Design Patents Aren't Patents (And It's a Good Thing Too)

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ABSTRACT

In design patent law we have created a monster—a chimera, a hybrid that sometimes looks and acts like a patent regime and then, unexpectedly, doesn't. Courts in design patent cases sometimes apply the rules as they would in utility patent cases, sometimes modify those rules for the design context, and sometimes ignore the utility patent rules altogether. The consequences of that incomplete adoption of utility patent rules are grossly underappreciated. Among other things, it has wreaked havoc on the law of novelty and nonobviouness—doctrines that are supposed to ensure that we grant design patent protection only to new and meaningfully different designs. And it has too often resulted in rules that ignore how designers actually work.

In this Article, we suggest that the problem stems from trying to fit design into a framework that was intended for the very different context of inventions. There are good reasons not to use the utility patent infringement rules for design, even if we are skeptical of the particular design patent infringement rule the Federal Circuit has settled on. And there are good reasons not to allow a design patent to have a different scope when it comes to infringement than it does for validity; doing so allows patent owners (and infringers) to game the system in litigation. The Federal Circuit has recognized some – but not all – of these necessary differences.

But if there are good reasons to depart from utility patent rules in some cases, why insist on symmetry with utility patent in other respects? We think design patent law's strange hybridity is largely historical accident. In 1842, when design patents were first created, the utility patent system looked fundamentally different than it does today – and a lot more like an ideal design patent system would. Most significantly, it used central rather than peripheral claiming. But as utility patent law changed, design patent law tagged along, to its detriment.

Courts (and ultimately Congress) should recognize the fundamental divergence between utility and design patents. Perhaps we should get rid of design patents altogether and adopt a sui generis regime for design, as virtually every other country has done. But if we are stuck with design patents, courts should apply design patent law with sensitivity to the differences between design and invention.

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INTRODUCTION

We begin with a puzzle. Three fundamental principles are widely accepted in design patent law:

1. The legal rules for design patents are the same as for utility patents unless otherwise specified in the statute, and the statute treats anticipation and obviousness identically.[1]

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2. The design patent infringement standard is different from the utility patent standard.[2]
3. In both design patent and utility patent, the test for infringement is the same as the test for anticipation: "[t]hat which infringes, if later, would anticipate, if earlier."[3]

Those three things are all settled law with an impeccable pedigree. But they literally can't all be true.[4] You can't insist on symmetry between infringement and anticipation and on symmetry between utility patent and design patent anticipation law when design patents and utility patents

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1 The patent statute itself says this. *See* 35 U.S.C. § 171(b).

2 *See* Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 677–78 (Fed. Cir. 2008) (en banc) ("If the claimed design consists of a combination of old features that creates an appearance deceptively similar to the accused design, even to an observer familiar with similar prior art designs, a finding of infringement would be justified. Otherwise, infringement would not be found.").

3 *See* Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1239 (Fed. Cir. 2009) (alteration in original) ("[I]t has been well established for over a century that the same test must be used for both infringement and anticipation."); *see also* Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1312 (Fed. Cir. 2001) ("Because '[t]hat which infringes, if later, would anticipate, if earlier,' the design patent infringement test also applies to design patent anticipation." (citation omitted) (quoting Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889))).

4 And we mean "literally" in the old-fashioned sense of, well, literally.

don't use the same infringement rule.[5] If design patent infringement is different than utility patent infringement and the test for infringement is the same as the test for anticipation, then the test for anticipation must be different in design patents than in utility patents. Rules 2 and 3 hold but not rule 1. Alternatively, if design patent infringement is different than utility patent infringement and the test for anticipation is the same in both utility and design patents, then the test for design patent anticipation can't be the same as the test for infringement. Rules 1 and 2 hold but not rule 3. And so on.

In design patent law we have created a monster—a chimera, a hybrid that sometimes looks and acts like a patent regime and then, unexpectedly, doesn't Courts in design patent cases sometimes apply the rules as they would in utility patent cases, sometimes modify those rules for the design context, and sometimes ignore the utility patent rules altogether. The consequences of that incomplete adoption of utility patent rules are grossly underappreciated. Among other things, it has wreaked havoc on the law of novelty and nonobviousness—doctrines that are supposed to ensure we grant design patent protection only to new and meaningfully different designs. And it has too often resulted in rules that ignore how designers actually work.

In this Article, we suggest the problem stems from trying to fit design into a framework intended for the very different context of inventions. There are good reasons not to use the utility patent test for infringement, even if we are skeptical of the particular infringement rule the Federal Circuit has settled on.[6] And there are good reasons not to allow a design

[5] The design patent infringement rule doesn't require identity but instead uses "substantial similarity" from the perspective of an ordinary observer. Gorham Co. v. White, 81 U.S. 511, 528 (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] For prior criticism, see Mark A. Lemley, *Point of Novelty*, 105 NW. U. L. REV. 1253, 1270–72 (2011); Christopher Buccafusco, Mark A. Lemley & Jonathan S. Masur, *Intelligent Design*, 68 DUKE L.J. 75, 125 (2018).

patent to have a different scope when it comes to infringement than it does for validity; doing so allows both patent owners and infringers to game the system in litigation.[7] The courts have recognized some—but not all—of these necessary differences.

But if there are good reasons to depart from utility patent rules in some cases, why insist on symmetry with utility patents in other respects? Just as it doesn't make sense to assess infringement of a design patent using the element-by-element, claim construction-driven approach of utility patents,[8] it doesn't make sense to assess design patent validity that way either. We think the explanation is historical accident. In 1842, when design patents were first created, the utility patent system looked fundamentally different than it does today[9]—and a lot more like an ideal design patent system would. Most significantly, it used central rather than peripheral claiming. But as utility patent law changed, design patent law tagged along to its detriment.

As we show in Part I, the patchwork of design patent rules doesn't just produce inconsistencies in the treatment of infringement. Anticipation and obviousness in design patent law currently bear scant resemblance to their utility patent counterparts, notwithstanding the Federal Circuit's welcome overruling this year of precedent that had expressly rejected the application of utility patent obviousness law to design patents.[10] The process of construing patent claims—the heart of utility patent law—is actively discouraged in design patents,[11] and when courts do construe design patent claims,

7 *See* Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WM. & MARY L. REV. 2197, 2259–66 (2016).

8 *See* Lemley, *supra* note 6, at 1259–60.

9 *See* Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction*, 157 U. Pa. L. Rev. 1743, 1776 (2009); Amy L. Landers, *The Problem of Design Patents: Representation and Subject Matter Scope*, 30 TEX. INTELL. PROP. L.J. 185, 189–206 (2022).

10 *See* LKQ Corp. v. GM Glob. Tech. Operations LLC, No. 2021-2348, __ F.4th __ (Fed. Cir. May 21, 2024) (en banc). Full disclosure: we represent LKQ in this case.

11 *See* Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) ("[T]his court has not required that the trial court

it takes a very different form.[12] Disclosure doctrines are an important part of utility patent law because utility patents often claim untested technology and seek to lock up a whole genus of related inventions;[13] those issues are almost completely absent from design patents.[14] Design patents are for all intents and purposes not examined in the Patent and Trademark Office ("PTO"), as utility patents are; our design patent system is effectively a registration system.[15] Design

attempt to provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents.").

12 *See* Sarah Burstein, *Whole Designs*, 92 U. COLO. L. REV. 181, 182–84 (2021) (explaining design patent applicants can claim a small "fragment" of a shape as its own "design").

13 *See* Janet Freilich & Lisa Larrimore Ouellette, *Science Fiction: Fictitious Experiments in Patents*, 364 SCI. 1036, 1036 (2019) (finding untested patents make up about seventeen percent of chemistry and biology patents in the United States); Sean B. Seymore, *Patenting the Unexplained*, 96 WASH. U. L. REV. 707, 729 (2019) (remarking on the commonality of genus claims, especially "in the chemical and pharmaceutical arts").

14 To the extent there are problems with disclosure in design patents, it is because partial claiming allows applicants to disguise the ways the claimed components relate to or interact with the article as a whole. *See* Jason Du Mont & Mark D. Janis, *Disclosing Designs*, 69 VAND. L. REV. 1631, 1632–33 (2016).

15 *See* Dennis D. Crouch, A Trademark Justification for Design Patent Rights 18 (Aug. 10, 2010) (unpublished manuscript) (on file with the University of Missouri School of Law Scholarship Repository) ("For the past decade, the allowance rate for design patent applications has remained over 90%."); Burstein, *supra* note 12, at 186 (explaining the Federal Circuit "has eroded the substantive requirements of ornamentality, novelty, and nonobviousness to the point that it's very difficult for courts and the USPTO to reject any design patent claim, no matter how functional, banal, or unimportant the claimed design might be"); *cf.* Chad Gilles, *Design Patent Rejections – Update*, BIGPATENTDATA (Apr. 14, 2019), https://bigpatentdata.com/2019/04/design-patent-rejections-update/ [https://perma.cc/HSF7-N8Q5] (asserting that the allowance rate dropped to 70.7% since Crouch's 2010 study, but not measuring final allowance rates). The only vestige of similarity between utility patent and design patent prosecution is the antiquated requirement that one must have a technical background to prosecute design patents. *See* Christopher Buccafusco & Jeanne C. Curtis, *The Design Patent Bar: An Occupational Licensing Failure*, 37 CARDOZO ARTS & ENT. L.J. 263 (2019) (arguing patent bar eligibility rules should not apply to design patents). But even that rule is under siege and will hopefully disappear soon. *See* Changes to the Representation of Others in Design Patent Matters Before the United States Patent and

patents have their own system of remedies, focusing not on plaintiff's losses but on defendant's profits.[16]

In Part II, we explain the fundamental differences between design and invention. In Part III, we argue courts can and should change the rules of design patent law to take account of the different nature of design even within the larger patent framework. Courts have considerable freedom to tailor design patent law to the way design actually works. They should use that freedom. We suggest further modifications to many of the core doctrines of design patent law that better match both the unique nature of design and the infringement test the courts have already adopted.

More broadly, we question the whole idea of a patent system for design. Simply put, design patents aren't equivalent to utility patents in any meaningful sense, and the rules declaring them to be so cannot be applied coherently. Design is a hybrid form fitting uneasily in intellectual property ("IP") law's categories, but it has at least as much in common with the sorts of creativity copyright protects as it does with the traditional concerns of utility patent law. Whether or not some sort of freestanding design right is a good idea, an issue on which reasonable people can and have disagreed,[17] any protection for design

Trademark Office, 88 Fed. Reg. 31209 (proposed May 16, 2023) (to be codified at 37 C.F.R. pts. 1, 11, 41).

16 *See* 35 U.S.C. § 289; Mark A. Lemley, *A Rational System of Design Patent Remedies*, 17 STAN. TECH. L. REV. 219, 221 (2013) ("Unlike patents on technical inventions . . . design patent law requires that infringers—even innocent infringers—pay the plaintiff their entire profit from the sale of the infringing product, even if the design was only a small feature of that product.").

17 *See, e.g.*, Sarah Burstein, *The Patented Design*, 83 TENN. L. REV. 161, 229 (2015) [hereinafter Burstein, *Patented Design*] (arguing designs should not be protected *per se*); *see also* William Thompson, *Product Protection Under Current and Proposed Design Laws*, 19 U. BALT. L. REV. 271, 276 (1989) (arguing for "a simple and quick copyright registration process" that would apply to designs). The issue is complicated by the fact that copyright and trademark law have expanded to cover many of the things that would once have been protectable only by a design right. For discussions of this overlap, see Buccafusco & Curtis, *supra* note 15, at 81; see also Sarah Burstein, *Intelligent Design & Egyptian Goddess: A Response to Professors Buccafuso, Lemley & Masur*, 68 DUKE L.J. ONLINE 94, 95 (2019); Jason J. Du Mont & Mark D. Janis, *U.S. Design Patent Law: A Historical Look at the Design Patent/Copyright Interface*, *in* THE

should be tailored to encourage design, not just uncritically copied from the law that governs the very different context of technical inventions.

I. SYMMETRY AND ITS DISCONTENTS

At the time Congress passed the first design patent statute in 1842, the design of articles of manufacture was excluded from copyright's coverage, as well as from patent and trademark (or unfair competition) protection.[18] Those involved in lobbying for the 1842 design patent statute were concerned primarily with surface ornamentation,[19] but the statute did not limit protection to such "ornamental" designs. Instead, the statute's coverage reflected its gap-filling purpose. It covered "new and original" works created by the inventor's "industry, genius, efforts, and expense" in a hodgepodge of categories otherwise unprotected by IP at the time: designs for "manufactures," fabric designs, statues and other three-dimensional artwork, surface ornamentation of various sorts, and product "shape or configuration."[20]

From the modern perspective, the original subject matter has notes of both utility patent and copyright—unsurprising because in 1842, patent and copyright were not as clearly

COPYRIGHT/DESIGN INTERFACE: PAST, PRESENT, & FUTURE 341–82 (Estelle Derclaye ed. 2017).

18 *See* McKenna & Strandburg, *supra* note __. Peter S. Menell & Ella Corren, *Design Patent Law's Identity Crisis*, 36 BERKELEY TECH. L.J. 1, 8 (2021).

19 *See* Jason J. Du Mont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837, 851–52 (2013).

20 The original statute offered design patents to those who through "their own industry, genius, efforts, and expense, may have invented or produced any new and original [1] design for a manufacture, whether of metal or other material or materials, or any new and original [2] design for the printing of [woolen], silk, cotton, or other fabrics, or any new and original [3] design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original [4] impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful [5] pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original [6] shape or configuration of any article of manufacture not known or used by others." *See* Act of August 29, 1842, ch. 263 § 3, 5 Stat. 543.

delineated in terms of subject matter or eligibility standards.[21] By the early twentieth century, however, patent and copyright had evolved into distinct institutions with different approaches—utility patent law with higher thresholds for protection motivated by a cumulative conception of progress, and copyright maintaining a minimal threshold typically motivated by a sense of the impossibility of assessing the size of an aesthetic contribution.[22] Design patent law never benefitted from that evolution. It remained a patent system, but its subject matter came to be defined in terms of "ornamentality,"[23] in contrast with the "utility" that marks the subject of utility patent protection.[24]

Courts have always struggled to interpret the ornamentality requirement, vacillating over time between approaches that, on the one hand, aggressively excluded designs that had any relationship to function, and on the other hand, excluding almost nothing on ornamentality grounds and allowing design patents to serve as backdoor utility patents.[25] On the face of the statute, however, ornamentality remains one of the very few eligibility rules that distinguish design patent from utility patent subject matter.[26] The statute specifically subjects designs to the same novelty and nonobviousness requirements that apply to inventions, and the Federal Circuit has routinely said that, in general, it applies the same rules to design patents as utility patents.[27]

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21 *See* Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 STAN. TECH. L. REV. 1, 32 (2013).

22 *See id.* at 16.

23 Act of May 9, 1902, Pub. L. No. 57-109, § 4929, 32 Stat. 193.

24 *Id.*

25 *See* McKenna & Strandburg, *supra* note 21, at 32–36; *see also* Menell & Corren, *supra* note 18, at 7.

26 The statute also says designs must be "original," but despite that word's connection to copyright subject matter, courts have not treated it as a meaningful design patent eligibility requirement. 35 U.S.C. § 171(a) ("Whoever invents any new, *original* and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.") (emphasis added).

27 *See Auto. Body Parts Ass'n v. Ford Glob. Techs., LLC*, 930 F.3d 1314, 1322 (Fed. Cir. 2019) ("[W]e apply the same rules to design and utility patents whenever possible. Accordingly, we have held that

But, as we describe below, in fact courts and the PTO have in many cases developed different rules for designs.

A. The Different Nature of Design Patents: Anticipation, Obviousness, and Infringement

Courts have struggled to apply rules designed for inventions to the very different context of designs. In this section, we highlight the difficulty of translating rules governing the relationship between anticipation and infringement to the design patent context.

There is a well-known maxim in utility patent law: "[t]hat which infringes, if later, would anticipate, if earlier."[28] That maxim is supposed to ensure a fundamental symmetry between eligibility for a patent and the scope of that patent. If small differences are enough to distinguish your invention from what came before it, thereby making your invention patentable despite close prior art, then similarly small differences should be enough to distinguish an accused device, making it noninfringing despite its similarity to the patented invention. Put differently, you should not be able to get a patent by emphasizing small differences from the prior art and then turn around and act like small differences do not matter when it comes to infringement.[29]

That maxim works in the utility patent context because both anticipation and literal infringement require element-by-element identity. An accused device literally infringes

principles of prosecution history estoppel, inventorship, anticipation, and obviousness apply to both design patents and utility patents." (citation omitted)).

[28] Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1239 (Fed. Cir. 2009) (alteration in original) (quoting Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889)).

[29] *See* Lemley & McKenna, *supra* note 7 (describing this principle and courts' difficulty applying it in other areas of IP); White v. Dunbar, 119 U.S. 47, 51–52 (1886) ("Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is.").

only if it contains every element of the claimed invention.[30] Likewise, a prior art reference anticipates only if it discloses every element of the claimed invention.[31] The patent claim is central to both of those inquiries. Indeed, as the drafter of the 1952 Patent Act put it, "the name of the game is the claim."[32] And the process of claim construction—resolving ambiguities in the meaning of the words patent lawyers draft to define the scope of the invention—is frequently dispositive of both validity and infringement issues.[33]

Design patent infringement is different in three important ways. The first is that design patents are claimed

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30 *See* Mannesmann Demag Corp. v. Engineered Metal Prods. Co., 793 F.2d 1279, 1282 (Fed. Cir. 1986) ("Literal infringement requires that the accused device embody every element of the patent claim."). It could also infringe under the doctrine of equivalents if it is deemed equivalent "on an element-by-element basis." *See* Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 18 (1997).

31 *See* Messerschmidt v. United States, 29 Fed. Cl. 1, 21 (Fed. Cl. 1993) ("The Every Element Test for anticipation requires the presence of each and every element of a claimed invention in a single prior art disclosure.").

32 Giles S. Rich, *Extent of Protection and Interpretation of Claims – American Perspectives*, 21 INT'L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990) (emphasis removed); *see also* Umber Aggarwal, *Patent Law Could Use Another Judge Rich Right Now*, FINNEGAN (November/December 2017), https://www.finnegan.com/en/insights/articles/patent-law-could-use-another-judge-rich-right-now.html#:~:text=The%20Patent%20Act%20of%201952%20was%20the%20product%20of%20much,Judge%20Rich%20and%20P.J.%20Federico., [https://perma.cc/JPU9-86WC] (noting that Rich drafted the Patent Act).

33 *See* Richard J. Stark & Andrei Harasymiak, *Inducement of Patent Infringement: The Intent Standard and Circumstantial Evidence of Intent*, *in* RECENT TRENDS IN PATENT INFRINGEMENT LAWSUITS, at *19–20 (Thomson Reuters / Aspatore 2011), 2011 WL 601766 ("[T]he ultimate infringement determination is heavily dependent on claim construction, and that construction does not take place until and unless a patent is actually asserted in an infringement case. . . . Like infringement, the resolution of commonly asserted validity defenses such as anticipation or obviousness depends heavily on claim construction . . . ."); Peter S. Menell, Matthew D. Powers & Steven C. Carlson, *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 BERKELEY TECH. L.J. 711, 807 ("[M]ost of the weighty issues in a patent case—the technical aspects of infringement and most allegations of invalidity—depend in some way on claim construction.").

visually rather than verbally.[34] The "claim" of a design patent is effectively just the drawing of the design,[35] and that significantly complicates things for courts. In virtually every doctrinal context, courts insist that excessive reliance on verbal description should be avoided because of "the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole."[36] In fact, however, courts routinely describe design patents verbally, because they find it hard to make the relevant comparisons without doing so. They cannot evaluate the validity of a claimed design without identifying and describing aspects of the design and comparing them to the prior art.[37] Nor can courts assess infringement without evaluating the similarities between features of the accused product and those of the claimed design.[38] And even when they focus on the images, courts often resort to verbal formulations to interpret and evaluate

[34] *See* Jeanne C. Fromer & Mark P. McKenna, *Claiming Design*, 167 U. PA. L. REV. 123, 180 (2018).

[35] Because "[t]he design for an article consists of the visual characteristics embodied in or applied to an article [of manufacture]," MANUAL OF PATENT EXAMINING PROCEDURE § 1502, a design patent application may include only a single claim for the design, and that claim must consist of a drawing. *See* 37 C.F.R. §§ 1.152–53(a) (2022).

[36] Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc). Nonobviousness is an outlier on this issue because in that context a court's failure to reduce the design to verbal description is error. *See* High Point Design LLC v. Buyers Direct, Inc., 730 F.3d 1301, 1314 (Fed. Cir. 2013) (finding that the district court described the design at "too high a level of abstraction," and remanding for the district court to "add sufficient detail to its verbal description of the claimed design to evoke a visual image consonant with that design"); Apple, Inc. v. Samsung Elecs. Co., 678 F.3d 1314, 1329–33 (Fed. Cir. 2012) (concluding that the district court viewed the references in the obviousness context "from too high a level of abstraction"); *cf.* MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326, 1332 (Fed. Cir. 2014) (holding even though "the district court did not expressly undertake to translate the claimed design into a verbal description," that did not constitute error because "[i]t [was] entirely clear from the district court's opinion what it considered to be the relevant design characteristics of the . . . patented design").

[37] Fromer & McKenna, *supra* note 34, at 139–40.

[38] *Id.*

those images.[39] In the infringement context, verbal claim construction is often about interpreting dotted lines in the drawing—something that almost never matters in utility patents.[40]

In *Egyptian Goddess, Inc. v. Swisa*, [41] the Federal Circuit emphasized that the ordinary observer is understood to assess similarity in light of the prior art, and the court gave lower courts discretion to describe the designs verbally.[42] According to the Federal Circuit, "a court may find it helpful to point out, either for a jury or in the case of a bench trial by way of describing the court's own analysis, various features of the claimed design as they relate to the accused design and the prior art," and as a result, a district court's "relatively detailed claim construction will not be reversible error."[43] But at least in theory, the similarity analysis in design patents focuses on the images, not on the words selected by lawyers to describe the designs, in contrast with utility patents, where the analysis is entirely focused on the words.[44]

The second major difference between design patent and utility patent infringement analysis is that design patent infringement has no all-elements rule—design patent claims have no elements and design patent infringement doesn't demand identity. According to *Gorham Co. v. White*,[45] a

39 *See, e.g.*, *Design Patent Application Guide*, U.S. PAT. & TRADEMARK OFF., https://www.uspto.gov/patents/basics/apply/design-patent#main-content [https://perma.cc/BH5E-AMA8] (setting out examples of how to depict designs in drawings to indicate certain things); Think Green Ltd. v. Medela AG, No. 21 C 5445, 2022 WL 6123348, at *3 (N.D. Ill. Oct. 7, 2022) (discussing different interpretations of a blank surface in a design drawing).

40 *See In re* Blum, 374 F.2d 904, 907 (C.C.P.A. 1967) ("Dotted and broken lines may mean different things in different circumstances . . . [and] in each case it must be made entirely clear what they do mean, else the claim is bad for indefiniteness under 35 U.S.C. § 112."); Burstein, *supra* note 12, at 188–95 (providing examples of how dotted versus solid lines affect design patent claims).

41 543 F.3d 665 (Fed. Cir. 2008) (en banc).

42 *Id.* at 665.

43 *Id.* at 679–80.

44 *See infra* notes **Error! Bookmark not defined.**–73 and accompanying text.

45 81 U.S. 511 (1871).

design infringes "if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, [the] 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."[46] Substantial similarity is a copyright, not a patent, standard for infringement.[47] That standard means design patents have a penumbra in infringement—some accused products infringe design patents even though they are not identical to the patented design. Correspondingly, unlike utility patents, design patent law doesn't employ the doctrine of equivalents.[48] Utility patent claims, by contrast, are generally "open"—if you include all the elements of the patent in your product, you infringe even if you add other elements.[49] But in design patent law, adding something to a design you copied may avoid infringement.[50] So although utility patent infringement is about identifying and matching particular elements in the claims lawyers wrote, design patent

46 *Id.* at 528.

47 The second part of the *Gorham* definition—describing similarity in terms of the likelihood that the design will "deceive such an observer, inducing him to purchase one supposing it to be the other"—resembles to some extent the traditional trademark concept of passing off. The *Gorham* standard focuses only on comparison of the designs themselves, however, whereas trademark law would assess that similarity in marketplace context. *See id.* at 528; *see* Gray v. Meijer, Inc., 295 F.3d 641, 645 (6th Cir. 2002) ("To recover for trade dress infringement under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), a plaintiff must prove by a preponderance of the evidence: (1) that its trade dress has obtained "secondary meaning" in the marketplace; (2) that the trade dress of the two competing products is confusingly similar; and (3) that the appropriated features of the trade dress are primarily nonfunctional.").

48 On the application of the doctrine of equivalents in utility patents, see, e.g., Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 TEX. L. REV. 989 (1997); Joshua D. Sarnoff, *The Doctrine of Equivalents and Claiming the Future After* Festo, 14 FED. CIR. BAR J. 403 (2004).

49 *See, e.g.*, Robert P. Merges, Peter S. Menell & Mark A. Lemley, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGY AGE 273 (4th ed. 2007).

50 *See* Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc., 942 F.3d 1119, 1130 (Fed. Cir. 2019). *But see* L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1126 (Fed. Cir. 1993).

infringement is about assessing overall similarity of the designs.

Symmetry between infringement and anticipation would require that anticipation in design patents also not require identity between the claimed design and the prior art. And, in theory, the Federal Circuit has embraced *Gorham*'s ordinary observer test as the test for anticipation,[51] citing the requirement of symmetry. In practice, however, judicial adoption of design-specific rules for anticipation has been uneven and problematic in several respects. We think that is in part because of the inconsistent application of the different symmetry rules.

Some of those problems mirror problems with the infringement test itself. Prior to *Egyptian Goddess*, courts generally evaluated infringement by lining up the patented design, the accused product, and the closest piece of prior art.[52] That structure allowed the court to identify the "point of novelty" in the patented design—the feature or features making the design patentable over the prior art.[53] The Federal Circuit rejected the point of novelty approach in *Egyptian Goddess*, instructing factfinders to compare the accused product to the patented design from the perspective of the ordinary observer "familiar with the prior art,"[54] and

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[51] *See* Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009) ("In light of Supreme Court precedent and our precedent holding that the same tests must be applied to infringement and anticipation, and our holding in *Egyptian Goddess* that the ordinary observer test is the sole test for infringement, we now conclude that the ordinary observer test must logically be the sole test for anticipation as well.").

[52] *See, e.g.*, FMC Corp. v. Hennessy Indus., Inc., 836 F.2d 521, 526–27 (Fed. Cir. 1987); Applied Arts Corp. v. Grand Rapids Metalcraft Corp., 67 F.2d 428, 430 (6th Cir. 1933).

[53] Titan Tire Corp. v. Case New Holland, Inc., 566 F.3d 1372, 1383 (Fed. Cir. 2009) ("The 'point of novelty' test required a trial court to examine the prior art and the claimed design, identify one or more points of novelty that distinguished the claimed design from the prior art, and then determine whether those points of novelty were included in the accused design . . . .").

[54] Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc) ("Our rejection of the point of novelty test does not mean, of course, that the differences between the claimed design and prior art designs are irrelevant. To the contrary, examining the novel features of

treating that perspective as sufficient to guard against the possibility that the designs would appear similar because of features that did not originate with the patentee.[55]

Despite the fact the *Egyptian Goddess* court explicitly said the ordinary observer test was a test of infringement and not validity, the Federal Circuit later said symmetry demanded that the ordinary observer test be the sole test of anticipation as well—effectively rejecting the point of novelty as the test for novelty.[56] Just saying that out loud is evidence something has gone very wrong. Even if there were good reasons to reject explicit consideration of novelty in infringement, it makes no sense to do so for purposes of, well, novelty.[57] A design should be considered novel only if it actually offers something the prior art did not. The Federal Circuit's failure to recognize that has permitted courts to find infringement based on similarities that do not, in fact, owe their origin to the patentee.[58]

The insistence on symmetry between infringement and anticipation also sometimes causes courts to emphasize in the anticipation context *Gorham*'s language describing substantial similarity as that which would deceive an observer, "inducing him to purchase one supposing it to be

the claimed design can be an important component of the comparison of the claimed design with the accused design and the prior art. But the comparison of the designs, including the examination of any novel features, must be conducted as part of the ordinary observer test, not as part of a separate test focusing on particular points of novelty that are designated only in the course of litigation.").

55 We doubt that is sufficient. *See* Lemley & McKenna, *supra* note 7, at 2276; Lemley, *supra* note 6, at 1271–72.

56 *See Int'l Seaway*, 589 F.3d at 1240 ("In light of Supreme Court precedent and [its] precedent holding that the same tests must be applied to infringement and anticipation, . . . the ordinary observer test must logically be the sole test for anticipation as well.").

57 *Egyptian Goddess* actually said explicitly that it was only expounding an infringement test. 543 F.3d at 678 ("[A]lthough the approach we adopt will frequently involve comparisons between the claimed design and the prior art, it is not a test for determining validity, but is designed solely as a test of infringement.").

58 *See, e.g.*, OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997); Apple Inc. v. Samsung Elecs. Co., 786 F.3d 983 (Fed. Cir. 2015).

the other."[59] In our view, that part of the *Gorham* test was never intended to require marketplace context even in the infringement analysis. It is, instead, a description of the level of similarity necessary to qualify as "substantial" (read: a really high level of similarity). But it is especially problematic to treat that language as requiring, in the anticipation context, contextual information about consumer reaction. Consumers are not part of the evaluation of patents at the PTO, and it's hard to imagine the PTO applying such a standard.[60] Nor is it clear that we should grant a patent on a design just because consumers do not confuse that design for another design. Consumer confusion may frequently be influenced by things outside the designs themselves—where and how the designs are sold, for example.

That hints at a third way in which design patent infringement is different from utility patent infringement has to do with the perspective from which the relevant comparisons are made. Utility patent infringement, like all of the utility patent eligibility rules, is evaluated from the perspective of a person of reasonable skill in the relevant art—a technical expert.[61] By contrast, substantial similarity in design patent law is judged from the perspective of an ordinary observer, typically a purchaser of the type of product.[62] That means the design patent infringement

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[59] *See In re* Honeywell, Inc., 497 F.2d 1344 (C.C.P.A. 1974) ("Federal trademark laws, which are independent in origin from the design patent laws, seek to prevent the public from encountering confusion, mistake, and deception in the purchase of goods and services and to protect the integrity of the trademark owner's product identity.").

[60] The trademark side of the Patent and Trademark Office, which must assess confusion as a central part of its job, nonetheless generally does so with rote rules rather than detailed investigation into actual consumer perceptions. *See* Mark A. Lemley & Mark P. McKenna, *Trademark Spaces and Trademark Law's Secret Step Zero*, 75 STAN. L. REV. 1, 4 (2023).

[61] *See, e.g.*, Dan L. Burk & Mark A. Lemley, *Is Patent Law Technology-Specific?*, 17 BERKELEY TECH. L.J. 1155, 1158 (2002); Rebecca S. Eisenberg, *Obvious to Whom? Evaluating Inventions from the Perspective of PHOSITA*, 19 BERKELEY TECH. L.J. 885, 886 (2004).

[62] *Egyptian Goddess, Inc.*, 543 F.3d at 681–83 (finding infringement because "a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, 'inducing him to

question is at least in part a question of market substitution—does the consumer perceive the designs as interchangeable?[63]

We emphasize those differences because they substantially complicate the question of whether infringement and validity can or should be symmetrical in design patent law. But because design patent law is *patent* law, the Federal Circuit has nonetheless insisted that it must follow utility patent's lead when it comes to anticipation. That has led to an (inconsistent) emphasis on identity, with courts sometimes distinguishing prior art based on small differences when rejecting anticipation challenges,[64] but

purchase one supposing it to be the other'"). Obviousness, by contrast, is judged from the perspective of an ordinary designer. *See* High Point Design LLC v. Buyers Direct, Inc., 730 F.3d 1301, 1313 (Fed. Cir. 2013) ("[O]bviousness is assessed from the vantage point of an ordinary designer in the art . . . ."). Occasionally, the Federal Circuit departs from the ordinary observer to adopt more specialized observers. In *LKQ*, for instance, it held the ordinary purchaser of car parts could not be counted as an ordinary observer and only purchasers of repair parts (such as auto repair shops) counted as the "ordinary" observer. LKQ Corp. v. GM Glob. Tech. Operations LLC, No. 2021-2348, 2023 WL 328228, at *3 (Fed. Cir. Jan. 20, 2023), *reversed on other grounds*, __ F.4th __ (Fed. Cir. May 21, 2024) (en banc). But even when departing from the actual ordinary observer, the court gives lip service to the idea that it is that observer who is supposed to be making the inquiry. *Id.* at *3–4.

63 *See* Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1254 (2014) ("[D]esign patent law tend[s] to find infringement when two products satisfy the same market need or desire . . . ."). There is disagreement whether *depicting* the design rather than applying it to a product is infringement. The issue is thoroughly discussed in Burstein, *Patented Design*, *supra* note 17, who concludes it's not. That approach finds support in *In re SurgiSil, LLP*, which holds a design patent claim is limited to the article of manufacture identified in the patent. 14 F.4th 1380, 1381 (Fed. Cir. 2021). *But cf.* Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 STAN. TECH. L. REV. 107, 164 (2013) (arguing for protection of designs that appear only as virtual images, at least in the context of computers). We tend to think an ordinary observer would not view a depiction as a substitute for the thing itself, but there is no way to know for sure in any given case.

64 *See, e.g.*, High Point Design LLC v. Buyer's Direct, Inc., 621 F. App'x 632, 639–40 (Fed. Cir. 2015) (reversing summary judgment finding of anticipation, finding that small differences in slipper designs were enough to distinguish prior art); Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1314 (Fed. Cir. 2001) (finding that minor differences in

finding similar differences to be insignificant in the infringement context.[65]

Courts' application of the symmetry rules has also warped obviousness in design patent law. In the utility patent context, anticipation demands identity—a claimed

door designs were enough for a reasonable jury to reject an anticipation argument).

Figure 1 shows a bottle design that the court found insufficiently similar to the claimed design to render it obvious, let alone anticipated. *See Vitro Packaging LLC, v. Saverglass, Inc.*, IPR2015-00947, 2015 WL 5766302, at *1, 17 (P.T.A.B. Sept. 29, 2015). Figure 2 shows a "foldable club chair" design that the Patent Trial and Appeal Board also found insufficiently similar. *Macsports, Inc. v. Idea Nuevo, Inc.*, No. IPR2018-01006, at 19 (P.T.A.B. Nov. 13, 2018).

FIGURE 1. BOTTLE DESIGN CLAIM

Claimed Design **Rejected Prior Art Reference(s)**

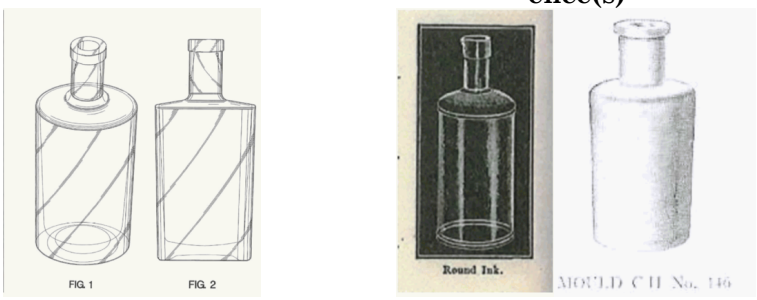
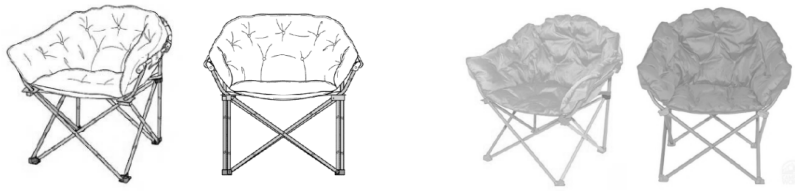


FIGURE 2. FOLDABLE CLUB CHAIR CLAIM

Claimed Design **Rejected Prior Art Reference(s)**



[65] *See* Crocs, Inc. v. Int'l Trade Comm'n, 598 F.3d 1294, 1297–303 (Fed. Cir. 2010) (reversing finding of noninfringement based on minor differences); Mojave Desert Holdings v. Crocs, Inc., 995 F.3d 969, 972 (Fed. Cir. 2021) (procedural ruling noting the Patent Trial and Appeal Board ("PTAB") decision upholding the validity of Crocs patent); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984) ("[M]inor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement."). For criticism of the design patent infringement analysis after *Egyptian Goddess*, see Lemley, *supra* note 6, at 1270–72.

invention is anticipated only if every element can be found in a single prior art reference. Obviousness complements anticipation by foreclosing patents on inventions that are not identically disclosed in the prior art, but that are only insignificantly different from it. That relationship doesn't translate directly to the design patent context because the design patent anticipation rule already doesn't require identity; it asks whether the claimed design is substantially similar to the prior art.[66] Having created a penumbra for anticipation, courts do not really know how to do a penumbra around a penumbra for obviousness.[67]

Because of the primary reference requirement in place from 1980 until its overruling in 2024, in practice the only real difference between anticipation and obviousness in design patent law has been the perspective from which the similarity comparison is supposedly made.[68] While the ordinary observer is used to measure anticipation, the courts

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66 The alternative would be Perry Saidman's view that no design patents are anticipated unless they are identical copies. *See* Perry J. Saidman, *Design Patents are Sinking in* International Seaway*: Rethinking Design Patent Anticipation*, SOC. SCI. RSCH. NETWORK 13 (2020) https://ssrn.com/abstract=3532376 [https://perma.cc/ZL4P-JPVB] ("The Federal Circuit needs to revert to the long-standing test for design patent anticipation, i.e., whether the single applied reference is identical in all material respects to the claimed design."). From a scope perspective, however, that should entail that only identical copies infringe, and the courts have consistently rejected that idea. *See* Burstein, *Patented Design*, *supra* note 17, at 184; Sarah Burstein, *Is Design Patent Examination Too Lax?*, 33 BERKELEY TECH. L.J. 607, 615 (2018) [hereinafter Burstein, *Design Patent Examination*].

67 *Cf.* Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1429–30 (Fed. Cir. 1997) (refusing to use the doctrine of equivalents to expand the penumbra of a means-plus-function claim); Conopco, Inc. v. May Dep't Stores Co., 46 F.3d 1556, 1562 (Fed. Cir. 1994) ("The doctrine of equivalents cannot be used to erase 'meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement.'" (quoting Pennwalt Corp. v. Durand–Wayland, Inc., 833 F.2d 931, 935 (Fed. Cir. 1987) (en banc), *cert. denied*, 485 U.S. 1009 (1988))).

68 The court's recent overruling of its prior test for obviousness in *LKQ Corp. v. GM Global Technology, Inc.*, __ F.4th __ (Fed. Cir. May 21, 2024) (en banc), may end up leading to further differences, particularly by allowing more combination of prior art references (as is characteristic in utility patent) and in allowing prior art to come from fields beyond the particular article of manufacture.

use a different audience, the "designer of ordinary skill," for obviousness.[69] That difference leads to an odd lacuna in the relationship between anticipation and obviousness not present in utility patents.[70] It may mean, for example, that in unusual cases an invention might be anticipated (because the ordinary observer sees no real difference from the prior art) but not obvious (because a designer would view the two as different). By definition, that could never be true in utility patent law—both anticipation and obviousness are evaluated from the perspective of the same person with ordinary skill in the art. Theoretically, it may also mean the opposite: there can be different relevant prior art, because obviousness focuses on designers of ordinary skill rather than ordinary observers, and they may look to different sources.[71]

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69 Spigen Korea Co., Ltd. v. Ultraproof, Inc., 955 F.3d 1379, 1383 (Fed. Cir. 2020) ("For design patents, the ultimate inquiry for obviousness 'is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.'" (quoting Titan Tire Corp. v. Case New Holland, Inc., 566 F.3d 1372, 1380–81 (Fed. Cir. 2009))).

70 The unusualness of evaluating novelty and obviousness from different perspectives probably explains why the Federal Circuit has not always kept the perspectives straight. *See* Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009) ("For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of art for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been constructed, obviousness, like anticipation, requires application of the ordinary observer test, not the view of one skilled in the art." (footnote omitted)). The Federal Circuit has since recognized that mistake. *See* High Point Design, LLC v. Buyer's Direct, Inc., 730 F.3d 1301, 1313 (Fed. Cir. 2013) ("The use of an 'ordinary observer' standard to assess the potential obviousness of a design patent runs contrary to the precedent of this court and our predecessor court, under which the obviousness of a design patent must, instead, be assessed from the viewpoint of an ordinary designer."); *see also id.* at 1313 n.2 (suggesting "[t]he *International Seaway* court may in fact have had the 'designer of ordinary skill' standard in mind when it used the term 'ordinary observer,'" but "[i]n any event, the court could not rewrite precedent setting forth the designer of ordinary skill standard").

71 *Cf.* Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1363, 1378–79 (Fed. Cir. 2023) (applying an analogous art test to determine whether designers would look outside a particular field for prior art).

Overall, anticipation and obviousness are a muddle. Design patent anticipation is somewhat but not entirely like utility patent anticipation. On one hand, courts demand symmetry between anticipation and infringement, like in utility patent law. But the design patent infringement rule is very different from the utility patent rule, which makes the relationship between anticipation and obviousness quite different in design patent. While we expect design patent obviousness to align more closely with utility patent law after *LKQ*, its relationship with anticipation will continue to look very different, simply because anticipation law looks very different in design patents.

B. Other Differences Between Utility and Design Patents

While the intersection between novelty, nonobviousness, and infringement is the most glaring example of how symmetry between utility and design patents is irretrievably broken, it's not the only example. In this section, we briefly consider several other differences between the two systems.

Claim construction. One important difference between design and utility patents is that design patents are claimed with drawings while utility patents define the invention using words. While there are words in design patent claims, and they may sometimes serve a useful purpose in defining the context in which the design appears, it makes little sense to translate a drawing into words about the drawing and then compare those words to the defendant's image, rather than comparing the images directly.[72] As a result, the Federal Circuit has frequently¾though not always consistently¾discouraged verbal claim construction in

[72] David Byrne compared writing about music to dancing about architecture. Frank Portman, *Writing About Music Is Like Dancing About Architecture*, MEDIUM (July 10, 2018), https://drankf.medium.com/writing-about-music-is-like-dancing-about-architecture-6b273f856411 [https://perma.cc/2FD3-QYTG]. Even if writing about images is not that fruitless, it seems odd to do it only to undo it.

Burk and Lemley have a similar critique of peripheral claiming in utility patents, Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction*, 157 U. PA. L. REV. 1743, 1776 (2009), but the problem is certainly worse here.

design patents.[73] When it does make sense to use words, it is often to identify the unprotectable parts of the drawing for purposes of defining the scope of the patent.[74]

As we discuss below, design patent "claims" are essentially central rather than peripheral.[75] Put another way, they are "signposts" identifying the very thing the patentee claims to have created rather than "fence posts" attempting to define the outer boundaries of what the patentee owns.[76] That changes claim construction even more fundamentally from utility patents. The all-elements rule for anticipation or infringement doesn't make sense with central claims because central claims do not define the elements of a patent in the same way as peripheral claims. Therefore, it's inevitable that the interpretation of design patent claims must be fundamentally different from how claims are interpreted in utility patent law.

Patent prosecution. Utility patents are examined by technically skilled examiners who search for prior art and compare it to the claimed invention. There is room to doubt

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73 Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) ("[T]his court has not required that the trial court attempt to provide a detailed verbal description of the claimed design . . . . [A] design is better represented by an illustration 'than it could be by any description and a description would probably not be intelligible without the illustration.'" (quoting Dobson v. Dornan, 118 U.S. 10, 14 (1886))); *LKQ*, __ F.4th at __ (reversing PTAB decision requiring verbal claim construction).

74 Fromer & McKenna, *supra* note 34, at 142 ("[M]any design patent validity and infringement doctrines require analysis of particular design features, and application of those doctrines encourages¾if it doesn't implicitly demand¾verbal elaboration. . . . [C]ourts must also appropriately define the scope of a party's rights in the design, and they cannot do that without accounting in some way for unprotectable features.").

75 Burk & Lemley, *supra* note 72, at 1747 ("Whereas peripheral claiming purports to mark the outermost boundary of the patentee's claims, central claiming describes the core or gist of the patentee's contribution to technology."). Utility patents used central claiming until the latter part of the nineteenth century, when it was replaced by the current focus on peripheral claims. *See id.* at 1769–71.

76 Burk & Lemley, *supra* note 72, at 1747 ("If the goal of peripheral claiming was to establish fence posts marking the boundary of the patent, we can think of central claiming as replacing fence posts with sign posts identifying new inventions.").

how good examiners are at doing prior art searches and whether they should devote more time to it,[77] but the basic approach is well-established, and it differs from copyright law, which registers virtually every work without substantive examination.[78] In theory, design patent applications are examined like utility patents. But in practice, in part because of central claiming, in part because it's currently so hard to search for designs,[79] and in part because of the strange rules for anticipation and obviousness discussed in the last section, the design patent prosecution process may as well be a registration system. Virtually every design patent application is allowed; only about 2% face anticipation or obviousness rejections.[80] And there is nothing

77 *Compare* Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW. U. L. REV. 1495 (2001) *with* Michael D. Frakes & Melissa F. Wasserman, *Irrational Ignorance at the Patent Office*, 72 VAND. L. REV. 975 (2019). *See also* S. Sean Tu & Mark A. Lemley, *What Litigators Can Teach the Patent Office About Pharmaceutical Patents*, 99 WASH. U. L. REV. 1673 (2022); Mark A. Lemley, Doug Lichtman & Bhaven Sampat, *What to Do About Bad Patents?*, 28 REGUL., Winter 2005–2006, at 10.

78 Thomas A. Reed, *The Role of the Register of Copyrights in the Registration Process: A Critical Appraisal of Certain Exclusionary Regulations*, 18 COPYRIGHT L. SYMP. 1, 13–14 (1968) (explaining the scope of the Copyright Office's review of registration applications is merely to check "whether the work fits under one of the statutory classifications of copyrightable subject matter" and whether other administrative requirements are met).

79 Buccafusco et al., *supra* note 6, at 134 ("The PTO likely has a very difficult time locating relevant design prior art because it is harder to search for shapes than for words."). It is possible the rapid development of image-based AI will help solve this problem, though the PTO is not notorious for being an early adopter of search technology.

80 Crouch, *supra* note 15, at 19 (finding only 1.2% of a sample of over one thousand design patents received "prior-art-based rejection[s]"); Giles, *supra* note 15 (finding a similar percentage of "prior art rejections," 2.1%, as of 2019); Burstein, *Design Patent Examination*, *supra* note 66, at 610 (citing Crouch's statistics on the over 90% allowance rate for design patents and noting "[t]his state of affairs has led some commentators to argue that the USPTO is being too lax in examining design patent applications"); Sarah Burstein & Saurabh Vishnubhakat, *The Truth About Design Patents*, 71 AM. U. L. REV. 1221, 1229–35 (2022) (explaining claims of a roughly 50% rejection rate for design patents are "empirically unsupported").

Burstein argues that the problem is not patent examiners, but the law: "The Federal Circuit has eroded the requirements for design patentability to the point that it is very difficult for the USPTO to reject design

in design patent prosecution that is analogous to the narrowing of utility patent claims by amending them to add new elements.[81]

Enablement and written description. Section 112 of the Patent Act incorporates a constellation of important validity doctrines ensuring the inventor has actually made the invention they claim and didn't claim the invention too broadly.[82] While in theory the same doctrines apply to design patents, in practice most of them have no force. The design is supposed to speak for itself; we shouldn't really need to determine whether a designer looking at a patent could make and use the design or what the design is. The only exceptions are cases where there are inconsistencies between different images shown in the figures of a design patent.[83] And because designs are centrally claimed, we don't need the doctrines of enablement and written description to police the outer boundaries of the patent claims.

Ornamentality and functionality. Design patents are supposed to protect *ornamental* designs. This is one of the rare differences in the statute; indeed, it's the fundamental way in which design patents are distinguished from utility

patent applications, no matter how ordinary or banal the claimed design." Sarah Burstein, *Uncreative Designs*, 73 Duke L.J. 1437, 1466 (2024) [hereinafter Burstein, *Uncreative Designs*]. Here too, the Federal Circuit's recent LKQ decision may have salutary effect. *LKQ*, _ F.4th _.

81 This narrowing is an important step in ensuring the quality of issued patents that is missing for design patents. *See* Mark A. Lemley & Bhaven Sampat, *Examining Patent Examination* 2010 Stan. Tech. L. Rev. 1, 3-9 (finding the vast majority of utility patent applicants have been required by the USPTO to amend their claims before issuance, "serving an important gatekeeper function" against overly broad claims).

The closest analog in design patents may be the occasional practice of changing a broken line in a claim, which is not intended to be limiting, to a solid line, which is. But this happens rarely during prosecution.

82 *See* 35 U.S.C. § 112.

83 See, e.g., Seed Lighting Design Co., Ltd. v. Home Depot, 2005 WL 1868152 (N.D. Ill, Aug. 3, 2005) (invalidating design patent on definiteness grounds because of inconsistencies in the drawings of the claimed lamp). Design patents can only have one claim, so while the drawings can show the claimed design from different perspectives, they cannot conflict—there are not, and cannot be, multiple "embodiments" of a design. *See* Manual of Patent Examining Procedure § 1503.02.

patents, which require inventions to be useful.[84] The Federal Circuit has narrowed the ornamentality requirement almost to the point of nonexistence by defining ornamentality merely as nonfunctionality and then by evaluating nonfunctionality exclusively in terms of alternative designs.[85] The result has been to allow design patents on many highly functional designs,[86] perhaps in a misguided effort to more closely align design and patent rights.[87] But functionality is used to limit the scope of design patents. Where the claimed design includes many functional features, courts often say that those features are only protectable as part of the overall design, the scope of protection for which is narrow.[88]

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84 *See* 35 U.S.C. § 101; Richardson v. Stanley Works, Inc., 597 F.3d 1288, 1293–94 (Fed. Cir. 2010) ("[A] design patent, unlike a utility patent, limits protection to the ornamental design of the article. If the patented design is primarily functional rather than ornamental, the patent is invalid." (citation omitted) (citing Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed. Cir. 1988))); L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) ("A design patent is directed to the appearance of an article of manufacture. An article of manufacture necessarily serves a utilitarian purpose . . . . If the particular design is essential to the use of the article, it can not be the subject of a design patent."). The closest analog to these doctrines in utility patent law is the requirement that an invention be patentable subject matter. But the issues there involve the scope of patents and the risk of protecting abstract ideas. *See* Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 573 U.S. 208 (2014); Mark A. Lemley, Michael Risch, Ted Sichelman & R. Polk Wagner, *Life After* Bilski, 63 STAN. L. REV. 1315 (2011). Those concerns have no parallel in design patents.

85 *See* Mark P. McKenna, *Fixing Functionality in Design Patent Law*, 36 BERKELEY TECH. L.J. 195 (2022).

86 *See, e.g.*, Sport Dimension, Inc. v. Coleman Co., 820 F.3d 1316, 1320–23 (Fed. Cir. 2016); Apple Inc. v. Samsung Elecs. Co., 786 F.3d 983, 998–99 (Fed. Cir. 2015). For a discussion of how ornamentality has been lost to history, see Landers, *supra* note 9, at 222–24.

87 For more discussion of the proper role of functionality in design rights, see Christopher Buccafusco & Mark A. Lemley, *Functionality Screens*, 103 VA. L. REV. 1293 (2017); Buccafusco et al., *supra* note 6; McKenna, *supra* note 85.

88 See Sport Dimension, Inc. v. The Coleman Co., Inc., 820 F.3d 1316, 1323 (Fed. Cir. 2016) ("the armbands and side torso tapering serve a functional purpose, so the fact finder should not focus on the particular designs of these elements when determining infringement, but rather focus on what these elements contribute to the design's overall ornamentation. Because of the design's many functional elements and its

Copying. Independent invention isn't a defense in patent law. Almost all utility patent cases are filed not against those accused of copying the plaintiff's invention but against independent inventors who arguably stumbled accidentally into the territory set off by the patentee's claim.[89] By contrast, a large fraction of design patent infringement litigation is about defendants accused of copying.[90] This is likely a function of central claiming, which focuses on the similarity between the patent and the accused product rather than the peripheral boundary of the claim, and differences in claim scope.

Damages. Monetary remedies are fundamentally different between utility and design patents. Utility patent damages are designed to compensate the inventor for lost profits or lost licensing revenue; only the plaintiff's losses, not the defendant's gains, can be recovered.[91] By contrast, a design patent plaintiff is entitled to capture the defendant's total profits from the sale of the article of manufacture.[92]

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minimal ornamentation, the overall claim scope of the claim is accordingly narrow."); Ethicon Endo-Surgery, Inc., v. Covidien, Inc., 796 F.3d 1312, 1334 (Fed. Cir. 2015) (limiting claim scope for design with functional elements).

89 Christopher A. Cotropia & Mark A. Lemley, *Copying in Patent Law*, 87 N.C. L. REV. 1421, 1443 (2009) ("Barely 10% (21 of 193, or 10.9%) of the complaints we studied alleged that the defendant had copied the invention, either from the patent or from the plaintiff's commercial product.").

90 Crouch, *supra* note 15, at 25 n.120 ("[O]ver 77% of the complainants in my sample self-identified as the manufacturer of a product covered by the asserted design patent and also asserted that the infringement was 'willful.' Slightly less than half specifically accused the defendant of copying or creating a knock-off product.").

91 *See* 35 U.S.C. § 284 ("Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court."); Aro Mfg. Co. v. Convertible Top Replacement Co., 377 U.S. 476, 505 (1964) ("By the 1946 amendment, Act of August 1, 1946, c. 726, § 1, 60 Stat. 778, 35 U.S.C. (1946 ed.), §§ 67, 70, the statute was changed to approximately its present form, whereby only 'damages' are recoverable. The purpose of the change was precisely to eliminate the recovery of [defendant's] profits as such and allow recovery of damages only." (footnote omitted)).

92 *See* 35 U.S.C. § 289.

That's generally a much higher number; courts have debated how broadly to define the article of manufacture.[93] But it is in any event a totally different calculation based on different evidence. Indeed, it's not even a measure of damages but an equitable remedy of disgorgement of profits.[94]

C. Central Versus Peripheral Claiming

As we have suggested above, many of the differences in the ways courts apply doctrines in the design patent context are traceable, at least in part, to the nature of design patent claims. Utility patents use peripheral claiming. That is, we define the validity and scope of utility patent rights by identifying the outer bounds of what is covered by the patent. Design patents, by contrast, use central claiming. We determine validity and infringement of a design patent not by trying to write out the metes and bounds of the invention but by comparing the thing the plaintiff made to the prior art or to the defendant's product. In Burk and Lemley's parlance, design patents are based on signposts identifying the core thing being protected while utility patents are based on fence posts setting out the boundaries of the IP right.[95]

That difference affects virtually everything about the evaluation and enforcement of the resulting patent right. A peripheral claiming system requires written claims, and it requires claim construction to determine the metes and bounds of the invention and therefore to find infringement.[96] A central claiming system doesn't need written claims; it compares the products directly.[97] A peripheral claiming

93 *See* Samsung Elecs. Co. v. Apple Inc., 580 U.S. 53, 62 (2016). *See generally* Sarah Burstein, *The "Article of Manufacture" Today*, 31 HARV. J. L. & TECH. 781, 789–93 (2018); Pamela Samuelson & Mark Gergen, *The Disgorgement Remedy of Design Patent Law*, 108 CALIF. L. REV. 183 (2020); Lemley, *supra* note 16, at 222–24.

94 *See* Chauffeurs, Teamsters & Helpers, Local No. 391 v. Terry, 494 U.S. 558, 570 (1990) ("[W]e have characterized damages as equitable where they are restitutionary, such as in 'action[s] for disgorgement of improper profits.'" (quoting Tull v. United States, 481 U.S. 412, 424 (1987))); Samuelson & Gergen, *supra* note 93 (discussing the history of disgorgement as an equitable remedy in IP cases).

95 *See* Burk & Lemley, *supra* note 72, at 1747.

96 *See id.* at 1747.

97 *See id.* at 1747.

system requires element-by-element identification of the invention to determine whether it is new and nonobvious; central claiming doesn't necessarily require that. Peripheral claiming requires the PTO to review the claims to see if they are enabled. That isn't true of a central design claim, which essentially enables itself. And we may have less need for PTO evaluation of prior art if we are looking for identical prior art than if we are looking to see if the prior art includes anything within the boundaries of the fence.

Utility patents did not always use peripheral claiming. In 1842, when the United States first protected design patents,[98] utility patents were centrally claimed. So the fact that the design patent statute says the utility patent rules apply unless otherwise noted should be understood against that backdrop. In the mid-nineteenth century, validity and infringement of utility patents looked much more like design patents do today. The linkage may have made sense back then. But that's no longer true.

II. DESIGN ISN'T INVENTION[99]

Design patents, then, aren't like utility patents in any meaningful sense. And we think that's a good thing. In this Part, we explain why design is different than invention, and why a law protecting design should necessarily differ from utility patent law.

Designers are not the archetypal subjects of IP. Designers are not authors who seek only creative expression nor are they inventors pursuing only technological

98 *See* Peter Lee & Madhavi Sunder, *Design Patents: Law Without Design*, 17 STAN. TECH. L. REV. 277, 280 (2013) ("Congress enacted the first design patent statute in 1842 based on a perceived lack of protection for ornamental designs.").

99 This section is adapted from Mark P. McKenna & Jessica Silbey, *Investigating Design*, 84 U. PITT. L. REV. 127, 140–43 (2022). For additional discussion of how design is different, see J. H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 COLUM. L. REV. 2432 (1994); Peter Lee & Madhavi Sunder, *The Law of Look and Feel*, 90 S. CAL. L. REV. 529 (2017).

innovation. In some ways, designers are hybrids of authors and inventors; in other ways they are neither.[100]

At least paradigmatically, inventors solve scientific and technological problems.[101] Invention is a mental activity more than a physical one—it is, famously, "not the work of the hands, but of the brain."[102] As a result, patent doctrine traditionally prioritized conception of the invention in the mind of the inventor over the work necessary to reduce the invention to practice.[103]

Inventions are patentable only when they are both new and nonobvious.[104] The inventor displays "ingenuity" and

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100 For more elaboration of designers' views of the design process based on interviews with a wide range of design professionals, see McKenna & Silbey, *supra* note 99, at 140–146.

101 We can dispute this rigid characterization and the ones following about authorship, but the point is IP law instantiates them for the purposes of channeling and regulating the activity and output.

102 Edison v. Foote, 1871 Dec. Comm'r Pat. 80, 81.

103 *See In re* Hardee, 223 U.S.P.Q. 1122, 1123 (Dec. Comm'r Pat. 1984) ("The threshold question in determining inventorship is who conceived the invention. . . . Insofar as defining an inventor is concerned, reduction to practice per se is irrelevant."). In fact, however, the law turns out to be significantly more complicated than this. It turns out we want both idea and implementation in utility patents. *See* Christopher A. Cotropia, *The Folly of Early Filing in Patent Law*, 61 HASTINGS L.J. 65, 73–74 (2009); Mark A. Lemley, *Ready for Patenting*, 96 B.U. L. REV. 1171, 1194 (2016).

104 *See, e.g.*, Laura Pedraza-Fariña & Ryan Whalen, *A Network Theory of Patentability*, 87 U. CHI. L. REV. 63 (2020) (relying on network theory and describing nonobviousness in terms of the combination of knowledge from distant fields). Novelty implies difference from what came before but only in the narrow sense that a claimed invention must not be exactly like the prior art. To anticipate, a single prior art reference must disclose every element of the claimed invention. The utility requirement does very little to limit patent law's domain as modern utility doctrine requires only that a claimed invention work for its intended purpose and have some credible use. *See* Brenner v. Manson, 383 U.S. 519, 533 (1966). As Professor Michael Risch has said, "the requirement that an invention be useful has been nearly nonexistent—essentially ignored." Michael Risch, *A Surprisingly Useful Requirement*, 19 GEO. MASON L. REV. 57, 58 (2011); *see also* Tun-Jen Chiang, *A Cost-Benefit Approach to Patent Obviousness*, 82 ST. JOHN'S L. REV. 39, 40 n.1 (2008) ("Nonobviousness is not the only requirement for a valid patent. . . . Nevertheless, nonobviousness has been frequently recognized as the 'ultimate condition of patentablility.'").

isn't merely someone with mechanical or artisanal skills.[105] Nonobviousness is judged from the perspective of the hypothetical "person having ordinary skill in the art" (the PHOSITA).[106] The Supreme Court recently characterized obviousness in these terms:

> When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under [the Patent Act].[107]

Interviews with designers make clear that designers are not merely inventors in this sense. Designers build prototypes and test models. Iteration, not discovery or revelation, is the primary method of problem-solving. Many designers differentiate design from engineering precisely by reference to this iterative process. Designers explain (and McKenna and Silbey show empirically) that design work is based on tinkering and brainstorming, and it is more emergent.[108] Also, most designers don't work alone but in interdisciplinary teams, a hallmark of their practice. And designers rarely consider their final output a "first" or "novel." Instead, designers generally regard their work as building upon things that came before, which is what makes the work relevant and useful but also familiar and desirable.[109]

Moreover, while utility patent law imagines inventors as skilled in a particular field and therefore evaluates obviousness in relation to "pertinent art," designers tend to roam more broadly. For many designers, hewing closely to

105 Hotchkiss v. Greenwood, 52 U.S. (11 How.) 248, 267 (1850).

106 Graham v. John Deere Co., 383 U.S. 1, 13–14 (1966); *Hotchkiss*, 52 U.S. at 267.

107 KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 421 (2007).

108 McKenna & Silbey, *supra* note 99, at 142.

109 *Id.* at 142.

precedent would be an incomplete process unlikely to produce good design. Designers regularly borrow and derive inspiration from a wide range of fields and objects.[110]

Like inventors, designers consider themselves to be solving problems (or "finding and solving" problems, as the McKenna-Silbey data explain).[111] But designers conceive of the "problems" they address in broad terms. They are not just solving scientific or technical problems. Designers often explain that their goal is the seamless blending of form and function, of the aesthetic and the useful.[112] That blending is what makes it so difficult to differentiate the functional and non-functional aspects of design, as the various channeling doctrines in IP attempt to do. Designers frequently seek to integrate form and function, and as a result, design output is routinely *both* aesthetic and functional. Even features that might on their own be susceptible of one of those categorizations are often blended in ways that resist disentanglement of the whole.

Design practice fits poorly with patent law because it is, at least in part, concerned with artistry, but it also fits poorly with copyright because that artistry must be merged with or subordinated to function. Those differences are why Congress thought a separate design right necessary. But they are also why neither patent nor copyright doctrines are a particularly good fit for design.

III. REDESIGNING DESIGN PATENTS

The weird partial symmetry between design and utility patents has left us with some nonsensical doctrines. In this Part, we offer thoughts on how to fix some of those problems. In Section A, we discuss ways design patent law could change even within the existing framework. In Section B, we articulate a more logical framework for an independent design patent right, assuming such a thing is desirable. Finally, in Section C we consider how these changes be implemented.

110 *Id.* at 142.
111 *Id.* at 142.
112 *Id.* at 142.

A. Rationalizing Design Patent Doctrine

1. Anticipation and the Ordinary Observer

If, as we have argued so far, design patent infringement doesn't—and shouldn't—look like utility patent infringement, then either the "utility patent = design patent" or the "infringement = anticipation" symmetry has to break. As we described above, courts already recognize that, in fact, utility patents are not equivalent to design patents in some respects. The problem is that recognition is only partial—in other contexts, courts insist utility patent principles must apply. As we have argued elsewhere, symmetry between infringement and anticipation is of central importance to all IP doctrines.[113] The scope of any IP right should be consistent. If the patent is broad enough to cover a design at infringement time, it's broad enough to be anticipated by the same design.

For this reason, we think it would be a mistake to reflexively apply the utility patent rules for anticipation. Anticipation shouldn't look like it does in utility patent law for the same reason infringement doesn't—it comes from a central rather than a peripheral claim. There is no regime for setting peripheral boundaries in design patent law.[114] And design patent claims don't have elements. As we have suggested elsewhere, it would be a very bad idea to give patent owners control over things already in the prior art.[115]

113 *See* Lemley & McKenna, *supra* note 7, at 2200.

114 Indeed, the presence of dotted-line claims and claim fragments means that even image-based claims are much less limiting than they might appear to be. Burstein, *supra* note 12, at 187–95; Sarah Burstein, *How Design Patent Law Lost Its Shape*, 41 CARDOZO L. REV. 555, 565 (2019).

115 *See* Lemley & McKenna, *supra* note 7, at 2242 ("The practical effect of not having a practicing the prior art defense is that some defendants who are actually using old technology are nonetheless held liable, and more are forced to pay settlements to avoid the risk of losing a case that, in theory, they should win."); *see also* Graham v. John Deere Co., 383 U.S. 1, 6 (1966) ("Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. . . . This is the standard expressed in the Constitution and it may not be ignored." (emphasis omitted)).

Doing so undermines what intellectual property is supposed to be about by rewarding those who take from others rather than those who contribute something new. So if the test of design patent infringement differs from the utility patent infringement test because of the different ways designs are claimed, then the test for anticipation also needs to adapt to the demands of design. If the infringement question is whether the ordinary observer would view the designs as substantially similar, that should be the question for anticipation too.

But two differences turn out to make the translation of the infringement standard to anticipation very difficult. The infringement-anticipation maxim¾"[t]hat which infringes, if later, would anticipate, if earlier"[116]¾works in utility patents because the mode of evaluation of similarity doesn't differ between infringement and anticipation, and because neither of those analyses depends on the perspective of someone purchasing the patented invention. In utility patent law, similarity is evaluated from the perspective of a person situated in the technical field of the invention; not someone whose perspective depends on the commercial context in which that invention is sold.[117] The ordinary observer in design patent is generally understood to be the ordinary purchaser of the articles in which the patented design appears.[118] Because the same design can be sold in multiple commercial contexts, the perspective of the ordinary observer can matter quite a lot in design patents.[119] Differences might seem very small or irrelevant in the eyes of certain observers but quite meaningful in the eyes of a

116 Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1239 (Fed. Cir. 2009) (alteration in original) (quoting Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889)).

117 *See, e.g.*, Burk & Lemley, *supra* note 61, at 1156.

118 Some cases have improperly departed from that ordinary observer test, substituting a specialized observer like a *repair* purchaser. *See* LKQ Corp. v. GM Glob. Tech. Operations LLC, No. 2021-2348, 2023 WL 328228, at *3, *rev'd on other grounds*, __ F.4th __ (Fed. Cir. May 21, 2024) (en banc).

119 *See* Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1363, 1374 (Fed. Cir. 2023) (relevant art depended on the market in which the design patent operated).

different observer, as we show below is true of car part purchasers.[120]

The substantial similarity requirement comes from *Gorham*.[121] Because the Court in that case was articulating an infringement standard, it was focused on a comparison between the defendant's silverware and the plaintiff's patented design.[122] Since the defendant in that case was selling competitive silverware sets and not replacement pieces, it was natural for the court to evaluate similarity from the perspective of a purchaser of new silverware. That is to say that the Court implicitly defined the relevant observer by reference to the *defendant's* use, not the plaintiff's.

But we don't have that commercial context when it comes to anticipation, because we don't know who might be sued for infringement. Anticipation is a validity doctrine, and for that reason it should not be shaped by the defendant's use. If it were, the same design could be invalid in one case because of the nature of the defendant's activities, but valid in another case where the defendant was in a different market—even though it's the same design. That makes a mockery of anticipation as a validity doctrine: the same design can't be anticipated in one case but not in another. Further, the PTO considers anticipation in the first instance, and, in that context there is no "defendant's use" shaping the similarity assessment.[123] Anticipation is determined by comparison of the claimed design to the prior art references, and that comparison should not be prompted by the presence of some other party's design.

The context-dependence of the ordinary observer standard is nowhere better illustrated than in the context of replacement parts. Car manufacturers obtain design patents

120 *See infra* notes **Error! Bookmark not defined.**–132 and accompanying text.

121 Gorham Co. v. White, 81 U.S. 511 (1871).

122 *See id*.

123 U.S. Patent and Trademark Office, *2131 Anticipation — Application of 35 U.S.C. 102 [R-08.2017]*, (Feb. 16, 2023, 12:58 PM) https://www.uspto.gov/web/offices/pac/mpep/s2131.html#~:text=102%20%5BR%2D08.2017%5D,is%20available%20as%20prior%20art [https://perma.cc/KEC9-W3LN].

on components of their vehicles—in many cases, very small components. Figure 3 shows a design patent filed for the front fender of a vehicle,[124] and Figure 4 shows a design patent filed for the rear fascia upper of a vehicle.[125]

FIGURE 3. DESIGN PATENT FOR FRONT FENDER OF A VEHICLE

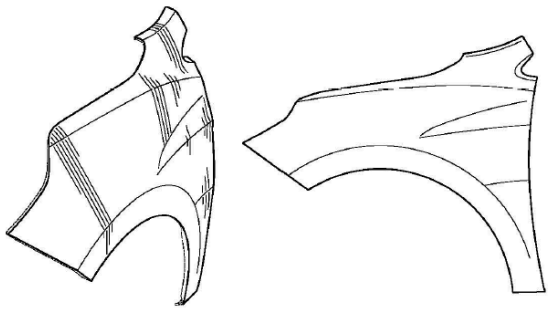
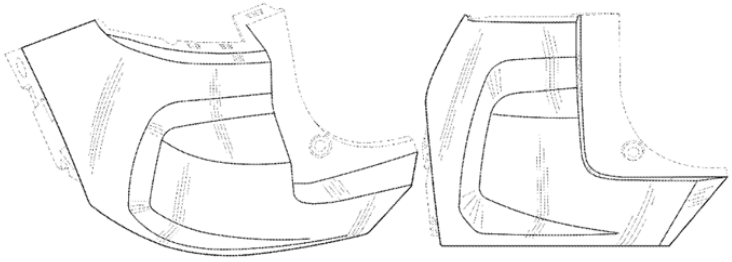


FIGURE 4. DESIGN PATENT FOR REAR FASCIA UPPER OF A VEHICLE



Those parts are incorporated into new vehicles in the first instance, so it seems logical to treat car buyers as the ordinary observers for the purpose of evaluating the novelty of the claimed designs. But the same designs are also sold in smaller quantities as replacement parts for vehicles involved in accidents.[126] Purchasers of replacement parts seek to

124 Vehicle Front Fender, U.S. Patent No. D797,625 S (filed Aug. 24, 2016) (issued Sept. 19, 2017).

125 Vehicle Rear Fascia Upper, U.S. Patent No. D931,176 S (filed Sept. 11, 2019) (issued Sept. 21, 2021).

126 *See* LKQ Corp. v. GM Glob. Tech. Operations LLC, No. 2021-2348, 2023 WL 328228, at *3–4, *reh'g en banc granted*, 71 F.4th 1383 (Fed. Cir. 2023).

restore their vehicles to their original design, so those purchasers are likely attuned to small differences between the designs they seek and other similar designs—differently-designed parts don't match the cars they are meant to repair.[127] Purchasers of new vehicles, by contrast, are purchasing the overall design of the car, and they are likely much less attuned to small differences in the designs of individual parts.[128]

In *LKQ Corp. v. GM Global Technology Operations LLC*,[129] the Federal Circuit panel defined the ordinary observer as the purchaser of replacement parts, upholding the validity of patents on designs with only tiny differences over the prior art.[130] In doing so, the court emphasized that LKQ "[could not] disagree that there is a market for the claimed fender alone, given that its business is selling individual replacement parts," and said it was "of no consequence" that "GM sells whole vehicles to retail consumers, rather than fenders to car manufacturers."[131] In the court's view, because the design was for a part and not the whole vehicle, and because some purchasers are interested in the part standing alone, the ordinary observer was the purchaser of replacement parts. Put simply, the court defined the ordinary observer by reference to LKQ's business model, even when the relevant comparison was between the patented designs and prior art that LKQ had not created or sold.[132]

The problem is that those same patents might be asserted not just against parties making the replacement parts but against competing car manufacturers. If a court defined the ordinary observer in that kind of case as the purchaser of repair parts, it would unduly narrow the

127 *See id.*

128 For an argument that design patents should cover the entire product, not just one piece, see Burstein, *Design Patent Examination*, *supra* note 80, 1480–81, 1497–98. But that ultimately just shifts the question to whether and when a part can be an entire product.

129 No. 2021-2348, 2023 WL 328228, at *3–4, *rev'd on other grounds,* __ F.4th __ (Fed. Cir. May 21, 2024) (en banc).

130 *See id.* at *3.

131 *Id.* at *3 (citation omitted).

132 *See id.*

infringement inquiry since only purchasers focused on small differences would be considered. Other purchasers who might regard the designs as fairly similar won't be taken into account, and the defendant's product won't be considered infringing. But if the court were to switch its definition of the ordinary observer to take account of the defendant's consumers, it would be treating the patent "like a nose of wax," narrowing it at the validity stage and broadening it for purposes of infringement.[133]

Relatedly, because the design patent anticipation rule requires the perspective of an ordinary observer, the same design might be deemed anticipated (or not) depending on the identity of the *patentee*. The reason is that the ordinary observer is usually defined as the purchaser to whom a design is marketed in the first instance.[134] In some cases, that purchaser is a retail customer for the article bearing the claimed design. In those cases, the retail customers are the ordinary observers.[135] In other cases, articles bearing the design are initially sold to parties who then combine those articles into a composite product ultimately sold to retail customers. In those cases, the ordinary observer is the wholesale customer who combines the component into a complex product.[136] That implies the ordinary observer

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133 *See* White v. Dunbar, 119 U.S. 47, 51 (1886); Lemley & McKenna, *supra* note 7, at 2200 ("[P]arties treat IP rights 'like a nose of wax which may be turned and twisted in any direction.' When infringement is at issue, IP owners tout the breadth of their rights, while accused infringers seek to cabin them within narrow bounds. When it comes to validity, however, the parties reverse their positions: IP owners emphasize the narrowness of their rights in order to avoid having those rights held invalid, and accused infringers argue the reverse." (footnote omitted) (quoting *White*, 119 U.S. at 51)).

134 *See LKQ*, 2023 WL 328288 at *3.

135 *See id.* at *3.

136 *See* KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc., 997 F.2d 1444, 1451 (Fed. Cir. 1993) ("[T]he patented design is of an individual block, not an assembled wall, and the 'ordinary observer' for the purpose of the block design patent is a purchaser of the patented block, not of the unpatented wall."); Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1323 (Fed. Cir. 2007) ("We agree, therefore, with the district court that the ordinary observer of the sprayer shroud designs at issue in this case is the industrial purchaser or contract buyer of sprayer

should be the retail purchaser of a new vehicle when the parts are made by the vehicle seller and first sold as parts of new vehicles, even when claimed as separate parts.[137] But where the parts are designed and sold by an independent parts supplier for inclusion in new vehicles, the ordinary purchaser would be the car company that buys the individual parts and combines them into composite vehicles they then sell to retail customers. Because purchasers of new vehicles may evaluate the similarity of fender designs differently than purchasers of fenders intended for inclusion in a new vehicle, under current law the same design might be deemed anticipated in one context but not the others. This is another effect of novelty being evaluated from a perspective requiring commercial context. Because anticipation requires information about who uses the design and how, the same design might be anticipated when a party with one business model claims it, but not anticipated when a party with a different business model does.

The fact that the definition of the ordinary observer can have such a powerful effect on the way certain features of the design might be emphasized in relation to prior art demonstrates the extent to which design patent standards require resort to the real-world context of product use, which is information outside of the patent and the prior art references and even outside of the field in which the design is created.[138]

shrouds for businesses that assemble the retail product from the component parts . . . .").

137 *Contra* LKQ Corp. v. GM Glob. Tech. Operations LLC, No. 2021-2348, 2023 WL 328228, at *3 (ignoring who purchases the parts in the first place because the patent covers only a part of the original product), *reh'g en banc granted*, 71 F.4th 1383 (Fed. Cir. 2023). For a discussion of the implications of allowing design patents to claim only a part of an article of manufacture, see generally Burstein, *supra* note 12; Burstein, *supra* note 114.

138 It is also worth noting that an anticipation standard requiring commercial context is one patent examiners are badly situated to apply. It is hard to imagine examiners having sufficient information to make judgments about what ordinary purchasers are likely to pay attention to. It's even harder to imagine examiners doing that across multiple possible contexts.

That is a striking contrast with utility patent law. Neither anticipation nor infringement in utility patent law requires consideration of commercial context—both are evaluated from the perspective of a technical expert, not the perspective of purchasers.[139] That means the comparisons—between the accused invention and the patented invention, or between the patented invention and the prior art—do not vary from case to case. It is precisely because none of the comparisons in utility patent law require commercial context, and because identity is the standard for both anticipation and infringement, that it is possible to say "[t]hat which infringes, if later, would anticipate, if earlier."[140] The fact that both of those things are different in design patent law is what makes it so difficult to hold the symmetry there.

2. Confusion About Confusion

The application of the symmetry rule between anticipation and infringement has led to another unfortunate rule in the Federal Circuit—too much emphasis on consumer confusion as the standard for anticipation.[141] The issue arises because of language in *Gorham* referring to the possibility of the customer "purchas[ing] one supposing it to be the other."[142] To be clear, consumer confusion is *not*, standing alone, the test for design patent infringement. The test is whether the ordinary observer would view the two designs as substantially the same, and the confusion language in *Gorham* is only supposed to indicate that the similarity threshold is very high: the accused product must be so similar that the ordinary observer would purchase one

139 *See* Messerschmidt v. U.S., 29 Fed. Cl. 1, 21 (Fed. Cl. 1993); Fromer & Lemley, *supra* note 63, at 1254.

140 Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1239 (Fed. Cir. 2009) (alteration in original) (quoting Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889)).

141 *See id.* at 1239–40; *LKQ*, 2023 WL 328228, at *4.

142 Gorham Co. v. White, 81 U.S. 511, 528 (1871); *see also* Lee & Sunder, *supra* note 99, at 558 (describing *Gorham*'s language as "somewhat reminiscent of the consumer confusion standard from trademark . . . law").

believing it to be the other.[143] Consumer confusion is relevant to design patent infringement only insofar as it indicates—in the infringement context, where the consumer has two designs to compare—that the two are, in fact, that similar. That is effectively the opposite of trademark law, where similarity itself isn't the issue; similarity is relevant only to the extent it makes confusion more likely in view of all the relevant contextual information regarding who buys the products and where.

But even if that type of confusion might be probative of similarity in the infringement context, it makes much less sense to focus on confusion in anticipation context. First, there aren't always two products to compare side by side in the anticipation context—prior art references might be other design patents or images in printed publications. Second, it's impractical to consider confusion when deciding whether to issue a patent in the first place. It is hard enough for the PTO to identify the proper context to pick an ordinary observer. To demand contextual information about how consumers encounter the designs in the market, or to require surveys about confusion would impose an impossible burden. Courts testing both infringement and anticipation should focus primarily on similarity, not consumer confusion.

3. Crowded Field

There are additional problems with translating the infringement standard to anticipation, even though those standards are supposed to be the same. In the infringement context, courts have sometimes said that when there is a crowded field, small differences matter to an observer's

143 *See* Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 677–78 (Fed. Cir. 2008) (en banc); Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1323–24 (Fed. Cir. 2007); Perry J. Saidman, *Functionality and Design Patent Validity and Infringement*, 91 J. PAT. & TRADEMARK OFF. SOC'Y 313, 329 (2009) ("As aptly held by the *Elmer* court, and affirmed in *Egyptian Goddess*, 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 eye of an ordinary observer." (footnote omitted)).

impression of similarity.[144] That concept makes sense in the infringement context: if there are many similar designs, small differences between the accused product and the patented design might be salient to ordinary observers and make designs that initially seem similar different enough that the accused product is not infringing.

But the crowded field concept makes much less sense in the anticipation context. Saying small differences are enough to avoid prior art has the perverse effect of making it more difficult to find anticipation when there is more prior art.[145] That puts more pressure on obviousness law to exclude designs that are not meaningfully different from the prior art. Small differences might be more observable against a large number of prior art designs, but the fact that the differences are small would be the very reason the design was obvious. And that's certainly how things would play out in utility patent law.[146]

As we explain in more detail below, however, until very recently, design patent law did not have a robust obviousness requirement. Courts seemed to accept that granting patents on trivial designs was not a big problem because patents in crowded fields are likely to be extremely narrow. But while there is some reason to think most design patents are narrow,[147] that's not a sufficient response. For one thing, we doubt courts enforce similarly narrow scope at the infringement stage. There are also costs to cluttering the patent register with a flood of patents differing only trivially from the prior art. And there are some contexts where narrow scope would not help: replacement parts, for example, need to be very close to the original design to work as replacement parts and there are significant competitive

144 *See, e.g.*, Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984).

145 *See, e.g.*, Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1314 (Fed. Cir. 2001); *LKQ*, 2023 WL 328288, at *6.

146 *See* Mark Bartholomew, *Nonobvious Design*, 108 IOWA L. REV. 601, 644 (2023).

147 *See* Burstein, *Design Patent Examination*, *supra* note 80, at 615 (praising the narrow scope that courts have thus far given to design patents in infringement actions and noting it would make denying design patent claims more difficult).

costs to giving out design patents for parts lacking any meaningful design contribution.[148] We think it's better for courts to test the similarity of designs directly without making the unwarranted assumption that the less creative the design, the closer people look at it.

In that regard, the Federal Circuit's en banc decision in *LKQ* could significantly improve design patent law by focusing the obviousness inquiry more squarely on the perspectives of designers and by making the obviousness comparison much less rigid.

4. Obviousness

Utility patent law's nonobviousness requirement is the means of preventing patents on inventions that make only minor changes over the prior art. That same obviousness rule ostensibly applies to design patents, but until 2024 the Federal Circuit's framework rendered that requirement essentially toothless.[149] A court considering the obviousness of a design had to first identify "a single reference, 'a something in existence, the design characteristics of which are basically the same as the claimed design.'"[150] Only if there was such a primary reference could the court consider secondary references. And even then, the factfinder could look at those secondary references only if they were "so related [to the primary reference] that the appearance of

148 For a discussion of the right to repair movement and how IP may interfere with it, see, e.g., Aaron Perzanowski, THE RIGHT TO REPAIR: RECLAIMING THE THINGS WE OWN 134 (2022).

149 *See* Bartholomew, *supra* note 146, at 601 ("[W]hile nonobviousness has been described as the 'heart' and 'cornerstone' of the utility patent system, in the design patent context, the term has become next to useless. Instead of actually policing nonobviousness in design, modern courts grant patent rights to any work that is not an exact replica of another."); Lee & Sunder, *supra* note 99, at 563 ("[I]t is relatively easy to establish nonobviousness for design patents versus utility patents.").

150 Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed. Cir. 1996) (quoting *In re* Rosen, 673 F.2d 388, 391 (C.C.P.A. 1982)). *LKQ*, 2023 WL 328228, at *7–9 (Lourie, J., additional views) (explaining *Rosen*'s instruction to rely on a single prior art reference for obviousness has not been overruled).

certain ornamental features in one would suggest the application of those features to the other."[151]

The primary reference rule meant that for the past 45 years, the standard for obviousness was virtually identical to the standard for anticipation ("substantially the same" vs. "basically the same"). We are not aware of anyone who has been able to articulate a meaningful difference between those tests in terms of the level of similarity required.[152] The only difference was in the perspectives from which those questions were considered: the ordinary observer for anticipation and the ordinary designer for obviousness. Worse, the primary reference rule wasn't the ultimate standard of design patent obviousness but, rather, a prerequisite to even considering the question of whether the design is obvious. That is, a court couldn't even ask whether the design would have been obvious to a designer of ordinary skill unless it had found a (very high) threshold level of similarity between the claimed design and a single prior art reference.

Fortunately, the en banc Federal Circuit held in *LKQ* that this approach was inconsistent with the Supreme Court's *KSR* decision. *LKQ* held that in design patent law, obviousness analysis must focus on how the designer of ordinary skill approaches problem-solving in the real world.[153]

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151 *Durling*, 101 F.3d at 103 (alteration in original) (quoting *In re* Borden, 90 F.3d 1570, 1575 (Fed. Cir. 1996)). Courts sometimes ignore this rule when the absurdity of the results it produces is sufficiently clear. *See* Campbell Soup Co. v. Gamon Plus, Inc., 939 F.3d 1335, 1344 (Fed. Cir. 2019) (design patent for soup can dispenser was obvious over prior art design that was the same except for not depicting the can of soup dispensed).

152 *See* Burstein, *Uncreative Designs*, *supra* note 80, 1473–74 ("[T]he Federal Circuit has required an extremely high degree of visual similarity for primary references, seeming to leave little room between what qualifies as 'the same' design (and, thus, anticipates) and 'basically the same' . . . . This . . . makes the *Durling* test difficult for challengers (and patent examiners) to satisfy.").

153 *LKQ*, __ F.4th at __. *See also* KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 421 (2007) ("A person of ordinary skill is also a person of ordinary creativity, not an automaton.").

LKQ is a welcome change. It is also one that aligns design patent law more closely with utility patent law. How, then, is it consistent with our thesis that design patents are different from utility patents? The answer is that obviousness law since *KSR* has focused precisely on what those of skill in the art would know and do, accommodating exactly the real-world focus we advocate.[154] Under *LKQ*, the question of whether a design is obvious should be determined reference to the way designers would approach something.[155]

Ordinary designers wouldn't limit themselves to making trivial modifications to a single known design.[156] To the contrary, designers often draw from a wide variety of different sources, combining existing designs and adapting concepts to different circumstances.[157] Design patent obviousness will consider combinations of references and modifications of designs based on demand and known principles of design because that is what designers would do.[158] And where there are differences in how designers and inventors approach problems, the new *LKQ* standard

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154 *See, e.g.*, Microsoft Corp. v. Parallel Networks Licensing, LLC, 715 F. App'x. 1013, 1022 (Fed. Cir. 2017) ("An obviousness challenger 'must demonstrate . . . that a skilled artisan would have had reason to combine [or modify] the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.'" (quoting Redline Detection, LLC v. Star Envirotech, Inc., 811 F.3d 435, 449 (Fed. Cir. 2015) (alteration in original)); Stone Strong, LLC v. Del Zotto Prods. of Fla., Inc., 455 F. App'x. 964, 969 (Fed. Cir. 2011) ("The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.* requires an 'expansive and flexible approach' in determining whether a patented invention was obvious at the time it was made." (quoting *KSR*, 550 U.S. at 415)).

155 *See KSR*, 550 U.S. at 419–20.

156 Mark Bartholomew has a new paper that advocates for "ending" the primary reference standard, though that's not his focus. *See* Bartholomew, *supra* note 146, at 638.

157 *See* McKenna & Silbey, *supra* note 99, at 163; P. Gu, M. Hashemian & A.Y.C. Nee, *Adaptable Design*, 53 CIRP ANNALS 539, 539 (2004) (explaining how adaptability and reusing existing designs are critical design success).

158 *See* Smith v. Whitman Saddle Co., 148 U.S. 674, 681 (1893) (finding the patented design obvious in light of evidence "that there were several hundred styles of saddles or saddle-trees . . . and that it was customary for saddlers to vary the shape and appearance of saddle-trees in numerous ways according to the taste and fancy of the purchaser").

accommodates them. For example, the court notes that the universe of references a designer of skill in the art might look to may be different than those a PHOSITA would use. By tying obviousness to the motivations of designers, the Federal Circuit has announced a rule that naturally accommodates differences.

LKQ may also help address some of the other problems we have identified. As we noted, under current law, the primary difference between anticipation and obviousness in design patent law is that we test anticipation from the perspective of the ordinary observer and obviousness from the perspective of the designer of ordinary skill in the art.[159] That difference in perspective could be meaningful—it might even mean different relevant prior art. Because ordinary observers are frequently defined as ordinary purchasers, they will typically look to finished products at some stage of the supply chain. Ordinary designers may look to diverse sources as raw materials for thinking about a design. So, unlike utility patents, a real design patent obviousness inquiry wouldn't be limited to the same prior art relevant for the anticipation inquiry. It will be the same approach *KSR* demands for utility patents—a holistic inquiry focused on what designers would actually do and look at.

5. Functionality

The key concept of design patent subject matter, and the one that distinguishes design patents from utility patents, is ornamentality.[160] But the Federal Circuit has interpreted ornamentality to mean only nonfunctionality, and it has read the functionality doctrine so narrowly it might as well not exist.[161] Both of us have, in prior work, explained the

159 *See* Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009); *In re* Rosen, 673 F.2d 388, 390 (C.C.P.A. 1982).

160 *See* 35 U.S.C. § 171(a).

161 *See* Apple Inc. v. Samsung Elecs. Co., 786 F.3d 983, 996, 998–99 (Fed Cir. 2015). The problem is so bad the same Federal Circuit panel held the same device (the iPhone's rectangle with rounded corners) both *was* functional (under trademark law) and *was not* functional (under design patent law). *See id.* at 996, 998–99.

problems with the Federal Circuit's current cramped reading of the ornamentality requirement[162] and we won't repeat those critiques here. But it may well be that situating design patents in the patent law framework causes patent-trained judges to deemphasize a doctrine entirely absent from utility patents, even though that requirement is the very point of distinction between utility and design patents.[163] Reinvigorating the ornamentality requirement, or at least giving some teeth to the functionality doctrine, would emphasize what design patent law is—and is not—supposed to protect. But it would also be a further reason why drawing doctrines from utility patents doesn't make sense.[164]

B. Implementation

We should break the utility-design patent symmetry. We could do that expressly, taking design rights out of patent law; virtually every other country does so.[165] But that would require legislation. In the current Congress the odds of any legislation, much less rational legislation improving the IP system, seem bleak. And legislation opens the door to rent-

162 *See* Cotropia & Lemley, *supra* note 89, at 1374–75; McKenna, *supra* note 85, at 206–10; *see also* Jason Rantanen, *Guest Post: Design Protection and Functionality: Does the PTO or the Copyright Office Apply a More Rubbery Stamp?*, PATENTLY-O (Nov. 21, 2021), https://patentlyo.com/patent/2021/11/protection-functionality-copyright.html [https://perma.cc/M4VD-ERM7].

163 EU law, by contrast, has a broader reading of functionality. *See* Case C-395-16, DOCERAM GmbH v. CeramTec GmbH (*DOCERAM*), 2018 E.C.R. 179, ¶ 3. For a discussion of the implications—and limitations—of *DOCERAM*, *see* Jens Schovsbo & Graeme B. Dinwoodie, *Design Protection for Products That Are "Dictated by Function"*, *in* THE EU DESIGN APPROACH: A GLOBAL APPRAISAL, 142, 150–52 (Annette Kur et al. eds., 2018); Peter S. Menell, *Navigating the Trans-Atlantic Design Protection Quandary*, *in* HARMONIZING INTELLECTUAL PROPERTY LAW FOR A TRANS-ATLANTIC KNOWLEDGE ECONOMY 26–29 (Peter Mezel et al. eds., forthcoming 2023).

164 *See* Peter S. Menell & Daniel Yablon, Star Athletica*'s Fissure in the Intellectual Property Functionality Landscape*, 166 U. PA. L. REV. ONLINE 137, 141–42 (2017), https://scholarship.law.upenn.edu/cgi/viewcontent.cgi?article=1208&context=penn_law_review_online [https://perma.cc/LLN2-58QL].

165 *See* Menell, *supra* note 163, at 20–24.

seeking that could make important parts of the design protection system worse.[166]

Even without legislation, there is substantial room to differentiate design patents from utility patents. The design patent statute dates to a time before peripheral claiming was the norm in utility patents.[167] Arguably, it is utility patent law that has drifted away from the statutory intent and design patent law that takes a more faithful historical approach.[168]

In any event, the statute equating utility and design patents was written in an era when we created common law rules to give life to the statute. While there are some things—changing the remedies rules or adopting a fair use doctrine, for instance—that would require a new statute, many of the most important issues in design patent law right now are judicially-created rules that courts can fix. The statute doesn't define infringement—*Gorham* and then *Egyptian Goddess* do.[169] Courts have also developed the rules for anticipation, and the (partial) requirement that those rules mirror infringement. More generally, most doctrines in utility patent anticipation and obviousness are judicially created too,[170] so there is no reason the statute compels us to incorporate those doctrines.

As we explained above, many of these judicially-created rules actually depart from the utility patent rules, or at least apply the rules in a way very different than utility patent law does.[171] That isn't necessarily a bad thing to the extent those rules actually reflect the way design works. But too many of design patent law's rules are warped by the continued (partial) insistence on symmetry with utility patent law. Courts should not feel compelled to import every aspect of utility patent law into design patent law. Indeed,

166 *See* DAN L. BURK & MARK A. LEMLEY, THE PATENT CRISIS AND HOW THE COURTS CAN SOLVE IT 95, 97–106 (2009).

167 *See id.* at 1168–70.

168 *See id.* at 1746, 1774, 1776.

169 *See supra* Section I.B.

170 *See, e.g.*, Messerschmidt v. U.S., 29 Fed. Cl. 1, 21 (Fed. Cl. 1993) (explaining the "Every Element Test for anticipation" and collecting judicial sources).

171 *See supra* notes 167–169 and accompanying text.

they should recognize they already deviate from those rules in many contexts. When they deviate, however, courts should do so with sensitivity to how design actually works, not by creating bright-line rules that have nothing to do with the actual design process.[172] *LKQ* is a welcome step towards recognizing the realities of design, but it is only one step.

What we need is more forthright consideration of which rules are statutorily required and where courts can and should tailor application of those rules to the realities of design. Courts are not free to allow patents on designs that are not new. But the statute doesn't compel courts to evaluate anticipation from the perspective of an ordinary observer rather than a designer of ordinary skill. Indeed, that choice is a departure from utility patent law, which always evaluates validity from the perspective of a person of ordinary skill.[173] Nor does the statute compel courts to ignore rules like ornamentality and functionality. Quite the contrary.

We should embrace the fact that design is different, even when applying the same basic legal principles (like anticipation and obviousness). Courts should apply those doctrines with an understanding of how design works and how the nature of design patents looks quite different than utility patents. If they do, design patents may remain patents in name, but they won't be anything like utility patents in form or function.

C. Potentially Broader Changes

The previous sections suggest changes that need to be made even under the existing legal framework to align design patent law with the statute and with common sense. But understanding that design patents differ in so many ways from utility patents may also free us to consider more radical reforms. The current system is a mash-up—a partial, but only partial, incorporation of utility patent rules, and not one that reflects considered judgment of when and how utility patent rules are workable for design. We might get

172 *See* Burk & Lemley, *supra* note 72, at 1778–1783.

173 *See* KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

more clarity if we break design law free of patent law and developing distinct design rights, as many other countries and the EU have done.[174]

Sui generis design systems still must face the challenges that are endemic to legal protection for design. Those systems also need rules to determine when a design is sufficiently new to warrant rights, and they need rules for dealing with functionality. The Community Design Regulation, for example, conditions protection on novelty and individual character.[175] A design is considered new if no identical design was previously available to the public, though the CDR is not serious about "identity." Designs in Europe are considered identical if their features differ only in "immaterial details."[176] A design is "considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has [previously] been made available to the public."[177] Design rights are denied to any design that is "dictated solely by its technical function," and "features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against

174 *See* Council Regulation 6/2002, § 3, 2002 O.J. (L 3) 1, 24 (EC); The Designs Law, 5777-2017, SH 2662, 1176 (Isr.), https://www.gov.il/BlobFolder/legalinfo/designs-law/en/designs_Dsn-law-trans.pdf [https://perma.cc/Q6FJ-LHE4]. For a discussion of Europe's different approach, see J. H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6 (1989); Graeme B. Dinwoodie, *Federalized Functionalism: The Future of Design Protection in the European Union*, 24 AIPLA Q.J. 611 (1996).

175 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, Art. 4(1). There is also a newly-amended European Design Directive that imposes mandatory rules on national design rights. See European Parliament legislative resolution of 14 March 2024 on the proposal for a directive of the European Parliament and of the Council on the legal protection of designs (recast) (COM(2022)0667 – C9-0395/2022 – 2022/0392(COD)).

176 Id. at Art. 5.

177 Id. at Art. 6.

another product so that either product may perform its function."[178] Many of these rules replicate some of the problems we have seen in U.S. law.

What a sui generis system like the Community Design Regulation has going for it, however, is that it exists separately from any patent system, so interpretation of the Regulation is not hampered an impulse to create symmetry with other patent rules. That frees the CDR to evaluate individual character from the perspective of an "informed user," not any of the hypothetical people from whose perspective utility patent law operates.[179] The Community Design system also has two distinct forms of protection with different scopes and durations. Registered Community Designs receive 5 years of protection, and the term is renewable for successive 5-year terms up to 25 years.[180] Unregistered designs are protectable for 3 years from the date on which the designs are made public, but those rights are importantly limited as compared to the registered designs. In particular, unregistered designs are infringed only if the owner can prove copying.[181]

Even short of creation of an entirely separate design system, Congress could amend the Patent Act in ways that could still improve design patent law. One of us has suggested that the rule giving design patentees all the defendant's profits from the sale of the article of manufacture is unsupportable as a matter of policy.[182] We could expressly require proof of copying, as we do in copyright law, and as is

[178] Id. at Art. 8. A new repair clause will come into effect this year, which will exclude replacement parts for "a complex product from design protection where those parts are used to restore a product to its original appearance." See https://www.europarl.europa.eu/doceo/document/TA-9-2024-0164_EN.html. The newly-amended Design Directive has a similar repair clause. Those clauses would resolve the spare parts cases we discussed above, since protection would be excluded for all of the designs at issue in those cases.

[179] CDR, Art. 6(1).

[180] Id. at Art. 12.

[181] Id. at Art. 19.

[182] Lemley, *supra* note 16, at 235 ("Section 289 is an anomaly, a holdover from a time when we both granted defendant's profits as a general measure of patent damages and required proof of knowing infringement. We don't need it.").

true for unregistered community designs. We might also consider importing a fair use defense. Fair use isn't a part of the utility patent system,[183] but we have fair use or analogs in both copyright and trademark law,[184] and, as we have seen, the design patent infringement and anticipation tests are far closer to copyright than they are to utility patent. So, the law might benefit from having a user right to engage in certain transformative uses.

Some question whether we need a freestanding design right at all.[185] Both we and others have suggested that any design right should be mutually exclusive with other forms of IP protection.[186] Other countries, including Israel, have such an exclusive system.[187] We don't delve here into these broader systemic attacks, but freeing design patents from their designation as patents at least opens the conversation into what form of IP protection, if any, is needed.

CONCLUSION

> "I think when you first start doing design patents you think of it as 'basically the same as utility except . . . ' then after more experience it becomes 'totally different from utility but uses some of the same terms.'"[188]

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183 Some scholars have suggested that a patent fair use defense should exist. *See, e.g.*, Maureen A. O'Rourke, *Toward a Doctrine of Fair Use in Patent Law*, 100 COLUM. L. REV. 1177, 1187 (2000); Katherine J. Strandburg, *Patent Fair Use 2.0*, 1 U.C. IRVINE L. REV. 265, 299–300 (2011); *cf.* Deepa Varadarajan, *Trade Secret Fair Use*, 83 FORDHAM L. REV. 1401, 1420 (2014).

184 *See* O'Rourke, *supra* note 183, at 1180.

185 Burstein, *Patented Design*, *supra* note 17, at 229 ("This Article has presented a number of reasons why we should not protect designs *per se* and, instead, should conceptualize the protected thing as the design as applied to a particular type of product."); *cf.* McKenna & Strandburg, *supra* note 21, at 4 (arguing unless the nonobviousness inquiry for design patents can be grounded "on the integration of form and function," the design patent system likely should not exist).

186 *See* Buccafusco et al., *supra* note 6, at 129–32; McKenna, *supra* note 85.

187 *See supra* note 174, at 5.

188 Patent Memes (@PatentMemes), TWITTER (Nov. 13, 2022, 10:58 PM),

Design patents aren't utility patents. And it's a good thing too. The structure and purpose of the laws differ fundamentally. Design patent doctrine has diverged over time from utility patent law, but it also remains tied to that law in odd ways. It's time to cut those ties and protect designs, if at all, with a law written with design in mind. At a minimum, courts need to recognize they are protecting something very different than invention and to apply existing rules with sensitivity to that fact.

https://twitter.com/PatentMemes/status/1592049298941829121?s=20&t=5vcBzzA80hkgCpQFi745Nw [https://perma.cc/B2J2-DJVZ].