

ALL OR NOTHING AT ALL: DESIGN PATENT'S ORNAMENTALITY REQUIREMENT AND THE FAILINGS OF FEATURE FILTRATION

Christopher V. Carani[†]

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† Christopher V. Carani is a partner and shareholder at the Chicago-based IP law firm of McAndrews, Held & Malloy, Ltd., practicing in all areas of IP with particular emphasis on design law, which focuses on the protection of the appearance of products using a strategic combination of design patents, utility patents, trade dress, and copyrights. Chris has extensive experience litigating design law cases, including high profile matters before U.S. district courts, the Federal Circuit, the International Trade Commission, and U.S. Supreme Court. Chris is on the faculty at Northwestern University School of Law teaching IP Fundamentals. Prior to joining McAndrews in 1995, Chris served as a law clerk to the Honorable Rebecca R. Pallmeyer at the U.S. District Court for the Northern District of Illinois. Chris earned his B.S. in Engineering from Marquette University and J.D. from University of Chicago. He is licensed to practice before the United States Patent and Trademark Office.

I. INTRODUCTION

“Functionality” is a general prohibition grossly applied across the field of design intellectual property (“Design IP”), which encompasses design patents, trade dress, and copyrights. Generally speaking, the functionality bar is viewed as a way to prevent Design IP from being used to secure a right to exclude others from functional ideas or concepts, which is strictly the province of utility patents. In design patent jurisprudence that prohibition is tied to the requirement of ornamentality; in copyright law, it is tied to the merger doctrine; and in trade dress law, it is tied to the non-functionality requirement. While the term “functionality” is often used loosely in each of the three Design IP regimes, the policies and underpinnings for the respective doctrines and requirements are quite different, and it is a mistake to assume that the functionality doctrines of each regime are interchangeable between the different branches of Design IP. Indeed, the rights afforded by each regime are different, carrying different terms, qualifications, and processes for protection, tests for infringement, and available remedies.

In design patent jurisprudence, the notion of functionality has arisen in two distinct contexts—one proper and one not. The proper context is as a matter of statutory compliance with 35 U.S.C. § 171, the provision in the Patent Act setting forth the eligible subject matter for design patents. As will be discussed herein, § 171 does not use the term “non-functional,” but instead only requires that the design be “ornamental.”¹ The statute asks whether the overall appearance of the claimed design as a whole is “ornamental” and also whether the overall appearance of the claimed design is “novel” and “original.”² Importantly, the statute is directed at the “design” as a whole, not at individual portions thereof. The statutory requirement of ornamentality aligns with the policy goal of promoting the decorative arts, but also safeguards against design patent protection being used to monopolize functional ideas.

The second context regards ill-advised attempts to exclude individual visual features (i.e., portions, aspects, elements, parts, etc.) of an overall claimed design. Attempts to neatly divvy up designs into ornamental and functional bits is reminiscent of misguided and prohibited attempts to divide designs into novel and non-novel bits, and even significant and insignificant bits. But designs cannot, and should not, be dissected into individual portions like this. A design is an amalgam—the net visual result of all of its visual parts. Filtering out visual elements leads to unwanted and unintended consequences such as broadening the design patent claim beyond that which the patentee

1. *See infra* Part II.

2. *See id.*

created and that which the U.S. Patent and Trademark Office (USPTO) examined and granted. All visual portions of a claimed design, even those with appearances that are functionally driven, have a visual relationship with the other constituent parts and ultimately contribute to the visual whole of the claimed design. Notably 35 U.S.C. § 171 (and TRIPS Article 25(1)) are not directed at screening functionality at the individual feature level;³ rather the inquiry is rightfully, and solely, focused on the “design” as a whole. Further, there is no principled policy reason to gut out individual visual portions from the overall claimed design. There are no independent rights afforded to individual visual portions of an overall claimed design; and for this reason, it is impossible for the appearance of an individual portion, even if purely driven by functional consideration, to monopolize a functional idea. But the concern over the inclusion of individual features having appearances that are driven partially, or even wholly, by functional consideration is often the cited reasoning for engaging in the wrongful filtration practice. It cannot be overemphasized that the “right to exclude” afforded by a design patent claim extends, and only extends, to the design *as a whole*, as claimed; the design patent claim does not provide any independent protection for individual visual features thereof. Accordingly, no individual visual features of the overall claim should be filtered out. A design patent claim rises and falls on its overall appearance. All or nothing at all.

Attempts to filter out functional features are not without a history in Federal Circuit case law.⁴ After bottoming out in 2010 with its filtration-heavy opinion in *Richardson v. Stanley Works, Inc.*,⁵ the Federal Circuit has bounced back with three forcefully written opinions rejecting feature filtration: *Apple, Inc. v. Samsung Electronics Co.*,⁶ *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*,⁷ and *Sport Dimension, Inc. v. Coleman Co.*⁸ *Apple*, *Ethicon* and *Sports Dimension* have all made

3. *See id.*

4. *See generally* Jason J. Du Mont & Mark D. Janis, *Functionality in Design Protection Systems*, 19 J. INTEL. PROP. L. 261 (2012); Frederick L. Medlin, *Functionality of Individual Features in Design Patents: A New Role After Egyptian Goddess*, 77 PAT. TRADEMARK & COPYRIGHT J. 139 (2008); Perry J. Saidman, *Functionality and Design Patent Validity and Infringement*, 91 J. PAT. & TRADEMARK OFF. SOC'Y 313 (2009); Perry J. Saidman & John M. Hintz, *The Doctrine of Functionality in Design Patent Cases*, 19 U. BALT. L. REV. 352 (1989); Robert G. Oake, Jr., *Design Patent Perspective: Understanding Functionality in Design Patent Law Part I*, INTEL. PROP. TODAY (Oct. 2011); *see DePaoli v. Daisy Mfg. Co.*, No. 07-cv-11778-DPW, 2009 U.S. Dist. LEXIS 62057, at *8–9 (D. Mass. July 14, 2009).

5. 597 F.3d 1288 (Fed. Cir. 2010).

6. 786 F.3d 983 (Fed. Cir. 2015), *cert. granted in part*, 136 S. Ct. 1453 (2016), *rev'd and remanded*, 137 S. Ct. 429 (2016).

7. 796 F.3d 1312 (Fed. Cir. 2015).

8. 820 F.3d 1316 (Fed. Cir. 2016).

clear that claimed visual features will not be excluded from a design's scope of protection, even if a feature has an appearance that is driven solely by function.⁹ Despite the Federal Circuit's recent seemingly clear jurisprudence, the urge to filter continues to percolate, including in district courts¹⁰ and

9. Although the Federal Circuit has made progress in clarifying the proper approach to determining the scope of protection, there is still more work to be done. *See* Jason J. Du Mont & Mark D. Janis, *Functionality in U.S. Design Patent & Community Design Law*, in RESEARCH HANDBOOK ON DESIGN LAW (forthcoming) (manuscript at 27), <https://ssrn.com/abstract=2773070> (“While *Ethicon* and *Sport Dimension* seem likely to become the foundation for a new line of analysis on scope functionality, the Federal Circuit still has much work to do in refining both its validity and scope functionality tests[.]”).

10. Despite this clear guidance from the Federal Circuit in the *Apple*, *Ethicon*, and *Sports Dimension* decisions, district courts continue to analyze “functionality” inconsistently. Many district courts properly continue to decline to “factor out” functional aspects of a design. *See, e.g.*, *SZ DJI Tech. Co. v. Autel Robotics USA LLC*, No. CV 16-706-LPS, 2019 WL 6840357, at *3 (D. Del. Dec. 16, 2019) (“The D’514 Patent does not attempt to claim functional elements; rather it claims a design that happens to have function. The design is not governed solely by function, as the design is not the only possible form of the article that could perform its function.”); *Graphic Packaging Int’l, LLC v. Inline Packaging, LLC*, No. 15CV03476ECTLIB, 2019 WL 4786148, at *5 (D. Minn. Oct. 1, 2019); *Lanard Toys Ltd. v. Toys “R” Us-Delaware, Inc.*, No. 3:15-CV-849-J-34PDB, 2019 WL 1304290, at *12 (M.D. Fla. Mar. 21, 2019); *Daimler AG v. A-Z Wheels LLC*, 334 F. Supp. 3d 1087, 1102 (S.D. Cal. 2018); *Hafco Foundry & Mach. Co., Inc. v. GMS Mine Repair & Maint., Inc.*, No. CV 1:15-16143, 2018 WL 2970754, at *2–3 (S.D.W. Va. June 13, 2018) (“[A] design may embody functional features and still be patentable. . . . Based on the foregoing, GMS did not meet its burden to show by clear and convincing evidence that the ’684 patent is dictated by functional considerations.”), *aff’d on other grounds and remanded*, 953 F.3d 745 (Fed. Cir. 2020); *Magnolia & Vine Inc. v. Tapestry, Inc.*, No. 17-CV-4382 (JNE/DTS), 2018 WL 2208316, at *3 (D. Minn. May 14, 2018) (“Nothing in Magnolia and Vine’s amended complaint indicates that the stringent standard for invalidating a design patent due to functionality is satisfied with regard to the asserted design patents.”); *HFA, Inc. v. Trinidad/Benham Corp.*, No. 6:17-CV-00343-RWS, 2018 WL 1210880, at *4 (E.D. Tex. Mar. 7, 2018) (“While the nested pans serve a functional purpose, that does not deem them excluded from the claim, particularly whereas here they are also ornamental in nature.”); *Auto. Body Parts Ass’n v. Ford Glob. Techs., LLC*, 293 F. Supp. 3d 690, 704 (E.D. Mich. 2018), *aff’d*, 930 F.3d 1314 (Fed. Cir. 2019), *cert. denied*, No. 19-1002, 2020 WL 1124449 (U.S. Mar. 9, 2020); *Crocs, Inc. v. Effervescent, Inc.*, No. 06-CV-00605-PAB-KMT, 2017 WL 2787589, at *14 (D. Colo. June 27, 2017) (“The Court finds that Dawgs’ proposed construction, which seeks to exclude ‘the existence of a heel strap and the connectors that attach the heel strap to the upper,’ would improperly eliminate features that contribute to the ornamental design of the ’789 Patent.” (internal citation omitted)); *Fecon, Inc. v. King Kong Tools, LLC*, No. 1:16-CV-1137, 2017 WL 4869000, at *5 n.5 (S.D. Ohio June 27, 2017); *Skechers U.S.A., Inc. v. Eliya, Inc.*, No. CV1602820SJOAGR, 2017 WL 3449594, at *6 (C.D. Cal. Mar. 14, 2017); *Equalia, LLC v. Kushgo LLC*, No. 216CV02851RFBCWH, 2017 WL 114084, at *7 (D. Nev. Jan. 11, 2017) (“As a preliminary matter, the Court notes that however the function is defined . . . the Court finds that the overall design of the board is not dictated by its function.”). However, a troubling number of district courts are still tempted to engage in the legal error of entirely factoring out functional elements. *See, e.g.*, *Covves, LLC v. Dillard’s, Inc.*, No. 218CV08518RGKAFM, 2019 WL 8227455, at *6

scholarship.¹¹ In this Article, I set out to: (1) generate a better awareness of the proper and limited role of functionality in design patent jurisprudence, namely, statutory compliance with § 171; and (2) explain the wrongheadedness of filtering out individual visual features of a design patent claim, whether on grounds of functionality, novelty, or otherwise.

II. THE REQUIREMENTS OF 35 U.S.C. § 171 PERTAIN TO THE CLAIMED DESIGN AS A WHOLE, NOT INDIVIDUAL FEATURES THEREOF

The functionality inquiry for design patents is limited to, and derived from, the need for statutory compliance with the governing statute for design patents, which reads:

§ 171: 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.¹²

To begin, it is worth noting that the statute does not impose a “non-functionality” requirement. Instead, the statute sets forth a positive requirement that the design be “ornamental.” By phrasing it this way, the statute does not require that the design for an article of manufacture be devoid of functionality or any functional aspects. Like “usefulness” for utility patents in 35 U.S.C. § 101, the “ornamental” requirement in § 171 is a minimal

(C.D. Cal. Dec. 20, 2019) (“[T]he Court finds that the innermost ring of the D’370 patent is a functional rather than ornamental feature. The Court therefore construes the D’370 patent’s claim as the ornamental design for an inflatable beverage holder, as shown in figures 1 through 6 of the D’370 patent, excluding the inner ring shape.”); *Static Media LLC v. Leader Assocs. LLC*, 395 F. Supp. 3d 982, 995 (W.D. Wis. 2019); *Kao v. Snow Monster Inc.*, No. CV1708934RSWLJJSX, 2019 WL 2164192, at *3 (C.D. Cal. May 16, 2019) (“[A] design patent infringement analysis should be construed to only the ornamentation of the product and not to the functional features.”); *Artskills, Inc. v. Royal Consumer Prod., LLC*, No. 3:17-CV-1552 (VAB), 2019 WL 1930751, at *17 (D. Conn. May 1, 2019); *Dyson, Inc. v. SharkNinja Operating LLC*, No. 14-CV-779, 2018 WL 1906105, at *6 (N.D. Ill. Mar. 29, 2018), *appeal dismissed*, No. 18-1915, 2018 WL 5733514 (Fed. Cir. Aug. 1, 2018); *Boiling Point Grp., Inc. v. Fong Ware Co.*, No. 216CV01672RGKJEM, 2017 WL 2930838, at *3 (C.D. Cal. Apr. 27, 2017) (“[T]he Court construes the claim . . . ‘excluding the functional aspects of the frustoconical bowl and of the prongs around the rim thereof to hold the hot pot in place, and of openings to allow air flow.’”); *Snap-on Inc. v. Harbor Freight Tools USA, Inc.*, No. 16-C-1265, 2017 WL 44833, at *3 (E.D. Wis. Jan. 4, 2017) (“I will use claim construction to ‘factor out the functional aspects’ of the design.” (quoting *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010))).

11. See, e.g., Peter S. Menell & Ella Corren, *Design Patent Law’s Identity Crisis*, 36 BERKELEY TECH. L.J. 1 (2021); Christopher Buccafusco, Mark A. Lemley & Jonathan S. Masur, *Intelligent Design*, 68 DUKE L.J. 75 (2018); Sarah Burstein, *Intelligent Design & Egyptian Goddess: A Response to Professors Buccafusco, Lemley & Masur*, 68 DUKE L.J. ONLINE 94 (2019).

12. 35 U.S.C. § 171 (emphasis added).

gatekeeper requirement to ensure that the policy goals of each of these two branches of patent law are met, respectively.

Feature filtration finds no support in the plain language of § 171. The statute only requires that the “design” be “new, original and ornamental.”¹³ The statute does not require that *individual features* of a design meet those requirements. This makes sense as the right afforded by a design patent is limited to the overall appearance of the claimed design, not individual portions thereof. This holistic approach is consistent with other tests in design patent jurisprudence, including those for infringement,¹⁴ novelty, non-obviousness, indefiniteness, and written description; the *overall appearance*¹⁵ of the claimed design is all that matters.¹⁶

13. Notably, the sole inquiry of § 171, which is directed at the design, and not features of the design, is consistent with the design functionality provision of TRIPS. Article 25(1) of TRIPS states the following: “Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.” Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, art. 25(1), 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) (as amended on Jan. 23, 2017).

14. *See, e.g.,* *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (“[T]his court will uphold a finding of infringement. In other words, the deception that arises is a result of the similarities in the overall design, not of similarities in ornamental features in isolation. The ordinary observer test applies to the patented design in its entirety, as it is claimed.” (citing *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992)) (internal quotation marks omitted)). Contrast this holistic approach with copyright law where, for example, there can be infringement when only one chapter of a twenty-chapter book is copied.

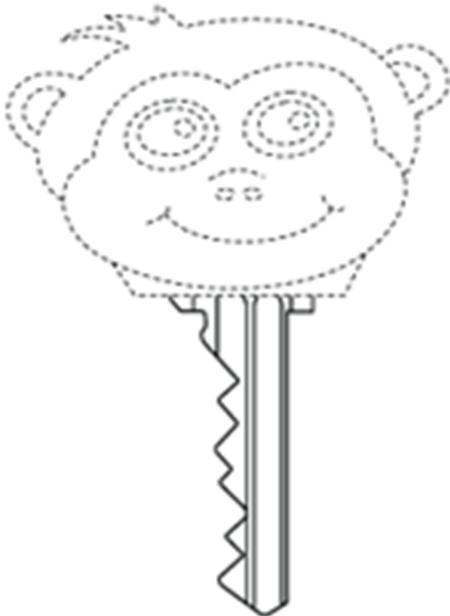
15. Note that when I refer to the design’s overall appearance, I am referring to the overall appearance of the claimed design, not the overall appearance of the entire product. Further, when I am referring to a design’s features or elements, I am referring to visual features and elements, not abstract underlying qualities of the article of manufacture to which the design is applied.

16. *See, e.g.,* *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (“However, the utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.”).

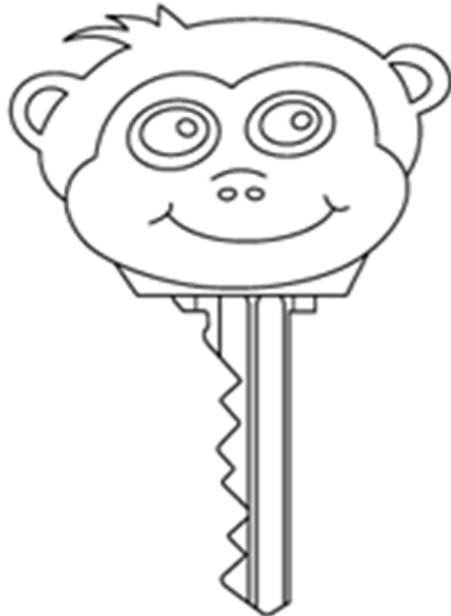
III. A DESIGN PATENT CLAIM PROVIDES NO INDEPENDENT PROTECTION FOR INDIVIDUAL VISUAL FEATURES THEREOF, EVEN IF PURELY FUNCTIONAL, PRESENTS NO LEGITIMATE MONOPOLY CONCERN

The justification for feature filtration is often premised on a misguided fear that, unless the feature is filtered out, the design patentee will be granted the right to exclude others from using that individual feature. In other words, the design patentee will possess a monopoly over the individual functional feature. If this were possible, the concern posited by proponents of feature filtration would be accurate. But design patents do not provide independent protection for individual portions of the claimed design. The right to exclude provided by a design patent only regards the overall appearance of the claimed design. As a result, there can be no legitimate monopoly concerns at the individual feature level. Of course, if the claim is directed at only a portion of the article of manufacture with an appearance dictated by function, then the claim as a whole is invalid for lacking ornamentality. But when the claimed design includes portions that are not driven solely by function, monopoly concerns are eliminated. A simple hypothetical illustrates this point.

Figure 1: Monkey Key Example



Example 1.1



Example 1.2

In Example 1.1 of Figure 1, the key head is disclaimed and only the key blade is claimed. In Example 1.2 of Figure 1, the entire key is claimed including its key head and key blade. The claimed design of Example 1.1 would not be deemed ornamental while the claimed design of Example 1.2 would be. The claimed design of Example 1.1, which is directed at just the key blade, runs the risk of monopolizing the functional mating relationship between the key blade shape and its corresponding keyhole. Example 1.2, on the other hand, presents no monopoly concern over that functional relationship; the design patent of Example 1.2 claims the appearance of the key blade *with* the key head. The protection for the key blade of Example 1.2 is always tethered to, and limited by, the key blade's relationship with the claimed key head.

The plain language of § 171 rightly regards only the design as a whole; it does not provide support for feature filtration.

IV. FEATURE FILTRATION IS COUNTER TO THE BEDROCK PRINCIPLE THAT DESIGN PATENTS PROTECT THE OVERALL APPEARANCE OF A CLAIMED DESIGN

A fallacy of the feature filtration approach is that visual features reside in isolation and thus can be surgically excised from the claimed design. To the contrary, the visual appearance of every feature, even those with appearances that are driven partly or exclusively by function, visually impacts and interacts with the remainder of the design. The “controlling consideration” of a design patent claim is the overall appearance, including the relative and spatial relationships of each and every solid line in the claim. A design patent protects the overall effect of all of the depicted design elements, whether such elements are new or old, functional or ornamental, significant or insignificant.¹⁷ Because it is the overall appearance that is protected, the traits and substance of any individual elements are irrelevant. As an overarching theme, design patent discourse should move away from element-by-element utility patent speak and refocus on the actual protected right—the overall appearance of the claimed design. As the U.S. Court of Customs and Patent Appeals succinctly stated:

17. See *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1246 (Fed. Cir. 2009) (Clevenger, J., dissenting) (criticizing the majority for its “dissection of designs into component parts,” namely “significant” and “insignificant” elements, and noting that such dissections “prohibit assessment of designs as a whole, in violation of long-standing law, starting with *Gorham*”).

“A design is a *unitary thing* and *all of its portions are material* in that they contribute to the appearance which constitutes the design.”¹⁸

That a particular portion of an overall claimed design has an appearance that is driven by function, even if exclusively driven by function, should not matter. Protection extends to the entire overall appearance (including all contributing elements), so long as the *overall appearance* is not purely functional (i.e., “ornamental”). Indeed, the combination of two functional elements, even two purely functional elements, can yield an ornamental design; ornamentality can reside in the spatial relationships of the elements, the relative sizes of the elements, etc. Whether speaking of infringement or validity, what counts in design patent law is the *overall appearance* of the claimed design. The feature filtration approach, by removing certain visual elements of the whole, runs afoul of this principle.

Feature filtration does not only affect the infringement analysis. As we know from the more developed utility patent case law, it is axiomatic that the same claim construction that is used for infringement also must be used for validity.¹⁹ You cannot exclude aspects of a claimed design when conducting an infringement analysis and then in the next breath include the features when assessing validity. In any event, feature filtration should not be used in either context.

While visual features should not be filtered out, it is proper to instruct the factfinder that design protection is directed to the overall appearance of the claimed design and further that such protection does not extend to any abstract, functional attributes, concepts, or characteristics embodied in the article of manufacture to which the claimed design is applied. When employed incorrectly, instead of excepting non-visual functional attributes, concepts, or characteristics from protection, courts often use claim construction to coarsely lop off *visual* features, elements, and portions from the claimed design that are considered “functional.”²⁰ The correct approach maintains the sanctity of the

18. *In re Blum*, 374 F.2d 904, 907 (C.C.P.A. 1967) (emphasis added); *see also* *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (holding that all solid lines shown in design patent drawings form part of the claimed design).

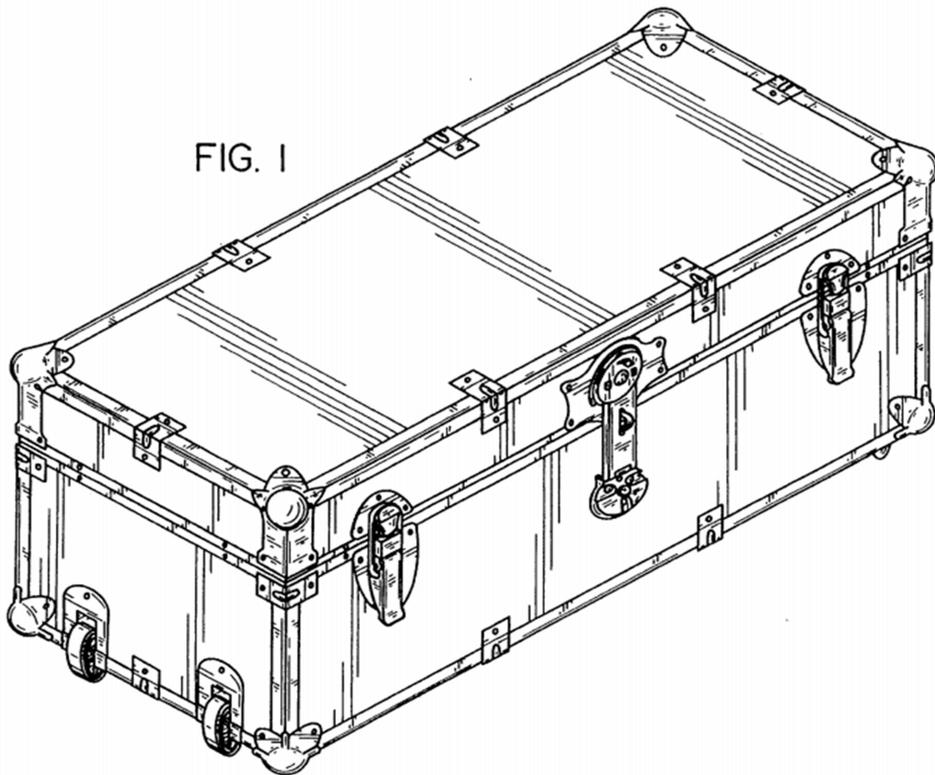
19. *See, e.g.*, *Source Search Techs., LLC v. LendingTree, LLC*, 588 F.3d 1063, 1075 (Fed. Cir. 2009) (“As this court has repeatedly instructed in the past, ‘[i]t is axiomatic that claims are construed the same way for both invalidity and infringement.’ ” (quoting *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003))).

20. *See, e.g.*, *Great Neck Saw Mfg. v. Star Asia U.S.A. LLC*, 727 F. Supp. 2d 1038 (W.D. Wash. July 23, 2010) (“Given its functional nature . . . th[is] blade lock means is not entitled to design protection”); *see also* *Boiling Point Grp., Inc. v. Fong Ware Co.*, 2017 U.S. Dist. LEXIS 171234 (C.D. Cal. Apr. 27, 2017) (excluding from its design patent claim construction the shape of the frustoconical bowl and prongs for a hot pot holder).

claimed design; the incorrect approach corrupts it. No attempt should be made to factor out visual features, elements, and portions of a claimed ornamental whole.

By way of example, take the trunk shown below in Figure 2 that includes a lock to secure the trunk's lid.²¹ As a matter of claim construction, the fact that the trunk is lockable (i.e., a functional attribute) should be wholly irrelevant to the design patent claim's scope of protection.

Figure 2: Trunk Example



But while this functional attribute of the trunk should be of no moment, the lock's depicted shape, size, and spatial relationship as it relates to the remainder of the trunk is claimed and thus part of the design's scope of protection. This should be true even if the lock's visual appearance were purely functional (which it is clearly not) because the depicted lock is but a portion of

21. U.S. Patent No. D351,502, fig. 1 (filed May 4, 1993).

an ornamental claimed whole.²² Regardless of whether the lock is functional or even purely functional, no attempt should be made to dissect out the appearance of the lock. Notably, with respect to utility patent claims, no effort is undertaken to identify and dissect out ornamental elements.²³ The same should be true with respect to design patents and functional elements—no effort should be made to identify and dissect out any functional elements. In both contexts, the patent protects the overall claim as issued, not the claim’s constituent elements in isolation.²⁴

Design patent claim construction methodology that purports to separate functional and ornamental elements of the overall claimed design is wrongheaded. Like the now defunct point of novelty approach (which sought to separate out new and old elements),²⁵ the feature filtration approach (which seeks to separate out ornamental and functional elements) conflicts with the

22. *See* *Good Sportsman Mktg. LLC v. Li & Fung Ltd.*, No. 6:07-cv-395, 2010 U.S. Dist. LEXIS 65458 at *10 (E.D. Tex. June 29, 2010) (“The utility of individual elements is irrelevant to the question of functionality, as it is the design in its entirety that provides the basis for the patent.”).

23. Consider a utility patent claim directed at a resealable container where, among other things, the base is claimed to be cylindrical and the lid frustoconical. While the combination of the claimed shapes of the base and lid yield an ornamental appearance, no attempt is made in the utility patent context to factor out these constituent elements, regardless as to whether they are ornamental or purely ornamental. The same should hold true for design patent claim construction as it related to functional or purely functional elements.

24. For examples where the courts fell into the feature filtration trap, see, for example, *Poly-America, L.P. v. API Indus., Inc.*, No. 13-693-SLR, 2014 U.S. Dist. LEXIS 49618, at *3 (D. Del. Apr. 10, 2014) (“[W]here a design contains both ornamental and functional features, it is proper to separate the functional and ornamental aspects because the scope of the design claim must be construed in order to identify the non-functional aspects of the design as shown in the patent. . . . [T]o the extent the . . . features identified above are considered functional, they should not be considered design elements that would be observed by the ordinary observer.” (internal quotation marks omitted)); *Keurig, Inc. v. JBR, Inc.*, No. 11-11941-FDS, 2013 U.S. Dist. LEXIS 73845, at *22 (D. Mass. May 24, 2013) (dissecting out a “functional aspect of the patented design” and concluding that it “cannot be considered in the [infringement] comparison”); *Safco Prods. Co. v. Welcom Prods., Inc.*, 799 F. Supp. 2d 967, 977 (D. Minn. 2011) (articulating list of ornamental features); *Mag Instrument, Inc. v. JS Prods., Inc.*, 595 F. Supp. 2d 1102, 1108 (C.D. Cal. 2008) (“Assuming, for the sake of argument, that Plaintiff’s [patents] contain both functional and non-functional elements, the Court, in the usual course of issuing a claim construction order, will construe the challenged claims to identify the non-functional aspects of the design as shown in the patent.” (internal quotation marks omitted)); *Hsin Ten Enter. USA, Inc. v. Clark Enters.*, 149 F. Supp. 2d 60, 64–66 (S.D.N.Y. 2001) (making a “determination of whether each element of the . . . patent is functional or non-functional”); *Butler v. Balkamp, Inc.*, 2014 U.S. Dist. LEXIS 122464, at *4–5 (S.D. Ind. Sept. 3, 2014) (“[T]he ’646 patent does not protect either the front or rear square drives of the tool handle because those aspects of the design are purely functional.”)

25. *See* *Egyptian Goddess v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (abrogating the point of novelty test).

tenet that a design patent protects the overall appearance of the claimed design and is fraught with logistical problems. Instead, claim construction functionality concerns could be addressed with an instruction to the fact-finder (whether judge or jury) that design patents only protect the appearance of the overall design depicted in the drawings and not any functional attributes, purposes, or characteristics embodied in the claimed design.

V. FEATURE FILTRATION LEADS TO AN UNWANTED BROADENING OF THE DESIGN PATENT CLAIM THEREBY UNDERMINING THE STATUTORY PRESUMPTION OF VALIDITY AND PUBLIC NOTICE FUNCTION OF PATENT CLAIMS

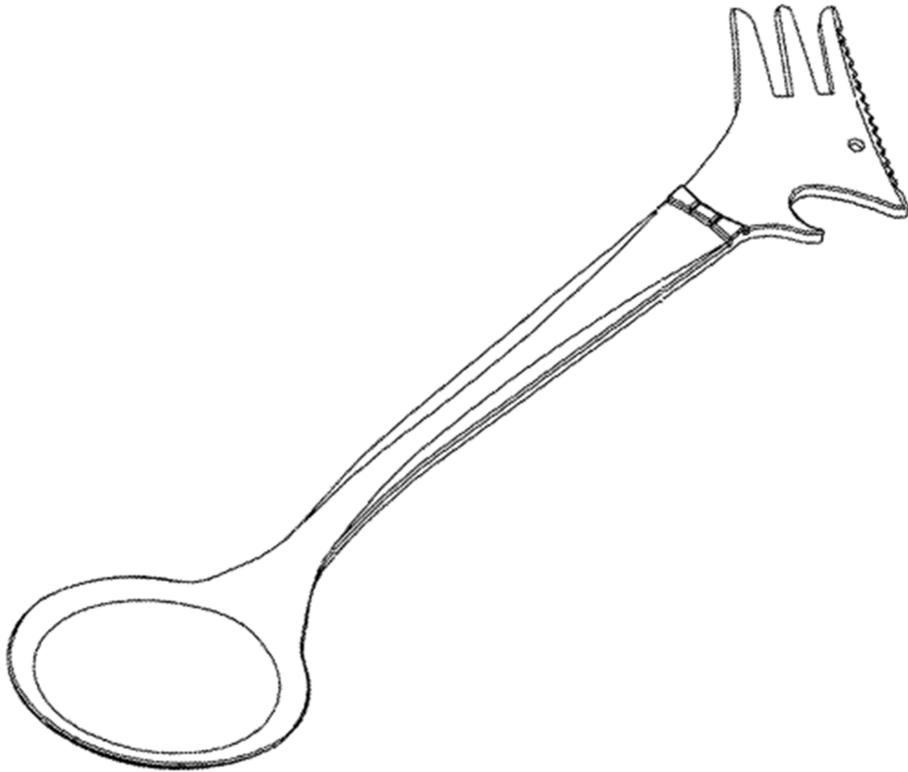
Feature filtration undermines the validity of design patents and also hinders the requisite public notice function of patent claims. Once a design patent application emerges from USPTO examination, an issued design patent enjoys a presumption of validity, just like any other patent.²⁶ The USPTO requires that patent claims be disclosed and described with a high level of certainty so that the public can understand the metes and bounds of the claims with reasonably certainty. Feature filtration undermines that important public notice function by fundamentally changing the scope of the claimed design after issuance, meaning the public can no longer rely on the claim as made by the designer and approved by the USPTO.

As an initial matter, at the USPTO, the patentability determination for a claimed design is premised solely on the *overall appearance* of the depicted design.²⁷ Yet, the presumption of validity and its underpinnings easily fall apart under the feature filtration approach because a judicially construed claim (with portions of the whole “factored out”) can be *fundamentally* different from the claim examined and issued by the USPTO. This conflict can be illustrated with a simple example.

26. See 35 U.S.C. § 282.

27. See U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 1503.02 (9th ed. June 2020) (“When the inconsistencies are of such magnitude that the *overall appearance* of the design is unclear, the claim should be rejected under 35 U.S.C. 112(a) and (b)” (emphasis added)); *id.* § 1504.01(c) (“[O]rnamamentality must be based on the *entire design*” (emphasis added)); *id.* § 1504.03 (“In determining patentability under 35 U.S.C. 103, it is the *overall appearance* of the design that must be considered.” (emphasis added)).

Figure 3: Spork Example



As shown in Figure 3 (above), a designer created and secured a design patent on the overall appearance of the eating utensil as shown above.²⁸ Like most industrial design, the net visual appearance is driven by both aesthetic and utilitarian considerations. Some elements are driven mainly by function, others by aesthetics, and still others by a bit of both. While the utensil, an article of manufacture, combines various functionalities, including a spoon, a fork, a knife, and a can opener, care was given to creating the overall visual appearance of the item—the *tout ensemble*.

During prosecution, the USPTO examined the overall appearance of the design for compliance with § 171, including the ornamentality requirement. An ornamentality challenge under § 171 would most likely (and rightfully) fail as the overall appearance of the design cannot be said to be dictated by function alone; it is not hard to imagine other appearances for a utensil with the same or similar functionality. During claim construction under the feature filtration approach,

28. See U.S. Patent No. D876,907, fig. 1 (filed Nov. 13, 2018).

however, several visual elements of the overall claim would be excised as being functional, including at least (1) the bowl of the spoon, (2) the tines of the fork, (3) the serrated edge of the knife, and (4) the can opener mouth. Filtration would leave behind a generic claim for only the handle, detached and isolated from the remainder of the utensil. Feature filtration leads to an unwanted, post hoc, *broadening* of the design patent claim.

Further, not only is this “filtered” claim scope not what the designer originally designed, it is not what the USPTO examined and granted. Is just the remaining handle itself novel? Nonobvious? Ornamental? It no longer makes sense to offer the presumption of validity once the claim is construed in a manner that renders it as having so little resemblance to the claim that was before the USPTO. This potential disparity in claim scope irreconcilably undermines the presumption of validity and its underpinnings. For this reason alone, the feature filtration approach should not be adopted.

It is true that filtration has been used in the context of copyright infringement claims, albeit with limited success and great confusion. But this does not provide reason for importing this practice into design patent law because there are fundamental differences between design patents and copyrights counseling against such practice. First, unlike copyright registrations, design patents are substantively examined and approved. There is a formal claim presented by the applicant that is reviewed by the USPTO for statutory compliance and, if allowed, published by way of a letters patent to provide public notice. This is not the case for copyright registrations. Second, design patents are intended to protect articles of manufacture, which will necessarily possess some utilitarian purpose. This is not the case for copyright law, which has steadfastly refused to protect applied art, and further industrial design. Third, the term of copyright is much longer than that of design, and thus as a matter of policy, copyright law is less willing to protect functionally driven expression.

VI. FEATURE FILTRATION PROVIDES FOR UNWANTED PIECEMEAL INVALIDITY ATTACKS

Taken to its logical conclusion, the feature filtration approach could yield a result where, upon claim construction, each and every individual element of the design patent is found to be “functional.” For instance, and continuing with the spork example above, what if the court concludes that the handle is functional as well? Under these facts, the claim is whittled away to nothing, effectively neutering the enforceability of an issued design patent without an invalidity challenge ever having been mounted.

Of course, invalidity challenges are confronted with the demanding safeguards that cloak a presumptively valid design patent, including most importantly the “clear and convincing” evidence standard.²⁹ The feature filtration approach to functionality provides an unwanted backdoor validity attack made under the guise of claim construction where the lesser preponderance evidentiary standard applies.³⁰

VII. FEATURE FILTRATION IS UNWORKABLE

Moreover, any attempt to dissect and separate an overall design into elements is unworkable. Most often, and particularly with modern day design, the elements of a design are fully integrated into, and inseparable from, the overall design, making fool’s errands of the feature filtration approach’s identification and excision steps.³¹ For example, consider a claim covering the ornamental handlebar depicted in Figure 4 below.³² The claimed design is an example of the seamless melding of form and function. While a court might go through the feature filtration exercise, the reality is that it is impossible to meaningfully identify and surgically separate ornamental and functional elements.³³ In short, factoring out and ignoring functional portions is an

29. *See, e.g.*, *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (requiring clear and convincing evidence to invalidate design patent on grounds of functionality and further noting that 35 U.S.C. § 282 includes a presumption of ornamentality).

30. This extreme example of feature filtration is not a mere hypothetical. District courts operating under the false belief that individual visual features having functionally driven appearances must be removed have gone so far as to filter every aspect of the claimed design. Notably, those courts did not invalidate the overall claim for lack of ornamentality under § 171. *See Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, No. 1:11-CV-871, 2014 WL 10212172, at *9 (S.D. Ohio Jan. 22, 2014) (“[T]he shape and placement of the U-Shaped Trigger, Torque Knob, and Rounded Button elements of the Design Patents are all based on functional considerations and therefore all of these elements must be ‘factored out’ of the claimed design.”).

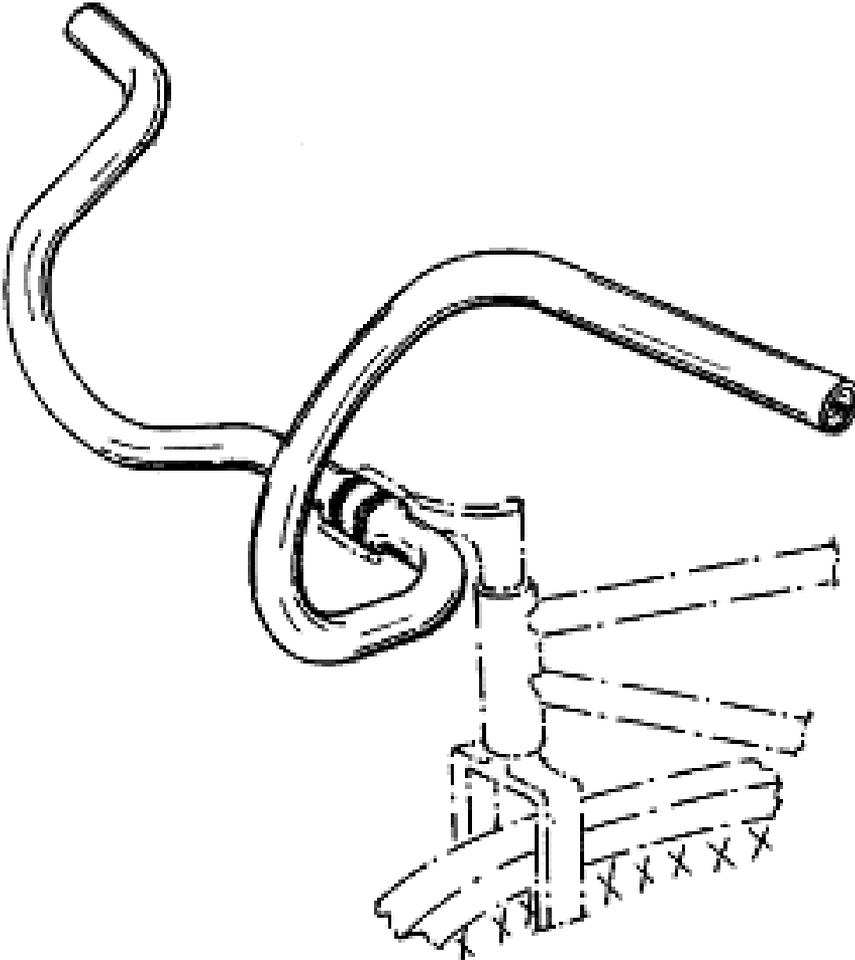
31. Copyright law has struggled for years with how to implement the separability doctrine, spawning a multitude of tests, one more confusing than the next. While the Supreme Court in *Star Athletica v. Varsity* sought to clean up the mess, truly it just served as a reset. Justice Thomas, ever the textualist, set forth a separability test that merely rephrases the statute. The most significant aspect of the opinion was that it wiped the slate clean from the many confusing and contradictory tests that had bounced around the regional circuits for decades. The sheer mess created by the copyright experience with feature filtration is reason alone to refrain from importing it into design law. *See Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1009 (2017).

32. U.S. Patent No. D387,316, fig. 1 (filed May 29, 1996).

33. *See Carlini Enters. v. Paul Yaffe Design, Inc.*, 2014 U.S. Dist. LEXIS 113941 at *5–6 (C.D. Cal. Aug. 12, 2016) (noting logistical difficulties in trying to separate out ornamental and functional elements in an overall design).

artificial enterprise that not only can distort the claimed design but also, practically speaking, is an unworkable approach.

Figure 4: Handlebar Example



VIII. CONCLUSION

Consistent with the Federal Circuit's recent opinions in *Apple*, *Ethicon*, and *Sport Dimensions*, and despite the calls from academia, courts should continue to resist the urge to attempt to identify and filter out any individual features, elements, or portions of the whole ornamental design. Per the plain language of design patent law's governing statute 35 U.S.C. § 171, it is the "design," not

individual features thereof, that are the only relevant consideration. Any attempts at feature filtration are unnecessary, fatally flawed, and should be prohibited.

Design patents do not protect any underlying non-visual functional attributes, purposes, or characteristics of an article of manufacture, but rather only protect the overall appearance of the claimed design depicted in the drawings. Design patent protection incentivizes and stimulates the exercise of inventive faculty in improving the appearance of articles of manufacture, which in turn forwards the meritorious policy goal of promoting the decorative arts.

