United States Patent [19]
Elmer

[11] **Patent Number: Des. 290,620**
[45] **Date of Patent: ** Jun. 30, 1987**

[54] **VEHICLE TOP SIGN HOLDER**

[76] Inventor: **William A. Elmer, 917 N. Pennsylvania Ave., Winter Park, Fla. 32789**

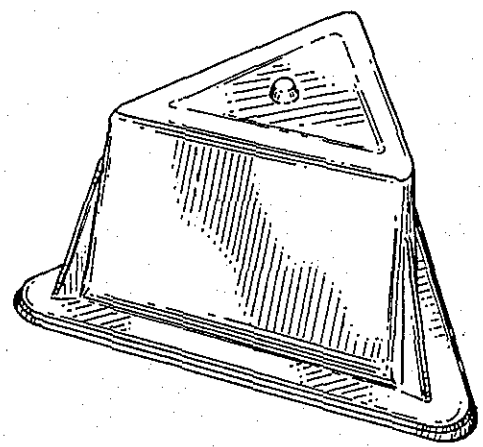

FIG. A

As a prelude to applying the standard two-step *Gorham*[5] and *Litton*[6] tests for design patent infringement, the court said that the meaning and scope of the design patent claim needs to be determined. The court then quoted the sole claim of Elmer's design patent: "... the ornamental design for a vehicle top sign holder, *as shown and described*" (emphasis by the court).[7]

5 *Gorham v. White*, 81 U.S. (14 Wall.) 511 (1871) ("[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.").

6 *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984) ("For a design patent to be infringed, however, no matter how similar two items look, 'the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art'.", (quoting *Sears, Roebuck and Co. v. Talge*, 140 F.2d 395, 60 USPQ 434 (8th Cir. 1944)). The *Elmer* court cited the more recent *Oakley, Inc. v. International Tropic-Cal, Inc.*, 923 F.2d 167, 17 USPQ2d 1401 (Fed. Cir. 1991) for this "point of novelty" test.

7 Virtually all design patent claims include the italicized language "as shown and described". *See* 37 C.F.R. §1.153 (a) and M.P.E.P. §1503.03.

ELMER V. ICC

ICC'S ACCUSED SIGN

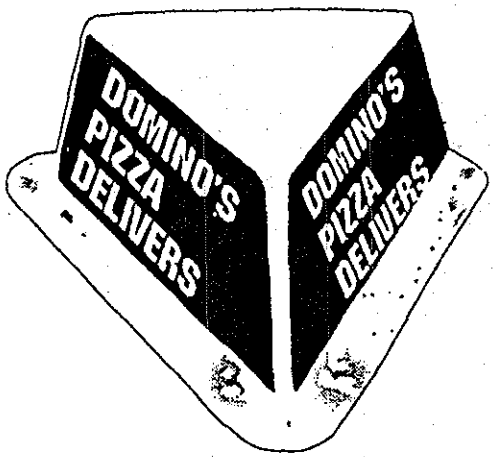

FIG. B

For the first time in a design patent case, the Federal Circuit, citing the *Markman* decision,[8] engaged in claim interpretation in order to determine, as a matter of law, the meaning and scope of a design patent claim. While this is in accordance with standard patent law precedent[9] the *Elmer* court's entire claim construction analysis consisted of noting that:

> Each of the patent's six drawing figures shows a sign having [triangular vertical ribs and an upper protrusion]. . . . [B]ecause no other design is disclosed in the '620 patent, we interpret the claim as being limited to a design that includes among its ornamental features triangular vertical ribs and an upper protrusion. 36 USPQ2d at 1421.

8 *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995) (in banc), *cert. granted*, 116 S.Ct. 40 (1995).

9 *Key Manufacturing Group, Inc. v. Microdot, Inc.*, 925 F.2d 1444, 17 USPQ2d 1806 (Fed. Cir. 1991) ("Before analyzing a claim to determine whether infringement occurs, the court must properly interpret the claim . . . Improper claim construction can distort the entire infringement analysis."); *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 228 USPQ 90 (Fed. Cir. 1985) ("To ascertain the meaning of disputed claim language, resort should be made to the claims at issue, the specification, and the prosecution history. Claims should be construed as they would be by those skilled in the art. Statements made during prosecution can limit claim scope.").

In responding to Elmer's argument that the ribs and protrusion were functional, the Federal Circuit bluntly noted:

> [The] . . . [triangular vertical ribs and an upper protrusion] . . . give the design a distinctive ornamental appearance . . . If, as HTH [Elmer] now contends, the vertical ribs and upper protrusion were functional, not ornamental, features, HTH could have omitted these features from its patent application drawings. *HTH did not do so, however, and thus effectively limited the scope of its patent claim by including those features in it.* (emphasis added) ***In re Mann***.[10] 36 USPQ2d at 1421.

Having interpreted the claim thusly, the court noted that the defendant's sign lacked vertical ribs and an upper protrusion. Since these two features "give the design a distinctive ornamental appearance",[11] the court concluded that the defendant's sign was not overall substantially the same as the claimed design, and thus did not infringe under the *Gorham* test. The court did not feel it necessary to reach the second part of the two-step infringement test (the *Litton* "point of novelty" test) since if the *Gorham* test was not met, the *Litton* test is moot; the tests are conjunctive.[12]

As a result of *Elmer*, design patent owners may be fearing that their design patents will be too narrowly construed so as to be limited precisely to that which is shown in their drawings. At the same time, alleged infringers may be laboring under a false sense of security in thinking that their products only need to differ a little from the illustrated designs in order to avoid infringement. To say that *Elmer* represents a nightmare for design patent owners would be to realize the worst of these fears.

III. My Life as a Patent Lawyer

To better understand the *Elmer* case, we will review some recent cases of the same genre. Before so doing, however, I'd like to share some of my own particular history with design patents, because from speaking to fellow practitioners I think my experience is in many ways typical.

I am a patent lawyer with a master's degree in electrical engineering, and, like so many others with technical backgrounds, I worked almost exclusively in utility patents for the first 15 years or so of my career.

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10 *supra*, note 2.

11 *Elmer*, 36 USPQ2d at 1421.

12 *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 n.4, 5 USPQ2d 1625, 1627 n.4 (Fed. Cir. 1988).

Before I got seriously involved in design patents in 1986,[13] I was the kind of patent attorney who usually recommended a design patent to a client only when the patentability search knocked out the possibility of a utility patent. I might've said something like: "Well, we can probably still get you a design patent".... it was like a booby prize! And design patents were so easy to prepare compared to utility patents. Gosh, all you had to do for a design patent was give the product to your draftsman to draw it up with your six standard, orthogonal views (with perhaps a perspective view for good measure), while you prepared brief figure descriptions. There was no worrisome claim drafting, since by rule there was only one claim in a design patent, and the claim format was standard.[14] What could be simpler? Does this sound familiar?

Well, I didn't realize it, but my client's design patent was a sitting duck for competitors, some of whom specialized in copying others' designs. Some of these folks attend trade shows with little hidden cameras, or carry sketch pads and have photographic memories. These knock-off artists, on their plane ride back to their factories, will not only have figured out which products they want to copy, but they'll make enough minor variations so as to escape liability for design patent infringement 6 out of 10 times.[15] Why? Because they can count on the fact that some guy like me unthinkingly provided my client with the narrowest possible claim, the easiest possible claim to design around, that any knock-off artist could possibly hope for. Unfortunately, this by and large is the state of affairs today.

Most patent attorneys still regard design patents as an afterthought, a booby prize; it should come as no surprise when the resulting design patent is held non-infringed, as still happens in 60% of the cases.[16]

One must ask: why would any reasonable patent lawyer, who spends hours and hours carefully crafting utility patent claims, who brags to colleagues and clients about drafting and getting allowed an enormously broad utility patent claim, carelessly approach the task of claim drafting when applying for a design patent?

13 Saidman & Mondry, "**SNEAKERS, DESIGN PATENTS & SUMMARY JUDGMENTS: Opening A New Era in the Protection of Consumer Product Designs**", 71 *Journal of The Patent and Trademark Office Society* 524 (July, 1989) discussing *Pensa, Inc. v. L.A. Gear of California, Inc.*, 4 USPQ2d 1016 (C.D. Cal. 1987), *aff'd., Avia Group International, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988).

14 *supra*, note 7.

15 Saidman, **Design Patents—the Whipping Boy Bites Back**. 73 *Journal of the Patent and Trademark Office Society* 859, 867 (November 1991).

16 *Id.*

What this attorney, and client, will wind up with is a *literal* picture claim. Since the standard claim in a design patent says "The ornamental design for a widget, as shown and described",[17] the subject matter of a design patent claim is defined by what is shown in the design patent drawings.[18] Thus, when you hand the product to your draftsman to draw it up, you are drafting a ***literal*** picture claim: a claim that includes every single feature of the design. This is a claim which your competitors will delight in designing around, since all they have to do is leave out or change some immaterial elements shown in your patent drawings and, while their product borrows the essence of your design, they may very well be able to avoid your claim, or at least raise a genuine issue as to infringement.[19]

IV. The Sign of Zahn

This brings us to the ***second*** most significant design patent case ever decided.[20] This case is *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). *Zahn* for the first time held that design patent law does not require the entire product to be illustrated in the design patent drawings in order to have design patent statutory subject matter.[21] *Zahn* held that you could show the *part of* the product that you wanted to claim in solid lines in the drawing, and the part that you didn't want to claim in broken lines, and that the resulting design patent still claimed statutory subject matter.

Mr. Zahn claimed to have invented the design of the shank portion of an otherwise conventional drill bit. Rather than claim the whole product, Zahn claimed only that which he regarded as his invention,[22] and thus illustrated only the shank portion in solid lines (see FIG. C). The question decided by the CCPA was whether the claimed design was "for an article of manufacture" as required by 35 U.S.C. §171. The court held that *part* of a product can be a design *for* an article of manufacture; you don't have to claim the whole product.[23]

17 *supra*, note 7.

18 and in some instances, what is described in the specification, although the major emphasis is generally on the design patent drawings.

19 Under *Elmer*, competitors will argue that infringement is avoided as a matter of law; the logic will be that there can be no genuine issue regarding infringement when the claim is interpreted (before the *Gorham* test is applied) to include all of the elements as illustrated in the drawings, and when their product does not include all of those elements.

20 the most significant being, of course, *Gorham v. White*, 81 U.S. (14 Wall.) 511 (1871).

21 35 U.S.C. §171.

22 which he had an obligation to do under 35 U.S.C. §112.

23 *In re Zahn*, 204 USPQ 988, 994 (CCPA 1980).

In re Zahn

204 USPQ 988 (1980)

U.S. COURT OF CUSTOMS AND PATENT APPEALS

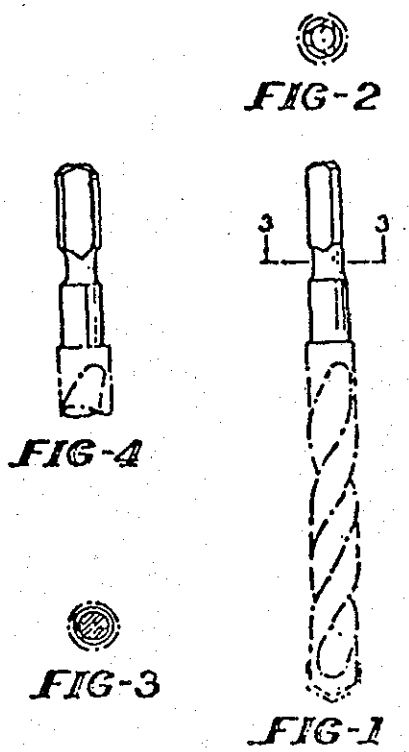


FIG. C

Zahn was a terribly significant case, since it meant for the first time that you could be just as creative in drafting your design patent claims as your utility patent claims. It meant that it was now possible to talk to your designer, just as you would talk to your inventor, before drafting the design patent application, and find out about the prior art, find out what the designer regarded as the most unique elements of the

product, find out what was important commercially to protect and what didn't matter. Having found out all of this terrific information, you could then instruct your draftsman to draw only that which you wanted to protect; only that which the designer regarded as the invention.[24] It meant that your client's product could embody a broad design invention, an intermediate design invention, and a narrow design invention, just as in a utility patent.[25]

In my on-going review of court holdings in design patent infringement litigation, the single most significant factor in holdings of non-infringement is that the patent practitioner didn't pay sufficient attention to *In re Zahn* while the application was being drafted. This seems to be confirmed by *Elmer*, where the court openly questioned the patentee's drafting of the drawings.[26]

What is the simple rule that design patent practitioners need to follow? It is this: ***eliminate unnecessary detail from the design patent drawings.*** If you do, you will be doing no more than a skilled patent lawyer does when she drafts utility patent claims, and you'll be joining the ever-expanding ranks of enlightened design patent practitioners. Even more importantly, your clients' design patents won't be so easy to get around.

V. Details, Details, Details

Before *Elmer* was decided, but long after *Zahn* was handed down, there abounded many sad tales of overclaiming, cases in which the outcome may well have been different had the "claimed design" not been drawn in such detail.[27]

In ***FMC Corp. v. Hennessy Industries, Inc.***, 2 USPQ2d 1479 (N.D. Ill. 1986), *aff'd.*, 836 F.2d 521, 5 USPQ2d 1272 (Fed. Cir. 1987), the patented design was for an automatic tire changer (FIG. D). The defendant's FMC Vulcan design was, at first glance, quite similar. The

24 Saidman, **The Ten Commandments of Design Patent Protection,** *innovation*, Fall, 1990, p. 21.

25 To protect the broad, intermediate and narrow design inventions, however, will likely require three design patents, in contrast to an analogous utility patent situation.

26 *Elmer v. ICC Fabricating, Inc.*, 36 USPQ2d 1417, 1421 (Fed. Cir. 1995) ("If, as HTH now contends, the vertical ribs and upper protrusion were functional, not ornamental, features, HTH could have omitted these features from its patent application drawings. HTH did not do so, however, and thus effectively limited the scope of its patent claim by including those features in it.").

27 I do not present these examples to criticize those who prepared the design patent applications in question; my intent is only to use them as learning tools for the future. In fact, I feel obliged to admit that, prior to my own "enlightenment" in 1986, I prepared more than a few design patent applications that also had literal picture claims; I was very fortunate that none were ever litigated. Also, as ever, hindsight is 20-20.

FMC V. HENNESSY

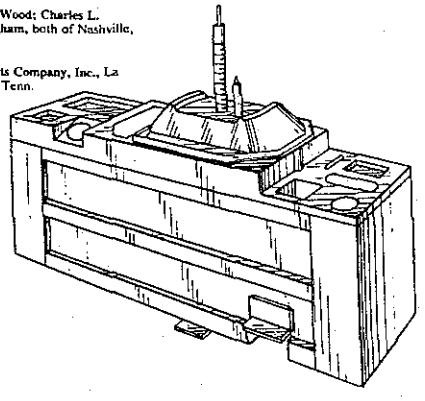
United States Patent [19]
Wood et al.

[11] Des. 243,551
[45] ** Mar. 1, 1977

[54] TIRE CHANGING APPARATUS OR SIMILAR ARTICLE

[75] Inventors: John F. Wood; Charles L. Cunningham, both of Nashville, Tenn.

[73] Assignee: The Coats Company, Inc., La Vergne, Tenn.



FMC Vulcan Tire Changer
Allegedly Infringing Design

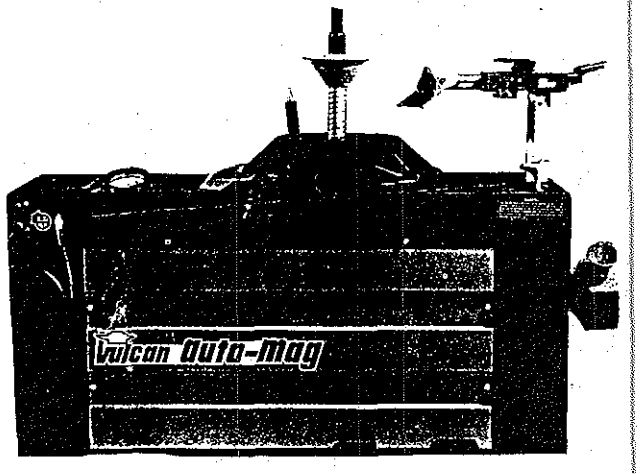


FIG. D

accused design in fact appeared much closer to the patented design than did the prior art (FIG. E). After confirming that the patented design was indeed novel and unique compared to the prior art, the lower court nevertheless determined that the accused design did not infringe. The district court said.[28]

In the design patent the top is of three levels, the gauge is recessed, and there are four trays. The top bracing is relatively narrow. The panel ribs are narrow, the recesses wide. The accused design has a flat top; the gauge projects above the top; there is one large tray on the left and one small well to the right; the top bracing is wider and heavier; the ribs are considerably wider and the recesses considerably narrower. 2 USPQ2d at 1479.

Look at all the unnecessary detail[29] illustrated in the design patents, avoided by the infringer, and focussed upon by the court.

In ***Lee v. Dayton-Hudson Corp.***, 666 F.Supp. 1072, 2 USPQ2d 1300 (E.D. Tenn. 1987), *aff'd.* 838 F.2d 1186, 5 USPQ2d 1625 (Fed. Cir. 1988), the district court, in another bittersweet decision that is typical in design patent cases, held that a design patent on a massage implement (FIG. F) was novel and nonobvious over the prior art, but was not infringed by the defendant's two Matrix models (FIG. G). When compared to the prior art, one can easily see that the patentee was the first to design a massage implement having the general configuration of an elongated, solid handle having two spherical balls diametrically opposed and rotatable about the same axis that was perpendicular to the handle at one end thereof. Also, as with the previous case, the defendant's accused designs were closer to the patented design than any of the prior art. Nevertheless, the district court in its analysis focussed on the following differences:

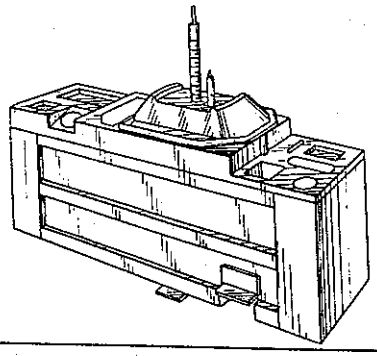
(1) the handle of Lee is wider at the bottom while the handles of the alleged infringements are roughly of equal width at each end; (2) the wooden handles of the alleged infringements extend all of the way up to the equator of the balls while Lee has a metal "T" device extending from the end of the wooden handle and to which the balls are attached; (3) Lee has a metal cap on the end of each of the balls while no caps appear on the balls of the alleged infringements; (4) most significantly, the alleged infringements have smooth wooden balls while the pat-

28 The court acknowledged the difficulty it was having: "A determination of the [design patent] infringement issue is somewhat of an existential exercise." 2 USPQ2d at 1490. It's unfortunate that some courts still feel unable to objectively evaluate design patent infringement issues.

29 Unnecessary from the standpoint that it was not required to distinguish over the prior art; less detail would clearly have been sufficient for the design concept to have been found patentable.

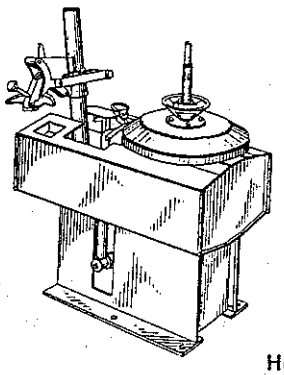
FMC V. HENNESSY

U.S. Patent No. Des. 243,551



Prior Art Cited

U.S. Patent No. Des. 213,914 Simkins



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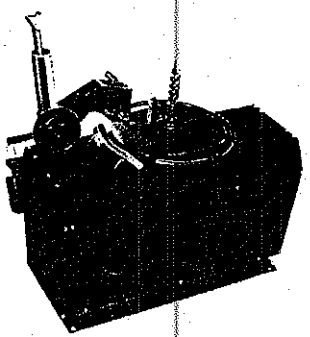


Hennessy Coats 20-20SA

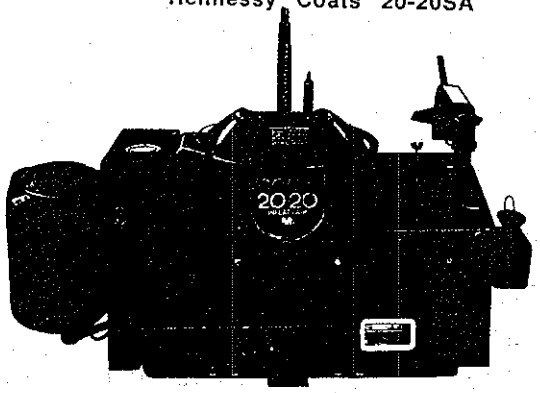
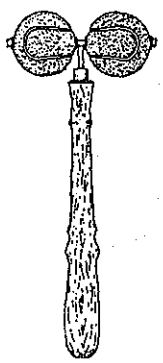


FIG. E

LEE V. DAYTON-HUDSON

U.S. Patent No. Des. 259,142



Prior Art Cited

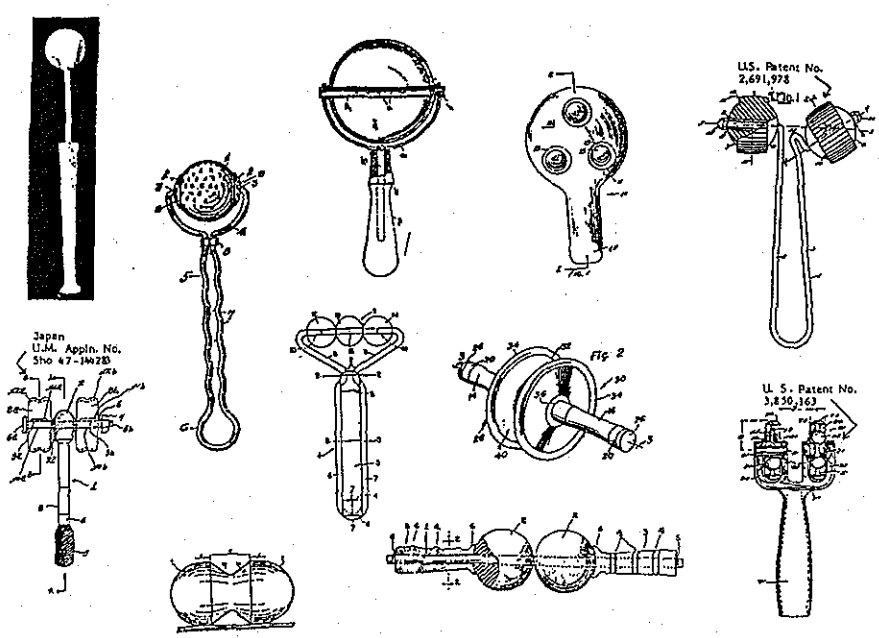


FIG. F

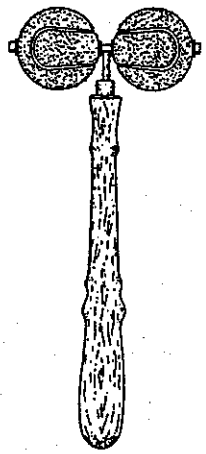
LEE V. DAYTON-HUDSON

United States Patent [19]
Lee et al.

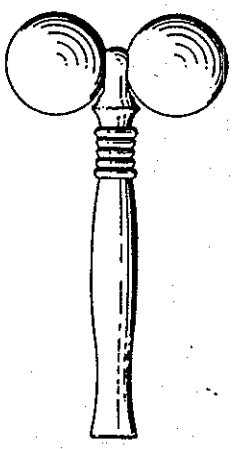
[11] Des. 259,142
[45] ** May 5, 1981

[54] MASSAGE IMPLEMENT

[76] Inventors: Robert W. Lee, Rte. 1, Box 42, Baxter, Tenn. 38544; Robert H. Folkerson, 1009 E. Pearl St., Hazel Park, Mich. 48030



Matrix Model 1050
Allegedly Infringing Design



Matrix Model 50
Allegedly Infringing Design

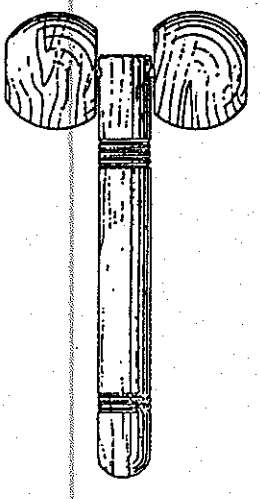


FIG. G

ented device has tennis balls having a fuzzy appearance and a continuous seam. 2 USPQ2d at 1302.

Was it really necessary to draft such a narrow claim that was seemingly so easy to avoid, even by defendants who took the general design concept? Would it not have made for a broader claim to, for example, "genericize" the balls by drawing them as smooth, unadorned spherical elements rather than as tennis balls?[30]

Bush Industries Inc. v. O'Sullivan Industries, Inc., 772 F.Supp. 1442, 21 USPQ2d 1561 (D.Del. 1991), was a suit for infringement of 5 design patents for RTA (ready-to-assemble) furniture. FIGS. H, J, and K show three of the five design patents that were litigated next to the defendant's accused designs; the wording and labels are taken from the successful defendant's exhibits in the case. Here's what the district court said:

(1) [Regarding the '888 patent] the key distinguishing feature is Bush's use of two framed vertical glass doors to cover all of the shelves on the left side of the piece; the alleged infringing piece has only one framed glass door. (2) [Regarding the '664 patent] only the Bush [patented] design includes rails and pilasters around the VCR cavity; this distinction renders the Bush piece more full-bodied in appearance. (3) [Regarding the '530 patent] the Bush design employs only subtle shaped edges for its drawers, while O'Sullivan contains widely framed drawers with recessed inner panels. In addition, the absence of rails and pilasters in O'Sullivan's designs is particularly apparent in the desk. 21 USPQ2d at 1566, 1567.

As you can by now appreciate, the patentee's drawings are replete with details, a lot of which may have served as a roadmap for the accused infringer in designing around the plaintiff's design patents.

The ***Keystone Retaining Wall Systems, Inc. v. Westrock, Inc.*** case, 997 F.2d 1444, 27 USPQ2d 1297 (Fed. Cir. 1993), is particularly sad because the problem with the plaintiff's design patent is (excuse the expression) so obvious. The lower court found that when plaintiff's and defendant's blocks (FIG. L) are placed in a retaining wall, they look virtually identical. Therefore, on appeal the patentee Keystone argued that only the front face of the '463 block design was ornamental and it alone should have been considered for infringement purposes,

30 The district court was affirmed on appeal, 838 F.2d 1186, 5 USPQ2d 1625 (Fed. Cir. 1988). The Federal Circuit's opinion is significant for its acknowledgment (at 5 USPQ2d 1628) that the doctrine of equivalents for design patents is alive and well, citing not only *Gorham*, but also *Schnadig Corp. v. Gaines Mfg. Co.*, 494 F.2d 383, 391-92, 181 UPSQ 417, 423 (6th Cir. 1974), and *Sanson Hosiery Mills, Inc. v. Warren Knitting Mills, Inc.*, 202 F.2d 395, 397, 96 USPQ 247, 249 (3rd Cir. 1953) in support thereof.

BUSH V. O'SULLIVAN

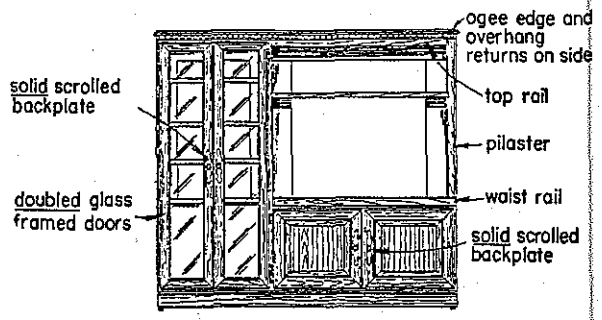
United States Patent [19]
Bush et al.

[11] Patent Number: **Des. 300,888**
[45] Date of Patent: ** **May 2, 1989**

[54] ENTERTAINMENT CENTER

[75] Inventors: Paul Bush, Lakewood, N.Y.; Bruce O. Anderson, Talbott, Tenn.

[73] Assignee: Bush Industries, Inc., Jamestown, N.Y.



O'Sullivan 79719 Entertainment Center
Allegedly Infringing Design

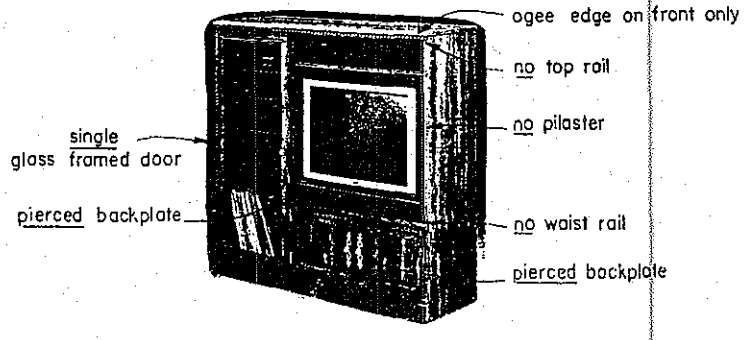


FIG. H

since the other features are all concealed when in an assembled retaining wall. The Federal Circuit disagreed. In affirming the finding of non-infringement, the court said the '463 claimed design includes the entire retaining wall block,[31] not solely the front face. Thus, under *Gorham v. White*, the entire block of defendant must be substantially the same

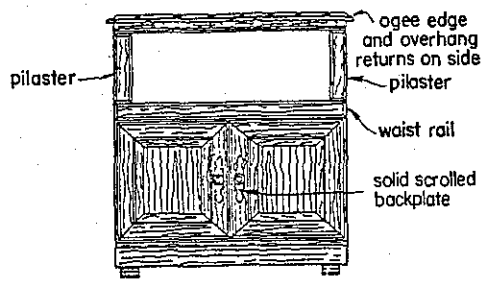
31 because the entire retaining wall block was illustrated in the drawings.

BUSH V. O'SULLIVAN

United States Patent [19]
Bush et al.

[11] **Patent Number: Des. 301,664**
[45] **Date of Patent: ** Jun. 20, 1989**

[54] **VIDEO STORAGE CART OR THE LIKE**
[75] Inventors: Paul Bush, Lakewood, N.Y.; Bruce O. Anderson, Talbott, Tenn.
[73] Assignee: Bush Industries, Inc., Jamestown, N.Y.



O'Sullivan 74710 Utility Cart Allegedly Infringing Design

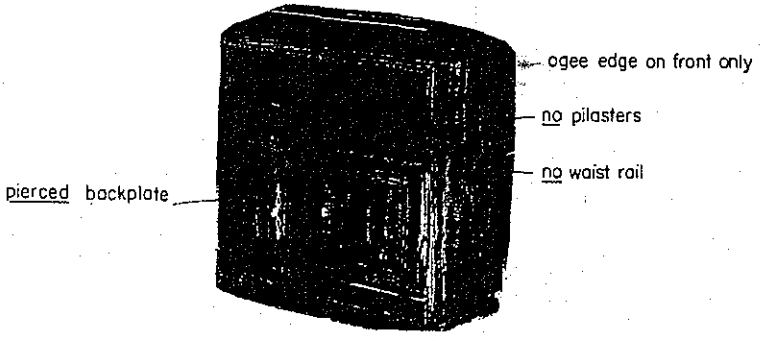


FIG. J

as the entire claimed block of the patentee for infringement to be found.[32] Concerning plaintiff's argument that part of the block is hidden in use, the court said:

32 *Keystone*, 27 USPQ2d at 1302 ("Thus, one cannot establish design patent infringement by showing similarity of only one part of a patented design if the designs as a whole are substantially dissimilar . . . If the claimed design were to a retaining wall, not to the whole retaining block, the inquiry would be different.").

BUSH V. O'SULLIVAN

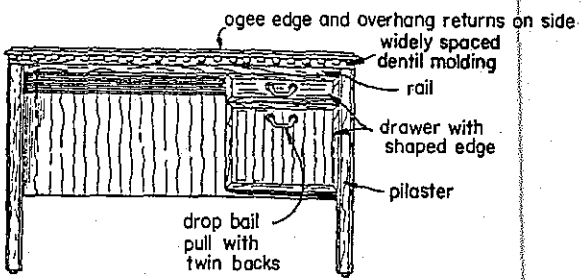
United States Patent [19]
Bush et al.

[11] **Patent Number: Des. 304,530**
[45] **Date of Patent: ** Nov. 14, 1989**

[54] **DESK**

[75] Inventors: Paul Bush, Lakewood, N.Y.; Bruce O. Anderson, Talbott, Tenn.

[73] Assignee: Bush Industries, Inc., Jamestown, N.Y.



O'Sullivan 50712 Desk (with Hutch)
Allegedly Infringing Design

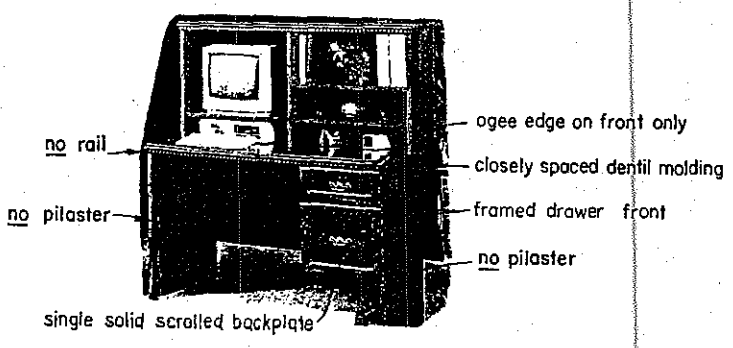


FIG. K

As regards the patented block, there is no hidden portion. As a block, all parts of it are visible. When incorporated in a wall, it ceases to be visible as a block. Keystone also owns patents on wall designs, but those patents are not in issue, the only issue here being infringement of a block design. 27 USPQ2d at 1302.

KEYSTONE V. WESTROCK

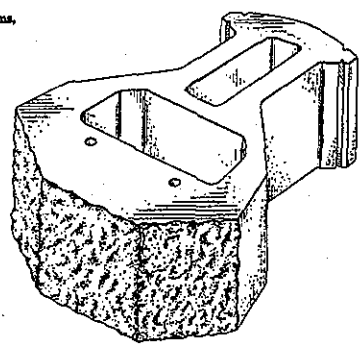
United States Patent [19]
Forsberg

[11] **Patent Number: Des. 298,463**
[45] **Date of Patent: ** Nov. 8, 1988**

[54] RETAINING WALL BLOCK

[75] Inventor: Paul J. Forsberg, Richfield, Minn.

[73] Assignee: Keystone Retaining Wall Systems, Inc., Edina, Minn.



Westblock's "Stonewall" Blocks Allegedly Infringing Design

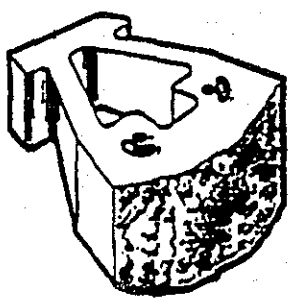


FIG. L

This result suggests a hypothetical claim for Keystone (see FIG. M) that takes *In re Zahn*[33] into account and perhaps would have fared a little better in this case against the accused product.

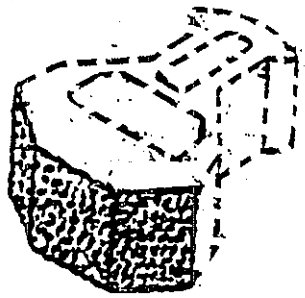
V. CLAIM DRAFTING 101

What will our new, broad design patent claims look like? Let's look at a few hypothetical and real examples.

33 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

KEYSTONE V. WESTROCK

HYPOTHETICAL NEW CLAIM



Westblock's "Stonewall" Blocks Allegedly Infringing Design

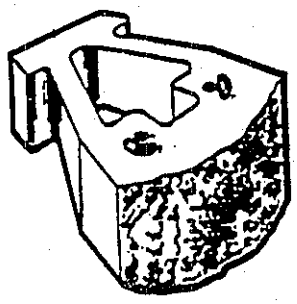


FIG. M

In FIG. N are shown two possible modifications to the design claimed in U.S. Pat. No. Des. 306,018 that would broaden the scope of the claimed design.[34] The ''broader'' and ''broadest'' examples were created by simply removing claimed details from the ''narrow'' embodiment. In a similar manner, FIG. P shows the same process applied

34 These examples were not guided by any consideration of the prior art.

HOW TO IMPROVE PROTECTION

U.S. PATENT NO. Des. 306,018
INTEGRAL FACSIMILE AND TELEPHONE
Kuzo Hara, Chiba, and Shiniehi Hiroki, Tokyo, both of Japan, assignors to Kabushiki Kaisha Toshiba, Kawasaki, Japan
Filed Nov. 30, 1987, Ser. No. 126,679
Claims priority, application Japan, Jun. 2, 1987, 62-22531
Term of patent 14 years
U.S. Cl. D14—118

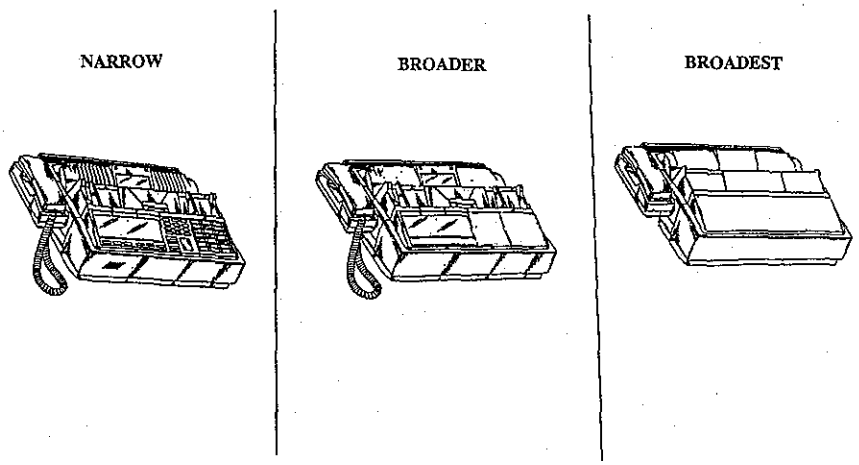


FIG. N

to U.S. Pat. No. Des. 305,998. For those who think that the "broadest" design in this example may be unpatentable due to §112 requirements or due to the prior art, the latter are certainly valid considerations that should be taken into account (as they always are in utility patent claims) when doing your claim drafting. However, just as with utility claims, design patent claims should be drafted as broadly as the prior art will allow in order to obtain for the designer the rightful scope of protection to which she is entitled.

A real life example occurred for an athletic footwear manufacturer who, after bringing out a very successful basketball shoe (whose upper design was covered literally by U.S. Pat. No. 291,144; FIG. Q), discovered that the competition was knocking off only the forefoot side support straps, which formed a relatively small portion of the overall design claimed in the '144 patent. Fortunately, this problem was noted before the '144 patent issued and, taking full advantage of *Zahn*, a divisional application was filed claiming only the forefoot straps, which eventually issued as U.S. Pat. No. Des. 299,583. The latter patent stopped the forefoot strap knockoffs in their tracks.

HOW TO IMPROVE PROTECTION

U.S. PATENT NO. Des. 305,998

AUTOMOBILE

Hans Lagaay, Herrsching, Fed. Rep. of Germany, assignor to Bayerische Motoren Werke AG, Fed. Rep. of Germany

Filed Jan. 29, 1987, Ser. No. 8,416

Claims priority, application Fed. Rep. of Germany, Jul. 30, 1986, MR 16768

Term of patent 14 years

U.S. Cl. D12—92

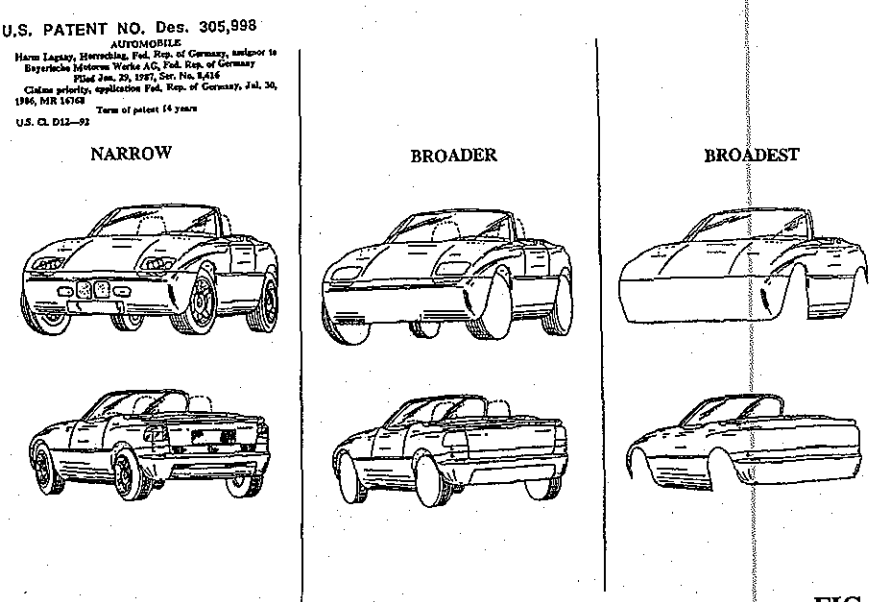


FIG. P

One of the disadvantages of design patents compared to utility patents is that in the latter, even though you are supposed to claim only one ''invention'' in any single application,[35] you are nevertheless permitted to present a range of claims to the invention from broad to intermediate to narrow. Under present design patent practice, this is not allowed since you can have only one claim in a design patent.[36] Thus, if you want a range of design protection for a product, you need to file several applications, each claiming a different design aspect. A good example of this are the seven design patents that cover various ornamental features of a new flatware design. All three pieces (the knife, fork and spoon each in combination with a handle) were covered in the first design patent (No. Des. 346,722; FIG. R), while the second patent covered the handle (Des. 345,486). The third, fourth and fifth design patents covered the underlying knife, fork and spoon without handles (Des. 345,284; 358,741; and 351,091; FIG. S). Two more design patents were obtained: one on the combination of the support knob and handle

35 35 U.S.C. §121; 37 C.F.R. §1.141; M.P.E.P. §802 (Rev. 1, Sept. 1995).
36 M.P.E.P. §§1503.03, 1504.05 (Rev. 1, Sept. 1995).

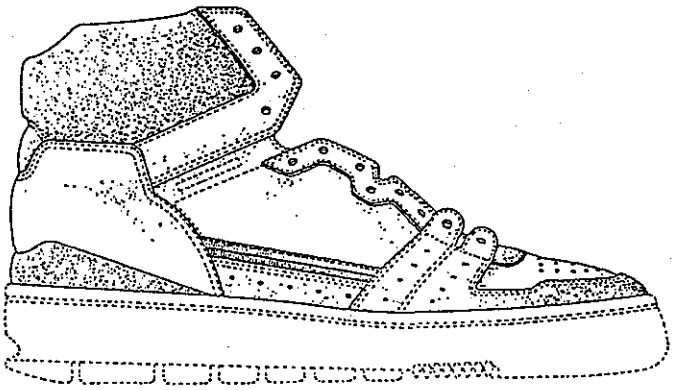
United States Patent [19]
Tong et al.

[11] **Patent Number: Des. 291,144**
[45] **Date of Patent: .. Aug. 4, 1987**

[54] SHOE UPPER

[75] Inventors: James K. Tong, Portland; Bruce MacGregor, Lake Oswego, both of Oreg.

[73] Assignee: Puma, Inc., Portland, Oreg.



United States Patent [19]
Tong et al.

[11] Patent Number: Des. 299,583
[45] Date of Patent: .. Jan. 31, 1989

[54] ELEMENT OF A SHOE UPPER

[75] Inventors: James K. Tong, Portland, Oreg.

[73] Assignee: AVIA Group International, Inc., Portland, Oreg.

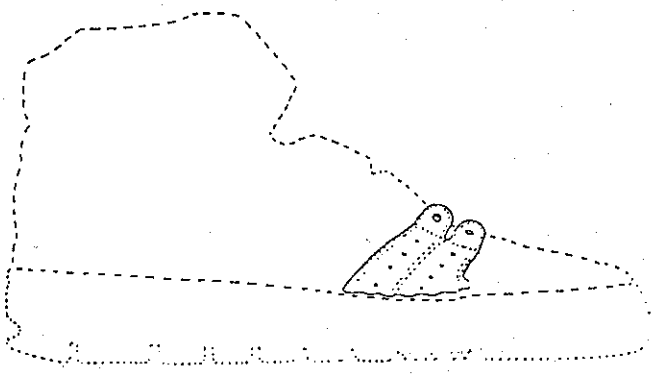


FIG. Q

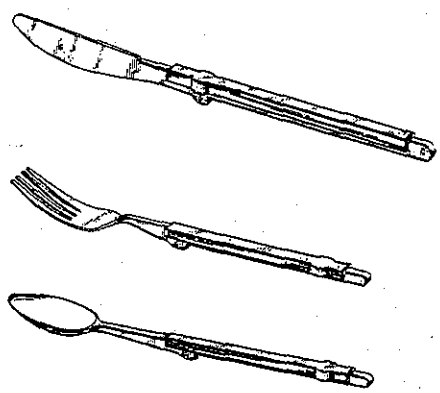
FLATWARE DESIGNS

United States Patent [19]
Burdick et al.

[11] **Patent Number: Des. 346,722**
[45] **Date of Patent: ** May 10, 1994**

[54] FLATWARE
[75] Inventors: Bruce Burdick; Susan K. Burdick, both of San Francisco, Calif.
[73] Assignee: The Burdick Group, San Francisco, Calif.

Primary Examiner—Alan P. Douglas
Assistant Examiner—Caron D. Veynar
Attorney, Agent, or Firm—Saidman Design Law Group



United States Patent [19]
Burdick et al.

[11] **Patent Number: Des. 345,486**
[45] **Date of Patent: ** Mar. 29, 1994**

[54] HANDLE FOR FLATWARE
[75] Inventors: Bruce Burdick; Susan K. Burdick, both of San Francisco, Calif.
[73] Assignee: The Burdick Group, San Francisco, Calif.

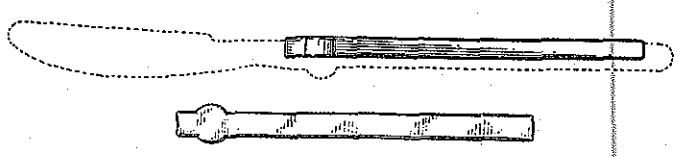


FIG. R

flanges (Des. 355,565; FIG. T), and the *pièce de résistance*, U.S. Pat. No. Des. 351,310 (FIG. U) covering the support knob alone.

These examples illustrate the possibilities of *In re Zahn*.

As utility patent attorneys, we are taught to be lexicologists, wordsmiths, in drafting *in words* the broadest allowable claim possible.

United States Patent [19]
Burdick et al.

[11] **Patent Number: Des. 345,284**
[45] **Date of Patent: ** Mar. 22, 1994**

[54] KNIFE

[75] Inventors: Bruce Burdick; Susan K. Burdick, both of San Francisco, Calif.

[73] Assignee: The Burdick Group, San Francisco, Calif.

United States Patent [19]
Burdick et al.

[11] **Patent Number: Des. 358,741**
[45] **Date of Patent: ** May 30, 1995**

[54] FORK

[75] Inventors: Bruce Burdick; Susan K. Burdick, both of San Francisco, Calif.

[73] Assignee: The Burdick Group, San Francisco, Calif.

United States Patent [19]
Burdick et al.

[11] **Patent Number: Des. 351,091**
[45] **Date of Patent: ** Oct. 4, 1994**

[54] SPOON

[75] Inventors: Bruce Burdick; Susan K. Burdick, both of San Francisco, Calif.

[73] Assignee: The Burdick Group, San Francisco, Calif.

FIG. S

On the other hand, as a design patent lawyer you need to exercise your right brain and become a "picture-smith" in order to draft the broadest claim possible. ***Do it***, and your design patent clients will be thrilled with the results. Their design patents will actually discourage the knock-offs.

United States Patent [19]
Burdick et al.

[11] **Patent Number: Des. 355,565**
[45] **Date of Patent: ** Feb. 21, 1995**

[54] **FLATWARE SUPPORT KNOB AND HANDLE FLANGES**

[75] Inventors: **Bruce Burdick; Susan K. Burdick, Both of San Francisco, Calif.**

[73] Assignee: **The Burdick Group, San Francisco, Calif.**

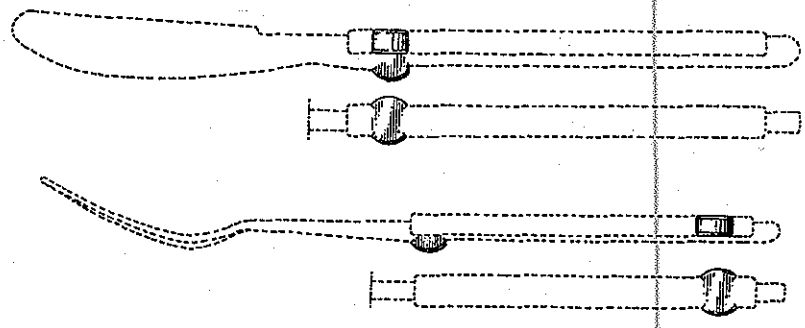


FIG. T

VII. Did the Court Fudd Up Elmer?

Let's now take a closer look at *Elmer*, a case where the patentee made only minor changes to one of his utility patent drawings before using it as one of his design patent drawings (FIG. W), including the perfunctory omission of reference numerals.

Upon close inspection, the Federal Circuit's analysis in *Elmer* has two potential problems. First, accused infringers will interpret the decision to try and undercut the thrust of at least *Read*,[37] and perhaps eventually *Litton*.[38] Second, the court may not have gone far enough in applying standard rules of claim construction to the design patent claim. Let's take a look at these potential problems, in turn.

The patentee Elmer relied on *Read v. Portec*[39] to argue that the defendant's product does not need to include functional elements shown in Elmer's design patent drawings. In the *Read* case, there was a major

37 *supra*, note 3.
38 *supra*, note 6.
39 *supra*, note 3.

United States Patent [19]
Burdick et al.

[11] **Patent Number: Des. 351,310**
[45] **Date of Patent: ** Oct. 11, 1994**

[54] **FLATWARE SUPPORT KNOB**

[75] Inventors: **Bruce Burdick; Susan K. Burdick, both of San Francisco, Calif.**

[73] Assignee: **The Burdick Group, San Francisco, Calif.**

FIG.1

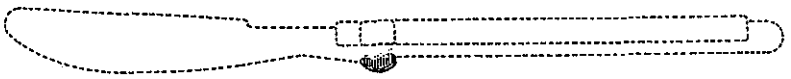


FIG.2

FIG.3

FIG.4

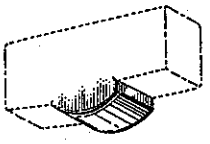


FIG. U

Zahn problem in that the design patent drawings seemed to illustrate every possible element of a portable loam screening plant (see FIG. X). The only testimony at trial going to infringement was given by the inventor Mr. Read, who essentially was asked whether the defendant's machine and his were substantially the same in overall appearance, to which he responded "yes".[40] The Federal Circuit reversed the district court's finding of infringement under *Gorham*, saying that where a design is composed of functional and ornamental features (as the literal picture claim drawings of Read's design patent were), to prove infringement you must show that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ***ornamental***.[41] This suggests that one first needs to identify the patented ornamental elements, and then make sure that one's or-

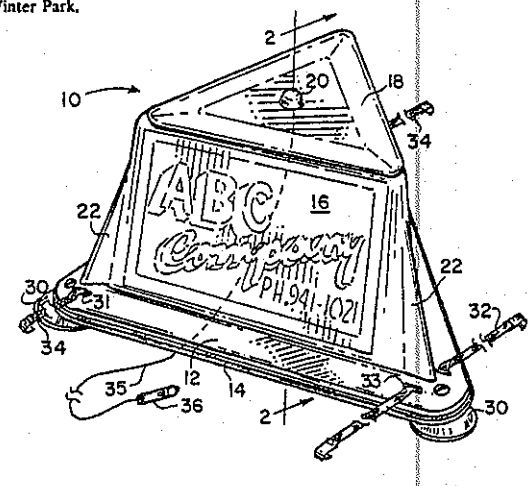
40 *Read*, 23 USPQ2d at 1434.
41 *Id.*

United States Patent [19]
Elmer

[11] Patent Number: 4,667,428
[45] Date of Patent: May 26, 1987

[54] TRIANGULAR CAR TOP SIGN

[76] Inventor: William A. Elmer, 917 N. Pennsylvania Ave., Winter Park, Fla. 32789



United States Patent [19]
Elmer

[11] Patent Number: Des. 290,620
[45] Date of Patent: ** Jun. 30, 1987

[54] VEHICLE TOP SIGN HOLDER

[76] Inventor: William A. Elmer, 917 N. Pennsylvania Ave., Winter Park, Fla. 32789

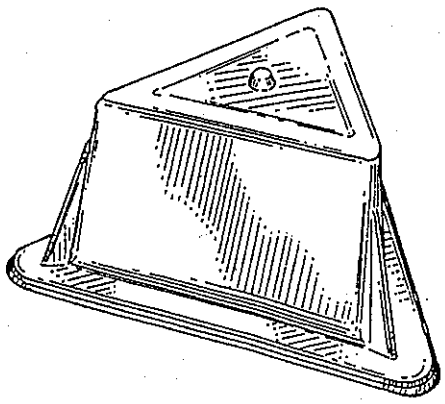


FIG. W

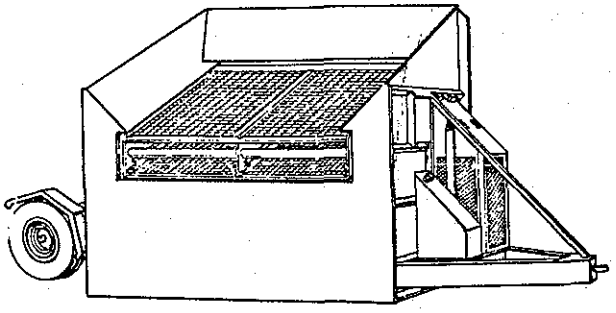
United States Patent [19]
Read

[11] **Des. 263,836**
[45] ** **Apr. 13, 1982**

[54] **PORTABLE SCREENING PLANT**

[75] Inventor: **James L. Read, Halifax, Mass.**

[73] Assignee: **F. T. Read & Sons, Inc., Rockland, Mass.**



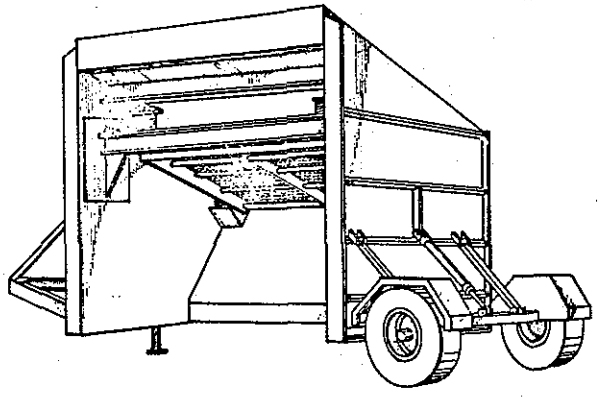


FIG. X

dinary observer comparison under *Gorham* is between those ornamental elements and corresponding elements in the accused device. Thus, for Mr. Read to simply have said that the overall appearances of the two

designs were similar may have given too much weight to similar functional elements of the designs, and not enough weight to similar ornamental elements of the designs.

The *Elmer* patentee tried to use the *Read* decision offensively in an attempt to eliminate certain allegedly functional design elements.[42] from the scope of his claim,[43] (the same design elements which were missing from the defendant's product). Although the *Read* court's ruling was that the patentee had failed to properly prove infringement under *Gorham* because there was no proof at trial that the ordinary observer was comparing only ornamental elements, the *Read* court in effect was compensating for a narrowly drafted design patent claim, one which presumably included many functional as well as ornamental elements. For years, courts have been similarly compensating for narrow design patent claims in applying the *Litton* "point of novelty" test.

The *Litton* point of novelty test says that no matter how similar the overall appearance of an accused product is to a claimed design under *Gorham*, it doesn't infringe the design patent unless the accused product also incorporates the novel elements which distinguish the patented design from the prior art.[44] In pre-*Zahn* times, this rule of law seemed to serve two purposes: first, it prevented a finding of infringement if the accused product did no more than appropriate old elements from the design illustrated in the design patent, and second, it seemed to compensate design patentees for submitting an unduly narrow "picture" claim. In other words, prior to *Zahn* design patent applicants were *required* to claim the whole product; thus, the point of novelty test was a convenient construct for a court to determine what was really novel about the claimed design. That is, courts were in essence drafting a claim for the design patentee that took into account the prior art. Only if that hypothetical "claim" was "infringed" (i.e., the novel elements were found in the accused device) would the test be met.

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42 *supra*, note 3.

43 While *Read v. Portec* makes sense, no court has ever articulated *how* to go about identifying the functional features and the ornamental features in a design patent drawing. One might surmise that it could be done by applying the alternative designs test on an element-by-element basis. *See* Saidman and Hintz, **The Doctrine of Functionality in Design Patent Cases**, *19 U. Balt. L. Rev. 352* (Fall 89-Winter 90).

44 *supra*, note 6. This rule of law goes much farther back than *Zahn*, see, e.g., *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 60 USPQ 434 (8th Cir. 1944), *Applied Arts Corporation v. Grand Rapids Metalcraft Corporation*, 67 F.2d 428 (6th Cir. 1933).

In the post-*Zahn* era, the rule of *Litton* seems to serve the same two functions, even though the picture claim requirement was abolished by *Zahn*.[45]

A fair reading of *Read* is that the *Gorham* ordinary observer comparison between the accused product and the claimed design must be based on the claimed ornamental features. That is, it is irrelevant to a finding of infringement under *Gorham* whether functional elements shown in the drawings appear or don't appear in the accused device as long as the overall resemblance is substantially the same.

A fair reading of *Litton* is that, given that the overall resemblance is substantially the same, the basis for granting the design patent (i.e., the novel elements) must appear in the accused device. That is, it is irrelevant to the *Litton* infringement determination whether "old" elements shown in the drawings appear or don't appear in the accused device as long as the overall resemblance is substantially the same (the *Gorham* test).

Accused infringers will, of course, attempt to interpret *Elmer* as saying that if functional elements are shown in the drawings, and they do not appear in the accused device, infringement cannot be made out. If according to this interpretation patentees are stuck with what's shown in the drawings, it won't matter if some elements are determined to be legally functional under *Read*. If this turns out to be the law, then *Elmer* would amount to a preemptive strike at *Read*; even before applying the *Gorham* test, *Read* would be discounted because it wouldn't then matter if your drawings showed functional elements.

The next logical argument for the alleged infringer would be that it doesn't matter if your drawings show old elements, since the design patentee had the option of illustrating them or not. If she did not want them in her claim, the argument would go, then she shouldn't have illustrated them. Thus, the alleged infringer would argue that if the functional or old elements show up in your drawings but not in the accused device, too bad, you lose!

The foregoing, fortunately, is not the law according to *Elmer*. The *Elmer* court did not disavow *Read, Gorham* or *Litton*. In fact, it cited all three cases with approval. In considering the *Read* test, the key finding seems to be that the court regarded the vertical ribs and upper

45 *Zahn* was decided in 1980. By the time *Litton* was decided in 1984, the idea had not become particularly widespread to leave out old elements from one's design patent drawings; in fact, the idea to do so is not particularly widespread today, as a glance through any issue of the *Official Gazette* will bear out.

protrusion as "[giving] the sign a distinctive ornamental appearance."[46] In other words, there is an implicit finding that the court regarded these two key features to be primarily ornamental rather than primarily functional.[47] It is well to keep in mind that claimed features are not legally functional merely because they perform a function; almost all design features perform some sort of function.[48] Thus, in contrast to *Read*, the *Elmer* court was not saying that functional elements had been erroneously included in the *Gorham* analysis; it was saying that the two elements in question were not legally functional.[49] The *Elmer* court also properly applied the *Gorham* ordinary observer test, and also quite properly omitted an analysis under *Litton* since the *Gorham* test failed.

Moreover, if the *Elmer* court had intended to eviscerate 125 years of case law and move towards a black and white literal infringement test for design patents, it would have said so. However, such a view would not be in accordance with the law which incorporates a doctrine of equivalents for design patents,[50] requires us to set aside consideration of legally functional elements (even if they are shown in the drawings),[51] and requires us to set aside consideration of old elements (even if they are shown in the drawings).[52]

Using the guise of claim interpretation, alleged infringers will be trying to limit the rightful scope of protection to which design patentees are entitled, in contravention of *Gorham, Litton* and *Read*. If the alleged infringer's view of *Elmer* becomes ensconced as the law, it will eliminate the notion of scope for design patent claims, a notion that goes back to the seminal Gorham case.[53]

Claim Scope Determination For Design Patents

In patent claim interpretation, it is quite common in determining the meaning and scope of utility patent claims to review the language of the patent, the prosecution history and the prior art:

Claim interpretation involves a review of the specification, the prosecution history, the claims (including unasserted as well as asserted claims) and, if necessary, other

46 *Elmer v. ICC Fabricating, Inc.*, 36 USPQ2d 1417, 1421 (Fed. Cir. 1995).
47 *supra*, note 43.
48 *supra*, note 13.
49 In the patent drawings these two features loom large in the overall aesthetic appearance of the relatively simple and unadorned claimed design.
50 *supra*, note 30 and *infra*, note 54.
51 *supra*, note 3.
52 *supra*, note 6.
53 *supra*, note 2 and *infra*, note 54.

extrinsic evidence, such as expert testimony. *Texas Instruments Inc. v. U.S. Int'l. Trade Comm'n.*, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993).

During consideration of the prosecution history, the prior art comes into play:

> The prosecution history gives insight into what the applicant originally claimed as the invention, and often what the applicant gave up in order to meet the Examiner's objections. Prosecution history is especially important when the invention involves a crowded art field, or when there is particular prior art that the applicant is trying to distinguish. *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 23 USPQ2d 1284 (Fed. Cir. 1992).

If the claimed invention is close to the prior art, then the scope of the claim is narrow. If the claimed invention is not close to the prior art, then the scope of the claim is broad. The same analysis should hold for design patent claims, especially given that *Gorham v. White* incorporates a doctrine of equivalents for design patents.[54]

Where in *Elmer* is the court's consideration of the prosecution history? Where in *Elmer* is the court's consideration of the prior art? Where in *Elmer* is the court's consideration of extrinsic evidence?

Perhaps the *Elmer* court did not need to delve into the prosecution history or the prior art in order to determine the meaning and scope of this particular claim; perhaps on these facts claim "language" (i.e., the drawings) interpretation was enough. In other cases, of course, a more in-depth analysis of the meaning and scope of a design patent claim may be in order.

VIII. Where Do We Go from Here?

One can argue that the Federal Circuit's first foray into claim interpretation as a matter of law for a design patent was somewhat perfunctory or superficial. However, if the events that occurred subsequent to the 1988 *In re Mann* case are any indication, the *Elmer* decision will likely become the rallying cry for every defendant whose design differs at all from that shown in the design patent drawings; such defendants can be expected to argue in effect that only literal infringement matters in design patents. Although, as noted above, this is not an accurate reading of the law, the *Elmer* case illustrates the debilitating effect of

54 The Supreme Court in *Gorham v. White*, 81 U.S. (14 Wall.) 511, 530 (1871), after comparing the allegedly infringing White design to Gorham's patented design, said: "*Is the adornment in the White design used instrumentally to produce an appearance, a distinct device, or does it work the same result in the same way, and is it, therefore, a colorable evasion of the [Gorham] patent, amounting at most to a mere equivalent?*"

letting go uncorrected loose *dicta* from previous cases,[55] which design patent litigants are then put to the not inconsiderable expense of trying to correct.

Design owners who have not yet applied for their patents might want to craft their design patent claims (i.e., drawings) with great care.[56] In addition, the *Elmer* court admonished:

> *[B]ecause no other design is disclosed in the '620 patent*, we interpret the claim as being limited to a design that includes among its ornamental features triangular vertical ribs and an upper protrusion. (emphasis added)[57]

Design patent applicants should therefore consider adding some prophylactic disclosure to their design patent specification to either specifically disclose other, alternate designs or at least say that other designs are possible.[58]

One possible remedy for those who already have a design patent application pending might be to consider filing one or more divisional applications claiming only those portions of the design deemed novel and ornamental.[59]

If your design patent has issued within the last two years, consider filing for one or more broadened reissues, since you may have claimed more or less than you had a right to claim originally.[60]

If your design patent issued over two years ago, you can argue that *Elmer* did not overrule *Read, Gorham* or *Litton*, but cited all three with approval. Moreover, *Elmer* was specifically limited to its facts.[61] You can also argue in an appropriate case that under *Markman*, claim construction requires an examination not only of the language of the claim (in a design patent, the drawings), but the prosecution history and the prior art as well, in order to reach a more reasoned determination of the scope of the claim of a design patent.

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55 *supra*, note 2.

56 See § VI, *supra*.

57 *Elmer*, 36 USPQ2d at 1421.

58 Sample prophylactic language: "This design is not limited to the exact details shown in the drawings, since equivalents and colorable imitations thereof will be evident to a person of ordinary skill in the art. Thus, within the scope of the appended claim, which is intended to cover only the ornamental and novel elements shown in the drawings, the invention may be practiced otherwise than as specifically shown and described herein."

59 M.P.E.P. § 1504.20 [R-1] (Rev. 1, Sept. 1995).

60 M.P.E.P. § 1509 (Rev. 1, Sept. 1995).

61 In *Elmer*, the claimed design was fairly simple (i.e., was not possessed of surface decoration and did not have a lot of elements), and the alleged functional elements indeed loomed large in the overall ornamental appearance of the relatively simple design.