

Keywords: design patent claim construction; design patent infringement; ordinary observer test

General: With respect to patent infringement, the Federal Circuit holds using the “ordinary observer” test as the sole test for patent infringement of a design patent does not preclude the separation of functional aspects of a claimed design from its ornamental aspects in determining the scope of the design patent; however, the discounting of functional elements cannot convert the overall infringement test to an element-by-element comparison.

Richardson v. Stanley Works Inc.
93 U.S.P.Q.2d 1937 (Fed. Cir. 2010)
Decided March 9, 2010

I. Facts

David Richardson owns U.S. Design Patent No. 507,167 (“the ‘167 patent”) to a design for a multifunction carpentry tool, known as the “Stepclaw,” that combines a hammer with a stud climbing tool and a crowbar. The ‘167 patent includes a single claim for an ornamental design depicted in FIGS. 1 and 2 below.

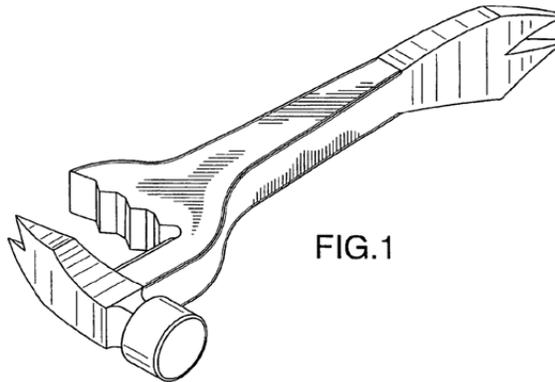


FIG.1

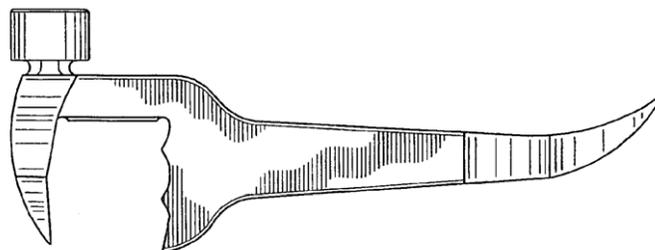


FIG.2

Stanley Works Inc. (“Stanley”), a manufacturer and seller of construction tools, began selling in 2005 a product line of tools called “Fubar” that included five different versions of a tool used in carpentry and construction work. Stanley owns U.S. Design Patent No. 562,101 (“the ‘101

patent”) that claims the basic design of the Fubar product line as depicted in FIGS. 1 and 5 of the ‘101 patent:

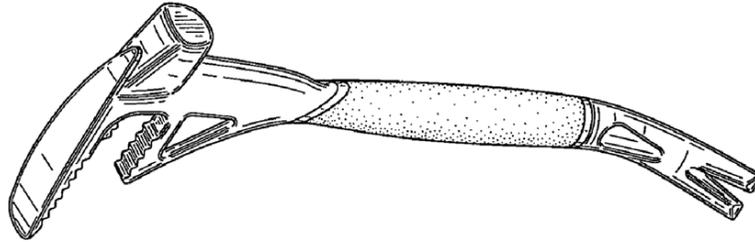


Figure 1

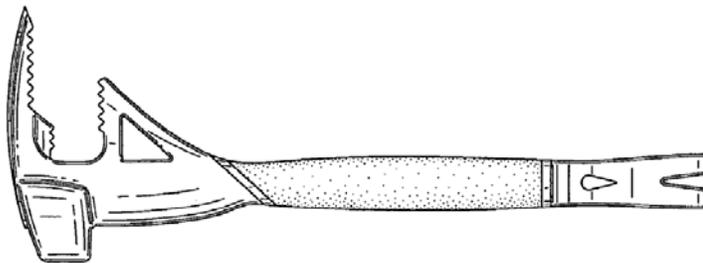


Figure 5

In 2008, Richardson filed a complaint in district court against Stanley alleging infringement of the ‘167 patent by the Fubar tools, as well as unfair competition in the U.S. market. Stanley filed a motion to dismiss on September 10, 2008, and an answer to the complaint on September 22, 2008. On October 22, 2008, Richardson filed a request for a jury trial, which Stanley moved to strike as untimely. The district court denied Richardson’s request for a jury trial as untimely. In addition, the district court dismissed the unfair competition claim. After a bench trial, the district court entered a judgment of noninfringement in favor of Stanley. During claim construction, the district court distinguished between the ornamental and functional aspects of Richardson’s design, then applied the ordinary observer test only to the ornamental aspects of the design to determine if an ordinary observer would be deceived into believing the Fubar tools were the same as the Stepclaw. The district court determined the “overall visual effect” between the Fubar and the Stepclaw was not substantially similar. Richardson appealed the district court’s decision.

II. Issues

- A. Does the “ordinary observer” test preclude the separation of functional aspects from the ornamental aspects of a claimed design during claim construction?
- B. Did the district court err in finding the Fubar tools did not infringe the patented Stepclaw design?

III. Discussion

- A. No. The scope of a design patent is limited to ornamental aspects alone and does not extend to any functional aspects. The Federal Circuit began by addressing Richardson’s argument that the district court erred in its claim construction by separating the functional aspects of the Stepclaw’s design from the ornamental aspects, instead of considering the Stepclaw’s design as a whole. Richardson argued that the *Egyptian Goddess* decision required the patented design be compared to the accused design in its entirety by an

ordinary observer. Richardson further argued that the separation of the functional aspects from the ornamental aspects is only necessary in designs that contain purely functional elements, which are elements whose function cannot be performed by any other design. The Federal Circuit disagreed with Richardson and stated the district court did not err in separating the functional and ornamental aspects. The Federal Circuit quoted the *OddzOn* decision stating that “where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.” Further, the Federal Circuit referred to the *Egyptian Goddess* decision which stated ordinarily the district court should not attempt to construe a design patent claim, but also mentioned in certain circumstances a court’s guidance may be useful in some claim scope issues such as distinguishing between the functional and ornamental aspects of a design. The Federal Circuit believed the district court acted properly in factoring out the functional aspects of the Stepclaw’s design as part of the claim construction since a design patent is limited to the protection of the ornamental design of the article.

The Federal Circuit noted that the Stepclaw contained numerous purely functional elements. As noted by the district court, the purely functional elements included the handle, the hammer-head, the jaw, and the crowbar. More specifically, the Federal Circuit noted the jaw needs to be located on the opposite end from the hammer head to use the Stepclaw as a step, the crowbar needs to be located on the end of the longer handle to reach into narrow spaces, the handle has to be the longest arm, and the hammer-head must be flat. The Federal Circuit found it would be improper to not separate out the functional aspects and “[a] claim to design containing numerous functional elements, such as here, necessarily mandates a narrow construction.”

Richardson also argued that the district court did not include the ‘167 patent drawings in the court’s claim construction. Further, Richardson argued that the ordinary observer’s perception of those drawings should be the controlling consideration. The Federal Circuit agreed that drawings are important. However, the Federal Circuit also believed the claim construction performed by the district court did not exclude the drawings since a court cannot construe design claims in any “way other than by describing the features shown in the drawings.” The Federal Circuit found Richardson’s argument was just another way of arguing that the district court erred by identifying the functional aspects of the patented design.

- B. No. The district court did not err in finding the overall effect of the Fubar tools was not found in the patented Stepclaw design, and thus did not infringe the ‘167 patent. Richardson argued that the district court did not apply the ordinary observer test in the court’s infringement analysis. Stanley argued the district court acted properly in finding the only similarities between the Stepclaw and the Fubar tools were unprotectable functional elements. According to the Federal Circuit, as held in *Egyptian Goddess*, the ordinary observer test is the sole test for determining infringement of a patented design. In the ordinary observer test, the “patentee must establish that an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design.” Citing the *Crocs* decision, the Federal Circuit stated a court is to compare the ornamental elements in both the patented design and the accused product to look at the overall effect and to determine if there is market confusion. The Federal Circuit noted that the ordinary observer test also applies in cases where the patented design has numerous functional elements and cited the holding in *Amini Innovation* for the proposition that while it is proper to factor out functional aspects of design elements, the “discounting of functional elements must not convert the overall infringement test to an element-by-element comparison.” Further, any determination of deception should arise as “a result of the similarities in the overall

design, not of similarities in ornamental features in isolation.” The Federal Circuit disagreed with Richardson’s argument and noted that the district court’s decision directly concluded that an ordinary observer would find the overall visual effect of the Fubar tools different from the Stepclaw. The Federal Circuit agreed with the district court that when “ignoring the functional elements of the tools, the two designs are different.” More specifically, the Fubar tools have a “streamlined visual theme” that includes “a tapered hammer-head, a streamlined crow-bar, a triangular neck with rounded surfaces, and a smoothly contoured handle.” The Federal Circuit found the streamlined effect gave the Fubar tools a more rounded appearance with fewer blunt edges than the Stepclaw’s patented design and thus the Fubar tools significantly differed. As a result, the Federal Circuit found the district did not err in finding the overall effect of the Fubar tools did not cause market confusion.

IV. Conclusion

The Federal Circuit affirmed the district court’s decision of noninfringement. Applying the “ordinary observer” test does not preclude the separation of functional aspects of a claimed design from its ornamental aspects in determining the scope of the design patent; however, the discounting of functional elements cannot convert the overall infringement test to an element-by-element comparison. Instead, the overall effect of the similarities in design must be analyzed to determine if any deception exists. Richardson petitioned the Federal Circuit for an *en banc* rehearing on April 8.