

The Dysfunctional *Read* Test:

Missing the Mark(man) Regarding the Test for Design Patent Infringement

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One is hard pressed to address all of the mis-characterizations of design patent law in Mr. Craig Zieminski's well-crafted but flawed article: "A Function for Markman Claim Construction in Design Patents" (90 JPTOS 326, May 2008; hereafter "Function article"). For example, does one start with the citation to the *Amini* case² where the Federal Circuit rather carelessly cited to a trade dress definition of functionality, never before used in design patent jurisprudence, taken from a case involving the color of generic pill

capsules?³ Or does one point out that contrary to the Function article's assertion⁴, the district court in *Lee v. Dayton-Hudson*⁵ never mentioned the issue of functionality? Or perhaps one calls into question Mr. Zieminski's rather unique formulation that would literally turn the test for design patent functionality on its head: "a design is not patentable if its overall visual appearance is not dictated by ornamental considerations." (Function article, p. 352).

To avoid the temptation to write a lengthy rebuttal pointing out my differ-

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² Function article, p. 332.

³ The proper test for design patent functionality is as follows: "To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989).

⁴ Craig Zieminski, *A Function for Markman Claim Construction in Design Patents*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 326, 332 (May 2008).

⁵ *Lee v. Dayton-Hudson Corp.*, 666 F.Supp. 1072 (E.D.Tenn. 1987). The only invalidity contention raised by the defendant was obviousness.

ences with the Function article, I will focus instead on its major underlying premise: "*Markman* claim construction is valuable in design patent suits because it allows the court to delineate between functional and non-functional design elements." (Function article, p. 328).

To the contrary, it is not necessary to parse ornamental and functional features during *Markman* claim construction, or at any other time.

The only designs that qualify for design patent protection are, *inter alia*, "...ornamental designs for an article of manufacture...", 35 U.S.C. §171 (emphasis added). An article of manufacture is akin to a useful article in copyright jurisprudence, i.e., "...an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article..." 17 U.S.C. §101. Thus, patentable industrial designs inherently have functional characteristics and features; otherwise, they would be hanging in the Museum of Modern Art, and be much better served by copyright protection.

The public buys industrial designs (i.e., articles of manufacture), because of how they work and how they look. The form and function of a product of industrial design are ideally "inextricably intertwined." *Brandir Int'l Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1144 (2nd Cir. 1987). The fact that all industrial designs have ample functional features is well recognized:

There is no dispute that shoes are functional and that certain features of

the shoe designs in issue perform functions. 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 that not true, it would not be possible to obtain a design patent on a utilitarian article of manufacture.⁶

Even the PTO agrees:

The distinction must be maintained between the ornamental design and the article in which the design is embodied. The design for the article cannot be assumed to lack ornamentality merely because the article of manufacture would seem to be primarily functional.⁷

The point is that if *de facto* functional features of articles of manufacture were removed from consideration prior to applying the *Gorham* infringement test, there would in many cases be nothing left of the patented design to compare to the accused design. This cannot be the law.

Further, since the long-accepted standard for determining whether a design is impermissibly *de jure* functional is whether there are alternate designs for performing substantially the same function, *Avia*, 853 F.2d at 1563, it is very difficult, as a practical matter, to identify any *de facto* functional design feature whose function cannot be performed by an alternate design. This makes perfect sense, since the overriding policy behind

⁶ *Avia Group Int'l Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988)

⁷ M.P.E.P. §1501.04(c) (emphasis in original).

the functionality doctrine is to prevent a design patent from monopolizing a function that should only be monopolized by a utility patent, *Chisum on Patents* §23.03[4] (2006). If the functional attributes of the claimed design can be manifested by other designs, then the design patent *ipso facto* is not monopolizing those functions.

Another reason why is it not necessary to parse functional and ornamental features prior to determining infringement is because functionality historically has always been an invalidity defense, rather than something the absence of which is required to be proven by the patentee in order to establish infringement.⁸ Again, a design patent applicant inevitably claims *de facto* functional features as part of his overall design, and the PTO examines the overall visual appearance of the entire claimed design to ensure that it is new, original, ornamental (i.e., not *de jure* functional), and non-obvious, and grants the patent on that basis. Issued patents are presumed valid, 35 U.S.C. §282. If a defendant in litigation believes that the PTO erred, i.e., if the defendant believes the overall design was dictated solely by functional considerations and is thus invalid, it has the burden of proving same by clear and convincing evidence. *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 40 USPQ2d 1048 (Fed. Cir. 1996). A design patent claiming an article of manufacture whose design is dictated solely by functional considerations is invalid as consisting of

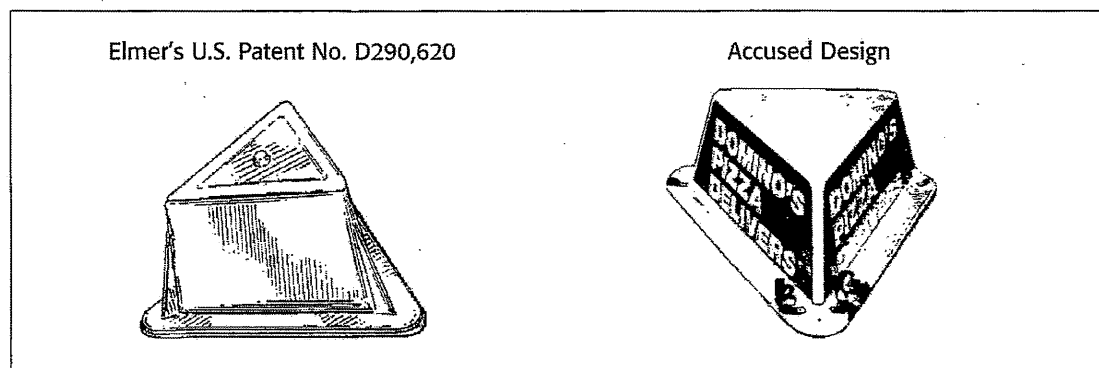
non-statutory subject matter (35 U.S.C. §171) and may be challenged by an appropriately pled invalidity defense.

Additionally, it is not that difficult for an accused infringer to avoid infringement altogether by merely leaving out or changing functional

features so as to render its design not substantially the same overall as the patented design.

This was clearly demonstrated in the first *Markman* case that construed a design patent claim, *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995), where the patentee included in its overall claimed design, a triangular pizza sign for mounting on the top of a car, fins at each of the corners of the triangle, plus a protrusion extending from the top of the sign. The patentee would have dearly loved the Federal Circuit to have removed from its infringement analysis his functional features of the fins and protrusion, because the accused design did not have those visual features. In fact, the *Elmer* plaintiff argued that the fin and protrusion elements shown in solid lines in his drawings were indeed functional, rather than ornamental, and should not be included in the claim. The court rejected this argument, saying that the patentee could have omitted those allegedly functional features from its patent application drawings, but did not do so, and thus effectively limited the scope of its patent claim by including those features in it. *Id.* at 1577.

⁸ This is analogous to what has occurred concerning novelty of a claimed design, the lack of which is an invalidity defense under 35 U.S.C. §102. But the so-called point of novelty test has turned the requirement for patentable novelty into something the presence of which is required to be proven by the patentee in order to establish infringement. See Perry J. Saidman, *What is The Point of the Point of Novelty Test for Design Patent Infringement?*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 401 (June 2008).



The court held that a design patent claim is limited in scope to the entirety of what is contained in the patent application drawings themselves. *Id.* In other words, a design patentee claims all features shown in solid lines in her drawings, regardless of whether such features are new, old, ornamental or functional. This case reinforces the widely accepted rule, recently confused, that functionality is a validity issue, not an infringement issue.

There remains for consideration the so-called *Read* test, the cornerstone of the Function article's argument for parsing functional and ornamental features prior to performing the *Gorham* infringement test.

Read Corporation v. Portec, Inc., 970 F.2d 816 (Fed. Cir. 1992) was based on the unstated but erroneous premise that a design patent cannot protect a product having features that perform a function. As noted previously, this is an absurd conclusion because all industrial designs have ubiquitous functional features. The detriment to the design patentee in claiming those functional features is that they will limit the scope of the resulting overall design, as the Federal Circuit made clear in *Elmer*.

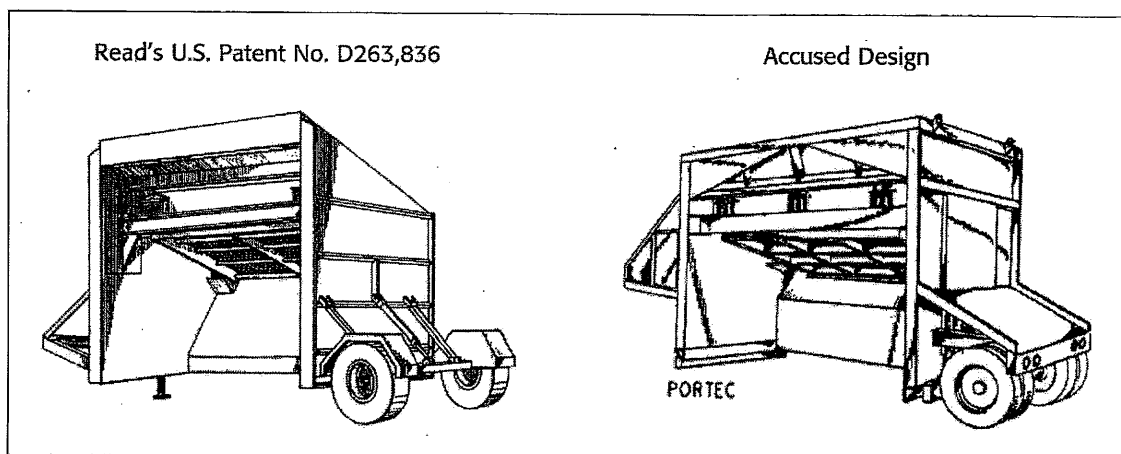
The defendant Portec took the position in the district court that Read's patented design was invalid based on functionality. The district court in *Read*⁹, in denying Portec's JNOV motion to that effect, had it exactly right:

We do not deny that the Read device performed a function. Nevertheless, its overall design was a choice made by the inventor who could have arranged the functioning parts in other, different designs. It is the "overall aesthetics of the various components and the way that they are combined" which constitute the "design" and which validly may be patented. *Id.* at 1099.

In other words, the entire discussion of functionality in the district court was in the context of an invalidity defense – the word "functional" was not mentioned in the same sentence as "infringement". The court affirmed the jury verdict of validity and infringement.

On appeal to the Federal Circuit, the defendant Portec, perhaps stung by the impeccable logic of the district court concerning validity, attacked the jury's ver-

⁹ *Read Corp. v. Portec, Inc.*, 748 F.Supp. 1078 (D. Del. 1990).



dict of infringement by arguing that the only features in common between the patented and accused designs were functional, that Mr. Read had testified as such¹⁰, and that Read had submitted no evidence comparing ornamental features. *Id.* at 825.

Apparently, the only evidence relied upon by Read at trial to prove infringement was Mr. Read's answer "Yes" to the question of whether the *Gorham* test was satisfied.

Perhaps unhappy with the dearth of testimony concerning the ornamental features of Mr. Read's material screening device, the Federal Circuit chided Read for "misperceiving the holding of *Gorham*." *Id.*, and then made its ill-advised pronouncement:

In *Gorham*, however, there was no preliminary issue respecting what the ornamental features of the design in issue were. The *Gorham* design patent claimed only the scroll work on the

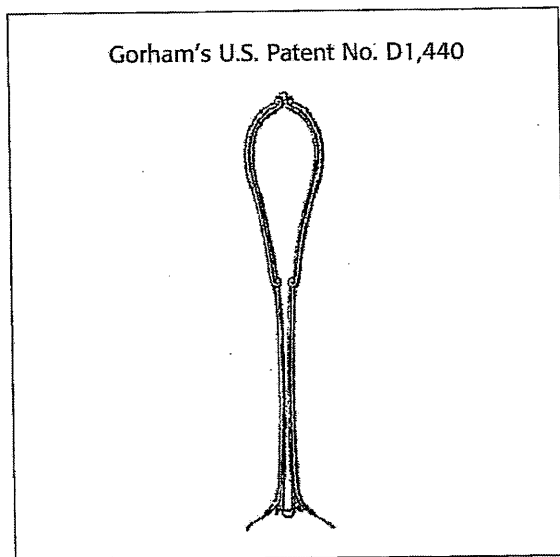
handle portion of table flatware.... Thus, all elements forming the claimed design were ornamental. Where this is not the case, that is, a design is composed of functional as well as ornamental features, to prove infringement a patent owner must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental. *Id.*

There are several problems with this pronouncement, which unfortunately has subsequently been cited in design patent cases too numerous to count. First, there is never "a preliminary issue" concerning identification of the ornamental features of a claimed design. What is ornamental is the overall appearance of the claimed design, 35 U.S.C. §171; the PTO has said so by issuing the design patent.

Second, *Gorham*'s silverware was not purely ornamental. *Gorham*'s claimed handle design performed the rather obvi-

¹⁰ Mr. Read quite naturally testified that the features of his design were (*de facto*) functional, and of course they were. His material screening device was, after all, an industrial design, an article of manufacture. This qualifies his device for a design patent, rather than disqualifies it. It is a common but unsuccessful tactic for an accused infringer to prove (usually via the expert testimony of an engineer) that all of the elements of a claimed design perform a function, to which the proper response is: So what?

ous function of enabling one to hold the silverware. A purely ornamental design, devoid of function, is a work of art, and can hardly be classified as an industrial design or an article of manufacture.



Third, and perhaps most significantly, it is illogical to suggest that there exists a special class of designs that are composed of functional *and* ornamental features. As noted previously, by its very nature an industrial design inherently includes a plethora of *de facto* functional features. The issue is not to identify *other* features that are ornamental; the real question is whether those *de facto* functional features are *themselves* ornamental because their functional attributes can indeed be embodied in other, different-looking features. In other words, all functional features are *themselves* ornamental

as a matter of law¹¹, unless there is no other way to design them so that they work for their intended function. See *Best Lock, supra*.

The Federal Circuit's unfortunate suggestion that functional and ornamental features needed to be parsed, never before stated in any design patent case (despite the Function article's assertions to the contrary) thereafter became an overused and distracting element of proof in design patentees' infringement cases, serving, really, no useful purpose.

By means of this one illogical paragraph in this one unfortunate case, functionality morphed from a validity issue into an infringement "defense", i.e., that the patentee had to somehow identify and separate functional features from ornamental features prior to proving its case in chief¹². This so-called *Read* test is therefore a rather loose, indeed shaky lynchpin for the Function article to hang its hat onto.

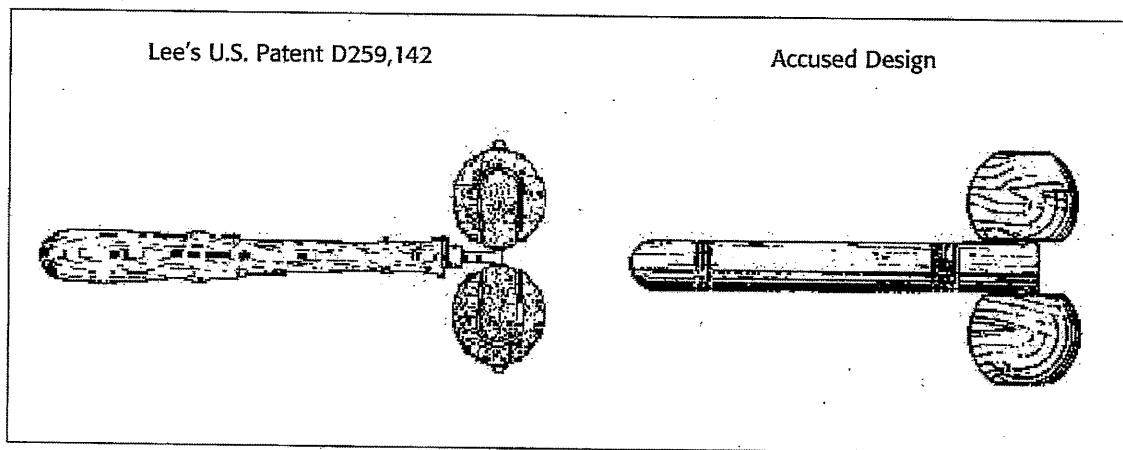
Let's delve a little deeper. The only case cited by the court in *Read* for its ornamental/functionality pronouncement was *Lee v. Dayton Hudson*, 838 F.2d 1186 (Fed. Cir. 1988). However, the *Lee* court never suggested that ornamental and functional features of a claimed design need to be identified prior to performing the test for infringement. In contrast, the *Lee* court affirmed the notion that functionality is an invalidity defense by citing and quoting a string of seminal functionality decisions, including *In re Garbo*¹³ and *In re Carletti*¹⁴.

¹¹ As were Elmer's fins and protrusion, see *Elmer, supra*.

¹² A considerable amount of confusion is believed due to the careless use of the word "functional" in design patent jurisprudence which, as pointed out by Judge Rich in a seminal trade dress case on functionality, can have two very different meanings: *de facto* functional (i.e., performs a function), and *de jure* functional (functional as a matter of law). See *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (CCPA, 1982).

¹³ 287 F.2d 192 (CCPA 1961).

¹⁴ 328 F.2d 1020 (CCPA 1964).



But the court's overarching discussion in *Lee* was in response to the patentee's argument, oft made by those who have claimed too narrowly, that his design patent protected the concept of his design, rather than the way his design looked. The court confirmed the tautology that a design patent cannot be used to protect the general function or concept embodied in a particular design: "...a design patent is not a substitute for a utility patent" *Lee, supra* at 1189. In other words, as similarly stated in a long series of decisions in which a design patentee attempted to wield its design patent as a utility patent, courts have uniformly and quite properly held that the idea or concept embodied in a design patent cannot be used to stop a different-looking design that embodies the same idea¹⁵ (this is akin to the idea/expression dichotomy in copyright law). In each of these cases, including *Lee*, the court was essentially

saying the same thing to the patentee: Your design patent does not and cannot protect the general concept or function of your product; the accused design, to infringe, must *look like* your overall patented design.

It is a stretch, to say the least, to move from this fundamental legal concept to one that requires delineation between functional and so-called non-functional features prior to determining infringement.

As aptly held by the *Elmer* court, the bedrock test for design patent infringement is the same whether the claimed design includes novel, old, ornamental or functional elements: the appearance of the accused design must be substantially the same overall as the patented design in the eyes of an ordinary observer.¹⁶ A design patentee cannot stop a third party from making a non-similar design that performs substantially the same function as the patented design. If the third

¹⁵ *N.Y. Belting & P. Co. v. N.J. Car Spring & R. Co.*, 53 F. 810 (2nd Cir. 1892); *Kruttschnitt v. Simmons*, 118 F. 851 (S.D.N.Y. 1902); *Ashley v. Samuel C. Tatum, Co.*, 186 Fed. 339 (2nd Cir. 1911); *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428 (6th Cir. 1933); *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186 (Fed. Cir. 1988); *Keystone Retaining Wall Sys. Inc. v. Westrock, Inc.*, 997 F.2d 1444 (Fed. Cir. 1993); *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995); *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir. 1995); *Oddz-On Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997).

¹⁶ The Function article's so-called pedagogical example on p. 343-44 is not helpful in that, depending of course on what the designs actually look like, it is doubtful that any reasonable jury could think polka dots look substantially the same as zig-zags, whether on a wheel or bowling ball or whatever.

party cannot make a dissimilar design that performs substantially the same function, then the patented design is invalid as being dictated by functional considerations because the design patent would impermissibly behave as a utility patent (see *Best Lock, supra*). This quite logically has nothing whatsoever to do with the test for infringement.

The lack of any logical or legal need to delineate between functional and orna-

mental design features prior to performing the *Gorham* infringement test is yet another reason that the *Markman* case has little, if any, practical applicability to design patent claim construction. The other reasons have been thoroughly expounded upon in a number of well-reasoned *Amicus Curiae* briefs filed in the *en banc* rehearing of the *Egyptian Goddess* case¹⁷ which, as this is being written, is still pending at the Federal Circuit.

¹⁷ *Egyptian Goddess, Inc. v. Swisa, Inc.* 256 Fed. Appx. 357 (Fed. Cir., 2007).