

Fed. Circ. Ruling Shows Words Matter In A Design Patent

By **Matthew Bultman**

Law360 (September 17, 2019, 9:05 PM EDT) -- The Federal Circuit's recent decision to toss a patent infringement suit over household goods raises the profile of the words used in design patents and could pressure the U.S. Patent and Trademark Office to reconsider certain examination procedures.

The appeals court's Sept. 12 ruling affirmed a New Jersey federal judge's decision to dismiss an infringement suit that household products maker Curver Luxembourg SARL filed against rival Home Expressions Inc. in 2017.

Home Expressions makes storage baskets that feature an overlapping "Y" pattern, and drawings in Curver's patent show a similar pattern. Curver argued the baskets infringed, even though the patent's title and claim describe its invention as a "pattern for a chair."

Ruling against Curver, the Federal Circuit held the title and claim language can limit the scope of a design patent when the patent's drawings don't indicate what type of product is involved. While the case addressed an "atypical" situation, the court's reasoning could have significant ramifications for design patent law, attorneys said.

"As someone who is maintaining a design patent portfolio, you would be wise to anticipate any potential ramifications of this decision," said Christopher V. Carani, a shareholder at McAndrews Held & Malloy Ltd. who specializes in design patents.

Importance of Words

When considering the scope of a design patent, judges typically focus on the drawings that are included in the patent. People have been unsure about the importance of the patent's title and its claim when it comes to the scope of protection, attorneys said.

Tracy-Gene Durkin, the leader of Sterne Kessler Goldstein & Fox PLLC's mechanical and design practice group, said patent applicants generally have not been overly concerned if a patent examiner asks them to change the title of an application.

That was the situation faced by Curver, which originally applied for a patent covering a "design for a furniture part." Responding to an examiner's suggestion, the company changed the patent to refer to a chair. The ruling illustrates the need to be careful when crafting the title and claim language.

“If during prosecution I’m asked to change my title by the office, I would be very careful in thinking through, ‘Is this title giving the client the scope of protection that they ultimately want?’” Durkin said, adding that “these kinds of changes matter.”

The USPTO requires that the title of the patent identify the article of manufacture in which the design is embodied. Sarah Burstein, a professor at the University of Oklahoma College of Law, said the ruling gives patent applicants an incentive to attempt to use broader titles in an effort to gain broader coverage.

This could set up a clash with the USPTO, which attorneys said has been pushing for more specificity from applicants in recent years.

“There is probably going to later have to be some clarification about how specific does the article of manufacture have to be,” said Damon Neagle, the founder Design IP.

Curver’s road to obtaining patent protection for its design started overseas, not in the U.S., records show. Standards for a design patent are different in other countries and can be more liberal in places like Europe, as compared to the U.S., attorneys said.

Durkin said companies planning to file for a patent in various countries need to prepare their initial application with the specific requirements of each country in mind.

“Know where you’re going before you start down the road, so that when you prepare your initial patent application, you’ve got everything in it for all of the different jurisdictions that you’re planning on eventually taking that patent application to,” she said.

USPTO Rule Changes?

There is a conflict between the Federal Circuit’s ruling in Curver and the USPTO’s rule regarding novelty, experts said.

The office’s patent examination manual says that “anticipation does not require that the claimed design and the prior art be from analogous arts.” That means an examiner could, for example, find a pattern for a chair is unpatentable because it is anticipated by a pattern on a basket.

“In view of this decision, that conclusion is called into question,” said Carani, who is also an adjunct professor at the Northwestern University School of Law.

There is a century-old axiom in patent law: “That which infringes if later, anticipates if earlier.” The basic idea is that the scope for infringement and anticipation are supposed to be the same. If a basket can’t infringe a pattern for a chair, there is an argument the basket shouldn’t be able to anticipate it either.

Burstein said she would be surprised if the office doesn’t revisit its rule.

“If they don’t, I would be shocked if an applicant doesn’t challenge it,” she said. “I got rejected with a basket for my chair’ — that applicant would be justifiably upset.”

It has also been suggested that now may be a good time for the USPTO to reconsider a rule that limits a

design patent application to a single claim.

With the option to include multiple claims, an applicant could, for example, describe a pattern and with each claim designate a different article: One claim identifies a pattern for a chair, another a pattern for a rug, another a pattern for a basket, and so forth.

This sort of change, however, would not be universally welcomed.

“This shouldn’t just be a game about how clever your patent attorney is,” Burstein said. “It should be, ‘What did you actually invent and are you actually teaching other designers how to make your design?’”

The case is *Curver Luxembourg SARL v. Home Expressions Inc.*, case number 18-2214, in the U.S. Court of Appeals for the Federal Circuit.

--Editing by Aaron Pelc and Alanna Weissman.