

Design Patents

On Thursday, we discussed design patents.

Design patents cover a sort of uncomfortable middle ground between the different classes of intellectual property. They cover the ornamental design of a product rather than anything useful about that product:

- Unlike normal utility patent law, design patents don't incentivize the invention of useful things.
- Unlike copyright law, design patents aren't designed to reward creative expression.
- Unlike trademark law, design patents don't prevent consumers from becoming confused as to the source of a product.

Instead, design patents incentivize nicer designs. It's our standard theory of IP rights: it costs more to design something nice than to copy that design once someone else has designed it. So absent an exclusive right, we would expect nice designs to be under-produced. The only difference is that here, we think that society is better off if products are more aesthetically pleasing – that's the innovation we want.

We talked about four separate doctrines that affect the assertion of design-patent rights.

First, we saw that design patents must cover the ornamental design of a product, and that the notion of ornamentality has expanded over time. In 1949, a vacuum-cleaner roll couldn't get a design patent because the part was inside a vacuum cleaner, not seen by consumers.

In 1990, however, an artificial hip prosthesis could get a design patent, because the design was visible to doctors and nurses and hospital administrators before it was implanted in a patient.

And so the result of that is that there are lots of design patents on things like printer parts and car parts. And one consequence of that is maybe those things are more aesthetically pleasing, though I'm a little skeptical. But another consequence is that it makes it harder for third parties to make replacement parts.

Second, we saw that design patents **cannot** provide exclusive rights to functionality. If it does, you need to be in utility-patent land. The concern is that by claiming a design that also happens to provide functional benefits, you get a backdoor utility patent on those functional

benefits, without the extensive review of a utility patent examiner.

But, we saw that the definition of functionality is relatively restrictive. So, an oval school-bus mirror isn't functional because there is more than one way to get a school-bus mirror with a widened field of view and better aerodynamics.

And this doctrine is also a little problematic, because it means that if there are two or three ways to accomplish a function, you can essentially get that monopoly by claiming a few different designs. Though that might be relatively rare.

Third, we saw that infringement works fundamentally differently in utility patents and design patents. Because design-patent claims are pictures and don't have lists of elements, we can't compare the accused product to the claim and see if it contains all the claim limitations.

So instead, we compare the accused product to the claim and see if the two look the same to an ordinary observer, in view of the prior art. But first, we have to exclude the functional components of the design.

Fourth, we saw that validity also works differently in

design-patent land. Anticipation works just like infringement: we look to whether an ordinary observer would consider the patented design to give the same overall visual impression as the prior-art design.

Obviousness, however, is different. Now, instead of looking to how an ordinary observer would evaluate the design, we ask whether an ordinary designer would consider the design obvious. And in doing so, we have to first identify a primary reference that closely resembles the patented design, and then identify other prior-art references that demonstrate how that reference could be modified. This is more limited than the *KSR* method of combining prior art.