A WELCOME LIMIT ON DESIGN PATENT PROTECTION: CURVER LUXEMBOURG, SARL V. HOME EXPRESSIONS

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Abstract: In 2019, the United States Court of Appeals for the Federal Circuit addressed the scope of design patent law in Curver Luxembourg, SARL v. Home Expressions. The court held that a design patent must be limited to a particular article of manufacture. As such, claim language may be used to limit the scope of a design patent to a particular article of manufacture if an article is not specified in the claim’s figures. Although the court’s failure to define an article of manufacture may result in some difficulties with Curver’s application, the court’s decision is consistent with the purpose of design patent law and necessarily limits the scope of design patent protection.

INTRODUCTION

Intellectual property is an intangible creation with commercial value. Intellectual property law is concerned with protecting intangible creations and does so in different ways depending on the defining characteristics of the creation. Design patents protect designs for the configurations of useful articles, which are products that can be used, not just admired or observed. Many of us use the word “design” conversationally to describe a broad spectrum of concepts, from the shape of a ceramic vase to the blueprint for a new home. Nevertheless, more formally, design refers to the world of large-scale manufacturing. Thus, design patent law is less about art and more about industrial design. Design patents offer protection for ornamental features of articles of manufacture. Ornamental features like color, shape, and pattern affect the way an article looks.

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3 Id. at 461.
4 Sarah Burstein, The Patented Design, 83 TENN. L. REV. 161, 168 (2015) (“A ‘useful article’ is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”).
5 Id. at 167.
6 Id. at 168.
7 Id.
8 McKenna & Sprigman, supra note 2, at 516.
9 Id. at 517.
It is often difficult to distinguish a design patent from a utility patent. A utility patent is the most commonly issued patent. It offers protection for any new and useful innovation, whether that innovation be a process or manufactured product. Although it is concerned with use rather than appearance, it is often difficult to separate the two because ornamental features can often be described in functional terms. For this reason, intellectual property law focuses on the defining characteristics of the creation. Although utility and design patents have shared requirements, they also each have unique requirements, different tests for infringement, and distinct purposes. Additionally, the application of designs to useful articles has raised questions about the scope of design patents, specifically, whether one design patent can apply to different types of articles. The United States Court of Appeals for the Federal Circuit answered this question in 2019 in Curver Luxembourg, SARL v. Home Expressions.

Part I of this Article addresses the similarities and differences between utility patents and design patents to provide context for the court’s decision in Curver. It looks at the requirements for these two areas of patent law, along with their respective purposes and tests for infringement. Part II provides an overview of Curver and how it has limited the scope of design patent protection. Part III discusses the likely effects of the Curver decision and addresses potential problems

10 Id.
12 McKenna & Sprigman, supra note 2, at 500.
13 Id. at 517 (“Design cannot categorically be excluded from utility patent because design features sometimes can be described in functional terms – when, for example, the shape of a machine affects its speed.”). Functional terms are typically used to describe the operations of an invention. See id. at 524 (noting that most courts interpret functionality as describing features that are useful).
14 Id. at 516–17.
15 Id. at 461.
17 Id.
18 See Burstein, supra note 4, at 166 (explaining the importance of understanding the nuances of design patent law to determine what it protects); McKenna & Sprigman, supra note 2, at 491–92 (explaining that there are significant differences between the different types of patent law).
19 McKenna & Sprigman, supra note 2, at 516 (introducing the differences between utility and design patents).
20 See Curver, 938 F.3d at 1340 (holding that design patents only afford protection to the design as applied to a particular article of manufacture).
with its application.\textsuperscript{21} Finally, Part IV argues that the court’s decision in \textit{Curver} is consistent with the primary purpose of design patents.\textsuperscript{22}

I. AN OVERVIEW OF DESIGN AND UTILITY PATENTS

To interpret the court’s decision in \textit{Curver}, it is helpful to have an understanding of what a design patent is and how it is both similar to and different from the more familiar utility patent.\textsuperscript{23} The most notable similarities and differences involve the requirements for each, their respective tests for infringement, and their respective purposes.\textsuperscript{24} First, Section A will explain the similarities and differences in the requirements for utility and design patents.\textsuperscript{25} Second, Section B will discuss utility and design patents’ respective tests for infringement and their distinct purposes.\textsuperscript{26}

A. Similarities and Differences in the Requirements for Utility and Design Patents

There are many similarities in the requirements for utility and design patents.\textsuperscript{27} The Patent Act states that “the provisions of the title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”\textsuperscript{28} Thus, utility and design patent law both require claimed creations to be novel and nonobvious.\textsuperscript{29} To meet the novelty requirement, the creation or invention must be


\textsuperscript{22} See \textit{Curver}, 938 F.3d at 1340 (holding that design patents are limited by claim language when no article of manufacture is provided in the claim’s figures); Burstein, \textit{supra} note 4, at 165 (arguing that design patents should be limited to a specific type of product).

\textsuperscript{23} See McKenna & Sprigman, \textit{supra} note 2, at 492 (explaining that every other area of intellectual property understands its boundaries in negative relation to the utility patent).

\textsuperscript{24} See \textit{id.} at 491 (noting that each regime of intellectual property has its own requirements and tests for infringement).

\textsuperscript{25} See 35 U.S.C. § 171 (1952) (explaining that many of the requirements for utility patents also apply to design patents); McKenna & Sprigman, \textit{supra} note 2, at 491 (highlighting that utility and design patents have different requirements).

\textsuperscript{26} See Gorham Co. v. White, 81 U.S. 511, 528 (1871) (explaining that the unique purpose of design patents calls for a unique test for infringement).

\textsuperscript{27} See 35 U.S.C. § 171 (stating that the requirements for utility patents also apply to design patents).

\textsuperscript{28} Id.

\textsuperscript{29} McKenna & Sprigman, \textit{supra} note 2, at 498.
new.\textsuperscript{30} The doctrine of anticipation guides the determination of whether the novelty requirement is met.\textsuperscript{31} A claimed invention is not considered new if it is identical to something that exists in the prior art.\textsuperscript{32} If comparing the claimed invention with the prior art reveals that each and every element in the claim shows, organizes, and functions in substantially the same manner as in the prior art referenced, then the claim is said to be anticipated.\textsuperscript{33} When a claimed invention is anticipated, it infringes a patent already issued that claims the same subject matter.\textsuperscript{34} Thus, the anticipated claimed invention is unpatentable.\textsuperscript{35}

Even if the novelty requirement is met, the invention must satisfy the nonobviousness requirement.\textsuperscript{36} Whereas the novelty requirement ensures that the invention is new by comparing it to the prior art, the nonobviousness requirement ensures that the invention is different enough from a previously patented process or design so that consumers will recognize it as new.\textsuperscript{37} To satisfy the nonobviousness requirement, the invention must be different such that the ordinary person would recognize it as an invention and not just the prior art packaged in a different way.\textsuperscript{38}

The key difference then between the requirements for utility and design patents is that whereas a utility patent has a utility requirement, a design patent has an ornamentation requirement.\textsuperscript{39} An invention must satisfy the utility requirement to qualify for a utility patent.\textsuperscript{40} Under the Patent Act, a utility patent can protect several different types of inventions, from a new process to a new machine.\textsuperscript{41} Although the purpose of the statute is to include a wide variety of inventions, the possibilities are not endless.\textsuperscript{42} Scholars share an understanding that patent law focuses on a particular kind of utility—namely, one that is technological.\textsuperscript{43} Thus, an invention must be explained in terms of scientific or engineering principles to satisfy the utility requirement.\textsuperscript{44}

Whereas the utility requirement is unique to utility patents, the ornamentation requirement is unique to design patents.\textsuperscript{45} Courts have understood ornamental to be the opposite of functional.\textsuperscript{46} Design patents can be obtained for

\begin{itemize}
\item \textsuperscript{31} \textit{Id.}
\item \textsuperscript{32} \textit{Id.} Prior art includes information and knowledge provided in applications for previously patented inventions. \textit{Art}, BLACK’S LAW DICTIONARY (11th ed. 2019).
\item \textsuperscript{33} Quinn, \textit{supra} note 30.
\item \textsuperscript{34} \textit{Id.}
\item \textsuperscript{35} \textit{Id.}
\item \textsuperscript{36} McKenna & Sprigman, \textit{supra} note 2, at 506.
\item \textsuperscript{37} \textit{Id.}; Quinn, \textit{supra} note 30.
\item \textsuperscript{38} McKenna & Sprigman, \textit{supra} note 2, at 507.
\item \textsuperscript{39} \textit{Id.} at 500, 516.
\item \textsuperscript{40} \textit{Id.} at 500.
\item \textsuperscript{41} \textit{Id.}; see also Patent Act, BLACK’S LAW DICTIONARY (11th ed. 2019) (“The current federal statute governing patent registrations and rights.”).
\item \textsuperscript{42} McKenna & Sprigman, \textit{supra} note 2, at 500.
\item \textsuperscript{43} \textit{Id.} at 501.
\item \textsuperscript{44} \textit{Id.} at 502.
\item \textsuperscript{45} \textit{Id.} at 516.
\item \textsuperscript{46} \textit{Id.}
\end{itemize}
three kinds of designs: “(1) a design for ornament, impression, print, or picture applied to or embodied in an article of manufacture; (2) a design for the shape or configuration of an article of manufacture; or (3) a combination of the first two categories.”  

Although ornamental features like shape and configuration may impact function, courts have recognized these features as ornamental if their primary purpose is to make the product look more appealing. Thus, the primary purpose of an invention must be aesthetic to satisfy the ornamentation requirement of a design patent.

B. Utility and Design Patents’ Respective Tests for Infringement and Purposes

Although utility and design patents overlap in their requirements for patentability, their tests for infringement and purposes are quite different. A utility patent is infringed when a patented “process, machine, manufacture, or composition of matter, or improvement thereof” is made, used, sold, offered to be sold, or imported. In contrast, a design patent is infringed when a patented design, rather than a patented machine or manufacture, is made, used, sold, offered to be sold, or imported. Making, selling, or importing is the process by which infringement occurs, and although this process is the same for both utility and design patents, the invention being infringed upon is different. This difference in subject matter is reflected in utility and design patents’ respective tests for infringement


There is a two-step process used to determine utility patent infringement. First, the court must interpret or construe the utility patent claim. The court construes a utility patent claim by looking to the claim language—or, the written description of the invention—and the prosecution history if it is available. Second, the court must compare the allegedly infringing process, machine, or manufactured product with the construed claim. Based on this comparison, the court decides
whether the accused process or manufactured product infringes the utility patent either literally or under the doctrine of equivalents.\textsuperscript{59}

2. Design Patent Infringement: Design per se or Design as Applied

The test used to determine design patent infringement is different in that its focus is on consumers’ understanding of the invention or lack thereof, rather than the invention itself.\textsuperscript{60} To prevail on a claim for design patent infringement, the patentee must establish that an ordinary observer, familiar with the prior art designs, would mistake the accused product for the patented design.\textsuperscript{61} The court puts itself in the shoes of the ordinary observer to determine not whether the accused design is exactly the same as the patented one, but rather whether the accused design would be understood as the same by the average consumer.\textsuperscript{62}

The ordinary observer test came out of the Supreme Court’s decision in 1871 in \textit{Gorham Co. v. White}.\textsuperscript{63} More than one hundred years later in 2008, the United States Court of Appeals for the Federal Circuit held that the ordinary observer test is the only test necessary to determine design patent infringement in \textit{Egyptian Goddess, Inc. v. Swisa, Inc.}.\textsuperscript{64} In \textit{Gorham}, the question before the Court was whether there was infringement.\textsuperscript{65} “There, the plaintiff argued that the defendant had infringed upon its design patent for the handles of spoons and forks.”\textsuperscript{66} The Court held that if the average consumer understands two designs to be the same and would mistake one for the other, then whichever one of those designs is patented is infringed upon.\textsuperscript{67} The \textit{Gorham} test did not define “design” as “design per se” or “design as applied.”\textsuperscript{68} A design per se is a surface ornamentation that can be applied to anything.\textsuperscript{69} A design as applied is a surface ornamentation for a particular article of manufacture.\textsuperscript{70} In \textit{Gorham}, even if the court defined design as applied to a particular article of manufacture, the plaintiff and defendant applied the design to

\textsuperscript{59} \textit{Id.} at 906. Literal infringement occurs when the accused product or process contains each and every element and limitation of a patent claim. \textit{Infringement}, BLACK’S LAW DICTIONARY (11th ed. 2019). Infringement under the doctrine of equivalents occurs when the accused product or process contains elements that are identical to each claimed element of the patented invention notwithstanding trivial differences. \textit{Doctrine of Equivalents}, BLACK’S LAW DICTIONARY (11th ed. 2019).

\textsuperscript{60} \textit{Gorham}, 81 U.S. 511 at 528.

\textsuperscript{61} \textit{Id.}

\textsuperscript{62} \textit{Id.}

\textsuperscript{63} \textit{Id.}

\textsuperscript{64} \textit{Egyptian Goddess, Inc. v. Swisa, Inc.}, 543 F.3d 665, 678 (Fed. Cir. 2008).

\textsuperscript{65} Burstein, \textit{supra} note 4, at 176–77.

\textsuperscript{66} \textit{Id.} at 176.

\textsuperscript{67} \textit{Gorham}, 81 U.S. at 528.

\textsuperscript{68} Burstein, \textit{supra} note 4, at 178.

\textsuperscript{69} See \textit{Curver}, 938 F.3d at 1339 (noting that the law does not permit design per se patents “such that the patent’s scope encompasses every possible article of manufacture to which the surface ornamentation is applied”).

\textsuperscript{70} See \textit{id.} at 1340 (noting that design patents are only permitted for designs as applied to a particular article of manufacture).
the same articles of manufacture, namely, forks and spoons, so the distinction between the two would not have made a difference.\textsuperscript{71}

In contrast, in cases where the same design was applied to different articles of manufacture, the distinction between design per se and design as applied made all the difference in determining infringement.\textsuperscript{72} Although the relevant case law did not explicitly define design, it has provided some clues.\textsuperscript{73} In 1998, the United States Court for the Northern District of California suggested that the proper interpretation of design is as applied to a particular article of manufacture in \textit{Vigil v. Walt Disney Co.}\textsuperscript{74} There, Vigil, the plaintiff, alleged that Disney, the defendant, infringed his design patent for a novelty duck call in the shape of a hockey stick.\textsuperscript{75} The accused product was a key chain in the shape of a hockey stick.\textsuperscript{76} The court dismissed the claim, holding that “plaintiff’s hockey stick duck call is not substantially the same as Disney’s hockey stick key chain.”\textsuperscript{77} The court highlighted that the duck call and keychain were different types of articles of manufacture, but it did not provide additional explanation as to why this was important.\textsuperscript{78} Nevertheless, it can be inferred that the court’s decision was based on an understanding of design as applied to a particular article of manufacture.\textsuperscript{79}

Similarly, in 2003, the United States District Court for the Eastern District of Michigan suggested that the proper interpretation of design is design as applied in \textit{Kellman v. Coca-Cola Co.}\textsuperscript{80} In \textit{Kellman}, the court held that the plaintiff’s design patent for a novelty foam hat in the shape of a wing nut was not infringed upon by the defendants’ bottles of soda with the design of the hat printed on the caps.\textsuperscript{81} Coca-Cola argued that the plaintiff’s claim did not withstand the ordinary observer test because average consumers “could not possibly be deceived into purchasing . . . [Coca-Cola’s] bottlecaps . . . thinking they were buying a hat.”\textsuperscript{82} Coca-Cola’s argument turned on the fact that the articles of manufacture were entirely different in that bottlecaps are not at all similar in appearance to foam wing nut hats.\textsuperscript{83} The court agreed with the defendant and held that the design as applied to the hat and as applied to the bottle caps was not “substantially similar as to cause confusion.”\textsuperscript{84} Once again, although the court did not provide additional explanation for the noted

\textsuperscript{71} Burstein, supra note 4, at 178.
\textsuperscript{73} Burstein, supra note 4, at 178.
\textsuperscript{74} \textit{Vigil}, 1998 U.S. Dist. LEXIS 22853, at *1.
\textsuperscript{75} Id.
\textsuperscript{76} Id.
\textsuperscript{77} Burstein, supra note 4, at 187–88.
\textsuperscript{78} Id.
\textsuperscript{79} See Vigil, 1998 U.S. Dist. LEXIS 22853, at *1 (concluding that a design as applied to a key chain did not infringe the same patented design as applied to a duck call).
\textsuperscript{80} Kellman, 280 F. Supp. 2d at 679–80.
\textsuperscript{81} Id.
\textsuperscript{82} Id. at 679.
\textsuperscript{83} Id.
\textsuperscript{84} Id. at 680.
significance of different types of articles of manufacture, it can be inferred that the court’s decision was based on an understanding of design as applied to a particular article of manufacture.85

3. How the Purpose of the Patent Shapes Its Legal Test

It can be inferred from cases like Vigil and Kellman that the courts’ understanding of design is based on the purpose of design patents, namely, preventing consumer confusion.86 Utility and design patents differ in their purposes.87 The purpose of a utility patent is to prevent competitors from making, using, and selling the claimant’s invention, whereas the purpose of a design patent is to prevent competitors from benefitting from consumer confusion.88 By using a well-known brand’s design, a company making a lower quality product that costs less to produce is able to steal consumers of that well-known brand and profit from the confusion they create.89 Consumers do not purchase the accused product because of its function, but because of the way it looks.90 Therefore, the essential problem that a design patent must address is the ability of a competitor to profit from consumer confusion.91

Consumer confusion does not really matter when it comes to utility patents because consumers are typically willing to buy a product no matter what brand it is or what it looks like so long as it works the same.92 Consumers purchase a competitor’s product because of the similar function of the product, not because of confusion resulting from the way a product looks.93 Therefore, the essential problem that a utility patent must address is the ability of a competitor to steal the inventor’s creation and profit from how it works.94 Consumer confusion is much more important when it comes to design patents because consumers may buy a product that they do not intend to if it looks like a product that they know and trust.95 Consumers often rely on the unique design of a product, whether that be its color or shape or some other ornamental feature, to quickly find what they are looking for.96 The differences between the tests for infringement illustrate these different purposes.97 The ordinary observer is central to the test for design patent protection.

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85 See id. (concluding that defendant’s use of plaintiff’s patented design was not infringement because defendant applied the design to a different article of manufacture).
86 See Gorham, 81 U.S. at 525–27 (explaining that the purpose of design patents is to prevent consumer confusion).
87 Gorham, 81 U.S. at 528; McKenna & Sprigman, supra note 2, at 503–04.
88 Gorham, 81 U.S. at 528; McKenna & Sprigman, supra note 2, at 503–04.
89 Gorham, 81 U.S. at 528.
90 Id.
91 Id.
92 McKenna & Sprigman, supra note 2, at 502.
93 Id.
94 Id. at 503–04.
95 Gorham, 81 U.S. at 528.
96 Id.
97 See id. (explaining that the ordinary observer test for design patent infringement serves the purpose of design patent law).
because the purpose of a design patent is to protect against competitors benefitting from the average consumer’s confusion resulting from a similar design.\textsuperscript{98}

**II. LIMITING THE SCOPE OF DESIGN PATENT PROTECTION: CURVER LUXEMBURG, SARL v. HOME EXPRESSIONS**

The scope of design patent protection has been unclear.\textsuperscript{99} Specifically, it has been unclear what “article of manufacture” means.\textsuperscript{100} On September 12, 2019, in *Curver Luxemburg SARL v. Home Expressions*, the United States Court of Appeals for the Federal Circuit answered this question in a case of first impression.\textsuperscript{101} First, Section A will provide an overview of the court’s decision in *Curver*.\textsuperscript{102} Second, Section B will discuss how the court responded to arguments in favor of expansive design patent protection.\textsuperscript{103}

**A. Curver Luxemburg SARL v. Home Expressions**

Curver sued Home Expressions for using a design that Curver held a patent for.\textsuperscript{104} Curver’s patent was for the design as applied to a chair.\textsuperscript{105} Thus, the chair was the article of manufacture.\textsuperscript{106} When Home Expressions used the design on a basket and sold it, Curver sued for design patent infringement.\textsuperscript{107}

There were two questions that the Federal Circuit had to address.\textsuperscript{108} First, the court had to decide “whether the District Court correctly construed the scope of the design patent as limited to the illustrated pattern applied to a chair, or whether the design patent cover[ed] any article, chair or not, with the surface ornamentation applied to it.”\textsuperscript{109} Second, the court had to address “whether claim language specifying an article of manufacture can limit the scope of a design patent, even if that article of manufacture is not actually illustrated in the figures.”\textsuperscript{110} Design patents are unique in that they have traditionally relied on figures and illustrations to identify an article of manufacture to limit the scope of the patent rather than claim language.\textsuperscript{111} As such, when there was no article of manufacture indicated in the figure of Curver’s patent, the court had to address whether it could turn to the claim language to find a limit on the scope of the patent’s protection.\textsuperscript{112}

\textsuperscript{98} *Id.*

\textsuperscript{99} *Curver*, 938 F.3d at 1336.

\textsuperscript{100} See *id.* at 1341 (discussing the article of manufacture requirement without defining it).

\textsuperscript{101} *Id.* at 1339.

\textsuperscript{102} See *id.* at 1340 (concluding that design patent protection is limited to a particular article of manufacture).

\textsuperscript{103} See *id.* at 1342–43 (responding to Curver’s arguments in favor of a broader interpretation of design patent protection).

\textsuperscript{104} *Id.* at 1336.

\textsuperscript{105} *Id.*

\textsuperscript{106} *Id.* at 1337.

\textsuperscript{107} *Id.* at 1336.

\textsuperscript{108} *Id.*

\textsuperscript{109} *Id.*

\textsuperscript{110} *Id.*

\textsuperscript{111} *Id.* at 1339.

\textsuperscript{112} *Id.*
The Federal Circuit affirmed the district court’s finding that the claim language “ornamental design for a pattern for a chair” limited the scope of the claimed design to its use on chairs. In so doing, the court held that claim language can limit the scope of a design where the claim language supplies the only instance of an article of manufacture even if it does not appear in the figures. The court explained that the law has never sanctioned granting a design patent for a design alone such that it could be applied to every possible article of manufacture. Design patents only protect designs as they are applied to articles of manufacture. In its decision, the court finally defined design as applied to a single type of article of manufacture. In support of its interpretation, the court explained that long-standing precedent, unchallenged regulations, and agency practices are all evidence that design patents are granted only for a design applied to an article of manufacture, and not a design per se.

**B. The Court’s Rejection of Greater Design Patent Protection**

The court rejected three arguments based on its interpretation of design as applied and consistent with the purpose of design patents. First, the Court rejected the argument that when determining the scope of the patent, the district court improperly relied on claim language reciting a “pattern for a chair,” rather than focusing on the figures, which contain no chair illustrations. In rejecting this argument, the Federal Circuit pointed out that the figures failed to illustrate any particular article of manufacture. As such, Curver’s argument effectively collapsed to a request for a design patent to be used on any article of manufacture. Curver tried to protect its design alone, rather than its design as applied to an article of manufacture and this is not allowed. The court conceded that it typically tries to rely on figures to define the scope of a design patent. Nevertheless, it held that when the figures do not provide an accompanying article of manufacture, as was the case here, it must turn to the design patent’s text for guidance.

Second, the court explained that Curver never had a claim to a broader scope than a “pattern for a chair.” Curver attempted to argue that because the examiner allowed the originally filed claim reciting a “design for a furniture part” before Curver was required to amend the claim to recite a “pattern for a chair,” it never

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113 Id. at 1336.
114 Id. at 1340.
115 Id. at 1339.
116 Id. at 1340.
117 Id.
118 Id.
119 Id. at 1339, 1341–43.
120 Id. at 1339.
121 Id.
122 Id.
123 Id.
124 Id. at 1341.
125 Id.
126 Id.
surrendered the broader scope encompassed by the original claim. In response, the court highlighted that the examiner ultimately required Curver to amend the claim to be limited to the “pattern for a chair” because a design patent requires the designation of a particular article of manufacture. In other words, the patent would not have been allowed if it had not been amended and thus, Curver never had a claim to broader scope.

Finally, the court rejected the notion that any dicta from earlier cases bound it to decide an alternative way. Curver argued that the United States Court of Customs and Patent Appeals’ 1956 decision in In re Glavas suggested that a design for an article of manufacture can be anticipated by a prior art article that shares the same design, even though the prior art article is completely unrelated. Curver sought to extend the asserted anticipation rationale from Glavas to infringement because the Federal Circuit has historically used the same test to determine anticipation and infringement. The court rejected this argument and explained that the statement about anticipation in Glavas was dictum and thus not binding. Moreover, the court concluded that Glavas did not go as far as Curver would have liked. In Glavas, the Court of Customs and Patent Appeals stated that articles might have different uses, but share “substantially the same appearance.” In Curver, however, all parties agreed that the basket and chair were not substantially similar in appearance. Furthermore, even if the dictum of Glavas permitted a patented design to be anticipated by the same design applied to a distinctly different article of manufacture, that dictum is subject to the decision in Egyptian Goddess, where the Federal Circuit held that the ordinary observer test is the sole test to determine design patent infringement.

III. CURVER’S IMPACT ON DESIGN PATENT LAW AND ISSUES WITH ITS APPLICABILITY

In 2019, the United States Court of Appeals for the Federal Circuit clarified the scope of design patent protection in Curver Luxemburg SARL v. Home Expressions, but there are several remaining questions about the effects of the decision and how it will be applied. Curver is likely to be a tool for those seeking

127 Id.; see also Patent-Application Amendment, BLACK’S LAW DICTIONARY (11th ed. 2019) (“A modification to a patent application, usually to narrowing or eliminating some claims in response to an examiner’s rejection.”).
128 Curver, 938 F.3d at 1342.
129 Id.
130 Id. at 1342–43.
131 Id.
132 Id.
133 Id.
134 Id.
135 Id. at 1342; In re Glavas, 230 F.2d 447, 450 (C.C.P.A. 1956).
136 Compare Curver, 938 F.3d at 1343 (involving a chair and a basket not substantially similar in appearance), with In re Glavas, 230 F.2d at 448 (involving a design patent application for a swimming float that looked substantially similar to a previously patented swimming float).
137 Curver, 938 F.3d at 1343; Egyptian Goddess, 543 F.3d at 678.
138 Jordahl, supra note 21.
design patents for non-analogous art and an obstacle for those seeking greater design patent protection. The Federal Circuit did not clarify how narrowly tailored claim titles must be or what constitutes an article of manufacture. The resulting confusion may make it difficult for those looking to adhere to Curver in the future.

Section A will first discuss the likely effects of Curver. More specifically, it will look at the impact this decision is likely to have on those looking to acquire design patents and those seeking greater protection under existing design patents. Then, Section B will discuss the challenges in applying Curver, specifically the confusion that remains over the level of detail needed in a design patent claim title and what constitutes an article of manufacture.

A. Likely Effects of Curver

Despite the newness of the Curver decision, predictions can be made about its likely effects. The most likely effect of this case is that it will limit the scope of protection obtainable for design patent holders. Section 102 of the Patent Act addresses the conditions for patentability, including the novelty requirement required by the doctrine of anticipation. For those seeking limits on design patent protection, specifically, those who have faced § 102 rejections over non-analogous art in design cases, Curver should prove useful.

To determine whether a design as applied is analogous or non-analogous, the question is whether the articles are “so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” In Curver, the Federal Circuit reaffirmed that the ordinary observer test is the sole controlling test for determining anticipation of design patents as well as infringement, and that under the ordinary observer test, non-analogous art is likely permissible. Curver, and presumably others, interpreted the dictum in Glavas as suggesting that the design for an article of manufacture can be anticipated by a prior art article that shares the same design,
even though the prior art article is completely unrelated.152 Prior to Curver, it seems this rationale may have been used to reject patents for non-analogous art.153 As such, the court’s rejection of this rationale in Curver should help those seeking patents for non-analogous art.154

On the other hand, those seeking more protection from a design patent may face new obstacles as a result of Curver.155 In Curver, the Federal Circuit held that claim language, including the title of the patent claim, can be used to limit the scope of the design patent when there is no article of manufacture in the figures.156 One approach to this is to adopt a broad title in the absence of an illustrated article of manufacture, however, an amendment will likely be required, as it was in Curver’s case.157 Another approach is to adopt more specific titles listing more articles of manufacture.158 For example, Curver could have tried to title its claim “Pattern for a Chair or Basket.”159 The outcome of this approach is uncertain and if used in excess could be subject to some sort of limitation.160 In either situation, there is the possibility that the claimant could pursue each article of manufacture as a separate patent.161

B. Challenges in Applying Curver

Curver’s application may come with some complications, specifically in regards to what constitutes an article of manufacture.162 Prior to Curver, some suggested that a design for an article refers to merely a design that is capable of being applied to one or more articles, not a design that is specifically for or limited to a particular article.163 Under this view, the requirement that a claim includes an article of manufacture could be viewed as a mere formality, demonstrating a design’s potential rather than limiting the scope of a claim.164 The court’s decision in Curver, however, seems to reject this understanding of the United States Patent and Trademark Office’s (USPTO) requirement to identify a particular article as a mere formality.165 Nevertheless, confusion results because it does not actually answer the question of what it means to be a design for an article of manufacture.166

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152 Id. at 1342.
153 See, e.g., Jordahl, supra note 21 (noting that a § 102 rejection over non-analogous art is a problem that design patent applicants face).
154 Id.
155 Id.
156 Curver, 938 F.3d at 1340.
158 Id.
159 Id.
160 Id.
161 Id.
162 Crouch, supra note 21.
163 Id.
164 Id.
165 Id.
166 Id.
Although the USPTO requires a design patent applicant to identify a particular article in the title of the design, it also instructs examiners to “afford the applicant substantial latitude in the language of the title/claim” because “the claim defines ‘the subject matter which the inventor regards as the invention’” under 35 U.S.C. § 112.¹⁶² These seemingly contradictory instructions result in confusion over how specific applicants need to be in the title of the claim.¹⁶³ The court’s decision in Curver does little to alleviate this confusion because it creates incentives for applicants to seek broader titles, but in doing so, the applicant risks it being deemed too vague by an examiner, just as Curver did, without knowing what “too vague” really means.¹⁶⁴ The examiner required Curver to amend its application because “furniture” was too broad to be an article of manufacture, but the court did not specify what too broad meant.¹⁶⁵ The court did not clarify whether Curver’s article of manufacture needed to be stated as “a chair,” or if it could have been stated more broadly as “seating.”¹⁶⁶ The level of specificity remains unclear and without setting clear rules about how specific article identifications need to be, future applicants will have every incentive to push back on these types of examiner rejections.¹⁶⁷ The USPTO will likely have to revisit this issue as a result.¹⁶⁸

Beyond what is necessary for the title of the claim, there is confusion as to what actually constitutes an article of manufacture.¹⁶⁹ Even though Curver defines design as applied to an article of manufacture, the relevant case law has not set forth a clear test to determine what qualifies as an article of manufacture.¹⁷⁰ For example, in 2016, in Samsung Electronics Co. v. Apple Inc., the Supreme Court answered the question of whether an article of manufacture is the article in its entirety or whether it can be broken down into its components for the purpose of awarding damages for infringement, but did not provide guidance beyond that.¹⁷¹ Justice Sonia Sotomayor explained that it is difficult to identify “the article of manufacture in the case of a design for a multicomponent product, such as a kitchen oven.”¹⁷² In Samsung, a case involving the infringement of designs for smart phones, the Court held that “the relevant ‘article of manufacture’ need not be the end product sold to the consumer but may be only a component of that product.”¹⁷³ Although this decision may seem inconsistent with the policy of design patents, namely, preventing consumer confusion over two similar looking end products, it actually

¹⁶³ Crouch, supra note 21.
¹⁶⁴ Id.
¹⁶⁵ Curver, 938 F.3d at 1337.
¹⁶⁶ Id.
¹⁶⁷ Crouch, supra note 21.
¹⁶⁸ Id.
¹⁶⁹ See Samsung Electronics Co., Ltd. v. Apple Inc., 137 S. Ct. 429, 432 (2016) (explaining that it can be difficult to identify an article of manufacture).
¹⁷⁰ Rao, supra note 21.
¹⁷¹ Samsung Electronics Co., 137 S. Ct. at 432.
¹⁷² Id.
¹⁷³ Id. at 431.
went a step further to prevent this problem. The decision ensured that consumers will not be confused by a signature component and mistakenly purchase the end product believing it is from the brand known for that component. Although it is consistent with the policy of design patents, the decision provided no clarification or test to determine what a relevant article of manufacture is. Without a clear test, the broad and vague terminology used in the relevant regulations and statutes will remain difficult for juries to interpret and may lead to both unpredictability and a lack of confidence in those acquiring design patents. As a result, innovators may be reluctant to put new products on the market.

IV. THE CASE FOR CURVER & THE BOUNDARIES OF DESIGN PATENT LAW

Despite issues that may arise in its application, the Federal Circuit’s decision in Curver is consistent with the primary purpose of design patents—namely, to prevent competitors from benefitting from consumer confusion. When consumers are misled by the design of an article and proceed to purchase it because they think the company who has earned their loyalty and whose design they think they recognize produced it, “the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed.” Design patents should offer sufficient protection to those who hold them, but should not be so broad as to make the system inefficient and discourage innovation. After Curver, questions may remain as to how to define an article of manufacture, but the boundaries of design patent law have become much clearer and the limits Curver introduced on design patent protection were necessary.

This Part will discuss the inner and outer boundaries that exist on design patent law. The inner boundary was set long ago by the ordinary observer test.

179 See id. at 436 (holding that a single component of a smartphone may be considered an article of manufacture because the term is broad enough to encompass both the end product and its components).
180 See id. (holding that an individual component of a multicomponent product qualifies as an article of manufacture).
181 Rao, supra note 21.
182 Id.
183 Id.
184 See Gorham, 81 U.S. at 528 (noting that design patents prevent competitors from making similar looking products to profit from consumers’ confusion).
185 Id.
186 Id.
187 See Burstein, supra note 4, at 208–09 (arguing that a specific-product approach should be used to limit the scope of design patent protection); Crouch, supra note 21 (explaining that prior to Curver, some suggested that a design could be patented without being limited to a particular article of manufacture).
188 See Gorham, 81 U.S. at 528 (expanding design patent protection by introducing the ordinary observer test); Curver, 938 F.3d at 1340 (limiting the scope of design patent protection to an article of manufacture regardless of whether the article is named in the claim’s figures or language of the patent).
when it expanded design patent protection in *Gorham*. The outer boundary, however, was unknown until the Federal Circuit’s decision in *Curver*.

The ordinary observer test broadens the scope of design patents. If a patent could only be considered infringing when it led to expert confusion, then no new patent would ever be considered infringing because experts can always distinguish between two articles. As such, design patents would offer little, if any, protection. Therefore, by focusing on how ordinary observers distinguish articles, rather than how experts distinguish articles, the ordinary observer test secures greater protection for design patent holders.

Although the ordinary observer test secures greater protection for design patent holders, the Federal Circuit’s decision in *Curver* limits the protection afforded to design patent holders by limiting protection to an article of manufacture, even if that article of manufacture is only indicated in the language of the patent. Although this may be discouraging to those seeking greater protection from design patents, it is a necessary limitation to ensure that design patent law remains efficient and continues to encourage innovation. Those seeking greater protection from design patents might argue that the court’s decision in *Curver* undermines both the creativity of the design and the labor that went into developing it. This argument, however, is inconsistent with policy underlying design patent law. The purpose of a design patent is not to reward creativity or labor. It is more industrial in purpose than it is artistic. The purpose of design patents is to protect the holders’ market share. At the same time, however, design patent protection needs to be limited to prevent multiple markets from being dominated by one innovator.

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189 *Gorham*, 81 U.S. at 528.
190 *Curver*, 938 F.3d at 1339.
191 See *Gorham*, 81 U.S. at 528 (holding that minor differences would be enough to escape design patent infringement if the test were based on the observation of experts).
192 See *id.* at 527 (noting that no replica exists such that an expert cannot distinguish it from the original).
193 See *id.* (explaining that a test based on expert observation would provide no protection to design patent holders).
194 See *id.* at 528 (finding that a test for design patent infringement based on the perspective of an ordinary observer is necessary to protect patentees from cunning competitors).
195 *Curver*, 938 F.3d at 1340.
196 See Burstein, *supra* note 4, at 208–09 (arguing that a specific-product approach should be used to limit the scope of design patent protection).
197 See Burstein, *supra* note 4, at 210 (suggesting that those who disagree with interpreting design as applied believe that limited design patent protection will discourage innovation in the field as a result of a cost-benefit analysis).
198 See *id.* at 208 (explaining that design patent law is about protecting the application of form to function).
199 *Id.* at 168.
200 *Gorham*, 81 U.S. at 528.
201 *Curver*, 938 F.3d at 1340.
Consider the following hypothetical. There is an existing patent for Design X as applied to a rug. The creator of Design Y acquires a design patent. It looks very similar to Design X, but the patent is for Design Y as applied to a lamp. The owner of the patent for Design X needs protection from a competitor that wants to use the same design on a similar product to profit from consumer confusion, but it does not need protection against Design Y because a consumer is not going to purchase the lamp mistaking it for the rug. Moreover, it cannot claim patent infringement by Design Y because the law has never sanctioned granting a design patent for a design alone, such that it could be applied to every possible article of manufacture. If the United States Patent and Trademark Office (USPTO) allowed the creator of Design X to hold a patent for the design as applied to all furniture, just as Curver hoped to, the creator of Design X would be able to monopolize the market.

A design needs to be attached to at least one article of manufacture, not only for policy purposes, but also for practicality purposes. If design patent law afforded the owner of the patent for Design X to claim infringement by Design Y, examiners would become bogged down by infringement claims across an enormous variety of different articles of manufacture. Furthermore, innovators would be discouraged from putting new products into the market because they would have to check every type of article of manufacture to ensure that they are not infringing upon an existing claim. Therefore, the Federal Circuit’s decision in Curver is a necessary limitation on design patent protection.

CONCLUSION

Patent law enables innovators to protect their creations in different ways. There is often confusion about which type of patent law applies—utility or design. Although these two types of patents overlap in their requirements for patentability, their tests for infringement and purposes are quite distinct. The focus of a design patent is its look, rather than its use, and this is reflected in the test used to determine infringement. The ordinary observer test is the sole test for determining design

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203 See infra notes 204–209 and accompanying text.
204 See Curver, 938 F.3d at 1337 (explaining that design patents must specify an article of manufacture to which the design is applied).
205 See Burstein, supra note 4, at 172–73 (describing the process of acquiring a design patent).
206 See Curver, 938 F.3d at 1337 (noting that a design patent applicant is required to indicate what article of manufacture its design is for).
207 See Kellman, 280 F. Supp. 2d at 679–80 (suggesting consumers were not confused by two dissimilar products like a novelty hat and a soda bottle cap).
208 Curver, 938 F.3d at 1340.
209 See Burstein, supra note 4, at 210 (explaining that a patent for a design per se would allow the patentee to dominate the market).
210 See id. at 212 (suggesting that a design patent for a design per se would cause problems for future applicants).
211 Id.
212 Id.
213 See Curver, 938 F.3d at 1340 (concluding that a design patent must be limited to a particular article of manufacture whether that article is identified in the claim’s figures or title).
patent infringement and it has resulted in greater design patent protection. Nevertheless, the scope of design patents remains unclear. The Federal Circuit addressed the question of scope in Curver, a case of first impression, by determining whether a design patent’s claim language could be used to limit the scope of a design patent in the event that the claim’s figures—illustrations customarily included in design patents—did not specify an article of manufacture. The court held that in the absence of an illustrated article of manufacture, claim language can be used to limit the scope of a patent. The effect of the court’s decision will likely result in less design patent protection, but more opportunity for those barred from patenting non-analogous designs.

Although difficulties may arise in the application of Curver because of the Federal Circuit’s failure to specify what constitutes an article of manufacture, the decision is consistent with the unique purpose of design patents: preventing consumer confusion. Not only is Curver consistent with the purpose of design patents, but it also introduces a necessary limitation to design patent protection by limiting it to an article of manufacture, even if the article is only included in the claim language and not the figures. This limitation is necessary to maintain an efficient system of design patent law and to encourage innovation in the marketplace.

**Recommended Citation:** Casey Houlton, Curver: *A Welcome Limit on Design Patent Protection*, B.C. INTELL. PROP. & TECH. F. (June 24, 2020), http://bciptf.org/2020/06/design-patent-protection.