

## NOTES

### THE WEAKENING OF THE PRESUMPTION OF VALIDITY FOR DESIGN PATENTS: CONTINUED CONFUSION UNDER THE FUNCTIONALITY AND MATTER OF CONCERN DOCTRINES

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2. The Matter of Concern Doctrine Should Be Stated as Follows:  
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INTRODUCTION

Under Title 35 of the U.S. Code, a patent granted by the U.S. Patent and Trademark Office (USPTO) is presumed valid.<sup>1</sup> This presumption applies to both utility patents (which cover *functional* inventions—e.g., a carburetor)<sup>2</sup> and design patents (which cover *ornamental* inventions—e.g., a hood ornament)<sup>3</sup> equally.<sup>4</sup> This statutory presumption of patent validity “rests on a legislative recognition of the considerable expertise possessed by the Patent Office and an assumption that the Office properly performs its administrative functions.”<sup>5</sup> “Thus, there is a wide agreement that the burden on the party asserting invalidity is a heavy one.”<sup>6</sup>

However, as one author has accurately concluded, “The statutory presumption of validity with respect to design patents appears to be easily overcome through a modicum of evidence and a plethora of judicial creativity.”<sup>7</sup> At least two studies suggest that the presumption of validity for design patents has been relatively weak.<sup>8</sup> In one study, Raymond L. Walter demonstrated that the holder of a design patent could have expected a court to find the patent valid only 23% of the time.<sup>9</sup>

1. 35 U.S.C. § 282 (Supp. I 1995).

2. See *infra* Part I.A.

3. See *infra* Part I.B.

4. 37 C.F.R. § 1.151 (1996) (“The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.”).

5. *Contico Int’l Inc. v. Rubbermaid Commercial Prods., Inc.*, 665 F.2d 820, 822-23 (8th Cir. 1981).

6. *Id.* at 823.

7. Thomas B. Lindgren, *The Sanctity of the Design Patent: Illusion or Reality? Twenty Years of Design Patent Litigation Since Compco v. Day-Brite Lighting, Inc., and Sears, Roebuck & Co. v. Stiffel Co.*, 10 OKLA. CITY U. L. REV. 195, 257 (1985).

8. Lawrence E. Evans, Jr., *Design Patents*, in *FUNDAMENTALS OF PATENT LAW AND PRACTICE* 85, 100 (1993) (ALI-ABA Course of Study No. C806) (citing Raymond L. Walter, *A Ten Year Study of Design Patent Litigation*, 35 J. PAT. & TRADEMARK OFF. SOC’Y 389 (1953)); Lindgren, *supra* note 7.

9. Walter, *supra* note 8. In this study, Raymond L. Walter performed a ten-year (1942-1951) survey of design patent litigation. Walter evaluated a total of 205 litigated design patents for

In a similar study, Thomas B. Lindgren showed that the holder of a design patent could have generally expected a court to hold his or her design patent valid only 29% of the time.<sup>10</sup>

Furthermore, although Lawrence E. Evans, Jr. concluded that “these unfavorable trends have been reversed,”<sup>11</sup> his study stated that only a “majority” of litigated design patents from 1987 to 1993 were held valid.<sup>12</sup> Certainly, the Evans study indicates a desirable improvement from the Walter and Lindgren results, but given the special expertise of the USPTO, the courts’ finding of validity a mere majority of the time seems unwarranted. It seems that design patents are still invalidated far too often.

The question that naturally follows is: “Why are so many design patents invalidated by the judiciary?” It is the main purpose of this Note to offer an answer to this question and a solution to this problem. One scholar has suggested two plausible answers to this question: (1) that perhaps only the “weak patents are attacked” or (2) that the “subjective nature of the judgment . . . [where] [t]he Patent Office examiners see it one way; a trial judge another; [and] an appellate bench another” causes higher percentages of invalidity.<sup>13</sup> This Note suggests an alternative explanation which, unlike the answers above, would provide a means of strengthening the presumption of validity for design patents.

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this period. Of the 205 cases, Walter reported that the courts in 48 of these cases expressly addressed the issue of validity and of those 48 design patents, 11 were held valid while 37 were held invalid. Thus, design patents from 1942 to 1951 were held valid only 23% of the time according to this study.

10. Lindgren, *supra* note 7. In this study, Thomas B. Lindgren used Westlaw and Lexis to find all design patent infringement cases from 1964 to 1983. Lindgren evaluated 124 design patent cases and reported that the courts in 87 of the cases expressly addressed validity and of those cases, 25 design patents were held valid, while 62 were declared invalid. Thus, according to this study, design patents were held valid only 29% of the time from 1964 to 1983. *Id.* at 195 n.\*\*.

11. Evans, *supra* note 8, at 104. Evans apparently credited this reversal in trends to the creation of the Federal Circuit in the fall of 1982. For the uninitiated, Congress created the Court of Appeals for the Federal Circuit in 1982 to set precedent for and have the power of review over the federal district courts. 28 U.S.C. § 41 (1994); Douglas M. McAllister, *The Ornamentality Standard of Design Patents: Evolution and Rejection of the “Hidden in Use” Test*, 13 U. BRIDGEPORT L. REV. 419, 452 n.1 (1993) (citing EDMUND W. KITCH & HARVEY S. PERLMAN, LEGAL REGULATION OF THE COMPETITIVE PROCESS 793 (4th ed. 1991)). Prior to 1982, if an Examiner rejected an applicant’s patent application, the applicant’s course of appeal was first to the Board of Patent Appeals and Interferences, then to the Court of Customs and Patent Appeals (CCPA), and then to the U.S. Supreme Court. Since 1982, however, the applicant’s appeal procedure begins with the Board of Patent Appeals and Interferences, then goes to either the District Court or to the Federal Circuit, then to either the Federal Circuit (if the District Court was previously appealed to) or to the Supreme Court (if the Federal Circuit was previously appealed to). See also RONALD B. HILDRETH, PATENT LAW: A PRACTITIONER’S GUIDE 30, 31 (2d ed. 1993). Accordingly, the Federal Circuit is the successor to the CCPA which no longer exists.

12. Evans, *supra* note 8, at 104.

13. Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1357 (1987).

This Note concludes that an unreasonable number of design patents are held invalid because the functionality and matter of concern doctrines (which are judicial requirements for design patent validity) have been inadequately defined. Further, this Note concludes that because of the inadequately defined doctrines, there has been considerable judicial confusion which has led to inconsistent results and incorrect findings of design patent invalidity. This Note also proposes a solution: by narrowing the legal standards which define both doctrines, the judicial review of design patent validity will be easier and more effective, will yield a higher percentage of design patent validity, and will better promote the legislative purpose behind creating design patents.

### I. BACKGROUND INFORMATION ABOUT PATENTS

Although various types of protection are available to artists, inventors, designers, or just "regular Joes" who are lucky enough to have a new and original idea worthy of legal protection in the United States,<sup>14</sup> this Note focuses only on patent protection. Accordingly, this section provides some general background information relating to utility patents and design patents which is critical to the development of this Note.

The U.S. Constitution grants Congress the power to pass laws relating to patents.<sup>15</sup> Under this authority, Congress promulgated the patent laws which are embodied in Title 35 of the U.S. Code, and federal courts have exclusive jurisdiction over matters arising under these laws.<sup>16</sup> Under this Title, two main types of patents are available to an inventor: (1) utility patents, and (2) design patents.<sup>17</sup> A utility patent can be obtained for "any new and *useful* process, machine, manufacture, or composition of matter, or any new and *useful* improvement therefor. . . ."<sup>18</sup> And a design patent can be obtained for "any new, original and *ornamental* design for an article of manufacture. . . ."<sup>19</sup>

To obtain a patent (either utility or design), an inventor or discoverer must apply for a patent through a process known as "patent office prosecution."<sup>20</sup> This involves submitting an application (with appropriate fees)<sup>21</sup> to the USPTO for

14. There are generally four types of intellectual property protection that are currently available: (1) patent, (2) trademark, (3) copyright, and (4) trade dress.

15. U.S. CONST. art. I, § 8, cl. 8 ("Congress shall have power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").

16. 28 U.S.C. § 1338(a) (1994).

17. HILDRETH, *supra* note 11, at 4-7. An inventor can also obtain a plant patent (35 U.S.C. § 161 (1994)) (for asexually reproducing any distinct and new variety of plant) and/or a reissue patent (for correcting errors within their previously issued patent). *Id.* § 251. However, the focus in this Note is on utility and design patents.

18. 35 U.S.C. § 101 (1994) (emphasis added).

19. *Id.* § 171 (emphasis added).

20. HILDRETH, *supra* note 11, at 13.

21. 35 U.S.C. § 41 (Supp. I 1995).

approval.<sup>22</sup> A Patent Examiner working for the USPTO studies the application to decide whether to accept the application and grant a U.S. patent or to reject the invention, thereby denying a U.S. patent.<sup>23</sup> If the examiner allows a patent to issue to the inventor, the patent represents an exclusive “grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States . . . .”<sup>24</sup> Thus, “[a] patent is a contract between an inventor and the United States government under which the government grants the inventor a limited monopoly, . . . [and in return] the inventor discloses the complete invention to the public in order to promote the progress of science.”<sup>25</sup>

### A. *Utility Patents*

Utility patents are the most common form of patents in the United States and “are what most people think of when they think of a patent.”<sup>26</sup> A utility patent can be obtained by anyone who “invents or discovers any new and *useful* process, machine, manufacture, or composition of matter, or any new and *useful* improvement therefor.”<sup>27</sup> Hence, the word, “utility,” derives from the fact that a utility patent must perform some “useful” function. For example, utility patents have issued for technology ranging from barbed wire to cellular phones, from paper clips to computers, and from shingles to lasers. In fact, utility patents are available for “all sorts of structural and functional technology.”<sup>28</sup> The critical point here is that utility patents are reserved for inventions that serve some *useful* or utilitarian *function* (e.g., the cellular phone must allow a user to make a phone call from almost anywhere; the paper clip must hold paper together; and the shingle must protect against moisture).

In addition to meeting the utility requirement of 35 U.S.C. § 101, an invention must also meet four substantive requirements in order for a patent to issue: (1) the subject matter must fall within one of the categories of § 101 (e.g., a process, machine, manufacture, composition of matter, or improvement therefor);<sup>29</sup> (2) the subject matter must satisfy the originality requirements of § 101 and § 115; (3) the claimed invention must be novel as defined by § 101 and § 102; and (4) the subject matter must not be obvious, under § 103, at the time the invention was made to one skilled in the art to which the subject matter pertains.<sup>30</sup> Once these

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22. McAllister, *supra* note 11, at 452 n.1 (citing KITCH & PERLMAN, *supra* note 11, at 793).  
See also HILDRETH, *supra* note 11, at 29-32.

23. McAllister, *supra* note 11, at 452 n.1.

24. 35 U.S.C. § 154 (1994).

25. HILDRETH, *supra* note 11, at 1.

26. Perry J. Saidman, *The Glass Slipper Approach to Protecting Industrial Designs or When the Shoe Fits, Wear It*, 19 U. BAL. L. REV. 167, 167 (1989).

27. 35 U.S.C. § 101 (1994) (emphasis added).

28. Saidman, *supra* note 26, at 167.

29. See *supra* note 27 and accompanying text.

30. McAllister, *supra* note 11, at 452 n.3.

requirements are met, the invention can issue as a U.S. patent which will be valid for a term of twenty years from the date the application was filed.<sup>31</sup> The twenty-year term cannot be renewed or extended.<sup>32</sup>

### B. Design Patents

Unlike utility patents, design patents are not granted for “useful” inventions or discoveries.<sup>33</sup> Instead, design patents are only available for “ornamental” designs on articles of manufacture.<sup>34</sup> For example, if an inventor of a cellular phone came up with some sleek new design (in addition to inventing improved functional qualities of the phone), such as configuring the phone in some new geometrical shape or providing grooves and lines on the phone which made the phone more appealing, the inventor could potentially obtain a design patent covering the ornamental qualities of the phone. As this example illustrates, it is possible to obtain both a utility patent and a design patent for the same article of manufacture, such as a cellular phone, provided the article has both functional and ornamental qualities (and meets the other requirements of patentability). However, the utility patent can relate only to the “functional” or useful aspect(s) of the article,<sup>35</sup> and the design patent can relate only to the ornamental characteristic(s) of the article.<sup>36</sup>

Accordingly, courts unanimously agree that an ornamental design cannot be functional.<sup>37</sup> This is the basis for the functionality doctrine which will be discussed below. However, there is currently some confusion as to what legal standard should be applied in determining whether a design is functional.<sup>38</sup> Some

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31. 35 U.S.C. § 154(a)(2) (1994).

32. Evans, *supra* note 8, at 89.

33. See 35 U.S.C. § 171 (1994) (“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).

34. *Id.* The word, “useful,” from § 101 (for utility patents) is replaced with the word, “ornamental,” in § 171 (for design patents). Of course, an ornamental design must also satisfy the novel requirements of § 102, the nonobvious requirement of § 103, and the originality requirements of § 101 and § 115 (as indicated by the “new” and “original” language in § 171) in order to be patentable.

35. *Id.* § 101.

36. *Id.* § 171.

37. *In re Carletti*, 328 F.2d 1020, 1022 (C.C.P.A. 1964) (“[W]hen a configuration is the result of functional considerations only, the resulting design is not patentable as an ornamental design for the simple reason that it is not ‘ornamental’—was not created for the purpose of ornamenting.”). *But see Barofsky v. General Elec. Corp.*, 396 F.2d 340, 342 (9th Cir. 1968) (applying functionality and ornamentality as distinct concepts).

38. See Perry J. Saidman & John M. Hintz, *The Doctrine of Functionality in Design Patent Cases*, 19 U. BALT. L. REV. 352, 353 (1989) (“[T]here is some confusion whether the functionality standard should be couched in terms of designs which are primarily functional or solely functional.”).

courts have stated that a design patent cannot be obtained for designs which are "solely functional," yet other courts have stated that design patents cannot be obtained for designs that are "primarily functional."<sup>39</sup> The side-by-side existence of these two tests is troubling. Moreover, the application of the primarily functional test weakens the presumption of validity and results in the unnecessary invalidation of many design patents<sup>40</sup> Part II.A of this Note analyzes the doctrine of functionality, illustrates the courts' use of dual standards and offers a solution to remedy the current situation.

Along with the functionality doctrine mentioned above, the judiciary has also created a matter of concern test which must be satisfied in order to meet the ornamental requirement of § 171.<sup>41</sup> Like the functionality doctrine, the matter of concern doctrine has caused considerable confusion.<sup>42</sup> Courts have wrongly defined the time period in which a design must satisfy the matter of concern requirement. As a result, this doctrine is also causing design patents to be unjustifiably invalidated, thereby weakening the presumption of validity. Part II.B of this note analyzes the matter of concern doctrine in order to pinpoint the problem with the current doctrine and to offer a realistic solution.

It is worth noting that in addition to the confusion surrounding the functionality and matter of concern doctrines individually, some courts have also erroneously merged the functionality and matter of concern doctrines together.<sup>43</sup> As a result, the already confusing doctrines are even more difficult to understand and the presumption of validity is weakened even further. Thus, even if courts do not adopt the suggestions provided in this Note for narrowing the scope of the two doctrines, courts should at least analyze the doctrines separately when rendering opinions.

## II. THE ORNAMENTALITY REQUIREMENT: DEVELOPMENT OF THE FUNCTIONALITY AND MATTER OF CONCERN DOCTRINES

As mentioned above, design patents are only available for ornamental designs on articles of manufacture.<sup>44</sup> Although the first design patent laws enacted by Congress in 1842 did not include the ornamental requirement,<sup>45</sup> the statute underwent several amendments,<sup>46</sup> and in 1902 the ornamental requirement was

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39. *Id.*

40. *See infra* Part II.A.

41. *See In re Koehring*, 37 F.2d 421, 423 (C.C.P.A. 1930) (stating the matter of concern test as follows: "Is the ornamentation [of the article] a matter of concern to anybody, reasonably within the purview of the act?").

42. *See infra* Part II.B.

43. *See infra* note 121 and accompanying text.

44. 35 U.S.C. § 171 (1994).

45. Act of Aug. 29, 1842, ch. 263, 5 Stat. 543.

46. *See McAllister*, *supra* note 11, at 421-22:

The original statute contained no requirement that a design be ornamental to qualify as patentable subject matter. The Act of 1861 and the Act of 1870 slightly modified the

added.<sup>47</sup> The current design patent statute reads:

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. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.<sup>48</sup>

To meet the ornamental requirement of § 171, courts have developed two prerequisites that a design patent must satisfy in order to be valid: (1) the design must meet the doctrine of functionality requirements<sup>49</sup> and (2) the design must be a “matter of concern.”<sup>50</sup> These doctrines will be discussed in the following two sections.

### A. *The Doctrine of Functionality*

“The question of when the functionality of a design so permeates an article of manufacture that design patent protection is not available under the law is a complex issue and one that continues to be the subject of considerable judicial attention.”<sup>51</sup> Still, the requirement that ornamental designs cannot be functional remains in force.<sup>52</sup>

1. *Historical Development of the Doctrine of Functionality.*—Although the term, functionality, is not used in the design patent statute,<sup>53</sup> courts have read into the statute that “designs be nonfunctional as the converse of the statutory requirement of ornamentality.”<sup>54</sup> However, because “[i]tems of manufacture are, for the most part, not likely to survive in the marketplace unless they perform some function, . . . the fact that an item is functional cannot mean that it cannot be the subject of a valid design patent.”<sup>55</sup> Indeed, as the Federal Circuit stated in *Avia*

wording of 5 Stat. 543 § 3, which subsequently became section 4929 of the Revised Statutes of 1874. Section 4929, like the original statute, specifically delineated certain articles deemed proper subjects for design patents. This modified version of the original statute also omits any reference to ornamentation as a prerequisite to patentability.

Congress amended section 4929 of the Revised Statutes in 1902 . . . primarily for the purpose of substituting the word ‘ornamental’ in place of the word ‘useful’ in the former statute.

*Id.* (citation omitted).

47. *Id.*

48. 35 U.S.C. § 171 (1994) (emphasis added).

49. *See supra* note 37 and accompanying text.

50. *See supra* note 41 and accompanying text.

51. *Chrysler Motors Corp. v. Auto Body Panels Inc.*, 908 F.2d 951, 954 (Fed. Cir. 1990).

52. *See supra* note 37 and accompanying text.

53. *See* 35 U.S.C. § 171 (1994).

54. Saidman & Hintz, *supra* note 38, at 352 n.3.

55. *Smith v. M & B Sales & Mfg.*, No. C 89 0293 MHP (WDB), 1990 WL 11112, at \*2 (N.D. Cal. Jan. 31, 1990).



*Group International, Inc. v. L.A. Gear California*:<sup>56</sup>

There is no dispute that shoes are functional and that certain features of the shoe designs in issue perform functions. However, a distinction exists between the functionality of an article or features thereof and the functionality of the particular design of such article or features thereof that perform a function. Were that not true, it would not be possible to obtain a design patent on a utilitarian article of manufacture, . . . or to obtain both design and utility patents on the same article . . . .<sup>57</sup>

Thus, even though a particular design has functional qualities (e.g., a kitchen chair),<sup>58</sup> “a design may embody functional features and still be patentable.”<sup>59</sup>

The doctrine of functionality was developed primarily to distinguish between those articles which are functional and those which are not.<sup>60</sup> Accordingly, in the case, *In re Carletti*,<sup>61</sup> one of the most significant opinions on the issue of functionality,<sup>62</sup> the court stated that “it has long been settled that when a configuration is the result of functional considerations *only*, the resulting design is not patentable as an ornamental design.”<sup>63</sup> Similarly, in the case, *In re Garbo*,<sup>64</sup> the court stated that in order for a design patent to be valid, “the design must have an unobvious appearance distinct from that dictated *solely* by functional

56. 853 F.2d 1557 (Fed. Cir. 1988).

57. *Id.* at 1563 (citations omitted).

58. The following list of cases illustrates that design patents can be held valid despite the utilitarian nature of the article of manufacture: *In re Klein*, 987 F.2d 1569 (Fed. Cir. 1993) (roof or siding shingle); *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815 (Fed. Cir. 1992) (hand-held kitchen blender); *Padco, Inc. v. Newell Co.*, 878 F.2d 1445 (Fed. Cir. 1989) (paint roller); *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557 (Fed. Cir. 1988) (shoes); *Jacuzzi, Inc. v. Kohler Co.*, 835 F.2d 870 (Fed. Cir. 1987) (bath tubs); *In re Sung Nam Cho*, 813 F.2d 378 (Fed. Cir. 1987) (bottle cap); *Pacific Furniture Mfg. Co. v. Preview Furniture Corp.*, 800 F.2d 1111 (Fed. Cir. 1986) (chairs); *Contico Int'l Inc. v. Rubbermaid Commercial Prod.*, 665 F.2d 820 (5th Cir. 1981) (dolly for refuse containers); *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980) (drill bit shank); *In re Swett*, 451 F.2d 631 (C.C.P.A. 1971) (food storage bowls); *In re Koehring*, 37 F.2d 421 (C.C.P.A. 1930) (cement mixer); *Smith Corona Corp. v. Pelikan, Inc.*, 784 F. Supp. 452 (M.D. Tenn. 1992) (typewriter ribbon cassettes); *Independent Prods. Co. v. Tamar Plastics Corp.*, 16 U.S.P.Q.2d 1806 (D. Mass. 1990), *aff'd*, 19 U.S.P.Q.2d 1314 (Fed. Cir. 1991) (plastic hanger); *Liqui-Box Corp. v. Reid Valve Co., Inc.*, 16 U.S.P.Q.2d 1848 (W.D. Pa. 1990) (rectangular bottle); *Nunes v. Bishop Aviation, Inc.*, 703 F. Supp. 774 (W.D. Ark. 1988) (aviation instruments); *Larson v. Classic Corp.*, 683 F. Supp. 1202 (N.D. Ill. 1988) (water bed mattress).

59. *In re Garbo*, 287 F.2d 192, 193 (C.C.P.A. 1961).

60. See Saidman & Hintz, *supra* note 38, at 357 (arguing that “[t]he doctrine of functionality serves a primary purpose of distinguishing the two types of patents available for articles of manufacture—utility and design patents”).

61. 328 F.2d 1020 (C.C.P.A. 1964).

62. Saidman & Hintz, *supra* note 38, at 355.

63. *Carletti*, 328 F.2d at 1022 (emphasis added).

64. 287 F.2d 192 (C.C.P.A. 1961).

considerations.”<sup>65</sup> Accordingly, under this solely functional standard, “a design patent is not invalid if the functional aspect [of the article] could be accomplished in ways other than by the patented design.”<sup>66</sup>

However, the Federal Circuit adopted the position that “if a patented design is ‘*primarily* functional,’ rather than *primarily* ornamental, the patent is invalid.”<sup>67</sup> In doing so, the court apparently chose to move away from the solely functional standard of *Carletti* and *Garbo* to move towards a new, primarily functional standard.

The Federal Circuit’s use of the primarily functional standard, however, has “evolved without explanation of the distinction between it and its predecessor—the solely functional standard . . . [and] the Federal Circuit seems unable to remain consistent with its own interpretations of the scope and application of the doctrine.”<sup>68</sup> In addition, the Federal Circuit’s primarily functional statement in *Avia* was derived from the Federal Circuit’s prior statements in *Power Controls Corp. v. Hybrinetics, Inc.*<sup>69</sup> and *Lee v. Dayton-Hudson Corp.*,<sup>70</sup> which supported the primarily functional language by quoting liberally from cases espousing the solely functional standard.<sup>71</sup>

To make matters worse, both *Carletti* and *Garbo*, which espouse the solely functional standard, are binding precedent for the Federal Circuit.<sup>72</sup> This strongly suggests that the Federal Circuit should be applying the solely functional standard and not the primarily functional standard. In addition, the Federal Circuit has endorsed the primarily functional standard without providing an explanation as to why the new standard was adopted.<sup>73</sup> Therefore, it seems as though the Federal Circuit has carelessly adopted the primarily functional standard by employing that language with no further explanation.<sup>74</sup>

As a result, a solely/primarily dichotomy has arisen which has caused, and continues to cause, anomalous results.<sup>75</sup> For example, under the primarily functional approach, an “element-by-element” analysis must be undertaken to determine whether the majority of the design elements are functional or

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65. *Id.* at 194 (emphasis added).

66. *Motorola, Inc. v. Alexander Mfg. Co.*, 786 F. Supp. 808, 812 (N.D. Iowa 1991) (citing *Avia Group Int’l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988)).

67. *Avia Group Int’l*, 853 F.2d at 1563 (emphasis added).

68. *Saidman & Hintz, supra* note 38, at 354. *See also id.* at 354-55 nn.18-22; *Best Lock Corp. v. Ilco Unicam Corp.*, 94 F.3d 1563, 1566 (Fed. Cir. 1996) (majority espousing the solely functional test). *Id.* at 1567, 1569 (Newman, J., dissenting) (dissent espousing the primarily functional test).

69. 806 F.2d 234 (Fed. Cir. 1986).

70. 838 F.2d 1186 (Fed. Cir. 1988).

71. *Saidman & Hintz, supra* note 38, at 353-54.

72. *Id.* at 355. Moreover, the Supreme Court has seemed to adopt the solely functional test. *Bonita Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989).

73. *Saidman & Hintz, supra* note 38, at 358.

74. *Id.*

75. *Id.* at 354.

ornamental.<sup>76</sup> However, under the solely functional approach, a court needs only to determine “if the functional aspect [of the article] could be accomplished in ways other than by the patented design.”<sup>77</sup> If the functional aspect could be accomplished in a number of different ways, then the design cannot be “dictated solely by functional considerations,”<sup>78</sup> and should not be invalidated under the doctrine of functionality. Thus, anomalous results occur because “it will be easier for an alleged infringer to satisfy his burden of proving invalidity under a primarily functional standard.”<sup>79</sup>

Furthermore, if courts continue to apply the primarily functional standard, then the presumption of validity for design patents will continue to weaken because more design patents will be held invalid. Indeed, as the following sections will illustrate, most courts are applying the primarily functional standard without acknowledging the existence of a solely functional requirement, thereby weakening the presumption of validity as a result. Instead, courts should be applying the solely functional standard because that standard better serves the legislative intent behind the design patent statute.

2. *The Doctrine of Functionality Should Be Stated in Terms of a Solely Functional Standard in Order to Further the Legislative Intent Behind the Design Patent Statute and to Strengthen the Presumption of Validity.*—Binding precedent dictates that the doctrine of functionality should be couched in terms of a solely functional standard, not in terms of a primarily functional standard.<sup>80</sup> As mentioned above, both *Carletti* and *Garbo*, which espouse the solely functional standard, are binding precedent for the Federal Circuit.<sup>81</sup> However, the Federal Circuit has moved away from the solely functional standard of *Carletti* by endorsing the primarily functional standard in *Avia* without explaining why the change was made.<sup>82</sup> Therefore, because the Federal Circuit has not explained why the new standard was adopted, the solely functional standard should remain in force until the Federal Circuit expressly revokes or replaces it.

In addition, by following the solely functional standard instead of the primarily functional standard, the legislative intent behind the design patent statute would be better served. The Congressional purpose in enacting the design patent statute was “to promote the decorative arts and to stimulate the exercise of inventive faculty in improving the appearance of articles of manufacture.”<sup>83</sup> “The principal reason that the system of design patents exists is to promote commerce (i.e., increase sales) in items of manufacture by giving designers of such items an

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76. *Id.*

77. *Motorola, Inc. v. Alexander Mfg. Co.*, 786 F. Supp. 808, 812 (N.D. Iowa 1991).

78. *In re Garbo*, 287 F.2d 192, 194 (C.C.P.A. 1961).

79. *Saidman & Hintz*, *supra* note 38, at 354.

80. *See supra* note 62-74 and accompanying text.

81. *Id.* *See supra* note 11 for a description of the C.C.P.A. and the creation of its successor, the Federal Circuit, in 1982.

82. *See supra* notes 67-71 and accompanying text.

83. *Hueter v. Compco Corp.*, 179 F.2d 416, 417 (7th Cir. 1950) (citations omitted).

incentive to make them more aesthetically appealing to consumers.”<sup>84</sup> As the Supreme Court stated in *Gorham Co. v. White*,<sup>85</sup> “The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge demand for it, and may be a meritorious service to the public.”<sup>86</sup>

The solely functional standard promotes this purpose better than the primarily functional standard because it allows inventors of articles which are mostly functional to nevertheless be rewarded for spending time and money enhancing the ornamental design of the product. For example, designers of electronic circuit boards are primarily concerned with the functional requirements of the circuit boards which they design: the circuit boards must fit into particular slots and must perform specific hardware functions. However, the designers should not be denied design protection just because the potential design is dictated almost entirely by the function. Instead, if a circuit board designer develops a new and original design for a circuit board that provides a more appealing appearance (e.g., that satisfies the matter of concern test, which will be described below), and meets the other requirements for patentability,<sup>87</sup> the design should be worthy of a design patent even though the features of the design are dictated substantially by function. The USPTO has recognized the design patentability of such electronic circuit boards,<sup>88</sup> even though the judiciary has not yet had the opportunity to evaluate the validity of such a patent.

The primarily functional standard, on the other hand, detracts from the legislative intent because it allows courts to reach almost any conclusion which they desire. In the electronic circuit board example above, it would not be surprising for a court to invalidate the design patent under the primarily functional standard because the design is dictated substantially by the shape and size of the slot and the functional hardware specifications of the circuit board. Thus, it appears as though courts can manipulate the primarily functional standard to reach any desired conclusion because the word, primarily, is very flexible. It may be interpreted in any number of different ways given the circumstances and most

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84. *Smith v. M & B Sales & Mfg.*, No. C 89 0293 MHP (WDB), 1990 WL 1112, at \* 2 (N.D. Cal. Jan. 31, 1990) (citing *In re Koehring*, 37 F.2d 421, 422 (C.C.P.A. 1930)). See also *In re Krueger*, 208 F.2d 482, 483 (C.C.P.A. 1953) (“One purpose Congress had in mind in the enactment of the statute authorizing the grant of a patent on any new, original and ornamental design for an article of manufacture was to enhance the salability of such articles in competitive markets through an aesthetic appeal to the purchasing public.”); *Forestek Plating & Mfg. Co. v. Knapp-Monarch Co.*, 106 F.2d 554, 559 (6th Cir. 1939) (stating that Congress intended the enactment of the design patent laws to “encourage ornamentation and beautification in manufactured articles so as to increase their salability and satisfy the aesthetic sense of the purchasers”).

85. 81 U.S. 511 (1871).

86. *Id.* at 525.

87. See *supra* note 34.

88. U.S. Design Patent No. 293,099, Michael H. Fitzpatrick, *Face Plate for an Electronic Circuit Board* (issued Dec. 8, 1987).

articles of manufacture have functional roles.<sup>89</sup> Therefore, the doctrine of functionality should be stated in terms of a solely functional standard in order to promote the legislative intent, to reduce confusion, and to strengthen the presumption of validity for design patents.

3. *Several Cases Have Held Presumptively Valid Design Patents Invalid by Applying the Primarily Functional Standard, but if the Solely Functional Standard Had Been Applied More Design Patents Would Have Been Held Valid.*—Although binding precedent dictates that a solely functional standard should be applied,<sup>90</sup> courts have nevertheless applied the primarily functional standard in a number of cases.<sup>91</sup> Furthermore, in several of these cases, the design patents would have probably been held valid if the solely functional standard had been applied, which would strengthen the presumption of validity.<sup>92</sup>

In *Trimble Products, Inc. v. W. T. Grant Co.*,<sup>93</sup> the Second Circuit affirmed the district court's finding that a design patent for a child's playpen was invalid for reasons of functionality and its failure to meet the test of nonobviousness.<sup>94</sup> The design patent involved "a simple rectangular" playpen,<sup>95</sup> where "[t]he predominant design feature [was] created by the crossed legs which form[ed] a small 'V' on top and a larger inverted 'V' on the bottom on two sides of the crib."<sup>96</sup> Although the court was probably correct in holding the design patent invalid because the design was obvious in light of the prior art,<sup>97</sup> the court would have probably reached an opposite conclusion in regards to functionality if it would had applied the solely functional standard of *Carletti*. Under the solely functional standard, a design is nonfunctional only if "the functional aspect [of the article] could be accomplished in ways other than by the patented design."<sup>98</sup>

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89. See *supra* note 55 and accompanying text.

90. See *supra* note 72 and accompanying text.

91. See, e.g., *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) ("When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose"); *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988) (stating that "if a patented design is 'primarily functional,' rather than primarily ornamental, the patent is invalid").

92. See *infra* text accompanying notes 107-19.

93. 283 F. Supp. 707 (S.D.N.Y. 1968), *aff'd*, 404 F.2d 344 (2d Cir. 1968).

94. *Id.* at 716.

95. *Id.*

96. *Id.* at 714.

97. *Id.* at 716. The court was probably correct in holding this design patent invalid under 35 U.S.C. § 103 for obviousness. Based on the facts of this case, this invention would have been obvious "at the time the invention was made to one skilled in the art to which the subject matter pertains." See *supra* note 30. It is worth noting that "prior art" is a term of art which has been defined as "any material and pertinent information known to the applicant prior to the discovery of the invention." HILDRETH, *supra* note 11, at 159. Thus, "prior art" references can include issued patents (foreign or U.S.), sales brochures, magazine advertisements, etc. . . ., which were published before the claimed invention was made.

98. *Motorola, Inc. v. Alexander Mfg. Co.*, 786 F. Supp. 808, 812 (N.D. Iowa 1991) (quoting

Under this approach, the *Trimble* court would have been compelled to find the playpen design nonfunctional because the court in fact noted that there were different ways that the playpen could have been designed.<sup>99</sup>

In *G.B. Lewis Co. v. Gould Products, Inc.*,<sup>100</sup> affirmed by the Second Circuit, the district court found that a design patent for a plastic storage box was invalid because “[i]ts pure functionality deprives it of patentability.”<sup>101</sup> However, like the court in *Trimble*, this court also noted that the functional aspect of the article could be accomplished in ways other than by the patented design. The court stated that “[w]hile the prior art of other inventors cited in the Patent Office and on the present motion does not precisely anticipate the design of Schanz, the Schanz design does not embody any unobvious ornamental advance over prior art structures.”<sup>102</sup> Therefore, although this patent was probably invalid for reasons of obviousness under § 103, the design patent should not have been held invalid due to functionality because there were other design possibilities to accomplish the same functional aspect of the storage box.

In *Dale Electronics, Inc. v. R.C.L. Electronics, Inc.*,<sup>103</sup> the court determined that a design patent for a resistor housing was invalid because “[i]t was not only the prior art, but the dictates of the manufacturing process that made the design obvious. ‘If the design of the patent is dictated primarily by functional needs the patent is invalid.’”<sup>104</sup> Here, the court is incorrectly combining the functional and nonobvious analyses.<sup>105</sup> Although the court is probably correct in determining that the design for this particular resistor housing was obvious in light of the prior art of record, the court should not have stated that the resistor housing design was dictated by functional considerations. Indeed, the court pointed out that the design was “different to a degree from the other prior art housings,”<sup>106</sup> which indicates that other designs were possible. Like the cases above, this should have required the court to conclude that the design was not functional under the solely functional approach.

In *Eldon Industries, Inc. v. Vanier Manufacturing, Inc.*,<sup>107</sup> the Federal Circuit pointed out that the district court had held a design patent for a soldering iron tip to be valid because “it found that the soldering iron tip was not ‘primarily

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*Avia Group Int'l, Inc. v. L.A. Gear Cal. Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988)).

99. *Trimble*, 283 F. Supp. at 715.

100. 297 F. Supp. 690 (E.D.N.Y. 1968), *aff'd*, 436 F.2d 1176 (2d Cir. 1971).

101. *Id.* at 695.

102. *Id.*

103. 356 F. Supp. 1117 (D.N.H. 1973), *aff'd in part, rev'd in part*, 488 F.2d 382 (1st Cir. 1973).

104. *Id.* at 1132 (citations omitted).

105. *See also* *Pioneer Photo Albums, Inc. v. Holson Co.*, 654 F. Supp. 87, 88-89 (C.D. Cal. 1987) (noting that “the Holson design combines functional elements in a way which, although obvious, had not been done before. Nonetheless, the elements of the design are wholly functional and, therefore, not entitled to patent protection.”).

106. *Dale*, 356 F. Supp. at 1132.

107. No. 90-1117, 1990 WL 172655 (Fed. Cir. Nov. 8, 1990).

functional' because other configurations could have been used in place of the flat surface, semi-circular rear stock, and collar design of the claimed tip."<sup>108</sup> This analysis appears to be perfect (except, of course, "primarily" should read "solely") because the district court properly realized that alternative design possibilities necessarily compel a finding of nonfunctionality.<sup>109</sup> However, the Federal Circuit reversed the district court by stating that although "other configurations for the tip design were possible, we think it is clear that this design had solely functional significance."<sup>110</sup> By the standards developed in this Note, this statement is clearly erroneous. The fact that other designs were possible directly demonstrates that a particular design is not dictated solely by function.<sup>111</sup> Therefore, the Federal Circuit should have affirmed the district court's decision and applauded its analysis, instead of compounding the confusion under the doctrine of functionality and weakening the presumption of validity for design patents.

In *Best Lock Corp. v. Ilco Unican Corp.*,<sup>112</sup> the district court held a design patent for a key blade blank invalid because "[t]he function of the key is to open the lock,"<sup>113</sup> and "[t]he shape of the key end is dictated by the need to make the lock pick proof and by the need to provide methods of key control."<sup>114</sup> The court then stated that "customers do not buy keys and locks based on whether they like the looks of the end of the key."<sup>115</sup> By doing this, the district court confused the doctrine of functionality with the matter of concern doctrine (which will be discussed below). If, however, the court would have applied the solely functional standard which it correctly set forth,<sup>116</sup> the court would have been compelled to find the design patent valid (assuming the matter of concern test was also met) because there are obviously an infinite number of ways that keys can be designed.<sup>117</sup>

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108. *Id.* at \*1.

109. *Id.*

110. *Id.*

111. *See supra* note 78 and accompanying text.

112. 896 F. Supp. 836 (S.D. Ind. 1995), *aff'd* 94 F.3d 1563 (Fed. Cir. 1996).

113. *Id.* at 843.

114. *Id.*

115. *Id.*

116. *Id.* The court correctly stated that a design "is deemed to be functional when the appearance of the claimed design is 'dictated by' the use or purpose of the article," even though the court did not use the solely functional language (quoting *LA. Gear v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993)).

117. Although the majority opinion espoused a solely functional standard by stating that "[a] design is not dictated solely by its function when alternative designs . . . are available," the majority was apparently confused between the business of OEM (Original Equipment Manufacturers), key manufacturers, and replacement key manufacturers. *Best Lock*, 94 F.3d at 1566. The majority stated that because "no other shaped key blade would fit into the corresponding keyway, . . . the claimed key blade design was dictated solely by the key blade's function." *Id.* This may be true for the replacement key manufacturer that is trying to make its key fit into an OEM's keyway because the only way for the replacement key to work with the OEM's keyway is for the

Although the cases above (*Trimble*, *G.B. Lewis*, *Dale Electronics*, *Eldon Industries*, and *Best Lock*) demonstrate that design patents on functional articles are frequently held invalid, many design patents on useful and functional products have been held valid.<sup>118</sup> In the cases which held the design patents valid, the courts did not misapply the doctrine of functionality in a way which rendered the design patents invalid. Instead, the courts reached the proper results which could have been reached by the courts discussed immediately above if the solely functional standard had been applied.

Certainly, application of the solely functional standard would not have validated all of the design patents above because many of the patents were invalid due to obviousness.<sup>119</sup> However, the solely functional standard would have helped to validate some of the patents, such as those in *Eldon* and *Best Lock*, because functionality was the only reason for invalidity in these cases. Therefore, unanimous adoption of the solely functional standard would strengthen the presumption of validity for design patents because fewer design patents would be invalidated under this standard.

### B. *The Matter of Concern Doctrine*

As stated above, design patents only protect ornamental designs for articles of manufacture.<sup>120</sup> Also repeated throughout this Note<sup>121</sup> is the fact that a design must satisfy (1) the doctrine of functionality and (2) the matter of concern doctrine in order to satisfy the ornamental requirement of § 171.<sup>122</sup> This section will focus

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replacement key manufacturer to copy the OEM's design. However, an OEM key designer is not limited to a specific design because the keyway can subsequently be configured to mate with any key that is ornamentally designed. Thus, as Judge Newman rightfully pointed out, because "there are myriad possible designs of key profiles . . . the fact that the key blade is the mate of a keyway does not convert the arbitrary key profile into a primarily functional design." *Id.* at 1569 (Newman, J., dissenting).

118. See *supra* note 58 for a list of valid design patents on useful and functional articles.

119. See *supra* notes 97, 105 and accompanying text.

120. 35 U.S.C. § 171 (1994).

121. This has been repeated throughout this Note because courts continue to intermingle the functionality and matter of concern requirements. See, e.g., *Best Lock*, 896 F. Supp. at 843 (stating within the same paragraph that "[t]he shape of [a] key end is dictated by the need to make the lock pick proof . . . [and] customers do not buy keys and locks based on whether they like the looks of the end of the key"); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (noting that "the primacy of appearance in the design of shoes can not be ignored when analyzing functionality").

122. See *supra* notes 37, 41, and accompanying text. See also *Bonita Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989) ("To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability."); *Evans*, *supra* note 8, at 102 ("Webb does not address the functionality issue. The subject matter of a design patent must still be ornamental. If the subject matter can be shown to be solely functional, the patent is invalid.").



solely on the matter of concern doctrine.

1. *Historical Development of the Matter of Concern Doctrine.*—Unlike the solely functional requirement which is the converse of “ornamentality,”<sup>123</sup> the matter of concern doctrine attempts to define when an article of manufacture is ornamental in appearance.<sup>124</sup> In *Gorham Co. v. White*,<sup>125</sup> the first design patent decision rendered by the Supreme Court, the Court defined ornamental as “that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which gives it form.”<sup>126</sup> Thus, a design patent pertains only to the “visual appearance” of the invention.<sup>127</sup> A design “consists of the visual characteristics or aspects displayed by the object. It is the appearance presented by the object which creates a visual impact upon the mind of the observer.”<sup>128</sup>

Initially, some courts required a certain level of artistic appeal in order to meet the ornamental standard espoused by *Gorham*.<sup>129</sup> However, in the case, *In re Koehring*,<sup>130</sup> the Court of Customs and Patent Appeals rejected that approach by stating that “the beauty and ornamentation requisite in design patents is not confined to such as may be found in the ‘aesthetic or fine arts.’”<sup>131</sup> Courts now recognize that “design patents are concerned with the industrial arts, not the fine arts.”<sup>132</sup> Furthermore, modern courts also recognize that although the ornamentation requirement necessarily involves the visual appearance of the article, the true determinant of ornamentation is whether “at some point in the life of the article an occasion (or occasions) arises when the appearance of the article becomes a ‘matter of concern.’”<sup>133</sup>

In the past, some courts denied design patent protection for certain types of articles because the courts believed the articles were incapable of possessing the

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123. Saidman & Hintz, *supra* note 38, at 352 n.3.

124. See *In re Koehring*, 37 F.2d 421, 423 (C.C.P.A. 1930) (stating the matter of concern test as follows: “Is the ornamentation [of the article] a matter of concern to anybody, reasonably within the purview of the act?”).

125. 81 U.S. 511 (1871) (involving a design patent for a silverware handle which was alleged to be infringed).

126. *Id.* at 525.

127. *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993) (relating to a design patent for a vase).

128. U.S. PATENT & TRADE OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1502 (Rev. 4, 1986).

129. See, e.g., *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 696 (2d Cir. 1961).

130. 37 F.2d 421 (C.C.P.A. 1930).

131. *Id.* at 422. See *supra* note 11 for a description of the C.C.P.A. and the creation of its successor, the Federal Circuit.

132. *Contico Int’l, Inc. v. Rubbermaid Commercial Prods., Inc.*, 665 F.2d 820, 825 (5th Cir. 1981).

133. *In re Webb*, 916 F.2d 1553, 1557 (Fed. Cir. 1990) (relating to a design for a hip stem prosthesis).

requisite ornamentality because their appearance could never be of consequence to anyone.<sup>134</sup> As a result, courts began denying patent protection for those articles which were hidden during their normal and intended use because the design of hidden articles could not be a matter of concern to anyone.<sup>135</sup> In addition, in *Norco Products, Inc. v. Mecca Development, Inc.*,<sup>136</sup> the court invalidated a design patent for an automobile filter under the “hidden in use” doctrine because the “[i]tems are not designed for sale, display, replacement or repair.”<sup>137</sup>

However, the hidden in use test was tacitly overruled by *In re Webb*.<sup>138</sup> In fact, one author devoted an entire article to describing the evolution and rejection of “hidden in use” test after the decision in *Webb*.<sup>139</sup> In *Webb*, a design patent for a hip prosthesis was held *valid* because “features of the device were displayed in advertisements and in displays at trade shows” thereby causing the design to be a matter of concern.<sup>140</sup> As the court pointed out,

the applicant may be able to prove to the PTO that the article’s design is a ‘matter of concern’ because of the nature of its visibility at some point between its manufacture and its ultimate use. Many commercial items, such as colorful and representational vitamin tablets, or caskets, have designs clearly intended to be noticed during the process of sale and equally clearly intended to be completely hidden from view in the final use.<sup>141</sup>

Under *Webb*, the matter of concern inquiry is now defined to begin “after completion of manufacture or assembly and ending with the ultimate destruction,

134. See, e.g., *Williams Calk Co. v. Kemmerer*, 145 F. 928, 929 (3d Cir. 1906) (“It is impossible to suppose that [a horseshoe calk] should be bought or used because of its aesthetic features”); *Bradley v. Eccles*, 126 F. 945, 949 (2d Cir. 1903) (holding a design patent for a washer invalid because “[t]here is not a scintilla of evidence that the sale of a single washer was ever induced by reason of any attractiveness in its appearance”); *Rowe v. Blodgett & Clapp Co.*, 112 F. 61, 62-63 (2d Cir. 1901) (holding that a design patent for a horseshoe calk, a piece of iron or steel “adapted to be applied to the shoe of a horse for use in snow, ice, and mud,” was invalid because there is nothing attractive about the appearance of the calk, and the calk does not “appeal in any way to the eye”); *C & M Fiberglass Septic Tanks, Inc. v. T & N Fiberglass Mfg. Co.*, 214 U.S.P.Q. 159, 160 (D.S.C. 1981) (holding a design patent for a septic tank invalid as a matter of law because a septic tank is “incapable of possessing the requisite ‘ornamentality’ of design because their appearance or beauty can never be of consequence to anyone”).

135. See *In re Stevens*, 173 F.2d 1015 (C.C.P.A. 1949) (holding a design patent for a vacuum cleaner brush invalid because a vacuum cleaner brush “is nearly always concealed in normal and intended use”). See also *McAllister*, *supra* note 11, at 425-49 (describing the “evolution and rejection of the ‘hidden in use’ test”).

136. 617 F. Supp. 1079 (D. Conn. 1985).

137. *Id.* at 1082.

138. 916 F.2d 1553 (Fed. Cir. 1990).

139. *McAllister*, *supra* note 11, at 451.

140. *Webb*, 916 F.2d at 1558.

141. *Id.*

loss or disappearance of the article,"<sup>142</sup> which includes the time period when the article is displayed for sale.

This standard is consistent with the Supreme Court's statements in *Gorham Co. v. White*,<sup>143</sup> which emphasized the commercial objectives of the design patent statute by stating that "[t]he law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge demand for it, and may be a meritorious service to the public."<sup>144</sup> The decision in *Webb* encourages designers of manufactured goods to improve the appearance of the goods and to display and market them in a way that causes them to be a matter of concern to the purchaser. In addition, this standard appears to be taking hold since even the most mundane and ordinary articles are now proper subjects for design patent protection.<sup>145</sup>

One problem under the current matter of concern standard is that future displays for sale do not necessarily protect a design patent from being invalidated. For example, if a new design is invented or discovered, but has not yet been displayed for sale, or has historically been of no concern to any consumer, a court could rule that the design is not a matter of concern because during the current life of the item no one other than the designer has seen the design.<sup>146</sup> Indeed, the fact that the hip prosthesis in *Webb* was displayed in advertisements and displays at trade shows indicates that a design must *currently* be a matter of concern to the purchaser during some point in the product's useful life.<sup>147</sup>

Therefore, the current standard is insufficient because it ignores the dynamics of modern marketing practices which are designed to influence what matters to customers. For example, there was a time when customers did not care about the appearances of athletic shoes, tire treads, or internal computer components. However, commercials depicting Michael Jordan wearing Nike shoes, babies riding on Michelin tires, and Intel computer components making computers come to life have created consumer preferences that were previously nonexistent. In each of these instances, if a design was invented or discovered before the marketing of the item took place (which is usually the case) and a court held the design patent invalid before the inventor was given a chance to market the item, then the designer would lose the fourteen-year<sup>148</sup> market advantage that the design patent was intended to protect. Therefore, the legal standard for the matter of

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142. *Id.*

143. 81 U.S. 511 (1871).

144. *Id.* at 525.

145. *See* cases cited *supra* note 58.

146. *See* *Best Lock Corp. v. Ilco Unican Corp.*, 896 F. Supp. 836, 843 (S.D. Ind. 1995) (holding that a design for a key was not a matter of concern because "witnesses from the lock and key industry testified that customers do not buy keys and locks based on whether they like the looks of the end of the key"). The court did not discuss the possibility of key designs being marketed in the future in a way that creates a customer preference for certain types of key designs.

147. *Webb*, 916 F.2d at 1558.

148. *See* 35 U.S.C. § 173 (1994) (Design patents "shall be granted for the term of fourteen years from the date of grant.").

concern doctrine needs to reflect the fact that consumer preferences are capable of changing in the future.

2. *The Matter of Concern Doctrine Should Be Stated as Follows: If It Is Conceivable That the Design in Question Is or Could Potentially Become a Matter of Concern to Any Customer During the Life of the Design Patent, the Design Should Not Be Invalid Under the Matter of Concern Doctrine.*—One way in which the matter of concern doctrine could reflect the dynamics of changing markets is to broaden the definition of the doctrine to include designs that could conceivably become a matter of concern during the life of the patent. Under this approach, courts would be forced to recognize that even though a newly designed article might not matter to anyone at the present time (because the article, due to its newness, has not been displayed for sale or marketed for general consumption), it might be possible for the design to become a matter of concern under marketing strategies that are prevalent in today's marketplace.

Certainly, this modification of the matter of concern doctrine would significantly limit the number of cases in which courts could determine that a product's design was of no concern to any purchaser. Indeed, it is difficult to imagine an item which is so mundane that it would be impossible to conceive of a marketing technique to create consumer preferences.<sup>149</sup> However, the purpose of the design patent is to encourage designers to make their products more salable.<sup>150</sup> Therefore, if it is at all possible to conceive of a way in which marketing strategies could be used to make an item more appealing to any potential consumer due to the item's design, then the design should be considered a matter of concern. Accordingly, the matter of concern doctrine should be stated as follows: If it is conceivable that the design in question is or could potentially become a matter of concern to any customer during the life of the design patent, then the design should not be invalid under the matter of concern doctrine.

3. *Several Cases Have Held Presumptively Valid Design Patents Invalid Under the Matter of Concern Doctrine, but if the Standard Described Above Were Applied the Presumption of Validity Would Be Strengthened.*—As mentioned above, the current legal standard under the matter of concern doctrine is for a court to inquire whether "at some point in the life of the article an occasion (or occasions) arises when the appearance of the article becomes a 'matter of concern.'"<sup>151</sup> However, courts applying this standard are occasionally reaching conclusions contrary to the purpose behind the design patent statute because these decisions fail to recognize that modern marketing practices could cause an item to become a matter of concern in the future.<sup>152</sup> If, on the other hand, these cases would have applied a standard requiring any conceivable design which could

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149. See cases cited *supra* note 58.

150. See *supra* note 84 and accompanying text.

151. *In re Webb*, 916 F.2d 1553, 1557 (Fed. Cir. 1990) (relating to a design for a hip stem prosthesis).

152. See *supra* note 134 (suggesting that one purpose behind the design patent statute is to enhance the salable value of an article of manufacture). This purpose is frustrated if future sales of an item are limited due to inadequate design patent protection.

potentially become a matter of concern to be valid, then the presumption of validity for design patents could be strengthened and the purpose behind the design patent statute could be followed more faithfully.

In *C & M Fiberglass Septic Tanks, Inc. v. T & N Fiberglass Mfg. Co.*,<sup>153</sup> the court granted a motion for summary judgment to an alleged infringer because the court concluded that the appearance of septic tanks “can never be of consequence to anyone.”<sup>154</sup> However, it seems possible to conceive of a tradeshow display or an advertisement that could potentially create a customer preference for certain septic tanks, thereby allowing the design of a certain septic tank to become a matter of concern. Although the end user, the homeowner, would probably never see the septic tank and would probably consider the design to be of no concern, the actual buyer of the tank from the original manufacturer (e.g., the construction contractor) could certainly be persuaded to buy a given septic tank based on its appearance. If, for example, cost, availability, and function were equal between two septic tank manufacturers, a contractor might potentially make his/her buying decision based on which septic tank had a more appealing appearance. Therefore, under the matter of concern standard suggested above, the presumption of validity could have been strengthened in *C & M Fiberglass* because under that standard, the court would have probably found the design of the septic tank to have the potential of becoming a matter of concern since it is conceivable that the appearance of the septic tank might matter to some purchaser at some point during the fourteen-year life of the design patent.

In *Design, Inc. v. Emerson Co.*,<sup>155</sup> the court held a design patent for an insulated beverage container invalid because the court considered the design not to be a “thing of beauty.”<sup>156</sup> However, this artistic critique appears to be irrelevant because design patents are “concerned with the industrial arts, not the fine arts.”<sup>157</sup> Moreover, it does not seem unreasonable to suggest that even the most mundane beverage insulator could be a matter of concern, especially knowing that design patents have been held valid on a drill bit shank, a paint roller, and a typewriter ribbon cassette.<sup>158</sup> Thus, if the court had applied the “conceivably possible” matter of concern test mentioned above, the court would have probably found that the

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153. 214 U.S.P.Q. 159 (D.S.C. 1981).

154. *Id.* at 160.

155. 319 F. Supp. 8 (S.D. Tex. 1970).

156. *Id.* at 10. The court actually provided an irrelevant artistic critique of the design: The primary feature which is most striking to the casual observer is its featurelessness. Although it is not an object which is displeasing to the eye, it is far from what could be considered a thing of beauty. There is nothing either artistic or aesthetic about it. One who sees it does not take delight in its creation. It is an item which is more likely to be stored in a kitchen closet rather than on display in one's living room. The design embodied in [this] patent is, therefore, not ornamental.

*Id.* at 10-11.

157. *Contico Int'l, Inc. v. Rubbermaid Commercial Prods., Inc.*, 665 F.2d 820, 825 (5th Cir. 1981); see *supra* text accompanying notes 130-33.

158. See *supra* note 58.

design patent met the ornamentality requirements of § 171. Like the septic tank above, it is possible to conceive of a realistic way to market insulated beverage containers to make them a matter of concern. If computer components can be marketed in a way that causes them to become a matter of concern, certainly an insulated beverage container could also be marketed in a way, perhaps even for its lack of ornamentality, that creates consumer demand for the product based on its appearance. This patent would have probably been upheld if the matter of concern standard suggested by this Note had been applied.

In *Best Lock Corp. v. Ilco Unican Corp.*,<sup>159</sup> the court held a design patent for a key invalid because “[s]everal witnesses from the lock and key industry testified that customers do not buy keys and locks based on whether they like the looks of the end of the key.”<sup>160</sup> However, it seems unreasonable to suggest that no purchaser of a key has ever been or will ever be influenced by the appearance of a key. Certainly, if a consumer were choosing between two keys of equal quality and equal price, the consumer would probably consider the keys’ appearances in making a purchasing decision. Therefore, under the standard suggested in this Note, the court should have been able to hold the design patent valid because the design could potentially be a matter of concern to some purchaser at some point in the life of the patent if certain marketing strategies were invoked.

Although the cases above illustrate that design patents are occasionally held invalid when courts determine that the design in question is not a current matter of concern to purchasers, a broader definition of the matter of concern doctrine would produce better results. Because the purpose of the design patent statute is to promote the salability of articles of manufacture,<sup>161</sup> the matter of concern standard should be further developed to allow the life of the design patent<sup>162</sup> to determine if the design has the *potential* for becoming a matter of concern at some point in the future. If it is conceivable that an item is or may become a matter of concern due to existing or potential marketing strategies, the design should be given the benefit of the doubt and remain valid.

Only when there is no way to imagine an article’s design ever becoming a matter of concern during the life of the design patent should a design patent be held invalid under the matter of concern doctrine. Such may have been the case in 1901 and 1906 when two different design patents for horseshoe calks were held invalid because the appearance of a horseshoe calk could not have conceivably mattered to any customer.<sup>163</sup> However, if these design patents were present today, it would not seem unreasonable to suggest that a horseshoe calk (which are pieces of iron or steel applied to the shoe of a horse for use in snow, ice, and mud) might be a matter of concern to some purchaser. Therefore, the modern standard for the

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159. 896 F. Supp. 836 (S.D. Ind. 1995), *aff’d* 94 F.3d 1563 (Fed. Cir. 1996). The federal circuit court did not address the matter of concern issue.

160. *Id.* at 843.

161. *See supra* notes 84-86 and accompanying text.

162. 35 U.S.C. § 173 (1994) (design patent valid for term of 14 years from date patent was granted).

163. *See supra* note 134.

matter of concern doctrine should reflect the fact that marketing strategies are often used to create customer preferences for products which are normally considered mundane.

#### CONCLUSION

The presumption of validity for design patents, although beginning to strengthen, is still too easy to overcome. Supposedly, the presumption of validity for design patents "rests on the legislative recognition of the considerable expertise possessed by the Patent Office and an assumption that the Office properly performs its administrative functions."<sup>164</sup> Thus, the role of the trial court is supposed to be somewhat limited.<sup>165</sup> However, courts have continued to demonstrate that this presumption is not very strong because courts continue to find ways to invalidate a large percentage of litigated design patents.

The continued weakness of the presumption appears to be partially due to the current legal standards under the functionality and the matter of concern doctrines. Courts continue to be confused about the solely/primarily dichotomy surrounding the functionality doctrine, and as a result, a high percentage of design patents are held invalid. Similarly, the narrow scope of the matter of concern doctrine yields a high percentage of design patent invalidity because courts do not necessarily consider marketing strategies which could cause an article to become a matter of concern in the future life of the patent.

The presumption of validity could easily be strengthened by making minor adjustments to the functionality and matter of concern doctrines. First, the presumption could be strengthened by narrowing the doctrine of functionality in a way which is already dictated by binding precedent: the doctrine of functionality should state that a design patent can only be invalidated if there are no other designs that are available to accomplish the same function (e.g., if the design is dictated solely by functional considerations). Second, the presumption of validity could be strengthened by slightly modifying the matter of concern doctrine: the matter of concern doctrine should be broadened such that if it is at all conceivable that a patented item could be marketed in such a way as to cause the design to become a matter of concern, then the design patent should not be invalidated under the matter of concern doctrine.

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164. *Contico Int'l, Inc. v. Rubbermaid Commercial Prods., Inc.*, 665 F.2d 820, 822-23 (8th Cir. 1981).

165. *Id.* at 822.

