A PRIMER ON DESIGN PATENT FUNCTIONALITY

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INTRODUCTION

Professor Peter S. Menell and J.S.D. Candidate Ella Corren of the University of California, Berkeley, School of Law have published a paper entitled "DESIGN PATENT LAW'S IDENTITY CRISIS."[1] That paper formed the basis of a conference held February 18, 2021 "Navigating and Rectifying the Design Patent Muddle." Both of which focused on the issue of design patent functionality. In an extensively researched 145-page paper, they describe the "muddle" thusly:

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† Design Lawyer, Perry Saidman, LLC. This essay was prepared for the BCLT Design Patent Symposium (February 19, 2021). It is an explanation of some basic design patent law realities drawn from my many years in private practice. The opinions expressed herein are those of the author only and do not necessarily represent those of any client, past or present.

1. Peter S. Menell & Ella Corren, *Design Patent Law's Identity Crisis*, https://papers.ssrn.com/sol3/papers.cfm?abstract_id=366803237

> The [IP] system requires that functional advances meet the higher thresholds of the utility patent system. Affording protection for functional advances short of applying the *utility* patent law's more exacting novelty, non-obviousness, and disclosure requirements would be, as the Supreme Court observed in [*Baker v. Selden*] denying copyright protection for a system of accounting (and the associated lined forms), "a surprise and a fraud upon the public" and undermines free competition.[2]

They concluded:

> [T]he Federal Circuit has allowed the design patent regime to drift into a troubling collision with the utility patent regime. Product designers can now gain protection for functional features without meeting the higher requirements of the utility patent system…
>
> …Design patents should never have been interpreted so broadly as to protect functional features . . . Designers should not be offered a backdoor for protecting functionality.[3]

The foregoing encapsulates the wrong-headed thinking that pervades the paper in that two basic design patent principles were overlooked.

First, a product that has utilitarian features has an associated appearance that, if claimed in a design patent, must be taken into account in determining patentability/validity.[4] It is true that obtaining a design patent on a product that has utilitarian (functional) features prevents others from making, using, or selling a product whose overall appearance is substantially the same as the claimed design. However, it does not prevent someone from making, using, or selling a product having the same utilitarian features. In other words, even though the system removes that one patented design from the universe of designs available to a competitor, it does not remove the competitor's ability to use the same utilitarian features among the many choices of designs open to it. Thus, it is misleading and inaccurate to suggest that a design patent somehow protects a design's utilitarian features. It protects only their appearance in combination with all other features.

Second, Menell and Corren's paper advocates that utilitarian features should be "filtered out" of a patented design, i.e., excluded from consideration, before determining infringement, akin to copyright law.[5] This

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2. *Id.* at 106. In *Baker v. Selden*, 101 U.S. 99, 103–04 (1879), the Court explained that a copyright on the particular manner of expression of a bookkeeping system gives the author the exclusive right to that expression, but it does not give an exclusive right to the underlying idea for protection of which the author would need to obtain a utility patent for that. This is analogous to the design patent/utility patent dichotomy: A design patent protects the particular manner of expression, i.e., the appearance of a design, but not the underlying idea. The designer would need to obtain a utility patent to protect the function embodied in the protected expression.

3. Menell & Corren, *supra* note 1, at 245.

4. For the purpose of clarity, wherever possible the word "appearance" will be used rather than "ornamental," and the word "utilitarian" shall be used rather than "functional."

5. Menell & Corren, *supra* note 1, at 225, 233.

is contrary to the fact that such utilitarian features all have an associated appearance that, if claimed, must be taken into account in infringement analysis. The failure of Menell and Corren's paper to take into account these two basic principles undermines their premise that design patents somehow monopolize utilitarian features of a design.

It is notable that copyright applications are not examined by the Copyright Office, whereas design patent applications undergo a rigorous examination by the U.S. Patent and Trademark Office (USPTO) resulting in a design patent that carries a statutory presumption of validity.[6] In other words, determination of what is copyrightable is left to the courts, while the USPTO determines what is patentable before any court action. This leaves courts in copyright actions to feel free to filter out features that are not novel, too simple, or have solely utilitarian features. In contrast, since a design patent protects the overall appearance of a claimed design, the issued design patent can, and frequently does, consist of features that, when taken alone, are perhaps not novel and/or are simple or utilitarian. It is only when an entire claimed design is not novel or is solely utilitarian will patentability be denied by the USPTO.

Contrary to the assertions in Menell and Corren's paper, the design patent system does not foist a "fraud upon the public,"[7] nor present a "troubling collision with the utility patent regime."[8] Given that design patents protect only the appearance of products and not any utilitarian features that may be part of the overall appearance, any purported conflict with utility patents is illusory. Menell and Corren rely on ancient design patent case law decided long before the courts came to properly analyze so-called functionality. Also, the "filtering out" shibboleth propounded by the paper has been quite properly dealt with by recent Federal Circuit decisions.

The rest of this paper will explore these topics. Section II will set forth the role of utilitarian features in determining design patent validity and explain the alternative designs test, now almost universally used to determine design patent functionality. Section III will discuss recent Federal Circuit case law which puts filtration of so-called functional features in its proper place.

FUNCTIONALITY AND DESIGN PATENT VALIDITY

This Section first notes that—by statute—design patents must include utilitarian features. It also demonstrates the basic principle that design patents do not protect such utilitarian features, only appearance features. This is because each utilitarian feature has an associated appearance which, if claimed as part of the design patent, is and must be taken into account in determining patentability. Established Federal Circuit case law mandates that

6. *See* 35 U.S.C. § 282.
7. Menell & Corren, *supra* note 1, at 106.
8. Menell & Corren, *supra* note 1, at 246.

Title search: A Primer on Design Patent Functionality

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