

# UPDATE

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## FUNCTIONALITY—THE NEXT TURF WAR IN DESIGN PATENTS?



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In recent years,  
design patent

law has received increased attention at the Federal Circuit. Starting in 2006 with a panel decision,<sup>1</sup> and then a clarifying opinion in *Lawman v. Winner*,<sup>2</sup> followed by a panel decision<sup>3</sup> and rehearing *en banc* in *Egyptian Goddess v. Swisa* in 2008,<sup>4</sup> the Federal Circuit clarified a key principle of design patent law—the test for infringement. In particular, the Federal Circuit in the *en banc* rehearing of *Egyptian Goddess*<sup>5</sup> refocused the test for design patent infringement towards the “ordinary observer” test set forth in 1871 in *Gorham v. White*.<sup>6</sup> While the dust is still settling regarding the revised test for infringement, another issue may be moving to front and center in the realm of U.S. design patent law—*functionality*.

### FUNCTIONALITY—DISTRICT COURT OF ARIZONA

On June 3 2008, Richardson filed suit against Stanley Works, Inc. (Stanley) in the District of Arizona, alleging that Stanley’s “Fubar”

product infringed Richardson’s U.S. Design Patent No. D507,167 (‘167 Patent). As seen in FIGS. 1 and 2 of the ‘167 patent, Richardson’s design patent was directed to “a multi function stud climbing and carpentry tool,”<sup>7</sup> which commercially was known as the “Stepclaw.”<sup>8</sup>

Like Richardson, Stanley also obtained a patent covering its product—the Fubar, and FIGS. 1 and 5 of U.S. Patent No. D562,101 (‘101 Patent) illustrate the Fubar.<sup>9</sup> [MORE>](#)



Turf War

1. *Lawman Armor Corp v. WinnerInt'l LLC*, 437 F.3d 1383 (Fed. Cir. 2006)
2. *Lawman Armor Corp v. WinnerInt'l LLC*, 449 F.3d 1190 (Fed. Cir. 2006)
3. *Egyptian Goddess, Inc. v. Swisa Inc.*, 498 F.3d 1354 (Fed. Cir. 2007)
4. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008)
5. *Id.*
6. *Gorham Manufacturing Company v. White*, 81 U.S. 511 (1871)
7. U.S. Pat. No. D507,167.
8. *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1290 (Fed. Cir. 2010).
9. *Richardson*, 597 F.3d at 1291.

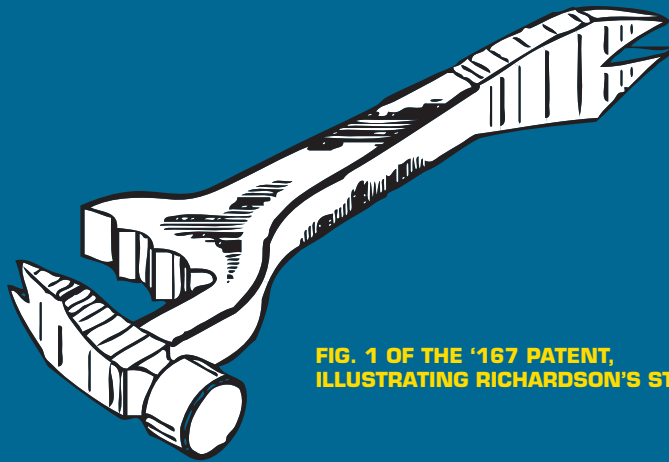


FIG. 1 OF THE '167 PATENT,  
ILLUSTRATING RICHARDSON'S STEPCLAW

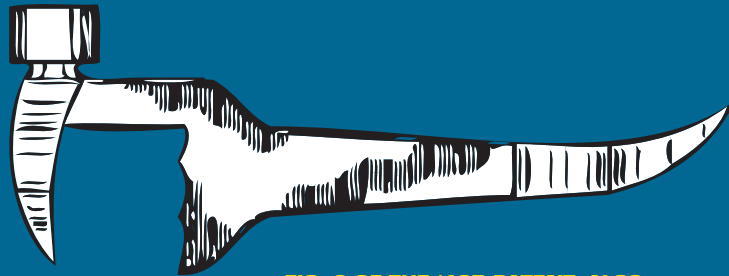


FIG. 2 OF THE '167 PATENT, ALSO  
ILLUSTRATING RICHARDSON'S STEPCLAW



FIG. 1 OF THE '101 PATENT,  
ILLUSTRATING STANLEY'S FUBAR PRODUCT

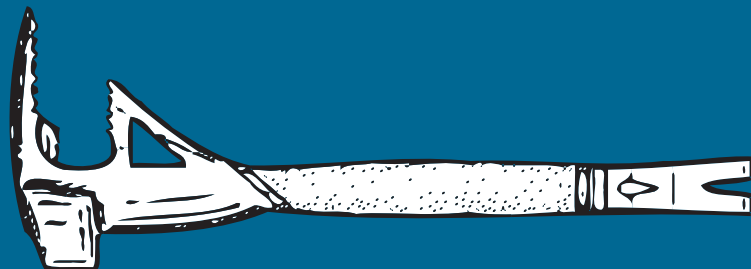


FIG. 5 OF THE '101 PATENT,  
ILLUSTRATING STANLEY'S FUBAR PRODUCT

[FUNCTIONALITY, FROM PAGE 1]

After a bench trial, the District Court entered judgment in favor of Stanley, ruling that the Fubar did not infringe Richardson's design patent.<sup>10</sup> The trial court determined that after discounting the functional elements of the '167 patent, the standard for design patent infringement was not met.<sup>11</sup> Thereafter, Richardson appealed the District Court's findings, including its claim construction and finding of non-infringement.

### FUNCTIONALITY ON APPEAL

On appeal, Richardson essentially argued that the trial court incorrectly applied the law by separating out the "functional aspects" of his design from the "ornamental" aspects instead of analyzing his design as a whole.<sup>12</sup> Richardson also argued that his design was not impermissibly functional because "(1) the functions that the '167 Patent is capable of performing can be achieved through other designs... and (2) that the overall design of the '167 Patent is not dictated by the use or purpose of the tool or of any useful elements found in the tool."<sup>13</sup> Likewise, Richardson asserted that *Egyptian Goddess* requires a comparison of his patented design be made in its entirety with the Fubar, and the similarities be evaluated from the perspective of an ordinary observer.<sup>14</sup>

The Federal Circuit rejected Richardson's arguments, however, and instead stated that Richardson is only "entitled to a design patent whose scope is limited to those [ornamental] aspects alone and does not extend to any functional aspects of the claimed article."<sup>15</sup> The Court specifically identified "the handle, the hammerhead, the jaw, and the crowbar" of Richardson's design as being "dictated by their functional purpose."<sup>16</sup>

After affirming the District Court's claim construction, the Federal Circuit also affirmed

that the Fubar product did not infringe the '167 patent, noting that "ignoring the functional elements of the tools, the two designs are indeed different."<sup>17</sup> In the Court's opinion, the Fubar had a "streamlined visual theme that runs through the design," which was evident in the Fubar's "tapered" hammerhead, "streamlined" crow-bar, "triangular neck with rounded surfaces," and "smoothly contoured" handle.<sup>18</sup> Thus, in comparing the Fubar with the '167 patent, the court held that Fubar's "more rounded appearance and fewer blunt edges" made it "significantly different" from the '167 patent's design.<sup>19</sup>

### REQUEST FOR REHEARING

Richardson further challenged the decision, requesting a rehearing *en banc* before the Federal Circuit. The Federal Circuit's ruling in this case also stirred the interest of members of the design patent community. As a result, non-parties Apple, Inc. and the American Intellectual Property Law Association (AIPLA) filed amicus briefs supporting the request for rehearing *en banc*.

In its brief, Apple argued that "[t]he parsing of ornamental and functional features should be abolished. Whether an individual feature of an overall design performs a function is simply not relevant to design patent infringement."<sup>20</sup> Apple further argued that "[t]he proper place in design patent law to consider functionality is when evaluating the validity of a design patent, i.e., whether the overall claimed design is dictated solely by function."<sup>21</sup>

AIPLA also argued that the functionality analysis performed by the Court was improper. In particular, AIPLA argued that "the Court should disavow a claim construction methodology... that purports to separate functional and ornamental elements of the claim [MORE >](#)

10. *Id.* at 1292.

11. *Id.* at 1292–93.

12. *Richardson*, 597 F.3d at 1293.

13. Brief for Plaintiff-Appellant's Petition for Rehearing En Banc at 18, *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288 (Fed. Cir. 2010) (No. 2009-1354), *reh'g denied* (May 24, 2010).

14. *Richardson*, 597 F.3d at 1293.

15. *Id.* at 1294.

16. *Id.*

17. *Id.* at 1296.

18. *Richardson*, 597 F.3d at 1296.

19. *Id.*

20. Brief for Apple Inc. as Amicus Curiae Supporting Plaintiff-Appellant's Petition for Rehearing En Banc at 1, *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288 (Fed. Cir. 2010) (No. 2009-1354), *reh'g denied* (May 24, 2010).

21. *Id.*

[FUNCTIONALITY, FROM PAGE 3]

design, rather than properly directing the fact-finder to the overall design, considering all of a design's depicted elements taken together."<sup>22</sup> AIPLA compared the Court's approach in *Richardson* to the "point of novelty" type of analysis that the Federal Circuit recently rejected in *Egyptian Goddess*. Specifically, AIPLA noted that "[l]ike the now defunct 'Point of Novelty' approach (which sought to separate out new and old elements), the panel's approach (which seeks to separate out ornamental and functional

design's individual components are functional or ornamental. As such, it is improper, and contrary to established precedent, to address "functionality" during claim construction. Rather, any functionality-validity challenges should only be performed as a determination as to whether the design's overall appearance is "dictated by function alone" and under the "safeguards that cloak a presumptively valid design patent including the higher clear and convincing evidentiary standard."<sup>27</sup>

**It is well established law that a design patent, unlike a utility patent, protects the *ornamental design* of the article of manufacture. However, virtually every "article of manufacture" has functional purposes or else it probably would not exist.**

elements) conflicts with the tenet that a design patent protects the overall appearance of the claimed design, and is fraught with logistical problems."<sup>23</sup> The AIPLA brief also notably illustrated (see images on next page) one such logistical problem graphically by showing in a step-by-step manner the removal of the alleged "functional features" and the resulting presumptively valid design patent having no claim scope or features.<sup>24</sup>

Despite the issues raised by *Richardson* and the *amici*, the Federal Circuit denied the request for rehearing *en banc* on May 24, 2010.<sup>25</sup>

### THE FUTURE OF "FUNCTIONALITY" IN DESIGN

It is well established law that a design patent, unlike a utility patent, protects the *ornamental design* of the article of manufacture.<sup>26</sup> However, virtually every "article of manufacture" has functional purposes or else it probably would not exist. As implicitly suggested by *Richardson* and the *amici* in support of a request for rehearing, design patents protect the overall appearance of designs regardless of whether the

While interest exists as to whether the Federal Circuit's functionality analysis in *Richardson* will be effectively used as a back door for attacking validity under a lower evidentiary standard in the future, those that disagree with the functionality analysis in *Richardson* may be comforted. The Federal Circuit may further address the issue of "functionality" should one or more future design patent decisions continue to analyze "functionality" element by element instead of looking to the design as a whole. Recall that the *en banc* rehearing in *Egyptian Goddess* came well after the Court's initial panel decision in *Lawman* that escalated the interest as to whether the point of novelty test was properly a part of the infringement analysis.

District Courts may also choose to read and apply *Richardson* in a narrow fashion. Recently, in a design patent infringement case involving a design patent directed to a "clip light"<sup>28</sup> the E.D. Texas rejected arguments that under *Richardson* "functional elements are wholly eliminated from the claimed design..."<sup>29</sup> In its claim construction order the Court simply construed the claim to

22. Brief for Am. Intellectual Prop. Law Ass'n as Amicus Curiae Supporting Plaintiff-Appellant's Petition for Rehearing En Banc at 2, *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288 (Fed. Cir. 2010) (No. 2009-1354), *reh'g denied* (May 24, 2010).

23. *Id.*

24. *Id.*

25. *Richardson*, 597 F.3d at 1288.

26. 35 U.S.C. § 171

27. Brief for Am. Intellectual Prop. Law Ass'n as Amicus Curiae Supporting Plaintiff-Appellant's Petition for Rehearing En Banc at 8-9.

28. U.S. Des. Pat. No. D498,322

29. *Good Sportsman Marketing, LLC v. Li Fung Ltd.*, 2010 WL 2640385 (E.D. Tex.)

30. *Id.* at 4.

31. *Id.*

32. *Id.* ("Here, however, there is no evidence that the claimed configuration is the only configuration for a clip on a book light. The relative locations of the elements are not necessarily dictated by the function of the article.")

33. *Id.* at 3

[FUNCTIONALITY, FROM PAGE 4]

mean “the design for a clip light as shown in Figure 1 of the patent.”<sup>30</sup> The Court refused to eliminate allegedly functional features from its construction, stating that nothing in *Richardson* “compels the court to wholly ‘factor out’ any element.”<sup>31</sup> Instead, the Court focused its functionality analysis on the design as a whole <sup>32</sup> and also reasoned that the Federal Circuit in *Richardson* merely observed “that function dictated the *configuration* of the tool.”<sup>33</sup> Only time will tell whether *Richardson* keeps functionality a hot topic in the world of design for the foreseeable future or whether its effects will be narrow and functionality will fall from the limelight. In the meantime, the design community will watch the effects of the *Richardson* decision very closely in design patent infringement cases moving forward. ■



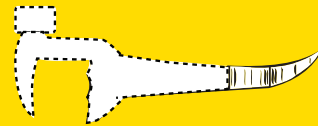
**D'167 AS ISSUED**



**HAMMER-HEAD DISCARDED  
AS “FUNCTIONAL”**



**JAW DISCARDED  
AS “FUNCTIONAL”**



**HANDLE DISCARDED  
AS “FUNCTIONAL”**



**CROWBAR DISCARDED  
AS “FUNCTIONAL”**



**D'167 AS CONSTRUCTED**

AS ILLUSTRATED IN THE BRIEF FOR...