Functionality

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Two Separate “Functionality” Issues

Issue 1: Validity
Appearance of the Overall Claimed Design

Issue 2: Claim Construction
Appearance of an Individual Claimed Feature
Issue 1:
Functionality - Validity

Validity Question: Is Appearance of Overall Claimed Design Dictated by Function?

Best Lock Corp. v. Ilco Unican Corp. (Fed.Cir. 1997)
Issue 2: Functionality – Claim Construction

**Claim Construction:** Is Appearance of a *Claimed Design Feature* Dictated by Function?

*Richardson v. Stanley Works, Inc.*, (Fed. Cir. 2010)
Richardson v. Stanley Works, Inc.,
597 F.3d 1288 (Fed. Cir. Mar. 9, 2010)
**Richardson v. Stanley Works, Inc.,**
597 F.3d 1288 (Fed. Cir. 2010)

<table>
<thead>
<tr>
<th>Prior Art</th>
<th>‘167 Patented Design</th>
<th>Accused Design</th>
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<tbody>
<tr>
<td><img src="image1.png" alt="Hammer" /></td>
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**Question:** Do the two designs have substantially the same overall visual appearance, in view of the prior art?
While as a general rule, verbalizations should not be attempted:

“a trial court can usefully guide the finder of fact” regarding “.. those features of the claimed design that are ornamental and those that are purely functional.”

*citing OddzOn Prods., Inc. v. Just Toys Inc., 122 F.3d 1396 (Fed. Cir. 1997)
Claim Construction (Matter of Law)

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

*Egyptian Goddess*
Claim Construction

“Discount,” “Ignore,” “Factor out,” purely functional features
Elmer v. ICC Fabricating, Inc.,
67 F. 3d 1571 (Fed. Cir. 1995)
**Elmer v. ICC Fabricating, Inc.,**
67 F. 3d 1571 (Fed. Cir. 1995)

**Holding:** Regardless of whether features such as “support ribs” and “protrusion” are functional, the elements are depicted in **solid lines** and thus **part of the claimed design.**
Examples of Functionality-Validity (Inquiry 1)
As a result, the Court is left to conclude that the design of the article depicted in the ‘455 Patent is largely functional, not ornamental.’ INVALID
Rip-It Holdings v Wilson Hunt Int’l,

U.S. Design Patent D603,102

**COURT:** Overall Design Dictated by Function; **INVALID**
COURT: “CVS misapplies the law on functionality because in order **to render a design patent invalid, the design must be dictated by function.**

**The court should consider:**

1. whether the protected design represents the best design;
2. whether alternative designs would adversely affect the utility of the specified article;
3. whether there are any concomitant utility patents;
4. whether the advertising touts particular features of the design as having specific utility; and
5. whether there are any elements in the design or an overall appearance clearly not dictated by function.”

*citing PHG Techs., LLC v. St. John Cos., (Fed. Cir. 2006)*
Examples of Functionality - Claim Construction (Inquiry 2)
COURT: “The ‘flex-grip’ consisting of three frown shaped lines could have been designed in an infinite number of ways and still would have served the same purpose.”

Flex-grip is part of claimed design.
Great Neck Saw Mfg. v. Star Asia U.S.A. LLC,
COURT: “Given its functional nature […], the blade lock means is not entitled to design protection.”
B&R Plastics v. Kikkerland

Prior Art

- '861 Patent
- '488 Patent
- '674 Patent

Patented Design

- '256 Patent
- '026 Patent
- '669 Patent

Accused Design

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B&R Plastics v. Kikkerland

Several Examples of Alternate Ornamental Hinge Designs

B&R’s Ornamental Hinge Design

Alternate Ornamental Hinge Design 1
“Square Corner”

Alternate Ornamental Hinge Design 2
“Square Corner with Relief”

Alternate Ornamental Hinge Design 3
“Square Opening Compressed”

Alternate Ornamental Hinge Design 4

Alternate Ornamental Hinge Design 5
“Chamfered Corner with Surface Texture”
Good Sportsman Marketing LLC v. Li & Fung Ltd.,
Defendant identifies four primary components of the claimed design:

1) the clip;

2) the head lamp, containing the light and battery;

3) the on-off switch on the headlamp; and

4) the flexible wire.

Defendant argues each component is primarily functional and contends they should be wholly factored out of the claim.”
Good Sportsman Marketing LLC v. Li & Fung Ltd.,

- Components are not purely functional.
- Configuration is not purely functional.
The figures of the '708 patent disclose, based on this Court's independent assessment, several ornamental features of the pushcart, from top to bottom are:

(1) the dual scalloped handles, with the curved dual scalloped shape of the lower handle mirroring the curved scallop shape of the upper handle;
(2) the textured appearance of the center portion of the top scalloped handle;
(3) a crossbar with a rearward bowing configuration with tapering ends by the vertical uprights of the pushcart;
(4) a bottom brace featuring visually prominent exposed fasteners with corresponding recesses for the rear ends of the fasteners, "S" shaped sloped shoulders, and a horizontal lower region curved upward at the ends to form an elliptical aperture; and
(5) a particular pattern of openings in the toe plate."
Overall Appearance “Functional”?
Feature “Functional”?

**Cobra Fixations v. Newell Operating Co.,**
2011 U.S. Dist. LEXIS 40239 (M.D.N.C. March 7, 2012)
THANK YOU!

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Christopher V. Carani, Esq. is a partner and shareholder at the intellectual property law firm of McAndrews, Held & Malloy, Ltd. (“McAndrews”) based in Chicago, Illinois. He is a leading authority in the field of design law, counseling clients on a wide range of strategic design protection and enforcement issues; he is often called upon to render infringement, validity and design-around opinions and serve as a legal consultant/expert in design law cases. Chris has worked extensively with clients to secure a wide array of design rights both in the U.S and outside of the U.S.

Chris currently chairs the American Bar Association’s Design Rights Committee, and is the past chair of the American Intellectual Property Law Association (AIPLA) Committee on Industrial Designs. In the landmark design patent case Egyptian Goddess v. Swisa, he authored amicus briefs on behalf of the AIPLA at both the petition and en banc stages. In 2009 and 2011-13, he was an invited keynote speaker at the United States Patent & Trademark Office’s (“USPTO”) Design Day.

Prior to joining McAndrews, Chris served as a law clerk to the Honorable Rebecca R. Pallmeyer at the U.S. District Court for the Northern District of Illinois. Mr. Carani was conferred his Juris Doctorate from The Law School at The University of Chicago. He also holds a Bachelor of Science in Engineering from Marquette University. He is currently licensed to practice before the U.S. Supreme Court, the U.S. Federal Circuit Court of Appeals and other U.S. District Courts. He is a registered patent attorney licensed to practice before the USPTO.

He has published and lectured extensively on the topic of design rights and is a frequent contributor to CNN on intellectual property law issues. He is also often called upon to provide comment to other media outlets, including New York Times, Wall Street Journal, NPR, PBS TV, CNBC TV, BBC, Bloomberg TV, Reuters, InformationWeek, Fast Company, ComputerWorld, PCWorld, Washington Post, L.A. Times, Chicago Tribune, Forbes, Fortune, and FoxBusiness TV.