VISUAL INVENTION

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The Federal Circuit recently raised—but did not answer—the question of whether its nonobviousness test for design patents should be modified in light of its decision in Egyptian Goddess or the Supreme Court’s decision in KSR v. Teleflex. This Article provides an affirmative answer to that question, taking the Federal Circuit’s question as an opportunity to reconsider how the nonobviousness requirement should be applied to design patents. Nonobviousness has been called “the ultimate condition of patentability,” but for years, courts and commentators have struggled with how to apply this requirement to designs. It has even been described as an “impossible” task.

In the utility patent context, the nonobviousness requirement measures technical accomplishment. Some commentators have suggested that, by analogy, nonobviousness must measure aesthetic merit in design patents. But this Article provides a new approach. This Article argues that, in order to promote the decorative arts, design patents should encourage intentional efforts to make products look better. However, designs should not be available to every new product design, especially not to those that would have been produced without any design patent incentive. To promote these goals, the nonobviousness inquiry should focus not on aesthetic merit but on aesthetic conception—that is, on visual invention. Based on these principles, this Article proposes several changes to the Federal Circuit’s current nonobviousness test for design patents.

First, this Article argues that the scope of prior art for primary references should be limited, in most instances, to products of the same general type as the claimed design. The designer’s problem—how to make a given product look better—has many possible solutions. If a new design is so different from other products of its type that no primary reference can be found, that could be strong evidence of visual invention. In light of KSR, however, this need not be a rigid test, and exceptions could exist in some cases, such as where the product itself is entirely new.

Second, this Article argues that new rules should be adopted for modifying primary references. Generally, an examiner (or defendant) should have to show some motivation to modify the existing design. However, evidence of such motivation should neither be limited to written disclosures nor constructed ex post by cherry-picking design elements out of the prior art. Additionally, where the only difference between the new design and the prior art was the result of a non-aesthetic change—e.g., where the design was modified to make the product more useful or to reduce production costs—that fact would be evidence that the resulting design was visually obvious. In such cases, an ordinary designer would be motivated to create the new design without any aesthetic conception at all—and without any need for a design patent incentive.