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EVOLUTION OF THE UNOBVIOUSNESS STANDARD: 35 U.S.C. § 103 FOR DESIGN PATENTS

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I. INTRODUCTION

The concept of obviousness in patent law and the related statutory requirements are embodied in the Patent Act of 1952. This Article traces the history and evolution of the standard for design patentability under title 35, section 103 of the United States Code.

II. DESIGN PATENTS AND THEIR HISTORY

Although Congress, acting under its constitutional powers to protect the writings of authors and the discoveries of inventors, passed copyright and patent laws in 1790,¹ no subsequent statutory protection for designs was enacted for more than half a century. The first provisions for the protection of new and original designs for a manufacture were included in the Patent Act of 1842,² which also set forth specifically the classes of patentable designs. An amendment enacted in 1902 dropped the 1842 classifications for the general term "article of manufacture" in describing those designs subject to protection.³ Also, the 1902 amendment replaced the term "useful," which had given rise to some confusion, with the term "ornamental."⁴

The statutory design provisions now in effect were enacted as part of the Patent Act of 1952, title 35 of the United States Code. The basic design provision appears in section 171, which provides: "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."⁵ Under section 173, the term of design patent protection is fourteen years.⁶

A. *Design Patentability Determinations Prior to the Patent Act of 1952*

Prior to the Patent Act of 1952, the Patent Office and the courts generally concluded that a design was not patentable simply because it could be distinguished from a prior design. To be patentable a design's creation had to involve an exercise of the inventive faculty.⁷ If, in the judgment of the

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1. Act of Apr. 10, 1790, ch. 7, 1 Stat. 109, *repealed by* Act of July 4, 1836, ch. 357, 5 Stat. 117, 125.

2. Act of Aug. 29, 1842, ch. 263, 5 Stat. 543.

3. *See* Act of May 9, 1902, ch. 783, 32 Stat. 193.

4. *See generally* W. SHOEMAKER, PATENTS FOR DESIGNS (1929).

5. 35 U.S.C. § 171 (1988).

6. *Id.* § 173 (1988).

7. *See, e.g., Ex parte Knothe*, 1903 Dec. Comm'r Pat. 42 (1903).

Patent Office and the courts, a design application claim or a design patent claim did not involve an exercise of the inventive faculty, patentability would be denied or the design patent claim would be invalidated because the claim lacked invention. This rationale was based on the Patent Act of 1902 which, as interpreted by the courts, required that a design be invented in order to be patentable.⁸

Lack of invention was interpreted in various ways by the early courts. In *Knapp v. Will & Baumer Co.*,⁹ the United States Court of Appeals for the Second Circuit concluded that the right to make any article round, square, or in any other standard form or shape, is inherently open to all. Thus, a design claim differing from the prior art merely by changing its shape to a standard form lacked invention.¹⁰ *Northrup v. Adams*¹¹ held that putting molding around the edges or sides of articles might be pleasing in appearance, but was not patentable.¹² In *Collender v. Griffith*,¹³ it was held that a billiard table with bevelled sides and ends lacked invention.¹⁴

Furthermore, prior to 1952, courts differed as to the standard of inventiveness that should be used to determine design patentability. For example, in the case of *Untermeyer v. Freund*,¹⁵ the court stated:

It is impossible to read the literature upon this subject without being convinced that the courts, though applying the same rules, have looked with greater leniency upon design patents than patents for other inventions. . . . A design patent necessarily must relate to subject-matter comparatively trivial. The object of the law is to encourage those who have industry and genius sufficient to originate objects which give pleasure through the sense of sight.¹⁶

Following this same reasoning, the court in *Smith v. Stewart*¹⁷ held: "The invention in a majority of patent designs is very small, and of a low order."¹⁸ On the other hand, in the case of *Cahoone Barnet Manufacturing Co. v. Rubber & Celluloid Harness Co.*,¹⁹ the following statement was made by the court:

[I]t may be taken as settled that, to sustain a design patent, there must be exhibited in the production of the design an exercise of

8. See, e.g., *Mygatt v. M. Schaffer-Flaum Co.*, 191 F. 836 (2d Cir. 1911). See generally W. SYMONS, *THE LAW OF PATENTS FOR DESIGNS* (1914).

9. 273 F. 380 (2d Cir. 1921).

10. *Id.* at 384-85.

11. 18 F. Cas. 374 (C.C.E.D. Mich. 1877) (No. 10,328).

12. *Id.* at 375.

13. 6 F. Cas. 104 (C.C.S.D.N.Y. 1873) (No. 3000).

14. *Id.* at 105.

15. 37 F. 342 (C.C.S.D.N.Y. 1889).

16. *Id.* at 345.

17. 55 F. 481 (C.C.E.D. Pa.), *aff'd*, 58 F. 580 (3d Cir. 1893).

18. *Id.* at 483.

19. 45 F. 582 (C.C.D.N.J. 1891).

the inventive or original faculty as clear and of as high a degree as is called for in patents for inventions or discoveries. In the latter class there must be novelty and utility; in the former, beauty and originality. In both, the final production must have been engendered by the exercise of brain power, and to such an extent that it may be said to be born of genius.²⁰

B. Courts' Frustration with Patentability Determination Prior to the 1952 Patent Act

The Design Patent Act of 1902 required a design to be new, original, and ornamental in order to be patentable.²¹ As indicated above, the requirement that a design be an invention was judicially created. Defining what was an invention proved to be elusive. Nearly a century ago, the Supreme Court, in a ruling on utility subject matter, addressed the difficulty of defining the term "invention" as follows:

The truth is the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that palpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do or do not involve invention; but whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition.²²

This impression of the invention standard resulted in an inconsistent and unpredictable body of law, because it required that the decision of patentability be based ultimately on the subjective whims of a reviewing court.²³

In the 1952 revision of the patent laws, the novelty and ornamentality requirements were maintained and recodified under 35 U.S.C. §§ 102, 171. The retention of these requirements did not, however, completely define the concept of patentability. Missing was the essential quality which goes

20. *Id.* at 585.

21. Act of May 9, 1902, ch. 783, 32 Stat. 193.

22. *McClain v. Ortmyer*, 141 U.S. 419, 427 (1891).

23. In this regard, Judge Giles S. Rich, one of the coauthors of § 103, stated:

In the final analysis, all [the "invention" standard] amounted to was that if the court thought the invention, though new and useful, was not patentable, then it did not involve "invention" and vice versa. The requirement for "invention" was the plaything of the judges who, as they became initiated into its mysteries, delighted to devise and expound their own ideas of what it meant; some very lovely prose resulting.

Rich, *Principles of Patentability*, 28 GEO. WASH. L. REV. 393, 404 (1960).

beyond mere newness and utility for mechanical patents, and newness and ornamentality for design patents—that “*something*” that the courts had unsuccessfully strived for by the use of the term “invention.” In order to promote uniformity in the application of the patent laws, Congress enacted section 103.²⁴ In section 103, Congress replaced the judicially imposed requirement of invention with the requirement of nonobviousness.²⁵

Section 103 received its definitive interpretation in *Graham v. John Deere Co.*²⁶ The *Graham* Court, in calling for “strict observance” of section 103’s requirements, laid out the analysis to be followed in cases involving the obviousness standard:

While the ultimate question of patent validity is one of law, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.²⁷

C. *The Transition Period: Implementation of the 1952 Patent Act*

Between 1952 and 1966, courts generally interpreted section 103 as requiring a display of something more than that required of “a person having ordinary skill in the art to which the subject matter pertains.”²⁸ The decision of *In re Warren*²⁹ stated that for “a design to be inventive [it] must produce a substantially different aesthetic effect . . . which is something more than that of the ordinary artisan or designer.”³⁰ *In re Zemon*³¹ concluded

24. 35 U.S.C. § 103 (1988). Section 103 provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Id.

25. Under the 1952 Act, the word “invention” was statutorily defined as any “invention or discovery.” 35 U.S.C. § 100(a) (1952). Thus, an invention which is novel, original, and ornamental is a patentable invention. A design which is lacking one or more of the criteria is an unpatentable invention.

26. 383 U.S. 1 (1966).

27. *Id.* at 17 (citation omitted).

28. 35 U.S.C. § 103 (1988).

29. 194 F.2d 715 (C.C.P.A. 1952).

30. *Id.* at 717 (citations omitted).

31. 205 F.2d 317 (C.C.P.A. 1953).

that a patentable design "must be the result of an unusual talent, not within the reach of the ordinary artisan or designer."³² In the case of *In re Rouso*,³³ the appellant urged that there was a lower standard of patentability required for design patents than for other patents. The Court of Customs and Patent Appeals (CCPA) in *Rouso*, however, held that it did "not regard appellant's contention as being a correct statement of law."³⁴ The *Rouso* court pointed out that the appellant had overlooked *Nat Lewis Purses, Inc. v. Carole Bags, Inc.*,³⁵ where the Second Circuit had held that "a design patent must be the product of 'invention,' by which we mean[] the same exceptional talent that is required for a mechanical patent."³⁶

That same standard, requiring consideration of what would be obvious to a person of ordinary skill in the art, appears to have been used by the CCPA in holding a design for a treillage patentable in *In re Braun*.³⁷ The *Braun* court stated: "[T]he disclosure of the reference, combined with ordinary ornamental iron work designing skill, would not result in appellant's design as the obvious outcome."³⁸

Decisions in other courts generally were in agreement with the previously noted obviousness standard. That is, a valid design patent must reveal a greater skill than that exercised by the ordinary designer who is charged with knowledge of the prior art.³⁹ The Seventh Circuit in *Amerock Corp. v. Aubrey Hardware Manufacturing, Inc.*⁴⁰ held: "It is settled beyond dispute that '[a] design patent, in order to be valid, must disclose a design that is new, original and ornamental, unanticipated and inventive in character, and beyond the skill of the ordinary designer or draftsman.'"⁴¹ Further, the CCPA in *In re Glavas*⁴² seemed to have impliedly recognized specialization among designers. The *Glavas* court held that a designer of devices useful in one field would not be expected to look in search of design suggestions to devices having remote utility. The *Glavas* opinion stated:

It is evident that a worker seeking ideas for improving the appearance of a device would look first to the similar devices of the prior art for ideas. If his problem were one of designing a float for swimmers, he would not be likely to turn to bottles, soap or razor blade sharpeners for suggestions, as was done by the board here,

32. *Id.* at 318.

33. 222 F.2d 729 (C.C.P.A. 1955).

34. *Id.* at 731.

35. 83 F.2d 475 (2d Cir. 1936).

36. *Rouso*, 222 F.2d at 731 (quoting *Nat Lewis Purses* 83 F.2d at 476).

37. 275 F.2d 738 (C.C.P.A. 1960).

38. *Id.* at 740.

39. *See, e.g.*, *General Time Instruments Corp. v. United States Time Corp.*, 165 F.2d 853 (2d Cir.), *cert. denied*, 334 U.S. 846 (1948).

40. 275 F.2d 346 (7th Cir. 1960).

41. *Id.* at 348 (quoting *Spaulding v. Guardian Light Co.*, 267 F.2d 111, 112 (7th Cir.), *cert. denied*, 361 U.S. 883 (1959)).

42. 230 F.2d 447 (C.C.P.A. 1956).

and accordingly the presence in any of the last-named devices of some particular element of configuration would not normally suggest the adaptation of that element to a float.⁴³

D. The Patentability Standard of In re Laverne

In *In re Laverne*,⁴⁴ the CCPA gave an interpretation of the requirements of section 103 as applied to design applications and patents which differed significantly from previous court decisions rendered after the 1952 Patent Act. The *Laverne* court, in reaching its conclusion as to the proper standard for determining design patentability under section 103, put forth the following:

What is "the art to which the subject matter pertains" in this case? Is it the molded chair "art" or is it the ornamental design "art"? In what field is the "inventor" of the design operating? Since those who create designs are designers, not chair makers, it would seem to follow that he is operating in the field of industrial design and that it is the "art" involved.

. . . .

In the field of design, the analysis is not so easy. Design inventing or originating is done by designers. The examiner here has referred to "the expected skill of a competent designer" as the basis of comparison. However, if we equate him with the class of mechanics, as the examiner did, and refuse design patent protection to his usual work product, are we not ruling out, as a practical matter, all patent protection for ornamental designs for articles of manufacture? Yet the clear purpose of the design patent law is to promote progress in the "art" of industrial design and who is going to produce that progress if it is not the class of "competent designers?"

. . . .

Following the mandate of section 103, it would seem that what we have to do *is to determine obviousness to the ordinary intelligent man*. The test is inherently a visual test, for the design is nothing more than appearance, and the appearance is that of the article as a whole. No special skill is required to determine what things look like, though individuals react differently. It is bound to be an individual reaction.⁴⁵

Laverne's new standard of "obviousness to the ordinary intelligent man" was intended to replace the previous court rulings which had required nonobviousness to be based on the ordinary designer standard. This new

43. *Id.* at 451.

44. 356 F.2d 1003 (C.C.P.A. 1966).

45. *Id.* at 1005-06 (emphasis added) (citation and footnote omitted).

standard, however, ignored the Supreme Court's *Graham v. John Deere Co.*⁴⁶ analysis, which had set forth the conditions to be followed in cases involving the obviousness standard.

E. Reaction of Federal Courts to the Nonobviousness Standard

Between 1966 and 1981, the federal courts did not agree as to which standard should be used in determining nonobviousness in design cases. Addressing this issue, the Tenth Circuit in *Sidewinder Marine, Inc. v. Starbuck Kustom Boats & Products, Inc.*⁴⁷ reviewed the findings and conclusions of the trial court which had "noted the division among the circuits on the application of the nonobviousness test in the area of design patents."⁴⁸ The Ninth Circuit had adopted the view of the CCPA, that under section 103, it is only necessary "to determine obviousness to the ordinary intelligent man." On the other hand, the Second, Third, Sixth, Eighth and District of Columbia Circuits disagreed and required that nonobviousness be measured from the perspective of a designer having ordinary skill in the art. The trial court agreed with the latter position.⁴⁹

The plaintiff in *Sidewinder* contended that the trial court had erred in assessing the obviousness issue from the perspective of an ordinary designer rather than an ordinary, intelligent man. The Tenth Circuit thus addressed the issue of which standard should apply to the nonobviousness requirement in design cases. The court set forth the following:

We are persuaded that the proper standard is that of the "ordinary designer" in the field in question. Not only does this standard hew more closely to the statutory wording in § 103, but . . . it serves as a "more objective reference point" concerning obviousness than the "ordinary observer" standard. If the latter standard were adopted, as again pointed out in *Fields*, commercial success of the design among the mass of "ordinary" consumers would be a "virtually conclusive determinant" of non-obviousness, rather than the secondary consideration it is supposed to be under the rule of *Graham v. John Deere Co.*

In sum, we cannot agree with plaintiff *Sidewinder* that the proper standard is that of the ordinary intelligent man. We feel instead that the standard to apply is that of an ordinary designer in the sport and pleasure boat field.⁵⁰

46. 383 U.S. 1 (1966).

47. 597 F.2d 201 (10th Cir. 1979).

48. *Id.* at 204.

49. *Id.* at 208.

50. *Id.* at 208-09 (citations and footnotes omitted).

F. Resolving the Nonobviousness Standard Dispute

In view of the controversy in the federal courts, the CCPA decided to set a single standard for the federal courts and the Patent and Trademark Office to follow.⁵¹ In *In re Nalbandian*,⁵² the CCPA addressed this issue as follows:

We believe it is appropriate to close this schism. Accordingly, with this case we hold that the test of *Laverne* will no longer be followed. In design cases we will consider the fictitious person identified in § 103 as "one of ordinary skill in the art" to be the designer of ordinary capability who designs articles of the type presented in the application. This approach is consistent with *Graham v. John Deere Co.*, which requires that the level of *ordinary skill in the pertinent art be determined*.

. . . .

It is apparent the "ordinary designer" standard has been found helpful to courts in infringement litigation because of the objective evidence which can be brought to bear on the question of obviousness under the tests of *Graham*. We believe it also can be more effectively dealt with by an applicant during patent prosecution than can the "ordinary observer" test. For example, where an examiner selects features from various designs, or relies on common knowledge in the art, the possibility is present of submitting an affidavit from an expert in whose opinion, subjective though it may be, it would not have been obvious to an ordinary designer, despite knowledge (or imputed knowledge) of the prior art to combine features or make modifications as shown in an applicant's design. This possibility is not present using the "ordinary observer" test. No affiant can be qualified as an expert ordinary observer who might, thereby, persuade the person who is deciding the matter that the latter's judgment of the reaction of an ordinary observer is in error.

Rejection of the "ordinary observer" test under 35 U.S.C. § 103 does not preclude its application in other contexts. The "ordinary observer" test was applied in determining whether a claim to a design had been infringed as long ago as *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871). Further, the "ordinary observer" test has been applied when determining anticipation under § 102 by courts which apply the "ordinary designer" test under § 103.⁵³

51. See PATENT AND TRADEMARK OFFICE, *MANUAL OF PATENT EXAMINING PROCEDURE* § 1500 (5th ed. 1983) (providing guidelines for the application of § 103 in the examination of design patent applications).

52. 661 F.2d 1214 (C.C.P.A. 1981).

53. *Id.* at 1216-17 (emphasis in original) (citations omitted).

The CCPA provided further guidance in the application of section 103 to design cases in the case of *In re Rosen*.⁵⁴ The *Rosen* court stated:

While a § 103 rejection of a claimed design need not be based on a single reference, the long-standing test for the proper combination of references has been "whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other. . . ."

Thus, there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.⁵⁵

Presently, the federal courts and the Patent and Trademark Office are following the guidelines set forth by the CCPA in the *Nalbandian* and *Rosen* decisions.

III. CONCLUSION

The Court of Appeals for the Federal Circuit and its predecessor, the CCPA, have interpreted federal patent law and established workable standards for the district courts and the Patent and Trademark Office to follow. Both district courts⁵⁶ and the Patent and Trademark Office are presently attempting to uniformly interpret section 103 in the determination of design patentability. Design patent examiners must include in all section 103 rejections a statement of the rationale as to why the proposed modification or combination of the applied references would have been obvious. Finally, it seems clear that if the CCPA had not overruled the ordinary, intelligent man standard, design patent examiners would have found considerable difficulty in complying with the Patent and Trademark Office policy concerning section 103.

54. 673 F.2d 388 (C.C.P.A. 1982).

55. *Id.* at 390-91 (citations omitted).

56. *See, e.g., Whittar Indus., Ltd. v. Superior Indus. Int'l Inc.*, 230 U.S.P.Q. (BNA) 68, 69 (C.D. Cal. 1986).