick key chain. The court dismissed the plaintiff’s claim because the “similarity between the two items arises from the fact that both are in the shape of a hockey stick and nothing more.” In other words, despite some similarity in appearance, the two items were designed to perform entirely different functions, which meant that the plaintiff did not “appropriate any novelty of plaintiff’s duck call.” Here, in contrast, the article in the Wing Nut Patent was not designed to function as a wing nut, but rather as a visual pun symbolizing support for the Detroit Red Wings, which is exactly the same purpose of the design of the wing nut hat images on the Red Wings’ T-shirts and the Coca-Cola

the hat as consisting solely of a three-dimensional article. . . . Clearly, the Kellmans patented a design for a novelty hat shaped like a wing nut that is not restricted to a three-dimensional form . . .” (alteration in original) (citations omitted)); *see also id.* at 29 (“[T]here is no description in the Wing Nut Patent limiting the design of the hat to a three-dimensional article . . .”).

153. *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 672 (E.D. Mich. 2003). *See also* Kellman Brief, *supra* note 136, at 29 (describing the patented invention as “a visual pun representing a metaphor for fan devotion to the Detroit Red Wings that can be depicted in both two and three-dimensional form”).

154. Kellman Brief, *supra* note 136, at 25 (emphasis omitted) (quoting *In re Rubinfeld*, 270 F.2d 391, 393 (C.C.P.A. 1959)).

155. *Id.*

Defendants' bottle caps, which an "ordinary observer" would find so strongly resemble the Wing Nut Patent image.¹⁵⁶

In reply, both Coca-Cola and the Red Wings focused on the plaintiffs' claim that their design patent protected the "visual pun."¹⁵⁷ Coca-Cola also pointed out that the language that the plaintiffs quoted from *In re Rubinfeld* was taken out of context and, based on the cases cited, that language actually appears to be attempting to invoke the well-established proposition that an accused article does not have to be perfectly identical to the patented design in order to infringe.¹⁵⁸ Neither Coca-Cola nor the Red Wings responded directly to the plaintiffs' arguments regarding the language of § 289.¹⁵⁹

After considering these arguments, the court granted the motions to dismiss the design patent claims because they "fail[ed] the 'ordinary observer' test."¹⁶⁰ According to the court:

The fundamental question we have to decide—and there is not much case law to guide us—is whether a design patent can be infringed when the articles of manufacture are so

156. *Id.* at 26 (internal citations omitted).

157. Defendant Detroit Red Wings' Reply to Plaintiffs' Brief in Response to Defendants' Motions to Dismiss at 3, *Kellman v. Coca-Cola Co.*, No. 2:03-cv-71542 (E.D. Mich. Aug. 1, 2003), ECF 34 [hereinafter Red Wings Reply]; Reply Brief of The Coca-Cola Co. & Coca Cola Enterprises, Inc. in Support of Their Motion to Dismiss Counts I & III of Plaintiffs' First Amended Complaint at 1, *Kellman*, No. 2:03-cv-71542 (E.D. Mich. June 16, 2003), ECF 35 [hereinafter Coca-Cola Reply].

158. *See id.* at 4 n.3 ("[T]he language in [*In re Rubinfeld*] quoted out of context by Plaintiffs is based on earlier cases holding that an infringing design need not be identical to a patented design. *See In re Rubinfeld*, 270 F.2d at 393, citing *Borgfeldt Co. v. Weiss*, 265 F. 268, 272 (2d Cir. 1920) and *Gorham Co.*, 81 U.S. at 531."). Coca-Cola was correct on this point. *See In re Rubinfeld*, 270 F.2d 391 (C.C.P.A. 1959). For example, the cited portion of *Gorham* is where the Court made it clear that an accused product need not be "struck from the same die" in order to infringe. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 531 (1871)).

159. *See Coca-Cola Reply*, *supra* note 157; Red Wings Reply, *supra* note 157. Coca-Cola did, however, suggest that § 271 provides the sole definition of design patent infringement. Coca-Cola Reply, *supra*, at 2–3 ("[P]atent law does not protect the two-dimensional drawings contained in a patent from copying; it protects the invention—as claimed in the patent and depicted in the drawings—from being made, used or sold by an unauthorized party. To infringe, a third party must make, use, offer to sell or sell the patented invention . . ." (internal quotation marks omitted) (citing 35 U.S.C. § 271(a) (2000))).

160. *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 680 (E.D. Mich. 2003) ("In sum, because Plaintiffs' design patent claims fail the 'ordinary observer' test, we dismiss the design patent claims.").

entirely different (i.e.: a novelty hat versus a t-shirt or bottlecap) that no reasonable person would purchase the t-shirt or bottlecap thinking that he or she was purchasing the novelty hat. After analysis, we do not find that the design of the hat as compared to the t-shirts and bottlecaps to be substantially similar to cause confusion.¹⁶¹

The court was not persuaded by the plaintiffs' "visual pun" argument, noting that the plaintiffs "cite[d] no case law which holds that an intangible, visual pun can be protected by a design patent."¹⁶² Nor was the court persuaded by the plaintiffs' attempt to distinguish *Vigil*.¹⁶³ Instead, the court referred to *Vigil* as "[t]he case most on point."¹⁶⁴ As for the plaintiffs' reliance on *In re Rubinfeld*, the court merely stated that "*In re Rubinfeld* was not in the context of a patent infringement case and the favorable language quoted above has not been relied on in any subsequent cases (at least we could not find any and the Kellmans have not found any)."¹⁶⁵ The court did not address the plaintiffs' § 289 argument.¹⁶⁶

c. P.S. Products, Inc. v. Activision Blizzard, Inc.

In this case, the plaintiffs invented and sold a stun gun designed to be worn like a pair of brass knuckles.¹⁶⁷ They obtained a design patent for the design, a representative image of which is shown below:¹⁶⁸

161. *Id.* at 679–80.

162. *Id.* at 680.

163. *Id.* ("Plaintiffs' attempt to distinguish this case by arguing that, in the case *sub judice*, the purposes/functions behind the novelty hat and the t-shirts and bottlecaps are the same (i.e. devotion to Red Winds [sic]) is unavailing.").

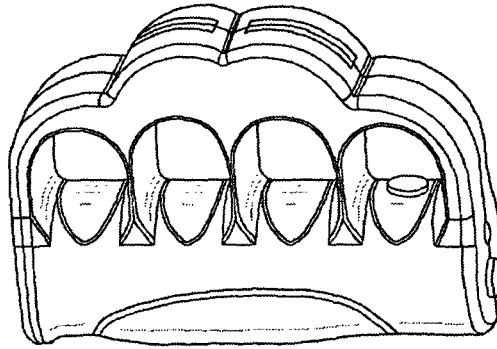
164. *See id.* ("The case most on point, cited by Defendants, is *Vigil v. Walt Disney Co.*, where the court found that a patented design for a hockey stick duck call was not substantially similar to defendant's hockey stick key chain because—despite some similarity in appearance (they both were in the shape of a hockey stick)—the two items were designed to perform entirely different functions." (internal citation omitted)).

165. *Id.* at 679 (referring to *In re Rubinfeld*, 270 F.2d 391, 393 (C.C.P.A. 1959)).

166. *See id.* at 670–80.

167. First Amended Complaint ¶¶ 11, 16, 18, P.S. Products, Inc. v. Activision Blizzard, Inc., No. 4:13-cv-00342 (E.D. Ark. Sept. 13, 2013), ECF 20.

168. *See* Stun Gun, U.S. Patent No. D561,294 fig.6 (issued Feb. 8, 2008).



The plaintiffs sued the makers of the video game *Call of Duty: Black Ops II*, alleging that certain images in the game infringed their design patent.¹⁶⁹ Specifically, they alleged that the visual depictions of two weapons—the “Combat Suppression Knuckles” and “Galvaknuckles”—and the icons used to designate those weapons were “illegal cop[ies]” of the design patent.¹⁷⁰

The defendants moved to dismiss the design patent claim, contending that “the inclusion of images of certain fictional stun guns” in the video game could not, as a matter of law, infringe the plaintiffs’ design patent.¹⁷¹ The defendants relied heavily on their interpretation of the *Gorham* test, arguing that “no ordinary observer would ever confuse the patented stun-gun design for the accused videogame.”¹⁷² In their brief, the defendants pointed to *Kellman* and *Vigil*, arguing that the plaintiffs’ “claim fails for the same reasons as the claims rejected” in those cases.¹⁷³

169. First Amended Complaint, *supra* note 167, ¶ 24.

170. *Id.* ¶¶ 36–37. Actually, the in-game weapons looked nothing like the patented design—another fatal flaw in this design patent claim.

171. Defendants’ Brief in Support of Motion to Dismiss Under Rule 12(b)(6) at 4, *P.S. Products*, No. 4:13-cv-00342 (E.D. Ark. Oct. 23, 2013), ECF 25.

172. *Id.* at 9; *see also id.* at 5–6 (“P.S. Products’ Complaint should be dismissed because no ordinary observer would ever be deceived into buying the accused . . . videogame thinking that it was the patented stun gun.”); *id.* at 1 (“To prevail on a design patent infringement claim, a plaintiff must prove that an ordinary observer would be deceived into buying the accused product (a videogame) thinking that it was the same as the patented invention (a stun gun).”).

173. *Id.* at 8–9 (citing *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670 (E.D. Mich. 2003); *Vigil v. Walt Disney Co.*, No. 3:97-cv-04147, No. 1998 U.S. Dist. LEXIS 22853 (N.D. Cal. Dec. 1, 1998), *aff’d*, 232 F.3d 911, 2000 WL 353148 (Fed. Cir. Apr. 5, 2000)

In opposition to the defendants' motion to dismiss, the plaintiffs argued that "[o]ne does not escape infringement by using a patented invention for a purpose not contemplated or disclosed by the patentee."¹⁷⁴ In support of this and similar points, the plaintiffs relied entirely on utility patent cases dealing with apparatus, composition, or method claims.¹⁷⁵ They also argued that because the PTO grants design patents for computer-generated images, their patent should be interpreted to cover computer-generated images.¹⁷⁶ They also suggested that the *Gorham* test could be satisfied if an ordinary observer believed that the images shown in the video game were "related to connected [sic] and licensed by the Plaintiffs."¹⁷⁷

(unpublished disposition).

174. Plaintiffs Response to Defendants Motion to Dismiss at 6, *P.S. Products*, No. 4:13-cv-00342 (E.D. Ark. Aug. 8, 2013), ECF 12 (citing *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1091 (Fed. Cir. 2009)). Of course, this begs the question of what, precisely, constitutes the "patented invention."

175. *Id.* at 6–7 (citing *Paragon Solutions*, 566 F.3d at 1091 (discussing apparatus claims); *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (discussing apparatus claims); *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002) (discussing apparatus or composition claims); *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1519 (Fed. Cir. 1995) (en banc), *rev'd on other grounds*, 520 U.S. 17 (1997) (discussing method claims); *Union Oil Co. of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 995 (Fed. Cir. 2000), *cert. denied*, 531 U.S. 1183 (2001) (discussing composition claims); *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (discussing composition claims); *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1380 (Fed. Cir. 2003) (quoted but erroneously attributed to *Catalina Mktg.*) (discussing method claims)); *see also id.* at 8 (citing similarly inapposite propositions of utility patent law).

176. *Id.* at 7–9. They also argued that:

Simply because the Plaintiff did not obtain a design patent for a computer icon or image doesn't permit the Defendants to infringe on the Plaintiffs design patent. The Plaintiffs could not have anticipated that their design patent would be used in such a way. However, this does not prohibit the Plaintiffs from enforcing their exclusive rights to protect its [sic] patent. Additionally, if applied for the Plaintiffs would be been [sic] granted a design patent on the computer image and icon of the design. The Defendants should be enjoined from infringing on the said design.

Id. at 9. *See also id.* at 8 ("The Plaintiffs design patent is for a stun device. The Defendants are using the design of the Plaintiffs design patent [as] a computer image and icon in a video game for a stun device.").

177. *Id.* at 9. It is not entirely clear what Plaintiffs meant by this statement; however, it appears that they may have been conflating the test for design patent infringement with the test for infringement of § 43(a) of the Lanham Act. *Compare id.*, with 15 U.S.C. § 1125(a)(1)(A) (2012) (providing a civil cause of action against

The court granted the motion to dismiss.¹⁷⁸ The court concluded that “[n]o reasonable person would purchase defendants’ video game believing that they were purchasing plaintiffs’ stun gun,” relying heavily on the reasoning in *Kellman* and *Vigil*.¹⁷⁹ The court summarily rejected the plaintiffs’ arguments that were based on utility patent cases, stating that those cases “do not apply here” without any additional discussion or explanation.¹⁸⁰ It also rejected the plaintiffs’ arguments that they “could have obtained a design patent for a computer icon” as being “a hypothetical situation . . . not before the Court” and rejected plaintiffs’ interpretation of *Gorham*.¹⁸¹

So, in all three of these cases, the courts reached consistent conclusions. But the reasoning in each is unfortunately thin. And the decisions in both *Kellman* and *P.S. Products* appear to be based on an inaccurate reading of *Gorham*—specifically, on the idea that design patent infringement requires actual confusion at the point of sale. These cases also suggest that the patentee must actually sell a product embodying the claimed design in order to prevail on a claim of infringement, something that is clearly not required by the law.¹⁸² And, in *Kellman*, the court ducked the plaintiffs’ argument regarding

“[a]ny person who . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof . . . which . . . is likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person”).

178. *P.S. Products, Inc. v. Activision Blizzard, Inc.*, No. 4:13-cv-00342, 2014 WL 10538078, at *1 (E.D. Ark. Feb. 21, 2014).

179. *See id.* at *5 (discussing *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670 (E.D. Mich. 2003); *Vigil v. Walt Disney Co.*, No. 3:97-cv-04147, No. 1998 U.S. Dist. LEXIS 22853, at *5 (N.D. Cal. Dec. 1, 1998), *aff’d* 232 F.3d 911, 2000 WL 353148 (Fed. Cir. Apr. 5, 2000)).

180. *Id.*

181. *Id.* (“Plaintiffs also raise the argument that they could have obtained a design patent for a computer icon if they had applied for one. Plaintiffs have not alleged infringement of a design patent for a computer icon, and such a hypothetical situation is not before the Court. Plaintiffs also argue that an ordinary observer ‘would believe the Defendants[] icon is related to [and] connected and licensed by the Plaintiffs’. This argument misapplies the ordinary observer test” (alterations in original) (internal citations omitted)).

182. *See Unette Corp. v. Unit Pack Co., Inc.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986) (“The holder of a valid design patent need not have progressed to the manufacture and distribution of a ‘purchasable’ product for its design patent to be infringed by another’s product.”). *See also Cont’l Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 429 (1908) (rejecting “nonuse” as a defense to utility patent infringement and noting, *inter alia*, that Congress has refused to enact a working requirement for patents).

the language of 35 U.S.C. § 289—arguably the best argument that could be made to support the opposite conclusion.¹⁸³

C. Patent Office Interpretations

1. Decisions of the Commissioner of Patents

A few opinions issued by the Commissioner of Patents in the early twentieth century provide some clues—though not firm answers—about the nature of “the patented design.” This section will discuss those cases briefly.

a. Ex parte Cady I

Harrison Cady was an illustrator, best known for his illustrations of a character named “Peter Rabbit” in a series of children’s books written by Thornton W. Burgess and in comic strips.¹⁸⁴ In 1914, Cady applied for a design patent for his version of Peter Rabbit.¹⁸⁵ In his application, he sought to claim “[t]he ornamental design for articles of manufacture as shown and described.”¹⁸⁶ He also stated that the design “was adapted to be embodied in various articles of manufacture, such as toys, composition figures, etc., or as an ornamentation for any article of manufacture.”¹⁸⁷ Along with his application, he submitted a drawing of the character—apparently this one:¹⁸⁸

183. 35 U.S.C. § 289 (2000). For more on § 289, see *infra* Section III.B.2.b.

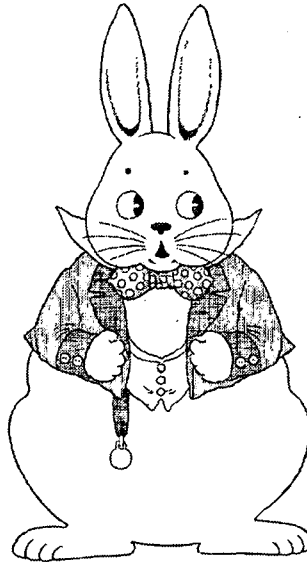
184. See Donald Phelps, *The Rabbit Man: The Art of Harrison Cady*, 3 PROSPECTS 215, 215 (1978). This character should not be confused with the famous Beatrix Potter character. Compare, e.g., THORNTON W. BURGESS, PETER RABBIT PUTS ON AIRS (1914) (illustrated by Harrison Cady), with BEATRIX POTTER, THE TALE OF PETER RABBIT (1902) (written and illustrated by Beatrix Potter). It does appear, however, that Burgess’ work was inspired by Potter and that he named his character after “Potter’s best-known animal hero” at the insistence of his four-year-old son. See Corinne K. Hoexter, *Where Peter Rabbit Romped on Cape Cod*, N.Y. TIMES, Aug. 12, 1990, at 28 (discussing Burgess’ life and work).

185. See *Ex parte Cady*, 1916 Dec. Comm’r Pat. 57, 61 (describing the applicant’s invention as a drawing “of Peter Rabbit, being a dressed-up figure of a fat young rabbit in upright posture and having what the children would call a ‘cute’ expression and attitude”).

186. *Id.* at 58.

187. *Id.*

188. See Article of Manufacture, U.S. Patent No. D50,236 (issued Jan. 30, 1917) (claiming a design that appears to match the Assistant Commissioner’s description in *Ex parte Cady*, with Harrison Cady listed as the inventor and Thornton W. Burgess listed as assignee).



The examiner interpreted Cady's claim as a "claim for either a design embodied in any (indefinite) article or a mere surface ornamentation applied on any article" and rejected it.¹⁸⁹

Cady appealed.¹⁹⁰ In an opinion dated August 28, 1916, Assistant Commissioner of Patents Francis W. H. Clay described the issues as "how to set forth and claim an artistic design which is itself a self-contained character figure and has various obvious applications to useful purposes."¹⁹¹ Clay noted that "[t]he design patent is not to protect the artist as such."¹⁹² Clay stated that, to the extent that Cady had created a patentable invention, that invention was "[t]he physical thing a figure of Peter Rabbit, being a dressed-up figure of a fat young rabbit in upright posture and having what the children would call a 'cute' expression and attitude."¹⁹³ According to Clay, Cady's design "may obviously be embodied in a doll or a cut-out dinner-card, or a bean-bag, or a paper-weight, etc. The drawing, in

189. *Ex parte* Cady, 1916 Dec. Comm'r Pat. at 58.

190. *Id.*

191. *Id.*

192. *Id.*

193. *Id.* at 61. Clay distinguished the patentable invention from the larger idea of "the whimsical character Peter Rabbit." *Id.* (internal quotation marks omitted). According to him, the visual depiction of the character could be "protected by copyright only." *Id.*

fact, shows any one of these, as well as any other.”¹⁹⁴ And “[w]hile the statute requires the applicant to specify some one particular article of manufacture to which he *has* applied the design, it seemingly cannot be required that his patent be limited to any one article.”¹⁹⁵ Clay concluded that Cady could claim either “[t]he ornamental design for an article of manufacture as shown and described” or “[t]he ornamental design for a manufactured figure as shown and described.”¹⁹⁶

b. Ex parte Cady II

On remand, Cady and the examiner were “unable to agree” on the language for the patent.¹⁹⁷ The case went back up on appeal and in an October 24, 1916 decision, Assistant Commissioner Clay stated that:

The applicant insists upon setting forth in his specification that his rabbit design may be applied to a bedquilt, a handkerchief, etc. In an extended oral argument the applicant’s point appears to be a desire to show by the specification that the design is not intended to be limited to a figure in three dimensions.¹⁹⁸

Clay agreed with Cady on those points.¹⁹⁹ But according to Clay, Cady’s argument went further, “contending that the design patent may cover any possible embodiment of the picture of the design.”²⁰⁰ On that point, Clay did not agree, noting that “[i]f it could do so, there would be no difference between patenting the design and patenting a mere picture.”²⁰¹

According to Clay, “[a] disembodied design or mere picture is not the subject of [design] patent”²⁰² because “[t]he invention is not the article and is not the design per se, but is the design *applied*.”²⁰³

194. *Id.*

195. *Id.*

196. *Id.* at 62.

197. *Id.*

198. *Id.* at 62–63. This passage could possibly be read as recognizing some kind of test for infringement by equivalents. However, Clay’s main concern here appears to be more along the lines of enablement—i.e., would the disclosure teach a designer of ordinary skill how to apply the claimed design to other articles.

199. *Id.* at 63 (“I think he has the right to so say.”).

200. *Id.*

201. *Id.*

202. *Id.*

203. *Id.*

Clay appeared to view this rule an application of the general principle that, in order to be patentable, an invention must be reduced to practice, stating:

When the applicant has shown the design applied to one article, he has fulfilled the requirement of reducing the invention to practice, and he may state other articles to which the design is to be applied, if, and only if, the mode and effect of such application have been rendered obvious by the example given.²⁰⁴

Clay agreed with the examiner “that it is not obvious how the design presented is the design for a bedquilt or handkerchief. It does not present to the reader’s mind the appearance of the bedquilt or the handkerchief.”²⁰⁵ Clay indicated, however, that the examiner should “permit a statement that the design is applicable to other articles, naming different articles the applicant can name to which the design is obviously applicable.”²⁰⁶

This decision indicates that, at least in the opinion of one Assistant Commissioner of Patents, design patents do not protect designs *per se*. If they did, there would be no reason for the patent applicant to “state other articles” to which the design could be applied.²⁰⁷ The decision also appears to limit the potential applicability of designs to multiple articles to circumstances in which it would be “obvious” how those designs would be applied to those other articles.²⁰⁸

B. The Manual of Patent Examining Procedure

In the Manual of Patent Examining Procedure (“MPEP”), the PTO provides examiners with guidance on how to evaluate patent applications.²⁰⁹ In doing so, the PTO attempts to condense and

204. *Id.*

205. *Id.* Clay noted that Cady’s stated “object of showing that the design is not confined to articles in three dimensions would be attained by specifying that it is applicable to a child’s dinner-card.” *Id.*

206. *Id.* at 64.

207. *See id.* at 63.

208. *See id.* (“When the applicant has shown the design applied to one article . . . he may state other articles to which the design is to be applied if, and only if, the mode and effect of such application have been rendered obvious by the example given.”).

209. *See* John M. Golden, *Patentable Subject Matter and Institutional Choice*, 89 TEX. L. REV. 1041, 1047 (2011).

summarize the relevant law into useable guidelines.²¹⁰ “Although the [MPEP] does not have the force of law, examiners and patent applicants rely heavily on its guidance, and it is frequently cited by courts as persuasive authority.”²¹¹ Therefore, it is worth considering whether the MPEP provides answers to—or guidance in answering—the question of what, precisely, is “the patented design.”

In a section entitled “Definition of a Design,” the MPEP states that, “[i]n a design patent application, *the subject matter which is claimed is the design embodied in or applied to an article of manufacture* (or portion thereof) and not the article itself.”²¹² It also states that a protectable “[d]esign is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation.”²¹³

Similarly, in the section entitled “Statutory Subject Matter for Designs,” the MPEP states:

A picture standing alone is not patentable under 35 U.S.C. 171. The factor which distinguishes statutory design subject matter from mere picture or ornamentation, per se (i.e., abstract design), is the embodiment of the design in an article of manufacture. Consistent with 35 U.S.C. 171, case law and USPTO practice, the design must be shown as applied to or embodied in an article of manufacture.

A claim to a picture, print, impression, etc. per se, that is not applied to or embodied in an article of manufacture should be rejected under 35 U.S.C. 171 as directed to nonstatutory subject matter.²¹⁴

These provisions suggest that the PTO views the patented design as product-specific—or, at least, as context-specific. It seems particularly clear that the PTO does not consider two-dimensional surface designs, in the abstract, to be design patentable subject matter.

210. See *id.* (“No matter how incoherent or tortured relevant judicial precedent is, the USPTO must try to distill it into a set of comprehensible guidelines for several thousand patent examiners.”).

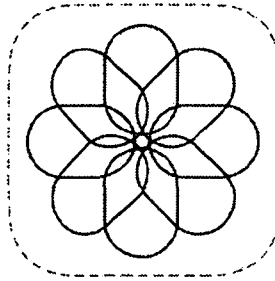
211. Paul R. Gugliuzza, *The Federal Circuit as a Federal Court*, 54 WM. & MARY L. REV. 1791, 1824 (2013) (citing Golden, *supra* note 209, at 1047–48 nn.32–33).

212. MPEP, *supra* note 49, § 1502 (emphasis added and omitted) (citing *Ex parte Cady*, 1916 Dec. Comm’r Pat. 62); see also *id.* (“The design for an article consists of the visual characteristics *embodied in or applied to* an article.” (emphasis added)).

213. *Id.*

214. *Id.* § 1504.01 (emphasis added).

However, in the context of “computer-generated icons,”²¹⁵ the PTO has made the requirement that the design be applied to or embodied in an article of manufacture into something of a farce. The MPEP states that “design applications for computer-generated icons must comply with the ‘article of manufacture’ requirement.”²¹⁶ But, according to the PTO, that requirement is satisfied if the icon (or other computer-generated imagery) is “shown on a computer screen, monitor, other display panel, or a portion thereof.”²¹⁷ And the PTO allows applicants to indicate that the image is “shown on a computer screen, monitor, other display panel, or a portion thereof” simply by drawing broken lines around it.²¹⁸ For example, here is the drawing from a design patent that was recently issued to Apple, Inc., entitled “Display Screen or Portion Thereof with Icon”.²¹⁹



The PTO also instructs examiners to “[r]eview the title to determine whether it clearly describes the claimed subject matter,” stating that:

The following titles do not adequately describe a design for an article of manufacture under 35 U.S.C. 171: “computer icon”; or “icon.” On the other hand, the following titles do

215. *See id.* § 1504.01(a).

216. *Id.*

217. *Id.* § 1504.01(a)(I)(A). *See also* Lance L. Vietzke, Note, *Software as the Article of Manufacture in Design Patents for Icons*, 21 AIPLA Q.J. 138, 139 (1993) (criticizing this interpretation and arguing that “the software which produces an icon is the article of manufacture”).

218. *See id.* § 1504.01(a)(I)(B) (“If the drawing does *not* depict a computer-generated icon embodied in a computer screen, monitor, other display panel, or a portion thereof, in either solid or broken lines, reject the claimed design . . . for failing to comply with the article of manufacture requirement.”). *See also id.* § 1503.02(IV) (“Surface treatment may either be disclosed with the article to which it is applied or in which it is embodied and must be shown in full lines or in broken lines (if unclaimed) to meet the statutory requirement.” (citing *id.* § 1504.01)).

219. U.S. Patent No. D734,779 (issued July 21, 2015).

adequately describe a design for an article of manufacture under 35 U.S.C. 171: “computer screen with an icon”; “display panel with a computer icon”; “portion of a computer screen with an icon image”; “portion of a display panel with a computer icon image”; or “portion of a monitor displayed with a computer icon image.”²²⁰

So while the PTO maintains that “[a] picture standing alone is not patentable,”²²¹ it is perfectly happy to grant patents for such pictures as long as the applicant surrounds it with some broken lines and adds certain magic words in the title.²²²

The PTO also requires that design patent applications include a title.²²³ Until recently, § 1503.01(I) of the MPEP stated that “[t]he title of the design identifies the article in which the design is embodied by the name generally known and used by the public but it *does not define the scope of the claim.*”²²⁴ Arguably, that statement could have been read as indicating that, at least in the view of the PTO, design patents protect designs *per se*. However, the PTO did not provide any explanation or legal authority in support of the proposition that “[t]he title . . . does not define the scope of the claim.” It merely cited to § 1504.04(I)(A) of the MPEP.²²⁵ Section 1504.04(I)(A), in turn, cites back to (and only to) § 1503.01(I).²²⁶ This type of circular self-citation does not provide evidence of thorough consideration, valid reasoning, or anything else that would “give it

220. MPEP, *supra* note 49, § 1504.01(a)(I)(B)(A)(2).

221. *Id.* § 1504.01; *see also id.* § 1503.02(IV) (“Surface treatment, *per se* (i.e., not applied to or embodied in a specific article of manufacture), is not proper subject matter for a design patent . . .” (citation omitted)).

222. *See id.* § 1504.01(a)(I)(B), item (B) (“If the drawing does not depict a computer-generated icon embodied in a computer screen, monitor, other display panel, or a portion thereof, in either solid or broken lines, reject the claimed design under 35 U.S.C. § 171 for failing to comply with the article of manufacture requirement.”); *id.* § 1504.01(a)(I)(B), item (A)(2) (“The following titles do not adequately describe a design for an article of manufacture: ‘computer icon’; or ‘icon.’ On the other hand, the following titles do adequately describe a design for an article of manufacture: ‘computer screen with an icon’; ‘display panel with a computer icon’; ‘portion of a computer screen with an icon image’; ‘portion of a display panel with a computer icon image’; or ‘portion of a monitor displayed with a computer icon image.’” (citations omitted)).

223. *See* 37 C.F.R. § 1.153(a) (2015) (“The title of the design must designate the particular article.”).

224. U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1503.01(I) (emphasis added) (9th ed. Mar. 2014).

225. *See id.* (citing MPEP § 1504.04(I)(A)).

226. *Id.* § 1504.04(I)(A) (“The title does not define the scope of the claimed design but merely identifies the article in which it is embodied.” (citing MPEP § 1503.01(I))).

power to persuade.”²²⁷ Moreover, this version of the MPEP also required that the title correspond to the verbal claim.²²⁸ And, of course, the verbal claim—along with the drawings—*does* define the scope of the design patent claim.

In November 2015, § 1503.01(I) was amended to read: “The title of the design identifies the article in which the design is embodied by the name generally known and used by the public and *may* contribute to defining the scope of the claim.”²²⁹ The PTO did not provide a reason for this change or explain when and how the title “may contribute to defining the scope of the claim.”²³⁰ And while § 1503.01(I) was revised, the cited portion of § 1504.04(I)(A) was not.²³¹ So on this point, the MPEP is at best inconclusive.

Later in § 1503.01(I), the MPEP states that:

A title descriptive of the actual article aids the examiner in developing a complete field of search of the prior art and further aids in the proper assignment of new applications to the appropriate class, subclass, and patent examiner, and the proper classification of the patent upon allowance of the application. It also helps the public in understanding the nature and use of the article embodying the design after the patent has been issued. For example, a broad title such as “Adapter Ring” provides little or no information as to the

227. See *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944) (recognizing that the “power to persuade” includes “thoroughness [in] consideration,” “validity [in] its reasoning,” “consistency with earlier and later pronouncements,” and any other “factors”).

228. *Id.* § 1503.01(I) (“When the title and claim do not correspond, the title should be objected to under 37 CFR 1.153 as not corresponding to the claim.”). See also *id.* § 1503.01(III) (“The single claim should normally be in formal terms to ‘The ornamental design for (the article which embodies the design or to which it is applied) as shown.’ The description of the article in the claim should be consistent in terminology with the title of the invention.” (citing MPEP § 1503.01(I))).

229. MPEP, *supra* note 49, § 1503.01(I) (emphasis added).

230. *Id.* See also *Change Summary for the Ninth Edition, Revision 07.2015*, U.S. PATENT & TRADEMARK OFFICE (Nov. 2015), <http://www.uspto.gov/web/offices/pac/mpep/mpep-0005-change-summary.html> (stating merely that § 1503.01(I) was “revised to indicate that the title may contribute to defining the scope of the claim”).

231. See MPEP, *supra* note 49, § 1504.04(I)(A) (still stating that “[t]he title does not define the scope of the claimed design but merely identifies the article in which it is embodied” (citing MPEP § 1503.01(I))). See also *id.* § 1503.01(I) (still citing MPEP § 1504.04(I)(A)). Hopefully, the PTO will remedy this inconsistency in future revisions to the MPEP.

nature and intended use of the article embodying the design.²³²

This suggests that the PTO does not view design patents as protecting designs *per se*. If design patents protect designs *per se*, how could the title help the examiner develop “a complete field of search of the prior art”?²³³ Everything would be prior art. Indeed, why bother classifying the application at all?²³⁴ And the title could not help “the public in understanding the nature and use of the article embodying the design after the patent has been issued”²³⁵ if the design patent protected designs *per se*, because the “article embodying the design” could be any article.

Overall, the MPEP provides some indication that the PTO does not conceptualize design patents as protecting designs *per se*. Instead, the MPEP seems to support (at least weakly) a product-specific—or, at least, context-specific—interpretation of “the patented design.” However, PTO practice, particularly with regard to “computer-generated icons,” raises serious questions about how seriously the PTO takes its own embodied-or-applied requirement. Therefore, even if the MPEP were authoritative—which it is not—it is not completely helpful in determining what, exactly, the PTO views as the patented design.

III. DEFINING THE PATENTED DESIGN

As demonstrated above, the precise nature of the patented design is an open question. This section will argue that, for several reasons, the patented design should be conceptualized as the design *as applied* to a particular type of product. It will then discuss various potential objections to that proposal.

A. *The Case for Limiting Design Patent Protection*

The patented design should not be conceptualized as a design *per se*. Nor should it be conceptualized as protecting only designs that are applied to the exact same product, used for the exact same purpose, as originally intended (or produced) by the patentee. Instead, the patented design should be conceptualized as the design *as applied* to a particular type of product.

232. *Id.* § 1503.01(I).

233. *See id.*

234. *See id.*

235. *See id.*

In this context, the word “product” should be defined as “something sold by an enterprise to its customers.”²³⁶ Under this definition, “product” would not be a synonym for “article of manufacture.” For example, naturally-occurring items such as berries could be sold as a “product” but they would not fall under any reasonable interpretation of the statutory phrase “article of manufacture.” And multiple articles of manufacture can be sold as a single product—for example, a set of flatware containing a spoon, a knife, and a fork.

Under this proposal, a design patent claiming a design that was initially intended for (or manufactured as) a child’s shoe could be infringed by the use of the same design on a shoe for adults.²³⁷ It could also, in appropriate circumstances, be infringed by the use of the design on other types of footwear—for example, a particular buckle design might be designed to apply to sandals as well as dress shoes. In all of these scenarios, even though the particular products would be different, they are all still of the same general type—namely, footwear.

However, the same design patent could not be infringed by a photograph or video recording of a shoe embodying the patented design. Nor could it be infringed by the reproduction of one of the patent’s drawings. And it would not be infringed by a shoe-shaped paperweight.

This approach is superior to either extreme—a very narrow specific-product approach or a *per se* approach—for a number of reasons. First, the process of design is, by its very nature, product-specific.²³⁸ Designers are not hired to create beautiful items to exist in a vacuum. Nor are they hired to develop beautiful shapes in the hopes that those shapes may be adaptable to some unspecified product in the future.²³⁹ Design is about melding form and function; it is the act of applying a particular form to a particular function that constitutes the act of “design.” Therefore, this approach—i.e., conceptualizing the patented design as a particular visual

236. KARL T. ULRICH & STEVEN D. EPPINGER, *PRODUCT DESIGN AND DEVELOPMENT* 2 (5th ed., 2011) (defining the term “product”) (italics omitted).

237. *Cf.* *Avia Grp. Int’l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557 (Fed. Cir. 1988), *abrogated on other grounds by* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (finding that L.A. Gear’s children’s shoe infringed upon Avia Group’s design patents for two of their adult shoes).

238. *See supra* Section I.A.

239. That is not to say that this does not happen sometimes. A designer may keep a sketchbook of general ideas and inspiration to be used later on specific products. But it is that later use—the application of the shape to a particular design problem—that constitutes the “designing.”

appearance applied to a particular type of product—best matches the designer's actual contribution.²⁴⁰ It also recognizes that the act of taking an existing appearance and adapting it to a new product is, in itself, a valuable act of design. Consider Paola Pivi's "Love Ball" chandelier, which was made from miniature models of chairs sold by Swiss furniture company Vitra.²⁴¹ Protecting designs *per se* would actively discourage this type of creativity.

Although this point may be most obvious with regard to three-dimensional designs, two-dimensional designs are also, in some important senses, product-specific. A surface design created for use on drinking glasses would not necessarily be appropriate for use on an armchair—or at least, not without making significant creative design choices on issues such as scale, repetition, and placement. That type of creative adaptation, as with product configuration, is the type of innovation that design patent law should encourage, not prohibit. Of course, under current law, this is something of an academic question. Virtually all two-dimensional designs are protected by copyright when they are fixed in a tangible medium of expression.²⁴² And copyright *does* protect its subject matter, "works of authorship," in the abstract.²⁴³ Regardless of how we define "the patented design," these types of designs will be protected as designs *per se* under copyright.

240. See Mueller & Brean, *supra* note 40, at 481 ("[T]he application of the design to the underlying article is an inextricable part of the value that [industrial] designers provide.").

241. See Paola Pivi, GALERIE PERROTIN, https://www.perrotin.com/Paola_Pivi-works-oeuvres-19561-10.html (last accessed Dec. 22, 2015). In this case, it appears that the artist used miniature chairs that had been sold by Vitra, as opposed to making her own miniature versions. See Paola Pivi: Vitra Mini Chair Chandelier, DESIGNBOOM (Dec. 9, 2010), <http://www.designboom.com/art/paola-pivi-vitra-mini-chair-chandelier/> (featuring similar works) ("Vitra has been producing miniature replicas of famous designer chairs for a number of years. This chandelier by artist Paola Pivi is made entirely from these small chairs with an aluminum structure to hold them together."). So it appears that, on these facts, the doctrine of patent exhaustion would apply. See generally CHISUM ON PATENTS, *supra* note 7, § 16.03[2][a] ("An authorized sale of a patented product exhausts the patent monopoly as to that product. Thus, a purchaser of such a product from the patent owner or one licensed by the patent owner may use or resell the product free of control or conditions imposed by the patent owner." (footnote omitted)). But creating miniature chairs for this purpose should also be allowed.

242. See generally 17 U.S.C. § 102(a) ("Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.").

243. See *id.*

And there is no reason to believe that allowing this kind of creative adaptation will meaningfully discourage the creation of the pioneering design in the first place. For example, it is highly unlikely that Vitra will stop commissioning and producing innovative new chairs just because designers are able to use miniature replicas of those chairs to create a new and innovative chandelier design.²⁴⁴ Similarly, there is no reason to believe that companies will stop investing in the creation of new chair designs because if they are unable to use a single design patent to monopolize the use their designs as chairs, as miniature models, and in architectural renderings.²⁴⁵ While other IP regimes, such as copyright and utility patents, protect derivatives, that does not mean design patents have to do so—or that the broad scope of protection for derivative works is justified or necessary in those other regimes.

Even without design patent protection, a design originator would still have the right under trademark law to sell the official, branded versions of such derivatives. For example, Toyota could sell model or toy versions of its cars²⁴⁶ under the name TOYOTA and block others from doing the same.²⁴⁷ And if Toyota could prove that all or part of a given car design was nonfunctional²⁴⁸ and had acquired secondary meaning,²⁴⁹ it could use trade dress law to prevent others from making similar-looking toy cars or visual depictions of its car.²⁵⁰

244. See *supra* note 241 and accompanying text.

245. Cf. Rain Noe, *Selling Virtual Versions of Design Classics: Is This Even Legal?*, CORE77 (May 29, 2013), http://www.core77.com/blog/business/selling_virtual_versions_of_design_classics_is_this_even_legal_24957.asp (discussing the business model of a company called 3D Furniture, which sells 3D models of classic furniture designs “for architects to drop into renderings”).

246. See *Motor Vehicle and/or Toy Replica Thereof*, U.S. Patent No. D719,067 (issued Dec. 9, 2014).

247. See *generally* *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000) (discussing the protection of trademarks under federal law).

248. Importantly, the word “functional” does not mean the same thing in trademark law and design patent law. See Sarah Burstein, *Commentary: Faux Amis in Design Law*, 105 TRADEMARK REP. 1455, 1455–57 (2015) (demonstrating the difference between the Supreme Court’s interpretation of the word “functional” in the trademark context and the Federal Circuit’s test for “functionality” in the design patent context).

249. See *Wal-Mart*, 529 U.S. at 211 (noting that a mark has secondary meaning “when, ‘in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.’” (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851, n.11 (1982)) (alteration in original)).

250. See, e.g., *Gen. Motors Corp. v. Lanard Toys, Inc.*, 468 F.3d 405, 410 (6th Cir. 2006) (affirming the grant of summary judgment on General Motor’s trade dress infringement claims “over a series of toy vehicles produced by Lanard called “THE

Admittedly, the proposal put forth here would make it more difficult for design patent owners to leverage their period of exclusivity in order to establish secondary meaning in their product designs. But design patent owners should not be given this artificial “head start” anyway.²⁵¹

In any case, to the extent that there is an open empirical question about incentives vis-à-vis design derivatives, that fact should counsel against extending protection to them. Unless and until there is evidence that denying design originators protections for these types of derivatives significantly reduces their incentives to make furniture at all, we should not protect such derivative designs. To do otherwise would be to grant design originators an unwarranted windfall. Second, this approach is a better fit with First Amendment and free speech values. Artists should be free to, for example, depict luxury items in order to comment on financial inequality without having to take on the risk, uncertainty, and expense of litigation.²⁵² Likewise, journalists should be free to illustrate their stories about real products with accurate photos or illustrations of those products.²⁵³ Although these types of use should

CORPS! ATK’ which resemble the Hummer vehicle produced by General Motors”); *Ultimate Creations, Inc. v. THQ Inc.*, No. 2:05-cv-01134, 2008 WL 215827, at *1, *6 (D. Ariz. Jan. 24, 2008) (denying defendant’s motion for summary judgment on plaintiff’s trade dress claim, where players of defendant’s video games could “create a character that has a similar build, face paint, and logo symbol as” the plaintiff). To be clear, this Article is not saying that the law *should* allow a trademark owner prevent these types of uses. Rather, the point is a descriptive one, based on the current state of the law.

251. See Daniel H. Brean, *Enough Is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 TEX. INTELL. PROP. L.J. 325, 364 (2008) (“While designers and manufacturers have enjoyed this ‘head start’ benefit of design patents, in a sense it is cheating the trademark system. No other types of trademark rights enjoy this exclusivity period for establishing secondary meaning.”).

252. Cf. Nadia Plesner, *Simple Living & Darfurnica*, PLESNER, <http://www.nadiaplesner.com/simple-living--darfurnica1> (last visited Dec. 22, 2015) (discussing the artist’s legal dispute with Louis Vuitton over her depiction of a Louis Vuitton handbag in her painting *Darfurnica*); see also Rosie Burbidge, *Louis Vuitton Attempts to Ban Darfurnica*, ART & ARTIFICE (Mar. 24, 2011), <http://aandalawblog.blogspot.com/2011/03/louis-vuitton-attempts-to-ban-darfurnica.html> (discussing the same legal dispute).

253. Cf. Tom Mighell, *Transformative Tech Tips*, 42 THE STUDENT LAWYER 1 (Sept. 2013), http://www.americanbar.org/publications/student_lawyer/2013-14/september/transformative_tech_tips.html (illustrating the cover story on “Transformative Tech Tips” with fictionalized images of computer icons instead of real ones, presumably to avoid any intellectual property issues). This type of use would be

be insulated from copyright or trademark liability by the fair use doctrine, it is risky and expensive to maintain a fair use defense. The same is true of a First Amendment defense.²⁵⁴ A bright-line rule of no infringement would better protect artists, journalists, and others engaged in expressive speech.

Third, this approach would provide competitors and the public with better notice about the scope of the claimed invention. If design patents were deemed to protect designs *per se*, the title and claim language would provide no useful information at all. But under this approach, the patent document would actually match the patent scope, making it easier for others to know what is and is not protected without having to consult a patent attorney. If a design originator believes that a new design would be suitable for multiple types of products, that originator can apply for multiple design patents.

Fourth, this approach would better allocate search costs among design patent applicants, competitors, and the public. If design patents protect designs *per se*, then the prior art would consist of literally everything that has ever existed. Protecting designs *per se* would impose undue burdens on downstream innovators. A designer should not have to search every type of product ever made and every shape occurring in nature to determine if her new design infringes someone else's design patent or whether invalidating prior art exists.

Fifth, this approach fits better with the presumption of validity that our system gives to granted design patents. Design patent examiners do not search through every type of product ever made when conducting their substantive examinations.²⁵⁵ And rightly so—such a task would be unduly time-consuming and impracticable.

roughly analogous to the types of uses deemed to be “nominative fair uses” in trademark law. See generally 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:11 (Thomson Reuters ed., 2015) (defining “nominative fair use” as “a use of another’s trademark to identify, not the defendant’s goods or services, but the plaintiff’s goods or services”).

254. And while, “[u]nder . . . trademark law . . . video game makers have been able to utilize First Amendment protections[,] . . . [a] similar First Amendment defense has not yet been recognized in the area of design patents.” Omer Salik & Neil Yang, *An Important Win for Video Games in Design Patent Case*, LAW360 (May 14, 2014, 4:11 PM) (citing *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008)); see also *id.* (“Omer Salik and Neil Yang are in-house counsel at Activision Publishing . . .”).

255. See MPEP, *supra* note 49, § 1504 (“Novelty and nonobviousness of a design claim must generally be determined by a search in the pertinent design classes. It is also mandatory that the search be extended to the mechanical classes encompassing inventions of the same general type. Catalogs and trade journals as well as available foreign patent databases are also to be consulted.”).

However, because design patent examiners do not search every class for prior art, the issuance of a design patent does not represent a determination that the design is novel and nonobvious as applied to all classes of products. At a minimum, if the patented design is conceptualized as something broader than what is proposed here, design patents should be given no presumption of validity outside of the design fields actually searched by the examiner.

Finally, there is support for this proposal in the current case law. As discussed above, all of the district courts that have dealt directly with the issue of infringement via use of a design on a different product or via visual depiction have ruled such uses to be noninfringing.²⁵⁶ This approach also accords with the manner in which some courts have interpreted *Gorham v. White*.²⁵⁷

It also accords with the Federal Circuit's decision in *Avia Group International, Inc. v. L.A. Gear California*.²⁵⁸ In that case, the Federal Circuit rejected the accused infringer's argument that the fact that one party made shoes for tennis players and that one made shoes for children "render[ed] the products not 'substantially the same,' as necessary under *Gorham*."²⁵⁹ According to the Federal Circuit:

[The defendant's] understanding of *Gorham* is grossly in error. To find infringement, the accused shoes need only appropriate a patentee's protected design, not a patentee's market as well. The products of the parties need not be directly competitive; indeed, an infringer is liable even when the patent owner puts out no product. *A fortiori*, infringement is not avoided by selling to a different class of purchasers than the patentee.²⁶⁰

This makes sense and comports with the approach proposed here. If the design patent claims a design for a shoe, the scope would extend

256. See *supra* Section II.B.3.

257. 81 U.S. (14 Wall.) 511 (1871). See *supra* Section II.B.3.

258. 853 F.2d 1557 (Fed. Cir. 1988), *abrogated on other grounds by* Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) (en banc).

259. *Id.* at 1565 (citing *Gorham*, 81 U.S. (14 Wall.) 511).

260. *Id.* (citation omitted). See also CHISUM ON PATENTS, *supra* note note 7, § 23.05[2] ("[A] design patent is not strictly limited to directly competitive products.") (citing *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.*, 162 F.3d 1113 (Fed. Cir. 1998); *Avia Grp. Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988); *Victus Ltd. v. Collezione Europa U.S.A. Inc.*, 48 U.S.P.Q.2d 1145, 1148 (M.D. N.C. 1998); *Child Craft Indus., Inc. v. Simmons Juvenile Prods. Co.*, 990 F. Supp. 638, 643 (S.D. Ind. 1998)).

to all shoes, regardless of whether those shoes are sold for adults or for children.

B. Potential Objections and Counter-Arguments

1. The PTO's Rules for Computer Icons

In a recent article, Jason Du Mont and Mark Janis address the topic of design patents for "virtual designs," a category they define as including "individual software-generated icons, the imagery associated with various graphical user interfaces, and other visual elements of the virtual environment."²⁶¹ Du Mont and Janis note that the PTO allows applicants to claim on-screen visual elements while disclaiming the screen on which they are shown.²⁶² As they explain, "the representation of the computer display is now typically rendered as a stylized square or rectangle in broken lines; it conveys no information other than the fact that the virtual design is indeed applied to an article of manufacture."²⁶³ They suggest that these claiming rules allow applicants to claim designs *per se*, despite the PTO's protestations to the contrary.²⁶⁴

Du Mont and Janis argue that, due to this claiming convention, "the scope of the patentee's . . . design for infringement purposes would not be limited to computer generated images" and that a design patent for a graphical user interface ("GUI") would, therefore, potentially cover the application of the image shown in the patent "to wallpaper, carpets, t-shirts, etc."²⁶⁵ Indeed, they assert that these types of claims "must be construed to cover [the image] as applied to any article of manufacture, without any limitations as to the appearance of that article of manufacture" or any limitation as to the type of article of manufacture.²⁶⁶

Du Mont and Janis use a "hypothetical patented daisy icon design" as an illustration.²⁶⁷ They argue that the daisy icon would be

261. Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 STAN. TECH. L. REV. 107, 109 (2013).

262. *See generally id.* at 114–21 (stating that "[d]esign patent law does not require the underlying article of manufacture to be depicted as part of the claim").

263. *Id.* at 127.

264. *Id.* at 116–17 (citing MPEP, *supra* note 49, § 1504.01).

265. *Id.* at 165.

266. *Id.* (arguing that a hypothetical design patent application for a GUI design resembling a daisy would presumptively be anticipated by the use of the same daisy on a planter).

267. *Id.* at 171.

infringed if it were “replicated on a t-shirt without the design patent owner’s authorization.”²⁶⁸ They assert that:

First, as a matter of claim construction, the appearance of the associated screen display is not part of the claimed design, as the broken-line designation indicates. The use of the design on *anything* falls within the scope of the claim. Second, the t-shirt maker’s activities are likely to constitute *prima facie* acts of infringement (assuming that they are carried out within the U.S. and during the term of the patent). The general infringement provision, 35 U.S.C. § 271(a), proscribes, *inter alia*, unauthorized acts of making, using, and selling, categories that have been construed liberally in the utility patent context.²⁶⁹

It is true that the Patent Act prohibits “using” a claimed invention and that, in the utility patent context, “use” has been interpreted broadly. But that does not answer the underlying question—what exactly *is* the claimed invention? Du Mont and Janis approach this question as matter of claim construction, noting that the PTO does not require applicants to visually disclose the context of their on-screen icons. But the PTO does require applicants to disclose at least some context in both the title and the verbal claim.²⁷⁰

If, as argued here, the claimed invention is best conceptualized as a particular appearance applied to a particular type of product, then putting a daisy image—even the same one shown in the hypothetical design patent—on a t-shirt simply would not constitute a “use” of the patented design.

Indeed, when it comes to computer-generated imagery, especially for GUI designs, the relevant product is likely the software—not the screen. At a minimum, these GUI design patents should be limited to uses of the claimed design *as* elements of GUIs. So, for example, a website would not infringe Apple’s design patent for the iTunes icon by posting the drawing from that design patent.²⁷¹ Properly understood, the patented design is the design *as applied to* a GUI icon—i.e., it is not being used as “a graphical symbol on a tool or other visual control” for software.²⁷² If the image is merely posted on

268. *Id.*

269. *Id.* at 172 (footnote omitted).

270. See MPEP, *supra* note 49, § 1504.01(a).

271. Cf. Dennis Crouch, *Apple Patents an Encircled Musical Note*, PATENTLY-O (Oct. 25, 2012), <http://patentlyo.com/patent/2012/10/apple-patents-an-encircled-musical-note.html> (showing the drawing from U.S. Patent No. D668,263 and asking, “Is Patently-O infringing the design patent by showing the image on your screen?”).

272. See LARRY L. CONSTANTINE & LUCY A.D. LOCKWOOD, SOFTWARE FOR USE: A

a website, it is not being used *as an icon*. Therefore, it should not be deemed to be infringing.

2. The Statutory Language

It may be argued that conceptualizing the patented design as a design as applied to a certain type of product is inconsistent with the language of the Patent Act. In particular, objections may be raised with respect to 35 U.S.C. §§ 171 and 289. This section will address those statutory provisions in turn.

a. Section 171

As discussed above, § 171 authorizes the PTO to issue patents to anyone who “invents any new, original and ornamental *design* for an article of manufacture.”²⁷³ Prior versions of the statute referred to a design “*of* an article of manufacture” instead of a design “*for* an article of manufacture” when describing the statutory subject matter.²⁷⁴ Some courts and commentators have read quite a bit into this change.²⁷⁵ But from a design perspective, this is a distinction without a difference.

Indeed, if there is any meaningful distinction between a design “*of*” and “*for*” an article of manufacture, it would seem to relate most naturally to whether or not the article has actually been manufactured. If an industrial designer is hired (or assigned) to design a new shoe, it would be natural to say that the designer has been engaged to create a new design “*for*” a shoe. And while the designer is working, we would say that she is working on a design “*for*” a shoe. We would not normally refer to the designer’s work as a design “*of*” a shoe until after the shoe is actually produced. The change in statutory language, if it is read to have any substantive

PRACTICAL GUIDE TO THE MODELS AND METHODS OF USAGE-CENTERED DESIGN 168 (1999) (defining the term “icon” in the context of software design).

273. 35 U.S.C. § 171(a) (Supp. I 2013). *See supra* Section II.A.

274. The first design patent act actually used both prepositions. *See* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 (1842) (listing, among the various types of statutory subject matter, “any new and original design *for* a manufacture” and “any new and original shape or configuration of any article *of* manufacture” (emphasis added)).

275. *See, e.g.,* Du Mont & Janis, *supra* note 261, at 115–16 (noting in the case of *In re Zahn*, “[f]or Judge Rich, the critical point was that the statute authorized the protection of designs ‘for’ articles of manufacture; it was not limited to designs ‘of’ articles of manufacture.”) (referring to 617 F.2d 261 (C.C.P.A. 1980)).

import, is best read as clarifying the fact that a design need not actually be in production in order to be patentable.

b. Section 289

Some commentators have suggested that 35 U.S.C. § 289 indicates—if not requires—that design patents protect designs *per se*.²⁷⁶ Section 289 states that:

Whoever during the term of a patent for a design, without license of the owner, (1) *applies the patented design*, or any colorable imitation thereof, to *any article of manufacture* for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties. Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.²⁷⁷

Viewed in isolation, the highlighted language might be read as defining the scope of design patents to include protection for designs *per se*, because it indicates that § 289 applies when “the patented design” is applied to “*any article*.” However, this is not the best way to read this provision, for at least two reasons.

First, this reading begs the real question—what, precisely, is “the patented design”? After all, it is “the patented design” that must be applied to “any article” in order for § 289 to apply.²⁷⁸ And some types of designs are created to be applied to distinct, though related, articles of manufacture.²⁷⁹ It would be possible, for example, to

276. See Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 STAN. TECH. L. REV. 107, 172 (2013) (“[T]he additional remedies provision applicable to design patents, 35 U.S.C. § 289, imposes liability upon anyone who, without the design patent owner’s authorization, ‘(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.’ This provision refers to the application of the design to any article of manufacture; it clearly extends to the t-shirt.”). To date, no court has weighed in on this issue.

277. 35 U.S.C. § 289 (2012) (emphasis added).

278. See 35 U.S.C. § 289.

279. Cf. UMA SUTHERSANEN, DESIGN LAW: EUROPEAN UNION AND UNITED STATES OF AMERICA 54 (2d. ed. 2010) (“[I]f the scope of protection is wide enough,

conceptualize a design for the configuration of a utensil handle as a unitary "patented design," even though it is meant to be applied to multiple articles of manufacture, such as forks and spoons.²⁸⁰ As the CCPA noted in *Schnell*:

To say, for example, that one who had invented a design for a tea set could not obtain a patent on the design for a tea set, but must be limited to a design for that particular one of the dishes shown, would be entirely out of harmony with the spirit and terms of the law. Though the patent show the design as applied to a saucer, yet if it be a design the mode and effect of which when applied to a cup or sugarbowl is obvious without further showing or explanation manifestly it would not be reasonable to require the applicant to take a series of patents to cover *what is, in fact, one single invention—namely, a design for dishes broadly, not narrowly for a particular dish.* The principal value of many of the most beautiful designs resides exactly in the adaptability of the design to several forms of articles.²⁸¹

It is thus possible to interpret "the patented design" as something other than a design *per se* without doing violence to the text of the statute.²⁸²

Second, § 289 is a remedial provision.²⁸³ It does not define the scope of the right, nor does it set forth the acts constituting

copyright or a registered design right in the design of the handle of a spoon, may extend to encompass . . . [other] manifestations of the design as applied to handles of forks, ladles, or soup tureens. *This makes much sense if all the artefacts have been designed as a set and are intended, by the designer, to present a united visual front to the user.*" (emphasis added).

280. See generally *In re Schnell*, 46 F.2d 203, 209 (C.C.P.A. 1931) ("The mere fact . . . that [the patentee] shows his design for glassware by a drawing of the same upon a saucer only, does not . . . limit the scope of his patent and his protection under it to its use on saucers."). The same logic would apply to things like surface patterns for bedding sets and designs for decorative zippers or studs.

281. *In re Schnell*, 46 F.2d 203, 208 (C.C.P.A. 1931) (emphasis added) (quoting *Ex parte Andrews*, 1917 Dec. Comm'r Pat. 13, 14).

282. Indeed, this is what the CCPA did in *Schnell*. See *id.* at 209 ("In an infringement suit, as we understand it, the test would be, Does the one complained of infringe the art taught by the patentee. If he has applied the same or similar design to the same or similar article or articles so as to mislead the public, he has infringed. The enforcement remedy provided in the act of 1887 [i.e., the remedy currently provided in 35 U.S.C. § 289], . . . we think, entitles the patentee to this degree of protection." (emphasis added) (footnote omitted) (citing *Ashley v. Samuel C. Tatum Co.*, 186 F. 339, 342 (2d Cir. 1911)).

283. See 35 U.S.C. § 289 (entitled "Additional remedy for infringement of design

infringement.²⁸⁴ Instead, it provides design patent owners with a special remedy for certain commercial acts of infringement.²⁸⁵ As a general matter, remedial provisions should not be read as enlarging—or fundamentally changing—substantive rights. That is especially true where, as here, the remedy provision was enacted later than the relevant substantive provision and where there is no indication that Congress meant to change the scope of the substantive right. The remedy provided by § 289 was added to the statute forty-five years after Congress enacted the first design patent statute.²⁸⁶ Congress added this remedy in response to a series of Supreme Court cases in which the owner of design patents that claimed designs for use on rugs received only nominal damages despite judicial findings that the design patents had, in fact, been infringed by certain accused rugs.²⁸⁷ There is no indication in the legislative history or in contemporary commentary that Congress intended to modify the scope of design patents in any way. It just wanted the carpet designers (and others like them) to get paid.

3. Line-Drawing Problems

In most cases, determining what the relevant product—or type of product—is should be easy. Design patent owners usually sue those who make or sell competing products.²⁸⁸ However, there may be situations that prove more difficult, especially where partial

patent”); *id.* (stating that “[n]othing in this section shall prevent, lessen, or impeach any other *remedy* which an owner of an infringed patent has under the provisions of this title.” (emphasis added)).

284. *See id.*; *see also* CHISUM ON PATENTS, *supra* note 7, § 23.05[1][b] (“This statute was enacted in 1887 to provide an additional remedy for the owner of a design patent and should not be taken as a definition of what constitutes infringement of a design patent.”). *But see* UMA SUTHERSANEN, DESIGN LAW: EUROPEAN UNION AND UNITED STATES OF AMERICA 222 (2d. ed. 2010) (describing 35 U.S.C. § 289 as “[t]he provision on scope of protection and infringement”); Smith, *supra* note 80 (manuscript at 6) (“Section 289 defines acts of infringement for a design patent.”).

285. *See* Burstein, *Costly Designs*, *supra* note 11 (manuscript at 20–21).

286. The first design patent act was enacted in 1842. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 (1842). The disgorgement remedy was added in 1887. Mark A. Lemley, *A Rational System of Design Patent Remedies*, 17 STAN. TECH. L. REV. 219, 222 (2013) (citing Act of Feb. 4, 1887, ch. 105, § 1, 24 Stat. 387, 387 (1887)).

287. *See* Lemley, *supra* note 286, at 222 (citing *Dobson v. Dornan*, 118 U.S. 10 (1886); *Dobson v. Bigelow Carpet Co.*, 114 U.S. 439 (1885); *Dobson v. Hartford Carpet Co.*, 114 U.S. 439 (1885)).

288. *Cf.* CHISUM ON PATENTS, *supra* note 7, § 23.05[2] (“In virtually all the reported cases, the accused article is of the same nature as the patented one.”).

claiming is involved.²⁸⁹ In those circumstances, one solution would be to put the burden of proof on the patent owner to show that the accused device should be considered the same type of product. Courts have been tasked with determining which products are and are not the same “type” of product in the trademark context; there is no obvious reason why they should not be able to do the same in the design patent context.²⁹⁰

If, however, the line-drawing problem proves to be intractable, an alternative would be to determine product “types” according to the Locarno Agreement Establishing an International Classification for Industrial Designs.²⁹¹ Specifically, “type of product” could be defined to map onto Locarno sub-classes.²⁹² For example, Locarno Class 10 includes subclasses for “Clocks and Alarm Clocks,” “Watches and Wrist Watches,” and “Other Time-Measuring Instruments.”²⁹³ The Locarno classification system is not perfect for this use but it may provide a second-best solution if judicial common law development proves unworkable.

In any case, the cost of dealing with potential line-drawing issues does not outweigh the benefits of this proposed approach. The only way to entirely avoid line-drawing problems would be to protect designs *per se*. But, as discussed above, doing so would extract significant costs on competition and creativity.

4. The Rule Is Too Easy To Circumvent

In practice, limiting design patents to designs for the same type of product would not be much of a limit for well-financed, sophisticated players. They could simply get more design patents to

289. For more on partial claiming, see Burstein, *Costly Designs*, *supra* note 11 (manuscript at 10–15).

290. See 15 U.S.C. § 1117(c)(1) (2012) (“In a case involving the use of a counterfeit mark . . . in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover . . . an award of statutory damages . . . in the amount of . . . not less than \$1,000 or more than \$200,000 per counterfeit mark *per type of goods* or services sold, offered for sale, or distributed . . .” (emphasis added)).

291. See generally LOCARNO AGREEMENT ESTABLISHING AN INTERNATIONAL CLASSIFICATION FOR INDUSTRIAL DESIGNS, http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=286253 (last visited Dec. 22, 2015).

292. See generally INTERNATIONAL CLASSIFICATION FOR INDUSTRIAL DESIGNS (LOCARNO CLASSIFICATION) (10th ed. 2013), http://www.wipo.int/classifications/nivolo/pdf/eng/locarno/LOC_10e.pdf.

293. See *id.* at 10.

cover more types of products. But that would not be a bad result. The public and competitors would get better notice of how the patent owner thinks the design could and should be applied. And, as long as the cost of each additional application is non-negligible, it will force design patent applicants to be selective about what they want to protect.²⁹⁴ If they believe the benefit of additional patents is worth the cost, then they will be able to obtain a broader scope of protection. If not, others should remain free to innovate and adapt their designs in other product fields.

5. Design Patent Term

It might be argued that because the term of a design patent is relatively short, there might be less competitive harm in protecting “derivatives” on different products. But even though a single design patent lasts for only 14–15 years,²⁹⁵ design patent practitioners can use the PTO’s continuation procedures to “evergreen”²⁹⁶ design patent protection for a particular product for thirty or even forty years.²⁹⁷ Acquiring a design patent can also help its owner gain potentially perpetual protection under trade dress law.²⁹⁸ So even though the duration of a design patent is limited, the implications of granting one are not.

294. See generally Burstein, *Costly Designs*, *supra* note 11 (manuscript at 4) (arguing that the PTO’s design patent examination likely operates as a beneficial costly screen).

295. See *supra* text accompanying note 44.

296. Cf. Mark A. Lemley & Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U. L. REV. 63, 81–82 (2004) (criticizing the practice of “evergreening”); Janice M. Mueller & Donald S. Chisum, *Enabling Patent Law’s Inherent Anticipation Doctrine*, 45 HOUS. L. REV. 1101, 1106 (2008) (discussing the concept of “evergreening” in the pharmaceutical context). For more on the use of continuation applications in design patent prosecution, see Burstein, *Costly Designs*, *supra* note 11 (manuscript at 12–13, 32, 43).

297. These numbers are based on representations made to the author by an experienced design patent prosecutor.

298. See Burstein, *Costly Designs*, *supra* note 11 (manuscript at 32–34) (“[T]rade dress protection, once established, can last as long as a design is ‘used in commerce,’ meaning that “a design patent . . . may be used as a stepping–stone to locking up a design in perpetuity.”).

IV. IMPLICATIONS

A. *Infringement*

Because the patented design should be conceptualized as the design as applied to a certain type of product, visual representations—such as photographs or digital renderings—of patented products should not be deemed infringing.²⁹⁹ In those circumstances, there would be no use of “the patented design.” Thus, the result in *Kellman* was correct; depicting a patented hat design on a t-shirt should not be deemed to infringe the design patent as a matter of law.³⁰⁰ And the court in *P.S. Products* was correct to conclude that using images of the “Zap Blast Knuckle” in a video game could not infringe a design patent for a stun gun.³⁰¹

Similarly, particular images or configurations should remain free to be adapted to new types of products. If someone made a piece of jewelry, handbag handle, or iPhone case that looked like the “Zap Blast Knuckle,” none of those would be infringing uses of “the patented design.” Similarly, a cookie shaped like a handbag would not be deemed to infringe a design patent for a handbag.³⁰²

B. *Prior Art*

This conception of the patented design also has several implications related to the prior art. This section will discuss those implications in turn.

299. To be clear, by “visual representations,” I mean representations that are solely visual. This would not necessarily include computer-aided design (“CAD”) files, which contain data in addition to visual information. And while photos and drawings of a product would not infringe a design patent, they *could* anticipate one if they “describe” the claimed invention. See 35 U.S.C. § 102(a)(1) (2012) (“A person shall be entitled to a patent unless . . . the claimed invention was patented, *described* in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention . . .” (emphasis added)).

300. *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 680 (E.D. Mich. 2005).

301. *P.S. Products, Inc. v. Activision Blizzard, Inc.*, No. 4:13-cv-00342, 2014 WL 10538078, at *5 (E.D. Ark. Feb. 21, 2014).

302. Cf. *Hermes Bag Cookies!*, LE BAKER'S DOZEN <http://lebakerson.com/post/44217985807/hermes-bag-cookies-hermes> (last visited Dec. 22, 2015).

1. Prior Art and Anticipation

To be patentable, a design must be novel.³⁰³ Section 102(a) of the Patent Act provides that:

A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.³⁰⁴

In applying this section to design patents, the phrase “the claimed invention” should be read as referring to the patented design.³⁰⁵ A design should not be deemed to be anticipated unless the same appearance—as applied to the same type of product—was “patented, described in a printed publication, or in public use, on sale, or otherwise available to the public” before the relevant priority date.³⁰⁶ This accords with the general principle that “the same test must be used for both infringement and anticipation.”³⁰⁷

Consider, for example, the arguments made in the recent case of *Kimber Cakeware, LLC v. Bradshaw International, Inc.* Kimber accused Bradshaw of infringing U.S. Patent No. D671,376, entitled “Batter Separator.”³⁰⁸ Kimber sold a commercial embodiment of this

303. See 35 U.S.C. § 102 (2012).

304. *Id.* § 102(a); see also *id.* § 171(c) (“The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.”).

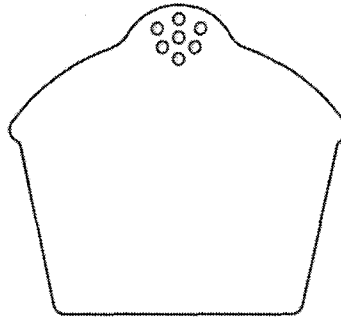
305. See *id.* § 171(b) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

306. See *id.* § 102(a). In this context, the degree of sameness required should be the same as for infringement—i.e., differing only in immaterial respects. See *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1243 (Fed. Cir. 2009) (“Just as ‘minor differences between a patented design and an accused article’s design cannot, and shall not, prevent a finding of infringement,’ so too minor differences cannot prevent a finding of anticipation.” (quoting *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984)) (internal quotation omitted)).

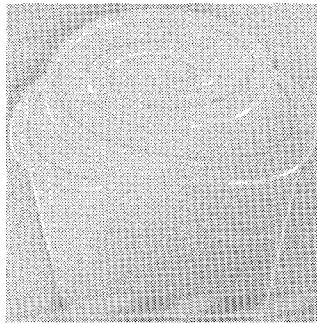
307. See *Int’l Seaway*, 589 F.3d at 1239 (noting that this principle “has been well established [in patent law] for over a century”).

308. See Complaint for Design Patent Infringement with Demand for Jury ¶¶ 3, 29–36, *Kimber Cakeware, LLC v. Bradshaw Int’l, Inc.*, No. 2:13-cv-00185 (S.D. Ohio

design under the brand name “Batter Babies.”³⁰⁹ A representative image from the D’376 patent is shown below:³¹⁰



The accused product was also a cupcake batter separator. It looked like this:³¹¹



As these images show, the accused design looks nothing like the claimed design, except for the fact that both are abstract, representational designs depicting cupcakes.³¹² The general idea is the same; the expressions are quite different.

Mar. 1, 2013), ECF 2.

309. *See id.* ¶ 18; *see also id.* ¶ 28 (showing a picture of one of Kimber’s cupcake batter separators).

310. *See* Batter Separator, U.S. Patent No. D671,376 fig.1 (issued Nov. 27, 2012).

311. This image was provided by Bradshaw in its brief in support of its motion for summary judgment. Defendant Bradshaw International, Inc.’s Motion for Summary Judgment and Memorandum of Points and Authorities in Support Thereof at 3, *Kimber Cakeware*, No. 2:13-cv-00185 (S.D. Ohio Feb. 5, 2014), ECF 21 [hereinafter Motion for Summary Judgment].

312. *See generally* PAUL ZELANSKI & MARY PAT FISHER, DESIGN PRINCIPLES AND PROBLEMS 321 (2d ed. 1996) (defining the term “representational” as referring to “art that depicts objects from the world of our experience,” as opposed to

Bradshaw moved for summary judgment of noninfringement.³¹³ The same day, Bradshaw also moved for sanctions under Rule 11 of the Federal Rules of Civil Procedure.³¹⁴ In its motion for sanctions, Bradshaw also argued that Kimber's design patent was "invalid as anticipated by [a] Cupcake Cookie Cutter prior art reference"³¹⁵ — i.e., by a cookie cutter shaped like a cupcake.³¹⁶

The case settled before the judge ruled on either motion.³¹⁷ However, the case still provides a helpful set of facts. Pursuant to the proposal set forth in this article, Bradshaw's anticipation argument should have failed. A cookie cutter—no matter what it looks like—should not be deemed to anticipate a design for a cupcake batter separator. Even though they both fall into the broad category of cookware, they are not used for the same purposes and they don't perform similar functions. Therefore, they should not be considered to be the same type of product under the analysis set forth here.³¹⁸

So what would count as the same type of product—and therefore, relevant prior art—on these facts? In its opposition to Bradshaw's motion for sanctions, Kimber provided a number of examples of other types of cupcake batter separators, including the Mrs. Fields Half N' Half Cupcake Pan:³¹⁹

"nonrepresentational art," which "does not depict real or natural things in any manner"); *id.* at 319 (defining the term "abstract art" as "[a]n art form in which subjects are simplified, with emphasis on design rather than realism" (emphasis omitted)).

313. Motion for Summary Judgment, *supra* note 311, at 1.

314. Defendant Bradshaw International, Inc.'s Memorandum in Support of Its Motion for Rule 11 Sanctions, *Kimber Cakeware*, No. 2:13-cv-00185 (S.D. Ohio Feb. 5, 2014), ECF 24 [hereinafter Motion for Sanctions].

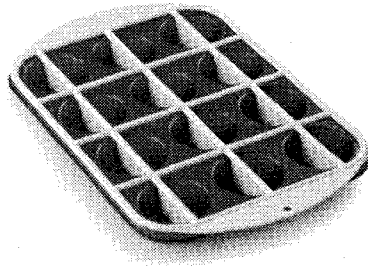
315. *Id.* at 17 n.3.

316. *See id.* (referring to the product shown in Exhibit 4, ECF 24-3).

317. Stipulated Dismissal with Prejudice, *Kimber Cakeware*, No. 2:13-cv-00185 (S.D. Ohio May 21, 2014), ECF 54. Kimber had obtained an extension of time to file its opposition to Bradshaw's summary judgment motion until May 28, 2014. *See* Opinion and Order, *Kimber Cakeware*, No. 2:13-cv-00185 (S.D. Ohio Mar. 31, 2014), ECF 41. Perhaps the court was waiting to rule on both motions together.

318. *See generally* *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009) ("In light of Supreme Court precedent and our precedent holding that the same tests must be applied to infringement and anticipation, and our holding in *Egyptian Goddess* that the ordinary observer test is the sole test for infringement, we now conclude that the ordinary observer test must logically be the sole test for anticipation as well."). The ordinary observer test is a test of visual sameness. *See supra* Section I.B.3.

319. Plaintiff Kimber Cakeware LLC'S Memorandum in Opposition to Defendant's Motion for Rule 11 Sanctions at 15, *Kimber Cakeware*, No. 2:13-cv-00185



This is not precisely the same type sub-type of product shown in the D'376 patent and embodied in the “Batter Babies.” While the latter design discloses a free-standing batter divider for a single cupcake, the Mrs. Fields design simultaneously divides batter in an entire pan of cupcakes. But it’s still the same general type of product—a cupcake batter separator. So the Mrs. Fields reference should count as prior art to the D'376 patent.

2. Prior Art and The Ordinary Observer Test

The prior art can also be used to narrow the usual scope of a design patent. That is because, as discussed above, the ordinary observer is deemed to be familiar with the prior art.³²⁰ In this context, the prior art should be the same as it is for anticipation under § 102.³²¹

Again, the briefing from *Kimber v. Bradshaw* provides a useful example.³²² In its motion for sanctions, Bradshaw argued that Kimber’s infringement claim “[l]ack[ed] any basis in fact or law.”³²³ Bradshaw contended that the claim was fatally deficient because, among other reasons, “Kimber’s infringement analysis ignores consideration of the prior art as required under *Egyptian Goddess*.”³²⁴ In support of this argument, Bradshaw pointed to an

(S.D. Ohio Feb. 27, 2014), ECF 31.

320. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008) (en banc) (stating that the ordinary observer test should be applied “through the eyes of an observer familiar with the prior art”).

321. See 35 U.S.C. § 102(a) (2012); *Int’l Seaway*, 589 F.3d at 1239 (“[T]he same test must be used for both infringement and anticipation.”).

322. See *supra* Section IV.B.2.

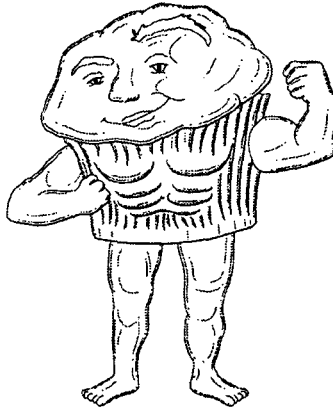
323. Motion for Sanctions, *supra* note 314, at 2.

324. *Id.* at 15 (referring to *Egyptian Goddess*, 543 F.3d at 675 (en banc) (capitalization changed from title case to sentence case)).

image from a website selling a cupcake-shaped cookie cutter³²⁵ and to design patents with the following titles:

- “Muffin Top,”³²⁶
- “Cupcake Holder,”³²⁷
- “Cupcake-Shaped Container for Holding Lip-Gloss or the Like,”³²⁸
- “Cupcake Mold,”³²⁹
- “Novelty Container,”³³⁰
- “Ice-Cream Candle,”³³¹ and
- “Male Figurine with a Muffin Torso and Head.”³³²

A representative drawing from the latter patent is shown below:³³³



Bradshaw asserted that all of these references constituted prior art that needed to be considered as part of the ordinary observer test.³³⁴

325. *Id.* (citing Exhibit 4, ECF 24-3).

326. *Id.* at 17 (citing Exhibit 5, ECF 24-4 (showing a copy of U.S. Patent No. D359,153 (issued Aug. 25, 1994))).

327. *Id.* (citing Exhibit 6, ECF 24-5 (showing a copy of U.S. Patent No. D601,379 (issued Oct. 6, 2009))).

328. *Id.* (citing Exhibit 7, ECF 24-6 (showing a copy of U.S. Patent No. D633,654 (issued Mar. 1, 2011))).

329. *Id.* (citing Exhibit 8, ECF 24-7 (showing a copy of U.S. Patent No. D616,260 (issued May 25, 2010))).

330. *Id.* (citing Exhibit 9, ECF 24-8 (showing a copy of U.S. Patent No. D649,905 (issued Dec. 6, 2011))).

331. *Id.* (citing Exhibit 11, ECF 24-10 (showing a copy of U.S. Patent No. D590,524 (issued Apr. 14, 2009))).

332. *Id.* (citing Exhibit 10, ECF 24-9 (showing a copy of U.S. Patent No. D610,944 (issued Mar. 2, 2010))).

333. U.S. Patent No. D610,944 fig.1 (issued Mar. 2, 2010).

Under the approach presented here, none of these references would count as prior art for the purposes of applying the ordinary observer test. They do not describe “the patented design” because they do not claim designs for the same type of product.³³⁵

3. Prior Art and Nonobviousness

To be patentable, a design must not only be novel; it must also be nonobvious.³³⁶ Section 103 of the Patent Act provides:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.³³⁷

The prior art used to determine nonobviousness may be broader than it is for anticipation. The person having ordinary skill in the art—the ordinary designer—may be aware of more than just the references that qualify under § 102. In appropriate circumstances, a prior design for a different type of product might provide evidence that a claimed design is obvious, even if it does not anticipate the claim.³³⁸

334. Motion for Sanctions, *supra* note 314, at 15–17. Kimber disagreed, arguing that “none of the design patents cited by Bradshaw fall within the scope of prior art.” Plaintiff Kimber Cakeware, LLC’s Memorandum in Opposition to Defendant’s Motion for Rule 11 Sanctions at 20, *Kimber Cakeware, LLC v. Bradshaw Int’l, Inc.*, No. 2:13-cv-00185 (S.D. Ohio Feb. 27, 2014), ECF 31; *see also id.* at 18 (“None of what Bradshaw cites as . . . prior art qualifies as such under the law . . .” (capitalization changed from title case to sentence case)). Kimber argued that “the scope of the prior art . . . should be limited to articles of the same type that have the same purpose.” *Id.* at 20 (emphasis omitted); *see also id.* at 21 (suggesting that only other “cupcake batter separator[s]” should count).

335. *See* Motion for Sanctions, *supra* note 314, at Exhibits 4–10 (all showing products that are clearly not applied to batter separators or kitchen implements of any type).

336. 35 U.S.C. § 103 (2012).

337. *Id.*

338. *See* Burstein, *Visual Invention*, *supra* note 44, at 201–02 (discussing some of those circumstances).

C. The Larger Policy Debate

The analysis presented here has important implications for the larger debate about how, if at all, designs should be protected. Critics of the design patent system have long argued that the United States should use a different system, such as copyright or a *sui generis* regime, to protect designs.³³⁹ And at least one commentator has argued that trademark law may be the best regime to protect product designs.³⁴⁰

This Article has presented a number of reasons why we should not protect designs *per se* and, instead, should conceptualize the protected thing as the design as applied to a particular type of product. But many of these reasons have nothing to do with patents or patent law. Rather, they pertain to the nature of the subject matter being protected and various policy-related concerns. If, as argued here, protecting designs *per se* is a bad idea, it is a bad idea regardless of which IP regime is used. A system like copyright, which protects “works” in the abstract, is therefore particularly ill-suited for designs.³⁴¹

CONCLUSION

This Article has demonstrated that the scope of the patented design is still an open question, which leaves other important questions unanswered, including:

- Does a visual representation (such as a photograph or digital rendering) of a commercial embodiment of the patented design infringe that design patent?
- Does the use of a claimed shape or image on a totally different type of product constitute infringement?

339. See, e.g., William Thompson, *Product Protection Under Current and Proposed Design Laws*, 19 U. BALT. L. REV. 271, 276 (1989) (arguing that adopting “a simple and quick copyright process” would be “a ‘win-win’ situation for both the designer and the public”).

340. See Dratler, *supra* note 39, at 975 (“[P]erhaps the very flexibility of trademark principles—as distinguished from the relative absoluteness of patent or copyright protection—is the answer to the riddle that has puzzled Americans for so long.”).

341. Professor Dratler reached a similar conclusion. See *id.* at 916 (“Copyright principles . . . may not be the best candidates for protecting industrial designs. . . . Their emphasis on similarity in the abstract, divorced from specific products and markets, seems especially inappropriate for industrial designs, which are necessarily product-specific.”).

This Article argues that the answer to both of these questions should be “no” because the patented design should be conceptualized as the design as applied to a specific type of product, not as a design *per se*. This position is supported by various policy rationales; however, those rationales are not limited to patent law or the patent system. Therefore, this analysis suggests that regimes that protect their subject matter in the abstract, like copyright, may be ill-suited to protecting designs.