

Design Patent Claim Interpretation: Factoring Out Function or Viewing the Whole Design?



Our Speakers



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Roadmap

- **First Principles: Origins of Functionality in Claim Construction**
- **The Pendulum Swings: Protecting the Design as a Whole**
- *Range of Motion*: Most recent chapter
- **Discussion on Claim Construction Functionality: Whether, If so, How and by Whom?**



Evolution of Functionality in Infringement



Spectrum: From Purely Artistic to Purely Functional



Patent Act: Subject Matter of Protection

35 U.S.C. § 171, Design Patents

“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor...”

35 U.S.C. § 101, Utility Patents

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor..”

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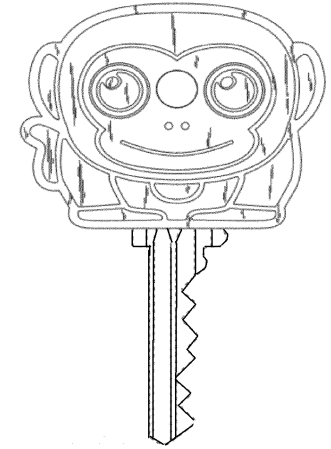
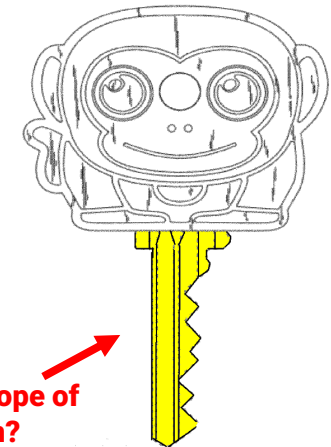
Two Separate “Functionality” Issues

Issue 1: Statutory Compliance

Is the Design Eligible for Design Protection?

Issue 2: Claim Construction

Are Any Aspects To Be Disregarded?

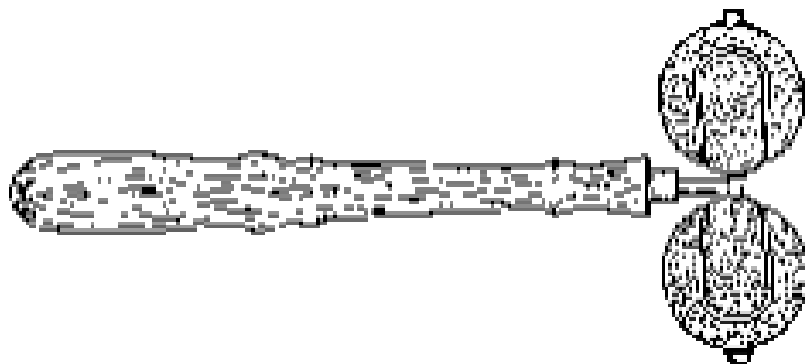


Part of scope of protection?

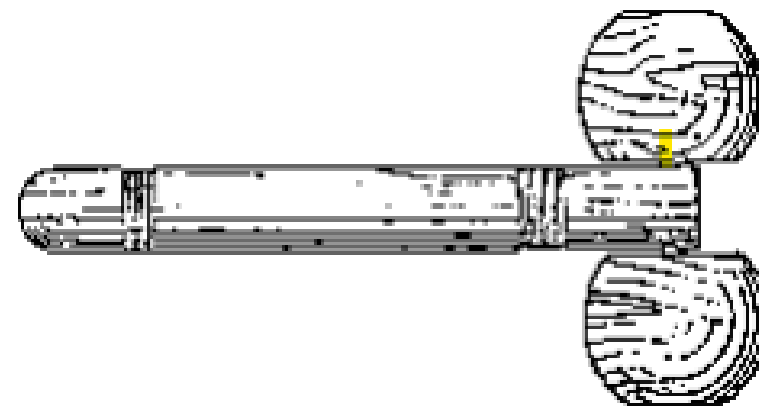


Lee v. Dayton-Hudson Corp., 838 F.2d 1186 (Fed. Cir. 1988) (J.Newman)

Design Right



Accused Product



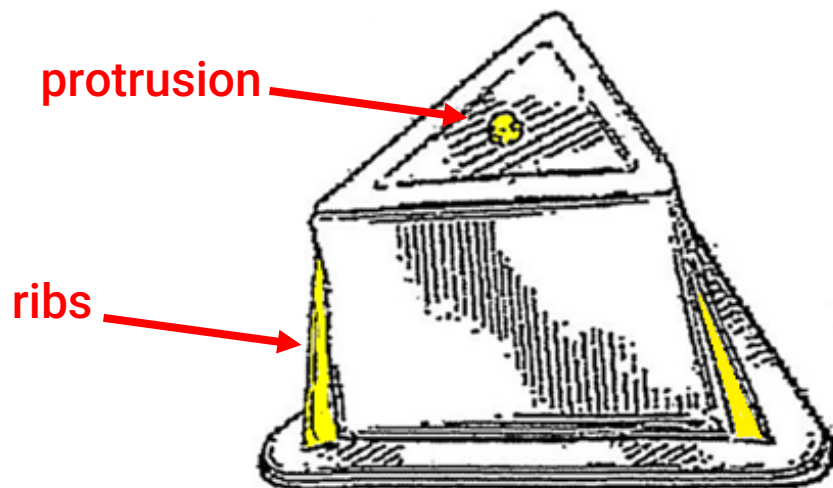
“Design patents do not and **cannot include claims to the structural or functional aspects of the article**....While we agree with Lee that infringement can be found for designs that are not identical to the patented design, such designs must be equivalent in their **ornamental, not functional, aspects.**”



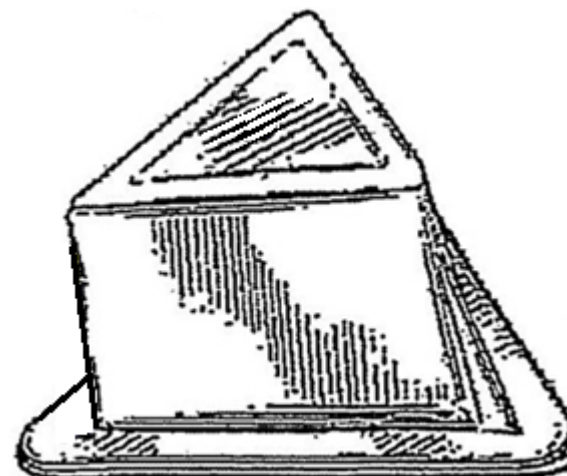
Elmer v. ICC Fabricating, Inc.,

67 F. 3d 1571 (Fed. Cir. 1995)(J.Lourie)

Design Right



Accused Product



Holding: “Support ribs” and “protrusion” are functional but are still part of the Claimed Design. Their inclusion in solid lines in claimed design limits scope of protection.

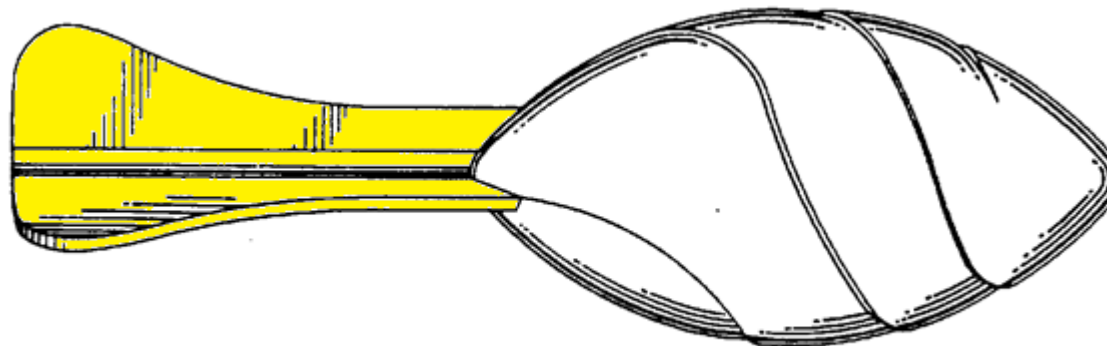


Oddzon Prods., Inc., v. Just Toys, Inc.

122 F. 3d 1396 (Fed. Cir. 1997) (J. Lourie)

Design Right

tail and fins



Holding: Tail and fins are “dictated solely by function” and are thus not part of claimed design.



Oddzon Prods., Inc., v. Just Toys, Inc.

122 F. 3d 1396, 1405 (Fed. Cir. 1997) (J. Lourie)

“A design patent only protects the:

(1) novel, and

(2) ornamental

features of the patented design.”



Oddzon Prods., Inc., v. Just Toys, Inc.

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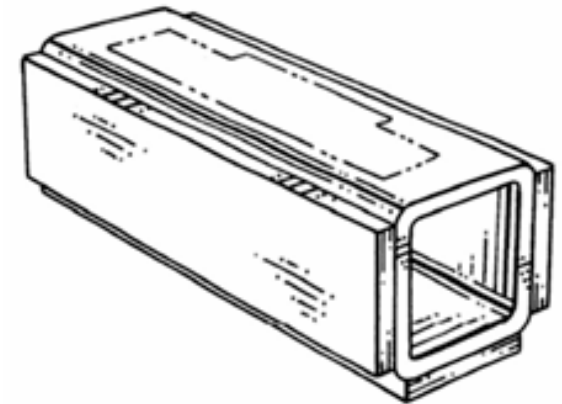
“Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”



Egyptian Goddess, Inc. v. Swisa, Inc.,

543 F.3d 665, 680 (Fed. Cir. 2008) (J.Bryson)(en banc)

“Apart from attempting to provide a verbal description of the design, a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those includedistinguishing between those features of the claimed design that are ornamental and those that are *purely functional*, see *Oddzon Prods.*”



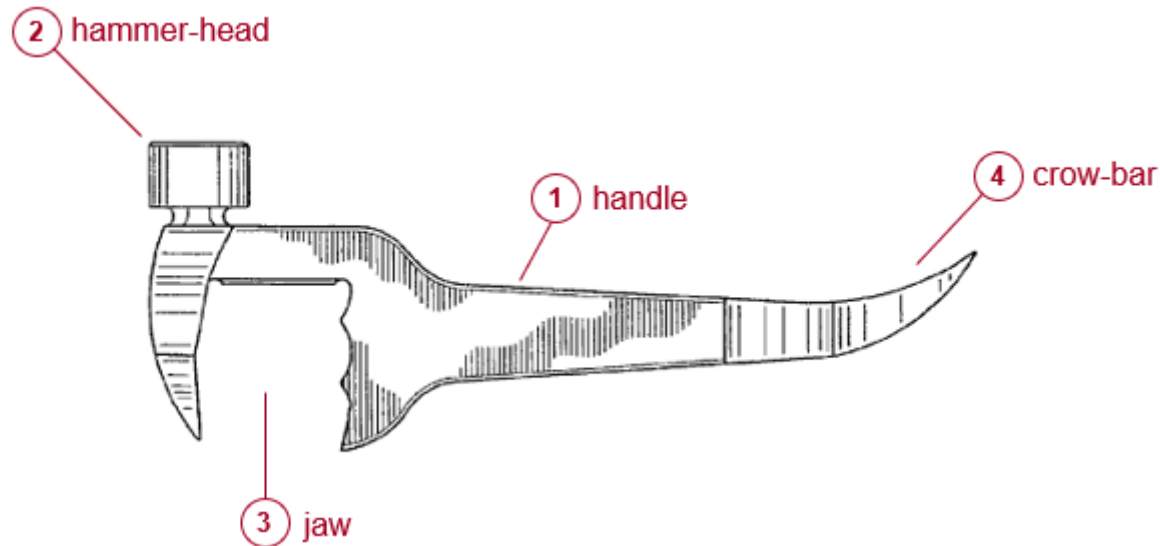


Richardson v. Stanley Works, Inc.,

597 F.3d 1288 (Fed. Cir. 2010)(J.Lourie)

Claim Construction (Matter of Law)

“Richardson's multi-function tool comprises several elements that are driven purely by utility. As the district court noted, elements such as the handle, the hammer-head, the jaw, and the crowbar are dictated by their functional purpose.”





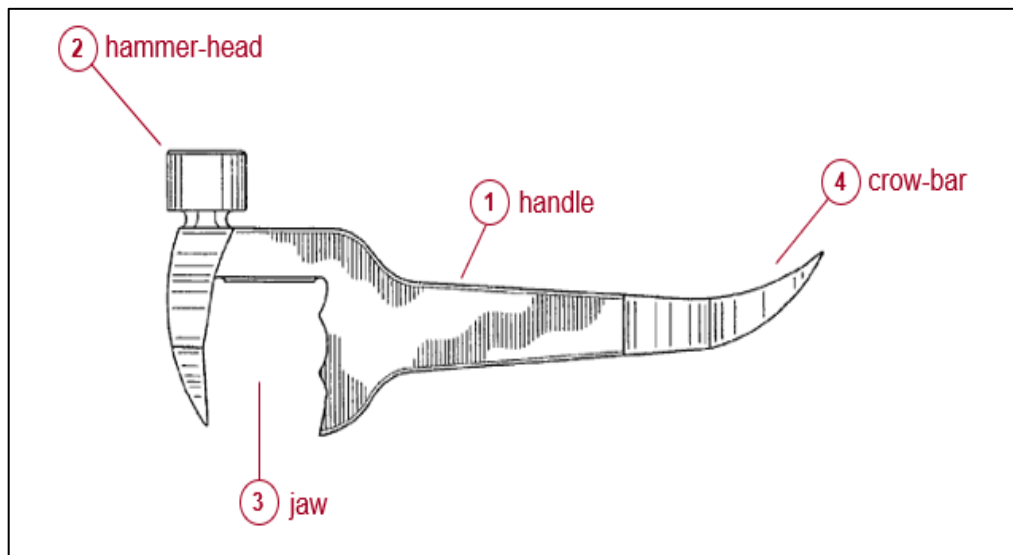
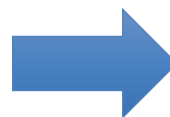
Richardson v. Stanley Works, Inc.,

597 F.3d 1288 (Fed. Cir. 2010)(J.Lourie)

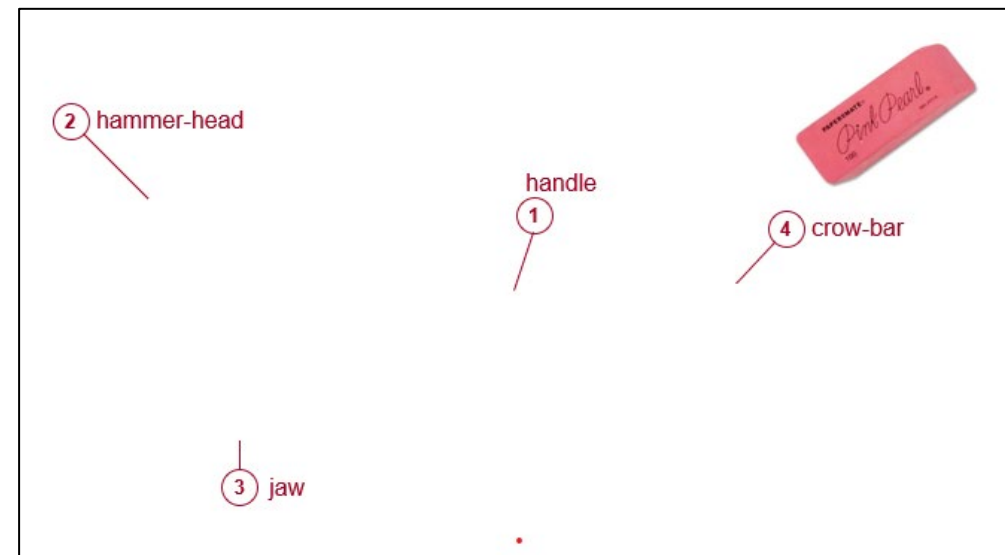
Claim Construction

“Discount,” “Ignore,” “Factor out,” these features

As claimed, As Examined, As issued



As “Construed”





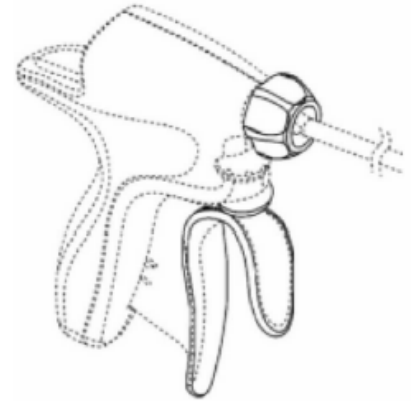
Range of Motion: Most recent chapter

Two Commands That Pull Apart

- § 171 limits protection to ornamental, non-functional features
- But the design must be judged as a whole — not as a collection of separable elements
- Result: the Federal Circuit has repeatedly corrected district courts that swung too far in either direction
- The live question is not whether functionality matters at claim construction, but what you may DO with the functional feature once you find it

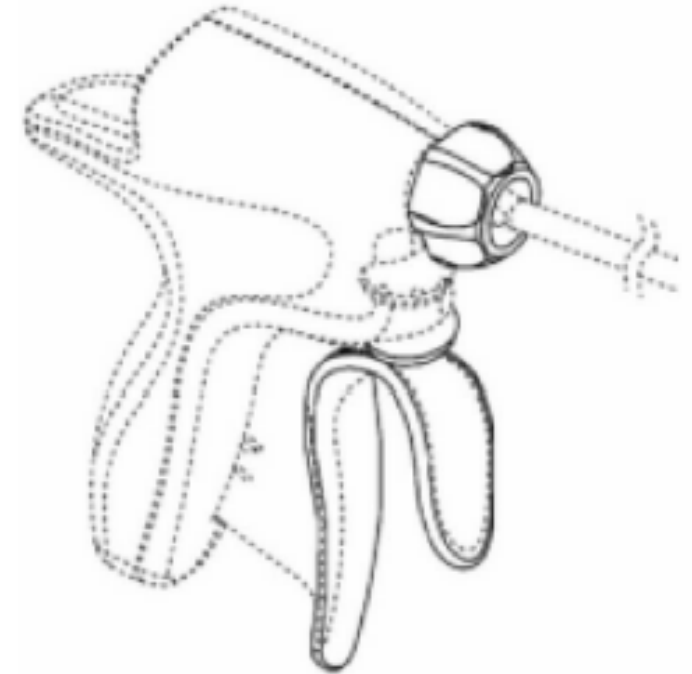
Ethicon: Functional Elements Limit Scope — They Do Not Erase It

- Reversed on invalidity but non-infringement affirmed
- District court factored out the trigger, knob, and button and construed each claim to cover “nothing”
- Validity asks whether the overall appearance is dictated by function
- If it is not, the claim is valid even though certain elements have functional purposes
- But scope is limited to ornamental aspects and does not reach “the broader general design concept”



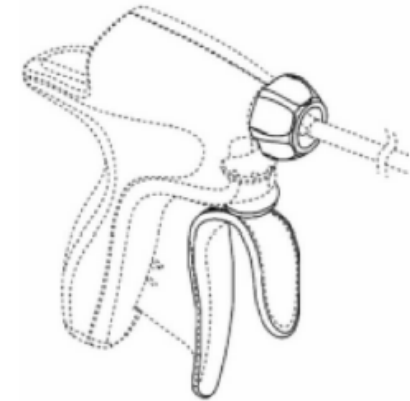
What the Design Patents Actually Covered

- The trigger, torque knob, and activation button of the underlying article do have functional aspects
- But the district court ignored the particular curved trigger, flat-front knob, and rounded button
- No record evidence that the ornamental designs adorning those elements are essential to the use of the article
- Scope: the depicted ornamental aspects of certain combinations of trigger, knob, and button, in specific relative positions and orientations



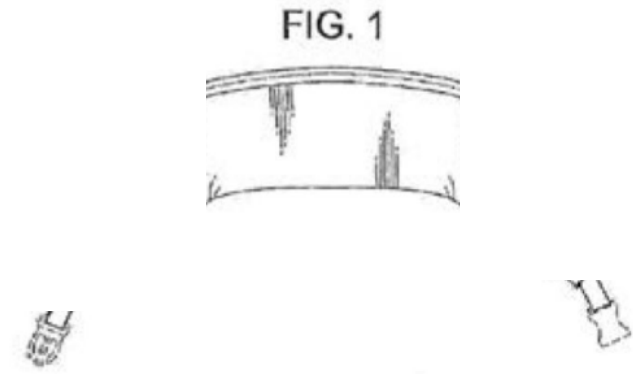
Plainly Dissimilar – The Specifics

- Conceptual similarity is not enough: both have an open trigger, a small button, and a fluted knob in similar positions
- Those functional underlying elements drop out at that general conceptual level
- Most obvious difference: overall “contoured shape” (claimed) vs. overall “linear shape” (accused)
- Trigger: curved proximal/distal portions and a tapered proximal handle vs. parallel portions of consistent width
- Button: football-shaped vs. rectangular
- Knob: unevenly tapered flutes and a recessed flat face vs. evenly tapered flutes and a rounded, unrecessed face



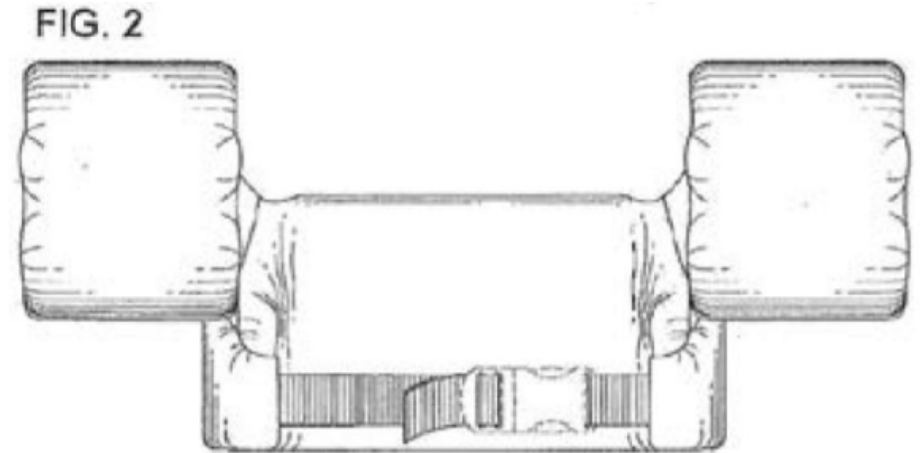
Sport Dimension v. Coleman (2016): No Wholesale Excision

- Coleman personal flotation device, U.S. D623,714: two armbands joined to a torso piece with tapered sides
- District court construction: the design “except the left and right armband, and the side torso tapering, which are functional and not ornamental”
- Vacated and remanded: the court improperly eliminated the armbands and torso tapering from the claim entirely
- “In no case did we entirely eliminate a structural element from the claimed ornamental design, even though that element also served a functional purpose”



Sport Dimension Claim Construction

- Includes the appearance of three interconnected rectangles, as seen in Figure 2
- Includes the armbands and side torso tapering, to the extent they contribute to the overall ornamentation
- The fact finder should not focus on the particular designs of those elements, but on what they contribute to the overall ornamentation
- Many functional elements and minimal ornamentation means claim scope is “accordingly narrow”





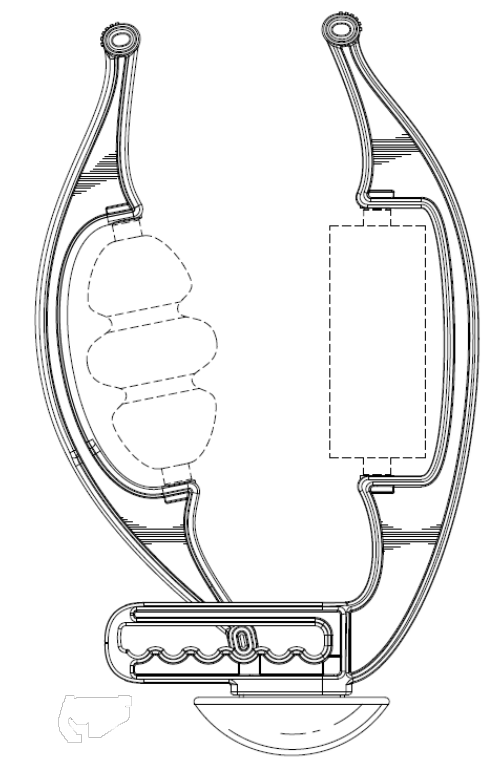
The Pendulum Swings: Protecting the Design as a Whole



Range of Motion v. Armaid Co. Inc.

166 F.4th 981 (Fed. Cir. 2026) (Cunningham)

D802,155
(Range of Motion)



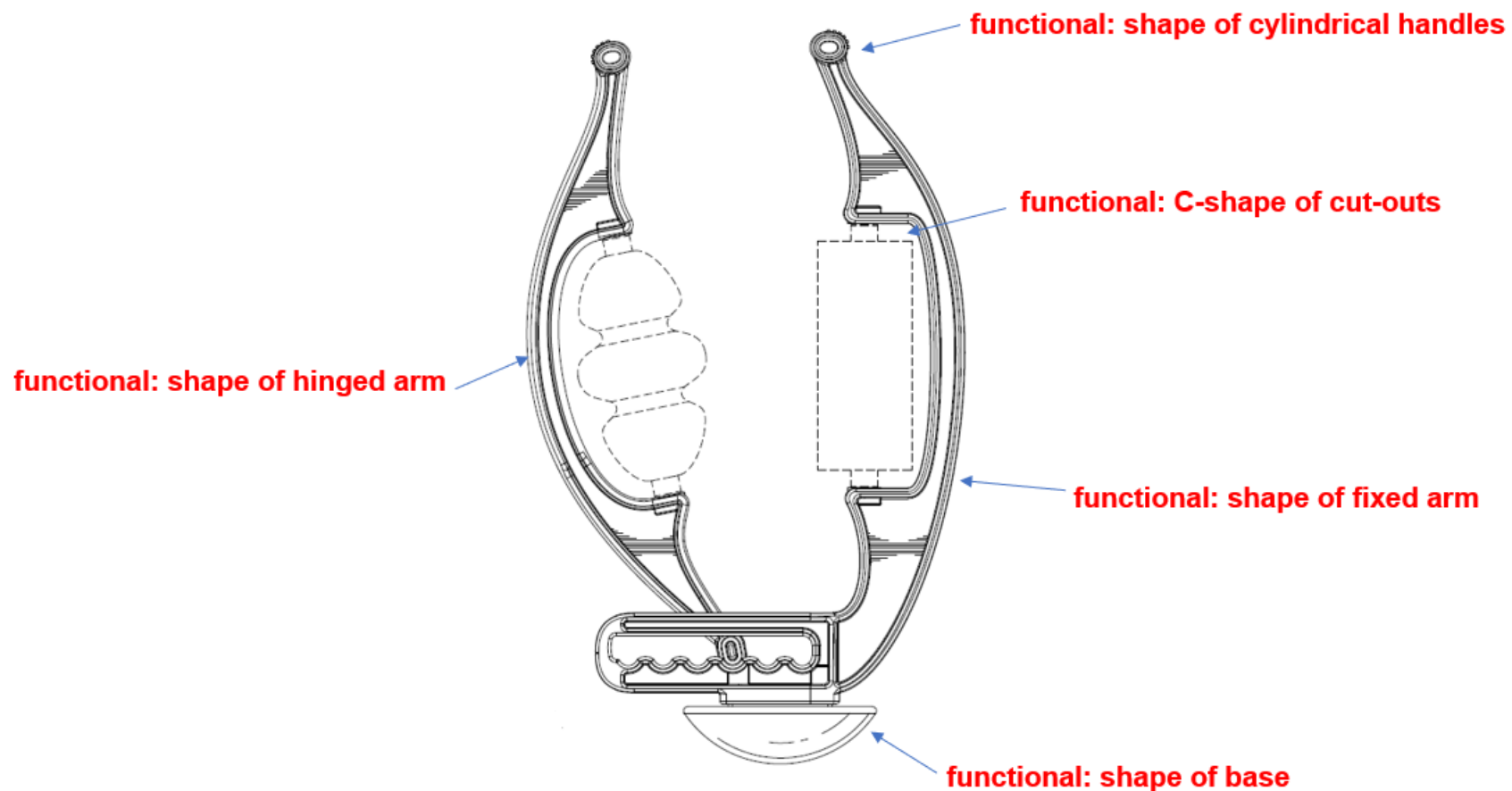
Accused Product





Range of Motion v. Armaid Co. Inc.

166 F.4th 981 (Fed. Cir. 2026) (Cunningham)



Court: functional purpose and “beyond the scope of the claim”



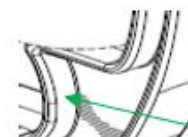
Range of Motion v. Armaid Co. Inc.

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Ornamental: Shape of transition from arms to handles

Ornamental: shape of end of hinge apparatus



Ornamental: thickness of ridge



Ornamental: shape of transition



Range of Motion v. Armaid Co. Inc.

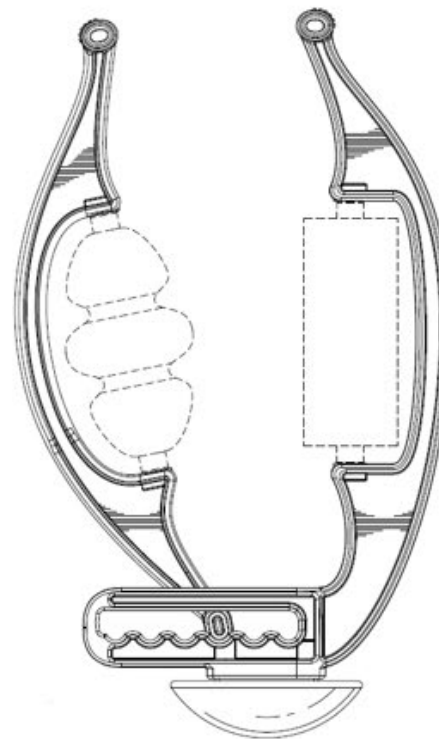
166 F.4th 981 (Fed. Cir. 2026) (Cunningham)

AFTER CLAIM CONSTRUCTION

HOLDING:

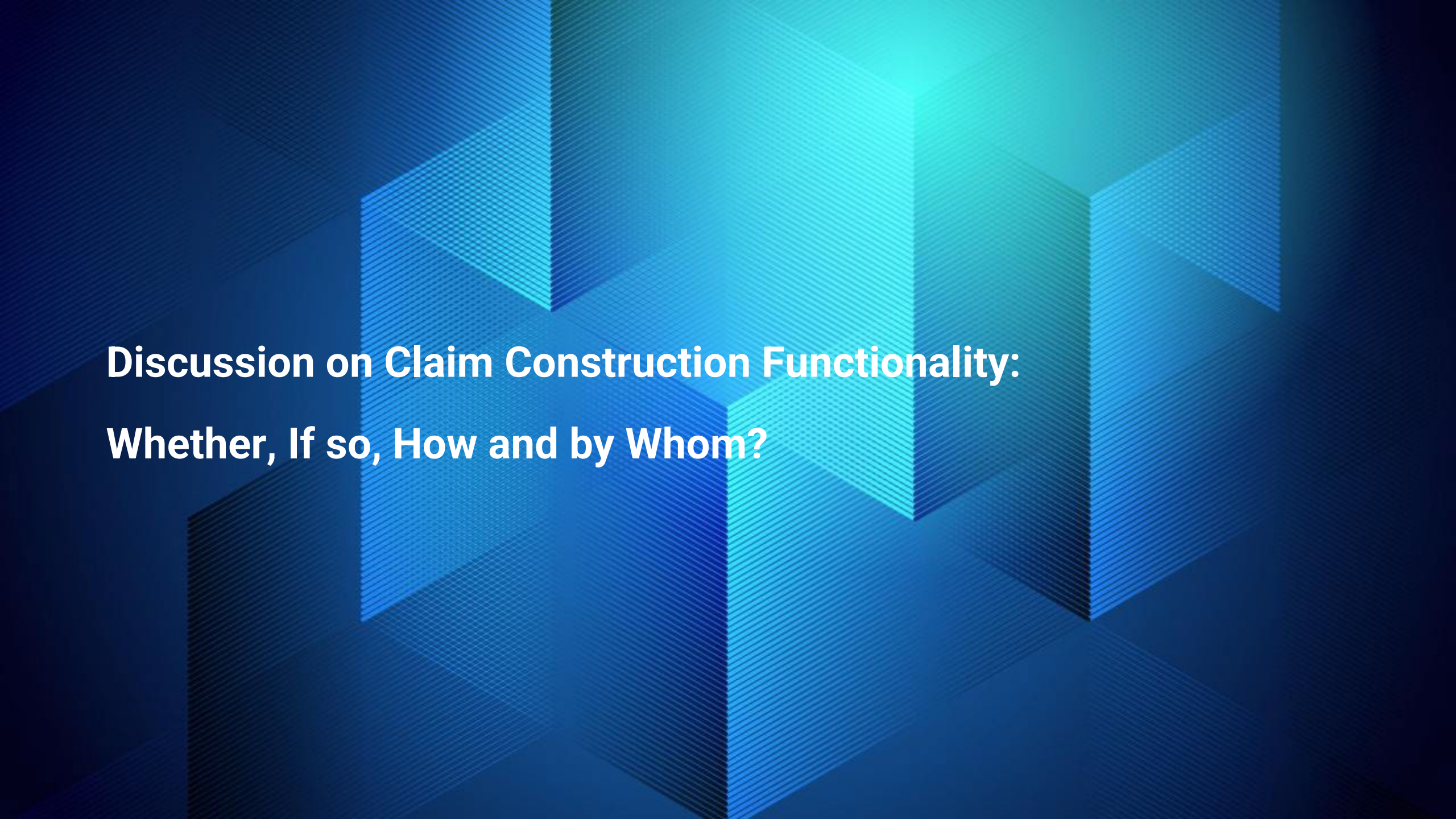
**AFFIRMED SJ OF NON-INFRINGEMENT
“PLAINLY DISSIMILAR”**

D802,155
(Range of Motion)



Accused Product

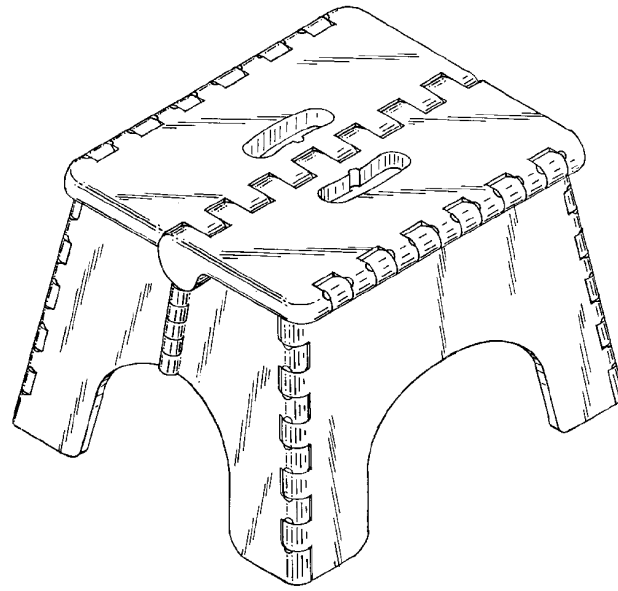




Discussion on Claim Construction Functionality: Whether, If so, How and by Whom?

Discussion Question 1 (Whether)

- **SHOULD** claim construction be used to exclude any portion of the claimed design's overall appearance on functionality grounds?



Discussion Question 2.1 (How?)

- If functional features of the claimed design should be identified, **HOW** should we identify them?

“Purely Functional”

- **Alternative designs:** Are there alternative designs? If so, not purely functional.

5-Factor Test Berry v. Sterling

(using Morton Norwich Factors from trademark law)

- **Best design:** Does the protected design represent the best design?
- **Alternative designs:** Would other designs impair the article’s utility?
- **Utility patents:** Are there related utility patents?
- **Advertising:** Does advertising promote specific utilitarian benefits of the design’s features?
- **Ornamental aspects:** Are individual elements—or the overall appearance—clearly independent of functional dictates?

Discussion Question 2.2 (Who)

- If functional features should be identified, **WHO** decides:
 - the court during claim construction as a matter of law, or
 - the jury when assessing infringement or invalidity as a matter of fact?

Question 2.3 (Then what?)

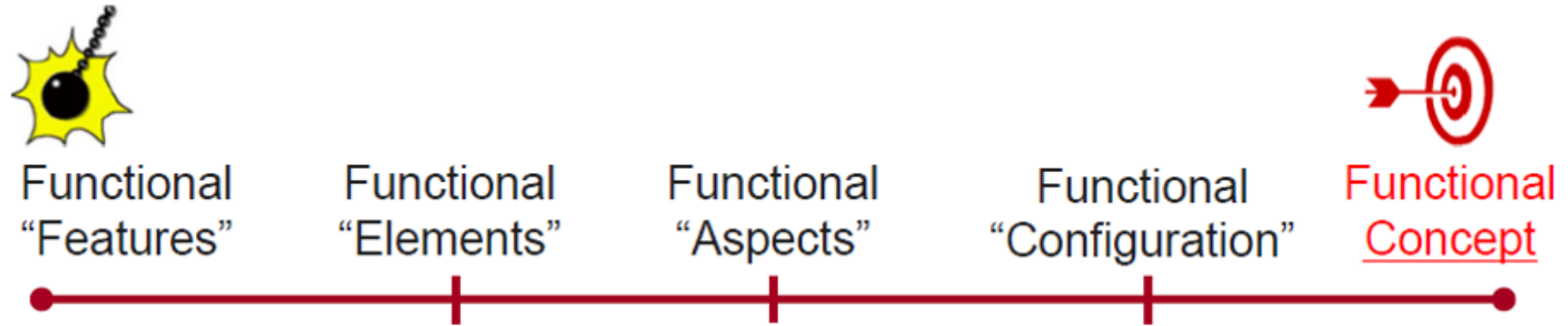
- Once functional features are identified, should they be included, excluded, or treated in some other way?



Discussion Question 3 (Final thoughts)

- Given the inconsistencies of the existing law what are the best arguments for the patentee and the accused infringer?

Discussion Question 3 (Final thoughts)



See Christopher V. Carani, *Design Patent Functionality: A Sensible Solution*, ABA's *Landslide*®, Nov/Dec 2014, Vol. 7, No. 2.; Christopher V. Carani, *All or Nothing at All: Design Patent's Ornamentality Requirement and the Failings of Feature Filtration*, 36 Berkeley Tech. L.J. 213 (2021)

Discussion Question 3 (Final thoughts)

“A design patent only protects the:

~~(1) novel, and~~

~~(2) ornamental~~

~~features of the patented design.”~~

overall appearance of the design as depicted in the drawings;
it does not protect functional qualities or general design
concepts.”

Thank you.

