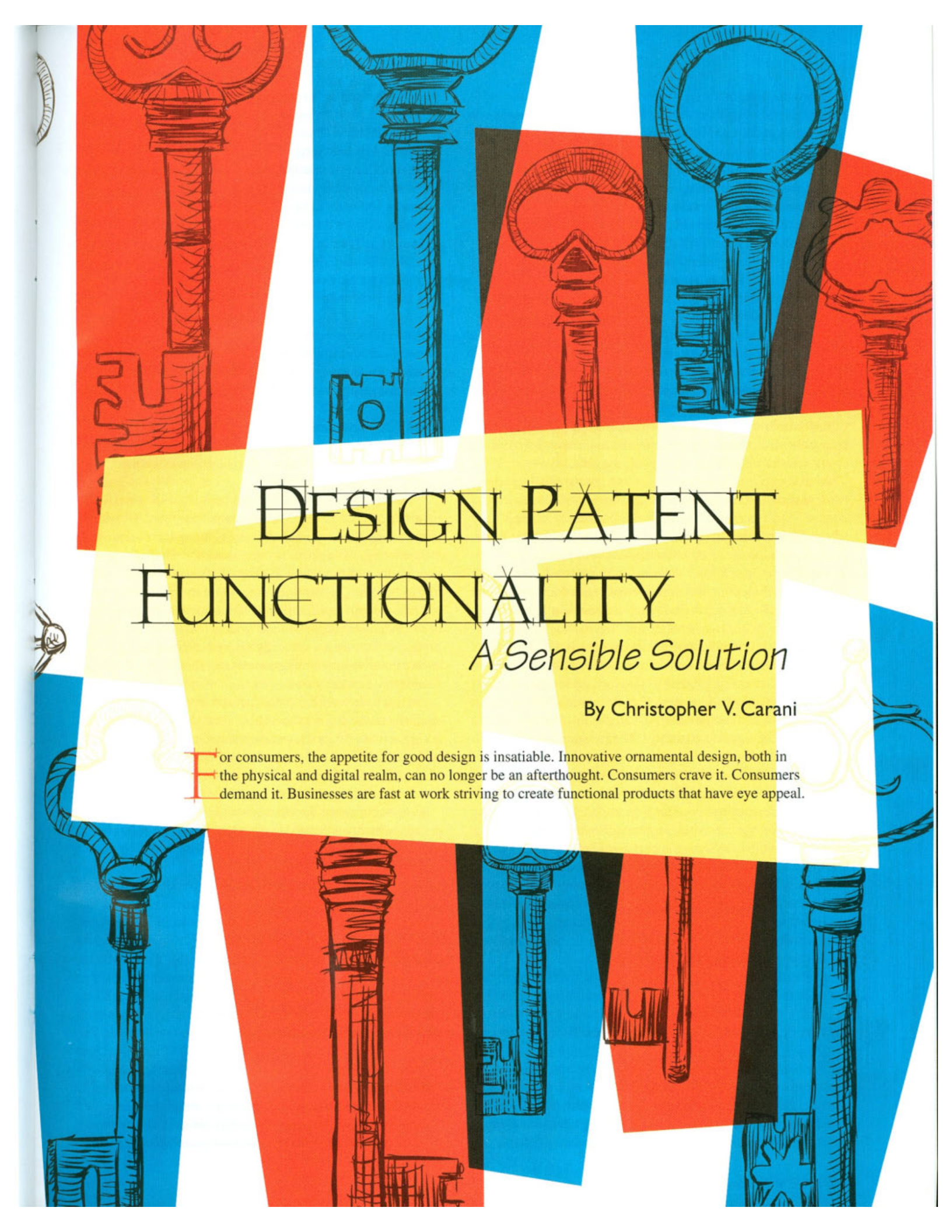




# DESIGN PATENT FUNCTIONALITY

*A Sensible Solution*

By Christopher V. Carani

For consumers, the appetite for good design is insatiable. Innovative ornamental design, both in the physical and digital realm, can no longer be an afterthought. Consumers crave it. Consumers demand it. Businesses are fast at work striving to create functional products that have eye appeal.

From the design houses of New York City, to the storied industrial design firms of Chicago, to the cutting-edge think tanks of Silicon Valley, the desire for effective and reliable design protection is at an all-time high. The need is paramount as commerce continues to migrate from brick-and-mortar stores (where consumers can touch and feel products) to the Internet (where appearance reigns supreme).

With design protection at a premium, the existing jurisprudential doctrines of “functionality” need better clarity. “Functionality” is a general prohibition grossly applied across the field of design intellectual property (IP), which encompasses design patents, trade dress, and copyrights. It is viewed as a way to prevent design rights from being used to monopolize ideas or concepts, which is strictly the province of utility patents. In design patent law, that prohibition is tied to ornamentality; in copyright law, it is tied to the merger doctrine; and in trade dress law, it is tied to nonfunctionality. While the term “functionality” is often loosely used in each of the three IP regimes, the policies and underpinnings for the respective doctrines are quite different, and thus it is injudicious to assume that they are interchangeable.

In design patent jurisprudence, there are two distinct contexts in which the notion of functionality arises. The first context is as a matter of statutory compliance; here, the inquiry regards the functionality (or as discussed below, more appropriately the “lack of ornamentality”) of the *overall appearance* of the claimed design. I will refer to this context as “statutory functionality.” The second context arises in the confines of claim construction (known elsewhere in the world in the design context as the determination of the “scope of protection.”) Attempting to hold true to the tenet that design patents protect aesthetics and not function, courts have used the claim construction process to (attempt to) identify and factor out aside *individual aspects* of the claimed design that are deemed to be functional. I will refer to this context as “claim construction functionality.” The jurisprudence in both contexts needs desperate attention.

In this article, I set out to: (1) generate a better awareness of the distinction between the issues of statutory functionality and claim construction functionality; (2) establish that the majority’s “dictated solely by” test for the distinct issue of statutory functionality is the best approach, inasmuch as it is consistent with the governing statutory framework and sufficiently shields against the unwanted monopolization of a functional ideas via design patents; and (3) explain the wrongheadedness of the current legal trend on the issue of claim construction functionality where courts are eliminating the appearance of so-called functional features from the claimed design. Ultimately, I offer an alternative approach that is sensible, workable, and, hopefully, a unifying solution.

## Statutory Functionality: The Tried and True Course

### Let the Statute Guide the Way

The issue of statutory functionality asks whether the design patent claim is eligible as statutory subject matter under the “ornamentality” requirement of 35 U.S.C. § 171. A challenge under § 171 is often referred to as a “functionality defense”

(i.e., “Is the claimed design functional?”). However, to better track the statute, the operative question should be phrased more accurately a “lack of ornamentality defense” (i.e., “Does the claimed design lack ornamentality?”). To better understand why, it is helpful to consider the relevant statutory framework for utility and design patents. Understanding this interplay allows us to better appreciate the gatekeeper role of ornamentality for design patents.

For utility patents, we look first to 35 U.S.C. § 101 for what is eligible subject matter; for design patents, we look to 35 U.S.C. § 171. Below is a side-by-side comparison of the two governing statutes:

§ 101: Whoever invents or discovers any new and *useful* process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 171: Whoever invents any new, original and *ornamental* design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

Notably, the terms “useful” and “ornamental” are positive requirements necessitating an attribute (e.g., useful, ornamental), not negative requirements necessitating the *absence* of an attribute (e.g., nonuseful, nonornamental).<sup>1</sup> Thus, § 171 does not require that the claimed design be “devoid of usefulness”; in the same way, § 101 does not require the claimed invention to be “devoid of ornamentality.”<sup>2</sup> The statutory framework of the Patent Act rightfully recognizes that usefulness and ornamentality are not mutually exclusive characteristics. The statute comfortably accommodates the ideal that good design seamlessly melds form and function.

Similar to the way § 101 does not specify a particular minimum amount or degree of usefulness needed for compliance, § 171 does not specify a particular minimum amount or degree of ornamentality. Instead, the gatekeeper requirements of §§ 101 and 171 simply necessitate that the claimed subject matter *is* “useful” for utility patents, and *is* “ornamental” for design patents.

Constructing tests for determining how much usefulness or ornamentality is needed to clear the statutory hurdles has been left to the judiciary. Generally speaking, and with reference to utility patents, the Supreme Court has interpreted the subject matter provisions of the Patent Act to be wide-reaching and inclusive, noting that the “subject-matter provisions of the patent law have been cast in broad terms to fulfill the constitutional and statutory goal of promoting ‘the Progress of Science and the useful Arts’ with all that means for the social and economic benefits envisioned by Jefferson.”<sup>3</sup> Specific to design patents, the Court in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* also articulated a broad standard for determining compliance with the ornamentality requirement:

Since 1842, Congress has also made protection available for ‘any new, original and ornamental design for an article of manufacture.’ 35 U.S.C. § 171. To qualify for protection, a design must present an aesthetically pleasing appearance that is *not dictated by function alone*, and must satisfy the other criteria of patentability.<sup>4</sup>

Picking up on this general proclamation, the Federal Circuit has adopted a test that deems a design ornamental so long as the claimed design is not “dictated solely by” its function.<sup>5</sup> By framing the issue this way, the courts effectively assume that a design has enough ornamental quality to pass statutory muster, *unless* it is shown that the design is dictated solely by its function. In other words, the test asks did the designer exercise any independent judgment in arriving at the design or was the overall appearance dictated solely by the functional requirements of the design? For if the entire appearance was preordained by the functional requirements of the article of manufacturer, then, in fact, nothing was designed and no patent reward should grant.<sup>6</sup>

Notably, a second strain of case law for determining statutory functionality has emerged from Federal Circuit dicta. This second strain seeks to tackle statutory functionality by employing a multifactor functionality test imported from trademark law.<sup>7</sup> Specifically, the second strain states that when assessing statutory compliance with the ornamentality requirement of § 171:

[C]onsiderations might include: whether the protected design represents the best design; whether alternative designs would adversely affect the utility of the specified article; whether there are any concomitant utility patents; whether the advertising touts particular features of the design as having specific utility; and whether there are any elements in the design or an overall appearance clearly not dictated by function.<sup>8</sup>

This multifactored trademark approach is neither doctrinally nor practically consistent with the prevailing “dictated solely by” design patent ornamentality standard; it is not a good fit in the design patent context and should be cast aside. First, the length of potential term of protection for trademarks is significantly longer than for design patents, thus warranting a more difficult standard for trademark rights; trademarks are potentially entitled to a perpetual term, whereas design patents are given a maximum term of 14 years.<sup>9</sup> Second, the multifactored trademark approach goes well beyond the simple and express language of the statute (i.e., “is the design ornamental?”). Third, by considering something that is the “best design” as a strike against patentability, the multifactored trademark approach is counter to the constitutional goal of incentivizing and rewarding (presumably good) design. Fourth, the multifactored trademark approach with its sweeping considerations injects unwanted uncertainty into the analysis. Fifth, the multifactored trademark approach disqualifies design protection beyond that needed to shield against the concern of monopolizing functional ideas and thus has the potential to thwart the progress of design.

Although it appears that the multifactored trademark approach has gained some traction, the vast majority of courts still continue to appropriately employ the “dictated solely by” test for statutory functionality.

### ***Alternative Designs: Dispelling the Monopoly Boogie Man***

With the “dictated solely by its function” test in place, the operative question becomes how does one establish that a design is *not* dictated solely by its function? According

to prevailing Federal Circuit case law, proof of *alternative designs* is decisive evidence that a design is not dictated solely by its function.<sup>10</sup> The Federal Circuit has adopted and confirmed this logic:

We apply a stringent standard for invalidating a design patent on grounds of functionality: the design of a useful article is deemed functional where the appearance of the claimed design is dictated by the use or purpose of the article. [T]he design must not be governed solely by function, i.e., *that this is not the only possible form of the article that could perform its function*.<sup>11</sup>

While not typically used stateside, this approach is employed, and referred to, elsewhere in the world as the multiplicity of forms approach.<sup>12</sup> In practice, it is true that the multiplicity of forms approach is quite easily met, and as explained below this is sensible given the consideration at play; most articles of manufacture, even highly functional items, can take on many others forms and still perform their intended function. Accordingly, the risk that functional ideas are monopolized through design patents is quite low. For example, while a chair certainly is a functional item, a quick pass down the halls of your office will reveal a variety of chair designs—each sufficiently ornamental to satisfy the threshold gatekeeper requirement of § 171. Whether furniture, footwear, consumer electronics, hand tools, or medical devices, skilled designers can almost always redesign the appearance of the item while maintaining the required functional attributes.<sup>13</sup> Simply put, conjuring up alternative designs is a fundamental skill of their profession.

So while the desire to guard against monopolizing functional ideas through design patents is certainly sound policy, practically speaking, it is a bit of a boogie man. The actual risk of monopolizing functional ideas through design patents is slim. This reality is supported by the fact that there are rarely lack of ornamentality rejections during USPTO examination, and only one published opinion from the Federal Circuit concluding that a design patent was invalid for failure to satisfy the ornamentality requirement of § 171.<sup>14</sup>

The current prevailing approach, which uses alternative designs to determine ornamentality, wisely side-steps the hairy task of deciding whether a design is “ornamental enough.” The approach recognizes the reality that “beauty is in the eye of the beholder,” and thus it is futile for the law to qualitative assess ornamentality, including the relative merit of design movements such as art Bauhaus, functionalism, art deco, minimalism, maximalism, etc.<sup>15</sup> At the same time, the approach provides sufficient safeguards against the rare, but still unwanted, backdoor monopolization of functional ideas through design patent protection. Lastly, this approach leaves the door amply open to accommodate the boundary-pushing creativity of the world of design.

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### Ornamentality of Overall Claimed Design Drives the Statutory Functionality Inquiry

The statutory functionality inquiry does not, and should not, examine the ornamentality of *individual portions* of a claimed design. After all, rights are not extended to portions of a claimed design; the only protection is for what is claimed, namely, the overall appearance of what is depicted in the drawings in solid lines.<sup>16</sup> Accordingly, the statutory functionality inquiry rightfully focuses on whether the *overall appearance* of the claimed design as a whole is dictated solely by its function.<sup>17</sup> This holistic approach is consistent with other tests in design patent jurisprudence, including those for infringement, novelty, and nonobviousness, which use the *overall appearance* of the design as their guiding principle.

Note that when I refer to the design's overall appearance, I am referring to the overall appearance of the *claimed* design, not the overall appearance of the article of manufacture. As shown in figure 1, often the statutory functionality inquiry hinges on the scope of the design being *claimed*.

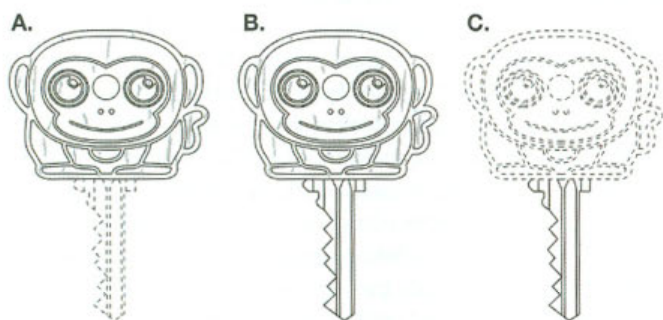


Figure 1

In figure 1A, only the key head (i.e., the monkey head-shaped handle) is shown in solid lines and thus claimed. The key blade portion (i.e., the portion to be inserted into a mating keyhole) is shown in dotted lines and thus disclaimed. In figure 1B, the entire key is claimed including its key head and key blade. In figure 1C, the key head is disclaimed and only the key blade is claimed. As noted above, when assessing statutory functionality, the operative question is whether the overall appearance of the *claimed design* is dictated solely by its function.

In figure 1A, the claimed design should pass “ornamentality” muster under § 171 because the design cannot be said to be dictated by its function. A key head can operate without having the same overall appearance as the key head claimed in figure 1A. Unquestionably, the key head could take on different appearances (a lion head? a different looking monkey head?).

Similarly, in figure 1B, where the combination of the key head and key blade are claimed, the overall claimed combination also cannot be said to be dictated solely by function. Here again, by modifying at least the shape of the key head, the overall appearance of the claimed combination is also necessarily modified.

In figure 1C, however, where *only* the key blade is claimed, there may be no alternative designs for this claimed portion. Assuming that the key blade is intended to access a specific key hole, and that no alternative appearances could achieve that function, the claimed design will not satisfy the ornamental requirement of § 171.

The results in each of these three examples are consistent with the legitimate policy concern of preventing the use of design patents to protect functional ideas. Specifically, providing design patent protection to figure 1C would provide an impermissible monopoly over the key blade, if it can only exist in a single form.<sup>18</sup> In contrast, in figure 1B, when the ornamental key head is combined with the key blade, alternative designs for the key exist; any concerns about monopolizing the functional key blade are eliminated.

Once we better understand the multiplicity of forms approach, we can better focus our patent prosecution strategies to hedge against statutory functionality issues. For example, if design and utility applications are being filed on a single product, consider including figures showing alternative designs in the utility patent application, or even using more abstract block figures, rather than the same figures from the design patent application. When the identical design patent figures are used in the utility patent application, right or wrong, there is the potential unwanted appearance that everything in the design patent figures is tied to the functional considerations disclosed in the utility patent application. Note, if you do include alternative designs in your utility patent application figures, be aware that failure to prosecute those designs in separate design patent applications potentially could result in prosecution history estoppel.<sup>19</sup>

As a further example, if you are prosecuting a design patent application directed at an isolated portion of a product that may be questionably ornamental (e.g., a key blade), consider prosecuting *additional* claims where that subject matter is bundled with other portions of the article of manufacture that are decidedly more “ornamental” (see fig. 1B). Again, the operative question for statutory functionality is whether the *overall appearance* is dictated by its function, not the functionality of individual elements of the claimed design. As a crude rule of thumb, the more you claim (in solid lines), the greater chance you have to overcome a statutory functionality challenge.

Because design patents are only entitled to one claim, this multiclaim approach may necessitate filing multiple patent applications (unless the varying claim scopes are considered patentably indistinct and can be maintained in the same application). However, to achieve a strategic and effective design patent portfolio, design patent applicants should not shy away from filing multiple applications. (i.e., multiple claims). Ask yourself, how often have you have seen a one-claim *utility* patent? The answer is most likely rarely, if ever. One of the main reasons for having multiple claims in utility patents is that they hedge against the inherent difficulties in predicting *ex ante* the contours of the prior art (for validity) and nuances of accused products (for infringement). This same multiclaim approach should be employed for an effective design patent prosecution strategy, and also to hedge against findings of lack of ornamentality.

In sum, with respect to statutory functionality, the nomenclature used in the case law has facially drifted away from the statute's express language. But, that drift can be righted by the Federal Circuit making clear that the prevailing multiplicity of forms approach should be employed exclusively.

This approach (1) stays true to the language of the statute and spirit of a subject matter eligibility provision, (2) adequately safeguards against using design patents to monopolize functional ideas, and (3) brings reasonable and desirable certainty to an otherwise grey area of the law. The Federal Circuit looks to have charted the right course.

### Claim Construction Functionality: Lost at Sea but Land in Sight

The second context where the issue of functionality enters design patent jurisprudence has been in the area of claim construction. Thanks to express guidance from § 171 and the *Bonito Boats* Court, statutory functionality jurisprudence fairly speaking has stayed on target coalescing around a single (sensible) approach—the multiplicity of forms approach. In contrast, claim construction functionality is currently lost at sea.<sup>20</sup> A new course for claim construction functionality needs to be charted to properly realign the doctrine with its initial purpose.

Claim construction functionality is not solely an issue for infringement, despite the fact that it almost exclusively rears its head in that context. As we know from the more developed utility patent case law on claim construction, it is axiomatic that the same claim construction that is used for infringement also must be used for validity.<sup>21</sup> Thus, the doctrine of claim construction functionality has wide-reaching ramifications and thus the governing principles of its application must be well-defined. As explained herein, while there is currently great confusion in the jurisprudence on claim construction functionality, the good news is that rerouting the course is accomplishable through judicial clarification, rather than overruling precedent.

When employed correctly, claim construction functionality can be accomplished with adherence to the principle that design protection is directed to the overall *appearance* of the claimed design and further that such protection does not extend to any *functional attributes, concepts or characteristics* embodied in the claimed design. When employed incorrectly, instead of excepting *functional attributes, concepts or characteristics* from protection, courts often use claim construction to coarsely lop off *visual features, elements and portions* from the claimed design that are considered “functional.” The correct approach maintains the sanctity of the claimed design; the incorrect approach corrupts it. The Federal Circuit should provide clear guidance that while design patents do not protect *functional attributes, concepts or characteristics*, they do protect the overall claimed appearance, which is inclusive of all constituent *visual features, elements and portions*. No attempt should be made to factor out *visual features, elements and portions* of a claimed ornamental whole. Without this fundamental tenet firmly in place, design patent jurisprudence will continue to operate in a state of confusion.

By way of example, take the trunk<sup>22</sup> in figure 2 that includes a lock to secure the trunk’s lid. As a matter of claim construction, the fact that the trunk is lockable (i.e. a functional attribute) should be wholly irrelevant to the design patent claim’s scope of protection.

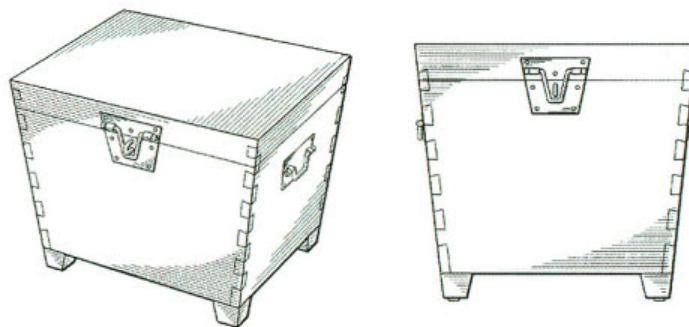


Figure 2

But while this functional attribute of the trunk should be of no moment, the lock’s depicted shape, size, and spatial relationship as it relates to the remainder of the trunk *is* claimed and thus part of the design’s scope of protection. This should be true even if the lock’s visual appearance were purely functional (which it is clearly not), because the depicted lock is but a portion of an ornamental claimed whole.<sup>23</sup> Regardless of whether the lock is functional or even purely functional, no attempt should be made to dissect out the *appearance* of the lock. Notably, with respect to utility patent claims, no effort is undertaken to identify and dissect out ornamental elements.<sup>24</sup> The same should be true with respect to design patents and functional elements—no effort should be made to identify and dissect out any functional elements. In both contexts, the patent protects the overall claim as issued, not the claim’s constituent elements in isolation. But yet this methodology, which I will refer to as the *point of ornamentality* approach, is precisely what many district courts have been doing as they attempt to identify and limit design patents to *ornamental design elements*.<sup>25</sup>

Design patent claim construction methodology that purports to separate functional and ornamental elements of the overall claimed design is wrongheaded. Like the now defunct point of novelty approach (which sought to separate out new and old elements),<sup>26</sup> the point of ornamentality approach (which seeks to separate out ornamental and functional elements) conflicts with the tenet that a design patent protects the overall appearance of the claimed design, and is fraught with logistical problems. Instead, claim construction functionality concerns could be addressed with an instruction to the fact-finder (whether judge or jury) that design patents only protect the *appearance* of the overall design depicted in the drawings, and not any *functional attributes, purposes or characteristics* embodied in the claimed design.

### Origins of Claim Construction Functionality Doctrine and Point of Ornamentality Approach

To understand the current state of confusion,<sup>27</sup> it is important to appreciate the historical evolution of the claim construction functionality doctrine and the point of ornamentality approach.<sup>28</sup>

#### Lee v. Dayton-Hudson (1988)

The origins of the claim construction functionality doctrine fairly can be traced back to the 1988 decision in *Lee v. Dayton-Hudson Corp.*<sup>29</sup> There, the plaintiff-patentee had secured a design patent on a hand-held massage device (see fig. 3). The plaintiff-patentee argued that his design patent covered “a massage device wherein an elongated handle has two opposing

balls at one end, and that the patent is perforce infringed by a massage device with that general configuration.”<sup>30</sup>

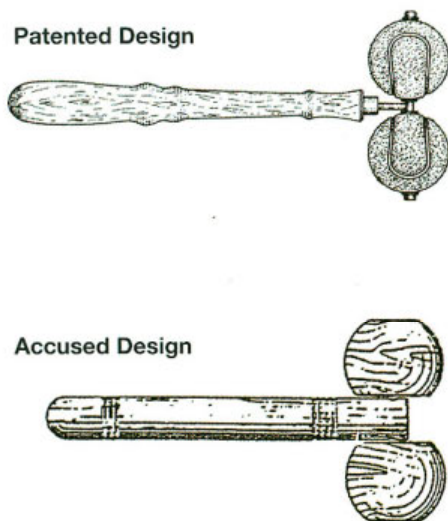


Figure 3

In explaining its holding of noninfringement, the Federal Circuit explained that the design patent did not protect the *general functional concept* of combining an elongated handle that has two opposing balls at one end to form a handheld massage device. It noted that infringement could not be premised upon the gross conceptual similarity between the patented and accused designs. The *Lee* Court concluded that “[d]esign patents do not and cannot include claims to the structural or functional aspects of the article.”<sup>31</sup> When placed in context, the *Lee* Court use of the term “aspects” refers to functional *attributes, purposes or characteristics*; it was not providing instructions to factor out *visual features, elements or portions of the overall claimed design*. Appropriately, the claimed design was limited to the specific expression of the functional concept as set forth in the patent drawings. Significantly, the court did not employ a point of ornamentality approach going through an element-by-element analysis for each component (i.e., “Is the handle functional?” “Are the massage balls functional?”). Thus, the core teaching of *Lee* is simple and straightforward: design patents do not protect general concepts; they protect appearances of a concept as specifically depicted in the design patent drawings. As will be shown below with later case law, however, the *Lee* Court’s use of the phrase “functional aspects” for functional *attributes, purposes or characteristics* soon drifted into meaning eliminating functional *features, elements or portions* of a claimed design. And from this word choice, the seeds for the point of ornamentality approach were sown.

#### Elmer v. ICC Fabricating (1995)

In *Elmer v. ICC Fabricating, Inc.*, it was the design patentee (not the accused infringer) who argued that two elements depicted in its design patent drawings for a vehicle sign, namely, lateral support ribs and an injection molding protrusion, should be factored out of the claim because the elements were “functional” (see fig. 4).<sup>32</sup>

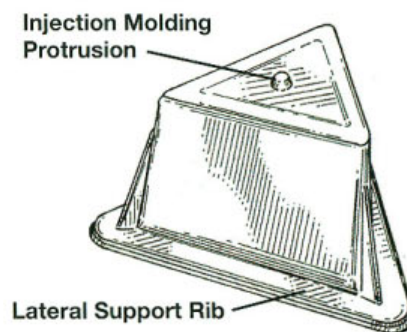


Figure 4

This was a convenient argument for the patentee because the accused product was missing these elements. Although it acknowledged the functional nature of these two elements, even pointing to detailed descriptions of the elements’ function in a corresponding utility patent, the Federal Circuit flatly rejected the argument that the design patent claim should be construed to factor out the appearance of these elements.<sup>33</sup> The court pointed out that the depicted elements could have been disclaimed from the claimed design during prosecution had they been reduced to dotted lines. Instead, the elements were depicted in solid lines and thus contributed to, and were part of, the claimed *overall design*.<sup>34</sup> Thus, *Elmer* stays true to the notion that the claimed overall appearance, including all constituent elements, whether ornamental or functional, is what a design patent protects. The *Elmer* rightly rejected the temptation to tinker with the overall claimed design by factoring out so-called functional elements. Simply put, if an element is shown in solid lines it is part of the overall claimed design.

#### OddzOn Products v. Just Toyz (1997)

In *OddzOn Products, Inc. v. Just Toyz, Inc.*, however, the seeds for the point of ornamentality approach that were planted in *Lee* did take root.<sup>35</sup> Ambiguous usage of terms like “aspects,” “general features,” and “elements,” are mainly to blame. As shown in figure 5, *OddzOn* regarded a design patent directed to a football-shaped toy having a tailshaft and fins.

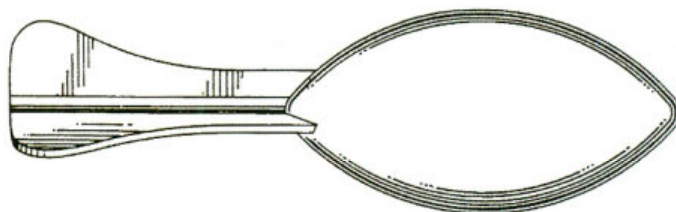


Figure 5

The Federal Circuit began its opinion by affirming the district court’s holding that the claimed design passed statutory functionality muster, as the claimed design’s overall appearance was not dictated solely by its function. In the context of discussing obviousness, and after noting the existence of several other alternative designs, the court sustained the validity of the patent:

Because the presence of a tailshaft and fins has been shown to be necessary to have a ball with similar aerodynamic stability to OddzOn's commercial embodiment, such *general features* are functional and thus not protectable as such. . . . The existence of prior art simply showing a ball with a tailshaft and fins, without more, is not sufficient to render the patented design obvious. . . . *Because none of the prior art cited by Just Toys exhibits ornamental characteristics that are the same as or similar to OddzOn's design*, we conclude that the district court did not err in holding that the cited references would not have rendered the patented design obvious.<sup>36</sup>

Up until this point, the opinion appears sound as it excludes from protection "general features" of the design (i.e. attributes, purposes or characteristics). Then, in the context of infringement, the *OddzOn* court makes its crucial misstep by stating that "[a] design patent *only protects the novel, ornamental features* of the patented design."<sup>37</sup> The court followed up that statement by adding: "Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional *aspects* of the design as shown in the patent."<sup>38</sup>

Based on both its statutory functionality and nonobviousness holdings, it appears that the *OddzOn* court clearly appreciated the fundamental distinction between unprotectable functional *attributes* of a claimed design (e.g., the general concept of a football-shaped toy with tailshaft and fins), and protectable overall ornamental appearances (e.g., the specific overall claimed design which is shown in the patent figures). Note, in parts of the opinion, the court, citing *Lee*, rightly refers to the unprotectable functional attributes as "general features." However, the court later uses less qualified terms like "aspects" and "features." As a result of these word choices, courts since *OddzOn* as part of claim construction have been wrongly divvying up design patents into perceived ornamental and functional features, elements and portions.

Bluntly, no matter how many times it is repeated in the case law that "a design patent *only protects the novel, ornamental features* of the patented design," the *OddzOn* sound bite is still fundamentally wrong. It is unassailable that a design patent does not protect constituent elements of a claimed design, but rather protected the patented whole. Further, it is a truism that even if all constituent elements of a design are old, the overall appearance of the assemblage of those old elements can constitute a patentably novel design.<sup>39</sup> Similarly, even if all constituent elements of a design are functional (even purely functional), the overall appearance of the assemblage of those functional elements can constitute a patentably ornamental design. Because design patents protect the overall claimed appearance, the individual novelty or ornamentality of the design's elements are irrelevant. An element-by-element assessment of ornamentality is not needed and contrary to the governing principles of design law. The Federal Circuit can make this point clear by clarifying that the word choices "functional aspects" refers to functional *attributes, purposes or characteristics* and not visual *features, elements or portions* of a claimed design that possess functional *attributes, purposes or characteristics*.

## Egyptian Goddess v. Swisa (2008)

In *Egyptian Goddess, Inc. v. Swisa, Inc.*, the en banc Federal Circuit made great strides toward improving design patent jurisprudence by eliminating the problematic point of novelty test and laying down a general rule discouraging courts from issuing claim constructions that verbally describe design patent claims.<sup>40</sup> The specific issue of claim construction functionality was not before the en banc court and was not briefed by the parties or the many amici curiae. Nevertheless, in addressing the general issue of claim construction for design patents, the *Egyptian Goddess* court, quoting the poorly worded *OddzOn* passage, suggested ways a trial court might assist the fact finder on issues that bear on patent scope. One suggestion was to distinguish "between those features of the claimed design that are ornamental and those that are purely functional."<sup>41</sup> Apparently to track the stringent "dictated solely by" approach for statutory functionality, the en banc court inserted the modifier "purely" before the word "functional."<sup>42</sup> While this modifier logically should greatly reduce the amount of so-called functional elements that courts might identify and excise, by citing *OddzOn*, the problematic point of ornamentality approach, whether intentionally or not, was further engrained in the case law. Significantly, and despite the citation to *OddzOn*, the point of ornamentality approach was not employed in *Egyptian Goddess*. In the opinion, there was no effort to exclude from protection the appearance of features of the design patent's claimed design that possess functional attributes, such as the finger nail buffer's buffing pads, square cross-section, and hollow core.

## Richardson v. Stanley Works (2010)

A few years later, and picking up on the loose language of *OddzOn* and *Egyptian Goddess*, the Federal Circuit in *Richardson v. Stanley Works, Inc.* more directly addressed the claim construction functionality issue.<sup>43</sup> There, the plaintiff-patentee asserted that U.S. Patent No. D507,167 (the '167 patent) was infringed by certain Stanley carpentry tools (see fig. 6). After a bench trial, the district court found that none of the Stanley accused products<sup>44</sup> infringed the '167 patent.<sup>45</sup>

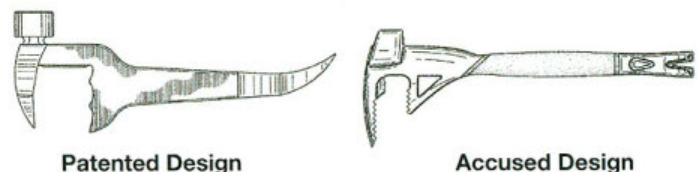


Figure 6

Similar to the holding in *Lee*, the district court, as part of claim construction, concluded that the '167 design patent did not provide a monopoly to the patentee for the general functional concept of combining a hammer-head, jaw, handle, and crow-bar in a single tool. The district court did not eliminate any visual features from the claimed design. To the contrary, all visual features were maintained: "The '167 patent does protect the ornamental aspects of Richardson's design, which include, among other things, the standard shape of the hammer-head, the

diamond-shaped flare of the crow-bar and the top of the jaw, the rounded neck, the orientation of the crow-bar relative to the head of the tool, and the plain, undecorated handle.” Thus, the district court rejected a point of ornamentality approach.

On appeal, the Federal Circuit affirmed the district court’s claim construction and finding of noninfringement. In explaining its claim construction affirmance, the court used awkward language that some might interpret as endorsing the point of ornamentality approach. Citing *OddzOn* and *Egyptian Goddess*, the *Richardson* court held that as part of design patent claim construction, a court is required to “separate” a design patent’s overall design into “purely functional” elements and “ornamental” elements, and then “factor out” (or “discount”) the former as unprotectable portions of the claimed design.<sup>46</sup> Specifically, the *Richardson* court, as part of claim construction, stated: “Richardson’s multi-function tool comprises several elements that are driven purely by utility. As the district court noted, elements such as the handle, the hammerhead, the jaw, and the crowbar are dictated by their functional purpose” (see fig. 7).<sup>47</sup>

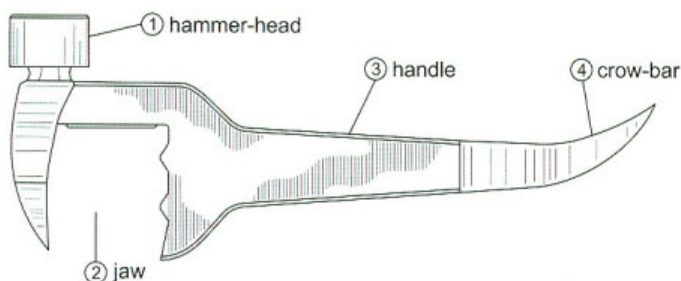


Figure 7

The *Richardson* court stated that these “purely functional” elements were properly “factored out” from the protected design as part of claim construction. On its face, the court’s conclusion could be interpreted as leading to a bizarre result. Visually, and using broken lines to depict the “factored out” elements of the design, it can be illustrated by figure 8 (beginning with the USPTO’s issued claim on the far left, and ending with the construed claim on the far right). Once factoring out is completed, it is entirely unclear what, if anything, is left. Using the point of ornamentality approach, the scope of the claim is altered to the point that it is effectively unenforceable. As explained below, this approach is wrongheaded.

By affirming the district court’s claim construction (which rejected a point of ornamentality approach), but then using words that seemingly endorse a point of ornamentality approach (and that contradict the district court’s opinion), the *Richardson* court ramped the confusion up to a fever-pitch.

### Point of Ornamentality Approach Should Be Abandoned

In an attempt to curb the cascade of the flawed case law, below are five reasons why the point of ornamentality approach should be abandoned.

#### It Is Inconsistent with the Principle That Design Protects Overall Appearances

One of the central holdings of *Egyptian Goddess* is that words are ill-equipped to describe design claims, and thus as a general rule verbal descriptions should not be used to define design claims. Instead, the drawings should control. The point of ornamentality approach, however, by requiring a verbal description of the claimed design’s protectable ornamental elements, runs directly afoul of this principle; the point of ornamentality approach sends us backward to a pre-*Egyptian Goddess* era where problematic verbal descriptions were the norm. Whether for defining the entire overall appearance as required pre-*Egyptian Goddess*, or for defining those elements deemed ornamental under the point of ornamentality approach, verbal descriptions of visual appearances is problematic.

Verbal descriptions risk placing undue emphasis on those listed elements rather than the overall appearance, which is subject matter of the right granted.<sup>48</sup> Further, the *Egyptian Goddess* court explained, Verbal descriptions are most often either too broad or too narrow to fully capture design. While words are at times capable of listing some, or even all, of the individual elements of the drawings, they are simply ill-suited for communicating the “controlling consideration” of a design patent claim—the overall appearance, including the relative and spatial relationships of each and every solid line in the claim.

Moreover, when verbalizations are employed to capture the claim and a list of elements is set forth, the verbalizations may inaccurately convey that the listed elements all have an equivalent effect on the eye. Even if the court were to include words to emphasize the relative predominance of certain elements of the design (i.e., major, minor, etc.), the court would be improperly substituting its perception for that of the trier of fact. In reality, depending on the fact finder, the eye may very well focus on certain elements of the drawings and minimize others. Thus, inasmuch as design patents are claimed with drawings, the only effective means by which to communicate each and every element of the claimed design are the drawings. The best description of the drawings is the drawings themselves.

As an overarching theme, design patent discourse should move away from element-by-element utility patent speak and

| D'167 as Issued | Hammer-head discarded as "functional" | Jaw discarded as "functional" | Handle discarded as "functional" | Crowbar discarded as "functional" | D'167 as construed |
|-----------------|---------------------------------------|-------------------------------|----------------------------------|-----------------------------------|--------------------|
|                 |                                       |                               |                                  |                                   |                    |

Figure 8

refocus on the actual protected right—the overall appearance of the claimed design. As the U.S. Court of Customs and Patent Appeals succinctly stated: “[A] design is a *unitary thing* and *all of its portions are material* in that they contribute to the appearance which constitutes the design.”<sup>49</sup>

Design, in the view of the patent law, is that characteristic of a physical substance which, by means of lines, images, configuration, and the like, taken as a whole, makes an impression, through the eye, upon the mind of the observer. *The essence of a design resides, not in the elements individually, nor in their method of arrangement, but in the tout ensemble—in that indefinable whole that awakens some sensation in the observer’s mind.* Impressions thus imparted may be complex or simple; in one a mingled impression of gracefulness and strength, in another the impression of strength alone. But whatever the impression, there is attached in the mind of the observer, to object observed, a sense of uniqueness and character.<sup>50</sup>

Thus, a design patent protects the *overall effect* of *all* of the depicted design elements, whether such elements are new or old, functional or ornamental, significant or insignificant.<sup>51</sup> Because it is the overall appearance that is protected, the traits and substance of any individual elements are irrelevant. It is a fallacy of the point of novelty approach that functional elements reside in isolation. To the contrary, the visual appearance of every functional element impacts, and interacts with, the remainder of the design.

That a particular portion of a design is functional, even if purely functional, should not matter. Protection should extend to the entire overall appearance (including all contributing elements), so long as the *overall appearance* is not purely functional (i.e., “ornamental”). Indeed, the combination of two functional elements, even two purely functional elements, can yield an ornamental design; ornamentality can reside in the spatial relationships of the elements, the relative sizes of the elements, etc. Whether speaking of infringement or validity, what counts in design patent law is the *overall appearance* of the claimed design. The point of ornamentality approach, by limiting a claimed design to specific elements, runs afoul of this principle.

#### It Is Unworkable

Moreover, any attempt to dissect and separate an overall design into elements is unworkable. Most often, and particularly with modern day design, the elements of a design are fully integrated into, and inseparable from, the overall design, making fool’s errands of the point of ornamentality approach’s identification and excision steps. For example, consider a claim covering the ornamental handlebar depicted in figure 9.<sup>52</sup> The claimed design is an example of the seamless melding of form and function. While a court might go through the point of ornamentality exercise, the reality is that it is impossible to meaningfully identify and surgically separate ornamental and functional elements.<sup>53</sup> In short, factoring out and ignoring functional portions is an artificial enterprise that not only can distort the claimed design, but also, practically speaking, is an unworkable approach.

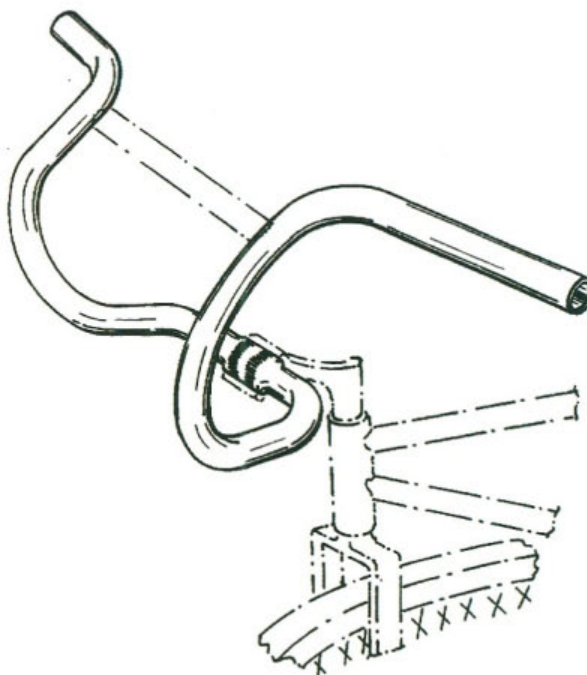


Figure 9

#### It Undermines the Statutory Presumption of Validity

Factoring out functional elements of a claimed design risks undermining both the validity and enforceability of design patents. Once a design patent application emerges from USPTO examination, an issued design patent enjoys a presumption of validity, just like any other patent.<sup>54</sup>

As initial matter, at the USPTO, the patentability determination for a claimed design is premised solely on the *overall appearance* of the depicted design.<sup>55</sup> Yet, the presumption of validity and its underpinnings easily fall apart under the point of ornamentality approach because a judicially construed claim (with portions of the whole “factored out”) may be fundamentally different from the claim examined and issued by the USPTO. This conflict can be illustrated with a simple example (see fig. 10).

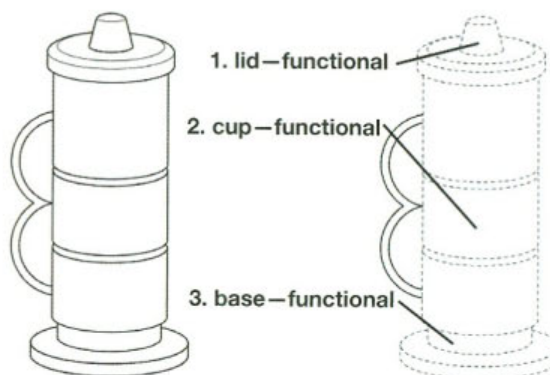


Figure 10

Assume that the image on the left is the design examined during prosecution and ultimately issued as the patented design. During prosecution, the USPTO examines *only the overall appearance* of the design. During claim construction under the point of ornamentality approach, assume a district

court determines that certain elements are “functional” and thus must be “factored out.” For example, those elements might be the (1) lid, (2) cup, and (3) support base. (See the image on the right with deemed “functional” elements shown in broken lines.) With only the handle remaining after claim construction, questions regarding the patent’s validity abound. Has the claim been inadvertently broadened? Is just the remaining handle itself novel? Nonobvious? Ornamental? Should the presumption of validity apply to a construed claim that has so little resemblance to the claim that was before the USPTO? Keep in mind that the USPTO only examined the *overall appearance* of the entire depicted design for patentability, not just the handle in isolation. This potential disparity in claim scope irreconcilably upsets the presumption of validity and its underpinnings. For this reason alone, the point of ornamentality approach should be abandoned.

#### *It Provides for Unwanted Piecemeal Invalidity Attacks*

Taken to its logical conclusion, the point of ornamentality approach could yield a result where, upon claim construction, each and every individual element of the design patent is found to be “functional.” For instance, and continuing with the same cup example above, what if the district court concludes that the handle is functional as well? Under these facts, the claim is whittled away to nothing, effectively neutering the enforceability of an issued design patent *without an invalidity challenge ever having been mounted*.

Of course, invalidity challenges are confronted with the demanding safeguards that cloak a presumptively valid design patent, including most importantly the “clear and convincing” evidence standard.<sup>56</sup> The point of ornamentality approach provides an unwanted backdoor validity attack made under the guise of claim construction where the lesser preponderance evidentiary standard applies.

#### *It Takes the Issue Away from the Fact Finder*

Whether in the context of infringement or validity, it is the responsibility of the fact finder, not the court through claim construction, to discount the functional attribute, purpose or characteristic of the claimed design.<sup>57</sup> Placing the analysis with the fact finder is consistent with the Federal Circuit’s holdings on the issue of statutory functionality. The Federal Circuit has consistently held that the issue of statutory functionality is a question of fact.<sup>58</sup> In short, all issues regarding functionality properly reside with the fact finder, not the court as part of claim construction.<sup>59</sup>

### **Conclusion**

Statutory functionality and claim construction functionality are distinct doctrines directed at different objectives that need to be clearly defined for an effective and reliable design patent system.

For statutory functionality, the prevailing multiplicity of forms approach (1) stays true to the language of the statute and spirit of a subject matter eligibility provision, (2) adequately safeguards against using design patents to monopolize functional ideas, and (3) brings reasonable and desirable certainty to an otherwise grey area of the law. To bring even more

certainty to the issue, the Federal Circuit should confirm that this test should be used on an exclusive basis.

With respect to claim construction functionality, the point of ornamentality approach is unnecessary, fatally flawed and should be abandoned. The solution is to provide clear authority that design patents do not protect the functional attributes, purposes or characteristics of an article of manufacture, but rather only protect the overall appearance of the claimed design depicted in the drawings. Courts should not as part of claim construction attempt to identify and factor out functional features, elements or portions of the ornamental whole design. ■

### **Endnotes**

1. Contrast the design patent law’s positive requirement that the claimed design be “ornamental” with trademark law’s negative requirement that the mark be “nonfunctional.” See Elizabeth W. King, *The Trademark Functionality Doctrine*, LANDSLIDE, Sept./Oct. 2012, at 20.
2. See *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997) (“[T]he fact that the article of manufacture serves a function is a prerequisite of design patentability, not a defeat thereof. The function of the article itself must not be confused with ‘functionality’ of the design of the article.” (citing *Avia Grp. Int’l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988) (distinguishing the functionality of the feature from the design of the feature))).
3. *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124, 131 (2001) (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 315 (1980)).
4. 489 U.S. 141, 148 (1989) (emphasis added).
5. See, e.g., *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997); *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563 (Fed. Cir. 1996); *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186 (Fed. Cir. 1988); *Seiko Epson Corp. v. Nu-Kote Int’l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999) (“The ornamental requirement of the design statute means that the design must not be governed solely by function.”)
6. See *Hupp*, 122 F.3d at 1460 (“A design or shape that is entirely functional, without ornamental or decorative aspect, does not meet the statutory criteria of a design patent.”).
7. See *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997) (dicta); *PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1366 (Fed. Cir. 2006) (quoting *Berry Sterling*); *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1316 (Fed. Cir. 2013) (citing *Berry Sterling* and *PHG Techs.*).
8. *Berry Sterling*, 122 F.3d at 1456; see also *Cheng v. AIM Sports, Inc.*, No. CV 10-3814 PSG (PLAx), 2011 U.S. Dist. LEXIS 42462 (C.D. Cal. Apr. 14, 2011).
9. Pursuant to the Patent Law Treaties Implementation Act of 2012, which became effective December 18, 2013, once the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs goes into effect in late 2014 or early 2015, the term for U.S. design patents will be increased from 14 years to 15 years.
10. *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002). While the more recent proclamation by *Rosco* uses a stringent test (i.e., “not the only possible form”), the Federal Circuit at times has articulated a slightly less rigid standard: “When there are several ways to achieve the function of an article of manufacture,

the design of the article is more likely to serve a primarily ornamental purpose.” *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (emphasis added) (holding design for shoes was ornamental when there were other ways to perform the function of the shoe). While both the *Rosco* and *L.A. Gear* articulations look to the existence of alternative designs as the tell-tale sign of ornamentality, the *Rosco* approach guards against monopolizing a functional idea via design patent, while the *L.A. Gear* approach guards against oligopolizing a functional idea via design patent. Regardless of what minimum threshold of alternative designs is used, the test for ornamentality is quite permissive.

11. *Rosco*, 304 F.3d at 1378 (alteration in original) (emphasis added) (citations omitted) (internal quotation marks omitted); see also, *Seiko*, 190 F.3d at 1368 (stating that a design is functional if it is “the only possible form of the article that could perform its function.”)

12. The multiplicity of forms theory has been followed by at least German, English, French, and Spanish courts. See Adolf Zemmann, *Functional Designs and Trademarks—Limits to the Scope of Protection*, ROADMAP 13, <http://roadmap2013.schoenherr.eu/functional-designs-and-trademarks/> (last visited Sept. 4, 2014).

13. The same can be said for many seemingly “functional” items that are the subject matter of issued design patents. See, e.g., *Tone Bros. v. Sysco Corp.*, 28 F.3d 1192 (Fed. Cir. 1994) (bottle for spices); *KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444 (Fed. Cir. 1993) (concrete block for retaining wall); *In re Klein*, 987 F.2d 1569 (Fed. Cir. 1993) (roof or siding shingle); *In re Webb*, 916 F.2d 1553 (Fed. Cir. 1990) (femoral hip stem prosthesis); *In re Cho*, 813 F.2d 378 (Fed. Cir. 1987) (bottle cap); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984) (microwave oven); *In re Koehring*, 37 F.2d 421 (C.C.P.A. 1930) (concrete mixing truck).

14. See *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563 (Fed. Cir. 1996) (holding that design patent directed at the overall appearance of a key blade was not ornamental and thus the patent was invalid under § 171). Notably, *Best Lock* was a 2–1 panel decision. Judge Newman penned a provocative dissenting opinion challenging the majority’s conclusion that the key blade design was dictated by its function: “[T]he panel majority has misapplied 35 U.S.C. § 171 in holding that the arbitrary design of the key profile is ‘functional’ because it mates with its matching keyway. The design of the key profile is not removed from access to the design statute because the key fits a matching keyway. That two articles are designed in harmony does not deprive the design of access to the design patent law. The design of the key profile is not determined by the function of the key to fit the lock.” *Best Lock*, 943 F.3d at 1567 (Newman, J., dissenting).

15. See, e.g., *Seiko*, 190 F.3d at 1368 (stating that to pass statutory muster a design need not “be aesthetically pleasing”; “an absence of artistic merit does not mean that the design is purely functional”).

16. See, e.g., *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (“[T]his court will uphold a finding of infringement. In other words, the deception that arises is a result of the similarities in the overall design, not of similarities in ornamental features in isolation. The ordinary observer test applies to the patented design in its entirety, as it is claimed.” (citations omitted) (internal quotation marks omitted) (citing *Braun, Inc. v. Dynamics*

*Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992))). Contrast this holistic approach with copyright law where, for example, there can be infringement when only one chapter of a 20 chapter book is copied.

17. See, e.g., *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (“However, the utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.”).

18. Whether there are alternative designs available often hinges on how broadly or narrowly the function of the article of manufacture is defined. Here, if it is assumed that the key must engage a specific keyhole, it may very well be that the key blade can take only one form. (i.e. its form is dictated solely by its function). However, if the depicted key’s function was to serve as child’s toy, then there could be myriad design alternatives to choose from.

19. *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014) (“We conclude that the principles of prosecution history estoppel apply to design patents as well as utility patents.”)

20. See *DePaoli v. Daisy Mfg. Co.*, No. 07-cv-11778-DPW, 2009 U.S. Dist. LEXIS 62057, at \*8–9 (D. Mass. July 14, 2009) (“It is not entirely apparent from this passage whether the Federal Circuit advocates resolving prosecution history and functionality issues through formal *Markman* claim construction, jury instructions, or some other means. On the one hand, the court refers to ‘guid[ing] the finder of fact’ in a manner ‘[a]part from attempting to provide a verbal description of the design,’ which suggests jury instructions may be the best avenue. On the other hand, the court’s parenthetical quotation from *OddzOn* suggests that these issues, or at least the question of functionality, may properly be addressed during claim construction.” (alterations in original) (citation omitted) (quoting *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc))).

21. See, e.g., *Source Search Techs., LLC v. LendingTree, LLC*, 588 F.3d 1063, 1075 (Fed. Cir. 2009) (“As this court has repeatedly instructed in the past, ‘[i]t is axiomatic that claims are construed the same way for both invalidity and infringement.’” (quoting *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003))).

22. U.S. Patent No. D430,753 figs. 1–2 (filed Jan. 8, 1999).

23. See *Good Sportsman Mktg. LLC v. Li & Fung Ltd.*, No. 6:07-cv-395, 2010 U.S. Dist. LEXIS 65458 (E.D. Tex. June 29, 2010) (“The utility of individual elements is irrelevant to the question of functionality, as it is the design in its entirety that provides the basis for the patent.”).

24. Consider a utility patent claim directed at a resealable container where, among other things, the base is claimed to be cylindrical and the lid frustoconical. While the combination of the claimed shapes of the base and lid yield an ornamental appearance, no attempt is made in the utility patent context to factor out these constituent elements, regardless as to whether they are ornamental or purely ornamental. The same should hold true for design patent claim construction as it related to functional or purely functional elements.

25. For examples where the courts fell into the point of ornamentality trap, see *Poly-America, L.P. v. API Indus., Inc.*, No. 13-693-SLR, 2014 U.S. Dist. LEXIS 49618, at \*3 (D. Del. Apr. 10, 2014) (“[W]here a design contains both ornamental and functional features, it is proper to separate the functional and ornamental aspects because the scope of the design claim must be construed in order to identify the non-functional aspects of the design as shown in the patent. . . . [T]o the extent the . . . features identified above are considered functional, they should not be considered design elements that would be observed by the ordinary observer.” (internal quotation marks omitted)); *Keurig, Inc. v. JBR, Inc.*, No. 11-11941-FDS, 2013 U.S. Dist. LEXIS 73845, at \*22 (D. Mass. May 24, 2013) (dissecting out a “functional aspect of the patented design” and concluding that it “cannot be considered in the [infringement] comparison”); *Safco Prods. Co. v. Welcom Prods., Inc.*, 799 F. Supp. 2d 967, 977 (D. Minn. 2011) (articulating list of ornamental features); *Mag Instrument, Inc. v. JS Prods., Inc.*, 595 F. Supp. 2d 1102, 1108 (C.D. Cal. 2008) (“Assuming, for the sake of argument, that Plaintiff’s [patents] contain both functional and non-functional elements, the Court, in the usual course of issuing a claim construction order, will construe the challenged claims to identify the non-functional aspects of the design as shown in the patent.” (internal quotation marks omitted)); *Hsin Ten Enter. USA, Inc. v. Clark Enters.*, 149 F. Supp. 2d 60, 64–66 (S.D.N.Y. 2001) (making “determination of whether each element of the . . . patent is functional or non-functional”); *Butler v. Balkamp, Inc.*, 2014 U.S. Dist. LEXIS 122464, at \*4-5 (S.D. Ind. Sept. 3, 2014) (“[T]he ‘646 patent does not protect either the front or rear square drives of the tool handle because those aspects of the design are purely functional.”)

26. *Egyptian Goddess*, 543 F.3d 665 (abrogating the point of novelty test).

27. As an example of the confusion, in 2006 the Federal Circuit in *Amini Innovation Corp. v. Anthony California, Inc.*, quoted a Supreme Court trademark case as support for the legal principles governing design patent functionality. 439 F.3d 1365, 1371 (Fed. Cir. 2006) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 (1982)). While the Federal Circuit has never repeated this obvious mistake, district courts have picked up on the language and perpetuated the gaffe. See *Keurig*, 2013 U.S. Dist. LEXIS 73845, at \*19 (“[T]he Federal Circuit defined functionality in the context of design patent interpretation. . . . [holding] ‘[a]n aspect is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’” (quoting *Inwood Labs*, 456 U.S. at 850 n.10)); *Luv N’ Care, Ltd. v. Regent Baby Prods. Corp.*, 898 F. Supp. 2d 650, 654 (S.D.N.Y. 2012) (“An aspect is functional ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’” (quoting *Amini*, 439 F.3d at 1371)).

28. See Jason J. DuMont & Mark D. Janis, *Functionality in Design Protection Systems*, 19 J. INTELL. PROP. L. 261 (2012); Frederick L. Medlin, *Functionality of Individual Features in Design Patents: A New Role after Egyptian Goddess*, 77 PAT. TRADEMARK & COPYRIGHT J. (BNA) 139 (2008); Perry J. Saidman, *Functionality and Design Patent Validity and Infringement*, 91 J. PAT. & TRADEMARK OFF. SOC’Y 313 (2009); Perry J. Saidman & John Hintz, *The Doctrine of Functionality in Design Patent Cases*, 19 U. BALT. L. REV. 352 (1989); Robert G. Oake, *Understanding Functionality in Design Patent Law*, INTELL. PROP. TODAY, Oct. 2011.

29. 838 F.2d 1186 (Fed. Cir. 1988).

30. *Id.* at 1188.

31. *Id.*

32. 67 F.3d 1571 (Fed. Cir. 1995) (Lourie, J.).

33. *Id.* at 1577.

34. *Id.* (holding that the patentee “effectively limited the scope of its patent claim by including those [functional] features in it”).

35. 122 F.3d 1396 (Fed. Cir. 1997) (Lourie, J.).

36. *Id.* at 1404 (emphasis added).

37. *Id.* at 1405 (emphasis added).

38. *Id.* (emphasis added) (citing *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988)). Note that identifying the non-functional elements of a design is no different than verbalizing the entire claimed design – a practice later expressly counseled against by the en banc Federal Circuit in *Egyptian Goddess*. See *Egyptian Goddess*, 543 F.3d at 679–80.

39. The United States Patent and Trademark Office (USPTO) has long granted design patents for novel combinations of old elements that create a nonobvious, ornamental visual appearance. See, e.g., *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 679 (1893) (“If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty and the result is in effect a new creation, the design may be patentable.”); *Gen. Gaslight Co. v. Matchless Mfg. Co.*, 129 F. 137, 138 (2d Cir. 1904) (“[T]he principle, as applied to design patents, is *unassailable* that whenever ingenuity is displayed in producing something new, which imparts to the eye a pleasing impression, *even though it be the result of uniting old forms and parts*, such production is a meritorious invention and entitled to protections.” (emphases added)); see also *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1443 (Fed. Cir. 1984).

40. 543 F.3d 665 (Fed. Cir. 2008) (en banc); see Perry J. Saidman, *What Is the Point of the Point of Novelty Test for Design Patent Infringement?*, 90 J. PAT. & TRADEMARK OFF. SOC’Y 401 (2008) (discussing the systemic problems with the point of novelty test and the implications of *Egyptian Goddess*).

41. *Egyptian Goddess*, 543 F.3d at 680 (citing *OddzOn*, 122 F.3d at 1405).

42. The Federal Circuit has never provided guidance on what it means by “purely functional” features. See *ATI Indus. Automation, Inc. v. Applied Robotics, Inc.*, No. 1:09CV471, 2014 U.S. Dist. LEXIS 101413, at \*3 n.3 (M.D.N.C. July 25, 2014) (“The Federal Circuit has used the language ‘dictated solely by function’ (or ‘governed solely by function’) in considering whether patented designs as a whole qualify as invalid as functional, but it has not applied the term when considering individual elements of a design.”). Given the absolute nature of “purely functional,” it would seem to reconcile with the “dictated solely by” standard. In other words, the “dictated solely by” standard that is employed to assess the overall appearance in statutory functionality (macro context) would also be used on an element-by-element approach in claim construction functionality (micro context). To be clear, while use of this strict standard in an element-by-element analysis might help to contain the reach of the problematic point of ornamentality approach, my proposal as explained herein is to completely refrain from element-by-element analyses.

43. *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288 (Fed. Cir. 2010).

44. U.S. Patent No. D507,167 fig. 2 (filed Jan. 9, 2004).

45. U.S. Patent No. D562,101 fig. 5 (filed Mar. 29, 2006).

46. *Richardson*, 597 F.3d at 1292–94.

47. *Id.* at 1294. In comparison to the Federal Circuit, the district court in *Richardson* painted with a much finer brush when opining on claim construction functionality. Specifically, district court excluded only the overall *configuration* of the handle, hammer-head, jaw, and crow-bar. *Richardson v. Stanley Works, Inc.*, 610 F. Supp. 2d 1046, 1050 (D. Ariz. 2009). (“The overall configuration of these four elements is dictated by the functional purpose of the tool and therefore is not protected by his design patent.”) The district courts approach is also problematic in that it fails to appreciate that the overall configuration is part and parcel with the overall design. The spatial relationships of the constituent elements, along with their individual shapes and aspect ratios, collectively produce the design. It is entirely unclear how an overall configuration can be dissected out while leaving anything meaningful behind.

48. See *Carlini Enters., Inc. v. Paul Yaffe Design, Inc.*, No. 8:13-cv-01671-ODW(RNBx), 2014 U.S. Dist. LEXIS 113941, at \*3 (C.D. Cal. Aug. 15, 2014) (“Yet, the task of distinguishing the ornamental features from the functional ones must be tempered—a detailed verbal description of the claimed design may place an undue emphasis on particular features of the design and may hinder examination of the design as a whole.” (citing *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1302 (Fed. Cir. 2010))); *DePaoli v. Daisy Mfg. Co.*, No. 07-cv-11778-DPW, 2009 U.S. Dist. LEXIS 62057, at \*14 (D. Mass. July 14, 2009) (“To provide the jury with a verbalized construction of the . . . design patent’s claims which directs their attention to the two illustrations in the patent and then describes only those elements that are implicated by prosecution history and functionality would place undue emphasis on those few elements. This is precisely the danger against which the *Egyptian Goddess* court cautioned.”).

49. *In re Blum*, 374 F.2d 904, 907 (C.C.P.A. 1967) (emphasis added); see also *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (holding that all solid lines shown in design patent drawings form part of the claimed design).

50. *Pelouze Scale Co. v. Am. Cutlery Co.*, 102 F. 916, 918–19 (7th Cir. 1900) (emphasis added).

51. See *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1246 (Fed. Cir. 2009) (Clevenger, J., dissenting) (criticizing the majority for its “dissection of designs into component parts,” namely “significant” and “insignificant” elements, and noting that such dissections “prohibit assessment of designs as a whole, in violation of long-standing law, starting with *Gorham*”).

52. U.S. Patent No. D387,316 fig. 1 (filed May 29, 1996).

53. See *Carlini Enters.*, 2014 U.S. Dist. LEXIS 113941 (noting logistical difficulties in trying to separate out ornamental and functional elements in an overall design).

54. See 35 U.S.C. § 282.

55. See U.S. PATENT & TRADEMARK OFFICE, MANUAL OF

PATENT EXAMINING PROCEDURE (MPEP) § 1503.02 (9th ed. Mar. 2014) (“When the inconsistencies are of such magnitude that the *overall appearance* of the design is unclear, the claim should be rejected under 35 U.S.C. 112(a) and (b).” (emphasis added)); *id.* § 1504.01(c) (“ornamentality must be based on the *entire design*” (emphasis added)); *id.* § 1504.03 (“In determining patentability under 35 U.S.C. § 103(a), it is the *overall appearance* of the design that must be considered.” (emphasis added)).

56. See, e.g., *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (requiring clear and convincing evidence to invalidate design patent on grounds of functionality, and further noting that 35 U.S.C. § 282 includes a presumption of ornamentality).

57. See *DePaoli v. Daisy Mfg. Co.*, No. 07-cv-11778-DPW, 2009 U.S. Dist. LEXIS 62057, at \*26–27 (D. Mass. July 14, 2009) (noting the confusion created by *Richardson* and *Egyptian Goddess* couching inquiry of functionality of individual features in claim construction as a matter of law) (“Such a construction clearly must occur prior to determining infringement. However, given that functionality is a finding of fact, it may be more reasonable to determine the claim construction on summary judgment or in jury instructions than to attempt it earlier in the proceedings.”); *Dexas Int’l, Ltd. v. Office Max, Inc.*, No. 6:07-cv-396, 2009 U.S. Dist. LEXIS 6642 (E.D. Tex. Jan. 30, 2009) (noting that both statutory functionality and claim construction functionality are questions of fact) (“While the Court adopts the aforementioned construction, the Court expresses no opinion as to whether the patented design incorporates functional elements. ‘Whether a patented design is functional or ornamental is a question of fact.’” (quoting *PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1365 (Fed. Cir. 2006))).

58. See, e.g., *PHG Techs.*, 469 F.3d at 1365 (statutory functionality is a question of fact); *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460–61 (Fed. Cir. 1997) (same); *Avia Grp. Int’l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988) (same).

59. While the point of ornamentality approach should not be employed at all, it is interesting to note that several courts have removed the inquiry from the confines of claim construction and ceded the responsibility of determining whether a feature is ornamental or functional to the fact finder. See, e.g., *PHG Techs.*, 469 F.3d at 1365; *Hupp*, 122 F.3d at 1467; *Sofpool, LLC v. Intex Recreation Corp.*, No. 2:07-CV-097, 2007 U.S. Dist. LEXIS 93057, at \*5 (E.D. Tex. Dec. 19, 2007) (whether element of design is functional is a question of fact for jury); *Five Star Mfg., Inc. v. Ramp Lite Mfg., Inc.*, 44 F. Supp. 2d 1149, 1155 (D. Kan. 1999) (“[W]hether the features of a design are functional or ornamental is an issue of fact.”); *Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc.*, No. 97-1123-A, 1998 U.S. Dist. LEXIS 9162, at \*15 (E.D. Va. June 2, 1998) (“[T]he Court will leave the question of whether certain elements of the . . . design patent are functional to the jury.”).