

Looks Matter...

Legally. ®

Navigating and Rectifying the Design Patent Muddle

BCLT Design Patent Symposium

February 19, 2021

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WHAT MUDDLE?

A PRIMER ON DESIGN PATENT FUNCTIONALITY

TWO IMPORTANT PRINCIPLES

Primer on Design Patent Functionality

I. A design patent does not protect “functional” features.

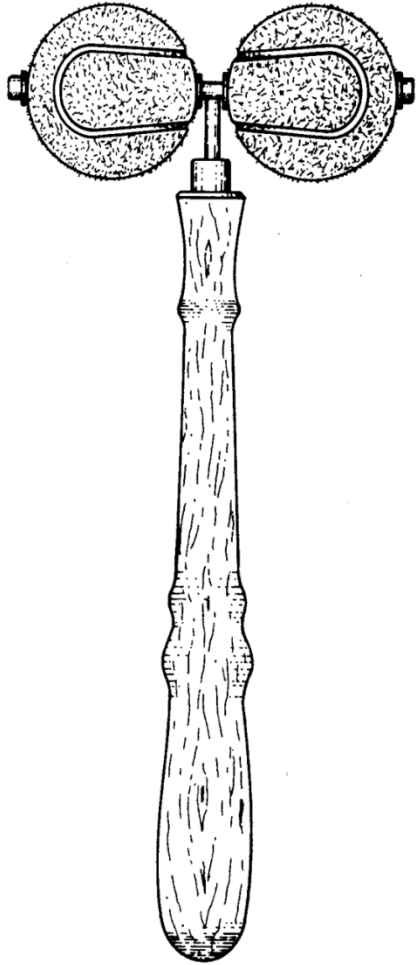
Primer on Design Patent Functionality

It only protects the **appearance** of the overall claimed design, including the **appearance** of any so-called “functional” features.

Primer on Design Patent Functionality

Anyone may use the same functional features, as long as their product does not look substantially the same as the claimed design.

Lee v. Dayton Hudson (Fed. Cir. 1988)



Patented Design

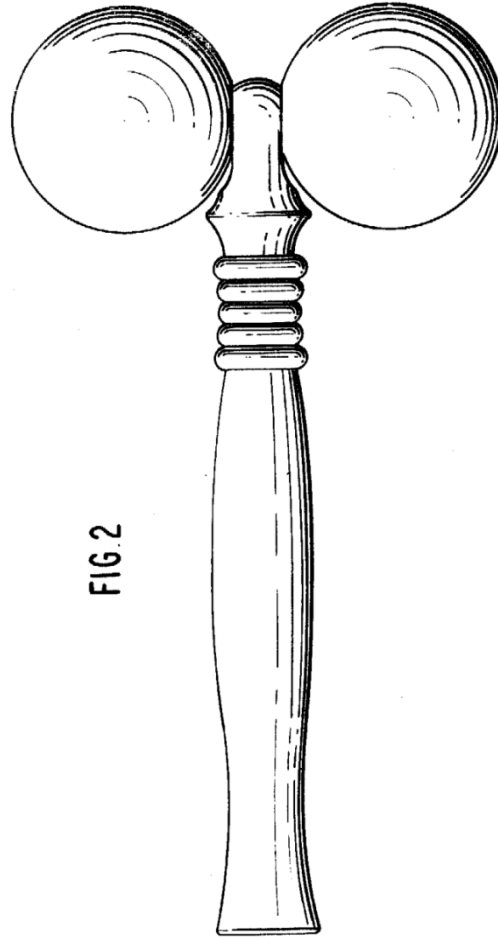


FIG. 2

Non-infringing Designs

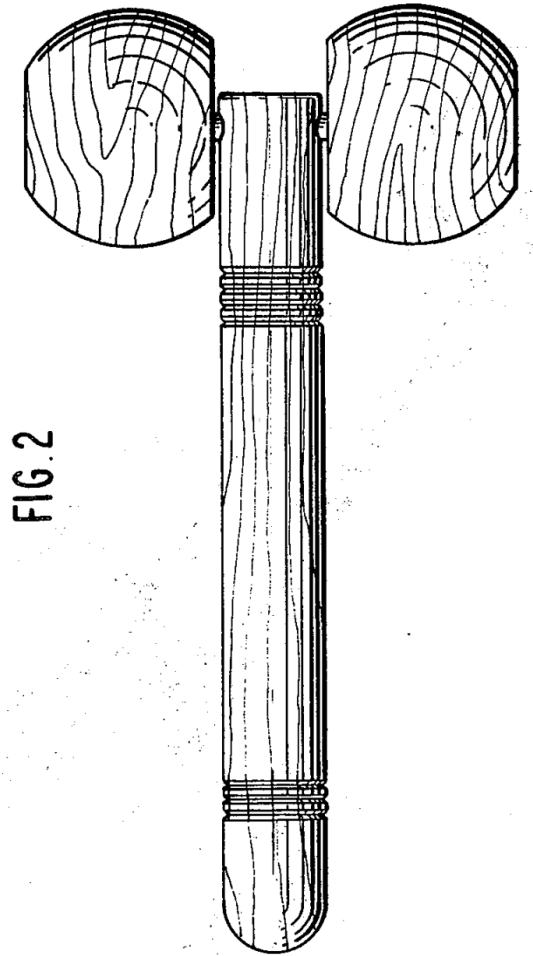
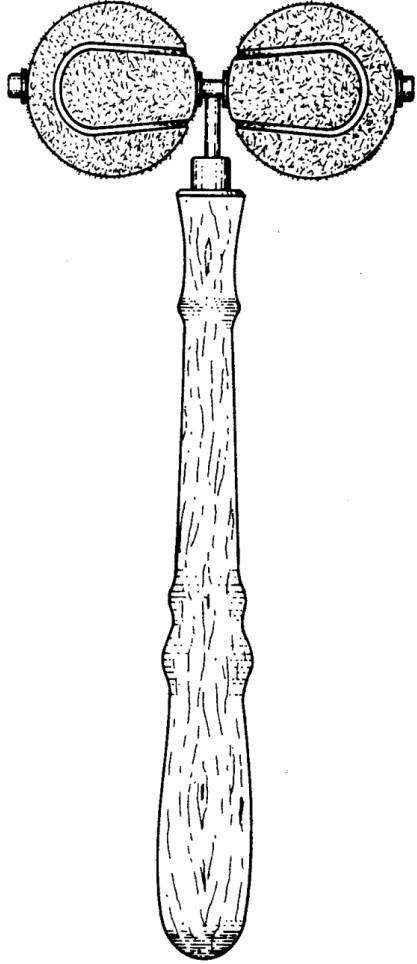


FIG. 2

Lee v. Dayton Hudson (Fed. Cir. 1988)



Patented
Design

COURT:

“...a design patent is not a substitute for a utility patent. A device that copies the utilitarian or functional features of a patented design is not an infringement unless the ornamental aspects are also copied, such that the overall resemblance is such as to deceive, citing Gorham.” No infringement.

Best Lock v. Ilco Unican

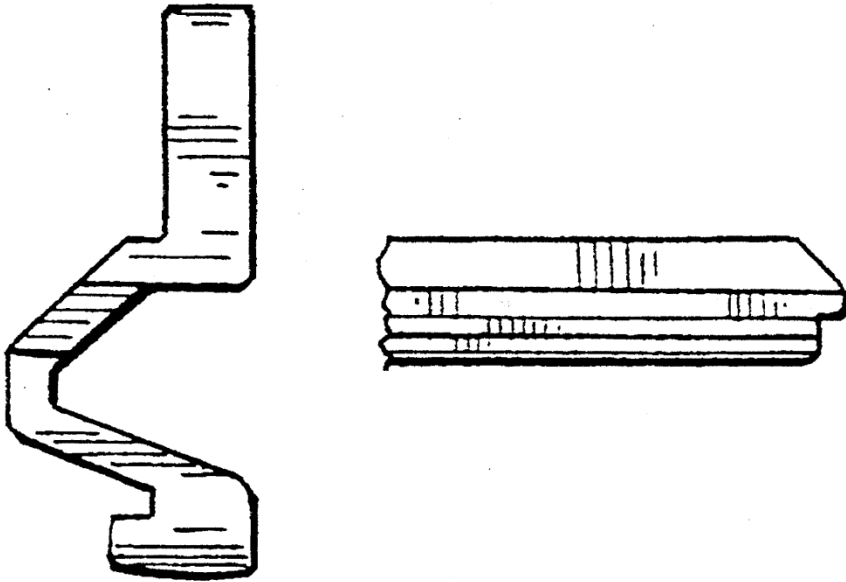
United States Patent [19]
Best et al.

[11] Patent Number: Des. 327,636
[45] Date of Patent: ** Jul. 7, 1992

[54] PORTION OF A KEY BLADE BLANK

[75] Inventors: Walter E. Best; Timothy R. Bjornson,
both of Indianapolis; James W.
Borgmann, Carmel; Gary R. Jacobs,
Indianapolis, all of Ind.

[73] Assignee: Best Lock Corporation, Indianapolis,
Ind.



A design is not dictated by its function when alternative designs for the article of manufacture are available, citing *Avia* & *L.A. Gear*.

Best Lock v. Ilco Unican

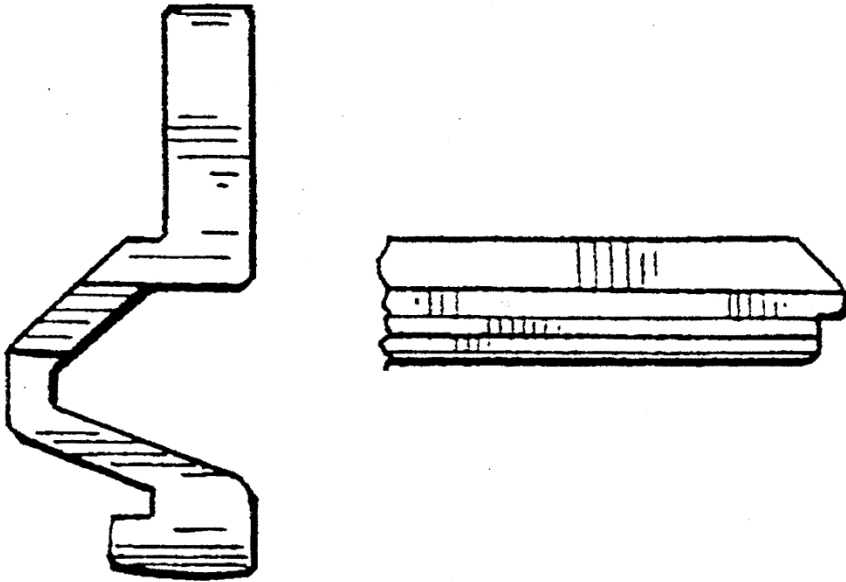
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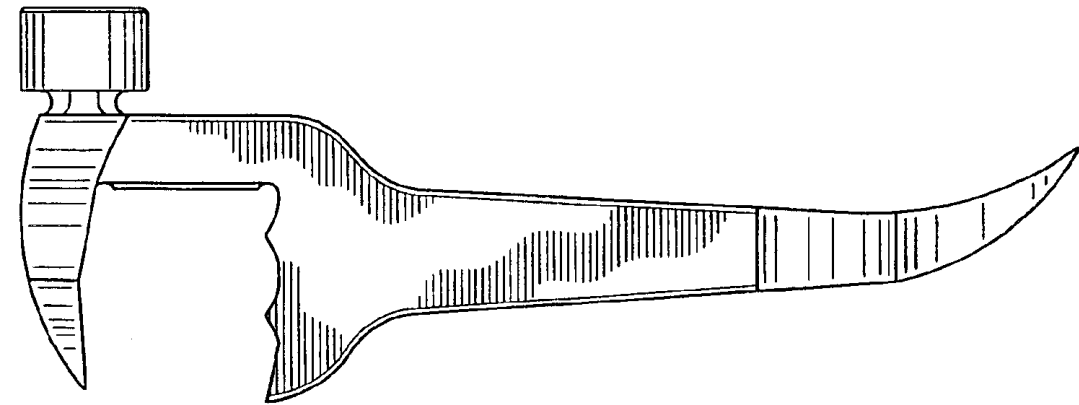


[T]he key blade must be designed as shown in order to perform its intended function...to fit into its lock's keyway...[thus] the design is dictated by function, and invalid.

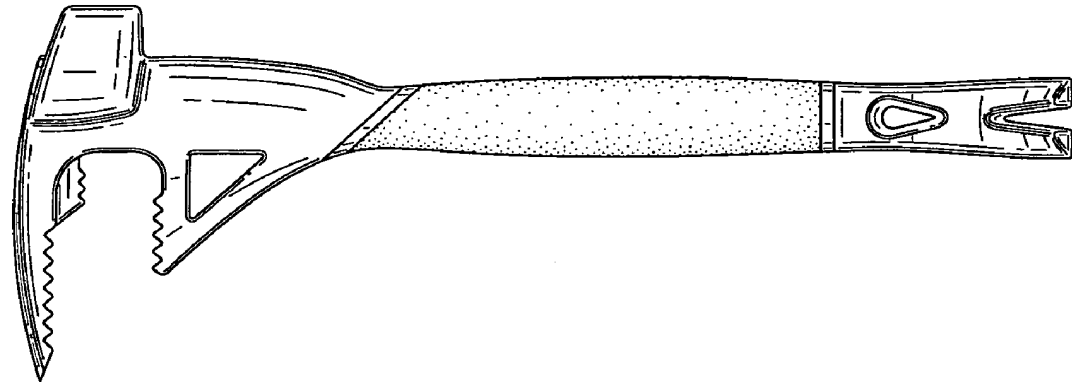
Primer on Design Patent Functionality

2. Because “functional” features also have an appearance, there is no need to “filter” them out

Richardson v. Stanley Works (Fed. Cir. 2010)



PATENTED
DESIGN

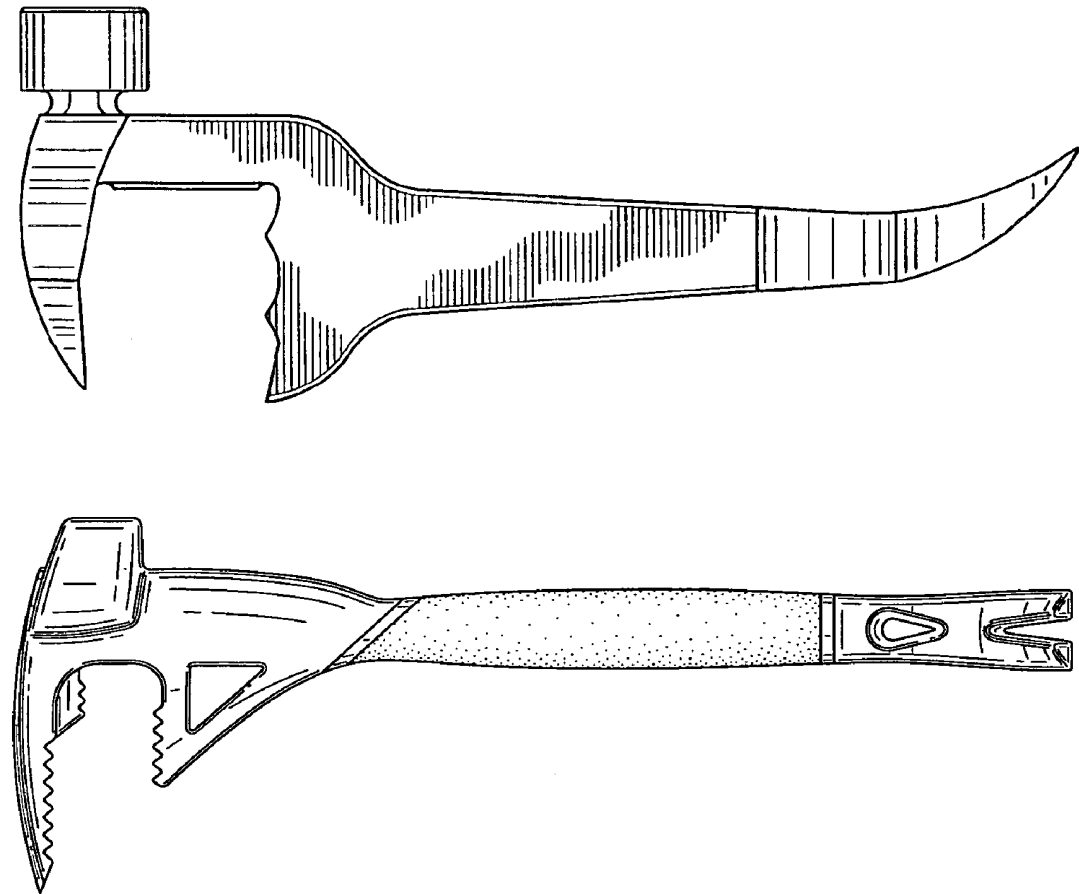


ACCUSED
DESIGN

Richardson v. Stanley Works (Fed. Cir. 2010)

FEDERAL CIRCUIT:

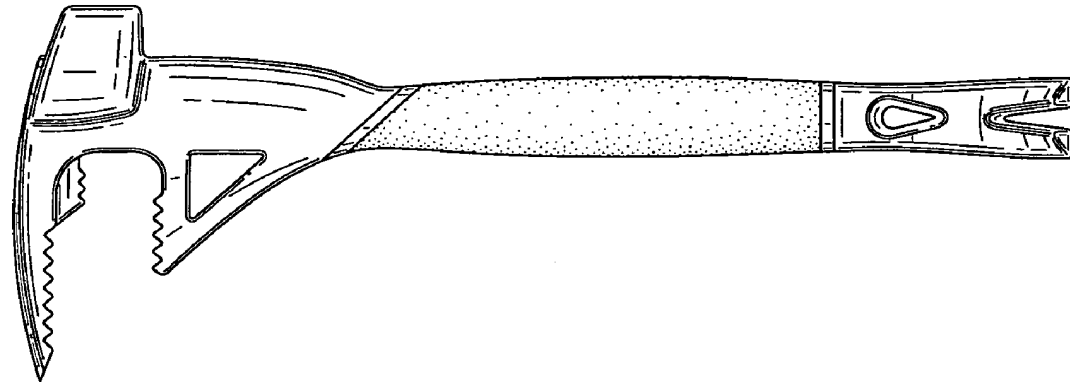
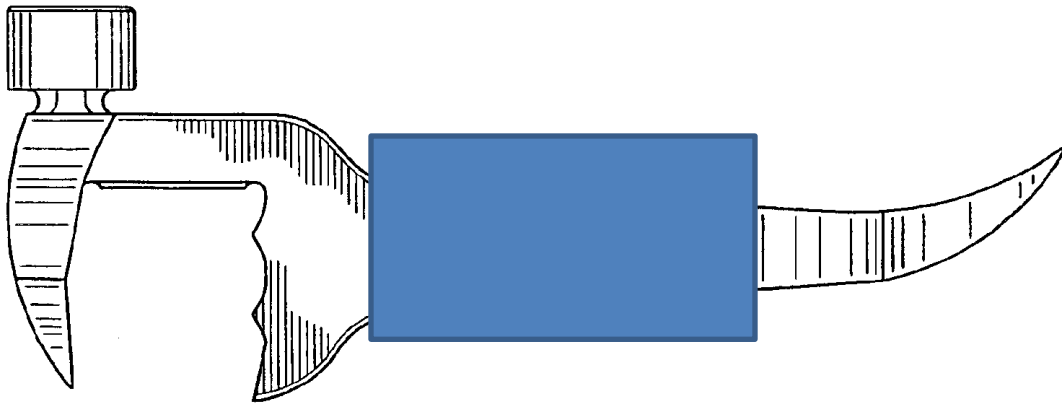
Richardson's multi-function tool comprises several elements that are driven purely by utility... the handle, the hammerhead, the jaw, and the crowbar are dictated by their functional purpose.



Richardson v. Stanley Works (Fed. Cir. 2010)

FEDERAL CIRCUIT:

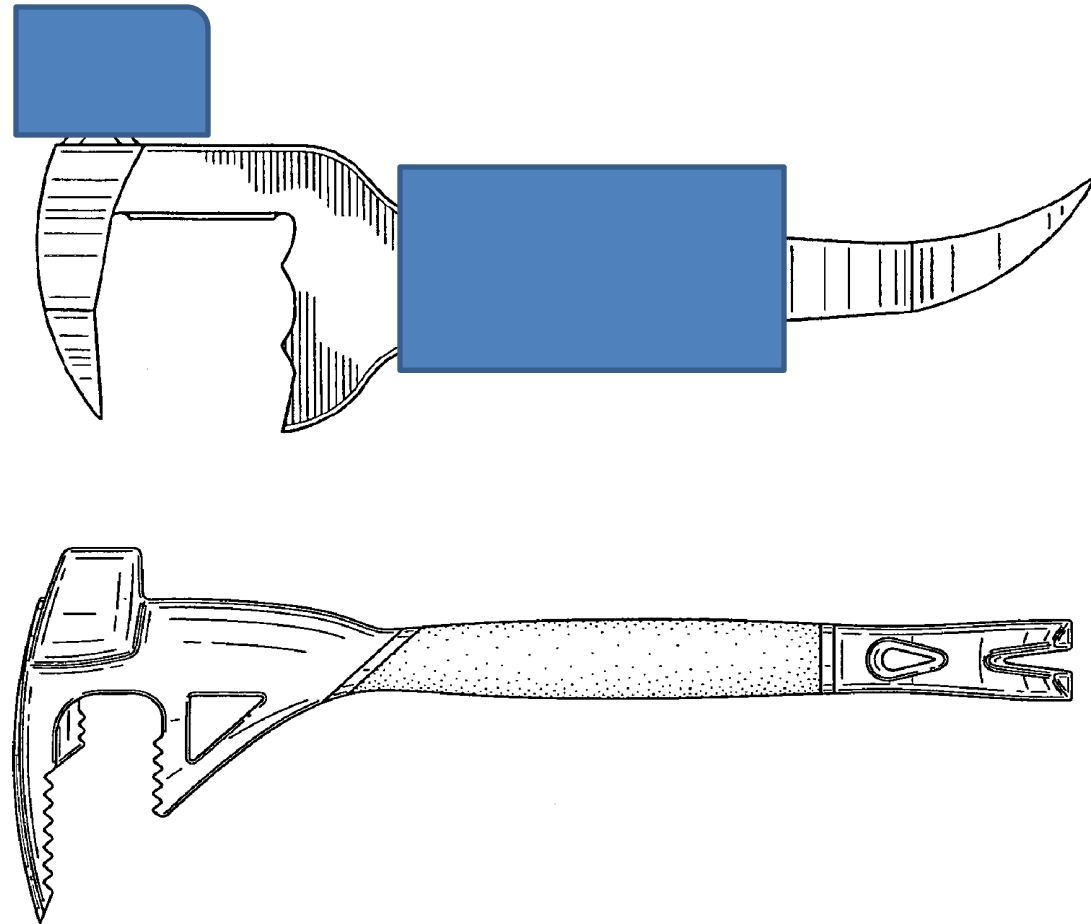
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Richardson v. Stanley Works (Fed. Cir. 2010)

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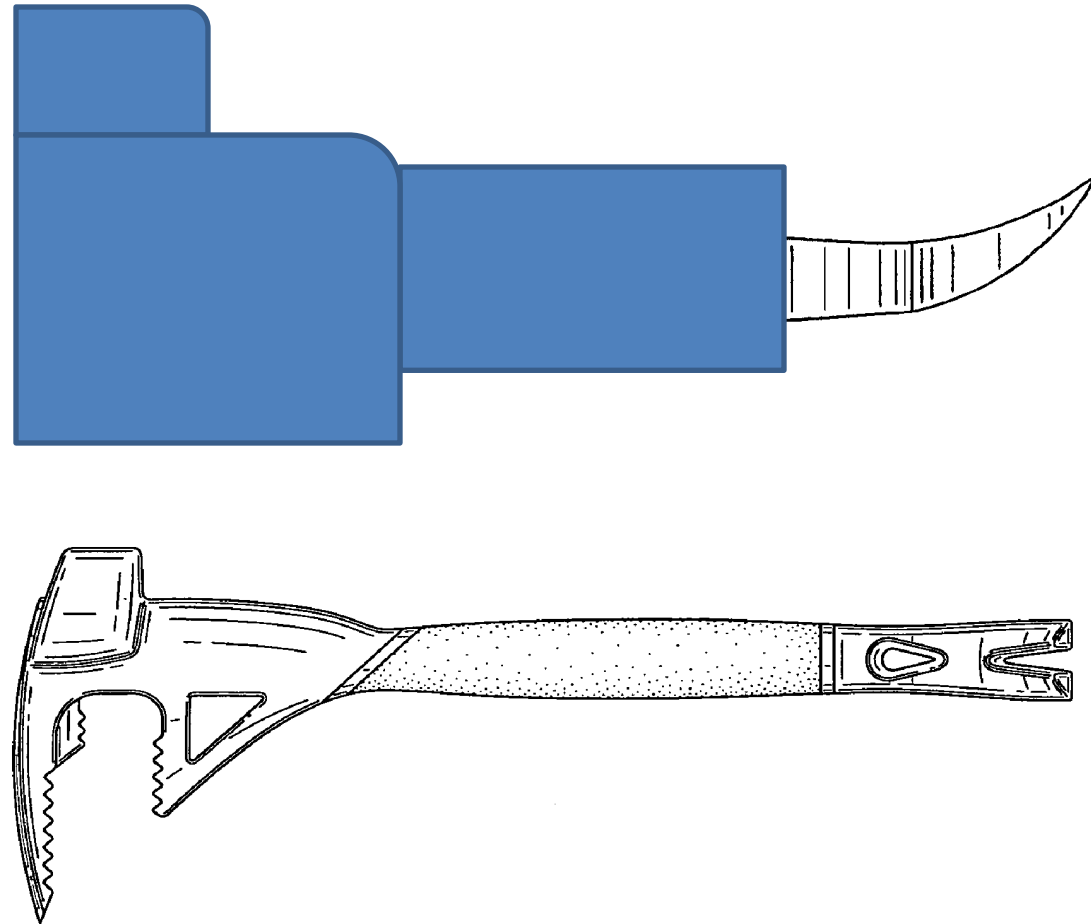
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Richardson v. Stanley Works (Fed. Cir. 2010)

FEDERAL CIRCUIT:

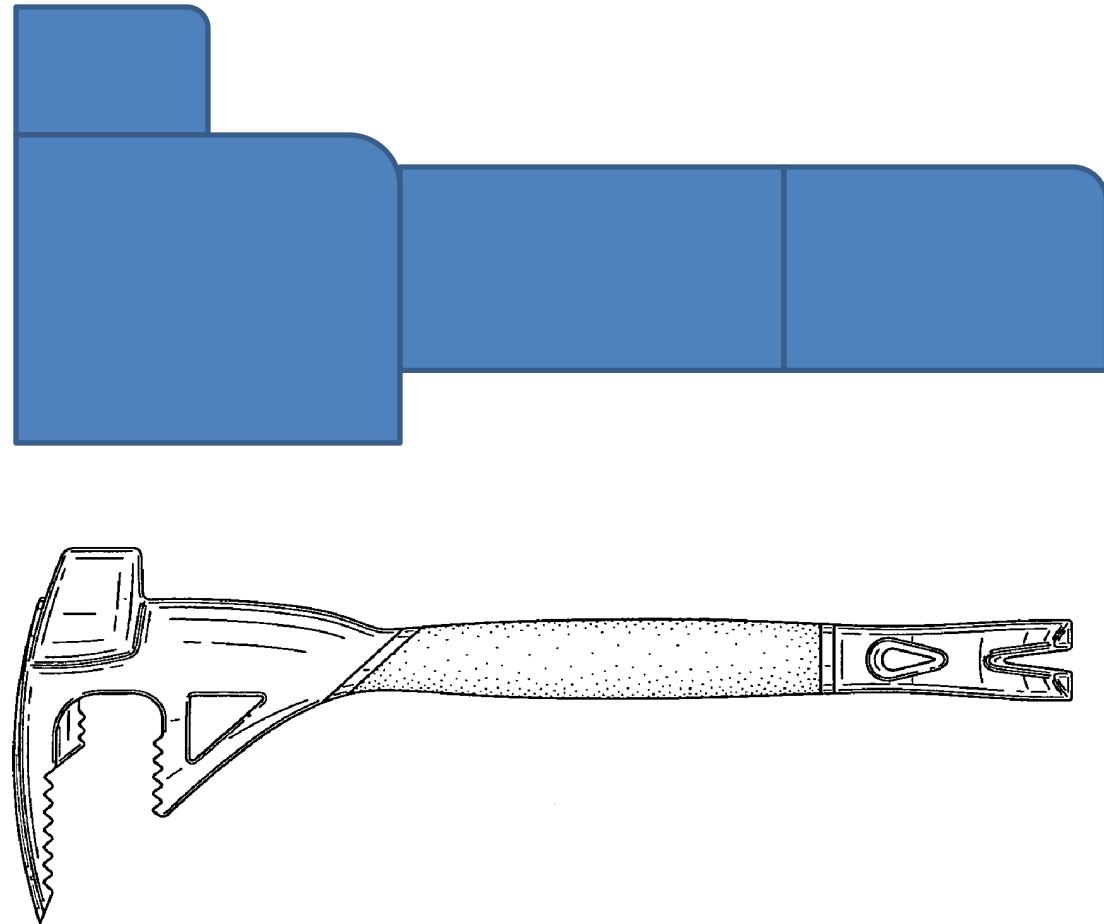
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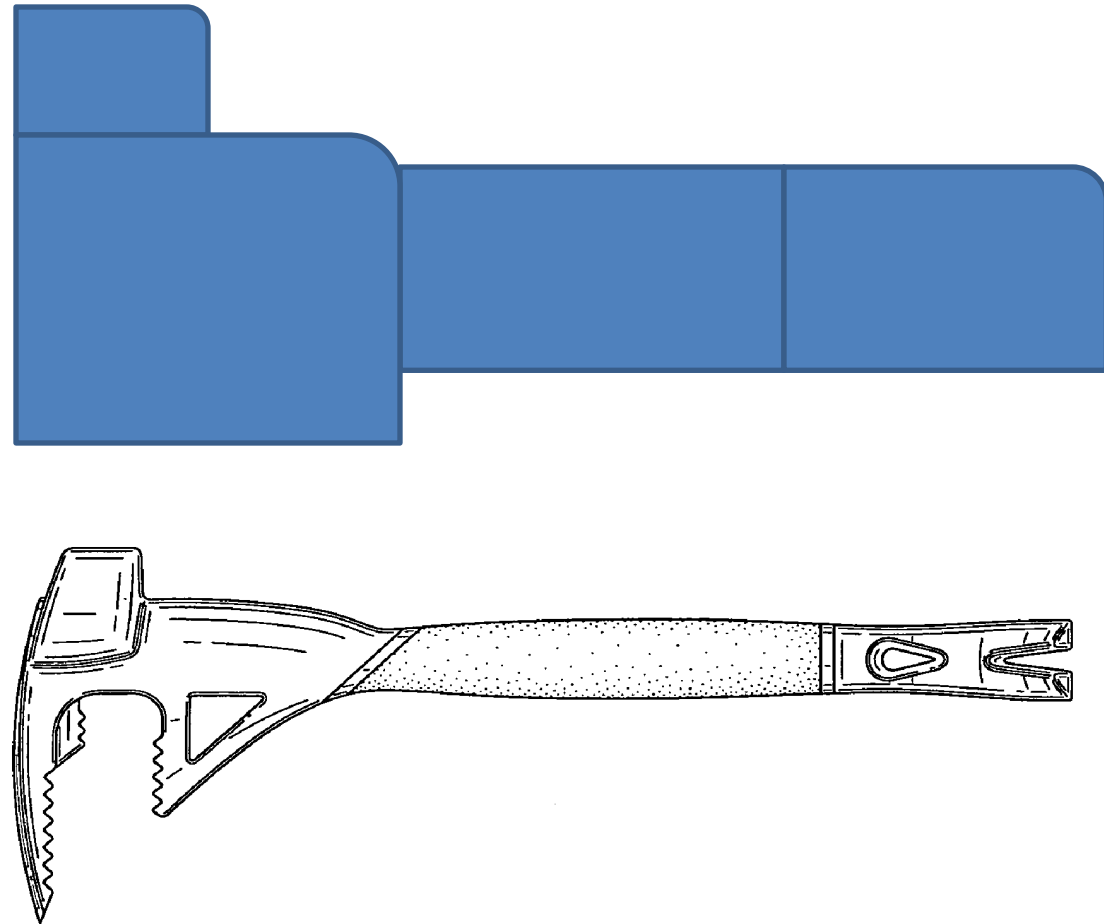
FEDERAL CIRCUIT:

Richardson's multi-function tool comprises several elements that are driven purely by utility... the handle, the hammerhead, the jaw, and the crowbar are dictated by their functional purpose.



Richardson v. Stanley Works (Fed. Cir. 2010)

So, the
design patent
covers
NOTHING??



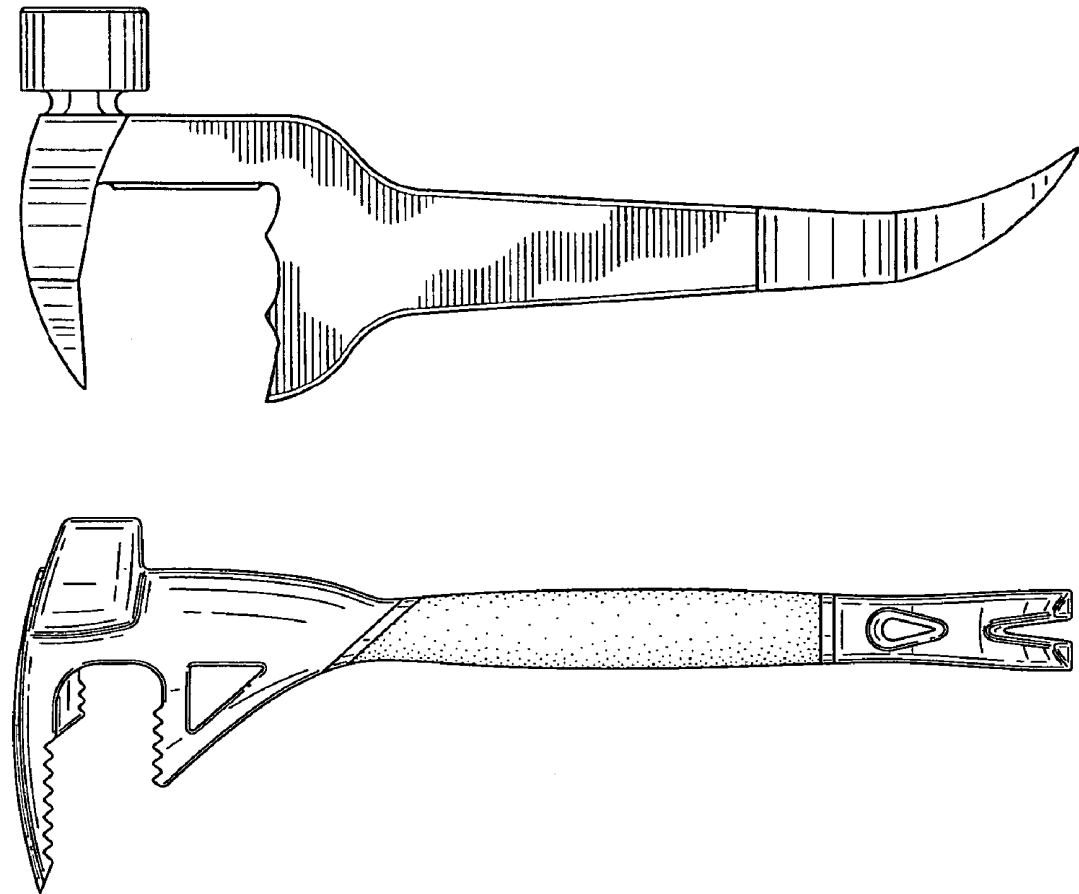
Richardson v. Stanley Works (Fed. Cir. 2010)

No, the design patent covers the **appearance** of the so-called “functional” features.

Here, the accused design simply does not **look like** the patented design.

No infringement.

End of story.



Sport Dimension v. Coleman

(Federal Circuit, 2016)

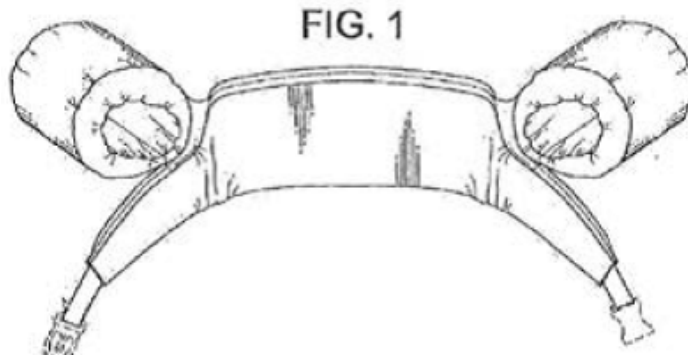
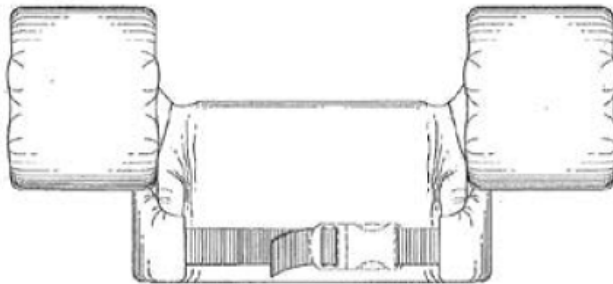


FIG. 2



PATENTED DESIGN



ACCUSED DESIGN

Sport Dimension v. Coleman (Federal Circuit, 2016)

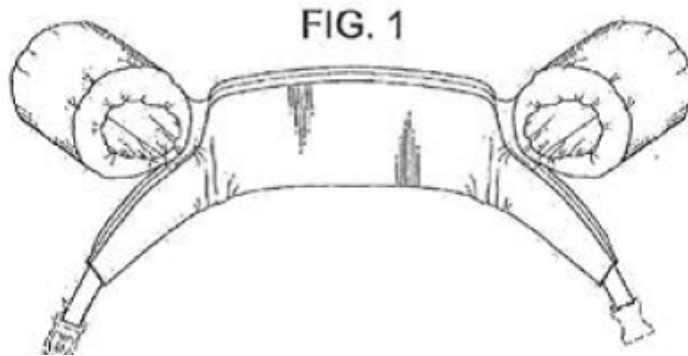
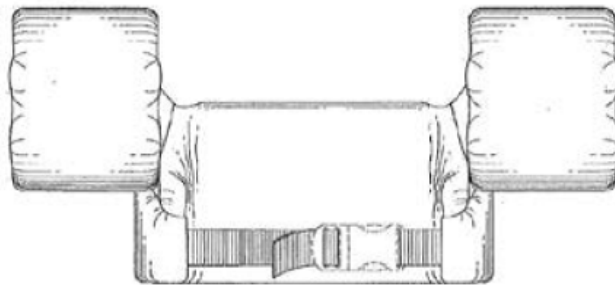


FIG. 2



FEDERAL CIRCUIT: [I]n no case did we entirely eliminate a structural element from the claimed design, even though that element also served a functional purpose.

Sport Dimension v. Coleman

(Federal Circuit, 2016)

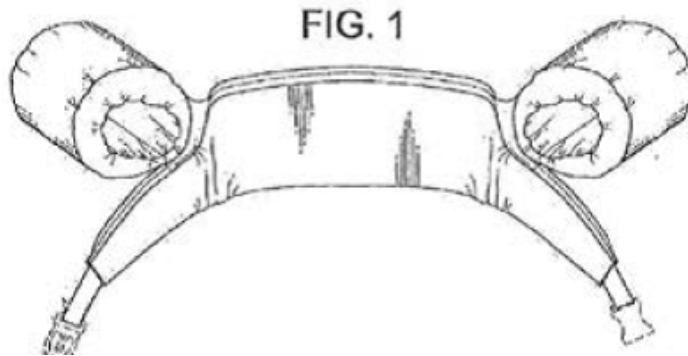
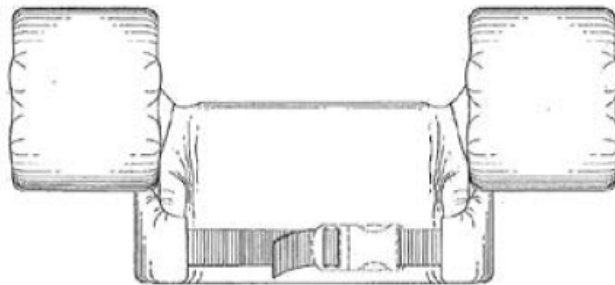


FIG. 2



FEDERAL CIRCUIT: Although the design patents do not protect ... general design concepts of utilitarian elements... they nevertheless protect the particular appearance of the elements (citing *Ethicon v. Covidien*).

Sport Dimension v. Coleman (Federal Circuit, 2016)

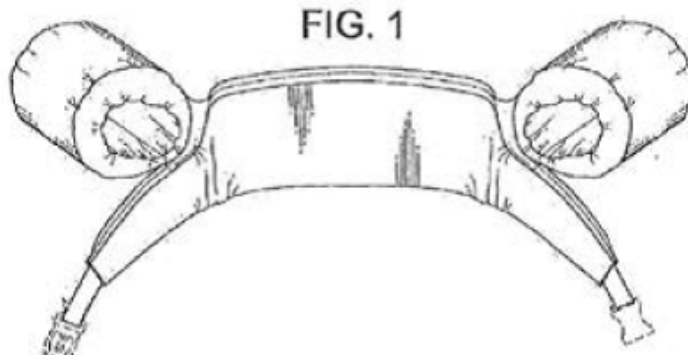
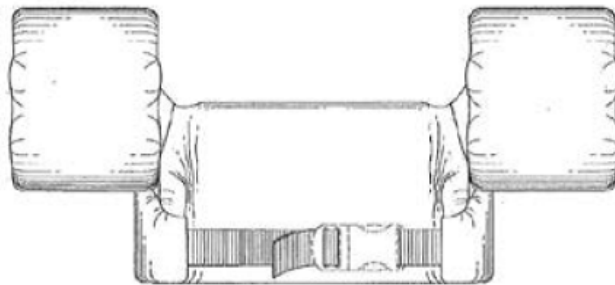


FIG. 2



FEDERAL CIRCUIT: [T]he district court erred by completely removing the armbands and side torso tapering from its claim construction.

Primer on Design Patent Functionality

1. A design patent does not protect “functional” features.
2. Because “functional” features also have an appearance, there is no need to “filter” them out.

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