

## Design

<b>9 Design</b>	<b>3</b>
<b>A Patent</b>	<b>3</b>
<b>B Copyright</b>	<b>3</b>
<b>1 Useful Articles</b>	<b>4</b>
<i>Mazer v. Stein</i>	4
Copyright Act § 101 (“useful article”)	5
H.R. Rep No. 94-1476	6
<i>Star Athletica, LLC v. Varsity Brands, Inc.</i>	7
Eames Chair Problem	14
Copyright Act § 113	14
Report of the Register of Copyrights on the General Revision of the Copyright Law (1961)	15
Model Car Problem	16
<b>2 Moral Rights</b>	<b>16</b>
<i>Cheffins v. Stewart</i>	16
<b>C Trademark</b>	<b>21</b>
<i>Wal-Mart Stores, Inc. v. Samara Brothers, Inc.</i>	22
Lanham Act §§ 2(e)(5), 43(a)(3)	25
<i>TrafFix Devices, Inc. v. Marketing Displays, Inc.</i>	25
<i>In re Florists’ Transworld Delivery, Inc.</i>	30
<i>Maker’s Mark Distillery, Inc. v. Diageo North             America, Inc.</i>	32
Eames Chair Problem, Revisited	33
Pez Dispenser Problem	33
<b>D Design Patent</b>	<b>33</b>
Patent Act §§ 171, 173	34
<b>1 Subject Matter</b>	<b>39</b>
<b>a Articles of Manufacture</b>	<b>39</b>
<i>In re Hruby</i>	39
<i>In re AlSabah</i>	42
<b>b Ornamentality</b>	<b>44</b>
<i>In re Webb</i>	44
<i>Rosco, Inc. v. Mirror Lite Co.</i>	46
<i>In re Koehring</i>	48
<b>2 Procedures</b>	<b>49</b>

	MPEP § 1503 . . . . .	49
	Patent Act § 173 . . . . .	51
<b>3</b>	<b>Ownership</b> . . . . .	<b>52</b>
<b>a</b>	<b>Novelty</b> . . . . .	<b>52</b>
	<i>International Seaway Trading Corp. v. Walgreens Corp.</i> . . . . .	52
<b>b</b>	<b>Obviousness</b> . . . . .	<b>54</b>
	<i>MRC Innovations, Inc. v. Hunter Mfg., LLP,</i> . . . . .	54
<b>4</b>	<b>Infringement: Similarity</b> . . . . .	<b>58</b>
	<i>Egyptian Goddess, Inc. v. Swisa, Inc.</i> . . . . .	58
	<i>Wing Shing Products (BVI) Co. v. Sunbeam Products, Inc.</i> . . . . .	63
	<i>OddzOn Products, Inc. v. Just Toys, Inc.</i> . . . . .	68
	<i>L.A. Gear, Inc. v. Thom McAn Shoe Co.</i> . . . . .	69
<b>5</b>	<b>Infringement: Prohibited Conduct</b> . . . . .	<b>69</b>
	Patent Act § 289 . . . . .	69
<b>6</b>	<b>Defenses</b> . . . . .	<b>70</b>
	<i>Jazz Photo Corp. v. International Trade Com'n</i> . . . . .	70
	Ralph D. Clifford & Richard J. Peltz-Steele, <i>The Constitutionality of Design Patents</i> . . . . .	71
	Eames Chair Problem, Re-revisited . . . . .	73

---

## Design

---

This chapter deals with IP protections for the designs of three-dimensional objects. The fundamental conceptual challenge such objects present is that they can be both useful and beautiful, and the bodies of IP law we have studied so far tend to insist either that they only protect the useful aspects or only that they don't protect the useful aspects. Thus, the doctrinal challenge in each IP area is how to draw the line between the utilitarian/functional/useful/applied aspects of an object's design and everything else. As we will see, design patents cut the Gordian knot by defining utility extraordinarily narrowly. But to understand how that solution works, we first need to see the difficulties other approaches face. And, as we will see, the design-patent solution creates its own difficulties.

### A Patent

There are no per se rules preventing the issuance of utility patents on three-dimensional designs; they are just not usually an effective tool for protecting design as such. One problem is utility: if the design's only improvement over the prior art is that it looks better, this might not qualify even under the permissive *Juicy Whip* standard. Another is claim drafting: to twist the phrase, writing about design is like dancing about architecture. Indefiniteness and enablement are likely to hem in the applicant's ability to capture the design in words. So while utility patents are well adapted to capturing the functional aspects of a design, they are so awkward as to be useless at capturing everything else.

### B Copyright

Copyright deals with the functionality problem for three-dimensional objects in three different ways, depending on whether

The problem of classifying objects as "useful" or "beautiful" extends far beyond intellectual property law. Consider: "In 1989, the United States moved to an international [tariff] standard known as the Harmonized Commodity Description and Coding System. Chapter 97 of the Harmonized System applies to "'works of art, collectors' pieces and antiques' and provides duty-free entry to paintings, drawings, and pastels executed entirely by hand; collages, original engravings, prints, and lithographs; and original sculptures in any material—including the first twelve casts or reproductions. The Harmonized System lacks the [previous system's] explicit restriction on 'articles of utility.' But a note to Chapter 97 specifies that the sculpture category 'does not apply to mass-produced reproductions or works of conventional craftsmanship of a commercial character, even if these articles are designed or created by artists.' To qualify as sculpture, furniture—even furniture made by renowned, professional sculptors—cannot be 'capable of any functional use.'" Brian Soucek, *Aesthetic Judgments in Law*, 69 Ala. L. Rev. 381 (2017)

If you add in *Baker* and the variations introduced for computer software, there are at least five different functionality tests.

the work is sculptural or architectural, and on whether VARA is in play.

## 1 Useful Articles

One could imagine drawing a distinction between fine art (like paintings and novels) and non-art (like boats and tools). *Bleistein*, however, dooms any inquiry into a work's artistry. Instead, the modern test focuses on utility; if a work is useful at all, the question is how much of the work is infected by its utility. You already know the answer in two dimensions: it is given by *Baker* and the merger doctrine. In three dimensions, the test is somewhat more stringent.

### Mazer v. Stein

347 U.S. 201 (1954)

Respondents are partners in the manufacture and sale of electric lamps. One of the respondents created original works of sculpture in the form of human figures by traditional clay-model technique. From this model, a production mold for casting copies was made. The resulting statuettes, without any lamp components added, were submitted by the respondents to the Copyright Office for registration as "works of art" or reproductions thereof and certificates of registration issued. Thereafter, the statuettes were sold in quantity throughout the country both as lamp bases and as statuettes. Petitioners are partners and, like respondents, make and sell lamps. Without authorization, they copied the statuettes, embodied them in lamps and sold them.

[Under the 1909 Copyright Act, copyright extended to "all the writings of an author," and the two potentially applicable classes of works were "Works of art; models or designs for works of art" and "Reproductions of a work of art".]

The case requires an answer, not as to a manufacturer's right to register a lamp base but as to an artist's right to copyright a work of art intended to be reproduced for lamp bases. Petitioners question the validity of a copyright of a work of art for "mass" production. "Reproduction of a work of art" does not mean to them unlimited reproduction. Their position is that a copyright does not cover industrial reproduction of the protected article.

It is not the right to copyright an article that could have utility that petitioners oppose. Their brief accepts the copyrightability of the great carved golden saltcellar of Cellini but adds:

If, however, Cellini designed and manufactured this item in quantity so that the general public could have salt cellars, then an entirely different conclusion would be reached. In such case, the salt cellar becomes an article of



Lamp base



manufacture having utility in addition to its ornamental value and would therefore have to be protected by design patent.

The [longstanding] practice of the Copyright Office was to allow registration “as works of the fine arts” of articles of the same character as those of respondents now under challenge. It is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts. Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration.

We hold that the [design] patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted.

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in “Science and useful Arts.” Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

Douglas, J., concurring:

An important constitutional question underlies this case—a question which was stirred on oral argument but not treated in the briefs. The Copyright Office has supplied us with a long list of such articles which have been copyrighted – statuettes, book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays. Perhaps these are all “writings” in the constitutional sense. But to me, at least, they are not obviously so.

---

*Mazer* frames the question. Here is how Congress tried to answer it in the 1976 Copyright Act.

### Copyright Act

- “Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps,



Salt cellar by Benvenuto Cellini.

The Cellini Salt Cellar, worth an estimated \$60 million, was stolen in 2003 from the Kunsthistorisches Museum in Vienna and recovered in 2006 after the thief was identified.

17 U.S.C. § 101  
Definitions

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”.

#### H.R. Rep No. 94-1476

1976 U.S.C.A.N. 5659

The Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. 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. The test of separability and independence from ‘the utilitarian aspects of the article’ does not depend upon the nature of the design – that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.

In reporting S. 22, the House Judiciary Committee has deleted Title II, which would create a new limited form of copyright protection

for “original” designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself. Thus designs of useful articles which do not meet the design patent standard of “novelty” would for the first time be protected. The Committee chose to delete Title II in part because the new form of design protection provided by Title II could not truly be considered copyright protection and therefore appropriately within the scope of copyright revision. In addition, Title II left unanswered at least two fundamental issues which will require further study by the Congress. These are: first, what agency should administer this new design protection system and, second, should typeface designs be given the protections of the title? The issues raised by Title II have not been resolved by its deletion from the Copyright Revision Bill. Therefore, the Committee believes that it will be necessary to reconsider the question of design protection in new legislation during the 95th Congress. At that time more complete hearings on the subject may be held.

### **Star Athletica, LLC v. Varsity Brands, Inc.**

137 S.Ct. 1002 (2017)

Respondents Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc., design, make, and sell cheerleading uniforms. Respondents have obtained or acquired more than 200 U.S. copyright registrations for two-dimensional designs appearing on the surface of their uniforms and other garments. These designs are primarily combinations, positionings, and arrangements of elements that include chevrons, lines, curves, stripes, angles, diagonals, inverted chevrons, coloring, and shapes.

Petitioner Star Athletica, L.L.C., also markets and sells cheerleading uniforms. Respondents sued petitioner for infringing their copyrights in the five designs.

## II

The Copyright Act establishes a special rule for copyrighting a pictorial, graphic, or sculptural work incorporated into a “useful article,” which is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” The statute does not protect useful articles as such. Rather, “the design of a useful article” is “considered a pictorial, graphical, 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.”

Courts, the Copyright Office, and commentators have described the analysis undertaken to determine whether a feature can be sepa-



Varsity uniform design

rately identified from, and exist independently of, a useful article as “separability.” In this case, our task is to determine whether the arrangements of lines, chevrons, and colorful shapes appearing on the surface of respondents’ cheerleading uniforms are eligible for copyright protection as separable features of the design of those cheerleading uniforms.

### A

As an initial matter, we must address whether separability analysis is necessary in this case.

Respondents contend that the surface decorations in this case are “two-dimensional graphic designs that appear on useful articles,” but are not themselves designs of useful articles. Consequently, the surface decorations are protected two-dimensional works of graphic art without regard to any separability analysis under. Under this theory, two-dimensional artistic features on the surface of useful articles are “inherently separable.”

This argument is inconsistent with the text of § 101. The statute requires separability analysis for any “pictorial, graphic, or sculptural features” incorporated into the “design of a useful article.” And the statute expressly defines “[p]ictorial, graphical, and sculptural works” to include “two-dimensional ... works of ... art.” The statute thus provides that the “design of a useful article” can include two-dimensional “pictorial” and “graphic” features, and separability analysis applies to those features just as it does to three-dimensional “sculptural” features.

### B

We must now decide when a feature incorporated into a useful article “can be identified separately from” and is “capable of existing independently of” “the utilitarian aspects” of the article.

The statute provides that a “pictorial, graphic, or sculptural feature[e]” incorporated into the “design of a useful article” is eligible for copyright protection if it (1) “can be identified separately from,” and (2) is “capable of existing independently of, the utilitarian aspects of the article.” § 101. The first requirement – separate identification – is not onerous. The decisionmaker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.

The independent-existence requirement is ordinarily more difficult to satisfy. The decisionmaker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article. In other words, the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in § 101

Can you imagine a two-dimensional “pictorial” or “graphic” feature that is *not* separable under the test the court announces in the next section?

once it is imagined apart from the useful article. If the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.

Of course, to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or “[a]n article that is normally a part of a useful article” (which is itself considered a useful article). Nor could someone claim a copyright in a useful article merely by creating a replica of that article in some other medium – for example, a cardboard model of a car. Although the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.

### C

In sum, a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.

Applying this test to the surface decorations on the cheerleading uniforms is straightforward. First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium – for example, on a painter’s canvas – they would qualify as “two-dimensional ... works of ... art.” And imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself. Indeed, respondents have applied the designs in this case to other media of expression – different types of clothing – without replicating the uniform. The decorations are therefore separable from the uniforms and eligible for copyright protection.

The dissent argues that the designs are not separable because imaginatively removing them from the uniforms and placing them in some other medium of expression – a canvas, for example – would create “pictures of cheerleader uniforms.” Petitioner similarly argues that the decorations cannot be copyrighted because, even when extracted from the useful article, they retain the outline of a cheerleading uniform.

This is not a bar to copyright. Just as two-dimensional fine art corresponds to the shape of the canvas on which it is painted, two-dimensional applied art correlates to the contours of the article on which it is applied. A fresco painted on a wall, ceiling panel, or dome would not lose copyright protection, for example, simply because it was designed to track the dimensions of the surface on which it was



painted. Or consider, for example, a design etched or painted on the surface of a guitar. If that entire design is imaginatively removed from the guitar's surface and placed on an album cover, it would still resemble the shape of a guitar. But the image on the cover does not "replicate" the guitar as a useful article. Rather, the design is a two-dimensional work of art that corresponds to the shape of the useful article to which it was applied. The statute protects that work of art whether it is first drawn on the album cover and then applied to the guitar's surface, or vice versa. Failing to protect that art would create an anomaly: It would extend protection to two-dimensional designs that cover a part of a useful article but would not protect the same design if it covered the entire article. The statute does not support that distinction, nor can it be reconciled with the dissent's recognition that "artwork printed on a t-shirt" could be protected.

To be clear, the only feature of the cheerleading uniform eligible for a copyright in this case is the two-dimensional work of art fixed in the tangible medium of the uniform fabric. Even if respondents ultimately succeed in establishing a valid copyright in the surface decorations at issue here, respondents have no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the ones on which the decorations in this case appear. They may prohibit only the reproduction of the surface designs in any tangible medium of expression – a uniform or otherwise.

## D

Petitioner and the Government raise several objections to the approach we announce today. None is meritorious.

### 1

Petitioner first argues that our reading of the statute is missing an important step. It contends that a feature may exist independently only if it can stand alone as a copyrightable work and if the useful article from which it was extracted would remain equally useful. In other words, copyright extends only to "solely artistic" features of useful articles. According to petitioner, if a feature of a useful article "advance[s] the utility of the article," then it is categorically beyond the scope of copyright. The designs here are not protected, it argues, because they are necessary to two of the uniforms' "inherent, essential, or natural functions" – identifying the wearer as a cheerleader and enhancing the wearer's physical appearance. Because the uniforms would not be equally useful without the designs, petitioner contends that the designs are inseparable from the "utilitarian aspects" of the uniform.

The debate over the relative utility of a plain white cheerleading uniform is unnecessary. The focus of the separability inquiry is on

the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.

Of course, because the removed feature may not be a useful article – as it would then not qualify as a pictorial, graphic, or sculptural work – there necessarily would be some aspects of the original useful article “left behind” if the feature were conceptually removed. But the statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one. Indeed, such a requirement would deprive the Mazer statuette of protection had it been created first as a lamp base rather than as a statuette. Without the base, the “lamp” would be just a shade, bulb, and wires. The statute does not require that we imagine a nonartistic replacement for the removed feature to determine whether that feature is capable of an independent existence.

Because we reject the view that a useful article must remain after the artistic feature has been imaginatively separated from the article, we necessarily abandon the distinction between “physical” and “conceptual” separability, which some courts and commentators have adopted based on the Copyright Act’s legislative history. According to this view, a feature is physically separable from the underlying useful article if it can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact. Conceptual separability applies if the feature physically could not be removed from the useful article by ordinary means.

The statutory text indicates that separability is a conceptual undertaking. Because separability does not require the underlying useful article to remain, the physical-conceptual distinction is unnecessary.

2

Petitioner next argues that we should incorporate two “objective” components, into our test to provide guidance to the lower courts: (1) “whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influence,” and (2) whether “there is a substantial likelihood that the pictorial, graphic, or sculptural feature would still be marketable to some significant segment of the community without its utilitarian function.”

We reject this argument because neither consideration is grounded in the text of the statute. The first would require the decisionmaker to consider evidence of the creator’s design methods, purposes, and reasons. The statute’s text makes clear, however, that

our inquiry is limited to how the article and feature are perceived, not how or why they were designed.

The same is true of marketability. Nothing in the statute suggests that copyrightability depends on market surveys. Moreover, asking whether some segment of the market would be interested in a given work threatens to prize popular art over other forms, or to substitute judicial aesthetic preferences for the policy choices embodied in the Copyright Act. *See ??*.

### III

We hold that an artistic feature of the design of a useful article is eligible for copyright protection if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article. Because the designs on the surface of respondents' cheerleading uniforms in this case satisfy these requirements, the judgment of the Court of Appeals is affirmed.

Justice Ginsburg, concurring in the judgment

I concur in the Court's judgment but not in its opinion. Unlike the majority, I would not take up in this case the separability test appropriate under 17 U.S.C. § 101.1 Consideration of that test is unwarranted because the designs at issue are not designs of useful articles. Instead, the designs are themselves copyrightable pictorial or graphic works reproduced on useful articles.<sup>2</sup>

Justice Breyer, dissenting

I agree with much in the Court's opinion. But I do not agree that the designs that Varsity Brands, Inc., submitted to the Copyright Office are eligible for copyright protection.

### I

An example will help. Imagine a lamp. with a circular marble base, a vertical 10-inch tall brass rod (containing wires) inserted off center on the base, a light bulb fixture emerging from the top of the brass rod, and a lampshade sitting on top. In front of the brass rod a porcelain Siamese cat sits on the base facing outward. Obviously, the Siamese cat is physically separate from the lamp, as it could be easily removed while leaving both cat and lamp intact. And, assuming it otherwise qualifies, the designed cat is eligible for copyright protection.

Now suppose there is no long brass rod; instead the cat sits in the middle of the base and the wires run up through the cat to the bulbs. The cat is not physically separate from the lamp, as the reality of the lamp's construction is such that an effort to physically separate the cat and lamp will destroy both cat and lamp. The two are integrated



Cat lamp



Cat lamp



into a single functional object, like the similar configuration of the ballet dancer statuettes that formed the lamp bases at issue in *Mazer*. But we can easily imagine the cat on its own, as did Congress when conceptualizing the ballet dancer. In doing so, we do not create a mental picture of a lamp (or, in the Court's words, a "replica" of the lamp), which is a useful article. We simply perceive the cat separately, as a small cat figurine that could be a copyrightable design work standing alone that does not replicate the lamp. Hence the cat is conceptually separate from the utilitarian article that is the lamp.

By way of contrast, Van Gogh's painting of a pair of old shoes, though beautifully executed and copyrightable as a painting, would not qualify for a shoe design copyright. Courts have similarly denied copyright protection to objects that begin as three-dimensional designs, such as measuring spoons shaped like heart-tipped arrows, candleholders shaped like sailboats, and wire spokes on a wheel cover. None of these designs could qualify for copyright protection that would prevent others from selling spoons, candleholders, or wheel covers with the same design. Why not? Because in each case the design is not separable from the utilitarian aspects of the object to which it relates. The designs cannot be physically separated because they themselves make up the shape of the spoon, candleholders, or wheel covers of which they are a part. And spoons, candleholders, and wheel covers are useful objects, as are the old shoes depicted in Van Gogh's painting. More importantly, one cannot easily imagine or otherwise conceptualize the design of the spoons or the candleholders or the shoes without that picture, or image, or replica being a picture of spoons, or candleholders, or wheel covers, or shoes. The designs necessarily bring along the underlying utilitarian object. Hence each design is not conceptually separable from the physical useful object.

In many or most cases, to decide whether a design or artistic feature of a useful article is conceptually separate from the article itself, it is enough to imagine the feature on its own and ask, "Have I created a picture of a (useful part of a) useful article?" If so, the design is not separable from the useful article. If not, it is.

## II

To ask this kind of simple question – does the design picture the useful article? – will not provide an answer in every case, for there will be cases where it is difficult to say whether a picture of the design is, or is not, also a picture of the useful article. But the question will avoid courts focusing primarily upon what I believe is an unhelpful feature of the inquiry, namely, whether the design can be imagined as a "two- or three-dimensional work of art." That is because virtually any industrial design can be thought of separately as a "work of



Vincent Van Gogh, "Shoes"



Marcel Duchamp, "In Advance of the Broken Arm"

art": Just imagine a frame surrounding the design, or its being placed in a gallery. Consider Marcel Duchamp's "readymades" series, the functional mass-produced objects he designated as art. What is there in the world that, viewed through an esthetic lens, cannot be seen as a good, bad, or indifferent work of art? What design features could not be imaginatively reproduced on a painter's canvas? Indeed, great industrial design may well include design that is inseparable from the useful article – where, as Frank Lloyd Wright put it, "form and function are one."

#### IV

If we ask the "separateness" question correctly, the answer here is not difficult to find. Can the design features in Varsity's pictures exist separately from the utilitarian aspects of a dress? Can we extract those features as copyrightable design works standing alone, without bringing along, via picture or design, the dresses of which they constitute a part? They certainly look like cheerleader uniforms. That is to say, they look like pictures of cheerleader uniforms, just like Van Gogh's old shoes look like shoes. I do not see how one could see them otherwise.

Were I to accept the majority's invitation to "imaginatively remov[e]" the chevrons and stripes as they are arranged on the neckline, waistline, sleeves, and skirt of each uniform, and apply them on a "painter's canvas," that painting would be of a cheerleader's dress. The esthetic elements on which Varsity seeks protection exist only as part of the uniform design – there is nothing to separate out but for dress-shaped lines that replicate the cut and style of the uniforms. Hence, each design is not physically separate, nor is it conceptually separate, from the useful article it depicts, namely, a cheerleader's dress. They cannot be copyrighted.

#### Eames Chair Problem

This is the Eames Lounge Chair by Charles and Ray Eames. Is its design copyrightable?



Eames Lounge Chair

#### Copyright Act

- (a) Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.
- (b) This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights

#### 17 U.S.C. § 113

*Scope of exclusive rights in pictorial, graphic, and sculptural works*

with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.

- (c) In the case of a work lawfully reproduced in useful articles that have been offered for sale or other distribution to the public, copyright does not include any right to prevent the making, distribution, or display of pictures or photographs of such articles in connection with advertisements or commentaries related to the distribution or display of such articles, or in connection with news reports. ...

### Report of the Register of Copyrights on the General Revision of the Copyright Law (1961)

There remains the question of protection to be given to a copyrighted work of art that is utilized as a design in the manufacture of useful articles. We believe that, where the copyrighted work is used as a design or decoration of a useful article, it should continue, as under the present law, to be protected by copyright if the owner wishes. However, where the "work of art" actually portrays the useful article as such – as in a drawing, scale model, advertising sketch, or photograph of the article – existing court decisions indicate that copyright in the "work of art" does not protect against manufacture of the useful article portrayed. We agree with these decisions and the distinctions made in them.

Some examples will illustrate these points.

- (3) Since the protection available to a copyrighted pictorial, graphic, or sculptural work is not affected by use of the work as a design or decoration of a useful article, the following works would continue to be accorded full protection under the copyright statute:
- A copyrighted painting reproduced on textile fabrics;
  - A copyrighted cartoon drawing or photograph reproduced on fabrics or in the form of toys or dolls;
  - A copyrighted drawing of a chair reproduced on a lampshade;
  - A copyrighted sculptured figure used as a lamp base.
- (4) Under distinctions indicated in existing court decisions, that the copyright in a work portraying a useful article as such would not protect against manufacture of that article, copyright protection would not extend to the following cases:

#### § 113.C.1.c

*Relationship between copyright and the designs of useful articles*

The present § 113 may be inartfully worded, but do you see how it adopts the Register's recommendations?

- A copyrighted drawing of a chair, used to manufacture chairs of that design;
- A copyrighted scale model of an automobile, used to manufacture automobiles of that design;
- A copyrighted technical drawing showing the construction of a machine, used to manufacture the machine;
- A copyrighted picture of a dress, used to manufacture the dress.

### Model Car Problem

Loosely based on *Meshwerks, Inc. v. Toyota Motor Sales USA, Inc.*, 528 F.3d 1258 (10th Cir. 2008)

You represent Schafer Software, creator of the hit *Out of Control* series of racing video games. Sterling normally pays car companies licensing fees to include their cars in the *Out of Control* games as part of the licensing agreement. Negotiations with Corley Motors have broken down over Corley's excessive licensing fee demands for its Corley Polecat – ten times higher than any other company is demanding per vehicle.

Marketing is desperate to include the Polecat in *Out of Control 2017* and has asked the development team to think of ways to include the Polecat without Corley's cooperation. They have suggested two ways of doing so. First, they could rent a Polecat and scan it with a high-resolution laser scanner that would generate an extremely detailed three-dimensional model. Second, it appears that digital copies of Corley's engineering diagrams for the Polecat have leaked onto car-enthusiast websites, where they have been available for months (with Corley's tacit acquiescence, it appears). The diagrams contain extremely detailed specifications for every part in the Polecat, as well as renderings showing a fully assembled Polecat from numerous angles. The developers believe that although both approaches would require significant work by Corley's 3D modeling artists, either approach would work for generating the files they would need to put the Polecat in *Out of Control 2017*.

Should Schafer proceed, and if so, how?

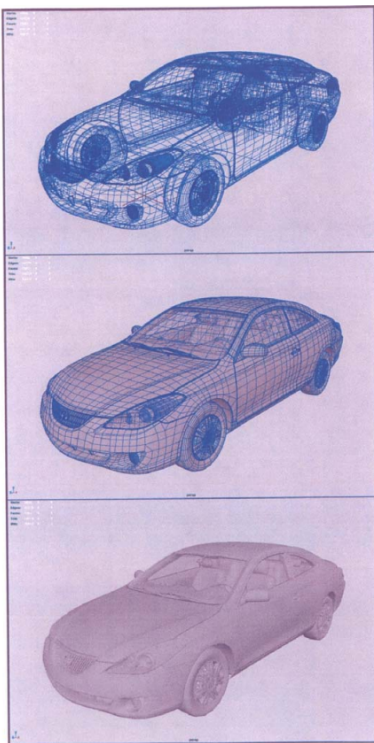
## 2 Moral Rights

VARA excludes from its coverage works of "applied art." Query how this standard differs from the tests applicable to the scope of copyright in a "useful article" or an "architectural work."

### Cheffins v. Stewart

825 F.3d 588 (9th Cir. 2016)

We must decide whether the Visual Artists Rights Act applies to a used school bus transformed into a mobile replica of a 16th-century



3D car model



Spanish galleon.

Plaintiffs Simon Cheffins and Gregory Jones, along with a number of volunteers, built the *La Contesssa*, a replica of a 16th-century Spanish galleon for use at the Burning Man Festival.<sup>1</sup> Cheffins began his creation by acquiring a used school bus. He and Jones then designed and constructed the galleon facade, including a hull, decking, masts, and a handcrafted figurehead. These elements and the bus were then transported to the Black Rock Desert in northern Nevada, the site of Burning Man, and assembled. When completed, the *La Contesssa* was approximately sixty feet wide and sixteen feet long with a mast over fifty feet tall.

The *La Contesssa* first appeared at the Festival in 2002. Festival participants took rides on the *La Contesssa*, and at least two weddings were performed on its deck. It reappeared in 2003 and 2005. In 2003, it was used as part of a marching band performance, and, in 2005, it was the centerpiece of a children's treasure hunt, among other things.

After the 2003 and 2005 Festivals, Cheffins and Jones stored the *La Contesssa* on land in Nevada held in life estate by one Joan Grant, who had given them permission to do so. In late 2005, however, Grant's home burned down, causing her to abandon the life estate. Thereafter, defendant Michael Stewart took possession of the land in fee simple through a limited liability company.

Cheffins and Jones did not relocate the *La Contesssa* after the change of property ownership. Rather, it sat unmoved on Stewart's land until December 2006. Sometime during that month, Stewart intentionally burned the wooden structure of the *La Contesssa* so that a scrap metal dealer could remove the underlying school bus from his property.

As the text of the statute shows, the VARA only applies to "works of visual art." On summary judgment, Stewart asserted, and the trial court subsequently concluded, that the *La Contesssa* was not a "work of visual art" because it was "applied art."

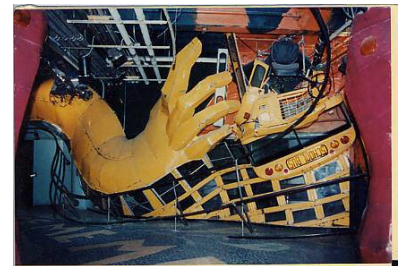
The VARA does not define the term "applied art," and federal courts have rarely had occasion to interpret its meaning. In *Carter v. Helmsley-Spear, Inc.*, the Second Circuit held that a sculpture constructed of portions of a school bus and affixed to a wall in a building lobby was not "applied art." It explained that the term "applied art" means "two-and threedimensional ornamentation or decoration that is affixed to otherwise utilitarian objects." The court further explained that the sculpture was not "applied art" simply because it was affixed to "the lobby's floor, walls, and ceiling" because "interpreting applied art to include such works would render meaningless

<sup>1</sup>Burning Man is an art and countercultural festival held each year for the week preceding Labor Day.



*La Contessa*

*Helmsley-Spear*: 71 F.3d 77 (2d Cir. 1995)



Installation by Jx3 from *Helmsley-Spear*

Pollara: 344 F.3d 265, 269 (2d Cir. 2003)



Banner by Joanne Pollara

VARA’s protection for works of visual art installed in buildings.”

The Second Circuit provided an additional gloss on what constitutes a “work of visual art,” and by extension what constitutes “applied art,” in *Pollara v. Seymour*, where it explained that the “VARA may protect a sculpture that looks like a piece of furniture, but it does not protect a piece of utilitarian furniture, whether or not it could arguably be called a sculpture.” The court went on to hold that an elaborate painted banner was not a “work of visual art” eligible for protection under the VARA.

We agree in large part with the Second Circuit’s analysis. As the Second Circuit suggested, the focus of our inquiry should be on whether the object in question originally was – and continues to be – utilitarian in nature. Dictionary definitions suggest that, in its ordinary meaning, applied art consists of an object with a utilitarian function that also has some artistic or aesthetic merit.

Further, this approach makes sense in the statutory context in which “applied art” is used in 17 U.S.C. § 101. “Applied art” is enumerated in a list that also contains, inter alia, maps, globes, charts, technical drawings, diagrams, models, newspapers, periodicals, data bases, and electronic information services. The fact that the other items in the list are utilitarian objects leads us to conclude that the listed items are related by their practical purposes and utilitarian functions, requiring a focus on utility when construing the term “applied art.”

We therefore hold that an object constitutes a piece of “applied art” – as opposed to a “work of visual art” – where the object initially served a utilitarian function and the object continues to serve such a function after the artist made embellishments or alterations to it.<sup>6</sup> This test embraces the circumstances both where a functional object incorporates a decorative design in its initial formulation, and where a functional object is decorated after manufacture but continues to serve a practical purpose. Conversely, “applied art” would not include a piece of art whose function is purely aesthetic or a utilitarian object which is so transformed through the addition of artistic elements that its utilitarian functions cease.

We respond briefly to the concern expressed in the concurrence that the standard we adopt today may not be workable – that it raises difficult questions regarding where exactly the line defining “applied art” will be drawn. The analysis we adopt today directs the court’s attention away from assessments of an object’s artistic merit and in-

<sup>6</sup>With recognition that nearly every object on which art is installed will be in some sense “utilitarian,” we caution that the utilitarian function must be something other than mere display of the work in question. See also 17 U.S.C. § 101 (“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.”).

stead toward the object's practical utility.

We now apply this standard to the facts of this case.

The *La Contesssa* began as a simple school bus – an object which unquestionably served the utilitarian function of transportation. To transform the bus into the *La Contesssa*, Cheffins and Jones adorned it with the visual trappings of a 16th-century Spanish galleon. While the *La Contesssa's* elaborate decorative elements may have had many artistic qualities, the *La Contesssa* retained a largely practical function even after it had been completed. At Burning Man, the *La Contesssa* was used for transportation, providing rides to festival-goers, hosting musical performances and weddings, and serving as a stage for poetry and acrobatics shows. Indeed, the *La Contesssa* often was driven about the Festival grounds and was banned from the Festival in 2004 because "its unsafe driving practices far exceeded community tolerance and out-weighed the visual contribution" it made.

Under the definition we adopt today, the *La Contesssa* plainly was "applied art." It began as a rudimentary utilitarian object, and despite being visually transformed through elaborate artistry, it continued to serve a significant utilitarian function upon its completion. As "applied art," the *La Contesssa* was not a work of visual art under the VARA and therefore not eligible for its protection. Therefore, the trial court properly granted summary judgment to Stewart on Cheffins and Jones's VARA claim.

McKeown, Circuit Judge, concurring:

To better effectuate the purpose of VARA, we need a more nuanced definition of "applied art" that balances between the risk of unduly restricting VARA's reach and the risks of turning judges into art critics or consigning to litigation every work of art that includes some utilitarian function. In determining whether a work is "applied art," the right question to ask is whether the primary purpose of the work as a whole is to serve a practical, useful function, and whether the aesthetic elements are subservient to that utilitarian purpose. Because the bus/Spanish galleon *La Contesssa* is applied art under either standard, I concur in the judgment.

Although many court decisions have addressed applied art, these cases provide little guidance on how to distinguish applied from visual art. The issue in nearly all applied art cases is whether the work was copyrightable applied art or instead a noncopyrightable work of "industrial design."

The analysis in these cases is driven by the principle that works may unquestionably be applied art, such as a detailed carving on the back of a chair – an obviously utilitarian object – but may also enjoy certain copyright protection.<sup>4</sup> Whether such a work falls under

<sup>4</sup>Indeed, examples of original "pictorial, graphic, and sculptural works" pro-





Caryatid Porch of the Erechtheum



Portion of the Bayeux tapestry

Tracy Emin, *My Bed* (1998)Auguste Rodin, *The Gates of Hell* (1880–1917)

VARA's protections is a different question. Thus, while these opinions have coalesced around a definition of applied art for the purpose of copyright protection as pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, they do not provide an answer under VARA because VARA protects a new and different genus of "works of visual art."

VARA's protections cannot be limited only to works entirely devoid of any utilitarian purpose. Many outstanding sculptures, including the Caryatids of the Acropolis and the monumental carvings of Ramses at the temple of Karnak are in fact columns that provided buildings with structural integrity. Medieval tapestries not only represented a form of fine art, but also kept castles and cathedrals free from drafts. Of course, the famous Bayeux tapestries, which depict events leading to the Battle of Hastings, retain their utilitarian function to some extent: they could still be used to keep a drafty castle warm. Likewise, Tracy Emin's *My Bed*, displayed at the Tate Britain, incorporates Emin's real bed as a "monument to the heartache of a relationship breakdown." The bed arguably retains its original utilitarian function – it remains a bed, and could still be slept in – but it is no longer meant or used for this utilitarian purpose. Rather, like the Bayeux tapestries, *My Bed* is now appreciated and viewed as a work of creative expression and, when viewed as a whole, the utilitarian object has become part of a visual art piece.

The modern era abounds with examples of fine art that serve some utility. Perhaps the most famous sculpture of the modern era – Rodin's *The Thinker* – was conceived when the artist was designing a set of monumental doors titled *The Gates of Hell*. Doors, of course, are utilitarian objects that facilitate the movement of people into and out of buildings. Likewise, a young Pablo Picasso painted a massive background piece for the ballet *Le Tricorne*. Although that painting surely served some utilitarian purpose as a stage curtain, following that debut, it has been displayed as a painting for half a century. The painting was the focus of intense debate when it was removed last year from the Four Seasons restaurant in New York's Seagram Building, where it had hung since 1959. Some sculptures designed by Dale Chihuly are fantastically artistic and original and yet could also serve a utilitarian purpose of diffusing fresh water or serving as a room divider. The artistic and utilitarian aspects are entwined in some of Chihuly's pieces.

It is easy to imagine a sculpture composed of an array of utilitarian objects. Indeed, a Florida plumber/artist who created a sculpture with auto parts, plumbing fixtures and scrap wiring, found himself in

tected by copyright include dolls and toys, mosaics, and stained glass designs.



the middle of VARA litigation when the “junk” was removed.<sup>9</sup> Automatically relegating these pieces – which are unquestionably works of visual art – beyond the scope of VARA simply because they may serve some practical function would undermine the purpose of the law.

To effect the purpose of VARA and provide guidance for the art community, I believe courts should evaluate the work as a whole, asking whether its primary purpose is to serve a useful function and whether the artistic creation is subservient to that purpose. If the primary purpose is for the work to be viewed and perceived as art, then any incidental utilitarian function will not push it outside the scope of VARA. If a work’s primary purpose is functional, however, no amount of aesthetic appeal will transfer it into visual art subject to VARA’s protections. Determining a work’s primary purpose need not constitute a judicial inquiry into the nature of art. Rather, as in other legal contexts, courts should ask whether “a reasonable observer” would “consider [the work] designed to a practical degree” for a utilitarian or artistic purpose.

In this case, applying the analysis I outline yields the same result as the majority: *La Contesssa* was applied art. The school bus-turned-galleon was designed for, and employed as, a performance venue, restaurant, and means of transportation around the Burning Man festival. Poets, acrobats, and bands performed on its decks. It drove revelers from party to party within Nevada’s Black Rock desert. On various occasions, the galleon was driven at high speeds, prompting festival organizers to send Cheffins and Jones a letter condemning its “unsafe driving practices.” When *La Contesssa* was not serving this purpose, it was dragged to a field, covered with a tarp, and left to sit idle for months at a time. Taken as a whole, this is powerful evidence that the primary purpose of *La Contesssa* was to serve the utilitarian functions of performance venue, gathering space, and people-mover. Although Cheffins and Jones testified passionately about *La Contesssa*’s beauty and the artistic expression they felt it embodied – and it is an impressive work of art in many respects – I conclude it is applied art because its aesthetic appeal was subservient to its primary utilitarian purpose. Thus, the VARA claim fails.

## C Trademark

Trademark protects designs under the general heading of trade dress, using the same general distinctiveness analysis as it does for word

<sup>9</sup>The story of this fascinating dispute is outlined in Christopher J. Robinson’s note *The “Recognized Stature” Standard in the Visual Artists Rights Act*, 68 Fordham L. Rev. 1935 (2000). The parties did not contest that the work was a sculpture, but fought bitterly over whether the visual art was of “recognized stature.”



Pablo Picasso, *Stage Curtain for the Ballet "Le Tricorne"* (1919)



Dale Chihuly, *The Sun*

marks and logos. But two very important limiting doctrines apply. One is that product design is effectively always at most descriptive: it can have acquired distinctiveness (via secondary meaning) but not inherent distinctiveness. The other is that functional aspects of a design are never protectable, even if they have secondary meaning.

### **Wal-Mart Stores, Inc. v. Samara Brothers, Inc.**

529 U.S. 205 (2000)

(Scalia, J.)

In this case, we decide under what circumstances a product's design is distinctive, and therefore protectable, in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act.

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.



Samara Brothers dress

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.

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. [Cases cited protected the designs of bedroom furniture, sweaters, and 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.

The text of § 43(a) provides little guidance as to the circumstances under which unregistered trade dress may be protected. 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.

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. 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*. 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.

The judicial differentiation between marks that are inherently distinctive and those that have developed secondary meaning has solid foundation in the statute itself. 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. In *Qualitex Co. v. Jacobson Products Co.*, 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 refers to a brand,” and does not “immediately signal a brand or a product source.” However, we noted that, “over time, customers may come to treat a particular color on a product or its packaging ... as signifying a brand.” 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.

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 deter-

Qualitex: 514 U.S. 159 (1995)



Qualitex dry-cleaning pad





Tide bottle



Penguin-shaped cocktail shaker

*Two Pesos*: 505 U.S. 763 (1992)



Taco Cabana exterior

gent) 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, and immediately signal a brand or a product source. 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 or “primarily geographically descriptive of them. 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.

Respondent contends that our decision in *Two Pesos, Inc. v. Taco Cabana, Inc.* 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,” could be protected under § 43(a) without a showing of secondary meaning. *Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive, 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.

### Lanham Act

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.

(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)

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

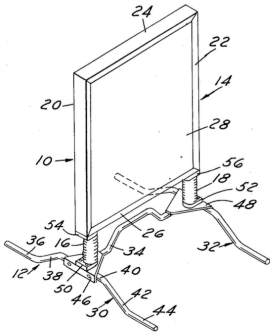


Earl Dean's Coca-Cola bottle design

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

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

No. 3,646,696 and No. 3,662,482



Patented dual-spring design



Traffix "Little Buster" sign with dual-spring base

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."

## 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. Congress confirmed this statutory protection for trade dress by amending the Lanham Act to recognize the concept. Lanham Act S 43(a)(3) 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." [The Court discussed *Qualitex, Two Pesos, and Wal-Mart Stores.*]

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. Copying is not always discouraged or disfavored by the laws which preserve our competitive economy. 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.

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 func-

tional. 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 otherwise 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 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. 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," 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.* 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. 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.

*Sarkisian*: 697 F.2d 1313 (1983)

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.” 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.” In the course of patent prosecution, it was said that “the 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.” 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.” 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.

Discussing trademarks, we have said “in 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*. 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.” *Id.* 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.” This was incorrect as a comprehensive definition. 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. It is proper to inquire into a “significant non-reputation-related disadvantage” in cases of esthetic functionality, the question involved in *Qualitex*. Where the design is functional under the traditional formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, es-



thetic 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. 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. 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.

### In re Florists' Transworld Delivery, Inc.

106 U.S.P.Q.2d (TTAB 2013)

Florists' Transworld Delivery, Inc. appealed from the final refusal of the trademark examining attorney to register the proposed mark shown [in the margin] for "flowers and live cut floral arrangements." The specimen of use is reproduced [in the margin]. The description of the mark is:



Proposed mark



Specimen of use

The mark consists of the color black as applied to a substantial portion of the outside surface of a box which serves as a container or packaging for the goods and in part forms a background to design and literal elements applied thereto.

Section 2(e)(5) of the Trademark Act prohibits registration of a mark if it "comprises any matter that, as a whole, is functional." There are two forms of functionality, utilitarian functionality and aesthetic functionality. A feature that is not essential to the use or purpose of the article, or does not affect the cost or quality of the article – in other words, would not be considered as utilitarian functional – is still prohibited from registration if the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage.

*Brunswick Corp.*: 35 F.3d 1527 (Fed. Cir. 1994)

In *Brunswick Corp. v. British Seagull Ltd.*, the applicant sought to register the color black for outboard engines. In affirming the Board's finding that the color black is de jure functional for outboard motors, the Federal Circuit reasoned:

The color black does not make the engines function better as engines. The paint on the external surface of an engine does not affect its mechanical purpose. Rather, the

color black exhibits both color compatibility with a wide variety of boat colors and ability to make objects appear smaller. With these advantages for potential customers, there is competitive need for engine manufacturers to use black on outboard engines.

The Federal Circuit also focused on competitive need in *L.D. Kichler Co. v. Davoil, Inc.* There, the Federal Circuit reversed a district court's cancellation on summary judgment of a registration for the "Olde Brick" finish of a lighting fixture backplate. The Federal Circuit found a genuine issue of material fact as to whether there was a competitive need for others to use the "Olde Brick" finish and remanded. In particular, the Court noted:

There is evidence that many customers prefer Olde Brick and other composite "rust-type" colors. It is not clear, however, that Olde Brick is one of a few colors that are uniquely superior for use in home decorating. Thus, the district court erred in granting summary judgment that Olde Brick was de jure functional.

In the present case, applicant seeks to register a single-color mark, black, for the outside of the box which serves as the container or packaging for its goods. We therefore determine factually whether registration of the color black for boxes for flowers and live cut floral arrangements serves a non-trademark purpose that would hinder the ability of others to effectively compete with the registrant.

The evidence in the record reflects that, indeed, in the floral industry, color has significance and communicates particular messages. It is commonly known that a dozen red roses are given as a message of love, particularly for Valentine's Day. [Numerous florist websites referred to the importance of the color of flowers in a bouquet and its packaging, e.g. red roses in a white box. Numerous websites also stated that black in connection with flowers connotes elegance or luxury.]

In addition, the evidence reflects that black has significance on somber occasions such as in the context of death. Office action at 8), states "Black has been ... often associated with death." Black is the traditional sign of mourning; it is common knowledge that black clothing is traditionally worn at funerals. Flowers and floral displays play an important role in the context of funerals and mourning; flowers are ubiquitous at funerals and it is also common knowledge that flowers are commonly presented as an expression of condolence. With regard to floral packaging, black is an appropriate color for floral packaging, and is used as floral packaging in bereavement bouquets

When we consider the evidence in the record, we find that the

*Kichler*: 192 F.3d 1349 (Fed. Cir. 1999)

"The color is functional because it indicates the flavor of the ice cream, for example, pink signifies strawberry, white signifies vanilla, brown signifies chocolate, etc." *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197 (11th Cir. 2004). Is that right?

examining attorney has demonstrated prima facie that there is a competitive need for others in the industry to use the color black in connection with floral arrangements and flowers. Competitors who, for example, want to offer flowers for bereavement purposes, Halloween or to imbue an element of elegance or luxury to their presentations through packaging therefor will be disadvantaged if they must avoid using the color black in such packaging. As the examining attorney stated, "competitors will need to use black packaging to convey an appropriate message or sentiment, whether that is elegance, style, festivity, grief or sympathy" and "allowing singular entities to control certain colors, in a field where color is both dynamic and has significance, would severely limit the availability of appropriate color choices to consumers seeking particular floral arrangement gifts."

**Maker's Mark Distillery, Inc. v. Diageo North America, Inc.**

703 F. Supp. 2d 671 (W.D Ky. 2010), *aff'd*, 679 F.3d 41 (6th Cir. 2012)

Plaintiff Maker's Mark is a Kentucky-based distiller specializing in bourbon whisky. Since 1958, when it first began producing bourbon, the company has capped its bottles with a red dripping wax seal that partially covers the neck of the bottle and drips down to the bottle's shoulder. Since 1985, Maker's Mark has held a federally registered trademark, U.S. Trademark Reg. No. 1,370,465, consisting of the "wax-like coating covering the cap of the bottle and trickling down the neck of the bottle in a freeform irregular pattern." Notably, the trademark does not mention the color red – it is silent as to color. [During the course of litigation, Maker's Mark narrowed its argument to assert protection only for a red dripping wax seal.]



Maker's Mark



Cuervo Reserva

The facts giving rise to this case began in the mid-1990s, when [Jose] Cuervo executives decided to create a high-end tequila to celebrate the company's 200th anniversary of producing tequila products legally. They designed the new product, Reserva de la Familia, in conjunction with a U.S. marketing firm and production began in 1995. Initially, the Reserva bottle design included a straight-edge, non-dripping wax seal capping the bottle, along with a stamp of the Cuervo crest imprinted into the wax and a small blue ribbon extending from underneath the wax.

Juan Domingo Beckmann, now Chief Executive Officer of Casa Cuervo, testified that sometime around 1997, he decided to alter the wax seal to include dripping wax after seeing such a bottle in mid-production, before its drips were cut off. Beckmann thought the uncut seal, with its drips, created a unique and artisanal look. By 2001, Reserva, with its red dripping wax seal, had entered the U.S. market. Packaged in a wooden box designed each year by a different Mexican artist, it retailed for about \$100 per bottle.

Defendants argue the red dripping wax seal is functional because

it protects a cork from air, moisture and contaminants, thus preserving the contents of the bottle on some bottles of alcohol. They further argue that drips are a natural byproduct of such a coating, and are costly to remove. In the Court's view, Cuervo completely failed to show that wax seals are functional. Not only did Cuervo fall short of proving that the wax seal on the Reserva bottle was functional, it also did not prove that *any* current wax seal users employ the method for a functional purpose. For example, Cuervo's production manager, Alfredo Guerrero, acknowledged that the company seals other Cuervo products with plastic caps or shrink wrap, and that some of those methods are less expensive than creating a wax seal.

Even assuming that the Sixth Circuit would apply the aesthetic functionality doctrine, the Court finds the case for its application here is unpersuasive. None of Cuervo's witnesses convinced the Court that it would be difficult or costly for competitors to design around the red dripping wax trademark. Furthermore, red wax is not the only pleasing color of wax that competitors may employ on their product, nor does it put competitors at a significant non-reputation related disadvantage to be prevented from using red dripping wax. There are other ways of making a bottle look artisanal or unique. Therefore, the doctrine of aesthetic functionality is inapplicable here.

### **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?

## **D Design Patent**

Design patent law has, until recently, been one of the most academically neglected fields of intellectual property law. The immense importance of design patents in smartphone litigation, however, has thrust them on the public stage again. As you read this section, pay close attention to how they deal with the limits on protections for functional matter hard-wired into copyright and trademark. There is a functionality test for design patents, but it is far more forgiving.

There are no canonical design patent treatises. Chisum's patent-law treatise has a chapter on design patents, and Matthew A. Smith has a draft treatise available online.

Design patents are an interesting hybrid of IP concepts we have seen elsewhere. They borrow their basic structure from utility patent law: a designer obtains exclusive rights to a design by filing an application that is examined under the same substantive and procedural rules as a utility patent application would be. But the subject matter that is actually protected, and the infringement test used to measure similarity, looks much more like copyright. There are even hints of trademark-law confusion concepts in the historical infringement tests for design patents, although recent cases insist that whether consumers are confused is (mostly) not the right question to ask.

### 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.

[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**

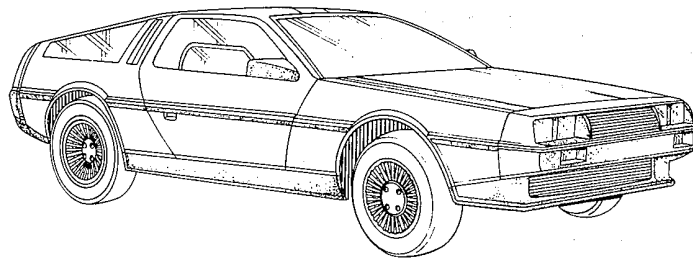
FIG. 1 is a front perspective view of an automobile showing my new design;

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.





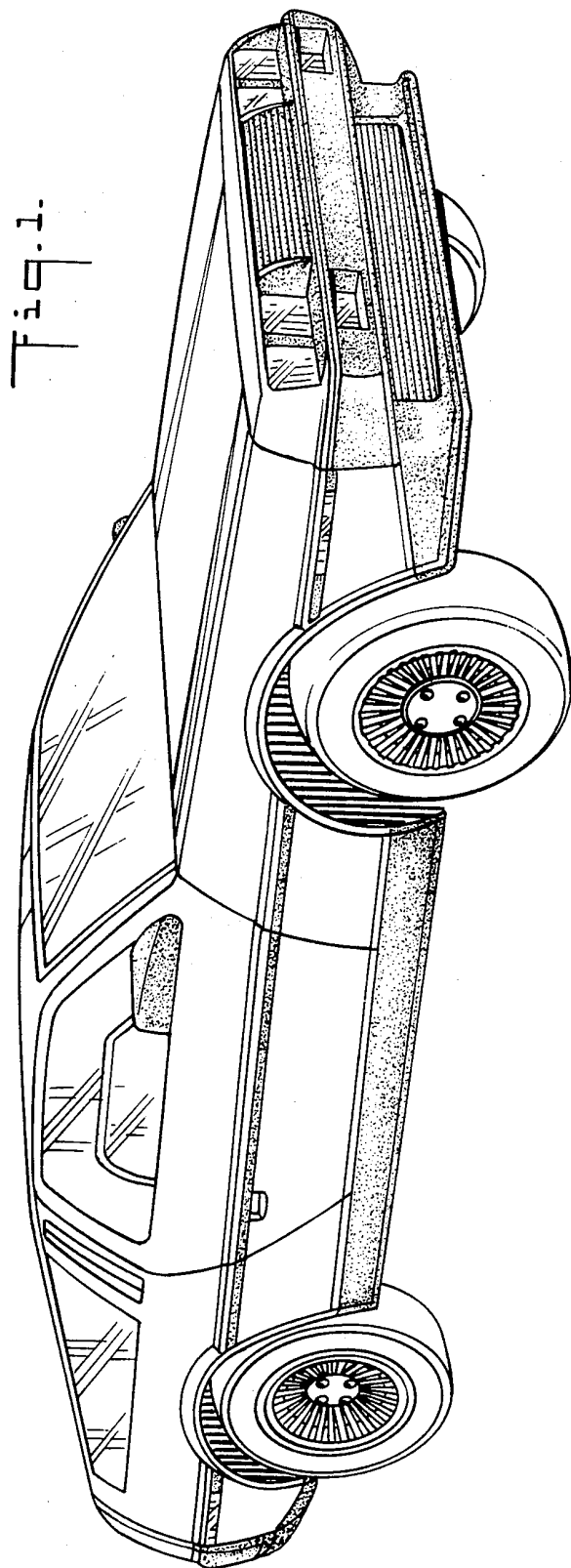




Fig. 2.

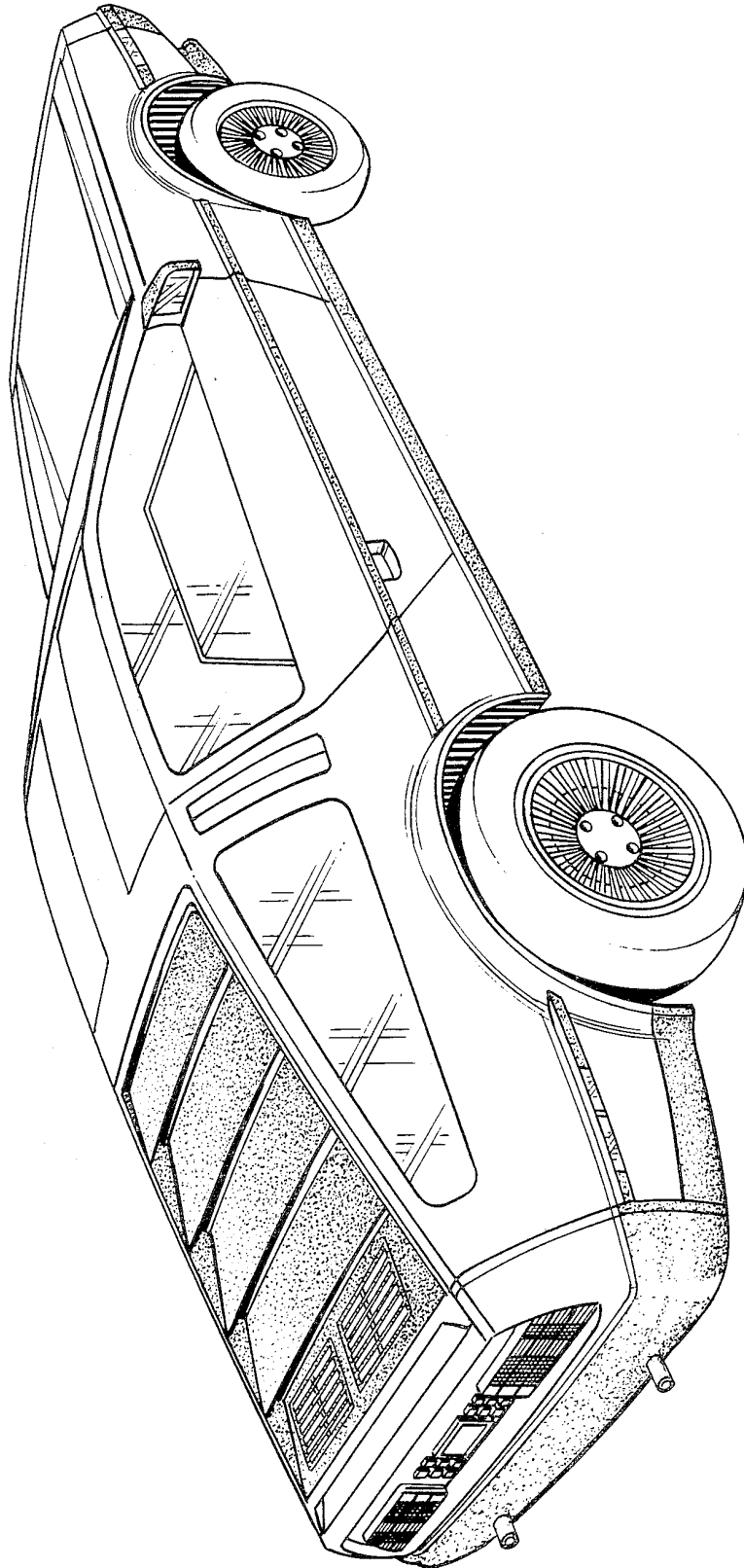


Fig. 3

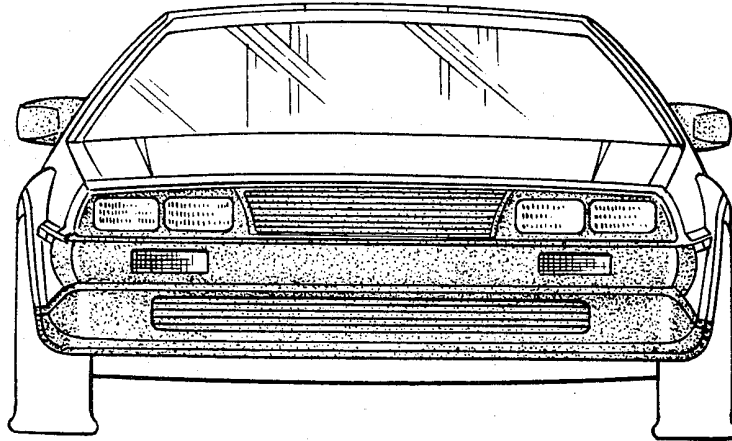
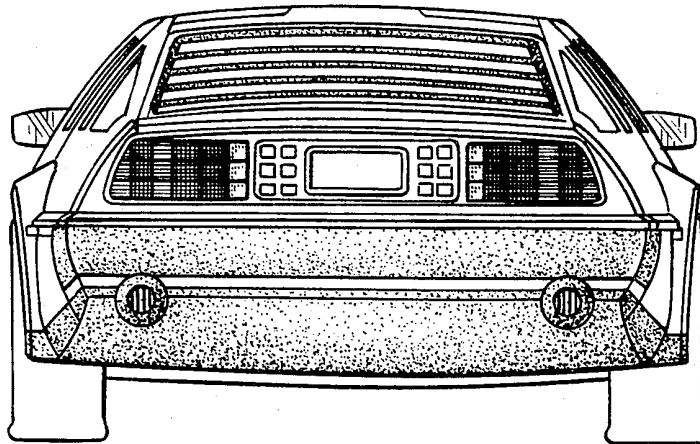


Fig. 4.



## 1 Subject Matter

Section 171 provides two subject matter threshold conditions: a design patent can apply only to a design for "an article of manufacture" and the design must be "ornamental."

### a Articles of Manufacture

**In re Hruby**  
373 F.2d 997 (CCPA 1967)

These appeals are from split decisions of the Patent Office Board of Appeals wherein the majority affirmed the rejection of appellant's claims in four design patent applications. The single claim in each application reads:

The ornamental design for a water fountain as shown and described.

The sole rejection was that the claim in each case does not define an article of manufacture. The precise question before us, therefore, is whether that portion of a water fountain which is composed entirely of water in motion is within the statutory term "article of manufacture."

The board said, "we appreciate that the forms created in water by fountains are a well recognized and much used decorative device" and that it "is evident as urged by appellant that the shape created in a specific fountain is manufactured by man in the sense that water as a raw material is put into planned patterns of motion for accomplishment of a decorative purpose." The majority further expressed disagreement with the examiner's objection that the water of which the designs are produced is a "natural" product, and wisely so as that argument would apply to every article made of wood or stone. Nor did it think much of the argument that the water droplets constantly changed position. Nevertheless the board majority concluded that the water display itself is not "an article of manufacture." The only reasons we can perceive for this conclusion in the board's opinion are that "the pattern created is wholly a fleeting product of nozzle arrangements and control of operating pressure or pressures" and that "the pattern exists only as a product or 'effect' of the mechanical organization during its continued operation."

The dissenting member of the board soundly answered the "fleeting" argument as follows:

Although appellant did not disclose the particular means for producing the fountain effect, it is recognized that if certain parameters such as orifice configuration, water

(Rich, J.)

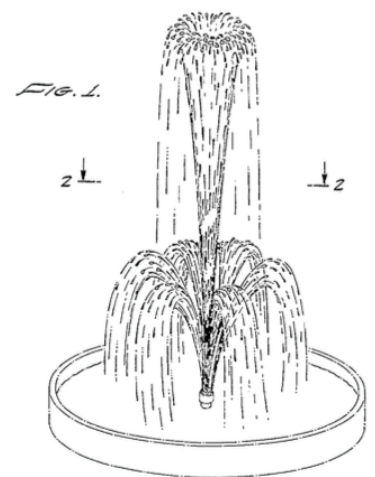


Figure 1 from Hruby's application

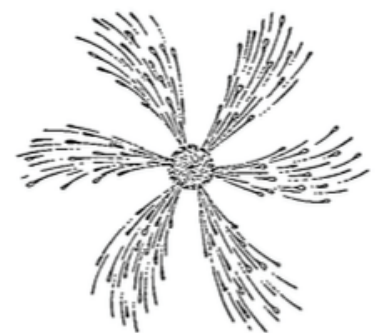


Figure 2 from Hruby's application

pressure and freedom from disturbing atmospheric conditions are maintained, the ornamental shape of the fountain will remain substantially constant and will at such times present an over-all appearance virtually the same from day to day.

We agree with the dissenter on that and would add that the permanence of any design is a function of the materials in which it is embodied and the effects of the environment thereon. Considering the fact that the Romans and the French built now famous fountains hundreds of years ago which still produce the same water designs today, the notion that a fountain is "fleeting" is not one which will "hold water."

The dissenting member continued:

It is true that a particular droplet or droplets may be "a fleeting product" but the fountain itself is not. The fountain in its entirety under proper conditions presents a product of constant appearance rather than a fleeting product. I assume that the majority would find no objection if a design effect would be produced in the form of frozen water. Is it logical or reasonable to find objection to a related design effect also having a constant appearance merely because of continuous movement of water droplets? I am unable to find any logical or legal basis for such a distinction. It must be remembered that in a design it is the over-all appearance due to the form or shape of the product that is determinative of patentability and not the minutia of the details that form the design.

Again we agree. The physicists and philosophers teach us that what we think we see is not really there at all; that the very concept of "solid" is something of an illusion and objects are mostly empty space, "substance" consisting of nuclei with electrons orbiting about them. In common parlance, however, what we see here are fountains, not droplets of water moving in space, any more than we see nuclei and electrons or atoms or molecules in solid objects.

Fountains are what appellant (or someone connected with him) sells. At oral argument, counsel presented us with a stereoscopic film-slide card, a sales device showing fountains like those here involved in three-dimensional pictures as offered for sale. There is no doubt in our minds that prospective buyers of these fountains would select them for the decoration of buildings or grounds according to specific, reproducible<sup>3</sup> designs, intending to use them as permanent decoration.

---

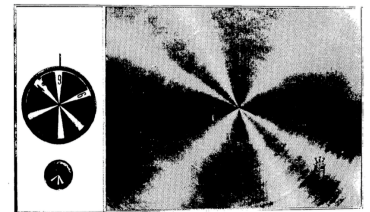
<sup>3</sup>We use the term "reproducible" in the practical sense of making another thing which has the same appearance to the average viewer. The examiner was con-

The fountains are certainly made by man (manufactured) for sale to and use by such buyers. They certainly carry into effect the plain intent of the design patent statute, which is to give encouragement to the decorative arts.

The brief for the Patent Office makes but a single argument in support of the contention the fountains *should* not be considered to be "an article of manufacture." It is, as the examiner contended, that water sprays "cannot exist of themselves," being dependent on the existence of the nozzles and the water under pressure. Only because of this dependence are we asked to affirm the rejection.

We fail to see any force in this argument. It is not denied that designs exist. It is perfectly clear that these designs are of the three-dimensional or configuration-of-goods type. The "goods" in this instance are fountains, so they are made of the only substance fountains can be made of – water. We see no necessary relation between the dependence of these designs made of water upon the means for producing them and their being articles of manufacture. A majority of this court recently held patentable a grille for a radio cabinet with a circularly brushed appearance which also had evenly-spaced small perforations. The peculiarity of this grille was that "with variations in viewing angle and ambient lighting" (emphasis added) a varying moiré effect was produced and the majority felt that this effect made the ornamental appearance unobvious and patentable. The design was thus dependent, insofar as the feature which made it patentable was concerned, on something outside itself, it did not exist alone, because without the proper angles of ambient lighting and viewing there was no moiré effect. *In re Boldt* We do not see that the dependence of the existence of a design on something outside itself is a reason for holding it is not a design "for an article of manufacture." Many such designs depend upon outside factors for the production of the appearance which the beholder observes. The design of a lampshade may not be apparent unless the lamp is lighted. The design of a woman's hosiery is not apparent unless it is in place on her legs. The designs of inflated articles such as toy balloons, water toys, air mattresses, and now even buildings are not apparent in the absence

cerned about the obvious fact that "the exact arrangement and configuration of droplets" could not be reproduced by a person skilled in the art. We do not think this important. The same problem exists to some degree with most everything made of such variable materials as wood, cloth, clay and many others which minutely vary from piece to piece. What matters with an ornamental design is only the ultimate over-all appearance of the article which embodies it. Technically, "exact" reproduction is an impossibility. It is always an approximation. We see no reason why design law — law being one of the greatest approximations of all — should be any more concerned with the "exact arrangement" of water droplets than it is with the exact arrangement of molecules, grains of sand, or even grosser building blocks so long as the general appearance is not affected.



Boldt's radio cabinet. Unfortunately, the same moiré effect remarked on by the court also makes the image in Boldt's filing hard to copy or scan faithfully.

*Boldt*: 344 F.2d 990 (1965)



of the compressed air which gives them form, as the water pressure here gives shape to the fountain. Even the design of wall paper is not always fully apparent in the commodity as it is sold and requires a wall and the services of a paperhanger to put it into condition for enjoyment by the beholder, which is the ultimate purpose of all ornamental design.

Worley, Chief Judge, dissenting:

It is inconceivable that Congress could possibly have intended Sec. 171, in letter or spirit, to allow an individual to remove from the public domain and monopolize mere sprays of water. To do so, one must necessarily rely on strained semantics at the expense of common sense. The instant sprays, so evanescent and fugitive in nature, presumably subject to the whims of wind and weather, incapable of existing in and of themselves, are merely the effect flowing from articles of manufacture, but certainly are no more articles of manufacture per se than are the vapor trails of jets, wakes of ships or steam from engines.

It appears that appellant presently enjoys patent protection on the mechanical elements of the fountains, but apparently not satisfied with that, now seeks to monopolize certain configurations of moving water, whether produced by a garden hose or otherwise. It is not difficult to imagine the potential harassment that could result from such a monopoly.

### In re AlSabah

No. 2015-1264 (Fed. Cir. 2015)

The examiner rejected AlSabah's application, and the PTAB affirmed. This is the brief for the USPTO in AlSabah's appeal to the Federal Circuit, which affirmed the PTAB without opinion. 621 Fed. Appx. 659, 2015 WL 6080577 (Fed. Cir. 2015).

AlSabah seeks a design patent on, "The ornamental design for a Teaching Aid for Teaching Arabic as shown and described." AlSabah's design is a table of synopsized Arabic letters divided into numbered groups and arranged in eleven rows and two columns.

The Board properly found that AlSabah's design is directed to nonstatutory subject matter as provided under 35 U.S.C. § 171 because the design is not embodied in or applied to an article of manufacture. Specifically, AlSabah seeks a design patent on a design for a teaching aid, where the design is a table of information (synopsized Arabic letters divided into groups arranged in an eleven rows and two columns). AlSabah's design can theoretically be applied to a variety of articles, from poster boards to coffee mugs, but has not yet been applied to any article. In other words, AlSabah seeks to improperly patent an abstract design.

A design patent may be obtained for a "new, original and ornamental design for an article of manufacture." An article of manufacture is a tangible man-made object. For example, a computer-generated icon shown on a computer screen is a patentable design

Group	Lateefa Groups
1st	أ
2nd	ب ت ث د هـ ز
3rd	ح خ د ذ
4th	ر ز
5th	س ش
6th	ص ض ط ظ
7th	ع غ ف ق
8th	ك
9th	ل م ن هـ ة و ي

AlSabah's design

on an article of manufacture. The icon itself is not patentable, but when claimed as an icon embodied on a computer screen, monitor, or other display panel, the combination of the icon and the display panel (or portion thereof) is patentable as a design.

The phrase “design for an article of manufacture” encompasses three categories of designs: (1) a design for an ornament, impression, print or picture to be applied to an article of manufacture (surface ornamentation); (2) a design for the shape or configuration of an article of manufacture; and (3) a combination of the first two categories. *In re Schnell* With respect to the sort of surface ornamentation at issue in this appeal, this Court’s predecessor, the United States Court of Customs and Patent Appeals held that section 171 requires that “design must be shown not to be the mere invention of a picture, irrespective of its manner of use, but that the applicant should be required to show by an appropriate drawing the manner of its application.” The court went on to state that “it is the application of the design to an article of manufacture that Congress wishes to promote, and an applicant has not reduced his invention to practice and has been of little help to the art if he does not teach the manner of applying his design.”

*Schnell*: 46 F.2d 203 (CCPA 1931)

The title of AlSabah’s application and claim generically describe the claimed design as being “for a Teaching Aid for Teaching Arabic.” The drawing in AlSabah’s application fails to identify an article of manufacture to which the claimed design must be affixed. Rather, the drawing simply shows synopsised Arabic letters in an eleven row by two column table and nothing more – i.e., a mere abstract design.

AlSabah argues that her application is in “full compliance” with section 171 because teaching aids and tables are articles of manufacture. While a design for a teaching aid is patentable subject matter, the problem for AlSabah is that her so-called design is the teaching aid. And, although AlSabah’s design can be applied to an unlimited number of articles of manufacture, there is no way for a person looking at AlSabah’s claim and drawing to discern whether the claimed design is applied, for example, to a paper handout, a computer icon, or even a coffee mug. Without application to a defined article of manufacture, AlSabah’s design is nothing more than an abstract idea.

AlSabah erroneously argues that her design is “applied to or embodied in an article of manufacture” because “the design is printed on a piece of white paper, and a piece of white paper is an article of manufacture.” More specifically, AlSabah argues that her design is “applied to or embodied” in paper because her design patent application was printed on paper and submitted to the USPTO for examination in paper form. According to AlSabah, an applicant can put any printed material in a design patent application, submit it to the USPTO, and because the application is transmitted to the Office on paper the application should not get rejected for not claiming a design

*textitIn re Zahn*, 617 F. 2d 261 (CCPA 1980): “a design for an article of manufacture may be embodied in less than all of an article of manufacture.”

for an article of manufacture. Following AlSabah's logic, all such proposed design patents would be embodied in paper just because they were submitted to the USPTO for examination. But that makes little sense, what matters is the context of the application itself. AlSabah's design is not depicted as being a table on paper nor is it described as being on paper in her application.

If AlSabah wanted to claim the design in Figure 1 as applied to paper, AlSabah could have done so using broken or dotted lines to represent the paper. But AlSabah's Figure 1 "as shown and described" does not depict any article of manufacture, let alone paper. For all these reasons, AlSabah's arguments regarding paper are inapt.

### b Ornamentality

#### In re Webb

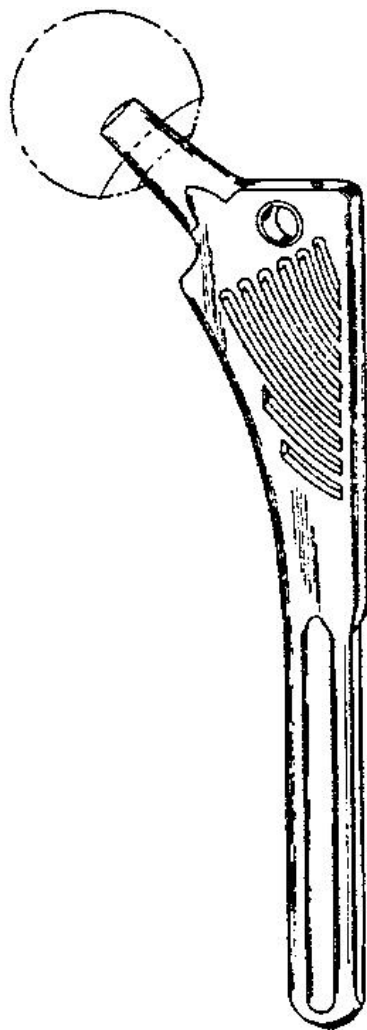
916 F.2d 1553 (Fed. Cir. 1990)

This is an appeal from a decision of the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences affirming the final rejection of the sole claim of appellants' U.S. Design Patent Application Serial No. 833,470. 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.

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.

In the Final Office Action, the Examiner stated:

There is not sound reason or logic for "normal use" to in-



Webb's '470 design

clude 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 issuance of design patents is limited by statute to designs that are ornamental. 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 “it 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*. Even earlier, that court affirmed the rejection of a design claim for a vacuum cleaner brush. *In re Stevens*. There the court noted:

*Cornwall*: 230 F.2d 457 (CCPA 1956)

*Stevens*: 173 F.2d 1015, (CCPA 1949)

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.

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. 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.

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.

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.

**Rosco, Inc. v. Mirror Lite Co.**  
304 F.3d 1373 (Fed. Cir. 2002)

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.



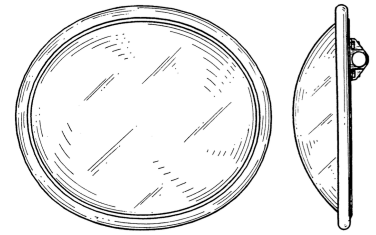
Rosco and Mirror Lite are competitors in the school bus mirror market. This dispute involves “cross-view” mirrors, which are convex, three-dimensional, curved surface mirrors mounted on the front fender of a school bus, enabling the bus driver to view the front and passenger side of a school bus. Rosco’s ‘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.”

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. [For a design patent to be valid,] the 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. 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. 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.

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. 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.

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



Rosco's '357 design

the '357 patent was dictated by functional considerations.

**In re Koehring**  
37 F.2d 421 (CCPA 1930)

This appeal from the decision of the Commissioner of Patents, refusing a patent for a design for a concrete mixer truck body and frame, presents as its main issue the very interesting, and oftentimes troublesome, question as to what articles of manufacture may constitute the subject-matter of design patents. Before us the Commissioner urges that it must be held, under *In re Stimpson* that this character of machine is not "inventively ornamental." The riveting machine in controversy in *Stimpson* was held not to be ornamental, because the drawing showed that it was

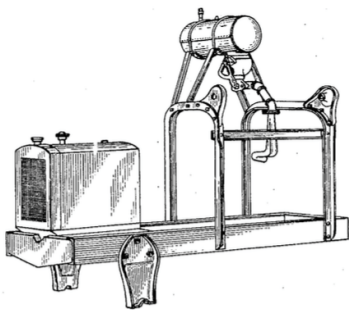
purely utilitarian, and without ornamentation of any kind. There is nothing about the assembled mechanical device which serves to beautify, embellish, or adorn it. The several parts of the mechanism, whether circular, curved, rounded, or spiral, are assembled into an entirety which is lacking in symmetry, wanting in grace, and destitute of any appeal to the senses or emotions. The design has no human interest, other than that aroused by the utilitarian nature of the machine.

In our view of the case, the beauty and ornamentation requisite in design patents is not confined to such as may be found in the "aesthetic or fine arts." It is not reasonable to presume that Congress, in basing a patent right upon the ornamentation or beauty of a tool or mechanical device, intended that such beauty and ornamentation should be limited to such as is found in paintings, sculpture, and artistic objects, and which excites the aesthetic sense of artists alone.

By the enactment of the design patent law, Congress expressed a desire to promote more beauty, grace, and ornamentation in things used, observed, and enjoyed by our people. Appellant's design of a truck body and frame for a concrete mixer shows the frame to be so designed as to place the different elements of the whole machine, including the hood, gas tank, mixer, etc., into a more symmetrical and compact whole than was known in the prior art. Aside from this arrangement, which removes much of the unsightliness from the machine, the covering of the motor is made to resemble, in appearance, an automobile hood, and the angular bars and framework of the same are given a rounded or oval appearance. By the plan of assembly of the more or less rounded hood, round gas tank, and rounded frame corners into a compact and more symmetrical whole, an article, possessing more grace and pleasing appearance than existed in the prior art, has been produced. This effect in the design as a whole is orna-

*Stimpson*: 24 F.2d 1012 (D.C. Ct. App.)

"Design applications which disclose subject matter which could be deemed offensive to any race, religion, sex, ethnic group, or nationality, such as those which include caricatures or depictions, should be rejected as nonstatutory subject matter." MPEP § 1504.01(e). Does this exclusion survive *Tam*?



Koehring's design

mental and inventive.

Since it is clear that Congress meant the design patent law to apply to tools and mechanisms of utilitarian character, it follows, we think, that it had in mind the elimination of much of the unsightly repulsiveness that characterizes many machines and mechanical devices which have a tendency to depress rather than excite the esthetic sense. In this mechanical age, when machines, engines, and various kinds of mechanisms are transported on our public highways and streets and moved by their own momentum from place to place, it is certainly not undesirable that some of the unsightliness – and, as frequently occurs, frightfulness – of such contrivances be eliminated, if possible.

## 2 Procedures

Most of the mechanics of obtaining a design patent are the same as for a utility patent. The principal difference is that designs are claimed by illustration rather than in words. This creates some distinctive drafting issues. Design patents also have a shorter term. (In addition, design patent prosecution is procedurally simpler in several ways not here relevant.)

### Manual of Patent Examining Procedure

A preamble, if included, should state the name of the applicant, the title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.

No description of the design in the specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. However, while not required, such a description is not prohibited and may be incorporated, at applicant's option, into the specification or may be provided in a separate paper. Descriptions of the figures are not required to be written in any particular format, however, if they do not describe the views of the drawing clearly and accurately, the examiner should object to the unclear and/or inaccurate descriptions and suggest language which is more clearly descriptive of the views.

The following types of statements are not permissible in the specification:

- (1) A disclaimer statement directed to any portion of the claimed design that is shown in solid lines in the drawings.
- (2) Statements which describe or suggest other embodiments of the claimed design which are not illustrated in the drawing disclosure, except one that is a mirror image of that shown or has

**MPEP § 1503**

*Elements of a Design Patent Application Filed Under 35 U.S.C. ch. 16*

a shape and appearance that would be evident from the one shown.

- (3) Statements describing matters that are directed to function or are unrelated to the design.

A design patent application may only include a single claim. The single claim should normally be in formal terms to “The ornamental design for (the article which embodies the design or to which it is applied) as shown.” The description of the article in the claim should be consistent in terminology with the title of the invention.

When the specification includes a proper descriptive statement of the design, or a proper showing of modified forms of the design or other descriptive matter has been included in the specification, the words “and described” must be added to the claim following the term “shown”; i.e., the claim must read “The ornamental design for (the article which embodies the design or to which it is applied) as shown and described.”

Full lines in the drawing show the claimed design. Broken lines are used for numerous purposes. Under some circumstances, broken lines are used to illustrate the claimed design (i.e., stitching and fold lines). Broken lines are not permitted for the purpose of identifying portions of the claimed design which are immaterial or unimportant. There are “no portions of a design which are “immaterial” or “not important.” A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design.

Every design patent application must include either a drawing or a photograph of the claimed design. As the drawing or photograph constitutes the entire visual disclosure of the claim, it is of utmost importance that the drawing or photograph be clear and complete, and that nothing regarding the design sought to be patented is left to conjecture.

When inconsistencies are found among the views, the examiner should object to the drawings and request that the views be made consistent. When the inconsistencies are of such magnitude that the overall appearance of the design is unclear, the claim should be rejected under 35 U.S.C. 112(a) and (b) as nonenabling and indefinite.

The drawings or photographs should contain a sufficient number of views to disclose the complete appearance of the design claimed, which may include the front, rear, top, bottom and sides. Perspective views are suggested and may be submitted to clearly show the appearance of three dimensional designs.

Views that are merely duplicative of other views of the design or that are flat and include no surface ornamentation may be omitted from the drawing if the specification makes this explicitly clear. For

Are enablement and definiteness the same for design patents?

example, if the left and right sides of a design are identical or a mirror image, a view should be provided of one side and a statement made in the drawing description that the other side is identical or a mirror image. If the design has a flat bottom, a view of the bottom may be omitted if the specification includes a statement that the bottom is flat and devoid of surface ornamentation.

Sectional views presented solely for the purpose of showing the internal construction or functional/ mechanical features are unnecessary and may lead to confusion as to the scope of the claimed design. The examiner should object to such views and require their cancellation.. However, where the exact contour or configuration of the exterior surface of a claimed design is not apparent from the views of the drawing, and no attempt is made to illustrate features of internal construction, a sectional view may be included to clarify the shape of said design.

While surface shading is not required, it may be necessary in particular cases to shade the figures to show clearly the character and contour of all surfaces of any 3-dimensional aspects of the design. Surface shading is also necessary to distinguish between any open and solid areas of the article. Lack of appropriate surface shading in the drawing as filed may render the design nonenabling and indefinite under 35 U.S.C. 112(a) and (b). Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Oblique line shading must be used to show transparent, translucent and highly polished or reflective surfaces, such as a mirror. Contrast in materials may be shown by using line shading in one area and stippling in another. By using this technique, the claim will broadly cover contrasting surfaces unlimited by colors.

The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim. Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines. This includes any portion of an article in which the design is embodied or applied to that is not considered part of the claimed design. Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof. A boundary line may be shown in broken lines if it is not intended to form part of the claimed design.

### **Patent Act**



Patents for designs shall be granted for the term of 15 years from the date of grant.

### 3 Ownership

*Skip this section. Not forever, just for a bit. Read the following section on the similarity analysis in design patent infringement. Then come back. Don't worry. This section will still be here, and it will make much more sense.*

Inventorship for design patents is much the same as for utility patents and initial ownership. Design patents pose more difficult questions when it comes to the tests for anticipation under § 102 and for nonobviousness under § 103. The difficulty flows from the fact that design patents use depictions rather than verbal claims, so that the claim-based tests used for utility patents simply map cleanly onto design patents.

#### a Novelty

For the most part, the are the rules for priority and for what counts as prior art are the same for design patents and utility patents. The test for experimental use is a little different because what counts as necessary experimentation is different for ornamentation than for function. In *In re Mann*, for example, the applicant exhibited a wrought-iron table embodying the design at a trade show, but argued that it was an "experimental use." The court disagreed, writing, "Obtaining the reactions of people to a design – whether or not they like it – is not 'experimentation' in that sense. In the case of a design, if market testing shows that it has no appeal and the design is changed, the result is a new and different design; the original design remains just what it was." It is the test for anticipation that requires modification.

*Mann*: 861 F.2d 1581 (Fed. Cir. 1988)  
(Rich, J.)

#### **International Seaway Trading Corp. v. Walgreens Corp.**

589 F.3d 1233 (Fed. Cir. 2009)

Plaintiff International Seaway filed suit against Walgreens Corporation and Touchsport Footwear claiming infringement of Seaway's patents, U.S. Design Patents Nos. **D529,263**, **D545,032**, and **D545,033**. The district court granted summary judgment for defendants, finding that the claims of the asserted patents were invalid under 35 U.S.C. § 102 as anticipated by a patent assigned to Crocs, Inc., U.S. Design Patent No. **D517,789**.

Seaway's patents claim designs for casual, lightweight footwear, which are typically referred to as "clogs." Seaway asserted that Touchsport had imported and continued to import shoes that infringed the Seaway patents and that Walgreens had sold and continued to sell the allegedly infringing shoes. The district court granted

summary judgment of anticipation, finding that the three Seaway patents were anticipated by the Crocs '789 patent.

It has been well established for over a century that the same test must be used for both infringement and anticipation. His general rule derives from the Supreme Court's proclamation 120 years ago in the context of utility patents: "that which infringes, if later, would anticipate, if earlier." ?? The same rule applies for design patents. In *Egyptian Goddess*, we abandoned the point of novelty test for design patent infringement and held that the ordinary observer test should serve as the sole test for design patent infringement. We now conclude that the ordinary observer test must logically be the sole test for anticipation as well.

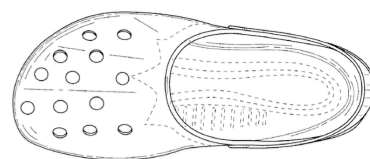
Walgreens and Touchsport argue that the asserted differences between the insoles of the patents-in-suit and the prior art "were at most slight variations of design elements already present in the Crocs prior art." We disagree. The insole pattern for the patents-in-suit is distinctly different than the Crocs insole pattern.

The Crocs '789 patent contains a long, U-shaped dimpling pattern on the insole. In contrast, the patents-in-suit have a dimpling pattern that includes multiple short rows of dimples. Because we cannot say that these differences are insignificant as a matter of law, a genuine issue of material fact exists as to whether the designs would be viewed as substantially similar in the eyes of the ordinary observer armed with the knowledge of the prior art.

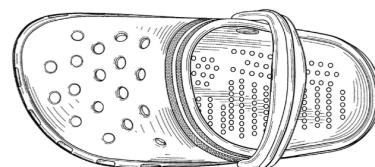
Beyond the insole features of its patented designs, Seaway argues that a genuine issue of material fact exists as to whether the exterior features of its designs preclude a finding of anticipation. It claims that four exterior features differ from the prior art to the degree necessary to preclude summary judgment: (1) the number and arrangement of the circular openings on the upper of the clog; (2) the number and position of the rectangular cut-outs in the lower portion of the upper of the clog; (3) the shape of the toe portion of the clog; and (4) the raised pattern of the outsole of the clog. These features are identical in all three of Seaway's patents-in-suit. With regard to these alleged dissimilarities, the district court stated:

Slight variations on the number and position of the circular holes on the top of the shoe, the rectangular holes on the toe of the shoe as well as the design of different shaped rectangles on the sole of the shoe would not convince a reasonable jury, or an ordinary observer with knowledge of the prior art, that the limitations were not inherently disclosed in the '789 patent. This conclusion does not change merely because plaintiff slightly changed the arrangement of the textured portions on the top and around

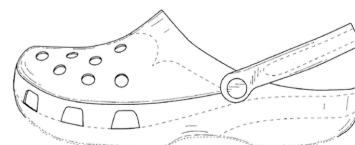
The test for anticipation of a utility patent is the mirror image of the *literal* infringement test. But the design patent infringement test bears more than a passing resemblance to the doctrine of equivalents in utility patents. What does this do to the symmetry argument? Should anticipation in design patents be confined to identical designs? Or is it all irrelevant, since obviousness under § 103 will take care of such cases?



'789 insole



'263 insole



'789 side view

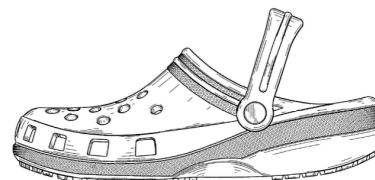
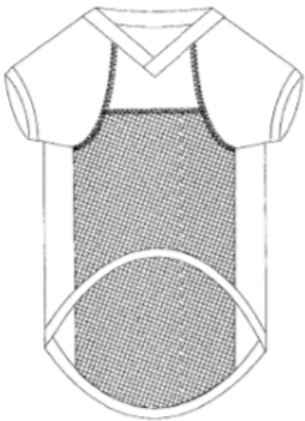


Fig. 2

'263 side view

the bottom portion of the sides of the shoe.

We agree with the district court that these minor variations in the shoe are insufficient to preclude a finding of anticipation because they do not change the overall visual impression of the shoe. Although the ordinary observer test requires consideration of the design as a whole, this does not prevent the district court on summary judgment from determining that individual features of the design are insignificant from the point of view of the ordinary observer and should not be considered as part of the overall comparison. The mandated overall comparison is a comparison taking into account significant differences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another. Just as minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement,, so too minor differences cannot prevent a finding of anticipation.



### b Obviousness

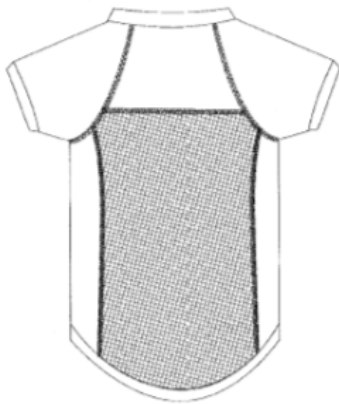
The *Graham* framework is nominally the same for design patents and for utility patents. But the application is very different. Query whether the tests used by the Federal Circuit survive *KSR*.

### MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326 (Fed. Cir. 2014)

MRC Innovations, Inc. appeals from a final judgment of the U.S. District Court for the Northern District of Ohio granting summary judgment of invalidity with respect to U.S. Design Patent No. **D634,488**. The '488 patent claims an ornamental design for a football jersey for a dog.

The district court concluded that the '488 patent would have been obvious in view of several prior art pet jerseys. MRC now appeals that determination. Obviousness is a question of law based on underlying factual questions. The underlying factual inquiries include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness. *Graham*.

In the context of design patents, the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved. To answer this question, a court must first determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design. That inquiry involves a two-step process. First, the court must identify a single reference, something in existence, the design characteristics



'488 design

"The 'ordinary designer' means one who brings certain background and training to the problems of developing designs in a particular field, comparable to the 'mechanic' or 'routinier' in non-design arts. We do not have a name for that person in the design field other than 'designer' which is also the name we must use for the person who creates a patentable design." *Nalbandian*

of which are basically the same as the claimed design. The “basically the same” test requires consideration of the visual impression created by the patented design as a whole. The trial court judge may determine almost instinctively whether the two designs create basically the same visual impression, but “must communicate the reasoning behind that decision.

Once the primary reference is found, other “secondary” references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. These secondary references must be so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.

#### A. Primary Reference

The district court used the “Eagles” pet jersey as the “primary reference” under step one of the analysis. MRC argues that this was legally erroneous because there are significant differences between the Eagles jersey and the patented design of the ’488 patent. Specifically, there are three differences: (1) the patented design has a V-neck collar where the Eagles jersey has a round neck; (2) the patented design contains an interlock fabric panel on the side portion of the design rather than mesh; and (3) the patented design contains additional ornamental surge stitching on the rear portion of the jersey. MRC argues that the district court overlooked these differences by focusing on the claimed design at too high a level of abstraction. If the district court had translated the claimed design into a verbal description as required by High Point, MRC insists, it would have concluded that neither the Eagles jersey nor any other prior art reference contained design characteristics that were basically the same as the claimed design.

As an initial matter, it is true that the district court did not expressly undertake to translate the claimed design into a verbal description. However, the purpose of requiring district courts to describe the claimed design in words is so that the parties and appellate courts can discern the trial court’s reasoning in identifying a primary reference. It is entirely clear from the district court’s opinion what it considered to be the relevant design characteristics of the ’488 patented design.

First, the district court pointed out three key similarities between the claimed design and the Eagles jersey: an opening at the collar portion for the head, two openings and sleeves stitched to the body of the jersey for limbs, and a body portion on which a football logo is applied. If the district court’s analysis had ended there, it might indeed have failed to meet the verbal description requirement. However, the district court went on to point out two additional similarities

“For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of art for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been constructed, obviousness, like anticipation, requires application of the ordinary observer test, not the view of one skilled in the art.”  
*International Seaway*



“Eagles” design





"V2" design

*Jore*: 117 Fed. Appx. 761 (Fed. Cir. 2005)

*Nalbandian*: 661 F.2d 1214 (CCPA 1981)

between the two designs: first, the Eagles jersey is made "primarily of a mesh and interlock fabric"; and second, it contains at least some ornamental surge stitching – both features found in the '488 claimed design. The district court also went on to acknowledge the three major differences between the two designs that are enumerated above. Taking all of those things together (the at least five design characteristics that the claimed design shares with the Eagles jersey and three design characteristics that differ from it), the district court painted a clear picture of the claimed design. The district court did far more than merely ask whether the Eagles jersey disclosed the general concept of a pet jersey; it thoroughly considered the "distinctive visual appearances of the reference and the claimed design. Thus, the district court did not err by failing to provide an express verbal description of the claimed design; rather, it described the claimed design in the context of comparing it to the prior art.

Nor did the district court err in finding that the design characteristics of the '488 design created basically the same overall visual impression as the Eagles jersey prior art reference. As the district court noted, both designs contain the same overall shape, similar fabric, and ornamental surge stitching. That there are slight differences in the precise placement of the interlock fabric and the ornamental stitching does not defeat a claim of obviousness; if the designs were identical, no obviousness analysis would be required.<sup>1</sup> Indeed, we have permitted prior art designs to serve as "primary references" when their differences are as great or greater than the differences in this case. See *Jore Corp. v. Kouvato, Inc.* (finding prior art drill bit to be a primary reference despite containing a smooth cylindrical shaft rather than the grooved hexagonal shaft of the claimed design); *In re Nalbandian* (finding tweezer design obvious in light of prior art reference that contained vertical rather than horizontal fluting and straight rather than curved pincers).<sup>3</sup>

<sup>1</sup>This conclusion is not inconsistent with the law of this circuit on design patent infringement. In that context, we have often noted that design patents have "almost no scope" beyond the precise images shown in the drawings. *Mann*. However, in practice, our focus on the "overall visual appearance" of a claimed design rather than on individual features has led us to find products infringing despite differences in specific ornamental features. For example, in *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294 (Fed. Cir. 2010), we concluded that all of the accused products infringed the asserted design patents despite the fact that two of the infringing products (the Groovy DAWGSTM shoes and Big DAWGSTM shoes) contained a wider shoe front with an additional row of holes, and another infringing product (the Effervescent Waldies AT shoe) contained square holes on the top of the shoe rather than round ones.

<sup>3</sup>Alternatively, the district court could have relied on the V2 jersey as the primary reference. The only differences between the V2 jersey and the claimed design are: (1) that the V2 jersey does not contain an "interlock" fabric panel; (2) it has "drop" sleeves while the claimed jersey has "raglan-style" sleeves; and (3) the



### B. Secondary References

After concluding that the Eagles jersey could be a “primary reference,” the district court determined that the V2 jersey and another reference known as the “Sporty K9” jersey were “so related to the primary reference” that they could serve as “secondary references” that would motivate the skilled artisan to make the claimed design.

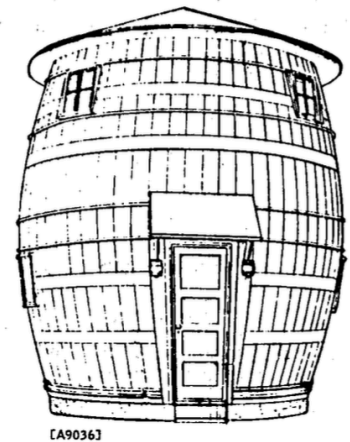
The district court found that both jerseys suggested the use of a V-neck pattern and non-mesh fabric on the side panels – the first two differences described above. MRC argues that the district court erred by failing to explain why a skilled artisan would have chosen to incorporate those features of the V2 and Sporty K9 jerseys with the Eagles jersey.

We disagree. It is true that in order for secondary references to be considered, there must be some suggestion in the prior art to modify the basic design with features from the secondary references. However, the teachings of prior art designs may be combined only when the designs are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other. In other words, it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design.

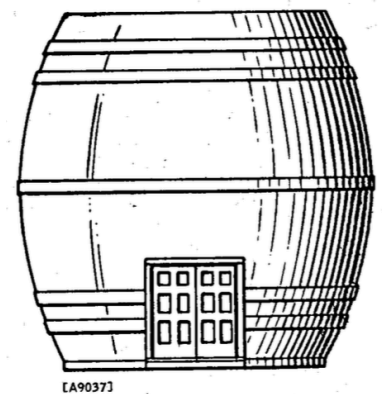
*In re Borden* discussed what is required for a reference to be considered sufficiently “related” for that test to apply. There, we noted that the secondary references were “closely akin” to the claimed design, and relied heavily on the fact that “the two missing design elements [were] not taken from unrelated references, but [were] found in other dual-chamber containers.” Thus, those references could be used “to bridge the small gap between the [primary] container and Borden’s claimed design.” So too, here, the secondary references that the district court relied on were not furniture, or drapes, or dresses, or even human football jerseys; they were football jerseys designed to be worn by dogs. Moreover, as discussed above, the V2 could easily have served as a primary reference itself, so similar is its overall visual appearance to that of the claimed design and the Eagles jersey. We therefore agree that those references were “so related” to the Eagles jersey that the striking similarity in appearance across all three jerseys would have motivated a skilled designer to combine features from one with features of another.

V2 jersey lacks any ornamental surge stitching. A side-by-side comparison of the two designs demonstrates that of those three differences, only the ornamental surge stitching truly alters the “overall visual appearance” of the design. Moreover, the ornamental stitching on the claimed design is suggested by the seam lines on the V2 jersey, further minimizing the difference in overall appearance. Thus, either the “Eagles” jersey or the V2 jersey could have served as a “primary reference” for purposes of the obviousness analysis.

*Borden*: 90 F.3d 1570 (Fed. Cir. 1996)



Prior art barrel-shaped building



Barrel-shaped building design held obvious in light of prior art

With respect to the only remaining difference between the Eagles jersey and the '488 claimed design – the presence of additional ornamental surge stitching running down the rear of the jersey – the district court acknowledged that no prior art reference contained exactly that same stitching on the rear of the jersey, but nevertheless concluded that this was not a “substantial” difference that created a patentably distinct design, but rather was a “de minimis change[] which would be well within the skill of an ordinary designer in the art.”

MRC argues that adding any ornamental feature to a primary reference that is not suggested by the prior art is, by definition, more than de minimis. But our case law plainly contradicts that position; on numerous occasions we have invalidated design patents despite the inclusion of ornamental features that were entirely absent from prior art designs. *See, e.g., Nalbandian* (different shape of fluting on finger grips and different shape of pincers were de minimis differences in design for tweezers); *In re Cooper* (affirming Board’s conclusion that numerous changes to the design of a prior art building – including a single rather than double door and the addition of windows – were de minimis because the overall impression was still a building that looked like a barrel).

Cooper: 480 F.2d 900 (CCPA 1973)

Here, the Eagles jersey had already disclosed the use of ornamental surge stitching. The only additional step needed was to extend the stitching down the sides of the rear of the jersey. Moreover, the V2 jersey plainly suggested the addition of vertical lines down the rear of the jersey through the use of the seams between the two types of fabric. We agree with the district court that adding ornamental surge stitching on top of a preexisting seam was an insubstantial change that would have been obvious to a skilled designer.<sup>6</sup>

#### 4 Infringement: Similarity

"Judges and lawyers in general are highly uncomfortable with images, yet design patents force direct legal engagement with images." Rebecca Tushnet, *The Eye Alone Is the Judge: Images and Design Patents*, 19 J. Intell. Prop. L. 409 (2012)

The “ordinary observer” analysis used to assess the similarity of designs actually predates its use in copyright law, which borrowed the term and some of the concepts from design patent law. *Egyptian Goddess* sets out the modern test. *Wing Shing* shows the test in action and deals with the problem of filtering out unoriginal elements of a design; *OddzOn* deals with the related problem of filtering out unprotectable functional elements. *L.A. Gear* clears up a couple of concep-

<sup>6</sup>To be clear, we do not intend to suggest that merely because one prior art reference used ornamental surge stitching, any use of such stitching would have been a de minimis change. Rather, the addition of the surge stitching in this case was de minimis because it merely followed the visual lines created by the seams of the V2 jersey; in other words, it served only to highlight a design feature that had already existed in the V2 prior art jersey.

tual points about how the analysis actually works.

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

I

The starting point for any discussion of the law of design patents is the Supreme Court's decision in *Gorham Co. v. White*. That case involved a design patent for the handles of tablespoons and forks. In its analysis of claim infringement, the Court stated that the test of identity of design "must be sameness of appearance, and mere difference of lines in the drawing or sketch ... or slight variances in configuration... will not destroy the substantial identity." Identity of appearance, the Court explained, or "sameness of effect upon the eye, is the main test of substantial identity of design"; the two need not be the same "to the eye of an expert," because if that were the test, "there never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them."

*Gorham*: 81 U.S. 511 (1871)

The *Gorham* Court then set forth the test that has been cited in many subsequent cases: "If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." In the case before it, the Court concluded that "whatever differences there may be between the plaintiffs' design and those of the defendant in details of ornament, they are still the same in general appearance and effect, so much alike that in the market and with purchasers they would pass for the same thing – so much alike that even persons in the trade would be in danger of being deceived."

Since the decision in *Gorham*, the test articulated by the Court in that case has been referred to as the "ordinary observer" test and has been recognized by lower courts, including both of this court's predecessors, as the proper standard for determining design patent infringement. However, in a series of cases tracing their origins to *Litton Systems, Inc. v. Whirlpool Corp.*, this court has held that proof of similarity under the ordinary observer test is not enough to establish design patent infringement. Rather, the court has stated that the accused design must also appropriate the novelty of the claimed design in order to be deemed infringing. The court in *Litton Systems* wrote as follows:

*Litton Systems*: 728 F.2d 1423 (Fed. Cir. 1984)

For a design patent to be infringed, no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from

the prior art. That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art.

After identifying the combination of features in the design that it considered novel, the court in *Litton Systems* held that the accused design had none of those features and therefore did not infringe.

In a number of cases decided after *Litton Systems*, this court has interpreted the language quoted above to require that the test for design patent infringement consider both the perspective of the ordinary observer and the particular novelty in the claimed design.

The extent to which the point of novelty test has been a separate test has not always been clear in this court's case law. In cases decided shortly after *Litton*, the court described the ordinary observer test and the point of novelty test as "conjunctive." It has not been until much more recently that this court has described the ordinary observer and point of novelty tests as "two distinct tests" and has stated that the merger of the point of novelty test and the ordinary observer test is legal error.

Regardless of the differences in the way it has been characterized, the point of novelty test has proved reasonably easy to apply in simple cases in which the claimed design is based on a single prior art reference and departs from that reference in a single respect. In such cases, it is a simple matter to identify the point of novelty and to determine whether the accused design has appropriated the point of novelty, as opposed to copying those aspects of the claimed design that were already in the prior art. However, the point of novelty test has proved more difficult to apply where the claimed design has numerous features that can be considered points of novelty, or where multiple prior art references are in issue and the claimed design consists of a combination of features, each of which could be found in one or more of the prior art designs. In particular, applying the point of novelty test where multiple features and multiple prior art references are in play has led to disagreement over whether combinations of features, or the overall appearance of a design, can constitute the point of novelty of the claimed design. In light of the questions surrounding the status and application of the point of novelty test, we use this case as a vehicle for reconsidering the place of the point of novelty test in design patent law generally.

## II

[The court reviewed previous caselaw in detail.]

As noted, this court has cited *Litton Systems* for the proposition that the point of novelty test is separate from the ordinary observer

test and requires the patentee to point out the point of novelty in the claimed design that has been appropriated by the accused design. We think, however, that *Litton Systems* and the predecessor cases on which it relied are more properly read as applying a version of the ordinary observer test in which the ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art. 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 to the eye of the hypothetical ordinary observer. It was for that reason that the Supreme Court in *Smith v. Whitman Saddle Co.* focused on the one feature of the patented saddle design that departed from the prior art – the sharp drop at the rear of the pommel. To an observer familiar with the multitude of prior art saddle designs, including the design incorporating the Granger pommel and the Jenifer cantle, “an addition frequently made,” the sharp drop at the rear of the pommel would be important to the overall appearance of the design and would serve to distinguish the accused design, which did not possess that feature, from the claimed design.

*Whitman Saddle*: 148 U.S. 674 (1893)

Applying the ordinary observer test with reference to prior art designs also avoids some of the problems created by the separate point of novelty test. One such problem is that the point of novelty test has proved difficult to apply in cases in which there are several different features that can be argued to be points of novelty in the claimed design. In such cases, the outcome of the case can turn on which of the several candidate points of novelty the court or fact-finder focuses on. The attention of the court may therefore be focused on whether the accused design has appropriated a single specified feature of the claimed design, rather than on the proper inquiry, i.e., whether the accused design has appropriated the claimed design as a whole.

In addition, the more novel the design, and the more points of novelty that are identified, the more opportunities there are for a defendant to argue that its design does not infringe because it does not copy all of the points of novelty, even though it may copy most of them and even though it may give the overall appearance of being identical to the claimed design. In such cases, a test that asks how an ordinary observer with knowledge of the prior art designs would view the differences between the claimed and accused designs is likely to produce results more in line with the purposes of design patent protection.

This court has characterized the purpose of the point of novelty test as being “to focus on those aspects of a design which render the design different from prior art designs.” That purpose can be equally



well served, however, by applying the ordinary observer test through the eyes of an observer familiar with the prior art. 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, and thus infringing. At the same time, unlike the point of novelty test, the ordinary observer test does not present the risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty.

This approach also has the advantage of avoiding the debate over the extent to which a combination of old design features can serve as a point of novelty under the point of novelty test. An ordinary observer, comparing the claimed and accused designs in light of the prior art, will attach importance to differences between the claimed design and the prior art depending on the overall effect of those differences on the design. If the claimed design consists of a combination of old features that creates an appearance deceptively similar to the accused design, even to an observer familiar with similar prior art designs, a finding of infringement would be justified. Otherwise, infringement would not be found.

On the basis of the foregoing analysis, we hold that the "point of novelty" test should no longer be used in the analysis of a claim of design patent infringement. In accordance with *Gorham* and subsequent decisions, we hold that the "ordinary observer" test should be the sole test for determining whether a design patent has been infringed.

In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear "substantially the same" to the ordinary observer, as required by *Gorham*. In other instances, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art, as in many of the cases discussed above and in the case at bar. Where there are many examples of similar prior art designs, as in a case such as *Whitman Saddle*, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.

We emphasize that although the approach we adopt will frequently involve comparisons between the claimed design and the prior art, it is not a test for determining validity, but is designed solely as a test of infringement.

## III

One of the issues raised by this court in its order granting en banc review was whether trial courts should conduct claim construction in design patent cases. While this court has held that trial courts have a duty to conduct claim construction in design patent cases, as in utility patent cases, the court has not prescribed any particular form that the claim construction must take. To the contrary, the court has recognized that design patents typically are claimed as shown in drawings, and that claim construction is adapted accordingly. For that reason, this court has not required that the trial court attempt to provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents. Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to “construe” a design patent claim by providing a detailed verbal description of the claimed design.

While it may be unwise to attempt a full description of the claimed design, a court may find it helpful to point out, either for a jury or in the case of a bench trial by way of describing the court’s own analysis, various features of the claimed design as they relate to the accused design and the prior art. Apart from attempting to provide a verbal description of the design, a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those include such matters as describing the role of particular conventions in design patent drafting, such as the role of broken lines; assessing and describing the effect of any representations that may have been made in the course of the prosecution history; and distinguishing between those features of the claimed design that are ornamental and those that are purely functional,

**Wing Shing Products (BVI) Co. v. Sunbeam Products, Inc.**

665 F. Supp. 2d 357 (S.D.N.Y. 2009)

Plaintiff Wing Shing owns United States Design Patent No. **D348,585** for the ornamental design of a coffeemaker. Defendant Sunbeam is a Delaware corporation that sells coffee makers under the MR. COFFEE brand. 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.

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)

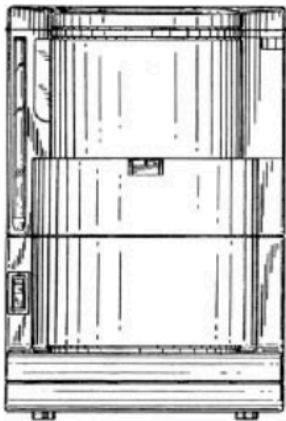
Two major differences between the designs are apparent. First, they have different bases: the '585 has a "bullnose" base – it is flat with a rectangular cross section up to the tip, where the top and bottom meet on a curve – while the AR 10/12 has a smooth base that slopes gradually from the heating 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. 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. That "a purchaser of things of similar design," as the ordinary observer has been defined, could be deceived by the devices' similarities seems unlikely to the Court, but resolution of the inquiry would benefit from a concrete guidepost. 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.

Defendants identify numerous examples of prior art. The primary piece is a coffeemaker called the "Accel" that Sunbeam itself developed in the early 1990's. 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." *Egyptian Goddess*. Accordingly, the scope of protection afforded the '585 patent falls in a narrow range.

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 circumfer-

ence 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. 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:





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. 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 analyze the design as a whole and not engage in an element-by-element comparison of the devices in question. Nonetheless, when the prior art is used as a frame of reference, the tops and bases of the devices in question dominate the overall visual impressions they make. 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.

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. 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. 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. 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.

**OddzOn Products, Inc. v. Just Toys, Inc.**  
122 F.3d 1396 (Fed. Cir. 1997)

OddzOn is a toy and sporting goods company that sells the popular “Vortex” tossing ball, a foam football-shaped ball with a tail and fin structure. The Vortex ball is OddzOn’s commercial embodiment of its design patent, U.S. Patent **D346,001**, which issued on April 12, 1994. Just Toys, Inc., another toy and sporting goods company, sells a competing line of “Ultra Pass” balls.

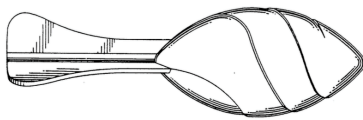
OddzOn argues that the district court erred in finding a lack of infringement. We do not agree.

In *Gorham*, the claimed elements were purely ornamental, being limited to the scroll work on the handle portion of flatware. If, on the other hand, a design contains both functional and ornamental features, the patentee must show that the perceived similarity is based on the ornamental features of the design. The patentee must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental.

In construing the claim of OddzOn’s patent, the district court carefully noted the ornamental features that produced the overall “rocket-like” appearance of the design. We agree with the district court’s claim construction, which properly limits the scope of the patent to its overall ornamental visual impression, rather than to the broader general design concept of a rocket-like tossing ball.

OddzOn argues that the shape of a football with an arrow-like tail is an ornamental feature because “it is not required for a tossing ball.” While OddzOn correctly states that there are many ways of designing “tossing balls,” it is undisputed that the ball in question is specifically designed to be thrown like a football, yet travel farther than a traditional foam football. It is the football shape combined with fins on a tail that give the design these functional qualities. The tail and fins on OddzOn’s design add stability in the same manner as do the tail and fins found on darts or rockets. They are no less functional simply because ‘tossing balls’ can be designed without them.

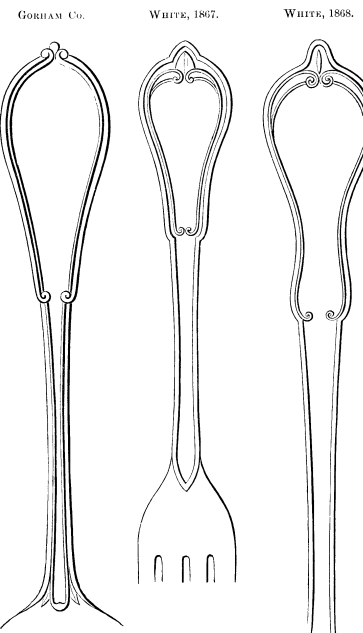
Because the accused products are clearly similar to OddzOn’s design in terms of their football shape and their tail and fins, it was incumbent on OddzOn to submit evidence establishing that the ornamental aspects of their football-with-tail-and-fin combination accounted for the similarity perceived by the survey participants. None of the evidence, when viewed in the light most favorable to OddzOn, would support a jury verdict that the accused devices are similar to the patented design with its football-shaped ball, slender tailshaft, and three fins which seemingly protrude out of the football and gen-



'001 design



Ultra Pass balls



Plaintiff's and defendant's designs from *Gorham*

tly flare outwardly.

OddzOn also submitted evidence establishing that Just Toys' balls were returned to OddzOn by retailers on nineteen different occasions. The district court excluded this evidence of alleged "actual confusion" on the ground of lack of relevance. We agree with OddzOn that the exclusion of the "actual confusion" evidence on relevance grounds was an abuse of discretion. Given the low threshold for relevancy, it is clear that the evidence was relevant. We find this error harmless, however, because it does not change the result of OddzOn's appeal.

**L.A. Gear, Inc. v. Thom McAn Shoe Co.**  
988 F.2d 1117 (Fed. Cir. 1993)

Although design patent analysis requires comparison of the claimed design with the accused articles, Melville has not argued that the patent drawing differs from the embodiment in the L.A. Gear shoe, and has offered no reason why the finding of substantial similarity between the actual shoes was not applicable to the infringement analysis. When the patented design and the design of the article sold by the patentee are substantially the same, it is not error to compare the patentee's and the accused articles directly; indeed, such comparison may facilitate application of the *Gorham* criterion of whether an ordinary purchaser would be deceived into thinking that one were the other.

Design patent infringement relates solely to the patented design, and does not require proof of unfair competition in the marketplace, or allow of avoidance of infringement by labelling.

## 5 Infringement: Prohibited Conduct

### Patent Act

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

35 U.S.C. § 289  
*Additional remedy for infringement of  
design patent*

A few notes:

1. Section 289 provides additional remedies; the clear implication is that the usual theories of direct, inducing, and contributory patent infringement under § 271 are also available for design patents.
2. As with utility patents, there is no requirement of copying from the plaintiff; design patents give a general right to exclude anyone from using the patented design.
3. Design patents probably also borrow their rules on intent from utility patent law: one can infringe without knowing of the patent or intending to infringe it.
4. Both prongs of § 289 have explicitly commercial thresholds: they turn on "the purpose of sale" and on "sells or exposes for sale," respectively.
5. § 289 is silent on questions of indirect liability. There is essentially no caselaw on point.

## 6 Defenses

### Jazz Photo Corp. v. International Trade Com'n

264 F.3d 1094 (2001)

[Fuji Photo Film Co. sold disposable cameras.] The cameras are intended by the patentee to be used only once. After the film is exposed the photo-processor removes the film container by breaking open a pre-weakened portion of the plastic casing which is accessed by removal of the cardboard cover. Discarded LFFPs, subsequently purchased and refurbished by the respondents, are the subject of this action.

We conclude that for used cameras whose first sale was in the United States with the patentee's authorization, and for which the respondents' activities were limited to the steps of (1) removing the cardboard cover, (2) cutting open the plastic casing, (3) inserting new film and a container to receive the film, (4) replacing the winding wheel for certain cameras, (5) replacing the battery for flash cameras, (6) resetting the counter, (7) resealing the outer case, and (8) adding a new cardboard cover, precedent requires that the described activities be deemed to be permissible repair.

[Most of the opinion dealt with the repair/reconstruction distinction as it bore on the exhaustion of Fuji's utility patents. But the court also discussed exhaustion of Fuji's design patents.]

The patented designs depict the exterior shape of the camera. The exterior design is unaffected by the "remanufacturing" process; it remains in its original form in the outer box and plastic structure of the

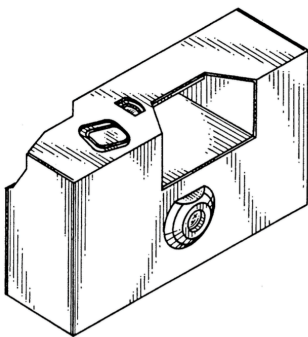


Figure 1, U.S. Des. Pat. No. D345,750, "Single use camera."

camera. The respondents do not dispute that their cameras have the same design as the original cameras; indeed, their argument is that their cameras are the original cameras, repaired for reuse.

For original cameras that have been permissibly repaired, the principle of exhaustion applies to the design patents as well as to the utility patents. The design patent right, like all patent rights, is exhausted by unrestricted first sale in the United States, and is not infringed by the importation and resale of the repaired articles in their original design.

**Ralph D. Clifford & Richard J. Peltz-Steele, *The Constitutionality of Design Patents***

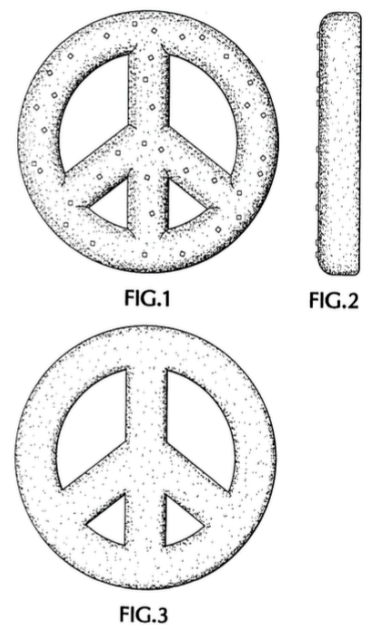
14 Chi.-Kent L. J. Intell. Prop. 553 (2015)

A federal case in 2013, closed upon voluntary dismissal without a court opinion, nicely demonstrates the need for a fair use defense in design patent law. Until the expiration of its 14-year term in April 2014, patent [D423,184](#) protected this “pretzel,” which we call the Peace Pretzel.

Plaintiff Leslie Friend of Pittsburgh, Pennsylvania, purchased the design patent in the last year of its validity from the sister of the inventor, Michael Lamont, who had passed away in 2007. Friend’s attorneys told media that Friend planned to start a pretzel business. She then discovered the design on offer from an online Massachusetts pretzel purveyor called Laurel Hill Foods. Laurel Hill sold pretzel chips in the shape of a peace sign in three flavors – “everything,” sea salt, and honey multigrain– which Laurel Hill bought from a Pennsylvania company, Keystone Pretzels. Friend sued Laurel Hill and Keystone.

Commentators on the *Friend* lawsuit suggested that Laurel Hill pretzel chips were not deep enough, in dimension, to run afoul of the Peace Pretzel design patent, in which figure 2 suggests a depth of dough equivalent to the width depicted in figure 1. We disagree. Employing design patent infringement analysis, the minimal novelty requirement would be satisfied by the peace-sign shape of the pretzel dough, which is what differentiates the product from the traditional pretzel knot. That very novelty is the defining characteristic of Laurel Hill pretzel chips. The ordinary observer very well might purchase the one, supposing it to be the other. So Friend had a strong lawsuit on her hands, even while she never got her pretzel business off the ground, and the impetus for Lamont’s initial conception in 1999 was all but forgotten. Neither news reports nor the case record explain why Friend voluntarily dismissed with prejudice just four months after filing, but it is reasonable to speculate that a settlement was reached.

The missing piece in the *Friend* lawsuit, and the unresolved prob-



'184 design



lem presented by design patents, is fair use. Insofar as Friend was a sympathetic plaintiff, Laurel Hill and Keystone were profiting off the ingenuity of another and may have been expected fairly to pay up. But change the defendant to a non-commercial user, and the case takes on a different cast. Imagine a city rally for Ukrainian-Russian peace at which a sponsoring ethnic bakery makes and gives away peace-sign-shaped pretzels. Or suppose that a German-American citizens group decides to counter community angst over immigration by uniting local persons of different backgrounds in Oktoberfest beer gardens to dialog over homemade peace-sign-shaped pretzels. Peace-sign-shaped cookies, adorned or not with sugar crystals, or other edibles, also might run afoul of the design patent, as the controlling diagrams say nothing about the edible ingredients.

Farther afield, suppose shaped pretzels become *objets d'art*. A latter-day Andy Warhol or redirected Thomas Forsyth might create a range of artwork meant to comment on the inequality of food distribution around the world, even employing bread dough as ironic medium. The Peace Pretzel might be just one entry in a series of works, perhaps alongside a doughy stalk of wheat, a floury planet earth, and a breadly bas-relief of scythe-wielding farm workers.

We can complicate the case further if we trade out the peace sign for a more controversial symbol. To choose a plaintiff that engenders less sympathy, suppose that the multinational oil and gas company BP obtained a design patent on a distinctive container for motor oil—let us borrow the double-sphere bottle in which POM Wonderful sells fruit juice. After the BP oil spill, a protestor and artist creates a sculpture depicting a blackened, oil-sodden pelican, surrounded by upturned BP oil bottles, also blackened, but recognizable by their shape. The artist might re-create (*make*) the bottles, or *use* discarded bottles. The artist might auction off (*sell*) the sculpture and donate the proceeds to an environmental advocacy group.

Critical training is hardly required to perceive the artist's message favoring environmental protection, or inversely, blaming BP for environmental degradation. But the work plainly runs afoul of the design patents, as the artist has made or used, and sold, the patented bottles. The ordinary observer properly perceives the BP bottles; indeed, the artist might be using BP bottles, which our auction winner buys because they are what they appear to be.

Without the structural safeguards and fair use defense that shape copyrights to accommodate free speech, design patents exclude the activists and artists from political advocacy and social commentary. These functions lie at the heart of First Amendment protection, and for good reason. If design patents can be perverted to freeze out this speech, then the public policy goals of free speech<sup>395</sup> are not achieved.



Hypothetical anti-BP protest sculpture

It is unnecessary to craft a new strict scrutiny test under the First Amendment because the copyright fair use doctrine provides a well-drawn test designed already to accommodate the balance between the IP Clause and the First Amendment. The deep similarity of copyrights and design patents, notwithstanding their semantic differences and historical divergence, further suggest the appropriateness of fair use to design patents with only slight adaptations that can be done as a matter of constitutional law, without modification to statutory patent law

### **Eames Chair Problem, Re-revisited**

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