



1989

A Designer as an Expert Witness

Roland Carter

American Society of Furniture Designers

Follow this and additional works at: <http://scholarworks.law.ubalt.edu/ubl>



Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Carter, Roland (1989) "A Designer as an Expert Witness," *University of Baltimore Law Review*: Vol. 19: Iss. 1, Article 27.

Available at: <http://scholarworks.law.ubalt.edu/ubl/vol19/iss1/27>

This Article is brought to you for free and open access by ScholarWorks@University of Baltimore School of Law. It has been accepted for inclusion in University of Baltimore Law Review by an authorized administrator of ScholarWorks@University of Baltimore School of Law. For more information, please contact snolan@ubalt.edu.

A DESIGNER AS AN EXPERT WITNESS*

Roland Carter†

This is my account of a design patent suit in which I participated as an expert witness. The names of the people and companies involved will not be used because any one of you might have been one of the parties, if you had enough money and time to go through the process. I will call the companies A, X, Y and Z. Where possible, I will avoid legal terms and what legal terms I use, I will define to the best of my understanding. My definitions may or may not be correct to a lawyer, so I beg your indulgence on that score.

My first involvement with this matter was a phone call from a lawyer representing company X and, indirectly, companies Y and Z. He asked if I would be interested in being an expert witness in a design patent suit. Briefly, he said that companies X, Y and Z were suing company A to prove that a design patent held by company A was invalid. I said that if he could show me a picture of the patented design, I could immediately tell him whether or not I considered the design to be patentable.

We met at a hotel in Lynchburg, Virginia, where I live, and he showed me pictures of the patented design, along with pictures of very similar furniture made by several other companies, including companies X, Y and Z. The items included a sofa, love seat and lounge chair, all of the same design, with a "country casual" look. Each piece of furniture had a skirted base, and the most distinguishing features consisted of exposed wood along the top of the back, going down toward the arms and some upholstering details in the back. Although I am uncertain whether I saw the patented design alone or in comparison with others, it was apparent that company A's design was not worthy of a patent.

Some time later, I was invited to go to Chicago to meet with the three lawyers representing companies X, Y and Z. Each company had its own law firm and the three were working as a team on the case. We went over all the pictures again and I was given a complete history of the case to that point. Apparently I passed muster, for we agreed that I would be their witness as an expert in the field of furniture design.

I was invited to give a deposition in the office of the lawyer for company A. The expert witness for company A and the lawyers for all four companies were present. The witness for company A testified first, so I had the benefit of seeing the process before I had to go through it. Obviously, there were opposing views expressed, but all was most polite and we

* This speech was delivered at the National Conference on Industrial Design Law and Practice at the University of Baltimore School of Law, March 10 and 11, 1989.

† Certificate, 1951, Pratt Institute, Industrial Design Department. Former president of the American Society of Furniture Designers. Roland Carter is an industrial designer who specializes in the home furnishings field, and is an experienced expert witness in design patent law.

seemed like old friends gathered for a lengthy and expensive discussion of a subject of mutual interest.

At this point, a history of the patented design and the ensuing lawsuit is in order. Two representatives of company A had gone to a furniture show in Europe where they saw a sofa, love seat and chair that they thought had potential for the American market. They studied the design and photographed the furniture. Upon their return to the United States, they asked their company designer to develop a version of the design they had seen. At first, they could only give a verbal description of the design, and the designer struggled for several days without success. After a time, the photographs were processed and prints were given to the designer to assist him in his assignment. The very next day, he produced a sketch which was immediately accepted. After some minor revisions, the furniture was introduced at a High Point, North Carolina market and was quite successful. Upon seeing the success of this design, a number of companies (eighteen in all, at one point), including companies X, Y and Z, introduced their versions of the design.

Company A then decided to get a design patent. After applying for the patent, company A advised all other companies producing a version of the design that a design patent was pending. As a result of this warning, all of those companies, except X, Y and Z, stopped the manufacture and sale of the offending designs. When company A realized that X, Y and Z were not complying with its request, it filed a "petition to make special."

A petition to make special is filed when a patent application has been submitted and the applicant has reason to believe his design has been copied and sold by others. In this petition, the applicant asks the Patent Office to pull the application and process it immediately so that further infringement may be prevented. A requirement of filing this petition is that the applicant must supply the Patent Office with all known prior art, any material which the designer used as inspiration, as well as any previously patented designs which look like or have features similar to the pending design patent. Company A's lawyer had a specialist search the design patent files for any such previous patents and attached several to the petition. These patents had elements of the applicant's design, such as exposed wood, but were not sufficiently similar to deny patentability. The lawyer, however, did not submit the photographs taken in Europe as prior art. (Later at the trial, there was much discussion as to whether or not the lawyer knew of these photographs at the time of the petition to make special.) The Patent Office issued a design patent to company A's designer, who signed all rights to the patent over to his employer.

Company A then notified companies X, Y and Z that the patent had been issued and threatened to bring suit to enforce its rights under the patent. Companies X, Y and Z would not agree to company A's demands and, in turn, joined together to sue company A over the patent's validity.

That is the bare outline of the case as I knew it at the time of my depo-

sition. I did not learn until much later that companies X, Y and Z had offered to settle out of court without giving up the right to manufacture the design in question. I do not know when this was done or what terms were offered, but company A refused, and the matter proceeded to trial.

So, in the fall of 1987, all of the interested parties assembled in a rather picturesque small town. Attending the trial were four lawyers, two legal assistants, several expert witnesses, a representative from each of the four companies, a couple of lawyers' wives, a fair sized truckload of paper exhibits, and samples of five sofas. The case was tried in a federal court without a jury.

For anyone fortunate (or unfortunate) enough to attend a trial like this, it is memorable. The courtroom atmosphere was hushed, the judge's presence was sobering, and the lawyers' careful presentations impressive, especially their attempt to reduce everything to concise language. As a visual person, I found this aspect at the time to be the most disconcerting. Somewhere in my art education I picked up the idea that any visual work that could be translated into words could not have really been a visual work in the first place. Nevertheless, in order to judge visual matters under the rules of law, lawyers must inevitably plunge into this thankless job.

The trial opened with testimony of an employee of company A. The employee said that he took the pictures in Europe which later became the inspiration for the patented design. Company A's designer then described how he created the design. Many other witnesses from various companies testified about different aspects of the case. The climax of the trial for me, at least, came with the testimony of the lawyer who had handled company A's patent application. This was not the same lawyer who was handling company A's case in the trial. This lawyer described his steps in the patent application and in the petition to make special. His testimony confirmed that he had not asked for any prior art from the designer or from anyone else in company A, and that he had not submitted the photographs of the European furniture. His reasoning was that company A had been issued design patents before, and therefore, he assumed that it knew about the requirement to submit prior art. Company A's designer had previously testified that the lawyer had not asked him face-to-face, by phone or by letter for any prior art. In my opinion, this testimony was the most damaging to company A's defense. It certainly was the most dramatic moment of the week-long trial—the judge twice had to bang his gavel to emphasize his order that the lawyer answer the questions directly.

I would like to say that my participation was crucial to the victory for companies X, Y and Z, but that was not the case. Although the patent was ultimately declared invalid and companies X, Y and Z won their suits, I suspect this result was in spite of rather than because of my testimony. At one point during my testimony, I ran afoul of the word "obvious." I cannot recall all of my exchange with company A's lawyer about this word, but I do remember one particular passage. I contended that a furniture designer of

average ability and experience, given the pictures from Europe, would be able to produce the design eventually patented. It was simply a matter of making obvious revisions—longer and deeper seating, adding the skirted base, and making some accommodations to mass production. Company A's lawyer then asked if the photographs had crossed my desk, would it have been so "obvious" that I would have immediately designed the patented furniture. Under those circumstances such a project would not have been interesting, but had I been company A's designer, I would have had no choice but to develop the design as part of my job. Having done that, however, I certainly would not have signed an application for a design patent. Company A's lawyer then contended that if I would not have drawn the design in question without the pressure of an immediate assignment, then it was not obvious. I still do not know what the lawyer meant by the word "obvious."

Based on past experience with design patents, I feel that the communication between patent lawyers and designers is insufficient. During my career, I have been awarded many design patents. I applied for these only at the request of the companies for whom I designed, and I assigned the patent rights to those companies; my involvement was never more than signing applications and assignments. Now here is the frightening thing. At no time did any of the several lawyers who handled these applications communicate with me face-to-face, by phone, or by mail. They never asked for prior art and never informed me of my obligations in signing those applications. Until I served as an expert witness, I had never met a patent attorney, even socially. What little I know about the responsibilities involved in making a patent application I learned as a result of the trial. For the final irony, company A's expert witness in patent law was one of the lawyers who had handled more than one of my patent applications!

I have tried to put this experience into perspective and draw some conclusions. (Now there is a statement by a visual person.) So long as we try to protect design under a system of design patents, the standards for issuing those patents should be the very highest. A patentable design should be truly novel in form, function, and/or material; it should break new ground and add to the vocabulary of design. In furniture, for instance, a dresser with six drawers should not be patentable no matter how ingeniously the drawers are decorated, if that is all there is to the design. A couple of my patents fall into this category. Mere variations on existing designs should not be patentable. From this point of view, company A's design clearly did not qualify and justice was served when the patent was declared invalid.

It is necessary, however, to look at this problem from a point of view closer to the real world. Company A did nothing unusual in going to Europe and adapting a design so that it would be marketable in the United States. That is frequently done by almost everyone in the furniture business who can afford the trip. The European furniture would not have sold here, nor would company A's furniture have sold in Europe. Thus, company A did no real harm with its adaptation. Companies X, Y and Z and the others,

however, went no further than North Carolina for their inspiration, and their adaptations possibly did harm company A. At this level of everyday commercial furniture designing, it can be argued that company A did deserve some protection.

This trial demonstrates that design protection needs a thorough overhaul. First, the criteria for design protection must include those designs which are not patentable under our present system. This includes most furniture being designed today. Second, the costs of the system must be reduced. Hundreds of companies that produce innovative designs will not even apply for patents because they know they cannot afford the expenses involved in defending those patents.

Thus, designs must be able to be protected by a simple, low cost registration process. Once registered, there must also be a simple, low cost method of defending a design. This can only be accomplished outside our court system, because of the system's high costs. Some kind of arbitration seems a likely solution, with legal action only as a last resort. Simpler, more effective design protection will have far-reaching results because people will be willing to put more time, effort and money into more innovative products.