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THE GLASS SLIPPER APPROACH
TO PROTECTING INDUSTRIAL DESIGNS

OR
WHEN THE SHOE FITS, WEAR IT

Perry J. Saidman†

Since I am the only patent lawyer on this opening panel, I think it is my
duty to point out some of the virtues of patents for industrial designs, which
are commonly referred to as "design patents." However, I want to assure
you that my high regard for design patents did not come easily. I was
among the nonbelievers several years ago when the opportunity to enforce a
client's design rights first presented itself to me. It was a unique challenge
because, like most patent lawyers, I had spent most of my career obtaining
and enforcing utility patents. Just so we can get this straight at the outset,
for those of you who may be unfamiliar with the jargon, utility patents are
the most popular form of patents in the United States and are what most
people think of when they think of a patent. Utility patents cover lasers,
computers, instant cameras, and all sorts of structural and functional tech­
nology. In contrast, a design patent protects the ornamental appearance of
a product without regard to how it works.

Several years ago, like many other patent lawyers, I considered recom­
mending a design patent to a client only when a utility patent was not avail­
able. Nobody spent any time teaching us about design patents in law school.
No great law review articles were written about design patents. Yale Law
School Professor Ralph Brown, who is on today's panel, wrote a sixty-four
page article on design protection in 1987. In fact, his article was cited by
the Supreme Court in Bonito Boats, Inc. v. Thunder Craft Boats, Inc. However,
only three pages of his article were addressed to design patents. The
rest were devoted to copyright and trade dress law, which are the other
two ways of protecting designs. In addition, the Supreme Court has not
adjudicated a design patent case in almost 100 years.

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GROUP.
1. Utility patents are granted for any "new and useful process, machine, manufacture, or
combination of matter, or any new and useful improvement thereof," 35 U.S.C. § 101
(1988); providing the invention meets the requirements under the patent laws. 35
5. Brown, supra note 3, at 1355-57.
6. Id. at 1344-55.
7. Id. at 1357-86.
8. In the late 1800s, the Supreme Court heard three cases dealing with design patents.
See Dunlap v. Schofield, 152 U.S. 244 (1894); Smith v. Whitman Saddle Co., 148 U.S.
674 (1893); Gorham Co. v. White, 81 U.S. (14 Wall.) 511 (1871). Since that time, the
Supreme Court has not adjudicated a case dealing primarily with a design patent issue.
Design patents were not understood well by the chemists, electronics engineers, physicists, and mechanical and industrial engineers who formed the bulk of patent attorneys. After all, their primary interests were in technology and utility patents. There were few court decisions on design patents and many judges professed a lack of understanding in evaluating design patents. Several statistical analyses on design patents cited high failure rates in court. For example, one article said that seven of every ten design patents were held invalid from 1964 to 1983.9 Professor Brown, in the three pages of his article that were devoted to design patents, professed he could not provide an explanation for the high failure rate. After listing the virtues of design patents, the good professor said, "Yet, despite these seeming credentials, design patent remains a Cinderella who never goes to the ball."10 Well Cinderella, my name is Prince Charming, and do I have a glass slipper for you!

Let me share with you how I got into the glass slipper business. As I sat down several years ago and tried to pick out one form of protection for my client's ornamental design, the options were only three. I therefore visited with Cinderella, the design patent, and her two step-sisters, trade dress and copyright. Now, copyright was beautiful; in fact, you could say she was a work of art. Trade dress was also very appealing; you should have seen her dress. But after I scraped away the soot and cinders caked on by years of neglect, Cinderella the design patent turned out to be the loveliest of all. Yes, I fell in love with Cinderella and felt that it was high time to bring this black sheep of the family out of the closet and into the open where others could appreciate her beauty.

It is my view that in most instances a design patent is the preferred mode of protection in the United States for the appearance of a consumer product. Having said that, let me assure you that this conclusion is not based on emotion alone. It is based on logic, facts, and legal analysis. There are, however, certain situations in which trade dress protection would be preferred, and there are instances, albeit fewer, where copyright protection is preferable. Now, this presentation cannot encompass an exhaustive analysis of the comparative virtues of design patents, trade dress, and copyright in the limited time given to me this morning. We have heard and will hear much more about these three sisters as the conference progresses. It is also likely that we will hear from others who do not share my view of Cinderella's beauty. But now, it is my turn to state the case for design patents, and I will leave it for you to judge whether I am speaking of a fairy tale or of a fable that has a moral to it.

I am going to begin by first discussing the pros and cons of copyright protection for industrial designs. Then I will do a similar analysis for trade dress protection. Finally, I will discuss the advantages and disadvantages of design patent protection.

First there is sister copyright. The advantages of copyright are that it is quick (you get protection upon creation) and inexpensive, and it lasts a long time. In addition, federal courts are quite accustomed to copyright litigation, although there is no central court of appeals to resolve disputes that may arise from different lower court interpretations. Another advantage is that the United States has just entered into a treaty known as the Berne Convention for the Protection of Literary and Artistic Works which does not require copyright notice on the product in order for copyright protection to begin. Some disadvantages of copyright are that damages awards are generally less in copyright cases than in patent cases, and the copyright owner has the burden of proving that the defendant copied the protected design.

A major problem with copyright protection is the separability requirement. As a practical matter, this requirement restricts copyright

11. A copyright is created in any original work of authorship when it is first “fixed in any tangible medium of expression.” 17 U.S.C. § 102(a) (1988). “A work is ‘fixed’ in a tangible medium of expression when its embodiment . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” Id. § 101.

12. An initial application for copyright registration can be made for as little as ten dollars. Id. § 708(a)(1).

13. The duration of a copyright can continue for the life of the author plus fifty years after the author's death. Id. § 302(a). Specific rules apply to copyright duration depending upon the status of the author(s) and the date when the work is created. See id. §§ 302-305.

14. Federal copyright laws have an origin in our Constitution which states: “The Congress shall have Power . . . (t)o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Const. art. I, § 8, cl. 8. Copyright law has evolved from both statutory and common law origins. See generally 1 M. Nimmer & D. Nimmer, Nimmer on Copyright § 1.01 (1990).


16. The lack of any requirement of notice is based in the Berne Convention's language that “the enjoyment and the exercise of [copyright] shall not be subject to any formality” between participating countries. Berne Convention, supra note 15, at art. 5(2).


19. The separability requirement requires the design of an article to be separate from any functional considerations before it is capable of copyright protection. As a result, copyright protection is not available for any design that cannot exist separate from its function. 17 U.S.C. § 101 (1988); see e.g., Esquire, Inc. v. Ringer, 591 F.2d 796, 803 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979); Carol Barnhart, Inc. v. Economy
protection to product designs that are more like a work of art than a consumer product. While many courts interpret and apply the separability requirement in different ways, I am going to tell you what the Court of Appeals for the Second Circuit held in a recent case involving the famous RIBBON bicycle rack. The case is *Brandir International, Inc. v. Cascade Pacific Lumber Co.* The RIBBON rack, which won an award in 1980 from the Industrial Designers Society of America for its striking design, was inspired from a wire sculpture. The court applied the "conceptual separability" test which states that an industrial design is protectable by copyright only when the design is conceptually separable from its utilitarian aspects. A design is not conceptually separable from its utilitarian aspects, the court said, if the form and function of the article are intertwined. This clearly does not square with the real world of industrial design, where form and function are ideally blended during the design process, and the court knew this. In deciding that the RIBBON rack was not a proper subject for a copyright, the court said:

Judging from the awards the rack has received, it would seem in fact that Brandir has achieved with the RIBBON Rack the highest goal of modern industrial design, that is, the harmonious fusion of function and aesthetics. Thus there remains no artistic element of the RIBBON Rack that can be identified as separate and is "capable of existing independently, of, the utilitarian aspects of the article."23

The result of the holding in *Brandir* is that our copyright maiden looks more and more like one of Cinderella's lazy sisters, or perhaps an artsy sister, who went to the ball first, but whom very few have asked to dance. We will see that our beauty Cinderella, the design patent, does not suffer from this flaw.

Now I will briefly discuss the pros and cons of trade dress law. Trade dress law is a branch of trademark law. Trade dress includes the following characteristics of a product: color or combination of colors, size, shape, texture, weight, and graphics.24 The area where trade dress protection is very valuable is where the product design or trade dress is so distinctive that the public has come to associate the features of the design with a particular source for the product. Generally, this kind of distinctiveness requires long and widespread use of the product. This, of course, cannot happen overnight.

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Cover Corp., 773 F.2d 411, 418 (2d Cir. 1985); see also 1 M. Nimmer & D. Nimmer, *supra* note 14. § 2.08[B].
20. 834 F.2d 1142 (2d Cir. 1987).
21. Id. at 1144.
22. Id.
23. Id. at 1147-48.
One major advantage of trade dress protection is that registration of the trade dress is not necessary to obtain relief in court. Another advantage is that courts are very accustomed to litigation involving trade dress and trademarks. Courts are familiar with the subject matter and have developed an expertise in trademark principles. Since trademark law is based on avoiding consumer confusion, it is a very appealing type of case to try before judges and juries. Another advantage is that the test for trade dress infringement is quite broad. The trade dress owner need only prove that the infringing product is likely to create confusion in the marketplace as to the source or origin of the product.

One of the disadvantages of trade dress protection is the requirement in a majority of courts of proving secondary meaning. Secondary meaning is a doctrine which says that through long and continuous use of the trade dress in the marketplace, the user has created a secondary meaning in addition to the primary meaning of the product. The secondary meaning occurs when a consumer looks at the product and, in addition to knowing what kind of product it is, associates a particular source with that product so as to enable her to distinguish that product source from another.

A good example of secondary meaning is the Mogen David wine bottle which, when first introduced, was just another different wine bottle. Through long and extensive use and advertising, the shape of the bottle became known to consumers as belonging to Mogen David. Thus, over time it acquired the distinctiveness necessary to give it valuable trade dress protection against other bottles which would likely cause confusion. This acquired distinctiveness is known as secondary meaning. Do you remember the RIBBON bicycle rack? Although Brandir lost on the copyright claim, the court reversed the summary judgment against Brandir and remanded the case to enable Brandir to make a case for secondary

26. The general federal law regarding trademarks has been focused and refined since the passing of the Trademark Act of 1946 (the Lanham Act). 15 U.S.C. §§ 1051-1127 (1988). In addition to the federal statute, many states have their own trademark statutes including antidilution statutes. See generally United States Trademark Ass'n, State Trademark and Unfair Competition Law (1988).
27. Nonexperts can assume the role of the consumer and obtain a sense of whether or not two products are confusingly similar. The question of likelihood of confusion is, however, a mixed question of fact and law. See Banff, Ltd. v. Federated Dep't Stores, Inc., 841 F.2d 486, 489 (2d Cir. 1988).
30. Id. McCARTHY, supra note 24, § 8:2.
meaning. Although it is very valuable when you have it, secondary meaning takes time to develop and a lot of money to prove. In addition, it may not be available for the first few years the product is being sold, which can be the most critical years for protecting the product, especially when the product life is short.

Another disadvantage of trade dress protection is that it does not necessarily protect or reward the originator of the design. Trade dress protection is directed toward protecting the user and promoter of the design, who is not necessarily the original designer. If the product is not protected by a patent, and has not achieved protectable trade dress status, anyone can copy it from the original designer without liability. This would not be possible under patent law because only the original and first designer can obtain the design patent.

Another disadvantage of trade dress is the federal courts' inconsistent application of trade dress principles. This has created a situation similar to the one that existed in the patent area ten years ago. The circuit courts of appeals have appellate jurisdiction over trade dress cases and each circuit may apply different trade dress principles. In addition, the Supreme Court rarely accepts a trade dress case to resolve conflict between the circuits. Right now, as a good example, the rules on secondary meaning differ from circuit to circuit. Thus, it is very difficult to advise your client, who is a national distributor of unique products, whether its trade dress has achieved protectable status. Factors include where the infringement occurs, where suit is brought, and where the case is eventually heard. Thus, trade dress is another one of Cinderella's sisters, who is probably not as lazy as copyright.

36. Federal district courts have original jurisdiction over "any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks." 28 U.S.C. § 1338(a) (1988); see T. B. Harms Co. v. Eliscu, 339 F.2d 823 (2d Cir. 1964) (discussing the principles for determining whether an action arises under the intellectual property statutes), cert. denied, 381 U.S. 915 (1965). Most trade dress claims are grounded in § 43(a) of the Lanham Act and, therefore, are subject to federal jurisdiction. The United States Courts of Appeals have jurisdiction to hear all appeals from final decisions made in the district courts. 28 U.S.C. § 1291 (1988).
37. The most recent Supreme Court case addressing a dispute which involved a trade dress matter was Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844 (1982).
38. See, e.g., Vaughan Mfg. Co. v. Brikam Int'l, Inc., 814 F.2d 346, 348-49 (7th Cir. 1987) (secondary meaning must be shown where the trade dress is not inherently distinctive); Vuitton et Fils S.A. v. J. Young Enters., Inc., 644 F.2d 769, 772 (9th Cir. 1981) (trade dress must be shown to be nonfunctional and have secondary meaning to be protectable); Le Sportsac, Inc. v. K Mart Corp., 754 F.2d 71, 78 (2d Cir. 1985) (conclusive evidence of secondary meaning not required).
Trade dress is already at the ball and already has had quite a few dances because of her pretty dress.

As I said, ten years ago the same situation was true for patent cases.\footnote{39} One of the major requirements in getting a patent is that the invention must not have been obvious in view of everything that has been done before.\footnote{40} Ten years ago, each of the circuit courts of appeals was applying different rules on the issue of obviousness. The cases were in total disarray and much money was spent on jockeying where a case was going to be heard rather than on the merits of the case itself.\footnote{41} Invalidity rates for utility patents ranged from 60\% to 100\%.\footnote{42} To resolve these differences and improve the use of the patent system to protect technology, Congress created the United States Court of Appeals for the Federal Circuit on October 1, 1982, giving it exclusive nationwide jurisdiction over all patent cases.\footnote{43}

What has happened during the last six and one-half years is nothing short of a miracle. The Federal Circuit has created entirely new respect for the patent system and for patents. The desired uniformity and predictability in the patent law\footnote{44} has finally come about. Now I am able to advise clients on the law on obviousness, irrespective of where the infringement occurs or which judge in which court might hear the case. Slowly but surely, the Federal Circuit is coming to grips with the many complex issues in patent law and is building up a storehouse of precedent according to which businessmen will be able to guide their actions for years to come.

To get back to our Cinderella story, the creation of the Federal Circuit is quite analogous to turning the pumpkin of patent law into a magnificent legal coach for taking our design patent beauty, Cinderella, to the ball. The unique thing about this state of the art legal coach is that the coach is big enough, and strong enough, to take design patents along for the ride with our old friend, the utility patent.

In a very real sense, the creation of our elegant coach, the Court of

\footnote{39. Before the creation of the Court of Appeals for the Federal Circuit, patent litigation success varied from circuit to circuit. The specific purpose of the Federal Circuit was to "reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist in the administration of patent law." H.R. REP. No. 312, 97th Cong., 1st Sess. at 23 (1981); see Atari, Inc. v. JS & A Group, Inc., 747 F.2d 1422, 1432 (Fed. Cir. 1984).
\footnote{41. For many interesting commentaries on the nonobvious standards applied by the courts in the 1970s and earlier, see NONOBVIOUSNESS—THE ULTIMATE CONDITION OF PATENTABILITY (J. Witherspoon ed. 1980) (papers compiled in commemoration of the silver anniversary of 35 U.S.C. § 103).
\footnote{42. See generally KAYTON, THE CRISIS OF LAW IN PATENTS (1970).
\footnote{44. For a discussion of the early concerns about the Federal Circuit, see Note, An Appraisal of the Court of Appeals for the Federal Circuit, 57 S. CAL. L. REV. 301 (1984).}
Appeals for the Federal Circuit, has resulted in a renaissance in the patent system.\(^{45}\) The exceeding popularity of obtaining and enforcing utility patents has resulted in utility patents bootstrapping design patents because patent legislation applies to both types of patents.\(^{46}\) That, my friends, is one very good reason for taking a long and hard look at design patents.

There is a definite time lag between the flowering of utility patents and the flowering of design patents. In other words, Cinderella is not yet accepted in all the best places. Why? Well, we all know that discrimination dies hard. It also makes sense in view of the fact that just over 300,000 design patents have been granted in the United States, while the number of utility patents granted approaches 5,000,000. I think it is fair to say that if utility patents are obtained over ten times more frequently than design patents, then they are also litigated in approximately those proportions. As a result, the case law, the general mystique surrounding design patents, and the user sophistication of the design patent system all lag behind that of utility patents. However, as I will note, these things are changing fast due to the presence of a particular section in the patent law (35 U.S.C. § 171) which says that the provisions of this law relating to utility patents shall apply equally to design patents.\(^{47}\) This means that all the great strides made by the Federal Circuit in cases concerning utility patents, also apply to design patents. Thus, the use of design patents is bound to become more predictable and reliable, which are the two main reasons for the establishment of the Federal Circuit in the first place.

Design patents cover designs on many different types of articles\(^{48}\) such as buildings, lawn chairs, truck fenders, work desks, espresso makers, icons, fabrics, and car parts like starter adapters. Examples of design patents are shown below:

\[\text{References:}\]


\(^{46}\) The federal patent laws specify that all law relating to utility patents “shall apply to patents for designs.” 35 U.S.C. § 171 (1988). As a result, the development of patent law doctrines from utility patent litigation directly applies to design patents.

\(^{47}\) Id; see also Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1440 (Fed. Cir. 1984); R. M. Palmer Co. v. Luden's, Inc., 236 F.2d 496, 498 n.3 (3d Cir. 1956).

\(^{48}\) An inventor may apply for a design patent to protect “any new, original and ornamental design for an article of manufacture” under the statute. 35 U.S.C. § 171 (1988). The design itself is defined as the appearance created by the configuration and/or the surface ornamentation of the article. Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 525-28 (1871); see also I D. CHISUM, PATENTS § 1.04[2][a] (1990).
Building

Adjustable Armchair

Worktable or Similar Article
Coffee Making Machine

Truck Fender

Icon for Voice File or the Like
Design patents can cover the shape or configuration of a product, the surface decoration on a product, or a combination of shape and surface decoration. One major advantage is that a design patent is available without having to meet the copyright separability test and the trade dress secondary meaning test. Design patent laws are very protective of the designer; only the designer can legally apply for a design patent. A true designer or a codesigner is one who conceives or contributes to the conception of the design elements of the product.

Another advantage of design patents over both trade dress and copyright protection is that it is very easy to obtain a design patent on a single element or portion of a design, as shown in the following examples. As long as the element itself meets the statutory tests of novelty, nonobviousness, and ornamentality, a design patent can be validly granted.

49. Gorham, 81 U.S. (14 Wall.) at 525 ("The appearance may be the result of peculiarity of configuration, or of ornament alone or of both conjointly. . . . ").


52. In 1980, the Court of Customs and Patent Appeals (predecessor to the Court of Appeals for the Federal Circuit) held that design patents are possible for protection of part of an article's overall design. In re Zahn, 617 F.2d 261 (C.C.P.A. 1980).

We have already discussed the general advantage provided by our elegant legal coach, the Court of Appeals for the Federal Circuit. Here are some specific examples which apply to both design and utility patents.

A design patent, once issued, is presumed valid by law. This means that someone who is accused of infringement has a very high burden to prove that the design patent was improperly granted. Another advantage is the ability of the patent owner to stop the accused infringer during the early stages of the lawsuit by obtaining a preliminary injunction. A preliminary injunction is an order issued by the judge which requires the infringer to immediately cease and desist from further manufacture, use or sale of the infringing product. If one has a good case of infringement, one will more likely than not get the injunction.

It is also significant that the Federal Circuit is often reluctant to postpone an injunction pending the outcome of an appeal. One good example is Polaroid Corp. v. Eastman Kodak Co., where Kodak failed to obtain a delay of the injunction granted to Polaroid pending Kodak’s appeal to the Federal Circuit. This put Kodak out of the instant camera business long before its appeal was decided. Thus, the ability to obtain an injunction, and have it stick, gives the design patent holder enormous leverage against a would-be infringer.

Turning to the area of damages, there is a special damage provision in the patent law which says, uniquely, that the owner of a design patent is entitled to the total profits of the infringer. Even in a case where the design patent covers only one small element of a product, the holder is entitled to the infringer’s total profit on sales of the whole product. Also, damages


61. Section 289 makes an infringer liable “to the extent of his total profit” resulting from sales of the infringing article. Id. Usually, the courts define “profit” using the incre-
begin to accrue from the day the patent is issued, so long as the product is marked with the design patent number. The infringer is not required to have actual notice of the design patent, nor will his plea that the infringement was accidental be of any help to him. The doctrine of willful infringement has given patent owners enormous leverage against would-be infringers in both design and utility patent cases. If an infringement is willful, the infringer could be held responsible for the payment of up to triple the regular damages, plus the patent owner's attorney's fees. The leading case from the Federal Circuit, Underwater Devices Inc. v. Morrison-Knudsen Co., held that one who is on actual notice of another's patent has a duty to determine whether or not he is infringing. This duty includes obtaining an opinion from a patent attorney before the initiation of any possible infringing activity. The opinion should be in writing, and be based on a comprehensive evaluation by patent counsel of the file history of the patent, all prior patents, and the allegedly infringing product. If a defendant has not discharged his duty to investigate, or has not followed his attorney's competent advice, then he can be liable to the patent owner for double or triple damages plus attorney fees.

Some of Cinderella's mean stepmothers have presented the disadvantages of design patents, and I will briefly address their four major arguments.

The first complaint is that the standard of obviousness is too difficult to apply in the case of design patents. This standard provides that a design patent cannot be granted if the illustrated design would have been obvious to a designer of ordinary skill in view of all earlier designs. Now I notice that later in the program we have an expert from the Patent Office who is going to speak more precisely on the application of this standard. Critics have said that determining obviousness of a design patent is unpredictable, very subjective, and must rely on the highly opinionated nature of designers as expert witnesses. Let me make three points in response to these concerns.


63. Notice to the infringer by the patent owner is required when the patented article is not properly marked. Id. Proper marking, however, serves as constructive notice. See Devices for Medicine, Inc. v. Boehl, 822 F.2d 1062, 1066 (Fed. Cir. 1987).
64. There is no requirement of intent for a finding of infringement. 35 U.S.C. § 271(a) (1988).
65. 717 F.2d 1380 (Fed. Cir. 1983).
66. Id. at 1389-90; see also Radio Steel & Mfg. Co. v. MTD Prods., Inc., 788 F.2d 1554, 1559 (Fed. Cir. 1986).
69. See In re Cho, 813 F.2d 378, 382 (Fed. Cir. 1987); In re Nalbandian, 661 F.2d 1214, 1217 (C.C.P.A. 1981).
First, the question of obviousness of a design is like the question of infringement. In determining infringement, someone must visually compare the accused product to the claimed design and determine if they are substantially the same. It is ultimately subjective, although there are objective signposts along the way, just like the question of obviousness. The question of infringement is no more subjective in a design patent case than in a trade dress or copyright action, but no one is complaining about subjectivity or unpredictability in those areas.

Next, it is easier to satisfy the obviousness test in a design patent than a utility patent because in a utility patent there are many limiting words describing the use, function, structure, and operation of the invention. The utility patent examiner uses all of those words to reject the utility patent application as obvious. In a design patent application, by contrast, there are generally no limiting words. The design is described only by the drawings, and it is more difficult for a design patent examiner to combine prior designs to reject the patent based on obviousness.

Finally, it is only by subjecting design patent applications to a rigorous examination on obviousness by the highly skilled and experienced design

71. In determining obviousness, a court analyzes the following four factors: (1) the scope and content of the prior art; (2) the differences between the prior art and the claim at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness (e.g., commercial success, long-felt need, widespread copying, etc.). Graham v. John Deere Co., 383 U.S. 1, 17 (1966); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1441 (Fed. Cir. 1984).


74. Section 112 provides that "the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (1988). In design patent applications, no description, other than a reference to the drawing of the design, is required. 37 C.F.R. § 1.153 (1990). Only a single claim is allowed. In re Rubinfield, 270 F.2d 391, 396 (C.C.P.A. 1959), cert. denied, 362 U.S. 903 (1960).


76. The Federal Circuit stated the difficulty of finding obviousness in ornamental designs in In re Cho:

77. 35 U.S.C. § 131 (1988); see Patent and Trademark Office, U.S. Dep't of Com-
patent examiners, and by having the claimed designs survive such examination, that the tremendous advantages provided by the presumption of validity are obtained. 78 There is no substantive examination of a copyright, 79 and the trade dress examination is very limited. 80

A second complaint with regard to design patents is that the issue of functionality kills many design patents. If a patented design is functional, then it does not meet the legal requirement that limits design patents to ornamental designs. 81 Many courts have had problems distinguishing the inherent function of a product with the function of the design of or on the product. 82 This is a critical distinction because virtually all products which are the subject of design patents have a function; otherwise, they would not be on the market. The question, therefore, should not be whether the product is functional, but whether the design appearing on or of the product is functional. 83 Unfortunately, the Federal Circuit has yet to adopt a sensible and easily applied test to determine whether a patented design is legally functional and therefore invalid. 84

Over the years, most of the attention has been focused on how the test is worded, 85 and not on how the test is applied, or on the underlying principles of why the test exists in the first place. The reason why we have a doctrine of functionality in design patents, as well as in trade dress and copyright cases, is that you ought not be able to obtain by a design patent, a trade dress registration, or a copyright registration, that which Congress only


79. Federal copyright registration only requires a deposit of the work with the Copyright Office. 17 U.S.C. § 408 (1988). No examination of prior art is required.

80. The Patent and Trademark Office will conduct a comparison with only federally registered trade dress before a federal trade dress registration application is allowed. 15 U.S.C. § 1052(d) (1988).

81. Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d 234 (Fed. Cir. 1986); In re Carletti, 328 F.2d 1020 (C.C.P.A. 1964).


83. "However, a distinction exists between the functionality of an article or features thereof and the functionality of the particular design of such article or features thereof that perform a function. Were it not true, it would not be possible to obtain a design patent on a utilitarian article of manufacture." Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc., 853 F.2d 1557, 1563 (Fed. Cir. 1988).


intended be obtainable by a utility patent.  A competitor has the right to copy the unprotected function in your product.  The only way to protect function is to obtain a utility patent.  If you do not have a utility patent, you cannot stop a competitor from making a product having the same or similar function.

The question for us becomes: What will the competitor’s product look like?  If your unprotected function can be embodied by a product that has a different appearance, then your design patent will be valid to protect your product’s specific design appearance.  If, on the other hand, the only way of expressing that unprotected function is by your product’s particular design, then your design patent will be invalid because the function has dictated the design, and there is no way for a competitor to copy the unprotected function without copying the design.

Therefore, I submit that the test for design patent functionality should be whether the design is dictated by function, and a court applying that test should receive evidence concerning the availability of alternative designs that incorporate substantially the same function.  If such alternative designs exist, or can be devised, that do not infringe the design patent, then the design patent is valid.  If no such alternative designs exist, the design patent is invalid for functionality.  This test has been used by several courts, but has not been fully embraced by the Federal Circuit as the test for functionality in design patent law.  It is an eminently reasonable test, which is susceptible to being proven by evidence and very capable of being evaluated properly by a judge or jury.

A third complaint involves the length of time it takes to obtain a design patent; up to two and one-half to three years is common.  However, there have long existed rules in the Patent Office which allow a patent applicant to expedite an examination of his application.  We have been able to obtain design patents for some clients in under six months from the time of filing.  This, of course, is a real plus when the product is very popular upon introduction and is being knocked-off immediately.  The extra expense neces-

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86. See Carletti, 328 F.2d at 1022.
89. A design patent application may be expedited upon filing the referenced petition and submitting a required fee.  37 C.F.R. § 1.102 (1990).  This process is known as a “Petition to Make Special.”  M.P.E.P. supra note 77, § 708.02, at 700-35.
90. For example, United States Patent No. Des. 297,181 was issued in less than six months.
sary to obtain expedited examination is generally well worth it, and no adverse effect on validity of the resulting patent is evident. Of course, if the design is not popular, then there is no reason to expedite examination, and there is nothing wrong with letting the patent application go its normal course.

The final major criticism of design patents is their high cost. Obviously, this is an important consideration, especially for companies that put out dozens or hundreds of designs per year and perhaps do not wish to spend $1,000 or more to get each one patented. I submit that for important designs, it is well worth the money. However, there are ways to prioritize expenses to get design patents on only the most important designs. There are also ways to preserve rights on even 50 to 100 new products relatively cheaply for a short period of time while the commercial success of the designs can be evaluated.

Well, things are looking up. There is my glass slipper. Since the shoe fits, hopefully Cinderella will wear it, and perhaps we can live happily ever after.
APPENDIX

Recent Design Patent Cases—Statistical Analysis

Since all of the previous statistical studies focus on design patent cases decided before the Federal Circuit's gospel filtered down, I concentrated on the three years from January 1, 1986, to April 19, 1989. I found some interesting numbers that should be encouraging to design patent owners, or at least not discouraging.

First, I looked at reported decisions on design patent preliminary injunctions, and they are encouraging. Out of five reported decisions, the district courts granted a preliminary injunction four times, for an excellent success rate of eighty percent. Table I below summarizes the five cases.91

Next, I looked at reported decisions of the federal district courts that actually decided the issues of validity and infringement. During this period of time, twelve design patents were litigated.92 In all cases, the question of validity was decided. Of the twelve, the court found the design patents invalid in five. Thus, the mortality rate was only about forty-two percent. The converse, of course, is that fifty-eight percent of the design patents litigated were held valid. This is an excellent success rate. One might, at first blush, actually expect only about a fifty percent success rate, since that is about the rate of utility patent success, and since presumably only closely contested cases get litigated and reported.

I then took a closer look at the five holdings of invalidity to determine the grounds the courts used to invalidate the design patents. I tried to determine whether there was something about design patents that was either inherently suspect or whether design patent issues were uniquely difficult to resolve, as suggested by some commentators. In two of the five, the design patents were invalidated because the designs were found to be on sale over one year prior to the date of application, violating 35 U.S.C. § 102(b).93 The "on sale" bar applies equally to utility patents and design patents.94 Thus, in these two cases, the fact that the patents were design patents did not make

them inherently suspicious or weak. In Pioneer Photo and Neo-Art, the court opinions were, to be kind, less than models of legal clarity. In only one of the twelve cases, Black & Decker, was the design patent held invalid for obviousness with a cognent legal analysis.

The infringement issue was decided eight times. I am reluctant to draw conclusions from statistics on infringement holdings because each infringement is so factually different. But of the eight, four were found infringed, for a success rate of fifty percent. Of the four noninfringement holdings, one was in the case where obviousness was also found, Black & Decker, and the other three simply did not infringe. I cannot quarrel with the outcomes. The results are summarized in Table 2 below.

The Federal Circuit reviewed seven design patents in five cases during this time period. In every case, it affirmed the lower court's findings on validity and infringement. On validity, it upheld four of four design patents, for a one hundred percent validity record. On infringement, it found four of seven design patents infringed, for a success rate of fifty-seven percent. One reason that the courts upheld the lower courts' findings of four infringements and three noninfringements is the requirement of demonstrating that the lower court was clearly erroneous in order to obtain a reversal. This is a very high burden for the party who loses on the infringement issue in the lower court. On validity, the Federal Circuit affirmed in all cases, which illustrates the power of the presumption of validity. The infringer has the burden of overcoming the presumption of validity at trial by clear and convincing evidence, which is also a difficult standard to meet. The Federal Circuit agreed with the lower court in each case that the infringer had failed to meet this burden. These results are summarized in Table 3 below.

Although it is clear that the number of cases decided both in the district courts and the Federal Circuit is not statistically significant, the above results indicate a shift in recent times in favor of design patent enforcement and help counteract the poor statistics reported for prior time periods.

95. Lee, 838 F.2d at 1187 (citing Mannesmann Demag Corp. v. Engineered Metal Prods. Co., 793 F.2d 1279, 1282 (Fed. Cir. 1986)).
<table>
<thead>
<tr>
<th>DESIGN PAT. NO.</th>
<th>CASE NAME</th>
<th>CITATION</th>
<th>COURT</th>
<th>YEAR</th>
<th>P.I.</th>
</tr>
</thead>
<tbody>
<tr>
<td>2. 285,987</td>
<td>MacDonald Assocs. Inc. v. Crownmark Corp.</td>
<td>2 U.S.P.Q.2d (BNA) 1235</td>
<td>D.R.I.</td>
<td>1987</td>
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<tr>
<td>5. 259,579</td>
<td>Designs for Leisure Ltd. v. Murrey &amp; Sons Co.</td>
<td>9 U.S.P.Q.2d (BNA) 1159</td>
<td>C.D. Cal.</td>
<td>1988</td>
<td>1</td>
</tr>
</tbody>
</table>

0 = denied
1 = granted
TABLE 2

UNITED STATES DISTRICT COURTS (Jan. 1, 1986 to April 19, 1989)

<table>
<thead>
<tr>
<th>DESIGN PAT. NO.</th>
<th>CASE NAME</th>
<th>CITATION</th>
<th>COURT</th>
<th>YEAR</th>
<th>VAL*</th>
<th>INF**</th>
<th>ENF***</th>
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</thead>
<tbody>
<tr>
<td>1. 272,476</td>
<td>Black &amp; Decker Inc. v. Pittway Corp.</td>
<td>636 F. Supp. 1193</td>
<td>N.D. Ill.</td>
<td>1986</td>
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<tr>
<td>2. 243,551</td>
<td>FMC Corp. v. Hennessy Indus., Inc.</td>
<td>650 F. Supp. 688</td>
<td>N.D. Ill.</td>
<td>1986</td>
<td>1</td>
<td>0</td>
<td>1</td>
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<tr>
<td>5. 259,142</td>
<td>Lee v. Dayton-Hudson Corp.</td>
<td>666 F. Supp. 1072</td>
<td>E.D. Tenn.</td>
<td>1987</td>
<td>1</td>
<td>0</td>
<td>—</td>
</tr>
<tr>
<td>6. 284,420</td>
<td>Pensa Inc. v. L.A. Gear Cal., Inc.</td>
<td>4 U.S.P.Q.2d (BNA) 1016</td>
<td>C.D. Cal.</td>
<td>1987</td>
<td>1</td>
<td>1</td>
<td>—</td>
</tr>
<tr>
<td>7. 287,301</td>
<td>Pensa Inc. v. L.A. Gear Cal., Inc.</td>
<td>4 U.S.P.Q.2d (BNA) 1016</td>
<td>C.D. Cal.</td>
<td>1987</td>
<td>1</td>
<td>1</td>
<td>—</td>
</tr>
<tr>
<td>9. 293,422</td>
<td>Nunes v. Bishop Aviation Inc.</td>
<td>703 F. Supp. 774</td>
<td>W.D. Ark.</td>
<td>1988</td>
<td>1</td>
<td>0</td>
<td>1</td>
</tr>
</tbody>
</table>

* 1 = held valid  ** 1 = held infringed  *** 1 = held enforceable  
0 = held invalid  0 = held not infringed  0 = held unenforceable  
— = no ruling on validity  — = no ruling on infringement  — = no ruling on enforceability
# Table 3

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT (Jan. 1, 1986 to April 19, 1989)

<table>
<thead>
<tr>
<th>DESIGN PAT. NO</th>
<th>CASE NAME</th>
<th>CITATION</th>
<th>YEAR</th>
<th>VAL*</th>
<th>INF**</th>
<th>ENF***</th>
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<tr>
<td>1. 267,927</td>
<td>Unette Corp. v. Unit Pack Co.</td>
<td>785 F.2d 1026</td>
<td>1986</td>
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<td>2. 258,100</td>
<td>Pacific Furniture Mfg. Co. v. Preview Furniture Corp.</td>
<td>800 F.2d 1111</td>
<td>1986</td>
<td>1</td>
<td>1</td>
<td>1</td>
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<tr>
<td>3. 258,101</td>
<td>Pacific Furniture Mfg. Co. v. Preview Furniture Corp.</td>
<td>800 F.2d 1111</td>
<td>1986</td>
<td>1</td>
<td>1</td>
<td>1</td>
</tr>
<tr>
<td>4. 243,551</td>
<td>FMC Corp. v. Hennessy Indus., Inc.</td>
<td>836 F.2d 521</td>
<td>1987</td>
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<td>5. 259,142</td>
<td>Lee v. Dayton-Hudson Corp.</td>
<td>838 F.2d 1186</td>
<td>1988</td>
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<td>6. 284,420</td>
<td>Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.</td>
<td>853 F.2d 1557</td>
<td>1988</td>
<td>1</td>
<td>1</td>
<td>—</td>
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