

## WHEN A PICTURE ISN'T WORTH A THOUSAND WORDS:

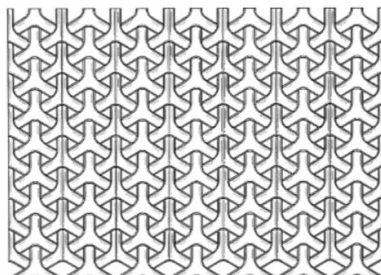
### EVEN IN THE WORLD OF DESIGN PATENTS, WHAT YOU SAY MATTERS

By: Emily Sample and Lisa Holubar | September 19, 2019

In a case of first impression, the Federal Circuit Court of Appeals addressed whether claim language specifying a specific article of manufacture can limit the scope of a design patent, even if that article of manufacture is not actually illustrated in the figures. The Court found the answer to be yes: “we hold that claim language can limit the scope of a design patent where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures.” As such, the Court affirmed the lower court’s dismissal because no plausible claim for infringement was asserted.

Curver Luxembourg, SARL (“Curver”), a company that sells home goods, sued Home Expressions for design patent infringement asserting that some of the baskets made and sold by Home Expressions infringed Design Patent No. D677,946 “Pattern for a Chair” (“the ‘946 Patent”), assigned to Curver. Home Expressions moved to dismiss the suit for failure to state a plausible claim. The district court granted the motion based on design patent estoppel. Specifically, the Patent Examiner requested amendment to the ‘946 Patent during prosecution to change the title and claim language from “design for a FURNITURE PART” to “design for a pattern for a chair,” because the original language was “too vague” as it was not directed to a particular article of manufacture. The patentee complied.

Relying on a two-step analysis to determine the plausibility of the claim, the district court first construed the scope of the ‘946 Patent and then considered whether, under the “ordinary observer” test, the baskets could be considered infringing. In construing the scope, the district court held that the ‘946 was limited to chairs, because “[t]he scope of a design patent is limited to the ‘article of manufacture’—*i.e.*, the product—listed in the patent.” Because an ordinary observer would not have been believed the design of the basket was a design for a chair, the district court dismissed the complaint.



‘946 Patent, FIG. 1



Home Expression Baskets

The Federal Circuit affirmed, emphasizing that while the scope of a design patent is typically constrained only by the figures, in a case where no article of manufacture is evident in the figures, the claim language can limit the scope of the design patent to the article of manufacture. The Federal Circuit reasoned that declining to apply the claim language to limit the scope of the design patent would effectively grant protection to an abstract, surface ornamentation design.