

*Looks Matter...*

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# Navigating and Rectifying the Design Patent Muddle

BCLT Design Patent Symposium

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WHAT MUDDLE?

# A PRIMER ON DESIGN PATENT FUNCTIONALITY

## TWO IMPORTANT PRINCIPLES

# Primer on Design Patent Functionality

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

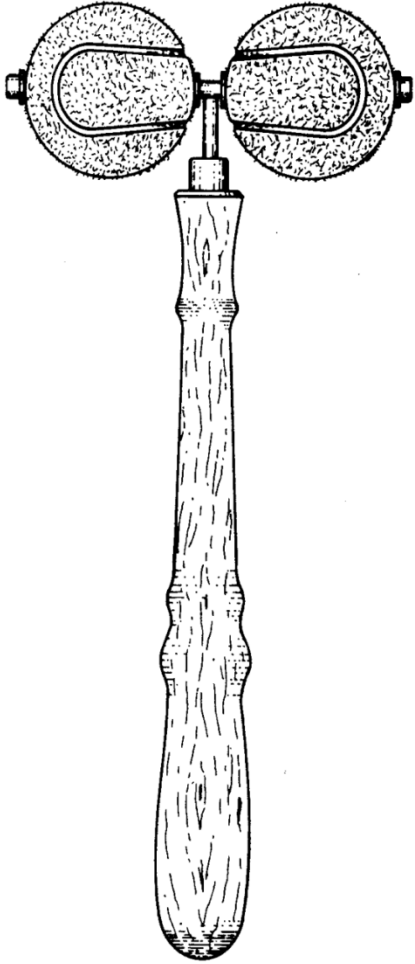
# Primer on Design Patent Functionality

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

# Primer on Design Patent Functionality

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

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



Patented Design

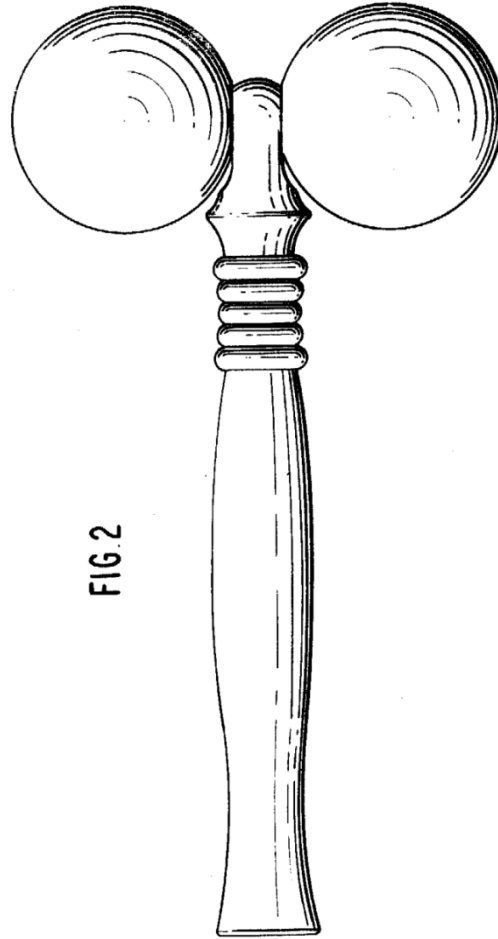


FIG. 2

Non-infringing Designs

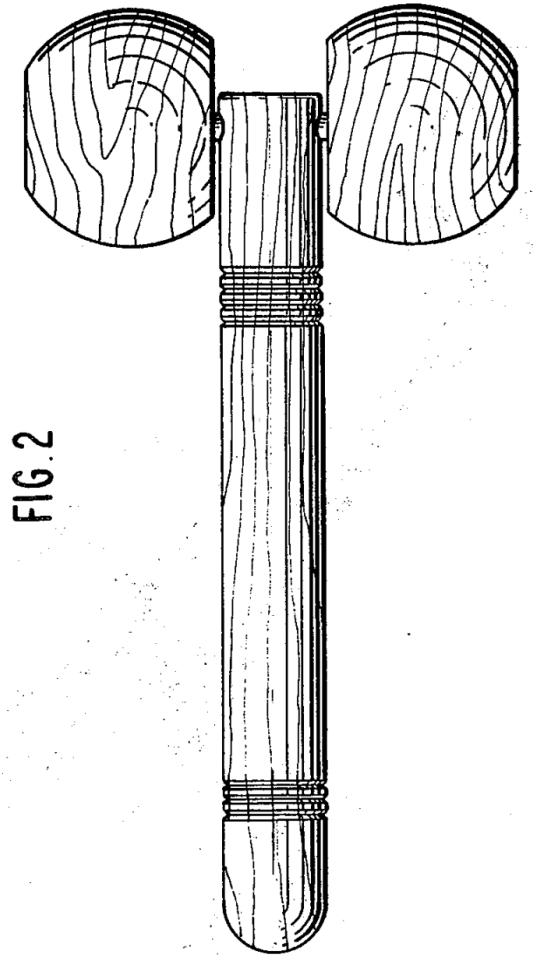
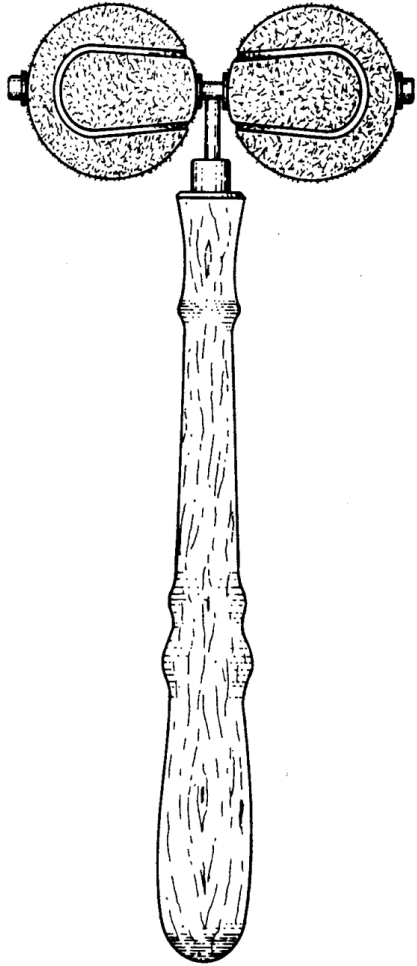


FIG. 2



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



Patented  
Design

COURT:

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

# Best Lock v. Ilco Unican

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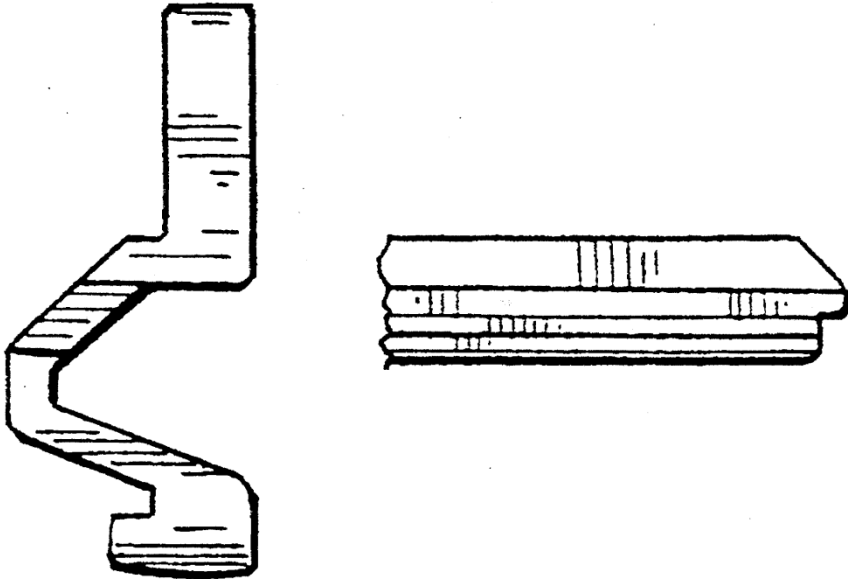
United States Patent [19]  
Best et al.

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

[54] PORTION OF A KEY BLADE BLANK

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

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



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

# Best Lock v. Ilco Unican

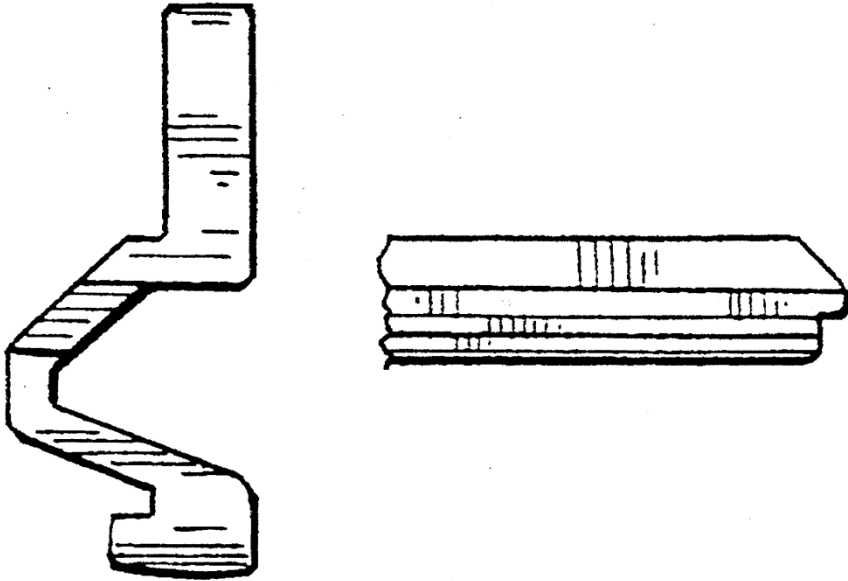
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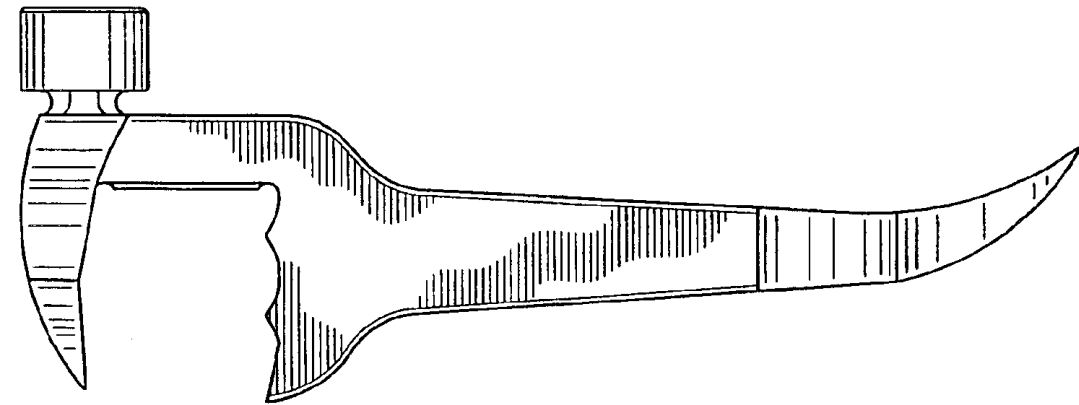


[T]he key blade must be designed as shown in order to perform its intended function...to fit into its lock's keyway...[thus] the design is dictated by function, and invalid.

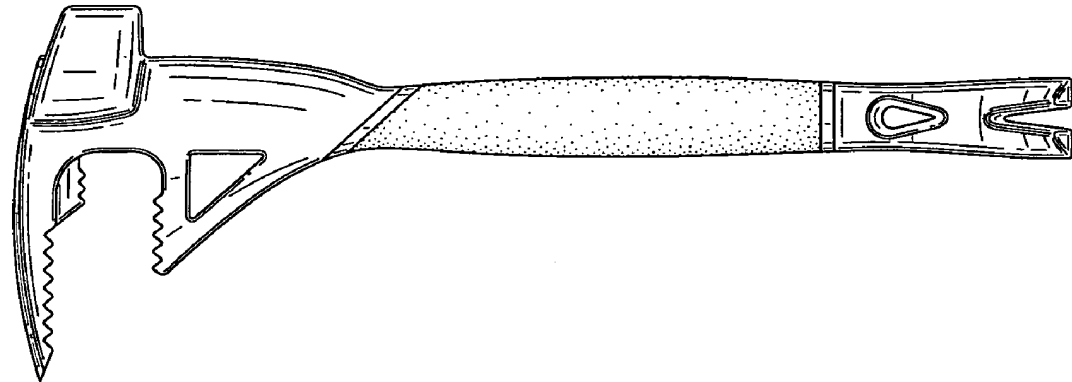
# Primer on Design Patent Functionality

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

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



PATENTED  
DESIGN

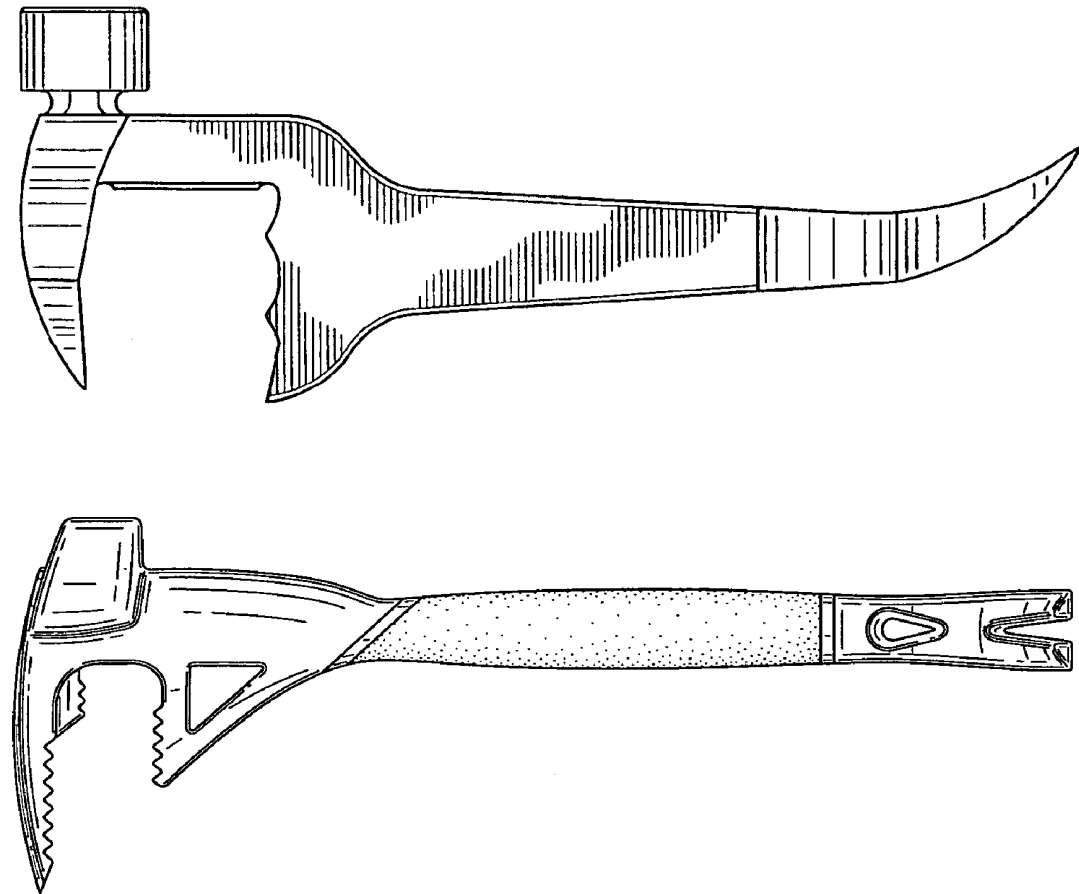


ACCUSED  
DESIGN

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

## FEDERAL CIRCUIT:

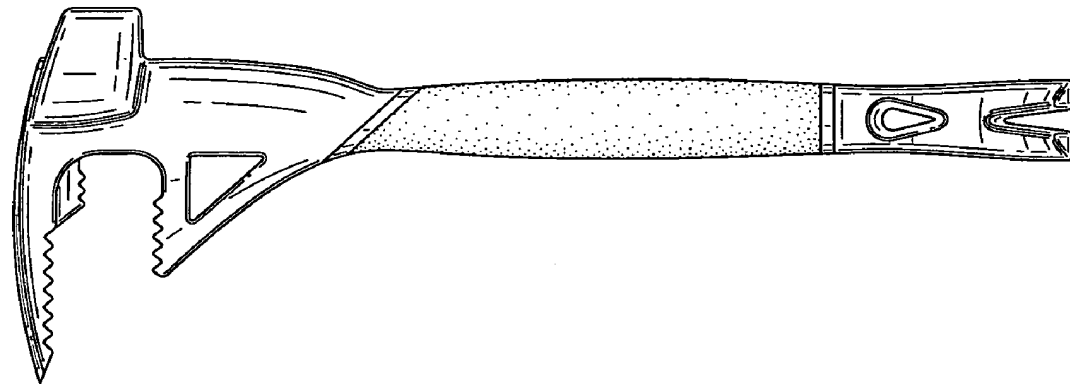
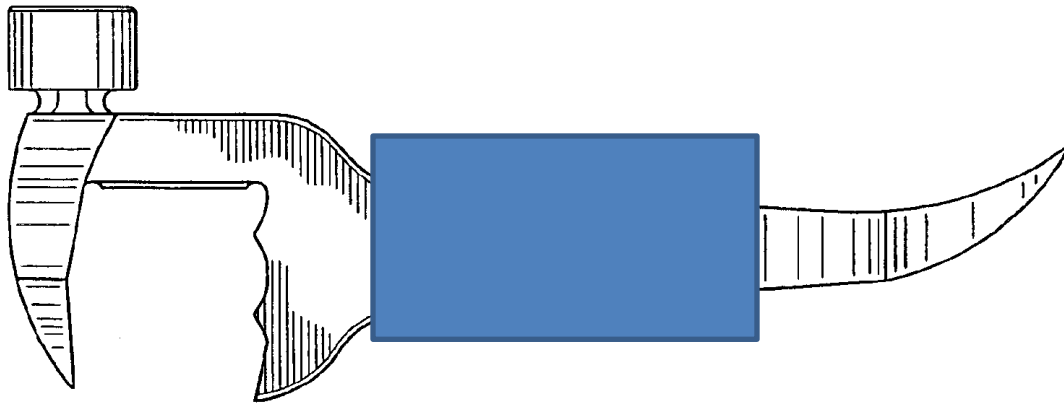
Richardson's multi-function tool comprises several elements that are driven purely by utility... the handle, the hammerhead, the jaw, and the crowbar are dictated by their functional purpose.



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

## FEDERAL CIRCUIT:

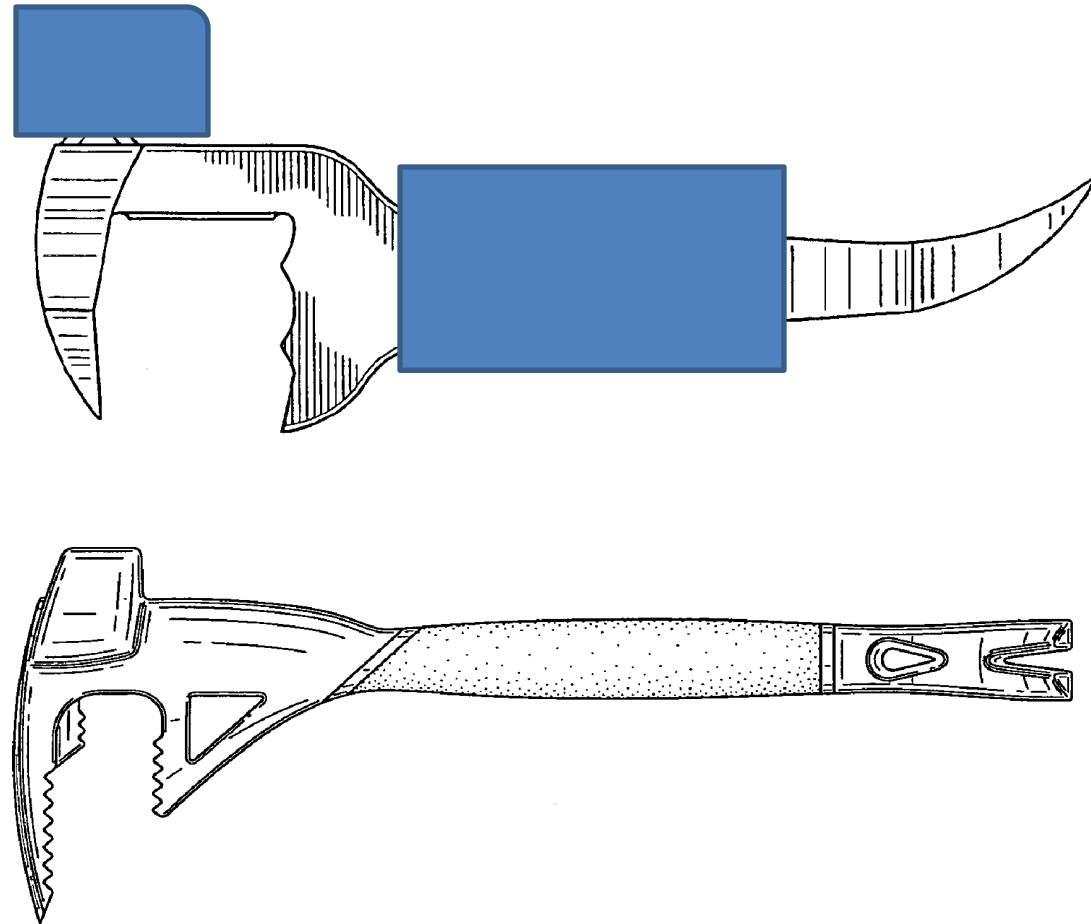
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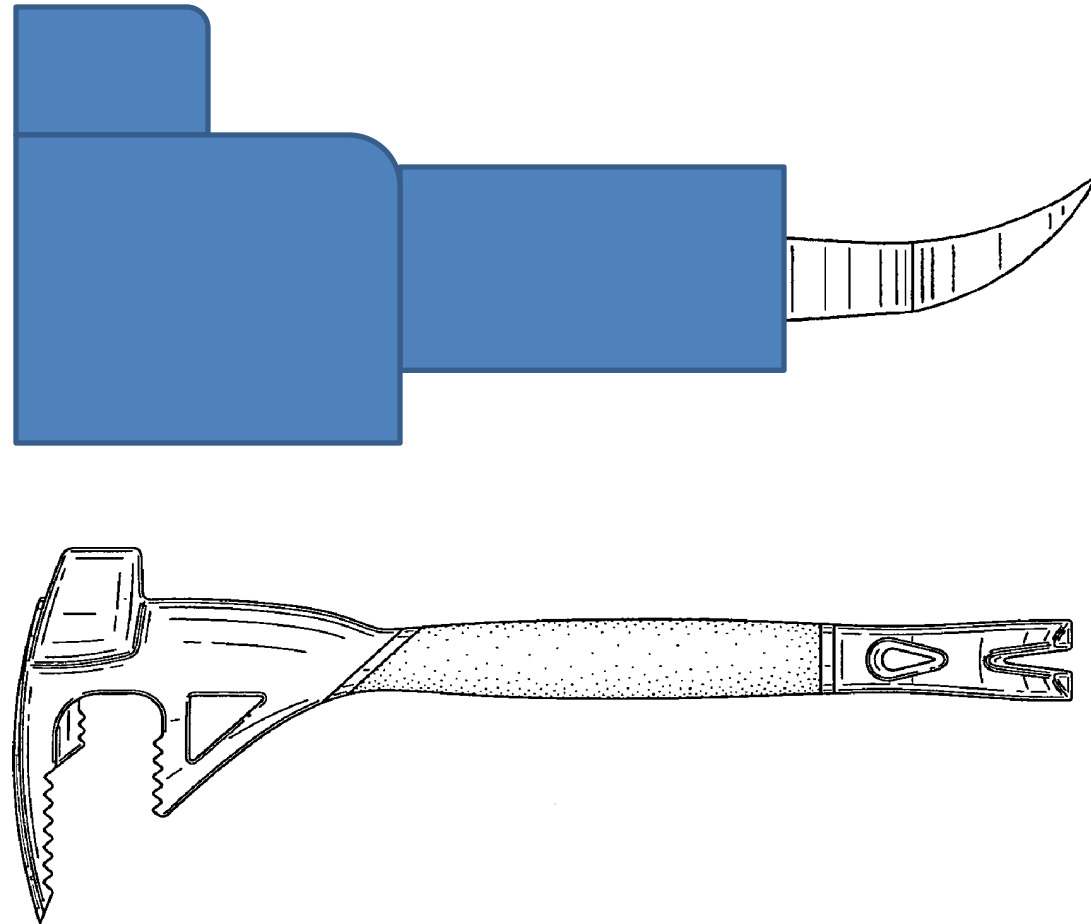




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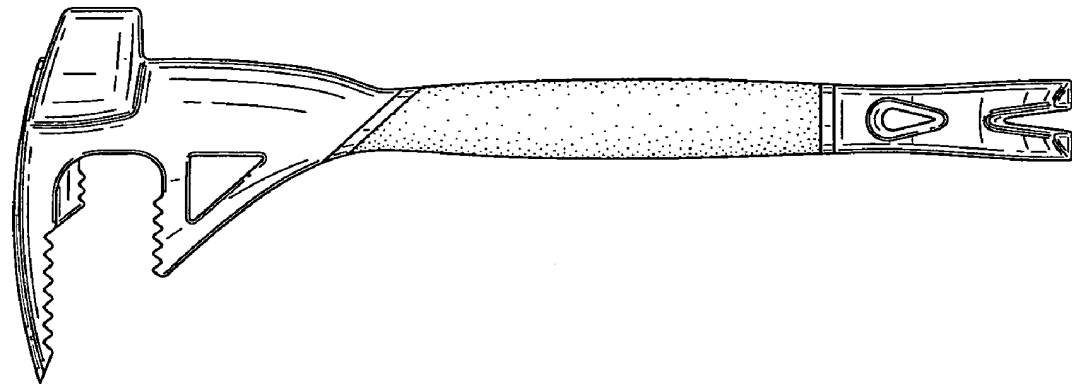
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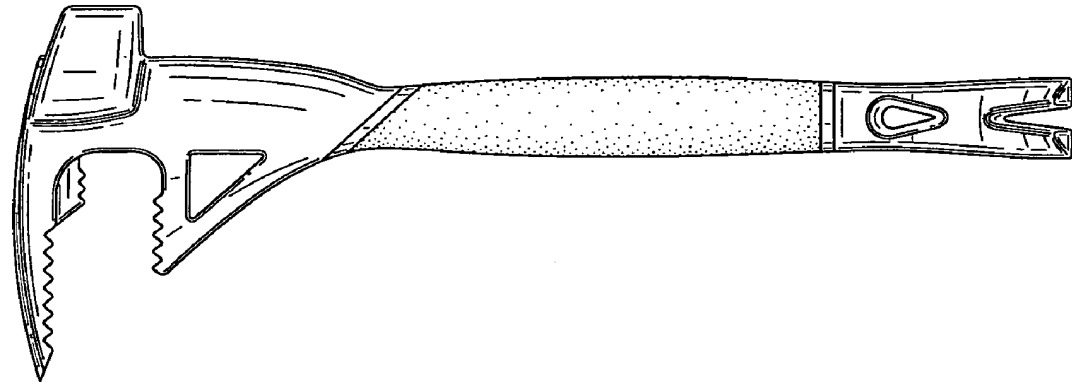
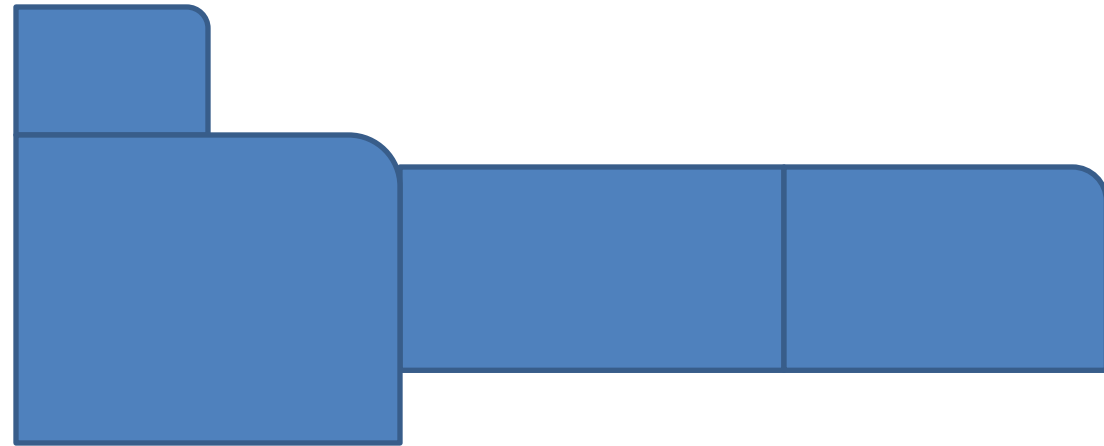
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Richardson's multi-function tool comprises several elements that are driven purely by utility... the handle, the hammerhead, the jaw, and **the crowbar** are dictated by their functional purpose.



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

So, the  
design patent  
covers  
**NOTHING??**



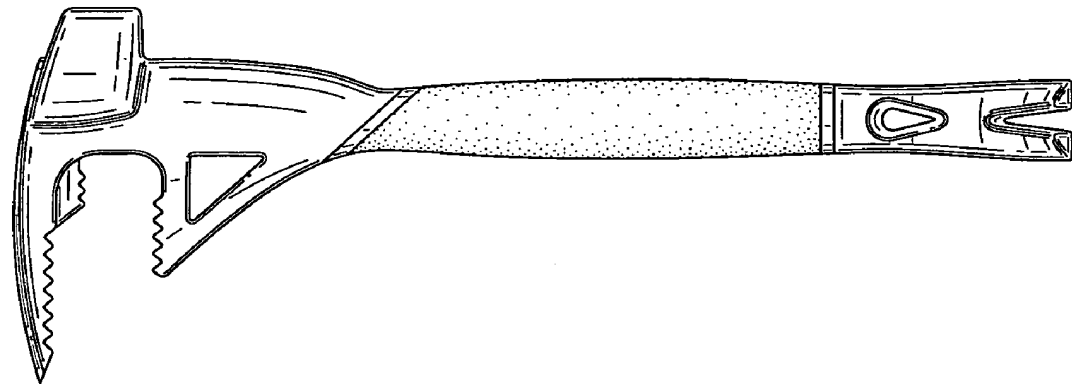
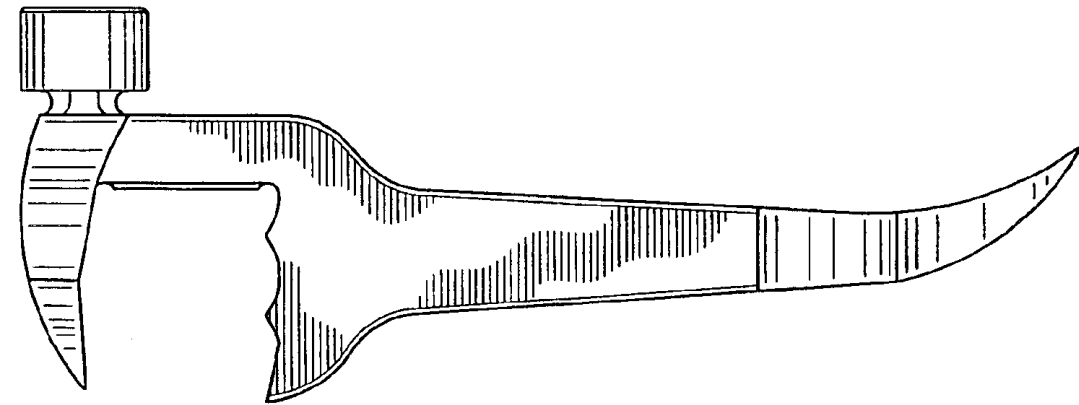
# Richardson v. Stanley Works (Fed. Cir. 2010)

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

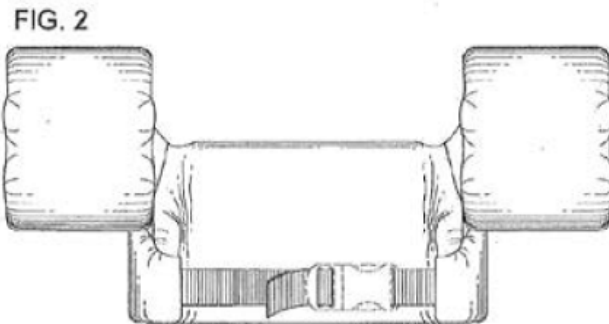
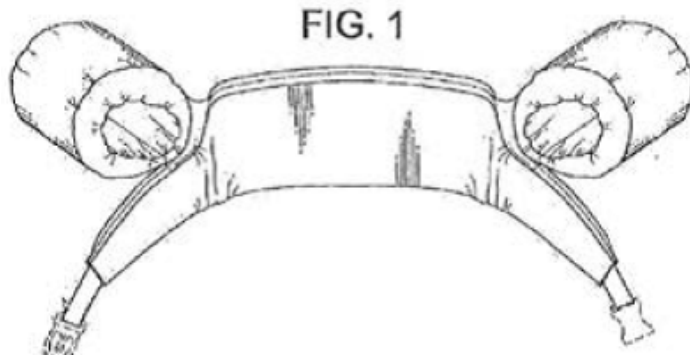
Here, the accused design simply does not **look like** the patented design.

No infringement.

End of story.



# *Sport Dimension v. Coleman* (Federal Circuit, 2016)



**PATENTED DESIGN**



**ACCUSED DESIGN**

# *Sport Dimension v. Coleman* (Federal Circuit, 2016)

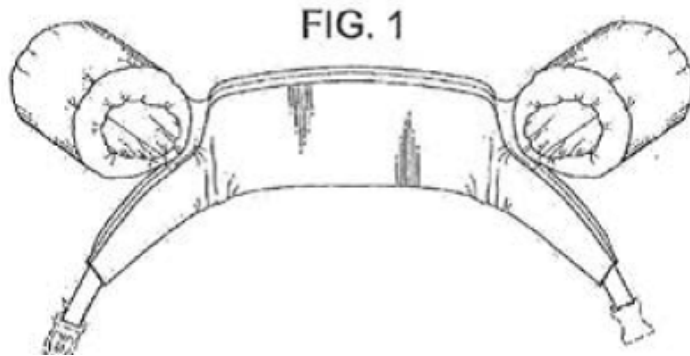
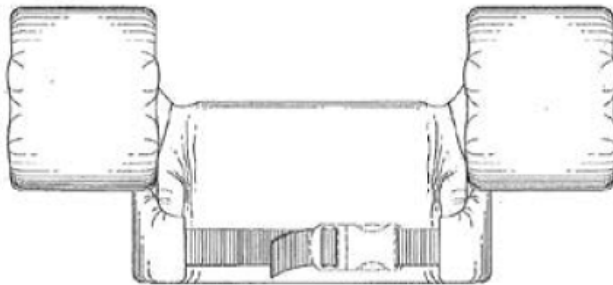


FIG. 2



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

# Sport Dimension v. Coleman

(Federal Circuit, 2016)

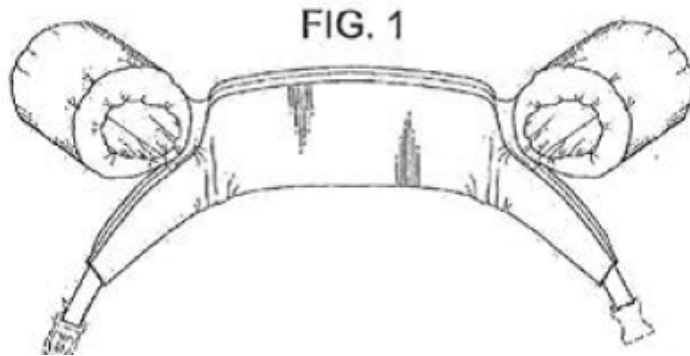
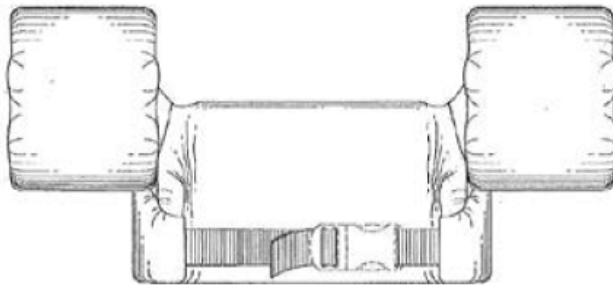


FIG. 2



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

# *Sport Dimension v. Coleman* (Federal Circuit, 2016)

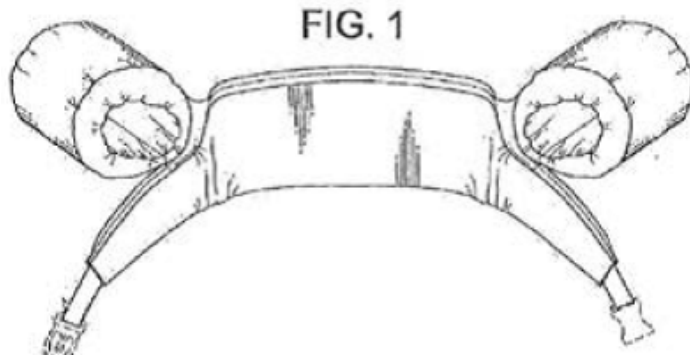
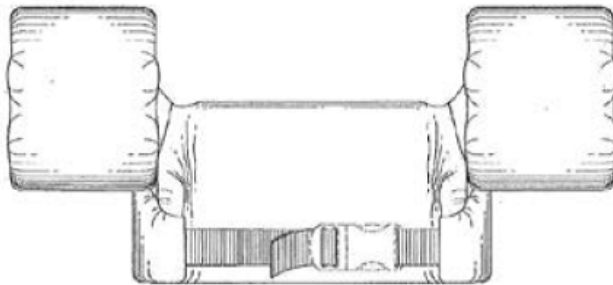


FIG. 2



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



# Primer on Design Patent Functionality

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

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