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Design

A Copyright

Copyright Act

17 U.S.C. § 101 - *Definitions*

“Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

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”.

Brandir Intern., Inc. v. Cascade Pacific Lumber Co.

834 F.2d 1142 (2d Cir. 1987)

OAKES, Circuit Judge:

In passing the Copyright Act of 1976 Congress attempted to distinguish between protectable “works of applied art” and “industrial designs not subject to copyright protection.” See H.R.Rep. No. 1476, 94th Cong., 2d Sess. 54, reprinted in 1976 U.S.Code Cong. & Admin.News 5659, 5667 (hereinafter H.R.Rep. No. 1476). The

courts, however, have had difficulty framing tests by which the fine line establishing what is and what is not copyrightable can be drawn. Once again we are called upon to draw such a line, this time in a case involving the “RIBBON Rack,” a bicycle rack made of bent tubing that is said to have originated from a wire sculpture. (A photograph of the rack is contained in the appendix to this opinion.) We are also called upon to determine whether there is any trademark protection available to the manufacturer of the bicycle rack, appellant Brandir International, Inc. The Register of Copyright, named as a third-party defendant under the statute, 17 U.S.C. § 411, but electing not to appear, denied copyrightability. In the subsequent suit brought in the United States District Court for the Southern District of New York, Charles S. Haight, Jr., Judge, the district court granted summary judgment on both the copyright and trademark claims to defendant Cascade Pacific Lumber Co., d/b/a Columbia Cascade Co., manufacturer of a similar bicycle rack. We affirm as to the copyright claim, but reverse and remand as to the trademark



claim.

Against the history of copyright protection well set out in the majority opinion in *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 415-18 (2d Cir.1985), and in *Denicola*, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 *Minn.L.Rev.* 707, 709-17 (1983), Congress adopted the Copyright Act of 1976. The “works of art” classification of the Copyright Act of 1909 was omitted and replaced by reference to “pictorial, graphic, and sculptural works,” 17 U.S.C. § 102(a)(5). According to the House Report, the new category was intended to supply “as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.” H.R.Rep. No. 1476, at 55, *U.S.Code Cong. & Admin.News* 1976, p. 5668. The statutory definition of “pictorial, graphic, and sculptural works” states that “the design of a useful article, as

defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U.S.C. § 101.¹ The legislative history added gloss on the criteria of separate identity and independent existence in saying:

On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.

H.R.Rep. No. 1476, at 55, U.S.Code Cong. & Admin.News 1976, p. 5668.

As courts and commentators have come to realize, however, the line Congress attempted to draw between copyrightable art and noncopyrightable design “was neither clear nor new.” Denicola, *supra*, 67 Minn.L.Rev. at 720. One aspect of the distinction that has drawn considerable attention is the reference in the House Report to “physically or conceptually” (emphasis added) separable elements. The District of Columbia Circuit in *Esquire, Inc. v. Ringer*, 591 F.2d 796, 803-04 (D.C.Cir.1978) (holding outdoor lighting fixtures ineligible for copyright), cert. denied, 440 U.S. 908, 99 S.Ct. 1217, 59 L.Ed.2d 456 (1979), called this an “isolated reference” and



gave it no significance.

Professor Nimmer, however, seemed to favor the observations of Judge Harold Leventhal in his concurrence in *Esquire*, who stated that “the overall legislative policy ... sustains the Copyright Office in its effort to distinguish between the instances where the aesthetic element is conceptually severable and the instances where the aesthetic element is inextricably interwoven with the utilitarian aspect of the article.” 591 F.2d at 807; see 1 Nimmer

¹The statute also defines “useful article” as one “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.’” 17 U.S.C. § 101.

on Copyright § 2.08[B] at 2-93 to 2-96.2 (1986). But see Gerber, Book Review, 26 U.C.L.A.L.Rev. 925, 938-43 (1979) (criticizing Professor Nimmer's view on conceptual separability). Looking to the section 101 definition of works of artistic craftsmanship requiring that artistic features be "capable of existing independently of the utilitarian aspects," Professor Nimmer queries whether that requires physical as distinguished from conceptual separability, but answers his query by saying "[t]here is reason to conclude that it does not." See 1 Nimmer on Copyright § 2.08[B] at 2-96.1. In any event, in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir.1980), this court accepted the idea that copyrightability can adhere in the "conceptual" separation of an artistic element. Indeed, the court went on to find such conceptual separation in reference to ornate belt buckles that could be and were worn separately as jewelry. *Kieselstein-Cord* was followed in *Norris Industries, Inc. v. International Telephone & Telegraph Corp.*, 696 F.2d 918, 923-24 (11th Cir.), cert. denied, 464 U.S. 818, 104 S.Ct. 78, 78 L.Ed.2d 89 (1983), although there the court upheld the Register's refusal to register automobile wire wheel covers, finding no "conceptually separable" work of art. See also *Transworld Mfg. Corp. v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95 (D.Del.1982) (finding conceptual separability sufficient to support copyright in denying summary judgment on copyrightability of eyeglass display cases).

In *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir.1985), a divided panel of this circuit affirmed a district court grant of summary judgment of noncopyrightability of four life-sized, anatomically correct human torso forms. Carol Barnhart distinguished *Kieselstein-Cord*, but it surely did not overrule it. The distinction made was that the ornamented surfaces of the *Kieselstein-Cord* belt buckles "were not in any respect required by their utilitarian functions," but the features claimed to be aesthetic or artistic in the Carol Barnhart forms were "inextricably intertwined with the utilitarian feature, the display of clothes." 773 F.2d at 419. But cf. *Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F.Supp. 175, 186-88 (D.Minn.1985) (holding bear-paw design conceptually separable from the utilitarian features of a slipper), aff'd mem., 794 F.2d 678 (8th Cir.1986). As Judge Newman's dissent made clear, the Carol Barnhart majority did not dispute "that 'conceptual separability' is distinct from 'physical separability' and, when present, entitles the creator of a useful article to a copyright on its design." 773 F.2d at 420.

"Conceptual separability" is thus alive and well, at least in this circuit. The problem, however, is determining exactly what it is and how it is to be applied. Judge Newman's illuminating discussion in dissent in *Carol Barnhart*, see 773 F.2d at 419-24, proposed a test that aesthetic features are conceptually separable if "the article ... stimulate[s] in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function." *Id.* at 422. This approach has received favorable endorsement by at least one commentator, W. Patry, Latman's *The Copyright Law*

43-45 (6th ed. 1986), who calls Judge Newman's test the "temporal displacement" test. It is to be distinguished from other possible ways in which conceptual separability can be tested, including whether the primary use is as a utilitarian article as opposed to an artistic work, whether the aesthetic aspects of the work can be said to be "primary," and whether the article is marketable as art, none of which is very satisfactory. But Judge Newman's test was rejected outright by the majority as "a standard so ethereal as to amount to a 'nontest' that would be extremely difficult, if not impossible, to administer or apply." 773 F.2d at 419 n. 5.

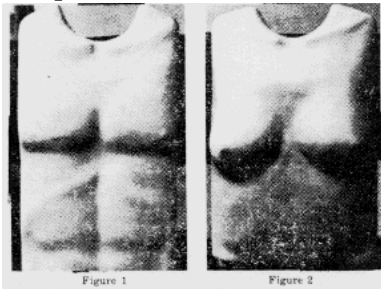
Perhaps the differences between the majority and the dissent in Carol Barnhart might have been resolved had they had before them the Denicola article on Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles, *supra*. There, Professor Denicola points out that although the Copyright Act of 1976 was an effort "to draw as clear a line as possible," in truth "there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns." 67 Minn.L.Rev. at 741. Denicola argues that "the statutory directive requires a distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear." He views the statutory limitation of copyrightability as "an attempt to identify elements whose form and appearance reflect the unconstrained perspective of the artist," such features not being the product of industrial design. *Id.* at 742. "Copyrightability, therefore, should turn on the relationship between the proffered work and the process of industrial design." *Id.* at 741. He suggests that "the dominant characteristic of industrial design is the influence of nonaesthetic, utilitarian concerns" and hence concludes that copyrightability "ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations." [2] *Id.* To state the Denicola test in the language of conceptual separability, if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.

We believe that Professor Denicola's approach provides the best test for conceptual separability and, accordingly, adopt it here for several reasons. First, the ap-



proach is consistent with the holdings of our previous cases.

In *Kieselstein-Cord*, for example, the artistic aspects of the belt buckles reflected purely aesthetic choices, independent of the buckles' function, while in *Carol Barnhart* the distinctive features of the torsos — the accurate anatomical design and the sculpted shirts and collars — showed clearly the influence of functional concerns.



Though the torsos bore artistic features, it was evident that the designer incorporated those features to further the usefulness of the torsos as mannequins. Second, the test's emphasis on the influence of utilitarian concerns in the design process may help, as Denicola notes, to "alleviate the de facto discrimination against nonrepresentational art that has regrettably accompanied much of the current analysis." *Id.* at 745.³ Finally, and perhaps most importantly, we think Denicola's test will not be too difficult to administer in practice. The work itself will continue to give "mute testimony" of its origins. In addition, the parties will be required to present evidence relating to the design process and the nature of the work, with the trier of fact making the determination whether the aesthetic design elements are significantly influenced by functional considerations.

Turning now to the facts of this case, we note first that *Brandir* contends, and

³We are reminded not only by Judge Gesell in the district court in *Esquire*, 414 F.Supp. 939, 941 (D.D.C.1976), but by Holmes in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52, 23 S.Ct. 298, 300-01, 47 L.Ed. 460 (1903), by *Mazer v. Stein*, 347 U.S. at 214, 74 S.Ct. at 468, and by numerous other opinions, that we judges should not let our own view of styles of art interfere with the decisionmaking process in this area. Denicola suggests that the shape of a Mickey Mouse telephone is copyrightable because its form is independent of function, and "[a] telephone shape owing more to Arp, Brancusi, or Moore than Disney may be equally divorced from utilitarian influence." 67 *Minn.L.Rev.* at 746. This is true, of course, of the artist Christo's "Running Fence," approved (following Professor Nimmer) as an example of conceptual separability in *Keiselstein-Cord*, 632 F.2d at 993.

its chief owner David Levine testified, that the original design of the RIBBON Rack stemmed from wire sculptures that Levine had created, each formed from one continuous undulating piece of wire. These sculptures were, he said, created and displayed in his home as a means of personal expression, but apparently were never sold or displayed elsewhere. He also created a wire sculpture in the shape of a bicycle and states that he did not give any thought to the utilitarian application of any of his sculptures until he accidentally juxtaposed the bicycle sculpture with one of the self-standing wire sculptures. It was not until November 1978 that Levine seriously began pursuing the utilitarian application of his sculptures, when a friend, G. Duff Bailey, a bicycle buff and author of numerous articles about urban cycling, was at Levine's home and informed him that the sculptures would make excellent bicycle racks, permitting bicycles to be parked under the overloops as well as on top of the underloops. Following this meeting, Levine met several times with Bailey and others, completing the designs for the RIBBON Rack by the use of a vacuum cleaner hose, and submitting his drawings to a fabricator complete with dimensions. The Brandir RIBBON Rack began being nationally advertised and promoted for sale in September 1979.

In November 1982 Levine discovered that another company, Cascade Pacific Lumber Co., was selling a similar product. Thereafter, beginning in December 1982, a copyright notice was placed on all RIBBON Racks before shipment and on December 10, 1982, five copyright applications for registration were submitted to the Copyright Office. The Copyright Office refused registration by letter, stating that the RIBBON Rack did not contain any element that was "capable of independent existence as a copyrightable pictorial, graphic or sculptural work apart from the shape of the useful article." An appeal to the Copyright Office was denied by letter dated March 23, 1983, refusing registration on the above ground and alternatively on the ground that the design lacked originality, consisting of "nothing more than a familiar public domain symbol." In February 1984, after the denial of the second appeal of the examiner's decision, Brandir sent letters to customers enclosing copyright notices to be placed on racks sold prior to December 1982.

Between September 1979 and August 1982 Brandir spent some \$38,500 for advertising and promoting the RIBBON Rack, including some 85,000 pieces of promotional literature to architects and landscape architects. Additionally, since October 1982 Brandir has spent some \$66,000, including full-, half-, and quarter-page advertisements in architectural magazines such as *Landscape Architecture*, *Progressive Architecture*, and *Architectural Record*, indeed winning an advertising award from *Progressive Architecture* in January 1983. The RIBBON Rack has been featured in *Popular Science*, *Art and Architecture*, and *Design 384* magazines, and it won an Industrial Designers Society of America design award in the spring of 1980. In the spring of 1984 the RIBBON Rack was selected from 200 designs to be included

among 77 of the designs exhibited at the Katonah Gallery in an exhibition entitled “The Product of Design: An Exploration of the Industrial Design Process,” an exhibition that was written up in the New York Times.

Sales of the RIBBON Rack from September 1979 through January 1985 were in excess of \$1,367,000. Prior to the time Cascade Pacific began offering for sale its bicycle rack in August 1982, Brandir’s sales were \$436,000. The price of the RIBBON Rack ranges from \$395 up to \$2,025 for a stainless steel model and generally depends on the size of the rack, one of the most popular being the RB-7, selling for \$485.

Applying Professor Denicola’s test to the RIBBON Rack, we find that the rack is not copyrightable. It seems clear that the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements. This is true even though the sculptures which inspired the RIBBON Rack may well have been — the issue of originality aside — copyrightable.

Brandir argues correctly that a copyrighted work of art does not lose its protected status merely because it subsequently is put to a functional use. The Supreme Court so held in *Mazer v. Stein*, 347 U.S. 201, 74 S.Ct. 460, 98 L.Ed. 630 (1954), and Congress specifically intended to accept and codify *Mazer* in section 101 of the Copyright Act of 1976. See H.R.Rep. No. 1476 at 54-55. The district court thus erred in ruling that, whatever the RIBBON Rack’s origins, Brandir’s commercialization of the rack disposed of the issue of its copyrightability.

Had Brandir merely adopted one of the existing sculptures as a bicycle rack, neither the application to a utilitarian end nor commercialization of that use would have caused the object to forfeit its copyrighted status. Comparison of the RIBBON Rack with the earlier sculptures, however, reveals that while the rack may have been derived in part from one of more “works of art,” it is in its final form essentially a product of industrial design. In creating the RIBBON Rack, the designer has clearly adapted the original aesthetic elements to accommodate and further a utilitarian purpose. These altered design features of the RIBBON Rack, including the spacesaving, open design achieved by widening the upper loops to permit parking under as well as over the rack’s curves, the straightened vertical elements that allow in- and above-ground installation of the rack, the ability to fit all types of bicycles and mopeds, and the heavy-gauged tubular construction of rustproof galvanized steel, are all features that combine to make for a safe, secure, and maintenance-free system of parking bicycles and mopeds. Its undulating shape is said in *Progressive Architecture*, January 1982, to permit double the storage of conventional bicycle racks. Moreover, the rack is manufactured from 2 3/8-inch standard steam pipe that is bent into form, the six-inch radius of the bends evidently resulting from bending the pipe according to a standard formula that yields bends having a radius equal to three times the nominal

internal diameter of the pipe.

Brandir argues that its RIBBON Rack can and should be characterized as a sculptural work of art within the minimalist art movement. Minimalist sculpture's most outstanding feature is said to be its clarity and simplicity, in that it often takes the form of geometric shapes, lines, and forms that are pure and free of ornamentation and void of association. As Brandir's expert put it, "The meaning is to be found in, within, around and outside the work of art, allowing the artistic sensation to be experienced as well as intellectualized." People who use Foley Square in New York City see in the form of minimalist art the "Tilted Arc," which is on the plaza at 26 Federal Plaza. Numerous museums have had exhibitions of such art, and the school of minimalist art has many admirers.

It is unnecessary to determine whether to the art world the RIBBON Rack properly would be considered an example of minimalist sculpture. The result under the copyright statute is not changed. Using the test we have adopted, it is not enough that, to paraphrase Judge Newman, the rack may stimulate in the mind of the reasonable observer a concept separate from the bicycle rack concept. While the RIBBON Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices. Indeed, the visually pleasing proportions and symmetry of the rack represent design changes made in response to functional concerns. Judging from the awards the rack has received, it would seem in fact that Brandir has achieved with the RIBBON Rack the highest goal of modern industrial design, that is, the harmonious fusion of function and aesthetics. Thus there remains no artistic element of the RIBBON Rack that can be identified as separate and "capable of existing independently, of, the utilitarian aspects of the article." Accordingly, we must affirm on the copyright claim. ...

WINTER, Circuit Judge, concurring in part and dissenting in part: ...

My colleagues, applying an adaptation of Professor Denicola's test, hold that the aesthetic elements of the design of a useful article are not conceptually separable from its utilitarian aspects if "[f]orm and function are inextricably intertwined" in the article, and "its ultimate design [is] as much the result of utilitarian pressures as aesthetic choices." Applying that test to the instant matter, they observe that the dispositive fact is that "in creating the Ribbon Rack, [Levine] has clearly adapted the original aesthetic elements to accommodate and further a utilitarian purpose." (emphasis added). The grounds of my disagreement are that: (1) my colleagues' adaptation of Professor Denicola's test diminishes the statutory concept of "conceptual separability" to the vanishing point; and (2) their focus on the process or sequence followed by the particular designer makes copyright protection depend upon largely

fortuitous circumstances concerning the creation of the design in issue.

With regard to “conceptual separability,” my colleagues deserve considerable credit for their efforts to reconcile *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir.1985) with *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir.1980). In my view, these cases are not reconcilable. Carol Barnhart paid only lip service to the fact that the “conceptual separability” of an article’s aesthetic utilitarian aspects may render the design of a “useful article” a copyrightable “sculptural work.” 17 U.S.C. § 101 (1982). Actually, the Carol Barnhart majority applied a test of physical separability. They thus stated:

What distinguishes [the Kieselstein Cord] buckles from the Barnhart forms is that the ornamented surfaces of the buckles were not in any respect required by their utilitarian functions; the artistic and aesthetic features could thus be conceived of as having been *added to, or superimposed upon*, an otherwise utilitarian article. The unique artistic design was wholly unnecessary to performance of the utilitarian function. In the case of the Barnhart forms, on the other hand, the features claimed to be aesthetic or artistic, e.g., the life-size configuration of the breasts and the width of the shoulders are inextricably intertwined with the utilitarian feature, the display of clothes.

773 F.2d at 419 (emphasis added). In contrast, Kieselstein-Cord focused on the fact that the belt buckles at issue could be perceived as objects other than belt buckles:

We see in appellant’s belt buckles conceptually separable sculptural elements, as apparently have the buckles’ wearers who have used them as ornamentation for parts of the body other than the waist.

632 F.2d at 993.

My colleagues’ adaptation of the Denicola test tracks the Carol Barnhart approach, whereas I would adopt that taken in Kieselstein-Cord, which allows for the copyrightability of the aesthetic elements of useful articles even if those elements simultaneously perform utilitarian functions.¹ The latter approach received its fullest elaboration in Judge Newman’s dissent in *Carol Barnhart*, where he explained that

¹Indeed, Kieselstein-Cord approved Professor Nimmer’s example of Christo’s “Running Fence” as an object whose sculptural features were conceptually, but not physically, separable from its utilitarian aspects. 632 F.2d at 993; see 1 Nimmer on Copyright § 2.08[B] at 2-96.1 & n. 112.2 (1987). The fact that the Running Fence’s aesthetic features were “inextricably intertwined” with its functional aspects, however, creates doubt as to whether it is a copyrightable “sculptural work” under *Carol Barnhart* or the instant decision.

“[f]or the [artistic] design features to be ‘conceptually separate’ from the utilitarian aspects of the useful article that embodies the design, the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.” 773 F.2d at 422 (Newman, J., dissenting).

In other words, the relevant question is whether the design of a useful article, however intertwined with the article’s utilitarian aspects, causes an ordinary reasonable observer to perceive an aesthetic concept not related to the article’s use. The answer to this question is clear in the instant case because any reasonable observer would easily view the Ribbon Rack as an ornamental sculpture.² Indeed, there is evidence of actual confusion over whether it is strictly ornamental in the refusal of a building manager to accept delivery until assured by the buyer that the Ribbon Rack was in fact a bicycle rack. Moreover, Brandir has received a request to use the Ribbon Rack as environmental sculpture, and has offered testimony of art experts who claim that the Ribbon Rack may be valued solely for its artistic features. As one of those experts observed: “If one were to place a Ribbon Rack on an island without access, or in a park and surround the work with a barrier, ... its status as a work of art would be beyond dispute.”

My colleagues also allow too much to turn upon the process or sequence of design followed by the designer of the Ribbon Rack. They thus suggest that copyright protection would have been accorded “had Brandir merely adopted ... as a bicycle rack” an enlarged version of one of David Levine’s original sculptures rather than one that had wider upper loops and straightened vertical elements. I cannot agree that copyright protection for the Ribbon Rack turns on whether Levine serendipitously chose the final design of the Ribbon Rack during his initial sculptural musings or whether the original design had to be slightly modified to accommodate bicycles. Copyright protection, which is intended to generate incentives for designers by according property rights in their creations, should not turn on purely fortuitous events. For that reason, the Copyright Act expressly states that the legal test is how the final article is perceived, not how it was developed through various stages. It thus states in pertinent part:

the design of a useful article ... shall be considered a ... sculptural work only if, and only to the extent that, such design incorporates ... sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. § 101 (1982) (emphasis added).

²The reasonable observer may be forgiven, however, if he or she does not recognize the Ribbon Rack as an example of minimalist art.

I therefore dissent from the decision so far as it relates to copyrightability but concur in its discussion and holding as to the trademark and unfair competition claims.

Eames Chair Problem

This is the Eames Lounge Chair by Charles and Ray Eames. Is its design copy-



rightable?

B Trademark

Wal-Mart Stores, Inc. v. Samara Brothers, Inc. 529 U.S. 205 (2000)

Justice Scalia, delivered the opinion of the Court.

In this case, we decide under what circumstances a product's design is distinctive, and therefore protectible, in an action for infringement of unregistered trade dress under § 43(a) of the Trademark Act of 1946 (Lanham Act), 60 Stat. 441, as amended, 15 U. S. C. § 1125(a).

I

Respondent Samara Brothers, Inc., designs and manufactures children's clothing. Its primary product is a line of spring/summer one-piece seersucker outfits decorated with appliques of hearts, flowers, fruits, and the like. A number of chain stores, including JCPenney, sell this line of clothing under contract with Samara.

Petitioner Wal-Mart Stores, Inc., is one of the Nation's best known retailers, selling among other things children's clothing. In 1995, Wal-Mart contracted with one of its suppliers, Judy-Philippine, Inc., to manufacture a line of children's outfits for sale in the 1996 spring/summer season. Wal-Mart sent Judy-Philippine photographs of a number of garments from Samara's line, on which Judy-Philippine's garments

were to be based; Judy-Philippine duly copied, with only minor modifications, 16 of Samara's garments, many of which contained copyrighted elements. In 1996, Wal-Mart briskly sold the so-called knockoffs, generating more than \$1.15 million in gross profits.

In June 1996, a buyer for JCPenney called a representative at Samara to complain that she had seen Samara garments on sale at Wal-Mart for a lower price than JCPenney was allowed to charge under its contract with Samara. The Samara representative told the buyer that Samara did not supply its clothing to Wal-Mart. Their suspicions aroused, however, Samara officials launched an investigation, which disclosed that Wal-Mart and several other major retailers—Kmart, Caldor, Hills, and Goody's—were selling the knockoffs of Samara's outfits produced by Judy-Philippine.

After sending cease-and-desist letters, Samara brought this action in the United States District Court for the Southern District of New York against Wal-Mart, Judy-Philippine, Kmart, Caldor, Hills, and Goody's for copyright infringement under federal law, consumer fraud and unfair competition under New York law, and—most relevant for our purposes— infringement of unregistered trade dress under § 43(a) of the Lanham Act, 15 U. S. C. § 1125(a). All of the defendants except Wal-Mart settled before trial.

After a week long trial, the jury found in favor of Samara on all of its claims. Wal-Mart then renewed a motion for judgment as a matter of law, claiming, *inter alia*, that there was insufficient evidence to support a conclusion that Samara's clothing designs could be legally protected as distinctive trade dress for purposes of § 43(a). The District Court denied the motion, 969 F. Supp. 895 (SDNY 1997), and awarded Samara damages, interest, costs, and fees totaling almost \$1.6 million, together with injunctive relief, see *App. to Pet. for Cert.* 56-58. The Second Circuit affirmed the denial of the motion for judgment as a matter of law, 165 F. 3d 120 (1998), and we granted certiorari, 528 U. S. 808 (1999).

II

The Lanham Act provides for the registration of trademarks, which it defines in § 45 to include “any word, name, symbol, or device, or any combination thereof [used or intended to be used] to identify and distinguish [a producer's] goods . . . from those manufactured or sold by others and to indicate the source of the goods” 15 U. S. C. § 1127. . . . In addition to protecting registered marks, the Lanham Act, in § 43(a), gives a producer a cause of action for the use by any person of “any word, term, name, symbol, or device, or any combination thereof . . . which . . . is likely to cause confusion . . . as to the origin, sponsorship, or approval of his or her goods” 15 U. S. C. § 1125(a). It is the latter provision that is at issue in this case.

The breadth of the definition of marks registrable under § 2, and of the

confusion-producing elements recited as actionable by § 43(a), has been held to embrace not just word marks, such as “Nike,” and symbol marks, such as Nike’s “swoosh” symbol, but also “trade dress”—a category that originally included only the packaging, or “dressing,” of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product. See, e. g., *Ashley Furniture Industries, Inc. v. Sangiacomo N. A., Ltd.*, 187 F. 3d 363 (CA4 1999) (bedroom furniture); *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F. 3d 996 (CA2 1995) (sweaters); *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F. 3d 780 (CA8 1995) (notebooks). These courts have assumed, often without discussion, that trade dress constitutes a “symbol” or “device” for purposes of the relevant sections, and we conclude likewise. “Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.” *Qualitex Co. v. Jacobson Products Co.*, 514 U. S. 159, 162 (1995). This reading of § 2 and § 43(a) is buttressed by a recently added subsection of § 43(a), § 43(a)(3), which refers specifically to “civil action[s] for trade dress infringement under this chapter for trade dress not registered on the principal register.” 15 U. S. C. § 1125(a)(3) (1994 ed., Supp. V).

The text of § 43(a) provides little guidance as to the circumstances under which unregistered trade dress may be protected. It does require that a producer show that the allegedly infringing feature is not “functional,” see § 43 (a)(3), and is likely to cause confusion with the product for which protection is sought, see § 43(a)(1)(A), 15 U. S. C. § 1125(a)(1)(A). Nothing in § 43(a) explicitly requires a producer to show that its trade dress is distinctive, but courts have universally imposed that requirement, since without distinctiveness the trade dress would not “cause confusion. . . as to the origin, sponsorship, or approval of [the] goods,” as the section requires. Distinctiveness is, moreover, an explicit prerequisite for registration of trade dress under § 2, and “the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U. S. 763, 768 (1992) (citations omitted).

In evaluating the distinctiveness of a mark under § 2 (and therefore, by analogy, under § 43(a)), courts have held that a mark can be distinctive in one of two ways. First, a mark is inherently distinctive if “[its] intrinsic nature serves to identify a particular source.” *Ibid.* In the context of word marks, courts have applied the now-classic test originally formulated by Judge Friendly, in which word marks that are “arbitrary” (“Camel” cigarettes), “fanciful” (“Kodak” film), or “suggestive” (“Tide” laundry detergent) are held to be inherently distinctive. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F. 2d 4, 10-11 (CA2 1976). Second, a mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs 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.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U. S. 844, 851, n. 11 (1982).

The judicial differentiation between marks that are inherently distinctive and those that have developed secondary meaning has solid foundation in the statute itself. Section 2 requires that registration be granted to any trademark “by which the goods of the applicant may be distinguished from the goods of others”—subject to various limited exceptions. 15 U. S. C. § 1052. It also provides, again with limited exceptions, that “nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce”—that is, which is not inherently distinctive but has become so only through secondary meaning. § 2(f), 15 U. S. C. § 1052(f). Nothing in § 2, however, demands the conclusion that every category of mark necessarily includes some marks “by which the goods of the applicant may be distinguished from the goods of others” without secondary meaning—that in every category some marks are inherently distinctive.

Indeed, with respect to at least one category of mark—colors—we have held that no mark can ever be inherently distinctive. See *Qualitex*, *supra*, at 162-163. In *Qualitex*, petitioner manufactured and sold green-gold dry-cleaning press pads. After respondent began selling pads of a similar color, petitioner brought suit under § 43(a), then added a claim under § 32 after obtaining registration for the color of its pads. We held that a color could be protected as a trademark, but only upon a showing of secondary meaning. Reasoning by analogy to the *Abercrombie & Fitch* test developed for word marks, we noted that a product’s color is unlike a “fanciful,” “arbitrary,” or “suggestive” mark, since it does not “almost automatically tell a customer that [it] refer[s] to a brand,” 514 U. S., at 162-163, and does not “immediately . . . signal a brand or a product ‘source,’” *id.*, at 163. However, we noted that, “over time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand.” *Ibid.* Because a color, like a “descriptive” word mark, could eventually “come to indicate a product’s origin,” we concluded that it could be protected upon a showing of secondary meaning. *Ibid.*

It seems to us that design, like color, is not inherently distinctive. The attribution of inherent distinctiveness to certain categories of word marks and product packaging derives from the fact that the very purpose of attaching a particular word to a product, or encasing it in a distinctive packaging, is most often to identify the source of the product. Although the words and packaging can serve subsidiary functions—a suggestive word mark (such as “Tide” for laundry detergent), for instance, may invoke positive connotations in the consumer’s mind, and a garish form of packaging (such as Tide’s squat, brightly decorated plastic bottles for its liquid laundry detergent) may attract an otherwise indifferent consumer’s attention on a crowded store shelf—their predominant function remains source identification. Consumers

are therefore predisposed to regard those symbols as indication of the producer, which is why such symbols “almost automatically tell a customer that they refer to a brand,” *id.*, at 162-163, and “immediately . . . signal a brand or a product ‘source,’” *id.*, at 163. And where it is not reasonable to assume consumer predisposition to take an affixed word or packaging as indication of source—where, for example, the affixed word is descriptive of the product (“Tasty” bread) or of a geographic origin (“Georgia” peaches)—inherent distinctiveness will not be found. That is why the statute generally excludes, from those word marks that can be registered as inherently distinctive, words that are “merely descriptive” of the goods, § 2(e)(1), 15 U. S. C. § 1052(e)(1), or “primarily geographically descriptive of them,” see § 2(e)(2), 15 U. S. C. § 1052(e)(2). In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful or more appealing.

The fact that product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematic; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests. Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness. How easy it is to mount a plausible suit depends, of course, upon the clarity of the test for inherent distinctiveness, and where product design is concerned we have little confidence that a reasonably clear test can be devised. . . .

Respondent contends that our decision in *Two Pesos* forecloses a conclusion that product-design trade dress can never be inherently distinctive. In that case, we held that the trade dress of a chain of Mexican restaurants, which the plaintiff described as “a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals,” 505 U. S., at 765 (internal quotation marks and citation omitted), could be protected under § 43(a) without a showing of secondary meaning, see *id.*, at 776. *Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive, see, e. g., *id.*, at 773, but it does not establish that product-design trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us not to constitute product design. It was either product packaging—which, as we have discussed, normally is taken by the consumer to indicate origin—or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.

Respondent replies that this manner of distinguishing *Two Pesos* will force courts to draw difficult lines between product-design and product-packaging trade

dress. There will indeed be some hard cases at the margin: a classic glass Coca-Cola bottle, for instance, may constitute packaging for those consumers who drink the Coke and then discard the bottle, but may constitute the product itself for those consumers who are bottle collectors, or part of the product itself for those consumers who buy Coke in the classic glass bottle, rather than a can, because they think it more stylish to drink from the former. We believe, however, that the frequency and the difficulty of having to distinguish between product design and product packaging will be much less than the frequency and the difficulty of having to decide when a product design is inherently distinctive. To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning. The very closeness will suggest the existence of relatively small utility in adopting an inherent-distinctiveness principle, and relatively great consumer benefit in requiring a demonstration of secondary meaning. ...

We hold that, in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning. The judgment of the Second Circuit is reversed, and the case is remanded for further proceedings consistent with this opinion. ...

Lanham Act

15 U.S.C. § 1052 [Lanham Act § 2] - *Trademarks registrable on principal register ...*

No trademark ... shall be refused registration on the principal register on account of its nature unless it—

- (e) Consists of a mark which ... (5) comprises any matter that, as a whole, is functional.

15 U.S.C. § 1125 [Lanham Act § 43] - *False designations of origin, false descriptions, and dilution forbidden*

- (a) Civil Action
 - (3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

Traffix Devices, Inc. v. Marketing Displays, Inc.
532 U.S. 23 (2001)

Justice Kennedy delivered the opinion of the Court.

Temporary road signs with warnings like “Road Work Ahead” or “Left Shoulder Closed” must withstand strong gusts of wind. An inventor named Robert Sarkisian obtained two utility patents for a mechanism built upon two springs (the dual-spring design) to keep these and other outdoor signs upright despite adverse wind conditions. The holder of the now-expired Sarkisian patents, respondent Marketing Displays, Inc. (MDI), established a successful business in the manufacture and sale of sign stands incorporating the patented feature. MDI’s stands for road signs were recognizable to buyers and users (it says) because the dual-spring design was visible near the base of the sign.

This litigation followed after the patents expired and a competitor, Traffix Devices, Inc., sold sign stands with a visible spring mechanism that looked like MDI’s. MDI and Traffix products looked alike because they were. When Traffix started in business, it sent an MDI product abroad to have it reverse engineered, that is to say copied. Complicating matters, Traffix marketed its sign stands under a name similar to MDI’s. MDI used the name “WindMaster,” while Traffix, its new competitor, used “WindBuster.”

MDI brought suit under the Trademark Act of 1946 (Lanham Act), 60 Stat. 427, as amended, 15 U. S. C. § 1051 et seq., against Traffix for trademark infringement (based on the similar names), trade dress infringement (based on the copied dual-spring design), and unfair competition. Traffix counterclaimed on antitrust theories. After the United States District Court for the Eastern District of Michigan considered cross-motions for summary judgment, MDI prevailed on its trademark claim for the confusing similarity of names and was held not liable on the antitrust counterclaim; and those two rulings, affirmed by the Court of Appeals, are not before us.

I

We are concerned with the trade dress question. The District Court ruled against MDI on its trade dress claim. 971 F. Supp. 262 (ED Mich. 1997). After determining that the one element of MDI’s trade dress at issue was the dualspring design, *id.*, at 265, it held that “no reasonable trier of fact could determine that MDI has established secondary meaning” in its alleged trade dress, *id.*, at 269. In other words, consumers did not associate the look of the dualspring design with MDI. As a second, independent reason to grant summary judgment in favor of Traffix, the District Court determined the dual-spring design was functional. On this rationale secondary meaning is irrelevant because there can be no trade dress protection in any event. In ruling on the functional aspect of the design, the District Court noted

that Sixth Circuit precedent indicated that the burden was on MDI to prove that its trade dress was nonfunctional, and not on Traffix to show that it was functional (a rule since adopted by Congress, see 15 U. S. C. § 1125(a)(3) (1994 ed., Supp. V)), and then went on to consider MDI's arguments that the dual-spring design was subject to trade dress protection. Finding none of MDI's contentions persuasive, the District Court concluded MDI had not "proffered sufficient evidence which would enable a reasonable trier of fact to find that MDI's vertical dual-spring design is nonfunctional." 971 F. Supp., at 276. Summary judgment was entered against MDI on its trade dress claims.

The Court of Appeals for the Sixth Circuit reversed the trade dress ruling. 200 F. 3d 929 (1999). The Court of Appeals held the District Court had erred in ruling MDI failed to show a genuine issue of material fact regarding whether it had secondary meaning in its alleged trade dress, *id.*, at 938, and had erred further in determining that MDI could not prevail in any event because the alleged trade dress was in fact a functional product configuration, *id.*, at 940. The Court of Appeals suggested the District Court committed legal error by looking only to the dual-spring design when evaluating MDI's trade dress. Basic to its reasoning was the Court of Appeals' observation that it took "little imagination to conceive of a hidden dual-spring mechanism or a tri or quad-spring mechanism that might avoid infringing [MDI's] trade dress." *Ibid.* The Court of Appeals explained that "[i]f Traffix or another competitor chooses to use [MDI's] dual-spring design, then it will have to find some other way to set its sign apart to avoid infringing [MDI's] trade dress." *Ibid.* It was not sufficient, according to the Court of Appeals, that allowing exclusive use of a particular feature such as the dual-spring design in the guise of trade dress would "hinde[r] competition somewhat." Rather, "[e]xclusive use of a feature must 'put competitors at a significant non-reputation-related disadvantage' before trade dress protection is denied on functionality grounds." *Ibid.* (quoting *Qualitex Co. v. Jacobson Products Co.*, 514 U. S. 159, 165 (1995)). In its criticism of the District Court's ruling on the trade dress question, the Court of Appeals took note of a split among Courts of Appeals in various other Circuits on the issue whether the existence of an expired utility patent forecloses the possibility of the patentee's claiming trade dress protection in the product's design. 200 F. 3d, at 939. Compare *Sunbeam Products, Inc. v. West Bend Co.*, 123 F. 3d 246 (CA5 1997) (holding that trade dress protection is not foreclosed), *Thomas & Betts Corp. v. Panduit Corp.*, 138 F. 3d 277 (CA7 1998) (same), and *Midwest Industries, Inc. v. Karavan Trailers, Inc.*, 175 F. 3d 1356 (CA Fed 1999) (same), with *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F. 3d 1498, 1500 (CA10 1995) ("Where a product configuration is a significant inventive component of an invention covered by a utility patent . . . it cannot receive trade dress protection"). To resolve the conflict, we granted certiorari. 530 U. S. 1260 (2000).

II

It is well established that trade dress can be protected under federal law. The design or packaging of a product may acquire a distinctiveness which serves to identify the product with its manufacturer or source; and a design or package which acquires this secondary meaning, assuming other requisites are met, is a trade dress which may not be used in a manner likely to cause confusion as to the origin, sponsorship, or approval of the goods. In these respects protection for trade dress exists to promote competition. As we explained just last Term, see *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U. S. 205 (2000), various Courts of Appeals have allowed claims of trade dress infringement relying on the general provision of the Lanham Act which provides a cause of action to one who is injured when a person uses “any word, term name, symbol, or device, or any combination thereof . . . which is likely to cause confusion . . . as to the origin, sponsorship, or approval of his or her goods.” 15 U. S. C. § 1125(a)(1)(A). Congress confirmed this statutory protection for trade dress by amending the Lanham Act to recognize the concept. Title 15 U. S. C. § 1125(a)(3) (1994 ed., Supp. V) provides: “In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.” This burden of proof gives force to the well-established rule that trade dress protection may not be claimed for product features that are functional. *Qualitex*, supra, at 164-165; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U. S. 763, 775 (1992). And in *Wal-Mart*, supra, we were careful to caution against misuse or over extension of trade dress. We noted that “product design almost invariably serves purposes other than source identification.” *Id.*, at 213.

Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying. As the Court has explained, copying is not always discouraged or disfavored by the laws which preserve our competitive economy. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U. S. 141, 160 (1989). Allowing competitors to copy will have salutary effects in many instances. “Reverse engineering of chemical and mechanical articles in the public domain often leads to significant advances in technology.” *Ibid.*

The principal question in this case is the effect of an expired patent on a claim of trade dress infringement. A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved other-

wise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

In the case before us, the central advance claimed in the expired utility patents (the Sarkisian patents) is the dualspring design; and the dual-spring design is the essential feature of the trade dress MDI now seeks to establish and to protect. The rule we have explained bars the trade dress claim, for MDI did not, and cannot, carry the burden of overcoming the strong evidentiary inference of functionality based on the disclosure of the dual-spring design in the claims of the expired patents.

The dual springs shown in the Sarkisian patents were well apart (at either end of a frame for holding a rectangular sign when one full side is the base) while the dual springs at issue here are close together (in a frame designed to hold a sign by one of its corners). As the District Court recognized, this makes little difference. The point is that the springs are necessary to the operation of the device. The fact that the springs in this very different-looking device fall within the claims of the patents is illustrated by MDI's own position in earlier litigation. In the late 1970's, MDI engaged in a long-running intellectual property battle with a company known as Winn-Proof. Although the precise claims of the Sarkisian patents cover sign stands with springs "spaced apart," U. S. Patent No. 3,646,696, col. 4; U. S. Patent No. 3,662,482, col. 4, the Winn-Proof sign stands (with springs much like the sign stands at issue here) were found to infringe the patents by the United States District Court for the District of Oregon, and the Court of Appeals for the Ninth Circuit affirmed the judgment. *Sarkisian v. WinnProof Corp.*, 697 F. 2d 1313 (1983). Although the WinnProof traffic sign stand (with dual springs close together) did not appear, then, to infringe the literal terms of the patent claims (which called for "spaced apart" springs), the WinnProof sign stand was found to infringe the patents under the doctrine of equivalents, which allows a finding of patent infringement even when the accused product does not fall within the literal terms of the claims. *Id.*, at 1321-1322; see generally *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U. S. 17 (1997). In light of this past ruling—a ruling procured at MDI's own insistence—it must be concluded the products here at issue would have been covered by the claims of the expired patents.

The rationale for the rule that the disclosure of a feature in the claims of a utility patent constitutes strong evidence of functionality is well illustrated in this case. The dual-spring design serves the important purpose of keeping the sign upright even in heavy wind conditions; and, as confirmed by the statements in the expired patents, it does so in a unique and useful manner. As the specification of one of the patents recites, prior art "devices, in practice, will topple under the force of a strong wind." U. S. Patent No. 3,662,482, col. 1. The dual-spring design allows sign stands to resist toppling in strong winds. Using a dual-spring design rather than a single spring

achieves important operational advantages. For example, the specifications of the patents note that the “use of a pair of springs . . . as opposed to the use of a single spring to support the frame structure prevents canting or twisting of the sign around a vertical axis,” and that, if not prevented, twisting “may cause damage to the spring structure and may result in tipping of the device.” U. S. Patent No. 3,646,696, col. 3. In the course of patent prosecution, it was said that “[t]he use of a pair of spring connections as opposed to a single spring connection . . . forms an important part of this combination” because it “forc[es] the sign frame to tip along the longitudinal axis of the elongated ground-engaging members.” App. 218. The dual-spring design affects the cost of the device as well; it was acknowledged that the device “could use three springs but this would unnecessarily increase the cost of the device.” *Id.*, at 217. These statements made in the patent applications and in the course of procuring the patents demonstrate the functionality of the design. MDI does not assert that any of these representations are mistaken or inaccurate, and this is further strong evidence of the functionality of the dual-spring design.

III

In finding for MDI on the trade dress issue the Court of Appeals gave insufficient recognition to the importance of the expired utility patents, and their evidentiary significance, in establishing the functionality of the device. The error likely was caused by its misinterpretation of trade dress principles in other respects. As we have noted, even if there has been no previous utility patent the party asserting trade dress has the burden to establish the nonfunctionality of alleged trade dress features. MDI could not meet this burden. Discussing trademarks, we have said “[i]n general terms, a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’” *Qualitex*, 514 U. S., at 165 (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U. S. 844, 850, n. 10 (1982)). Expanding upon the meaning of this phrase, we have observed that a functional feature is one the “exclusive use of [which] would put competitors at a significant nonreputation-related disadvantage.” 514 U. S., at 165. The Court of Appeals in the instant case seemed to interpret this language to mean that a necessary test for functionality is “whether the particular product configuration is a competitive necessity.” 200 F. 3d, at 940. See also *Vornado*, 58 F. 3d, at 1507 (“Functionality, by contrast, has been defined both by our circuit, and more recently by the Supreme Court, in terms of competitive need”). This was incorrect as a comprehensive definition. As explained in *Qualitex*, *supra*, and *Inwood*, *supra*, a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device. The *Qualitex* decision did not purport to displace this traditional rule. Instead, it quoted the rule as *Inwood* had set it forth. It is proper to inquire into a “significant non-reputation-related disad-

vantage” in cases of esthetic functionality, the question involved in *Qualitex*. Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, esthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.

The Court has allowed trade dress protection to certain product features that are inherently distinctive. *Two Pesos*, 505 U. S., at 774. In *Two Pesos*, however, the Court at the outset made the explicit analytic assumption that the trade dress features in question (decorations and other features to evoke a Mexican theme in a restaurant) were not functional. *Id.*, at 767, n. 6. The trade dress in those cases did not bar competitors from copying functional product design features. In the instant case, beyond serving the purpose of informing consumers that the sign stands are made by MDI (assuming it does so), the dual-spring design provides a unique and useful mechanism to resist the force of the wind. Functionality having been established, whether MDI’s dual-spring design has acquired secondary meaning need not be considered.

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI’s product; it is the reason the device works. Other designs need not be attempted.

Because the dual-spring design is functional, it is unnecessary for competitors to explore designs to hide the springs, say, by using a box or framework to cover them, as suggested by the Court of Appeals. The dual-spring design assures the user the device will work. If buyers are assured the product serves its purpose by seeing the operative mechanism that in itself serves an important market need. It would be at cross-purposes to those objectives, and something of a paradox, were we to require the manufacturer to conceal the very item the user seeks.

In a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain. There the manufacturer could perhaps prove that those aspects do not serve a purpose within the terms of the utility patent. The inquiry into whether such features, asserted to be trade dress, are functional by reason of their inclusion in the claims of an expired utility patent could be aided by going beyond the claims and examining the patent and its prosecution history to see if the feature in question is shown as a useful part of the invention. No such claim is made here, however. MDI in essence seeks protection for the dual-spring design alone. The asserted trade

dress consists simply of the dual-spring design, four legs, a base, an upright, and a sign. MDI has pointed to nothing arbitrary about the components of its device or the way they are assembled. The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller. The Court of Appeals erred in viewing MDI as possessing the right to exclude competitors from using a design identical to MDI's and to require those competitors to adopt a different design simply to avoid copying it. MDI cannot gain the exclusive right to produce sign stands using the dual-spring design by asserting that consumers associate it with the look of the invention itself. Whether a utility patent has expired or there has been no utility patent at all, a product design which has a particular appearance may be functional because it is "essential to the use or purpose of the article" or "affects the cost or quality of the article." Inwood, 456 U. S., at 850, n. 10. ...



Trademark Manual of Examining Procedure

1202.02(a)(vi) - 1202.02(a)(vi) *Aesthetic Functionality*

“Aesthetic functionality” refers to situations where the feature may not provide a truly utilitarian advantage in terms of product performance, but provides other competitive advantages. For example, in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531, 1533, 32 USPQ2d 1120, 1122, 1124 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995), the Federal Circuit affirmed the Board’s determination that the color black for outboard motors was functional because, while it had no utilitarian effect on the mechanical working of the engines, it nevertheless provided other identifiable competitive advantages, i.e., ease of coordination with a variety of boat colors and reduction in the apparent size of the engines. ...

In *M-5 Steel Mfg., Inc. v. O’Hagin’s Inc.*, 61 USPQ2d 1086, 1096 (TTAB 2001), the Board considered the proper use of the aesthetic functionality doctrine in connection with product designs for metal ventilating ducts and vents for tile or concrete roofs:

This case seems to involve elements of both utilitarian and aesthetic functionality. Here, for example, there is evidence of utility in applicant’s patent application, as well as statements touting the superiority of applicant’s design in applicant’s promotional literature, and statements that applicant’s design results in reduced costs of installation. On the other hand, there is no question that applicant’s roof designs which match the appearance of surrounding roof tiles are more pleasing in appearance because the venting tiles in each case are unobtrusive.

Citing extensively from the *Traffix*, *Qualitex*, and *Brunswick* cases, the Board concluded that the product designs were functional for a combination of utilitarian and aesthetic reasons. *Id.* at 1097.

Note that this type of functionality determination – while employed in connection with a normally “aesthetic” feature such as color – is a proper use of the functionality doctrine, necessitating a §2(e)(5) refusal where the evidence establishes that a color or other matter at issue provides identifiable competitive advantages and, thus, should remain in the public domain. In *In re Florists’ Transworld Delivery Inc.*, 106 USPQ2d 1784 (TTAB 2013), for example, the record included evidence reflecting that, in the floral industry, color has significance and communicates particular messages (e.g., elegance, bereavement, Halloween), which extend to floral packaging. The Board found, therefore, that the examining attorney had demonstrated a competitive need for others in the industry to use black in connection with

floral arrangements and packaging therefor and concluded that the proposed mark was functional under §2(e)(5). This is the opposite of an ornamentation refusal, where the matter at issue serves no identifiable purpose other than that of pure decoration.

Eames Chair Problem, Revisited

Look again at the Eames Lounge Chair. Is its design protectable trade dress?

Pez Dispenser Problem

Make yourself familiar, if you are not already, with PEZ dispensers. To what extent can Patrafico AG (the PEZ corporate parent) obtain trademark or trade dress protection in the appearance of PEZ dispensers? Can it trademark the spring-loaded flip-top design? The number of candies in a pack? The fluted front and footed base of a dispenser? Does it matter what heads the PEZ dispensers have? Against what products and uses will these rights be effective?

C Design Patent

Patent Act

35 U.S.C. § 171 - *Patents for designs*

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

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. § 173 - *Term of design patent*

Patents for designs shall be granted for the term of fourteen years from the date of grant.

United States Patent [19]

Giugiaro

[11] **Patent Number: Des. 283,882**

[45] **Date of Patent: ** May 20, 1986**

[54] **AUTOMOBILE**

[75] **Inventor: Giorgetto Giugiaro, Turin, Italy**

[73] **Assignee: Delorean Motor Company**

[**] **Term: 14 Years**

[21] **Appl. No.: 273,091**

[22] **Filed: Jun. 12, 1981**

[52] **U.S. Cl. D12/91**

[58] **Field of Search D12/91, 92; 296/185**

[56] **References Cited
PUBLICATIONS**

Road & Track, 3/73, p. 50, Lamborghini P250 Uracco, top right side of page.

Primary Examiner—James M. Gandy
Attorney, Agent, or Firm—David A. Maxon

[57] **CLAIM**

The ornamental design for an automobile, as shown and described.

DESCRIPTION

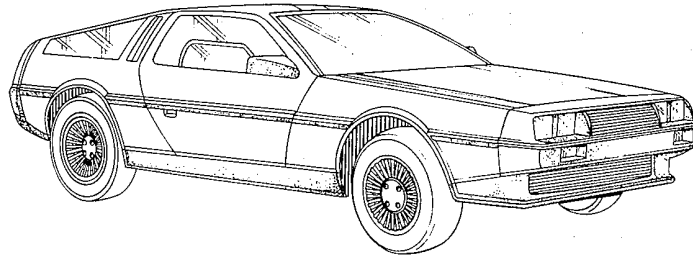
FIG. 1 is a front perspective view of an automobile showing my new design;

FIG. 2 is a rear perspective view thereof;

FIG. 3 is a front elevational view thereof; and

FIG. 4 is a rear elevational view thereof.

The side opposite to that shown in FIGS. 1 and 2 of the drawing is substantially a mirror image thereof.



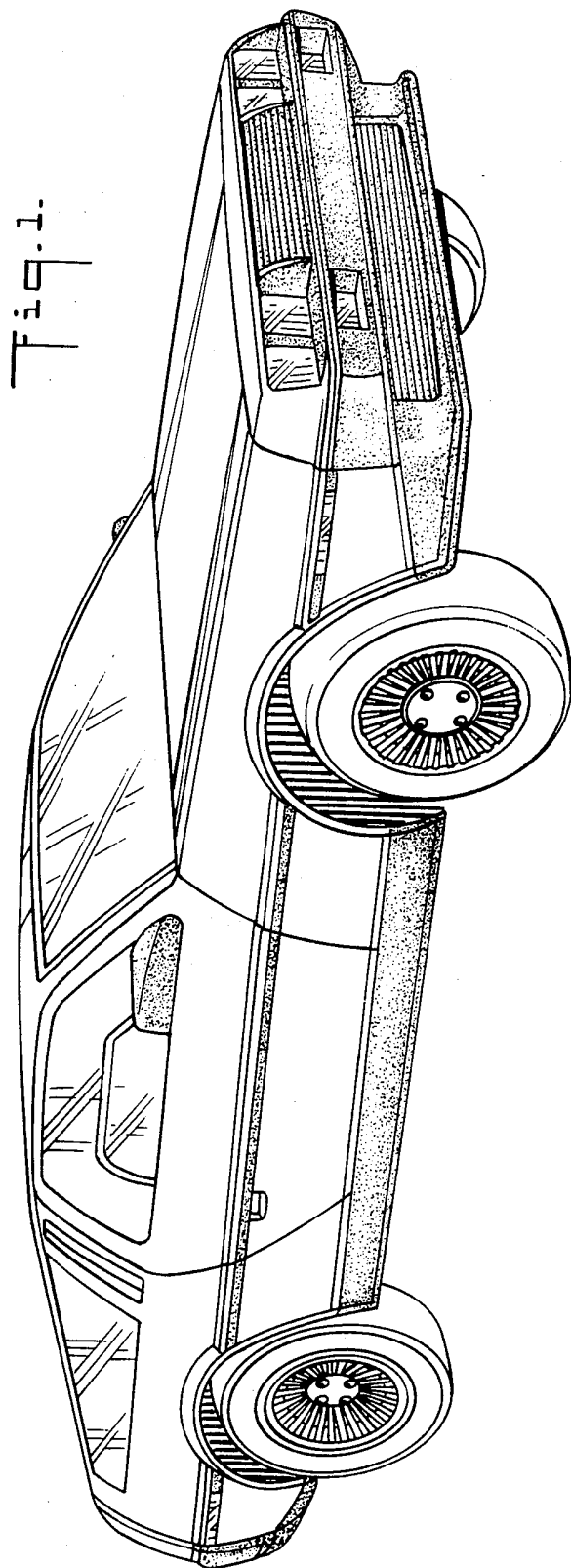


Fig. 2.

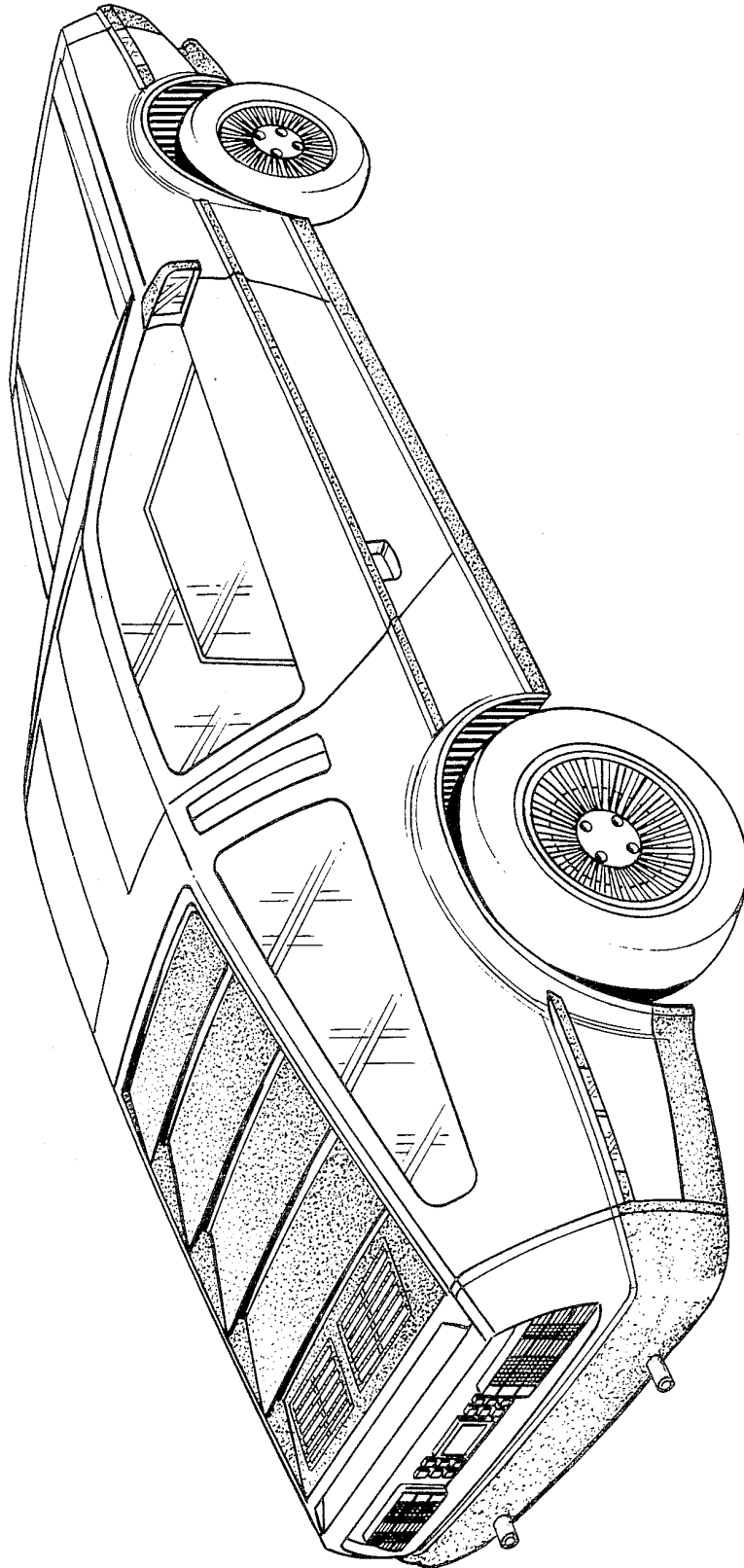


Fig. 3

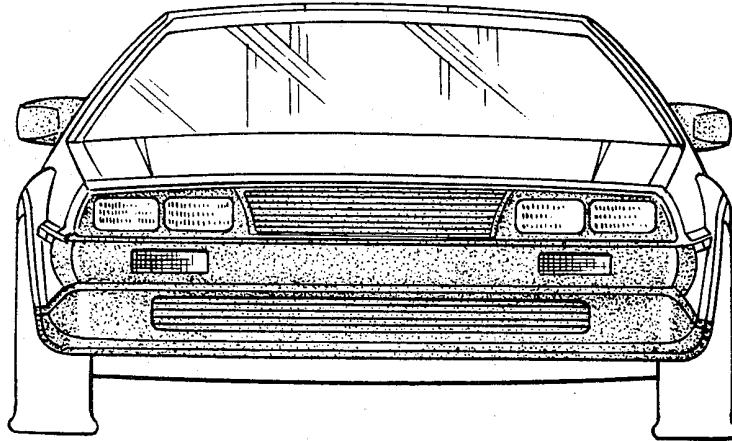
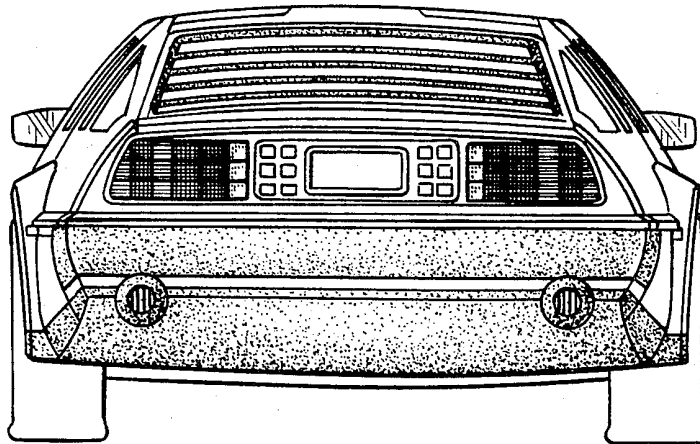


Fig. 4.



In re Webb
916 F.2d 1553 (Fed. Cir. 1990)

CLEVENGER, Circuit Judge.

This is an appeal from a decision of the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences (“Board”) affirming the final rejection of the sole claim of appellants’ (“Webb”) U.S. Design Patent Application Serial No. 833,470. The claim for “[t]he ornamental design for a grooved femoral hip stem prosthesis as shown and described,” was “rejected as being unpatentable under 35 U.S.C. § 171 as being directed to non-statutory subject matter.” The design can be appreciated from Figure 2 of the application reproduced below.

The Board affirmed the Examiner’s holding that the design, “clearly not intended to be visible in actual use,” “is not proper subject matter under 35 U.S.C. § 171.” The Board’s decision creates a per se rule that a design for an article which will not be visible in the final use for which the article was created is non-statutory subject matter even if the design is observed at some stage of the article’s commercial life. We reverse and remand.

I

Hip stem prostheses of the design invented by Webb are metallic implants that are generally used by orthopedic surgeons to supplant the functioning of a diseased or broken femur, near the hip, where the femur is joined to the pelvis. According to Webb, and not disputed by the Patent and Trademark Office (“PTO”), surgeons are made aware of differing brands and types of prostheses through advertisements in professional journals and through trade shows, where the prostheses themselves are displayed. Advertisements that were put in the record prominently and visually display the features of the prostheses. Furthermore, the applicant’s agent submitted that “an implant’s appearance is observed by potential and actual purchasers, surgeons, nurses, operating room staff, and other hospital personnel.” After purchase, the prosthesis is surgically implanted into a patient’s body where the implant is to remain indefinitely. Neither party disputes that, after implantation, the prosthesis is no longer visible to the naked eye.

II

In the Initial Office Action, the Examiner rejected the claim “under 35 U.S.C. 171 for the reason that the instant article is believed to be devoid of ornamentality, as comprehended by the statute. Articles of this type are not only completely hidden in use, but are devised to satisfy purely structural and mechanical requirements as

well.” The Examiner thus found the article to be unpatentable subject matter for two reasons: because it was purely functional and because it was concealed in normal use. In reply, Webb argued that the design was not purely functional since a “prosthetic implant could utilize the mechanical/utilitarian features/concepts ... and have a totally different visual appearance.” Webb also argued that the “visual appearance can certainly draw attention to a particular implant at a trade show or in advertising” and, therefore, the design was visible during normal use.

In the Final Office Action, the Examiner stated:

Applicant argues that, while the design is functional in nature, it is still ornamental. While this may be true, it has been held that articles which are hidden in use are not proper subject matter for design patents. There is not sound reason or logic for “normal use” to include the repair, service, replacement, sale or display of the article which incorporates the claimed design. While such occasions are of course “normal” in the sense of commonplace or routine occasions of an item’s use, for patent purposes “normal use” should be limited to the ordinary functioning for which it was designed, not incidents in the article’s life which are not integral to its function or purpose. Items are not designed for sale, display, replacement or repair.

The Board did not address the issue of functionality of the claimed design that had been raised in the Examiner’s Initial Action. It affirmed the Examiner’s final rejection of the claim as unpatentable subject matter because the article was not visible in what the Board considered to be its normal or intended use. ...

IV

The issuance of design patents is limited by statute to designs that are ornamental. 35 U.S.C. § 171 (1988). Our predecessor court has affirmed the rejection of design applications that cannot be perceived in their normal and intended uses. For instance, the Court of Customs and Patent Appeals affirmed the rejection of a design claim for a vent tube placed in the wall of a frame house, stating that “[i]t is well-settled that patentability of a design cannot be based on elements which are concealed in the normal use of the device to which the design is applied.” *In re Cornwall*, 230 F.2d 457, 459, 43 CCPA 824, 826, 109 USPQ 57, 58 (1956). Even earlier, that court affirmed the rejection of a design claim for a vacuum cleaner brush. *In re Stevens*, 173 F.2d 1015, 36 CCPA 1017, 81 USPQ 362 (1949). There the court noted:

Articles which are concealed or obscure are not proper subjects for design patents, since their appearance cannot be a matter of concern....

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

Id. at 1016, 36 CCPA at 1019, 81 USPQ at 363 (emphasis added).

We read those cases to establish a reasonable general rule that presumes the absence of ornamentality when an article may not be observed. This is a sound rule of thumb, but it is not dispositive. See *Larson v. Classic Corp.*, 683 F.Supp. 1202, 1202-1203, 7 USPQ2d 1747, 1747 (N.D.Ill. 1988). In each case, the inquiry must extend to whether at some point in the life of the article an occasion (or occasions) arises when the appearance of the article becomes a “matter of concern.”

Here, we read the Board’s decision to have established a per se rule under § 171 that if an article is hidden from the human eye when it arrives at the final use of its functional life, a design upon that article cannot be ornamental. The rule in *Stevens* does not compel the Board’s decision. Instead, *Stevens* instructs us to decide whether the “article such as here under consideration” — a hip stem implant — “is always concealed in its normal and intended use.” The issue before us, then, is whether “normal and intended use” of these prosthetic devices is confined to their final use.

V

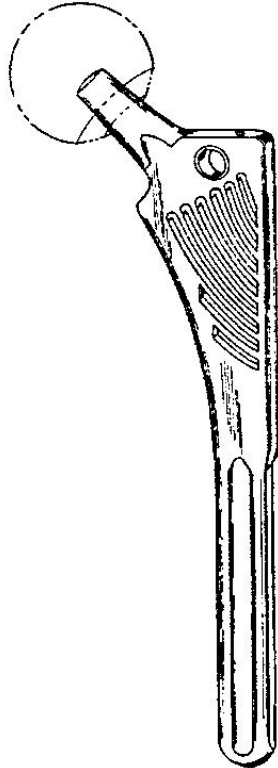
Although we agree that “normal and intended use” excludes the time during which the article is manufactured or assembled, it does not follow that evidence that an article is visible at other times is legally irrelevant to ascertaining whether the article is ornamental for purposes of § 171. Contrary to the reasoning of the Examiner in this case, articles are designed for sale and display, and such occasions are normal uses of an article for purposes of § 171. The likelihood that articles would be observed during occasions of display or sale could have a substantial influence on the design or ornamentality of the article. “The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value....” *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 525, 20 L.Ed. 731 (1871).

In short, we construe the “normal and intended use” of an article to be a period in the article’s life, beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article. Although the period includes all commercial uses of the article prior to its ultimate destination, only the facts of specific cases will establish whether during that period the article’s design can be observed in such a manner as to demonstrate its ornamentality.

It is possible, as in *Stevens*, that although an article may be sold as a replacement

item, its appearance might not be of any concern to the purchaser during the process of sale. Indeed, many replacement items, including vacuum cleaner brushes, are sold by replacement or order number, or they are noticed during sale only to assess functionality. In such circumstances, the PTO may properly conclude that an application provides no evidence that there is a period in the commercial life of a particular design when its ornamentality may be a matter of concern. However, in other cases, the applicant may be able to prove to the PTO that the article's design is a "matter of concern" because of the nature of its visibility at some point between its manufacture or assembly and its ultimate use. Many commercial items, such as colorful and representational vitamin tablets, or caskets, have designs clearly intended to be noticed during the process of sale and equally clearly intended to be completely hidden from view in the final use. Here, for example, there was ample evidence that the features of the device were displayed in advertisements and in displays at trade shows. That evidence was disregarded by the Board because, in its view, doctors should select implants solely for their functional characteristics, not their design. It is not the task of the Board to make such presumptions.

The decision of the Board is
REVERSED and the case is REMANDED.



Rosco, Inc. v. Mirror Lite Co.

304 F.3d 1373 (Fed. Cir. 2002)

DYK, Circuit Judge.

Rosco, Inc. (“Rosco”) appeals the decision of the United States District Court for the Eastern District of New York finding Rosco’s design patent, United States Design Patent No. 346,357 (“the ‘357 patent”), invalid as functional and obvious Because the district court erred in finding the ‘357 patent invalid as functional and obvious [we reverse].

BACKGROUND

Rosco and Mirror Lite are competitors in the school bus mirror market. This dispute involves “cross-view” mirrors, which are convex, three-dimensional, curved surface mirrors mounted on the front fender of a school bus, enabling the bus driver to view the front and passenger side of a school bus. Rosco filed a complaint on November 19, 1996, and amended the complaint on December 27, 1996 (the “Rosco I case”). A second civil action was subsequently filed by Rosco in October 1999 (the “Rosco II case”). Mirror Lite asserted a counterclaim in the second action. The two cases were consolidated.

Each party owns a patent that it alleged was infringed by the other. Rosco raised a variety of other claims.

1. Rosco’s ‘357 Design Patent

Rosco’s ‘357 design patent relates to an oval, highly convex cross-view mirror with a black, flat metal backing. Rosco applied for the patent on April 14, 1992, and the patent issued on April 26, 1994. Rosco alleged that Mirror Lite infringed the ‘357 design patent. Mirror Lite argued that the ‘357 design patent was invalid as functional and therefore was not infringed.

2. Mirror Lite’s ‘984 Utility Patent

Mirror Lite’s ‘984 utility patent relates to an oval cross-view mirror with a varying radius of curvature along the major axis of the convex ellipsoid mirror lens. Mirror Lite filed the parent application that led to the ‘984 patent on September 9, 1992. The ‘984 patent issued on December 31, 1996. ...

DISCUSSION ...

I ROSCO’S ‘357 DESIGN PATENT

“A patent shall be presumed valid.” 35 U.S.C. S 282 (2000). To overcome this presumption of validity, the party challenging a patent must prove facts supporting a determination of invalidity by clear and convincing evidence. Apotex USA, Inc.

v. Merck & Co., 254 F.3d 1031, 1036 (Fed.Cir.2001), cert. denied, 534 U.S. 1172, 1378*1378 122 S.Ct. 1196, 152 L.Ed.2d 136 (2002) (citing Am. Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1360, 220 USPQ 763, 770 (Fed.Cir.1984)).

Rosco's '357 design patent shows a highly convex, curved-surface, three-dimensional oval mirror with a black, flat metal backing. In May 1992, Rosco began manufacturing the mirror of the '357 patent under the name "Eagle Eye."

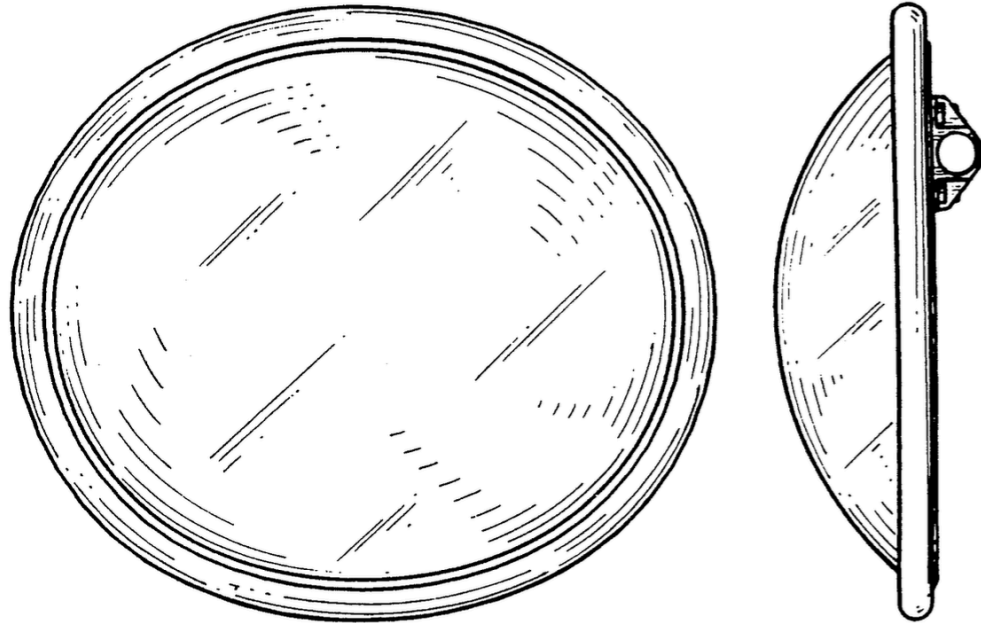
Rosco alleged that Mirror Lite infringed the '357 patent by manufacturing and selling a duplicate of Rosco's mirror under the name "Hawk Eye." Mirror Lite argued that the '357 patent was invalid as functional. The district court found the '357 design patent invalid as functional. Rosco, 139 F.Supp.2d at 296.

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." L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed.Cir.1993) (citing In re Carletti, 51 C.C.P.A. 1094, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964)). "[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." Seiko Epson Corp. v. Nu-Kote Int'l, Inc., 190 F.3d 1360, 1368, 52 USPQ2d 1011, 1017 (Fed.Cir.1999). "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, 988 F.2d at 1123, 25 USPQ2d at 1917 (citations omitted). That is, if other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional. Invalidity of a design patent claim must be established by clear and convincing evidence. Id.

The district court found that because the mirror's oval shape, the asserted point of novelty of the '357 patent, "of necessity dictates its function," the '357 patent was invalid as functional. Rosco, 139 F.Supp.2d at 296. The court based its determination of functionality on its findings that the mirror of the '357 patent offered a unique field of view (when compared to Mirror Lite's Bus Boy mirror); that Rosco represented to the Patent and Trademark Office that its mirror provided a superb field of view; and that Rosco marketed the mirror of the '357 patent as more "aerodynamic" than other cross-view mirrors. Id.

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

Mirror Lite has not shown by clear and convincing evidence that there are no designs, other than the one shown in Rosco's '357 patent, that have the same functional capabilities as Rosco's oval mirror. Under these circumstances it cannot be said that the claimed design of the '357 patent was dictated by functional considerations. We reverse the district court and hold that the '357 patent claim was not shown to be invalid on functionality grounds. ...



Wing Shing Products (BVI) Co. v. Sunbeam Products, Inc.
665 F. Supp. 2d 357 (S.D.N.Y. 2009)

RICHARD J. HOLWELL, District Judge.

Plaintiff Wing Shing brings this action against defendants Sunbeam and Simatelex for infringement of a patented coffee maker design. The matter now comes before the Court on defendants' motions for summary judgment. For the reasons stated below, those motions are granted. Simatelex's motion to dismiss for lack of personal jurisdiction is denied as moot.

BACKGROUND

Plaintiff Wing Shing, a British Virgin Islands corporation based in Hong Kong, owns United States Design Patent No. D348,585 ("the '585 patent") for the ornamental design of a coffeemaker. Defendant Sunbeam is a Delaware corporation that sells coffee makers under the MR. COFFEE brand. Defendant Simatelex is a company

located in Hong Kong that manufactures and sells coffee makers for Sunbeam.

The subject of this action is a line of MR. COFFEE automatic coffee-making devices called the “AR series,” which defendants manufactured and sold between 2001 and 2006. The AR series included three primary designs, the most popular of which, the “AR 10/12,” accounted for more than 85% of total AR sales. ...

The Court denied defendants’ original summary judgment motions without prejudice and stayed this action pending issuance of the en banc decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*, which portended significant revision of the standard for design patent infringement. The parties renewed and re-briefed the motions after the Federal Circuit issued its now-seminal opinion. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008). ...

DISCUSSION

A. Egyptian Goddess

To determine if an accused object infringes a design patent, courts have traditionally undertaken a familiar two-step approach: first, construing the patent claim to determine its scope; and second, comparing the construed claim to the accused design to determine whether they are “substantially the same.” *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). In *Egyptian Goddess*, the Federal Circuit significantly altered both steps in the analysis. First, the court strongly discouraged the construction of a design patent through a detailed verbal description of the claimed design. *Id.* at 679. Unlike utility patents, which ordinarily include textual claims requiring detailed construction, design patents are typically claimed only as shown in drawings. For this reason, *Egyptian Goddess* makes it “clear that the [trial] court is not obligated to issue a detailed verbal description of the design” and, indeed, warns courts of “the risks entailed in such a description.” *Id.* at 679-80. Though district courts may still exercise their discretion to point out relevant “features of the claimed design as they relate to the accused design and the prior art,” the general rule is now that “illustration . . . is its own best description.” *Id.* at 679-80 (quoting Manual of Patent Examining Procedure § 1503.01 (8th ed. 2006)). District courts following *Egyptian Goddess* have generally relied on patent drawings to construe design claims. See, e.g., *Arc’teryx Equip., Inc. v. Westcomb Outerwear, Inc.*, No. 07-cv-59, [2008 BL 250693], 2008 WL 4838141, at *2 (D. Utah Nov. 4, 2008); *Chef’n Corp. v. Trudeau Corp.*, No. C08-01135 (MJP), [2009 BL 121189], 2009 WL 1564229, at *4 (W.D. Wash. June 4, 2009); *HR U.S. LLC v. Mizco Int’l, Inc.*, No. CV-07-2394 (DGT) (JO), [2009 BL 66775], 2009 WL 890550 (E.D.N.Y. Mar. 31, 2009). This Court will follow suit and construes Wing Shing’s claim as the ornamental design for a coffeemaker, as shown in figures 1 through 7 of the ‘585 patent.

Egyptian Goddess also significantly changed the analytical framework for comparing the claimed design to the accused design to determine whether there has been infringement. Previously, the Federal Circuit prescribed a two-pronged test. Plaintiffs had to satisfy the hoary “ordinary observer” test set down in *Gorham v. White*, 81 U.S. 511 (1871), by proving that the patented design and the accused design would appear substantially similar to “the eye of the ordinary observer;” and plaintiffs also had to prove that the accused design appropriated the patented design’s “points of novelty” — the innovative features that distinguished it from the prior art. *Egyptian Goddess*, 543 F.3d at 670-71. *Egyptian Goddess* struck the “points of novelty” test from the framework, but incorporated its regard for the prior art into a new, enhanced version of the “ordinary observer” standard. Now, the test for design patent infringement consists of a single inquiry: “whether an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design.” *Id.* at 672.

The Federal Circuit abandoned the separate “points of novelty” prong because it proved ill-suited to all but the simplest cases. The test required identification of every “novel” feature in a patent, and where moderately complex designs were at issue, this subsidiary analysis often sidetracked courts and fact-finders from the salient question of “whether the accused design . . . appropriated the claimed design as a whole.” *Id.* at 677 (emphasis added). Application of the test raised such nettlesome and ultimately distracting issues as whether a new combination of old design features could constitute one or more “points of novelty.” *Id.* And defendants sometimes exploited the points of novelty analysis to argue that an accused design that was substantially identical to the patented design was nonetheless non-infringing simply because it did not appropriate a particular, arguably “novel” detail. *Id.*

In place of this onerous and often unproductive analysis, the court decided to fold the essence of the points of novelty test, with its focus on the degree to which the patented design departed from the prior art, into the ordinary observer test. Rather than parse the “novelty” of individual design elements, courts and fact-finders should now ask whether the two designs in question would appear “substantially the same” to an ordinary observer who is already familiar with the prior art. *Id.* The court was careful to note that this qualified ordinary observer standard serves many of the same purposes of the two-pronged approach it superceded. *Id.* at 678. Like the “points of novelty” test, the *Egyptian Goddess* standard is engineered to avoid the anomalous result where a design that simply embodies a piece of prior art is found to infringe. *Id.* But instead of addressing this problem by requiring an impractical determination of whether the accused device copies the “novel” aspects of a design patent, the law now endows its hypothetical ordinary observer with the knowledge and competence to distinguish between the patented object and its predecessors. As a result, if the patent and the prior art are particularly close, the scale

of comparison between the accused and patented designs shrinks. See *id.* at 676 (“When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important . . .”). Differences between the claimed design and the prior art clearly remain central to this analysis; however, unlike in the old approach, those differences are not examined in isolation for their “novelty.” *Id.* at 678.

Egyptian Goddess further explained that consideration of prior art is not required in every case, but only where the accused and claimed designs appear “substantially the same” in the first instance:

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. . . . In other instances, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art. . . .

Id. at 678; see *HR U.S. LLC*, [2009 BL 66775], 2009 WL 890550, at *10 (“a plaintiff must, as a threshold matter, show that the claimed and accused designs are not ‘plainly dissimilar’”). In other words, there are two levels to the infringement analysis: a level-one or “threshold” analysis to determine if comparison to the prior art is even necessary, and a second level analysis that accounts for prior art in less obvious cases.

B. Side-by-Side “Threshold” Analysis

Sunbeam argues that the ‘585 patent and the primary accused device — the AR 10/12 — are so plainly dissimilar that, even without considering any prior art, no reasonable fact-finder could conclude that they would appear “substantially the same” to an ordinary observer. The argument is not without merit. The two designs are pictured below:

'585 PatentAR 10/12 (Accused)

Two major differences between the designs are apparent. First, they have different bases: the '585 has a “bullnose” base — it is flat with a rectangular cross section up to the tip, where the top and bottom meet on a curve — while the AR 10/12 has a smooth base that slopes gradually from the heating plate. The designs also have dramatically different tops: the '585's is flat, whereas the AR's has a circular indent partially overhung by the lid to the water reservoir. As Sunbeam points out, these differences come at “focal points” in the designs: the top and base are the most visually commanding features of a coffeemaker, along perhaps with the brew basket. At least one district court applying *Egyptian Goddess* has granted summary judgment without considering prior art where two designs differed primarily at one highly significant feature. See *Minka Lighting, Inc. v. Maxim Lighting Intern, Inc.*, No. 3:06-CV-995-K, [2009 BL 53921], 2009 WL 691594, at *7 (N.D. Tex. Mar. 16, 2009). Here, however, in the cluttered world of the drip-coffeemakers, it seems senseless to attempt to determine whether the “ordinary observer” would confuse two designs without looking to the prior art for a point of reference. See *Egyptian Goddess*, 543 F.3d at 675 (quoting *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933) (“in a crowded art the composite of differences presents a different impression to the eye of the average observer. . . .”)). That “a purchaser of things of similar design,” as the ordinary observer has been defined, *Applied Arts*, 67 F.2d at 430, could be deceived by the devices' similarities seems unlikely to the Court, but resolution of the inquiry would benefit from a concrete guidepost. See *Egyptian Goddess*, 543 F.3d at 676-77 (“[I]t can be difficult to answer the question whether one thing is like another without being given a frame

of reference”). Thus, though the Court acknowledges manifest differences in the overall appearance of the ‘585 and the AR 10/12, it turns to the prior art for context.

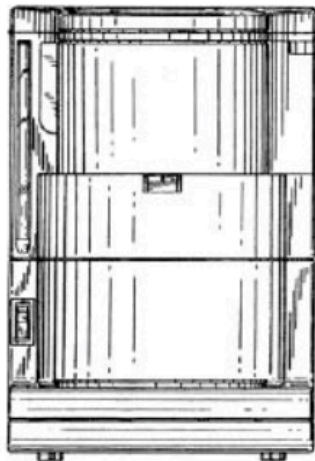
C. Prior Art Comparisons

Defendants identify numerous examples of prior art. The primary piece is a coffee maker called the “Accel” that Sunbeam itself developed in the early 1990’s. (Def. 56.1 ¶¶ 37-39, 43.) The Accel and the ‘585 are pictured below:

‘585 patent



Accel (Prior Art)



The two designs are quite similar. Each has a large, smooth brew basket with a circular cross section that is partially encased by vertical shafts connecting the brew

basket to the base of the machine. Each has a similarly shaped recess for the carafe. Both designs call to mind the familiar white or black coffeemaker that graces most American kitchens. As will be noted, differences exist, but on the whole the claimed design when compared to the prior art bespeaks “a field . . . crowded with many references relating to the design of the same type of appliance.” See *Egyptian Goddess*, 543 F.3d at 676 (quoting *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984)). Accordingly, the scope of protection afforded the ‘585 patent falls in a “narrow range.” *Id.*

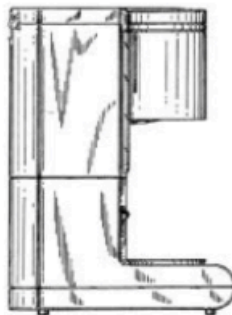
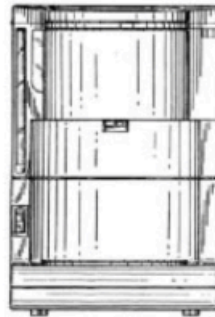
As for dissimilarities, the base is surely the most prominent observable difference between the designs. In contrast to the “bullnose” on the ‘585, the Accel has an angular base with a trapezoidal cross section. To the extent the devices have distinct overall appearances, their different bases supply them. There are additional minor differences — the top of the Accel is slightly crowned, while the ‘585’s is flat; and the water reservoir on the ‘585 extends further around the circumference of the brew basket — but these small details do not make nearly the visual impression that the distinct bases do.

If the AR 10/12 (the accused design) had copied the ‘585’s bullnose base — the one feature of the ‘585 that “departs conspicuously” from the prior art as depicted in the Accel — an inference of infringement might arise. See *id.* at 677 (“If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design. . . .”). Instead, the AR 10/12 has its own, unique base, as is all the more apparent when viewed alongside both the ‘585 and the Accel:

Accel

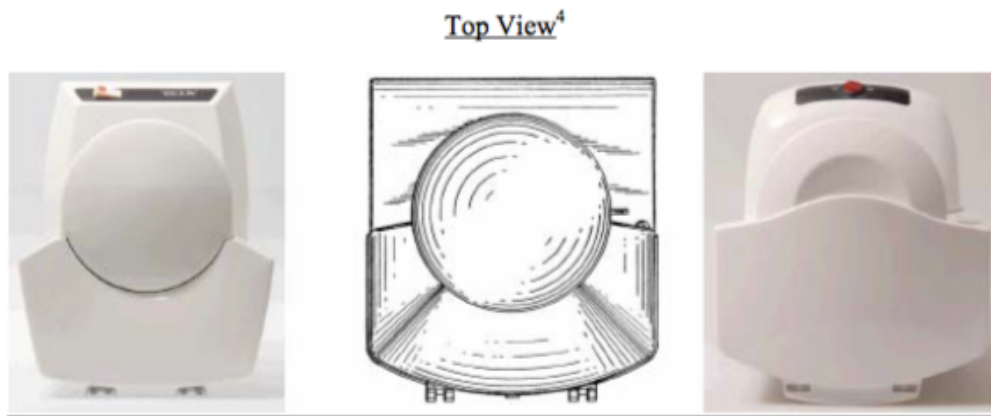


'585 Patent



AR 10/12





Because the AR 10/12 and the ‘585 differ at the very feature that primarily distinguishes the ‘585 from the Accel, no ordinary observer familiar with the Accel would be deceived into believing that the AR 10/12 and the ‘585 are the same. Indeed, since it is difficult to tell the ‘585 and the Accel apart without focusing on their bases, it would be unreasonable to conclude that any observer capable of distinguishing those two machines would confuse the AR 10/12 and the ‘585, which also have different bases. See *Egyptian Goddess*, 543 F.3d at 676 (“When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art.”). Additionally, the AR 10/12’s unique lid configuration, which distances it from both the ‘585 and the prior art, further solidifies the conclusion that no genuine issue of material fact as to non-infringement exists here.

The Court remains mindful of the Federal Circuit’s admonition to “analyz[e] the design as a whole” and not engage in an “element-by-element comparison” of the devices in question. See *Amini Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006). Nonetheless, when the prior art is used as a “frame of reference,” *Egyptian Goddess*, 543 F.3d at 677, the tops and bases of the devices in question dominate the overall visual impressions they make. See *HR U.S. LLC v. Mizco Int’l., Inc.*, [2009 BL 66775], 2009 WL 890550, at *12 (“Summary judgment . . . is appropriate where specific ornamental features substantially impact the overall design. . . .”). As *Egyptian Goddess* itself recognized, where a particular design element sharply distinguishes, against the context of the prior art, the claimed design from the accused design, it is not error to focus on that element in the infringement analysis. See *Egyptian Goddess*, 543 F.3d at 680-83 (summary judgment where accused design, in contrast to claimed design, contained fourth abrasive buffer).

Plaintiff argues that summary judgment cannot be granted here because, unlike in *Egyptian Goddess*, the AR 10/12 is “closer to the patented design than the prior

art.” Plaintiff contends that the AR 10/12 is closer to the ‘585 patent than the Accel because the “body” of the AR 10/12 — the region from “the bottom of the lid to the top of the base” — is “substantially identical” to the body of the ‘585 design. (Pl. Opp. at 18.) The Court does not find this argument persuasive. First, in focusing on the “body” of the design, plaintiff has chosen a frame of reference that conveniently excludes the salient points of comparison — the top and the base. Under this framework, the Accel itself could be found to infringe, because to the layman’s eye, its “body” is not readily distinguishable from the ‘585 patent. This is exactly the type of absurd result that consideration of the prior art is meant to avoid. See *Egyptian Goddess*, 543 F.3d at 678. Secondly, whether the accused device is “closer” to the patented design than to the prior art is not the controlling inquiry. *Egyptian Goddess* notes that strong similarities between the accused design and the prior art are an indication of non-infringement, but it does not require a mechanical determination — which in this case of “crowded art” would be impractical — that the accused device is “closer” to either the patent or the prior art. Instead, *Egyptian Goddess* requires an assessment of how the prior art will impact the ordinary observer’s perception of the accused and claimed designs. *Id.* at 676, 678. Here, for example, though reasonable jurors might disagree on whether the AR 10/12 is “closer” to the Accel or the ‘585 patent (it is different than both), no reasonable juror could dispute that an ordinary observer familiar with the Accel would not believe the AR 10/12 to be the “same as” the ‘585 patent. ...

CONCLUSION

For the reasons stated above, defendants’ motions for summary judgment are granted. ...

Eames Chair Problem, Re-revisited

Look again at the Eames Lounge Chair. Could its design be protected with a design patent?

Smartphone Problem

Here are Figure 1 from Design Patent 604,305 (left), assigned to Apple, and a picture of the Samsung Galaxy S (right). Does the Galaxy S infringe the ’305 patent?

