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Letter

# THE CRISIS IN THE LAW OF DESIGNS

Perry J. Saidman\*

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\* Principal, SAIDMAN **DesignLaw** Group, a law firm located in Silver Spring, Maryland that specializes in legal issues involving designs and product configurations. The opinions expressed herein are those of the author only and do not necessarily represent those of any client of the firm. © 2007 Perry J. Saidman.



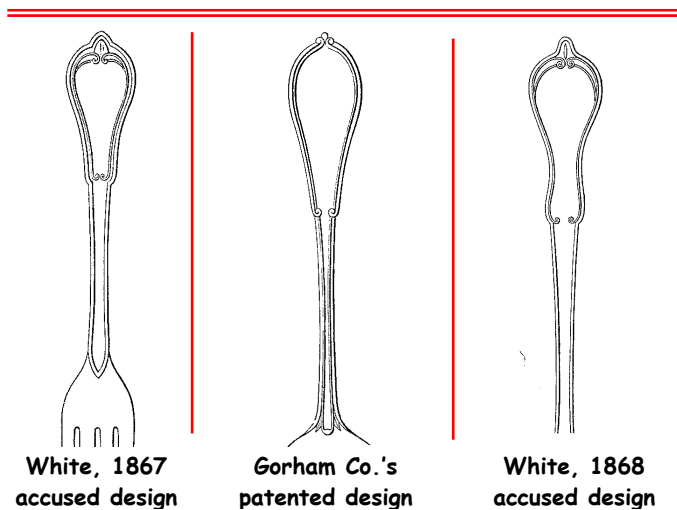
# THE CRISIS IN THE LAW OF DESIGNS

## I. Introduction

In 1871, the U.S. Supreme Court decided that it was through the eyes of an ordinary observer, rather than an expert, that mattered in determining whether Mr. White's designs were substantially the same as Gorham's patented design for a silverware handle.<sup>1</sup> This fundamental test for design patent infringement remains the law today.

In reaching its decision, the Court said that if the test for infringement was viewed through the eyes of an expert, or even through the eyes of a person versed in the trade, it would destroy all the design protection which the act of Congress intended to give, since persons versed in the trade would rarely not be able to discern differences between two designs. The Court did not require the lower court to verbalize the claimed design before applying the ordinary observer or "eye test" for infringement; the Court itself took notice of the similarities and differences between the patented and accused designs.

### Gorham v. White



<sup>1</sup> *Gorham Co. v. White*, 81 U.S. (14 Wall) 511 (1871).

The Court did not consider whether the accused silverware contained the point of novelty of the patented design before finding that both of White's designs infringed Gorham's patent.

The Court, in reaching its holding on infringement, did not say that design patents have almost no scope. In stark contrast, the Court gave Gorham's design patent unprecedented and substantial scope, as (excuse the expression) is patently obvious when viewing Gorham's patented design and both of White's designs.

And despite the overwhelming functional nature of a handle that allows a user to grip the silverware, the Court did not ask whether the patented design was primarily ornamental rather than primarily functional, whether it was the best design, or whether alternate designs would adversely affect the utility of the patented fork and spoon handles.

In sum, the Court wisely devised an ordinary observer test that gave design patents sufficient scope to give patentees a reasonable shot against knock-off artists, who, of course, purposely make a colorable imitation of a patented design but never copy it exactly.

Anyone who has followed recent design patent decisions from the courts, especially those from the U.S. Court of Appeals for the Federal Circuit, has to be scratching his or her head in bewildered amazement as to how the case law could have strayed so mightily from this still-binding and venerable 1871 precedent.

Not so long ago, from among the three ways for protecting industrial designs, design patents were clearly the best option.<sup>2</sup> Unlike trade dress protection, they didn't require a showing of secondary meaning,<sup>3</sup> and unlike copyright, they didn't require the aesthetic features and the utilitarian features to be "separable."<sup>4</sup> They could be obtained in a fairly timely manner

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<sup>2</sup> Perry J. Saidman & John Hintz, *SNEAKERS, DESIGN PATENTS & SUMMARY JUDGMENTS: Opening A New Era in the Protection of Consumer Product Designs*, 71 J. PAT. & TRADEMARK OFF. SOC'Y 524, July 1989.

<sup>3</sup> *Infra*, note 16.

<sup>4</sup> *Infra*, note 19.

when using the PTO's special "rocket docket" expediting procedure,<sup>5</sup> and lasted for 14 years without the need for maintenance fees or continued use affidavits.<sup>6</sup> Additionally, the Federal Circuit had as its mandate a unification of the various Circuits' patent case law in a way that could be relied upon.<sup>7</sup> For those cases in which infringement was strong, the chances of obtaining a preliminary injunction were fairly good.<sup>8</sup> Individual parts could be easily protected,<sup>9</sup> strategies could be devised for dealing with knock-off artists who cleverly avoid infringement of an original (or 'parent') design patent by filing continuation (or 'child') applications with broader claims,<sup>10</sup> and the infringement test was applied in a manner that gave the design patentee a reasonable chance of success before a jury.<sup>11</sup>

Today, these positive attributes of design patents are at best under attack, and at worst are no longer true, rendering the law of designs in a state of crisis. This article will explain the causes of this crisis, and provide a suggestion for turning the tide towards better design protection. Section I will describe the problems with attempts to protect industrial designs through trade dress and copyright laws. Section II will expound on how recent design patent decisions, and some long-standing problems, have made this once useful option problematic at best. Section III will resurrect a long-forgotten legal reform that will provide a design protection system that actually makes sense in the 21<sup>st</sup> century.

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<sup>5</sup> *Infra*, note 93.

<sup>6</sup> Saidman & Hintz, *supra*, note 2 at 536.

<sup>7</sup> *Id.* at 540-541.

<sup>8</sup> *Id.* at 538.

<sup>9</sup> *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980).

<sup>10</sup> See, e.g., D446,098 and D442,045.

<sup>11</sup> *cf. infra*, Section III.C.

## II. Trade Dress and Copyright Laws Are Less Effective to Protect Designs Than Ever Before

### A. The Ugliness of Trade Dress

Trade dress law, a branch of traditional trademark law, was not always unfriendly to product designs.<sup>12</sup> Though the primary goal of trade dress law is to protect consumers from being confused about a product's source or origin, it has had the spillover effect of protecting certain design elements against copying, taking into account the nature of the goods. Indeed, until the Supreme Court decisions in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*<sup>13</sup> and *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*,<sup>14</sup> trade dress law had quite a few positive attributes for design protection, in that you did not have to obtain registration prior to bringing suit under 43(a) of the Lanham Act, the designs clearly did not have to be identical in order to prove a likelihood of confusion (the test for infringement), and the duration of protectable trade dress was potentially infinite. However, the two Supreme Court decisions in *Wal-Mart* and *TrafFix* changed the landscape significantly, to the point where only the rare design will qualify for trade dress protection.

In its 2000 *Wal-Mart* decision, the Court ruled that product design trade dress, much unlike traditional word trademarks, could never be inherently distinctive,<sup>15</sup> and instead always required proof of secondary meaning.<sup>16</sup> The Court also instructed lower courts to err on the side

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<sup>12</sup> "The total image of a product" including "features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques" may be considered part of a product's trade dress. *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 808 n.13 (9th Cir. 2003).

<sup>13</sup> *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

<sup>14</sup> *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

<sup>15</sup> Distinctiveness can be either inherent or acquired and is determined as a matter of fact. See, e.g., *Two Pesos v. Taco Cabana*, 505 U.S. 763 (1992) (holding that a restaurant's decorative motive that was inherently distinctive but had not acquired a secondary meaning in the relevant market could be protected as trade dress). Note, however, that the Court effectively overturned its 1992 *Two Pesos* decision in *Wal-Mart*, decided only 8 years later.

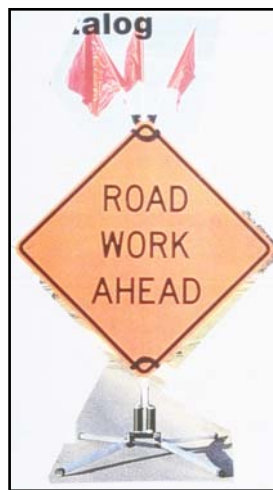
<sup>16</sup> Secondary meaning is acquired over time, as consumers come to associate the trade dress (in the case of a design, the shape of the product) with its source through use and advertising. When the association has been achieved, it

of requiring secondary meaning for any form of trade dress that could possibly be considered product design rather than product packaging.<sup>17</sup> This meant, in effect, that one's product design trade dress had to be near-famous in order for protection to attach. Since no product design has that status upon its first introduction to the marketplace, it takes some time, effort and investment to build it up, during which the design cannot effectively be protected using trade dress laws.

The next year, in *TrafFix*, the Court held that a dual-spring mechanism that permitted street signs to withstand strong winds could not be protected by trade dress because the mechanism had previously been protected by utility patents, and was thus impermissibly functional.

## TrafFix v. Marketing Displays

(2001)



MDI's Windmaster

United States Patent  
Sarkisian

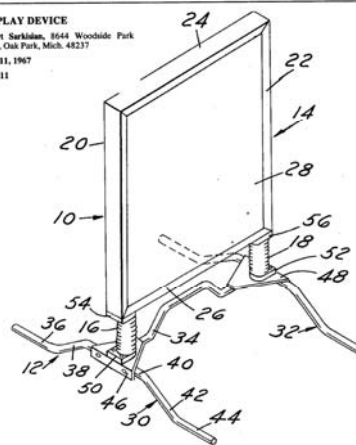
(15) 3,646,696  
(45) Mar. 7, 1972

[54] POSTER DISPLAY DEVICE

[72] Inventor: Robert Sarkisian, 8644 Woodside Park Drive, Oak Park, Mich. 48237

[22] Filed: Sept. 11, 1967

[21] Appl. No.: 670,511



Expired Utility Patent

According to the Court, the previous utility patents established strong evidence that the features of the design were functional. The test for functionality, already a major hurdle for

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means that the product shape has a 'secondary' meaning in addition to its 'primary' meaning (e.g., a bottle has the primary meaning of a vessel for holding liquid, but when people looking at the bottle can say "I know what that is," or "I know where that comes from," without resorting to any labeling, then secondary meaning has been achieved, i.e., the shape of the bottle has become a source identifier in addition to a vessel for holding liquid).

<sup>17</sup> *Wal-Mart Stores, Inc.*, 529 U.S. at 215. Secondary meaning can be proven by consumer testimony or surveys. Additionally, indirect evidence, including advertising expenditures, sales, length and manner of use, and exclusivity of use, can establish secondary meaning.

potential trade dress owners, was raised even higher as a result of this decision. The Court reaffirmed its earlier precedent that a product's design is impermissibly functional "if it is essential to the use or purpose of the article, or affects the cost or quality of the article."<sup>18</sup> In order to appreciate the hurdle presented by such a broad-ranging definition, one might well ask: what self-respecting lawyer cannot make a plausible argument that *any* design feature is essential to the use or purpose of a product, or affects the cost or quality of a product?

The *Wal-Mart* and *TrafFix* decisions were perhaps reactions by the Court to the overuse of trade dress law in the previous 20 years, where §43(a) of the Lanham Act seemingly became the rallying cry for every plaintiff whose design was copied, frequently because the design was not copyrightable, and perhaps after the time for applying for a design patent had expired. Indeed, trade dress laws were likely used as the default legal theory for uncopyrightable and unpatentable designs.

In all fairness, if you use in commerce a product design that has in fact attained the hallowed status of having secondary meaning (e.g., the McDonalds® "Golden Arches," an Absolute® Vodka bottle, a VW® bug) and is nonfunctional, you are the owner of a very valuable IP right. But such status is difficult, if not impossible, to attain for the vast majority of industrial designs.

## **B. Copyright Law Fails to Protect Against Copying of Industrial Designs**

Copyright law is on its surface extremely attractive for protecting designs because it is quick, inexpensive and efficient. Multiple design works can be registered in a single application filed in the US Copyright Office for a \$45 filing fee. Further, remedies are flexible and plentiful.

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<sup>18</sup> *Qualitex Co. v. Jacobson Products Co., Inc.*, 131 L.Ed.2d 248, 115 S.Ct. 1320 (1995); *Inwood Lab. Inc. v. Ives Lab. Inc.*, 456 U.S. 844, 72 L.Ed.2d 606, 102 S.Ct. 2182 (1982).



One who successfully proves copyright infringement can receive lost profits and actual damages, plus the infringer's profits, or statutory damages.

However, copyright law only protects the design of a useful article to the extent that its aesthetic features are separable from its utilitarian aspects.<sup>19</sup> This so-called separability requirement is applied by looking at whether the aesthetic features can be separated either physically or conceptually.<sup>20</sup> To test whether there is physical separability, the Copyright Office determines whether the useful article and its design can be physically separated by ordinary means.<sup>21</sup> If there is no physical separability, the Copyright Office then looks at whether the utilitarian and aesthetic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article.<sup>22</sup> The Copyright Office explains that the test of conceptual separability is not met by merely analogizing the general shape of a useful article to works of modern sculpture.<sup>23</sup>

The poster child that illustrates the harsh result of conceptual separability is *Brandir v. Cascade*.<sup>24</sup> *Brandir* barred copyright protection for an award-winning bicycle rack that had been inspired by a wire sculpture because the aesthetic features of the “Ribbon Rack” were “inextricably intertwined” with the functional features, which the court recognized as the “highest goal of modern industrial design.”<sup>25</sup> In other words, the better a product's design, the less likely it is to have copyright protection.

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<sup>19</sup> Copyright law protects the design of a useful article “only if, and only to the extent, that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U.S.C. 101.

<sup>20</sup> H.R. Rep. No. 94-1476, 94<sup>th</sup> Cong. 2d Sess. (1976) (indicating that the separability requirement can be either physical or conceptual).

<sup>21</sup> Compendium II of Copyright Office Practices, Chapter 5 (1984); the example given is “a pencil sharpener shaped like an antique car.” *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> In such a case, the alleged “artistic features” and the useful article cannot be perceived as having separate, independent existences. *Id.*

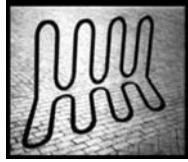
<sup>24</sup> *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

<sup>25</sup> *Id.* at 1147.

## Brandir v. Cascade Pacific

(2nd Cir. 1987)

Brandir's Ribbon Rack



Allegedly Infringing Design



To deny copyright protection for such an outstanding design is somewhat ironic.

The 7<sup>th</sup> Circuit has recently indicated a willingness to interpret separability in a much more liberal manner than that administered by the U.S. Copyright Office. In *Pivot Point v. Charlene*,<sup>26</sup> the manufacturer of mannequin heads having a “hungry look” that were used to practice make-up application and hair-styling, sued a knock-off manufacturer.

## Pivot Point v. Charlene

(7th Cir. 2004)



Copyrighted design



Accused design

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<sup>26</sup> *Pivot Point v. Charlene Products*, 372 F.3d 913 (7<sup>th</sup> Cir. 2004).

Though the lower court had found that the heads were useful articles because the heads were used to teach make-up techniques, and that the facial features were not conceptually separable from the function they performed, the 7th Circuit reversed the decision. The Court of Appeals held that “If the elements do reflect the independent artistic judgment of the designer, separability exists. Conversely, when the design of a useful article is as much the result of utilitarian pressure as aesthetic choices, the use and aesthetic elements are not separable.”<sup>27</sup>

Additionally, and apparently as an alternative rationale for its holding, the Court said that the mannequins’ facial features are protectable because one can conceive of a different face that would provide a “hungry look.”<sup>28</sup> This remarkably suggests an alternative designs test for copyright separability. In other words, the Court implied that designs are protectable if alternative designs can be conceived to reflect the artistic element while having the same utility.

*Pivot Point* established far more liberal tests for separability than the 2<sup>nd</sup> Circuit’s test in *Brandir*. Also, the Copyright Office has continued to apply the separability test quite rigidly, rebuffing any attempt to explore the 7<sup>th</sup> Circuit’s more liberal interpretation. New challenges to the Copyright Office’s narrow separability interpretation might therefore be ripe for an appeal from a refusal to register. If successful, it might lead to increased copyright protection for industrial designs under traditional copyright law. However, even under a liberalized separability standard, many modern industrial designs would still not qualify for registration because of their ‘simplicity’ or minimalist nature.<sup>29</sup>

Another emerging benefit of copyright law, and a possible strategy for traversing the Copyright Office’s overly strict application of the separability test, involves the registration of

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<sup>27</sup> *Id.* at 931.

<sup>28</sup> *Id.*

<sup>29</sup> 37 C.F.R. §202.1.

multiple designs illustrated in a single catalog. In 2005, the 3rd Circuit affirmed the registration of a catalog, protecting the designs of more than 100 products appearing in the catalog.<sup>30</sup>

## Kay Berry v. Taylor Gifts (3rd Cir. 2005)



Copyright Registration  
No. VA 857-542



The alleged infringer challenged the validity of the copyright, and the 3rd Circuit held that the catalog indeed qualified as a single registrable work that protects all of the self-contained works that are included within its single unit of publication.<sup>31</sup> This decision allows multiple designs to be registered with a single \$45 filing fee. Not only that, but the approach has the benefit of avoiding, or at least sidestepping, the Copyright Office's severe application of the separability test to individual designs in the catalog, in that the Office will register the catalog if at least one design shown in the catalog is found to meet its separability requirement. In other words, the rest of the designs may 'go along for the ride' with the catalog registration, leaving the copyright owner to defer a decision on separability of other designs in the catalog until it is

<sup>30</sup> *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 76 U.S.P.Q.2d 1119 (3rd Cir. 2005).

<sup>31</sup> 37 C.F.R. §202.3.

necessary to enforce a particular design in court against an infringer. In such a case, the copyright owner, by judicious selection of venue (such as a court in the 7<sup>th</sup> Circuit, where *Pivot Point* was decided) can perhaps obtain a more liberal application of the separability test for a borderline design than he/she would have obtained had the design been the subject of a single application to register it in the Copyright Office.

In spite of these recent decisions, and the work-around strategies suggested above, copyright law by and large remains unfriendly to most industrial designs that are deemed to be useful articles.

Finally, as if to add insult to injury, there has been a bill introduced into Congress known as the Orphan Works Act<sup>32</sup> which is supposed to fix the problem of third parties wanting to get permission to use a copyrighted work without being able to determine the identity of the copyright owner. Basically, this bill will allow an innocent infringer of a copyrighted work to avoid serious penalties provided the infringer makes a good-faith and diligent effort to try and find the copyright owner. While this sounds reasonable on its face, the difficulty comes in that, while there exists readily available searchable databases for photographs, music and books, there is no such database, and no prospect of having such a database, for works of the visual arts,<sup>33</sup> e.g., textiles, jewelry, ceramic tile, wrapping paper, carpet, placemats, book covers, and the like. This means that unscrupulous knock-off artists<sup>34</sup> could copy a design, alleging they could not find the copyright owner (of course, they cannot because there is no searchable database),<sup>35</sup> and market millions of copies. The Orphan Works Act specifies that the damages to the copyright owner in

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<sup>32</sup> The Orphan Works Act of 2006, H.R. 5439, 109th Congress (2006).

<sup>33</sup> With the notable exception of photographs.

<sup>34</sup> No one is really worried about a truly innocent third party user.

<sup>35</sup> In order to make the Orphan Works Act minimally palatable to design owners, implementation should be delayed with respect to visual works until the U.S. Copyright Office establishes a searchable database of such works.



such a case would be “reasonable compensation.”<sup>36</sup> Such compensation would likely take the form of a royalty on sales, which of course would be regarded by the knock-off artists as just another cost of doing business; under these circumstances, they will knock you off time and time again. Under standard copyright law (in the absence of the ‘remedy’ provided in the Orphan Works bill), the copyright owner would be entitled to the infringer’s net profits from the infringement, which actually serves as a deterrent to would-be knock-off artists. Copyright owners of visual works generally don’t wish to license infringers, they want to get them off the market. So, for those few designs (“useful articles”) that are even copyrightable under the separability standard, copyright law under the Orphan Works Act is threatened to be even less available and effective than it is today.

### **III. Recent Upheavals In Design Patent Law Have Made It Almost Impotent**

As noted above, though a few years ago design patents were fairly effective in protecting designs, recent developments in the case law have cast a dark cloud over design patents. While design patents still remain the only game in town for protecting most industrial designs, practitioners and companies need to be aware of the new reality, the hoops one must now jump through in order to effectively obtain and enforce this heretofore fairly reliable form of intellectual property.

This section of the paper will outline the major reasons, stemming from both recent court decisions and systemic problems in the PTO, why design patents have become problematic. While each of the legal issues discussed below could be the subject of its own article, this paper will attempt to provide a concise overview, in the context of understanding more fully the crisis in the law of designs.

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<sup>36</sup> *supra*, note 32.

### A. The “Ordinary Observer” Test of *Gorham* is Anything But Ordinary

As noted above, the cornerstone of design patent infringement is the venerable ordinary observer test from *Gorham v. White*,<sup>37</sup> which asked whether an ordinary observer would consider two products, in that case silverware handles, to be substantially the same. The Supreme Court in *Gorham* flatly rejected the notion that substantial similarity should be viewed through the eyes of an expert, even through the eyes of a person versed in the trade, since “that would destroy all the protection which the act of Congress intended to give” designs.<sup>38</sup> In a recent case, however, a district court in California turned *Gorham* on its head by considering the ordinary observer to be an industry expert rather than a person of ordinary intelligence.

In *Arminak & Associates v. Saint-Gobain Calmar*,<sup>39</sup> the design patent covered sprayer shrouds, the stylish plastic pieces that cover trigger sprayers that, in turn, are placed on top of spray cleansers such as Mr. Clean.

## Arminak v. Saint-Gobain Calmar



<sup>37</sup>*Gorham Co. v. White*, 81 U.S. (14 Wall) 511 (1871).

<sup>38</sup>*Id.* at 527.

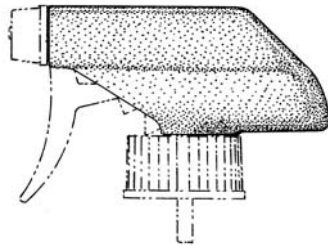
<sup>39</sup>*Arminak & Associates v. Saint-Gobain Calmar*, 424 F. Supp. 2d 1188 (C.D. Cal. 2006).

United States Patent (19) Patent Number: Des. 381,581  
Wadsworth (42) Date of Patent: \*\*Jul. 29, 1997

[54] SPRAYER SHROUD

[75] Inventor: Ronald Wadsworth, Canby, Calif.

[73] Assignee: Calmar Inc., City of Industry, Calif.



**Patented  
Design**



**Accused  
Design**

The district court ruled that the ordinary observer for sprayer shrouds was the buyer for the ‘middleman’ company (e.g., Procter & Gamble) who purchased the sprayer shrouds/trigger sprayers from their manufacturer (e.g., Calmar), to then be installed on the bottles as part of the final product, which was in turn sold to retailers, to be in turn sold to consumers. The court did not consider the consumer as the ordinary observer because when that person buys a bottle of cleanser, the sprayer shroud/trigger sprayer is already incorporated into the product. The court rejected the idea that the end purchaser should be the ordinary observer because they are purchasing an entire bottle of cleaning solution – not just the trigger sprayer.<sup>40</sup>

In *Arminak*, the court noted that not all of the purchases of trigger sprayers were industry experts; some were “relatively unsophisticated operations” concerned mostly with price.<sup>41</sup> However, after noting that female purchasers of cleaning products were indifferent to trigger

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<sup>40</sup> *Arminak* at 1199.

<sup>41</sup> *Id.*

designs, it seemed to equate the ordinary observer with the extraordinary observer who consciously cared about the design.<sup>42</sup>

The logical result of considering the ordinary observer to be the purchaser for a manufacturing middleman is that there would rarely be infringement because sophisticated industry shoppers would almost never be confused about what they are buying, would never think two designs are substantially the same, especially given the minute and lengthy examination given to these products by such industry buyers prior to purchasing them in huge quantities.

The two major Federal Circuit precedents upon which court in *Arminak* based its ruling were *Goodyear v. Hercules*<sup>43</sup> and *Keystone v. Westrock*.<sup>44</sup> In *Goodyear*, involving a design patent claiming a tire tread, the Court found that the ordinary observer was an ordinary trucker or fleet operator who purchases and uses truck tires, because the accused infringer sold only truck tires even though the design patent claimed a tire tread generally. The issue in *Goodyear* was not whether ordinary observers were middlemen or retail consumers, as in *Arminak*, but whether the infringement test was to be viewed from the standpoint of the patent claim (“tire tread”) or what was actually being sold in the marketplace (truck tires).<sup>45</sup> The court found that it was to be viewed from the standpoint of what was actually being sold in the marketplace. In *Arminak*, there is no similar issue; there is no question that the claimed design and the product in the marketplace are one and the same. The design patent covers sprayer shrouds, and the ordinary observers should be, according to *Goodyear*, those who buy and use sprayer shrouds, which

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<sup>42</sup> *Id.* at 1200.

<sup>43</sup> *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.* 162 F.3d 1113, 1116-17 (Fed. Cir. 1998).

<sup>44</sup> *Keystone Retaining Wall Systems, Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1449-50 (Fed. Cir. 1993).

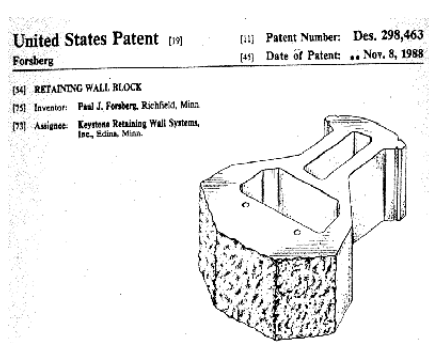
<sup>45</sup> Of course, the patentee preferred the ordinary observer to be a person who uses tires generally, since such a person would be less discerning, presumably, of tire tread designs than a trucker or fleet operator, and thus more apt to think two designs were substantially the same.

obviously includes middlemen *and* ultimate retail consumers who purchase bottles to which sprayer shrouds are applied as part of the trigger sprayers.

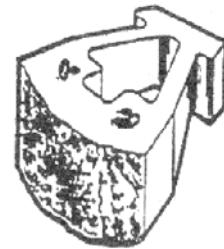
The *Arminak* court relied on *Keystone* to support its notion that only the middleman, the purchaser of the patented design, can be the ordinary observer because you must exclude consumer purchasers of a larger product into which the patented design had been incorporated. In *Keystone*, the design patent claimed a building block, having a decorative front face, intended for use in a retaining wall.

## Keystone v. Westrock

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**PATENTED DESIGN**



**ACCUSED DESIGN**

The only similarity between the patented block and the accused block was their decorative front faces; the rest of the blocks were dissimilar. The patentee argued that visitors to trade shows, viewing assembled retaining walls containing plaintiff's and defendant's blocks, were confused, and thought that they were substantially the same. The Federal Circuit quite properly noted:



Although the blocks when aligned in a retaining wall may create a similar wall appearance, the patented design is of an individual block, not an assembled wall, and the ordinary observer for the purpose of the block design patent is a purchaser of the patented block, not of the unpatented wall.<sup>46</sup>

Although *Keystone* did indeed involve a patented design (a building block) incorporated into a larger product (a wall of blocks), that was not the main issue. The main issue involved a patented design only a portion of which was visible in end use; a significant part of the patented block was *covered up* when used to construct a wall. Thus, those viewing the end product, the wall, did not even see the whole patented design. The Federal Circuit found that confusion in end use was not relevant in this case because you could not see large portions of the patented design. In contrast, in the *Arminak* case, there is no part of the patented sprayer shroud that is not visible in end use, or during any phase of its life. Thus, *Keystone* is inapposite to the facts in *Arminak*.

Finally, another widely-cited case also relied upon by the *Arminak* court was *Applied Arts v. Grand Rapids*<sup>47</sup> for the proposition that the ordinary observer is “not a person who has never seen the type of item the patent describes, but one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor ....”<sup>48</sup> However, upon careful reading, *Applied Arts* (in addition to not being binding precedent) misinterpreted the *Gorham* case which had specifically held that similarity is viewed through the eyes “of men generally, of observers of ordinary acuteness, [who] bring to the examination of the article upon which the design has been placed that degree of

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<sup>46</sup> *Keystone*, 997 F.2d at 1451.

<sup>47</sup> *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.* 67 F.2d 428 (6<sup>th</sup> Cir. 1933).

<sup>48</sup> *Id.* at 430.

observation which men of ordinary intelligence give.”<sup>49</sup> *Applied Arts* upped the *Gorham* ante substantially by requiring that an ordinary observer have reasonable familiarity with such objects, which is tantamount to requiring the ordinary observer to be a person engaged in the trade. The Supreme Court in *Gorham* carefully considered, and then rejected, the lower court’s standard, which is almost identical to the standard used in *Applied Arts* and cited with approval in *Arminak*. This is what the Supreme Court had to say about the *Gorham* lower court’s decision:

The learned judge [below] thought there could be no infringement unless there was “substantial identity” “in view of the observation of a person versed in designs in the particular trade in question---of a person engaged in the manufacture or sale of articles containing such designs---of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side.” There must, he thought, be a comparison of the features which make up the two designs. With this we cannot concur. Such a test would destroy all the protection which the act of Congress intended to give.”<sup>50</sup>

The net effect of the *Arminak* decision, if upheld on appeal,<sup>51</sup> would be to render a holding of design patent infringement virtually unattainable, returning us to pre-1871 law, indeed destroying all the protection for designs that Congress intended to give.

## **B. Confusion is Now the Point of the Point of Novelty Test**

The *Litton* point of novelty test, the second part of the test for design patent infringement,<sup>52</sup> requires the allegedly infringing device to have appropriated the novel elements of the patented design that distinguishes the patented design from the prior art.<sup>53</sup> To determine

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<sup>49</sup> *Gorham* at 528.

<sup>50</sup> *Gorham* at 527.

<sup>51</sup> The district court order is, as of this writing, on appeal to the Federal Circuit (Appeal No. 2006-1561).

<sup>52</sup> The first part is the ordinary observer test discussed *supra*, Section II.A.

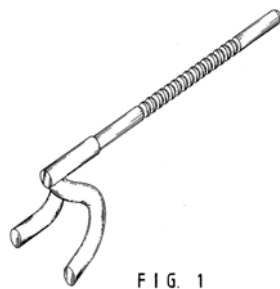
<sup>53</sup> *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1448 (Fed. Cir. 1984) (explaining that the allegedly copied design did not infringe the elements protected by the design patent).

the point of novelty, a court looks at which of the elements of the patented design exist in the prior art. Whatever elements are visually found in the prior art are, by definition, not novel, and all remaining elements collectively comprise the “point of novelty,” i.e., the reason the design patent was granted in the first place. Those new elements must be present in the accused design in order for the *Litton* infringement test to be met.

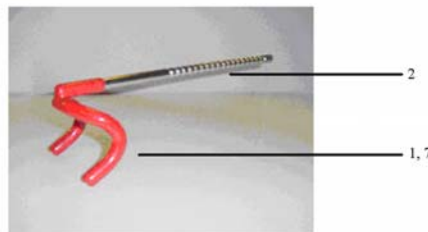
However, a recent case, *Lawman Armor v. Winner*, has greatly confused the point of novelty test. This case involved a design patent covering a steering wheel locking device, popularly used to prevent auto theft.

## **Lawman Armor Corp. v. Winner Int'l** (E.D. Pa. 2005)

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**PATENTED DESIGN**



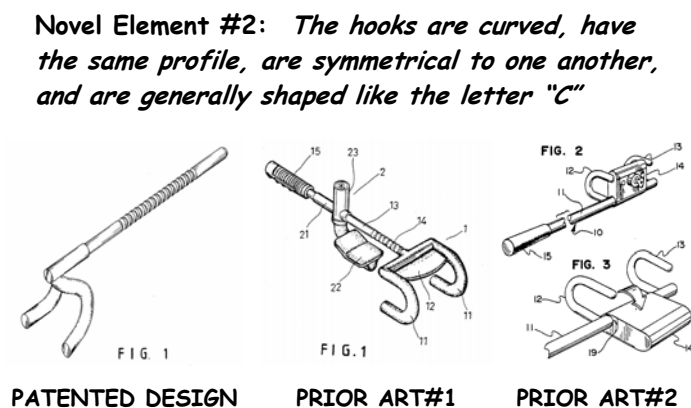
**ACCUSED DESIGN**

To meet its burden in the lower court, the patentee proffered 8 “points of novelty” that it said were not in the prior art but which were present in the accused design. The defendant, instead of taking the usual tack of denying that the accused product contains one or more of the novel elements, introduced prior art which it said rendered the 8 alleged “points of novelty” not,

in fact, novel. The district court agreed, and granted summary judgment of non-infringement to the defendant.<sup>54</sup>

On appeal to the Federal Circuit,<sup>55</sup> the plaintiff, in addition to contesting the argument that the 8 points of novelty were present in the prior art, suggested that the Court should additionally look at the combination of these 8 elements which the plaintiff argued was itself novel. The Court rejected this argument, saying since all 8 of these elements were not themselves novel, the plaintiff could not rely on a combination of non-novel elements to constitute a “9<sup>th</sup> point of novelty.” The Federal Circuit feared that such a holding would undermine the *Litton* test.<sup>56</sup>

The first error made by the Federal Circuit was in affirming the district court’s finding that the 8 proffered novel elements were present in the prior art relied upon by the defendant. As it turns out, while the functional attributes of the 8 elements are arguably in the prior art cited by the defendant, the prior art did not *look like* the 8 elements, and thus by definition, did not negate their design novelty. Following is an illustration of one of the “points of novelty” proffered by the plaintiff next to the prior art that the lower court and Federal Circuit said negated that point of novelty:



<sup>54</sup> *Lawman Armor Corp. v. Winner*, 2005 U.S. Dist. LEXIS 2078 (E.D. Pa., Feb. 15, 2005).

<sup>55</sup> *Lawman Armor Corp. v. Winner*, 437 F.3d 1383 (Fed. Cir. 2006).

<sup>56</sup> *Id.* at 1385.

Focusing on the shape of the hooks, the cited prior art simply doesn't *look like* Novel Element #2 of the patented design. Thus, novelty is not negated. Both the lower court and the Federal Circuit went astray on this.

In addition, the Court's decision overlooked the fact that nearly all designs are combination of elements from previous designs.<sup>57</sup> If a plaintiff relied on a combination of design elements to define the point of novelty, then the scope of her design patent would be somewhat narrow. This would not undermine *Litton* since the accused design would still need to contain this narrow point of novelty in order to infringe. In addition, it presumably would not take much effort to 'design around' such a narrow claim, so no one is damaged by allowing a narrow design claim, consisting of a 'combination' of known elements, over admittedly close prior art.

Another major problem with the Federal Circuit's reasoning is that it would encourage back door attacks on design patent validity. By allowing an accused infringer to attack the patent's point of novelty (an infringement issue) by introducing prior art to negate it, the infringer would in effect be mounting an invalidity argument (i.e., there's nothing novel about the claimed design) with the benefit of a much lower burden of proof. The preponderance of evidence standard required to decide infringement issues is a far lower burden of proof compared to the more difficult clear and convincing evidentiary standard required to prove patent invalidity.

This Federal Circuit decision that a combination of design elements cannot serve as a point of a novelty also directly contradicts previous Federal Circuit holdings and a variety of district court decisions. For example, in 1988, the Federal Circuit held that the point of novelty for a shoe upper was "the combination of saddle, eyestay and perforations," and explicitly

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<sup>57</sup> *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) ("Virtually all inventions are combinations and virtually all are combinations of old elements.").



rejected the argument that the existence of individual features in the prior art prevented their combination from being a point of novelty.<sup>58</sup> Again in 1993, the Federal Circuit affirmed that infringement could be found when the point of novelty existed in an “overall appearance of the combination” of the design patent’s major design elements even though individual elements of the design were found in prior art.<sup>59</sup>

The patentee, Lawman, petitioned the Federal Circuit for rehearing and rehearing *en banc*. While denying the petition, the Court did issue a “clarification” which, unfortunately, did little to clarify.<sup>60</sup>

In its “clarification,” the Federal Circuit affirmed its earlier decision (that a combination of non-novel elements may not itself be the point of novelty), but said in addition that “in appropriate circumstances a combination of design elements itself may constitute the point of novelty.” The Court provided no guidance of what would be considered “appropriate circumstances” beyond noting that “although a combination of design elements can be a point of novelty this is a different concept than the overall appearance of a design which ... our cases have recognized cannot be a point of novelty.”<sup>61</sup>

Judge Newman dissented from the denial of the petition for rehearing *en banc*, saying there was nothing wrong with finding that the point of novelty constitutes the overall appearance of a product.<sup>62</sup> Judge Newman, in her opinion (which can only be characterized as providing more clarity than the majority’s “clarification”) said that failure to grant rehearing on this issue could place design patent holders in a “state of limbo.” Of course, Judge Newman was

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<sup>58</sup> *Avia Group Int’l, Inc. v. L.A. Gear California, Inc.* 853 F.2d 1557, 1565 (Fed. Cir. 1988).

<sup>59</sup> *L.A. Gear v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993).

<sup>60</sup> *Lawman Armor Corp. v. Winner Int’l*, 449 F.3d 1190 (Fed. Cir. 2006).

<sup>61</sup> *Id.* at 1192.

<sup>62</sup> *Lawman Armor Corp. v. Winner Int’l*, 449 F.3d 1192, 1194 (Fed. Cir. 2006) (J. Newman dissenting).

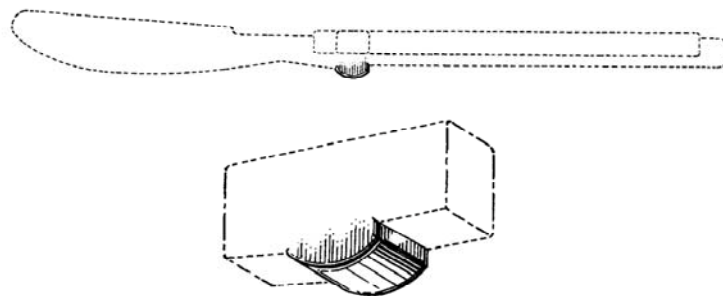
absolutely correct, in that many designs are so simple, or so broadly claimed,<sup>63</sup> that the point of novelty can hardly be anything other than the overall appearance of the claimed design.

**United States Patent** [19] **Patent Number: Des. 351,310**  
**Burdick et al.** [45] **Date of Patent: \*\* Oct. 11, 1994**

[54] **FLATWARE SUPPORT KNOB**  
 [75] **Inventors:** Bruce Burdick; Susan K. Burdick, both of San Francisco, Calif.  
 [73] **Assignee:** The Burdick Group, San Francisco, Calif.  
 [73] **Term:** 14 Years  
 [21] **Appl. No.:** 3,011  
 [22] **Filed:** Dec. 24, 1992

D. 247,086 1/1978 Gonshorek ..... D7/645  
 D. 249,626 9/1978 Seibel ..... D7/653  
 D. 262,089 12/1981 Fahy ..... D7/401.2  
 D. 275,169 8/1984 Watanabe ..... D7/645  
 D. 307,095 4/1990 Juergens ..... D7/653  
 356,452 1/1887 Cox ..... 30/298.4  
 356,453 1/1887 Cox ..... 30/295  
 1,250,890 12/1917 Johnson ..... 30/327  
 2,429,405 10/1947 Dringman ..... 30/327  
 2,789,349 4/1957 Lee ..... 30/142

*Primary Examiner—Alan P. Douglas*  
*Assistant Examiner—Caron D. Veynar*  
*Attorney, Agent, or Firm—SAIDMAN DesignLaw Group*



(12) **United States Design Patent** (10) **Patent No.: US D446,702 S**  
**Kilduff** (45) **Date of Patent: \*\* Aug. 21, 2001**

(54) **PORTION OF CORK EXTRACTOR**  
 (75) **Inventor:** Edward Kilduff, New York, NY (US)  
 (73) **Assignee:** Metrokane, Inc., New York, NY (US)  
 (73) **Term:** 14 Years  
 (21) **Appl. No.:** 29/142,842  
 (22) **Filed:** Jun. 6, 2001

D. 377,444 1/1997 Lin .  
 390,183 9/1888 Morgan .  
 D. 396,622 8/1998 Hong .  
 D. 407,284 3/1999 Crist et al. .  
 D. 408,697 4/1999 De Bergen .  
 D. 411,732 \* 6/1999 Chamberlain ..... D8/350  
 D. 415,667 10/1999 De Bergen .  
 D. 420,558 2/2000 Lee .  
 D. 421,060 \* 2/2000 Kelders et al. .... D19/69  
 D. 430,994 9/2000 Kilduff .  
 D. 432,892 \* 10/2000 Nakatani et al. .... D8/307  
 D. 441,265 5/2001 Kilduff .



<sup>63</sup> See, e.g., U.S. Pat. Nos. Des. 351,310 and Des. 446,702.

Upon closer examination, the cases relied upon in the “clarification” to support the proposition that the point of novelty may not reside in the overall design<sup>64</sup> were cases in which the plaintiff had utterly failed to identify the point of novelty at all, simply saying it was the whole design. The designs in question were not simple, and clearly included old elements that should have been excluded in the definition of the point of novelty.

What the Federal Circuit has left us with is the specter of design patentees scrambling not to run afoul of this twisted logic by defining their point of novelty in such a manner that it cannot be construed to cover the overall design, even if it properly is the overall design. What’s the point?

### **C. No More Flexibility In Chasing Knock-offs**

The major weapon that design patent owners have had in their arsenal against knock-off artists was the same weapon that utility patent owners have had for years: the ability to keep a patent application ‘in the oven’ (i.e., pending in the PTO) while monitoring the marketplace for potential infringers and, upon discovery of an infringer, amending one’s patent claim to read on the infringing product as closely as possible. This is standard and well-accepted patent gamesmanship.

Often, the patent application ‘in the oven’ is a continuation application - perhaps the parent application was allowed to issue and the continuation, or child, was filed before issuance of the parent. If so, the amended claim in the child, in order to be entitled to the benefit of the parent’s filing date, must be supported by the parent application in a manner that satisfies 35 U.S.C. §112, para. 1. That is to say, whatever is claimed in the child must be fully disclosed in

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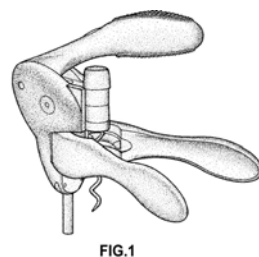
<sup>64</sup> *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193 (Fed. Cir. 1995); *Winner Int’l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375 (Fed. Cir. 1990).

the parent, or priority to the parent's filing date is not available under 35 U.S.C. §120. Priority to the parent's filing date is often critical, because without it, the child application would be barred if the claimed invention was in public use or on sale over one year before the child's filing date.<sup>65</sup>

This strategy of filing a continuation application to obtain broader claim coverage and/or in order to more precisely read upon a potential infringer's design, is critical to maintaining the flexibility of design patents as well as utility patents, since without it, a patentee is left to guess, at the outset of filing his patent application, as to what the infringer's product will be. In the case of design patents, it would require a design applicant to predict what the clever knock-off will look like, an impossible task. As one might expect, such a guess is more often wrong than right, because knock-off artists are not stupid – literal design infringement is the rare exception rather than the rule. Therefore, the flexibility needed by design patent applicants is the same flexibility that has been used for years by utility patent applicants.

One example should suffice to illustrate the point. The Rabbit was a highly successful lever-operated corkscrew for which U.S. Pat. No. D446,098 issued in 2001. Before the '098 patent issued, a knock-off called "Le Rapide" appeared in the marketplace.

**'098 PATENT**



**LE RAPIDE**

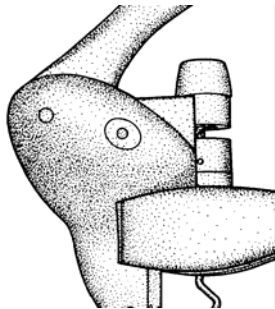


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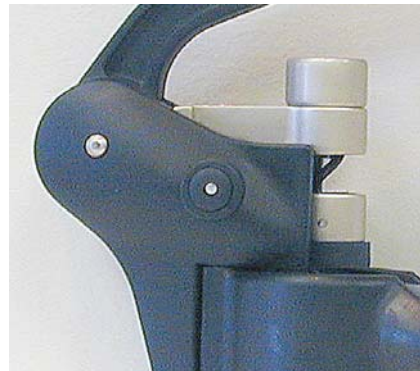
<sup>65</sup> 35 U.S.C 102(b).

The knock-off was far from identical to the original Rabbit, but it clearly appropriated some major design features.

**FIRST RABBIT  
DESIGN PATENT  
D446,098  
FILED 1/9/01  
ISSUED 8/7/01**



**LE RAPIDE  
CORKSCREW**

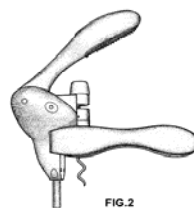


The original Rabbit design patent claimed the entire product:

**RABBIT  
CORKSCREW**



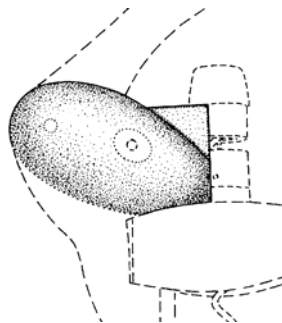
**FIRST RABBIT  
DESIGN PATENT  
(D446,098)  
FILED 1/9/01  
ISSUED 8/7/01**



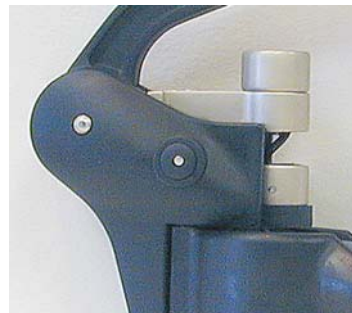
U.S. Patent  
No. 6,100,000  
May 1, 2001  
FIG. 2

While it was still pending, and after discovering Le Rapide, the applicant filed a continuation application claiming only that portion of the Rabbit that had been appropriated by the Le Rapide knock-off, namely, a portion of the ‘head’ of the corkscrew. The resulting design patent (D442,045) issued in 3 months on the PTO’s ‘rocket docket’, and it read quite literally on Le Rapide’s head:

**SECOND RABBIT  
DESIGN PATENT  
D442,045  
FILED 2/8/01  
ISSUED 5/15/01**



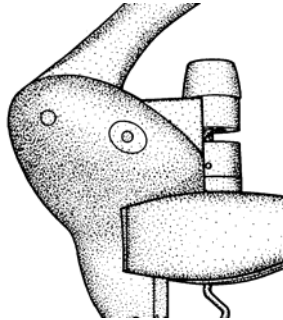
**LE RAPIDE  
CORKSCREW**



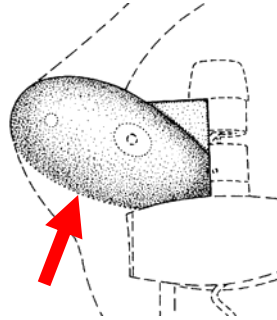
Of course, the ‘045 or ‘child’ claimed priority to the original ‘098 or ‘parent’ under 35 U.S.C. §120; this was critical since the Rabbit had been offered for sale over a year before the child application was filed. Thus, if the child was not entitled to the filing date of the parent, the child would have been invalid under 35 U.S.C. §102(b).

The PTO Examiner did not question the child’s claim to priority of the filing date of the parent, because presumably everything that was claimed in the child was disclosed in the parent. The only thing “new” in the child was the addition of a single boundary line (see arrow below), which had been drawn to mimic the location of the lower boundary of the Le Rapide knock-off.

## PARENT APPLICATION



## CHILD APPLICATION



Since the broken boundary line was not part of the claimed design, there was no “new matter” in the child. The ‘045 child was effective in bringing the Le Rapide infringement to an end.

This so-called Rabbit strategy has been used by this author in subsequent situations that warranted this type of flexibility. However, in a recent application employing the same Rabbit strategy, the PTO has refused to accord the child application the benefit of the filing date of the parent under §120, saying that the design claimed in the child was not disclosed in the parent and was not in possession of the designer at the time the parent application was filed. The PTO is also arguing that the addition of a single broken line in the child’s drawings introduced impermissible new matter into the child application.

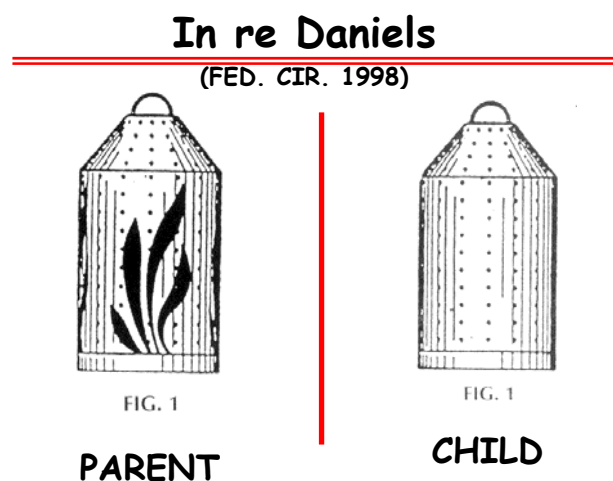
All of these PTO theories are based on the presence in the child of a broken boundary line, very similar to the broken boundary line indicated by the arrow in the Rabbit example shown above, that was not present in the parent. Once again, the boundary line is broken (i.e., not solid), and thus is not part of the claimed design. There is no question but that the portions of



the claimed design within the boundaries are fully disclosed in the parent application. Thus, the issue seems to boil down to whether the presence of a not-before-presented broken boundary line constitutes “new matter.” The applicant posits that it does not, since it is tantamount to merely excluding a portion of the originally claimed design that the applicant no longer wishes to claim.

The applicant also argues that it cannot be the law that design applicants are not allowed to file continuation applications having claims broader than the claims in earlier applications. Since a design patent claim is defined with reference to the drawings, it would be manifestly unfair not to allow the patentee/applicant to draw his boundaries around whatever portion(s) of his originally claimed design that he wishes, as long as the portions he is now claiming are disclosed in the parent application(s).

The applicant believes that this issue was substantially resolved by the 1998 Federal Circuit decision *In re Daniels*<sup>66</sup> where the court held that in a design case, the question of whether the applicant was entitled to claim priority to a parent depends on what is illustrated in the drawings in the parent compared to what is being claimed in the child. The *Daniels* case involved a container design.



<sup>66</sup> *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998).

At issue in *Daniels* was whether the child, claiming a container with no surface decoration, was entitled to the benefit of the filing date of the parent that had claimed a container with surface decoration. The court found that the container being claimed in the child was fully disclosed in the parent, and the child was thus entitled to the benefit of the filing date of the parent under §120.

Although the child did not include any additional boundary lines (as in the Rabbit strategy), it did fully remove the surface decoration present in the parent, and there was no disclosure in the parent of what lie underneath the surface decoration that had been removed. The Court overlooked this technicality in *Daniels*, which was a more serious defect than the addition of a new, unclaimed boundary line (that covered up nothing) as was used in the Rabbit strategy.<sup>67</sup>

This issue involving the validity of the Rabbit strategy is, as of this writing, headed to the PTO Board of Patent Appeals & Interferences, and then, if necessary, to the Federal Circuit.

If this flexible approach to design protection (i.e., the Rabbit strategy) is struck down, it would seriously undermine one of the most powerful weapons in a design patentee's arsenal, to the point where one might well question whether design patents are worth getting at all.

In other words, if this new PTO policy is not successfully challenged, it would be a devastating blow to the ability of design patent owners to stop knock-offs, depriving them of the same flexibility enjoyed by their utility patent brethren for years without question. And this flexibility is crucial, since no design owner has been able to predict with any degree of certainty what the later knock-offs will look like, which design features will be copied and which will not.

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<sup>67</sup> It was more serious because the child in *Daniels* actually claimed new matter not disclosed in the parent, i.e., those portions of the container underlying the surface decoration.

So the continuation ‘keep one in the oven’ strategy is the best way, in lieu of 20-20 foresight, to combat knock-offs.

#### **D. *Markman* Has Sounded the Death Knell for *Gorham***

A utility patent claim must be “construed” before applying the test for infringement, in order that the trier of fact knows what the claim language means. In *Markman v. Westview Instruments*,<sup>68</sup> the Supreme Court held, in a utility patent case, that claim construction was a question of law to be determined by the Court. The Federal Circuit, in considering the first design patent infringement case after *Markman*, rather automatically concluded that the *Markman* requirement to construe a claim as a matter of law applied equally to design patents.<sup>69</sup>

This holding has been an unmitigated disaster for design patent owners.<sup>70</sup> In order to comply with *Markman*, courts have routinely ‘verbalized,’ or put into words, the design features shown in the drawings of a design patent. After such painstaking verbalization, the court typically instructs the trier of fact, normally a jury, that this is what the claim of this design patent “means.” And then the jury is left to figure out whether the verbalized design patent claim, as construed by the court, is infringed by the accused design, using the standard *Gorham* and *Litton* tests for design patent infringement.

The *Gorham* test, applied first, requires the accused design to be “substantially the same” as the patented design in the eyes of an ordinary observer.<sup>71</sup> It has been noted that the “substantially the same” language incorporates an equivalents analysis,<sup>72</sup> i.e., the accused design

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<sup>68</sup> *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

<sup>69</sup> *Elmer v. ICC Fabricating*, 67 F.3d 1571, 365 U.S.P.Q.2d 1417 (Fed. Cir. 1995).

<sup>70</sup> Perry J. Saidman & Allison Singh, *The Death of Gorham Co. v. White: Killing It Softly With Markman*, 86 J. PAT. & TRADEMARK OFF. SOC’Y 792 (2004).

<sup>71</sup> *Gorham Co. v. White*, 81 U.S. (14 Wall) 511 (1871).

<sup>72</sup> *Lee v. Dayton-Hudson*, 838 F.2d 1186, 5 U.S.P.Q.2d 1625 (Fed. Cir. 1988).

does not have to be identical to the patented design in order for infringement to be made out.

The problem is that the *Markman* claim construction requirement, with its consequent detailed verbalization of everything shown in the drawings of a design patent, results in a literal design patent claim. Faced with such a verbalization, it is difficult, if not impossible, for the trier of fact to inject any notion of equivalents into the scope of the claimed design. That is, if the verbalized design is not present almost word for word in the accused device, non-infringement is made out. As a result, many a design patent litigation has been resolved by a motion for summary judgment of non-infringement brought after or concurrently with the *Markman* claim construction. In other words, the design patent never makes it to the jury for them to decide if the allegedly infringing product is ‘substantially the same’ under *Gorham* because the court has boxed the design patent in a literal infringement corner by its detailed verbalization of the claimed design.

There are two cases that suffice to illustrate this devastating trend. The first, decided before *Markman*, involved a hand-held, electric blender. In *Braun v. Dynamics*,<sup>73</sup> the accused design did not have the prominent handgrip indentation of the claimed design (see arrow below), though they were otherwise very similar.

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<sup>73</sup> *Braun v. Dynamics Corp. of America*, 975 F.2d 815, 24 U.S.P.Q.2d 1121 (Fed. Cir. 1992).

# Braun v. Dynamics Corp. of America

(FED. CIR. 1992)

United States Patent [19]  
Zinnawicz [11] Des. 271,176  
[45] Nov. 1, 1983

[54] HAND HELD ELECTRIC MIXER

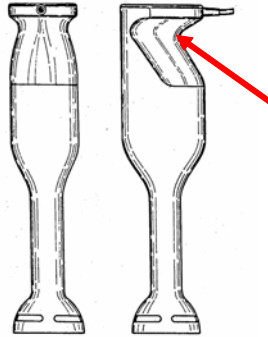
[73] Inventor: Jose Z. Zinnawicz, Barcelona, Spain

[75] Assignee: Bussan Española, S.A., Spain

[52] Term: 14 Years

[51] Appl. No.: 189,621

[22] Filed: Oct. 22, 1980



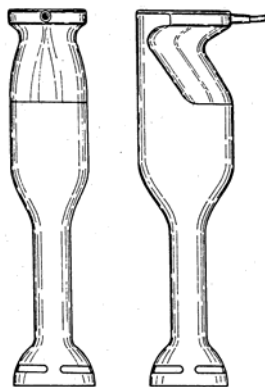
Braun's U.S. Pat. No.  
Des. 271,176



Accused Design

The devices more closely resembled each other than either did to the prior art, which had been a rule-of-thumb for finding infringement under the *Gorham* test.

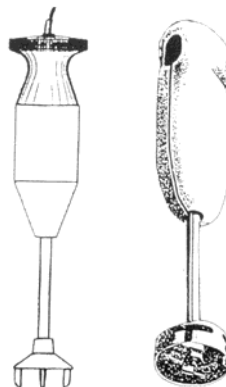
# Braun v. Dynamics Corp. of America



Braun's U.S. Pat. No.  
Des. 271,176



Accused Design



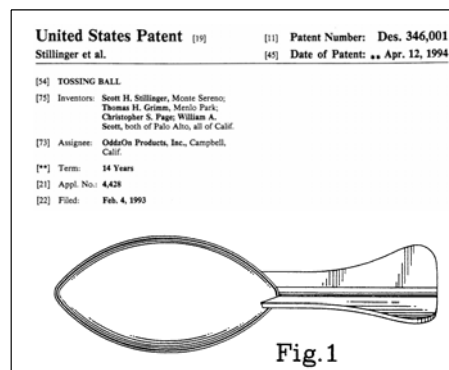
Closest Prior Art

Despite the absence of the handgrip indentation in the accused design, the Federal Circuit upheld a jury finding of infringement, never reaching the *Litton* test.

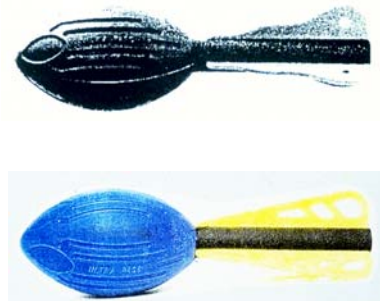
However, five years later, the Federal Circuit decision in *Oddz-On Products v. Just Toys*<sup>74</sup> became the epitome of law-gone-wrong due to *Markman*. This case involved very similar designs for a tossing football.

## OddzOn Products v. Just Toys

(FED. CIR. 1997)



PATENTED DESIGN

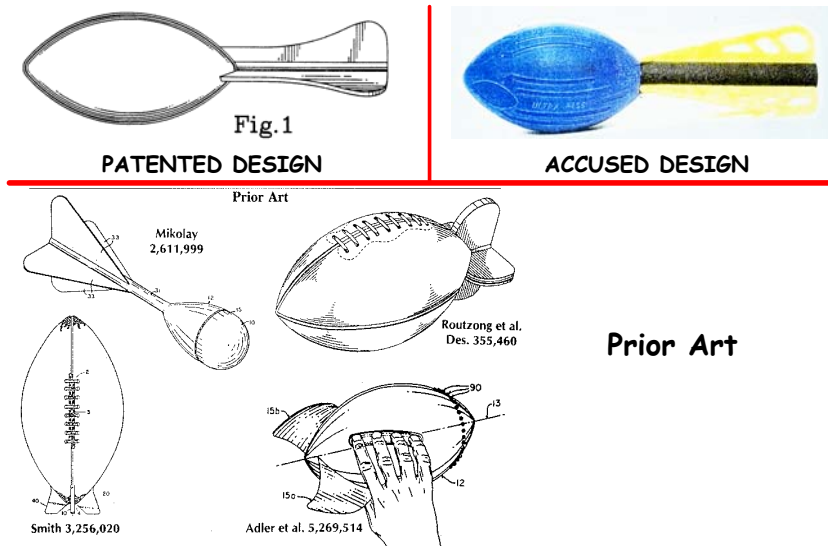


ACCUSED DESIGNS

As seen below, the accused toys were more similar to the patented device than either were to any prior art, a likely indicator of substantial sameness under *Gorham*.

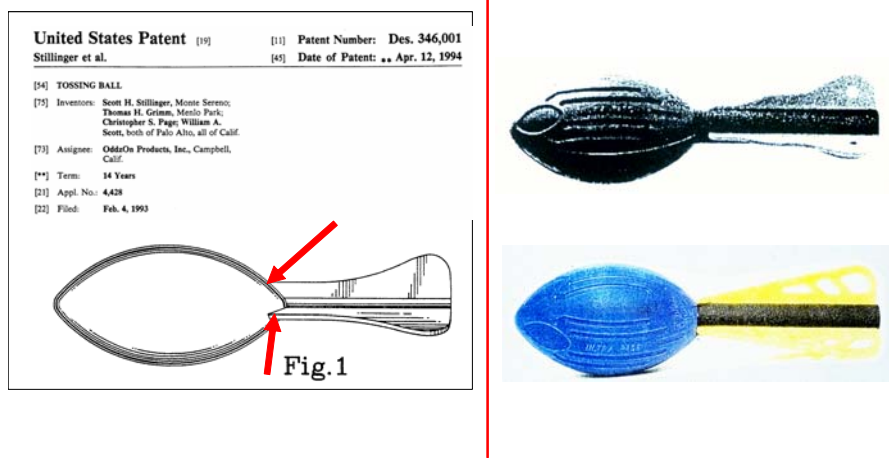
<sup>74</sup> *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 43 U.S.P.Q.2d 1641 (Fed. Cir. 1997).

# OddzOn Products v. Just Toys



However, the Federal Circuit upheld the district court's *Markman* claim construction that recited, *inter alia*, how the shafts of the claimed tail fins protruded from the rear of the football (see arrows below), a relatively inconsequential design feature.

# OddzOn Products v. Just Toys



The district court, after its detailed verbalization, determined that the tail fin protrusion feature was absent from the accused designs, and found non-infringement.<sup>75</sup> The Federal Circuit affirmed the district court's *Markman* determination, as well as its finding of non-infringement.

There is little question but had the *Braun* case been decided after *Markman*, the prominent handgrip indentation would have been part of the *Markman* claim construction, and as such the design patent would have been subject to a successful motion for summary judgment of non-infringement, since the accused design was clearly lacking such an indentation.

Since no design patent in litigation is ever literally infringed (knock-off artists are not stupid), the case is over before it begins. The patentee is denied her opportunity to demonstrate to the jury that the accused design is substantially the same as the patented design; the doctrine of equivalents, inherent in *Gorham*, is dead, because it is never reached. In fact, *Gorham* is comatose, almost dead itself. *Markman* has killed it.

The bottom line is that *Markman* should not apply to design patents because:

- (a) design patent claims do not contain disputed claim language like utility patents;<sup>76</sup>
- (b) literal verbalization of design patent claims robs design patentees of the scope of equivalents they would otherwise be entitled to under *Gorham*;<sup>77</sup> and
- (c) visual images of a design in design patent drawings are inherently incapable of being reduced to words – no two courts would describe a design in the same way.

The Federal Circuit has literally lost sight of the “meaning” of a design by requiring images to be reduced to words. Because *Markman* decisions have unfairly narrowed the breadth of design patents and have mortally wounded the 1871 *Gorham* case, it is time to acknowledge

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<sup>75</sup> *OddzOn Prods., Inc. v. Just Toys, Inc.*, No. 95-CV-1077 (N.D. Cal., July 29, 1996).

<sup>76</sup> *Black & Decker (US) Inc. v. Pro-Tech Power Inc.*, 1998 U.S. Dist. LEXIS 9162, 47 USPQ2d (BNA) 1843 (E.D.V.A. June 2, 1998).

<sup>77</sup> SAIDMAN & SINGH, *supra*, note 70.



that a design patent is fundamentally different from a utility patent and relieve design patent owners and courts from the *Markman* stranglehold.

### **E. The Function of Functionality is Being Obliterated**

A design that is dictated solely by function is not protectable by a design patent, because it is not “ornamental,” 35 U.S.C. §171. For years, accused infringers have alleged that patented designs are “functional” as a defense in a patent infringement case. Of course, all industrial designs are “functional” in the sense that they are embodied in products that perform a function. However, that does not mean that the design is impermissibly legally “functional.”<sup>78</sup>

While the test for whether a design patent is legally “functional,” and thus invalid, is not totally clear,<sup>79</sup> the standard way for a patentee to counter it is to introduce evidence of alternate designs that perform substantially the same function. Upon successful proof thereof, the inquiry should be over, because the patentee has unequivocally demonstrated that she is not impermissibly monopolizing the design’s functional attributes (as noted, there are always functional attributes to every design) with her design patent; she is only monopolizing the particular design that performs that function. If the patentee is unable to prove that alternate designs exist which perform substantially the same function as the patented design, the design patent is invalid for being dictated by function.

The leading Federal Circuit case on functionality is *Best Lock v. Ilco*<sup>80</sup> in which the court determined that a design patent for a key blade blank was invalid because the blank design was dictated solely by the key blade’s function of having to fit within its corresponding keyway.

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<sup>78</sup> *Avia Group Int’l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 7 U.S.P.Q. 2d 1548 (Fed. Cir. 1988).

<sup>79</sup> *cf. In re Garbo*, 287 F.2d 192 (CCPA 1961) and *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234 (Fed. Cir. 1986), which use the “primarily” functional and “solely” functional tests, respectively.

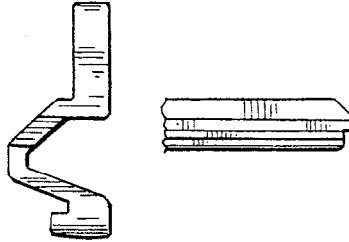
<sup>80</sup> *Best Lock v. Ilco Unican*, 94 F.3d 1563, 40 U.S.P.Q.2d 1048 (Fed. Cir. 1996).

# BEST LOCK v. ILCO UNICAN

(FED. CIR. 1996)

United States Patent [19]  
Best et al.  
[54] PORTION OF A KEY BLADE BLANK  
[75] Inventor: Walter F. Best, Timothy R. Berman,  
both of Peabody, MA; James W.  
Bergman, Clinton; Gary H. Shuck,  
Indianapolis, all of Ind.  
[73] Assignee: Best Lock Corporation, Indianapolis,  
Ind.

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



Therefore, the patent was invalid because it did not satisfy the statute's ornamentality requirement, i.e., every feature of the design was dictated by functional considerations. In other words, there were no alternate designs that would perform the function of fitting in the corresponding lock's keyway.<sup>81</sup>

The *Best Lock* case became the standard for not only understanding what is legally “functional,” but on how to apply the test in design patent litigation. Since *Best Lock*, however, there have been some troubling cases on the issue of functionality. In the 1999 case of *Berry Sterling v. Pescor*, the Federal Circuit in *dicta* set forth factors which it considered relevant in determining whether a claimed design was impermissibly functional.<sup>82</sup> In this list were factors such as whether the product design represents the best design, whether alternative designs would adversely affect the utility of the product, whether the product had any concomitant utility patents, and whether the advertising touts particular features of the design as having specific utility.<sup>83</sup>

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<sup>81</sup> *Id.* at 1565-66.

<sup>82</sup> *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452 (Fed. Cir. 1997).

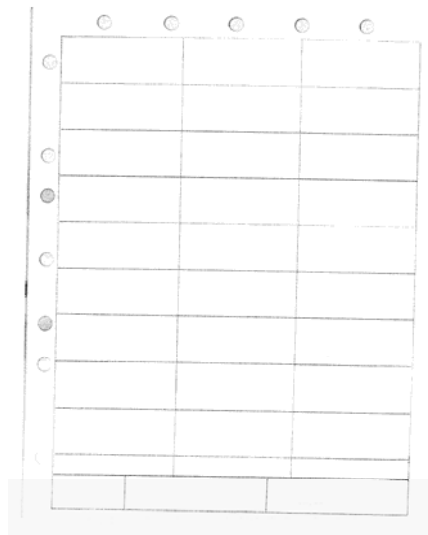
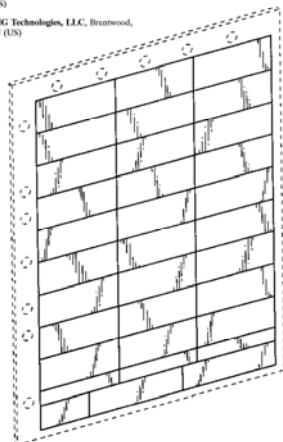
<sup>83</sup> *Id.* at 1456.

In November 2006, the Federal Circuit elevated this *dicta* from *Berry Sterling* to a rule of law in saying that proof of alternate designs that perform substantially the same function is no longer enough to defeat the functionality defense. In *PHG Technologies v. St. John*, they held that a design patent for a utilitarian article would be invalid if the alternate designs proffered by the patentee would adversely affect the utility of the product.<sup>84</sup>

In *PHG*, the district court granted a preliminary injunction against the makers of competing medical information labels because the court found that PHG's design was primarily ornamental in that there were multiple ways to arrange different sizes of labels on an 8 ½" x 11" sheet.<sup>85</sup>

## PHG v. ST. JOHN

(12) **United States Design Patent** (10) Patent No.: US D503,197 S  
Stewart et al. (45) Date of Patent: Mar. 22, 2005  
(54) LABEL PATTERN FOR A MEDICAL LABEL SHEET  
(75) Inventors: Thomas R. Stewart, Brentwood, TN (US); Brian D. Meyer, Brentwood, TN (US)  
(73) Assignee: PHG Technologies, LLC, Brentwood, TN (US)



On appeal, the Federal Circuit vacated the preliminary injunction, finding that St. John raised a substantial question with respect to whether the overall appearance of the patented

<sup>84</sup> *PHG Techs, LLC, v. St. John Cos.*, 2006 U.S. App. LEXIS 28468 (Fed. Cir. November 17, 2006).

<sup>85</sup> *PHG Techs., LLC v. St. John Cos.*, 2005 U.S. Dist. LEXIS 32808, \*13, \*16 (M. D. Tenn., December 5, 2005).

design is dictated by the function of the medical label sheet, because PHG did not prove that its proffered alternate designs did not adversely affect the utility of the patented label sheet.

Despite the Court's reference to Federal Circuit precedent revealing a lengthy "list of considerations" for assessing whether the overall appearance of a patented design is dictated by functional considerations, in fact, the only mention of this particular consideration (that alternate designs must not adversely affect the utility of the patented design) was in *dicta* from *Berry Sterling*.<sup>86</sup> In essence, the Court replaced its own prior test for functionality with a new one which requires a court to assess the utility of the proffered alternative designs and determine whether the chosen design best achieves the functional aspects of the article. If it does, then presumably the design choice was made for functional reasons, and any resulting design patent is invalid. In other words, the designer is penalized in the event that their best design choice also happens to lend itself to even marginally increased utility over the design alternatives.

PHG filed a Petition for Rehearing *En Banc* with the Federal Circuit, which was denied.<sup>87</sup> If this logic is left to stand, it would sound yet another death-knell for design patents. By inviting scrutiny of the underlying utility of possible design alternatives, the Court has opened a morass from which few design patents will emerge.

The holding in PHG is very dangerous for design patentees because it literally opens Pandora's Box to provide a defendant with a litany of new ways to attack a design patent based on functionality. For example, one of the factors in the "list of considerations" from the *dicta* in *Berry Sterling* is whether the claimed design is "the best design." Presumably, if it is, that becomes a factor weighing against the design patentee in determining functionality. This puts the court in the position of determining whether the claimed design is the "best" design from a

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<sup>86</sup> *Berry Sterling* at 1456.

<sup>87</sup> *PHG Techs., LLC v. St. John Cos.*, 2007 U.S. App. LEXIS 5570 (Fed. Cir., Feb. 12, 2007).

functional standpoint. Ironically, evidence will presumably be introduced by the defendant tending to prove that the patented design is best, while the design patentee will be trying to argue that her design is not in fact the best design for performing its function. Of course, all designers believe that their design is the best; else, why go to the trouble and expense of obtaining a design patent on it? And just how will the court determine if the patented design is “the best design”? Will expert witnesses be testifying about whether alternate designs are better/worse than the claimed design? The Court will be put in the business of determining functional performance characteristics of competing aesthetic designs, and ultimately deciding which is functionally “best,” which seems a very strange place for design patents to be.

And, ultimately, one must ask: what difference does it make whether the claimed design is even marginally “best” at performing its intended function? As long as alternate designs are available that perform substantially the same function, the design patentee is not monopolizing that particular function with her design patent. Since the main underlying rationale of the functionality doctrine is to prevent design patentees from using their design patents to protect functional features that Congress has said can only be protected with utility patents,<sup>88</sup> it matters not whether the patented design is the marginally “best” at performing that function. What matters is the availability of alternate designs that perform substantially the same function. If that is proven, then the inquiry should end, since the design patentee is clearly not monopolizing that function. The infringer is thus free to adopt any of the several available alternatives to perform substantially the same function, rather than knock-off the patented design.

The so-called “list of considerations” from *Berry Sterling* greatly resembles the factors that courts have looked into for many years in determining whether a particular trade dress is

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<sup>88</sup> *Chisum on Patents*, §23.03[4] (2006).

impermissibly functional.<sup>89</sup> This causes one to speculate that the author of the *Berry Sterling* opinion may have been researching trade dress cases on functionality rather than design patent cases on functionality. Of course, the underlying rationale of both functionality doctrines is the same: one should not use design patents or trade dress to protect those functional product features that Congress has said should only be protected by utility patents. And in the past, the test for trade dress functionality has appropriately been much more strict than design patent functionality.<sup>90</sup> Regardless of whether one considers that the test for functionality should be the same or different than that for trade dress, one can safely say that the courts should carefully consider underlying rationales of these two distinctly different forms of intellectual property before determining that issue, something that clearly was not done prior to the appearance of the unfortunate *dicta* in *Berry Sterling*.

## **F. Endemic Design Patent Problems Persist**

Some of the biggest objections to design patents over the years have been that they take too long to get, that they cost too much, that you can only protect one design per application, and that it is hard to satisfy the design patent standard of ‘non-obviousness.’<sup>91</sup> These drawbacks remain even today.

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<sup>89</sup> *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (CCPA 1982).

<sup>90</sup> When one obtains trade dress protection on a product configuration, the protection can last forever, as long as the product is being sold in commerce. Courts have said that this potentially perpetual protection for product configuration trade dress warrants a higher scrutiny before such protection is afforded. This higher scrutiny means that it is, and should be, much harder to prove that a particular trade dress is non-functional, when compared to patented designs that only enjoy a limited 14-year monopoly. Second, the basis of trade dress law is to avoid consumer confusion as to the source or origin of a product, and is grounded in the common law, where rights attach by use of the trade dress in commerce. In other words, the best interests of the consumer are paramount, and takes a back seat to considerations of whether the design itself is protected. A design patent, on the other hand, is a statutorily-created form of pure design protection; the interests of consumers do not enter into the considerations of whether a particular design is worthy of a design patent. In fact, a design patent may be obtained on a design that has never been made, has never been sold in commerce, and is only a figment of a designer’s imagination.

<sup>91</sup> Perry J. Saidman, *The Glass Slipper Approach to Protecting Industrial Designs or When the Shoe Fits, Wear It*, 19 U. BALT. L. REV. 167 (Fall 89-Winter 90).

Design patent applications routinely now take around 2 years to issue from the time they are filed. The average time to a first Office action is 15 months after filing.<sup>92</sup> These lengths of time are unacceptably long for product designs whose shelf life is measured in months rather than years. By the time a design patent has issued, the product design may have been long supplanted in the marketplace.

Even when using the PTO's vaunted "rocket docket,"<sup>93</sup> which had in the past enabled design patents to issue in around 6 months,<sup>94</sup> seemingly endemic printing delays in the PTO have increased the pendency of even rocket docket applications to around 1 year, again unacceptably long for many designs. And, to add insult to injury, one must pay an extra \$900 PTO filing fee in order to get so-called expedited "rocket docket" processing.

A design patent now can cost \$2,000 - \$4,000 to obtain. While this does not sound like much compared to the cost of a utility patent (easily \$5,000 - \$20,000 or more), keep in mind that you can only claim one design per application, in contrast to a utility patent in which several claims of varying scope can be granted in a single application. In order to obtain claims of varying scope for a product's design, multiple design applications must be filed, thereby multiplying the expense. When taken in conjunction with the fact that many manufacturers introduce dozens, or even hundreds, of new designs each season, it is quite clear that protecting each design with one or more design patents is economically unfeasible.

The statutory requirement that a claimed design, in order to be patentable, must have been non-obvious to a designer of ordinary skill, has presented difficulty for many designs that

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<sup>92</sup> [http://www.patentlyo.com/patent/2007/02/how\\_long\\_do\\_i\\_w.html](http://www.patentlyo.com/patent/2007/02/how_long_do_i_w.html).

<sup>93</sup> 37 C.F.R. §1.155; M.P.E.P. 1504.30.

<sup>94</sup> The unofficial record for shortest pendency is around 2 months; *see* U.S. Pat. No. Des. 380,417 (filed May 2, 1997, issued July 1, 1997).

are unquestionably novel and original.<sup>95</sup> An example from the author's own practice will suffice to demonstrate the point. Below is illustrated a perspective view (FIG. 1) of the claimed design for a commercially successful "Mesh Storage Basket" (Ser. No. 29/152,436) that was rejected by the PTO under 35 U.S.C. § 103 as obvious in view of the prior art combination of Hardy U.S. Pat. No. Des. 419,302 (see FIG. 1 below), Pope, U.S. Pat. No. 2,768,022 (see Fig. 1 below), and Glassenberg, U.S. Pat. No. Des. 418,998 (see Fig. 1 below).

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<sup>95</sup> A design is not patentable unless the differences between the design and the prior art would have been non-obvious to a designer of ordinary skill. *In re Nalbandian*, 661 F.2d 1214 (C.C.P.A. 1981).



## Claimed Design

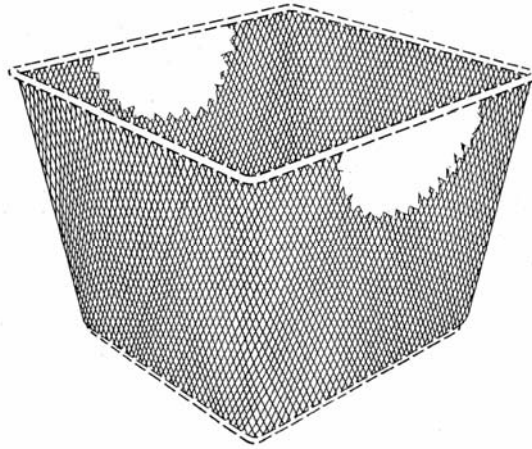


FIG.1

## Hardy

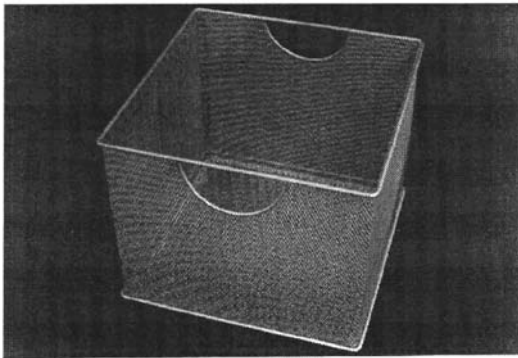
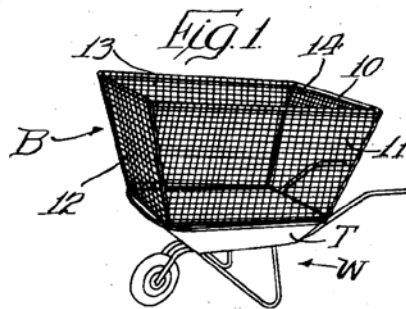


FIG. 1

## Pope



## Glassenberg

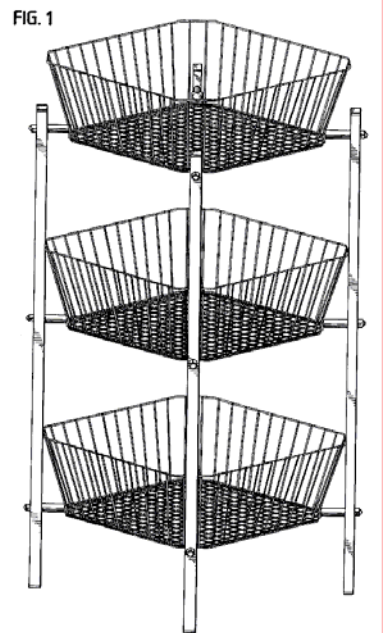


FIG. 1

The Hardy basket is very similar to the claimed design, but is essentially cubical while the claimed design has inclined sidewalls. The PTO took the position, affirmed *per curiam* by the Federal Circuit,<sup>96</sup> that the Hardy prior art is “basically the same” as the claimed design but for the presence of tapered sidewalls in the latter. The PTO said that Pope and Glassenberg “both show the provision of tapered sidewalls in basket designs similar to that shown in Hardy,”<sup>97</sup> and concluded that “[T]he provision of tapered sidewalls in a basket design of the type shown in Hardy is an obvious design expedient.”<sup>98</sup> Whether or not you agree that the claimed design is obvious in view of this prior art, it is quite clear that it is novel and original, and would be protected under a law that did not have non-obviousness as a criteria.

Finally, the design side of the PTO continues to experience operational difficulties, which makes the design patent system somewhat of a bad deal for its customers, i.e., design patent applicants. One example is the PTO’s apparent inability and/or unwillingness to issue design patents with decent quality photographs. The ironic thing is that the PTO demands that design patent applicants who choose to file photographs rather than pen and ink drawings must submit black and white photographs of the highest quality.<sup>99</sup> Applicants go to great expense and care to meet this standard. And if the photographs as filed are in any way deficient, the PTO does not hesitate to issue a notice to the applicant to correct the defects, on pain of abandonment.

Yet, when the PTO goes to print an allowed design patent application as an issued patent, one that has photographs filed as formal drawings, the images on the issued patents are so poor

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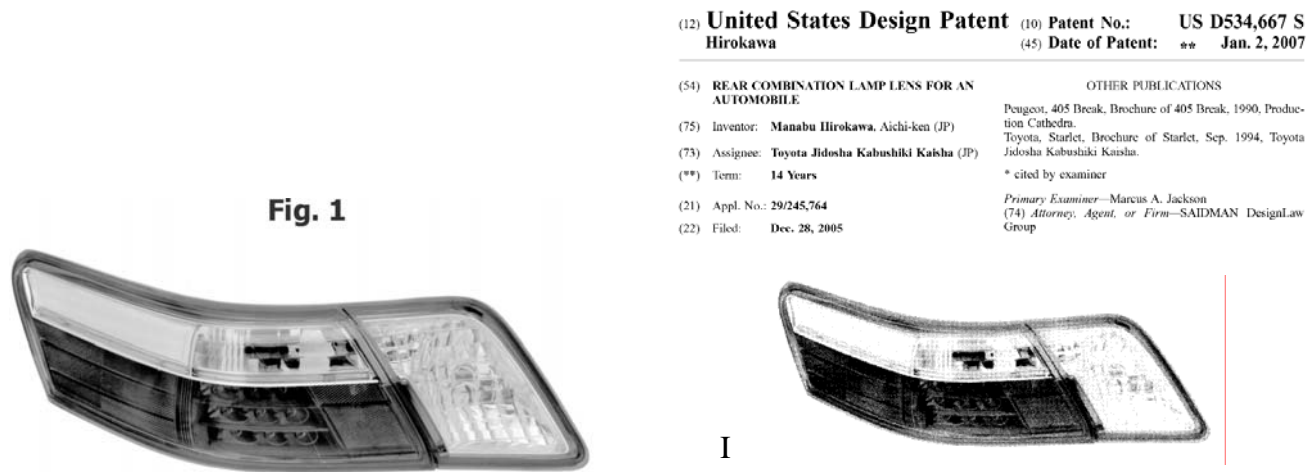
<sup>96</sup> *In re Christopher Hardy*, Appeal No. 06-1153 (October 10, 2006).

<sup>97</sup> *Ex parte Christopher Hardy*, Appeal No. 2005-1424, PTO Board of Interferences and Patent Appeals (Sept. 29, 2005), p. 13.

<sup>98</sup> *Id.*

<sup>99</sup> If the photographs are not of sufficient quality so that all details in the photographs are reproducible, this will form the basis of subsequent objection to the quality of the photographic disclosure. No application will be issued until objections directed to the quality of the photographic disclosure have been resolved and acceptable photographs have been submitted and approved by the examiner. If the details, appearance and shape of all the features and portions of the design are not clearly disclosed in the photographs, this would form the basis of a rejection of the claim under 35 U.S.C. 112, first and second paragraphs, as non-enabling and indefinite. 37 C.F.R. 1.152.

that in many cases the designs are unintelligible.<sup>100</sup> As one example, following is a photograph as filed in the PTO, and this same photo as it appears on the cover of the resulting U.S. Pat. No. D534,667:



It is rather incredible that the PTO can produce such an unacceptably poor product, especially in light of the fact that other organizations, such as WIPO, have no such problem.<sup>101</sup>

#### IV. Design Protection In The 21<sup>st</sup> Century

A design patent system created in 1842<sup>102</sup> no longer suffices to adequately protect most industrial designs. Something more suited to modern 21<sup>st</sup> century realities needs to be created to make sure designers and manufacturers get their just due, and are not willy-nilly knocked-off by unscrupulous operators who have absolutely zero investment in research, design or development. The present system in many cases is tantamount to legalized theft. It would be immoral and unethical not to try and fix it.

<sup>100</sup> See, e.g., U.S. Pat. Nos. D514,024; D530,841; and D506,276.

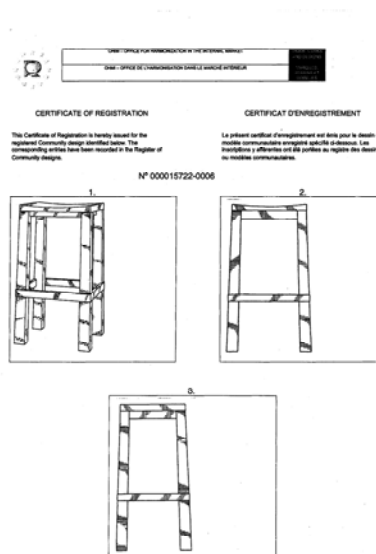
<sup>101</sup> See, e.g., WIPO International Designs Bulletin, DM/49372 Chaussures et semelles / *Footwear and soles*.

<sup>102</sup> 48 Act of August 29, 1842, Ch. 263, § 3, 5 Stat. 543, 544.

For inspiration as to what a new design protection regime would look like, we need look no further than the following three (non-obvious?) sources: the European Community Design system; the U.S. Vessel Hull Protection Act; and the proposed Fashion Bill.

### A. Europe Got It Right

In Europe, the relatively new Community Design system,<sup>103</sup> effective since 2001, is a model design protection system that protects even unregistered designs for three years from first disclosure. If a design is registered within one year of the first sale or publication, it can receive up to 25 years of protection. The registration process allows multiple designs to be filed in one application for a relatively low per design cost. There is no examination process, and the registration is usually issued within about 3-6 months of filing. Finally, the protection is valid in all of the European Union countries, and European customs officials will enforce both registered and unregistered design rights at the borders. What could be better?



<sup>103</sup> <http://oami.europa.eu/en/design/default.htm>

## **B. The Boat Hull Lobby Shows the Way**

After the U.S. Supreme Court struck down a state law that protected boat hull designs,<sup>104</sup> the boating industry began to lobby Congress for a law that would effectively overrule the Court's decision. In 1998, it succeeded when Congress passed the Vessel Hull Protection Act<sup>105</sup> that specifically protected the "design of a vessel hull, including a plug or mold."

Boat hull protection is limited to "original designs ... which makes the article attractive or distinctive in appearance to the purchasing or using public."<sup>106</sup> A design is considered "original" if it is "the result of the designer's creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source."<sup>107</sup> This seemingly broad protection is limited by restrictions on protection for designs that are "not original," that are "staple or commonplace," that are saved from being staple or commonplace "only in insignificant details or in elements which are variants commonly used in the relevant trades," and that are dictated by utilitarian functions.<sup>108</sup> Additionally, if a design has been made public more than two years before the application for registration is filed, no protection is granted.<sup>109</sup> Following is an example of a vessel hull registration, including its 2-page application:

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<sup>104</sup> *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989). The Court struck down a Florida plug-molding statute, which prohibited the process by which a boat hull is made by casting a competitor's mold.

<sup>105</sup> 17 U.S.C. § 1301 *et seq.*

<sup>106</sup> 17 U.S.C. § 1301(a)(1).

<sup>107</sup> 17 U.S.C. § 1301(b)(1).

<sup>108</sup> 17 U.S.C. § 1302(2)-(4).

<sup>109</sup> 17 U.S.C. § 1302(5).

**Form D-VII**  
UNITED STATES COPYRIGHT OFFICE

DATE OF REGISTRATION/PUBLICATION  
month 06 day 26 year 05

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET. (Form D-VIICOM)

Ultra Cat 258

**1** TITLE  
Please give the make and model of the vessel that embodies the design.

**2** (a) What is the type or style of the design for which registration is sought?  
Shallow draft recreational fishing boat

(b) Provide a brief general statement setting forth the salient features of the design.  
Channel that runs the length of the boat from the bow region through to the transom recess for an outboard motor

(c) If this design is derived from an earlier design, describe how that design has been revised, adapted, or rearranged.  
N/A

**3** Provide the name and address of the design(s). The name of the employer may be given instead of the design(s) if (1) the design was made within the regular scope of employment of the design(s) and (2) the individual authorship of the design is difficult or impossible to ascribe.  
Please check here if these conditions are satisfied and you are providing the employer's name.  
Name: Joel Euton  
Address: P.O. Box 39  
Hamlin, Texas 79520

**4** If the owner is different from the design(s) or employer named above, provide the name and address of the owner:  
Name: \_\_\_\_\_  
Address: \_\_\_\_\_

**5** (a) Was an application for registration of this design identified in an application filed in a foreign country that extends to designs of vessels in the United States, similar to those in the United States, or to persons filing applications in the United States, similar to those in the United States?  
Yes ☒ No ☐  
Date of application: \_\_\_\_\_  
Country: \_\_\_\_\_

(b) If yes, identify the country and date of application:  
Country: \_\_\_\_\_  
Date of application: \_\_\_\_\_

**6** Was this design made public before the date of application? Yes ☒ No ☐  
If yes, on what date? July 4, 2005  
Date made public: \_\_\_\_\_  
Public: \_\_\_\_\_

EXAMINED BY 774 FORM D-VII  
CHECKED BY \_\_\_\_\_ FOR  
CORRESPONDENCE OFFICE  
YES ☐ NO ☐ USE ONLY

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET. (Form D-VIICOM)

Please provide the name and address of the person to whom correspondence regarding this application may be directed:

**7** Name: Tim Cook  
Address: P.O. Box 10107  
Liberty, Texas 77575 Email address: timcook@libertypatent.com  
FAX number: 936.336.8203 Dextine phone: 936.336-8200

**8** Give the name and account number if the registration fee is to be charged to a Deposit Account established in the Copyright Office:  
Name of Account: \_\_\_\_\_  
Account number: \_\_\_\_\_

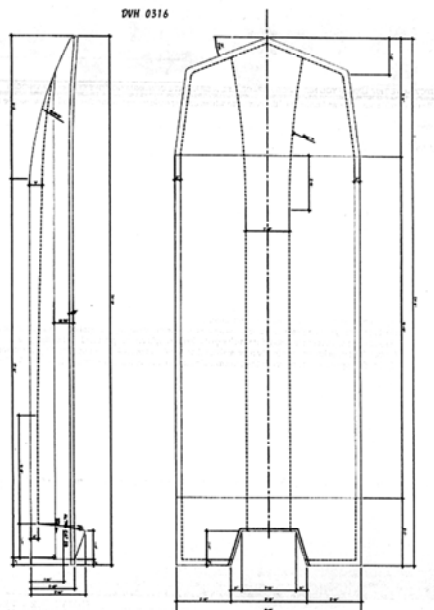
**9** DECLARATION: The undersigned, as the applicant or the applicant's duly appointed agent or representative, being hereby warned that willful false statements are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of this application or any resulting registration, hereby declares to the best of his or her knowledge and belief:  
(1) that the design has been fixed in a useful article;  
(2) that the design is original and was created by the design(s), or employer if applicable, named in the application;  
(3) that those aspects of the design for which registration is sought are not protected by a design patent;  
(4) that the design has not previously been registered on behalf of the applicant or applicant's predecessor in title; and  
(5) that the applicant is the person entitled to protection and to registration under Chapter 13 of title 17, United States Code.  
Complete if applicable:  
The design has been made public with a design notice as prescribed by 17 U.S.C. §1306.  
Following is the exact form of the design notice:  
Design Protected 2005 Ultra Cat LLC  
Where on the useful article is the design notice located?  
Starboard side of transom

If the undersigned is authorized to execute this application on behalf of the applicant:  
Name: Tim Cook Date: 21 November 2005  
Address: P.O. Box 10107 Counsel: \_\_\_\_\_  
Liberty, Texas 77575 Telephone number: 936.336.8200 FAX number: 936.336.8203 Email address: timcook@libertypatent.com

Copyright Office fees are subject to change. For current fees, check the Copyright Office website at [www.copyright.gov](http://www.copyright.gov), write the Copyright Office, or call (202) 707-9000.

Tim Cook  
P.O. Box 10107  
Liberty, TX 77575

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The Vessel Hull Protection Act, although not extensively used, got boat manufacturers and designers around the sticky problem of separability in conventional copyright law.<sup>110</sup>

### **C. How is Fashion Design Like Boat Hulls?**

Fashion designers have long suffered at the hands of knock-off artists. The fashion business, unlike many other industries, has incredibly short turnaround time for designs, such that the design patent system seems especially inappropriate. By the time a design patent issues, three or four fashion seasons could have passed by. With the restrictions on copyright of useful articles, many fashion designs are left easy prey for knock-off artists.

So, noting the success of the boat lobby, the fashion industry in 2006 got Congress to introduce the Design Piracy Prohibition Act (H.R. 5055), a proposed amendment to the Vessel Hull Protection Act, that would provide 3 year protection for original “apparel,” which includes “men’s, women’s, or children’s clothing, including undergarments, outerwear, gloves, footwear, and headgear; handbags, purses, and tote bags; belts; and eyeglass frames.”<sup>111</sup> Although the bill did not reach the floor for a vote, hearings were held, and the bill is expected to be reintroduced in 2007.

The Fashion Bill is significant because it is another ‘special purpose’ design protection law that is trying to latch on to the success enjoyed by the boating industry in getting Congress to pass a copyright-based design registration system.

And both the Fashion Bill and the Vessel Hull Protection Act were, curiously enough, drafted as slight modifications of the last *sui generis* general design protection bill for which

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<sup>110</sup> *supra*, note 19.

<sup>111</sup> Design Piracy Prohibition Act (H.R. 5055, 109th Cong. (2006)).

hearings were last held in 1990.<sup>112</sup> We are but a slight step away from considering new *sui generis* legislation that, rather than be directed once again to a special industry group, protects all industrial designs.

#### **D. The Future of Design Protection in the U.S.**

It seems quite clear to this author that the time has come for the United States to catch up to the rest of the world and finally enact a *sui generis* design protection law. Although there is a long history of the failure of many interested and well-intended parties to do just that,<sup>113</sup> the time is ripe to get a bill through Congress that makes sense in the 21<sup>st</sup> Century.

The last big push for *sui generis* design protection in the U.S. was in 1990,<sup>114</sup> which collapsed under stiff opposition by the spare parts and insurance lobbies.<sup>115</sup> The Community Design law, an unqualified success in Europe, adopted a work-around for this thorny issue that can serve as some food for thought for future U.S. legislation.<sup>116</sup> Perhaps the EU solution is the answer in the U.S., perhaps not. But let the discussion commence.

Since the last attempt at passing U.S. legislation in 1990, several significant developments combine to create a much more receptive environment to, and perhaps even demand for, *sui generis* industrial design protection, namely:

1. The current laws on the books for protecting designs, as evidenced in this paper, have been rendered almost impotent;

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<sup>112</sup> *Industrial Design Protection: Hearings on H.R. 902, H.R. 3017 and H.R. 3499 Before the Subcomm. on Courts, Intellectual property, and the Administration of Justice of the House Comm. on the Judiciary*, 101st Cong., 2d Sess. (1990).

<sup>113</sup> David Goldenberg, *The Long and Winding Road, A History of the Fight Over Industrial Design Protection in the United States*, 45 J. COPYRIGHT SOC'Y U.S.A. 21 (1997).

<sup>114</sup> *supra*, note 112.

<sup>115</sup> It is said that the impending 1992 Presidential election also greatly distracted the Congress from doing business as usual.

<sup>116</sup> [http://eur-lex.europa.eu/LexUriServ/site/en/com/2004/com2004\\_0582en01.pdf](http://eur-lex.europa.eu/LexUriServ/site/en/com/2004/com2004_0582en01.pdf) Simply stated, there is no protection for “must match” spare parts in the EC aftermarket.



2. Increased globalization has made many more consumer products available whose only distinguishing characteristic, in many cases, is their outward appearance, i.e., their design;

3. Corporate American digs good design and appreciates the value that good design brings to the bottom line;<sup>117</sup>

4. The U.S. is arguably in violation of the 1995 TRIPS agreement for not providing for a system to protect “new or original” industrial designs.<sup>118</sup>

5. The Vessel Hull Protection Act<sup>119</sup> and Fashion Bill<sup>120</sup> have demonstrated Congress’ willingness to consider and pass *sui generis* design protection laws, albeit special purpose ones.<sup>121</sup>

6. The Internet has emerged as an incredibly effective and inexpensive organizing and communicating tool.

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<sup>117</sup> Julie H. Hertenstein et al., *The Impact of Industrial Design Effectiveness on Corporate Financial Performance*, 22 THE JOURNAL OF PRODUCT INNOVATION MANAGEMENT 3, (2005); Gerda Gemser & Mark A. A. M. Leenders, *How integrating industrial design in the product development process impacts on company performance*, 18 THE JOURNAL OF PRODUCT INNOVATION MANAGEMENT 28 (2001); Julie H. Hertenstein, *Valuing design: Enhancing corporate performance through design effectiveness*, 12 DESIGN MANAGEMENT JOURNAL 10 (2001).

<sup>118</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods, art. 25, Apr. 15, 1994. *See also*, JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 227 (2d ed. 2006).

<sup>119</sup> *supra*, note 105.

<sup>120</sup> *supra*, note 111.

<sup>121</sup> *Sui generis* design protection also exists for computer chips. *See* 17 U.S.C. §§ 901-914.

The time has come to solve the current crisis in U.S. design law by reconstituting a coalition of designers, manufacturers, and allied trade associations, to protect industrial designs quickly, easily, and inexpensively, before this last bastion of American creativity is knocked-off out of existence.