



How the Title Impacts Design Patent Rights

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Richard Stockton, *Banner Witcoff*

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Titles MPEP OLD

- The title of the design identifies the article in which the design is embodied by the name generally known and used by the public *but it does not define the scope of the claim*. See MPEP § 1504.04, subsection I.A. (MPEP Aug. 2006 Rev 5)

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Titles – They are Important – 7 Ways

- 35 U.S.C. 102 – is it anticipated
- 35 U.S.C. 103 – is it obvious
- Infringement – 3 different ways
 - Is it similar in kind/category to infringe
 - Comparison art
 - Who is the ordinary observer
- Inventorship
- Damages/Infringer's Profits



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AOM in 1842 Act

[(1)] any new and original design for a **manufacture**, whether of metal or other material or materials, or

[(2)] any new and original design for the printing of woolen, silk, cotton, or other fabrics, or

[(3)] any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or

[(4)] any new and original impression or ornament, or to be placed on any **article of manufacture**, the same being formed in marble or other material, or

[(5)] any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any **article of manufacture**, or

[(6)] any new and original shape or configuration of any **article of manufacture** ...

- **Agnostic about how design is associated with AOM?**
- **AOM as mere formal requirement?**

AOM in Ex Parte Cady

- AOM requirement prohibits protecting “design per se” or “disembodied design”
- but AOM requirement does not require that protection “be limited to any one article”

← **Curver invokes**

← **Curver contradicts**

Ex Parte Cady, 1916 Dec. Comm’r Pat. 57, 62.

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AOM in Ex Parte Cady

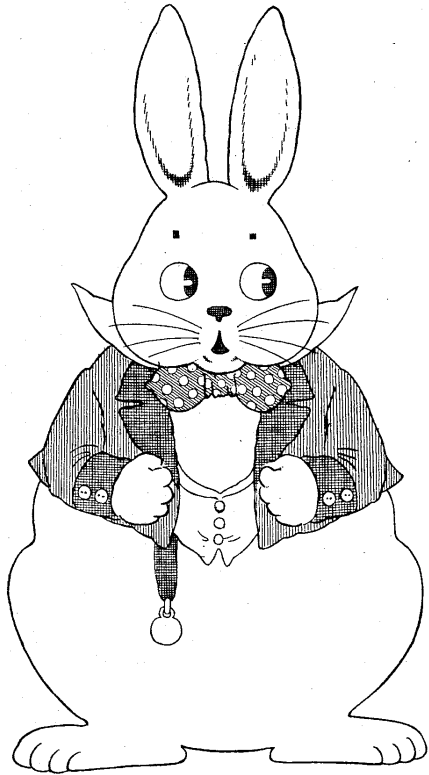
DESIGN.

H. CADY.

ARTICLE OF MANUFACTURE.
APPLICATION FILED DEC. 19, 1914.

50,236.

Patented Jan. 30, 1917.



UNITED STATES PATENT OFFICE.

HARRISON CADY, OF BROOKLYN, NEW YORK, ASSIGNOR TO THORNTON W. BURGESS,
OF SPRINGFIELD, MASSACHUSETTS.

→ DESIGN FOR AN ARTICLE OF MANUFACTURE.

50,236.

Specification for Design.

Patented Jan. 30, 1917.

Application filed December 19, 1914. Serial No. 878,201. Term of patent 7 years.

To all whom it may concern:

Be it known that I, HARRISON CADY, a citizen of the United States, and resident of Brooklyn, in the county of Kings, city and State of New York, have invented a new, original, and ornamental Design for an Article of Manufacture, of which the following is a specification, reference being had to the accompanying drawings, forming a part thereof.

In the drawings I have shown a representation of a toy embodying my design.

The design as shown comprises an orna-

mental figure in the form of a fanciful representation of a rabbit embodied in a toy, but I contemplate that the same may also be embodied in or applied to various other articles of manufacture. ←

I claim:

The ornamental design for an article of manufacture, as shown and described. ←

HARRISON CADY.

Witnesses:

LEWIS J. DOOLITTLE,
PERCIVAL E. JACKSON.

Harrison Cady
INVENTOR.

BY *Lewis J. Doolittle*
ATTORNEY.

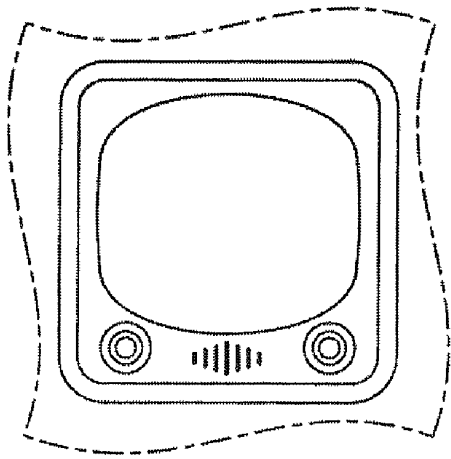
WITNESSES:
Isabel Ward
Kathryn Keenan.

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AOM in GUI Guidelines

- “if an application claims a computer-generated icon shown on a computer screen, monitor, other display panel, or a portion thereof, the claim complies with” the AOM requirement

MPEP §1504.01(a) (originally 1996 Guidelines)



- **Agnostic about how design is associated with AOM?**
- **AOM as mere formal requirement?**

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Mark D. Janis, *Design Patent Law's Three Little Words*, 100 IND. L.J. --- (forthcoming 2025)

mdjanis@iu.edu



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Title In the Spotlight

2015: MPEP change

- Title “does not define the scope of the claim” replaced by “may contribute to defining the scope of the claim”

2019: Curver Luxembourg v. Home Expressions

- Title can define article for infringement

2021: In re Surgisil

- Title can support distinction from prior art for anticipation

2023: Columbia v. Serius

- Title can limit comparison prior art in defining claim scope

2024: LKQ v GM

- Does title affect what is or is not analogous art for obviousness?



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Curver Luxembourg v. Home Expressions (2019)

- Design application filed in 2011, titled “FURNITURE (PART OF-)”
- Examiner objected to title in a *Quayle* action, suggesting Applicant amend to “Pattern for a Chair.” They did so.
- Patent issued in March 2013

(57)

CLAIM

The ornamental design for a pattern for a chair, as shown and described.



FIG. 3

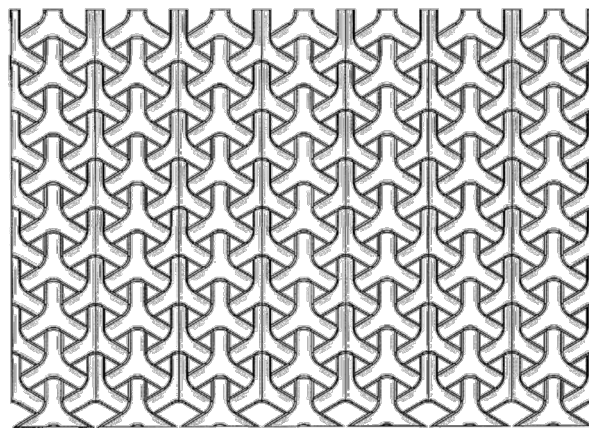


FIG. 1

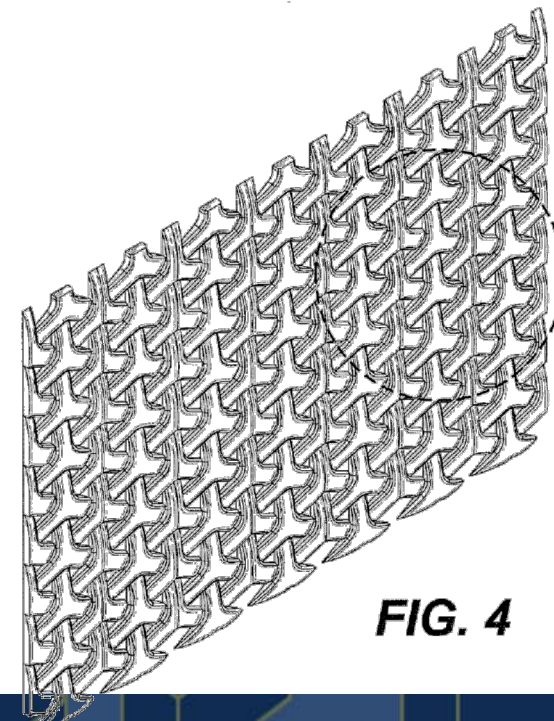


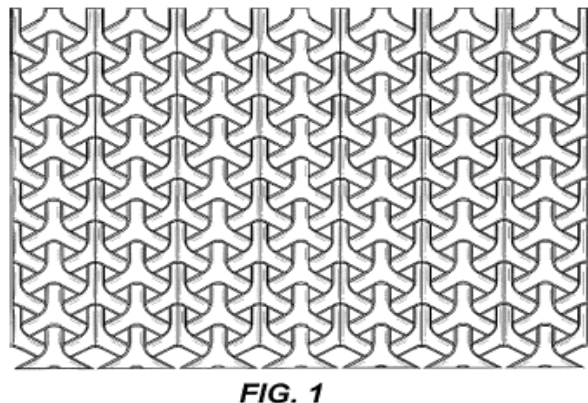
FIG. 4

FIG. 5

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Curver Luxembourg v. Home Expressions (2019)

- Curver sued Home Expressions in 2017 for applying the patented design to a basket
- Home Expressions argued the patent could only apply to a chair, not a basket
- Federal Circuit agreed: “The ornamental design for a pattern for a **chair**” did not cover a **basket** using the same design



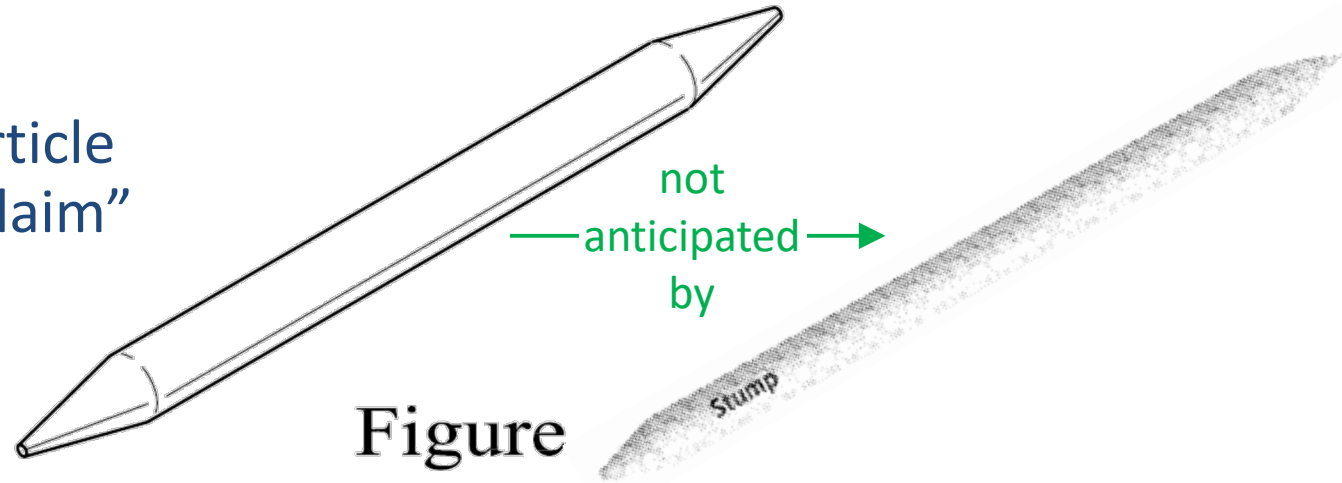
— not infringed by —>



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In re SurgiSil (2021)

- Examiner rejected the claimed “ornamental design for a lip implant” as anticipated by an art tool known as a stump
 - Examiner: anticipation “does not require the designs for comparison to be from analogous arts.”
- PTAB affirmed, finding it “appropriate to ignore” the title
- Federal Circuit reversed
 - “A design claim is limited to the article of manufacture identified in the claim”
 - Because the art tool was not a lip implant it didn’t anticipate the claimed design



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LKQ v. GM 102 F.4th 1280 (Fed. Cir. May 21, 2024) (en banc)



D797,625
"Vehicle Front Fender"



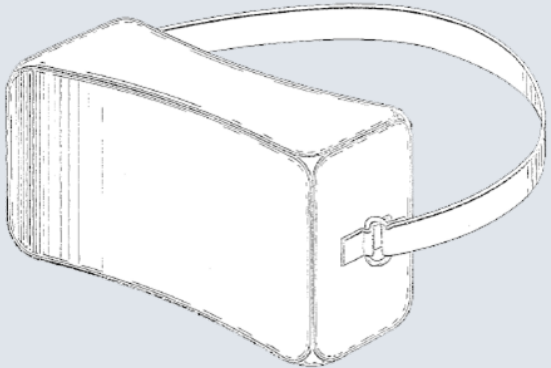
D773,340
"Vehicle"
Lian
(Primary Reference)



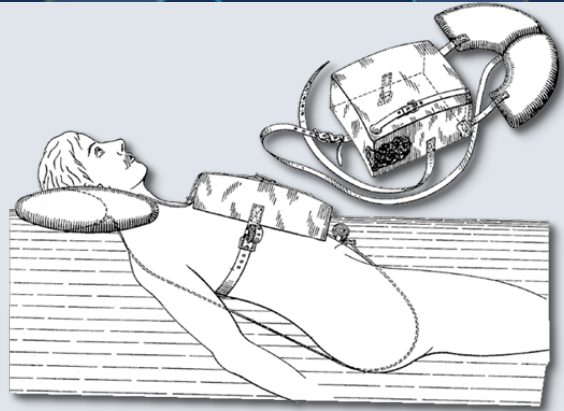
NPL
"Vehicle" (?)
Tucson
(2dary Reference)

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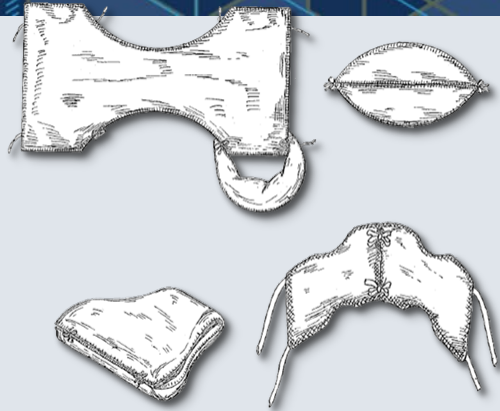
In re Glavas 230 F.2d 447 (CCPA 1956)



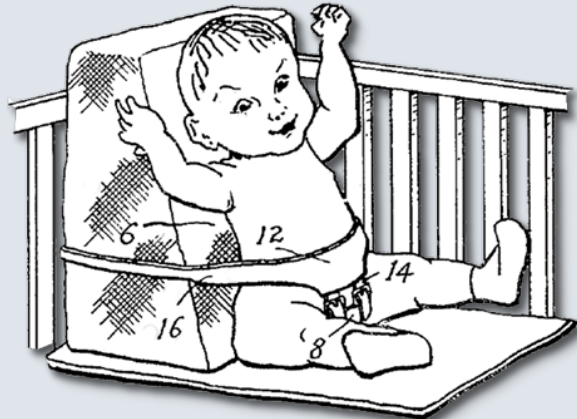
App. 8927
"Float"



715,938
"Life-Preserver"
Armstrong
(Primary Reference)



1,386,652
"Pillow"
Patton
(2dary Reference)



2,404,505
"Baby Supporter"
Knecht
(2dary Reference)

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*Columbia Sportswear North America, Inc. v.
Seirus Innovative Accessories, Inc.
(Federal Circuit)*

PATENTED DESIGN

ACCUSED PRODUCT

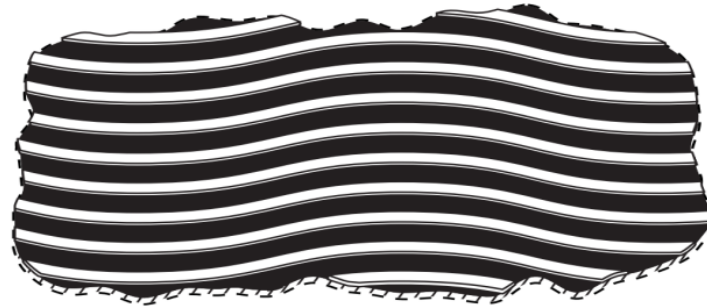
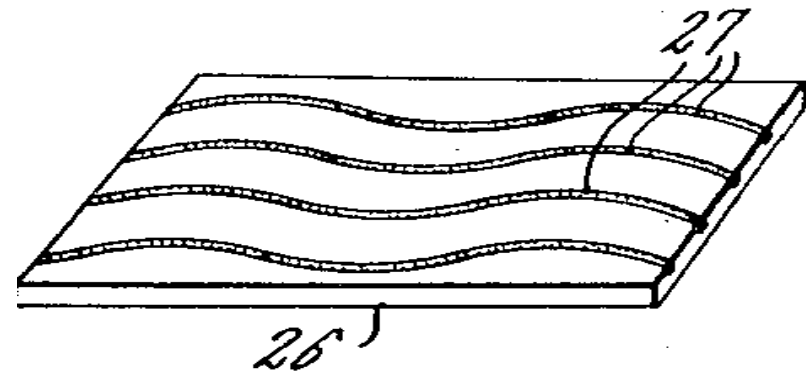


FIG. 2

PRIOR ART #1:

“Method of Providing Plastic
Sheets with Inlaid Stripes”

Title/Claim: HEAT REFLECTIVE MATERIAL

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*Columbia Sportswear North America, Inc. v.
Seirus Innovative Accessories, Inc.
(Federal Circuit)*

PATENTED DESIGN

ACCUSED PRODUCT

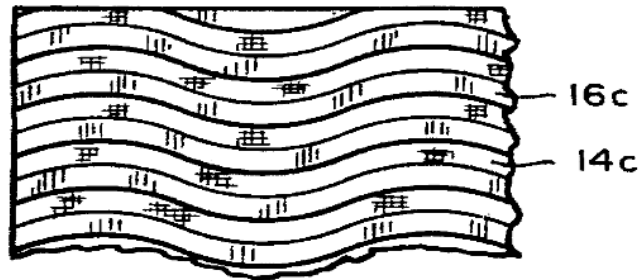


FIG. 5

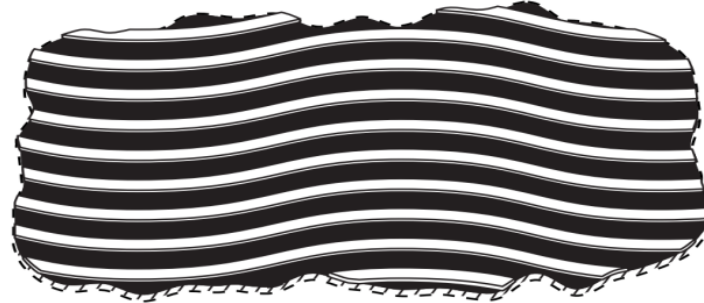


FIG. 2



PRIOR ART #2:

“Breathable Shell for
Outerwear”

Title/Claim: HEAT REFLECTIVE MATERIAL

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*Columbia Sportswear North America, Inc. v.
Seirus Innovative Accessories, Inc.*
(Federal Circuit)

PATENTED DESIGN

ACCUSED PRODUCT

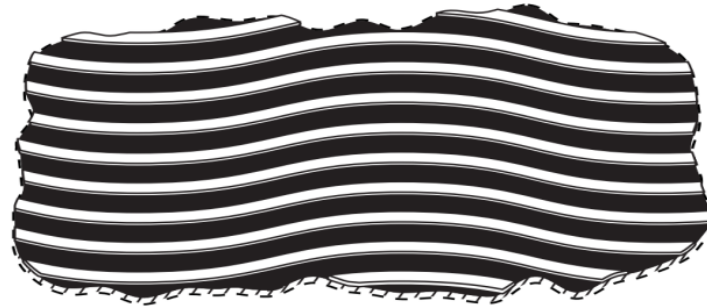


FIG. 2

PRIOR ART #3:

“Unwoven Fabric and Process
for Making the Same”

Title/Claim: HEAT REFLECTIVE MATERIAL

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*Columbia Sportswear North America, Inc. v.
Seirus Innovative Accessories, Inc.
(Federal Circuit)*

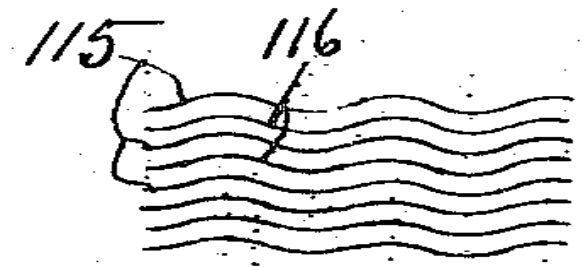
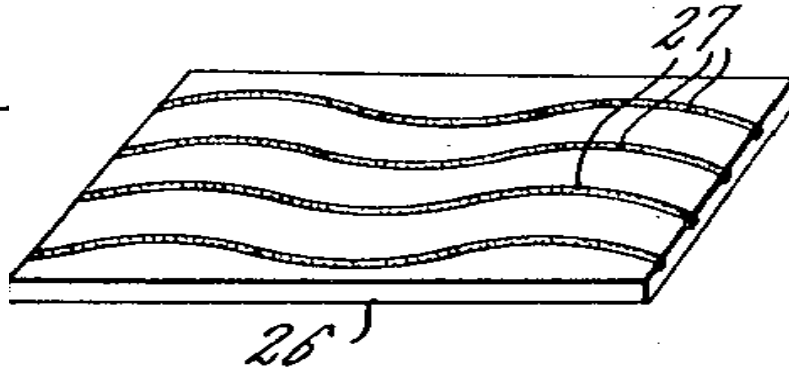


Fig 5



“Method of Providing Plastic Sheets with Inlaid Stripes”

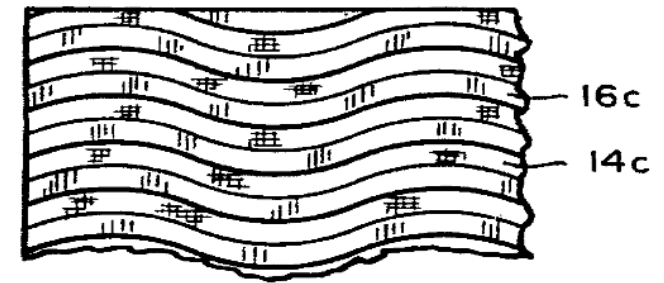


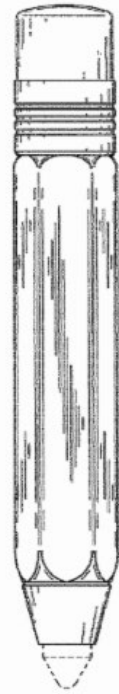
FIG. 5
“Breathable Shell for Outerwear”

COMPARISON PRIOR ART

Court: Comparison prior art must be the same article of manufacture as the claimed design.
Reversed and remanded.

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Lanard Toys v. Dolgencorp (Fed. Cir. 2020)



CLAIMED DESIGN



ACCUSED DESIGN

Title/Claim: Chalk Holder

Accused Design: Chalk Holder

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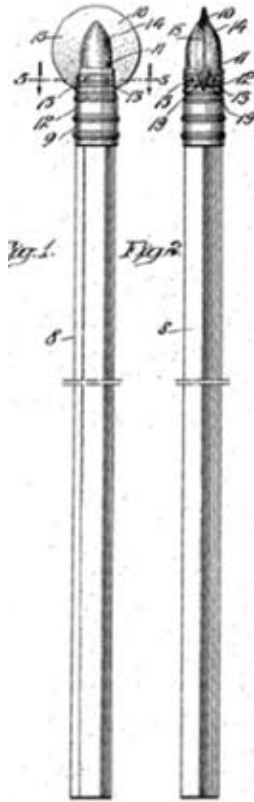
District Court's Prior Art



Ticonderoga #2
pencil



Dixon
Sense-Matic



The Van Dorn
Patent (Eraser And Holding Tip)

NONE OF THE
COMPARISON
PRIOR ART WAS
A CHALK HOLDER

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Samsung v. Apple *(SCOTUS 2016)*

SCOTUS: The “article of manufacture” for Sec. 289 damages can be either the end product sold by the infringer, or a component of the end product.

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Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc.

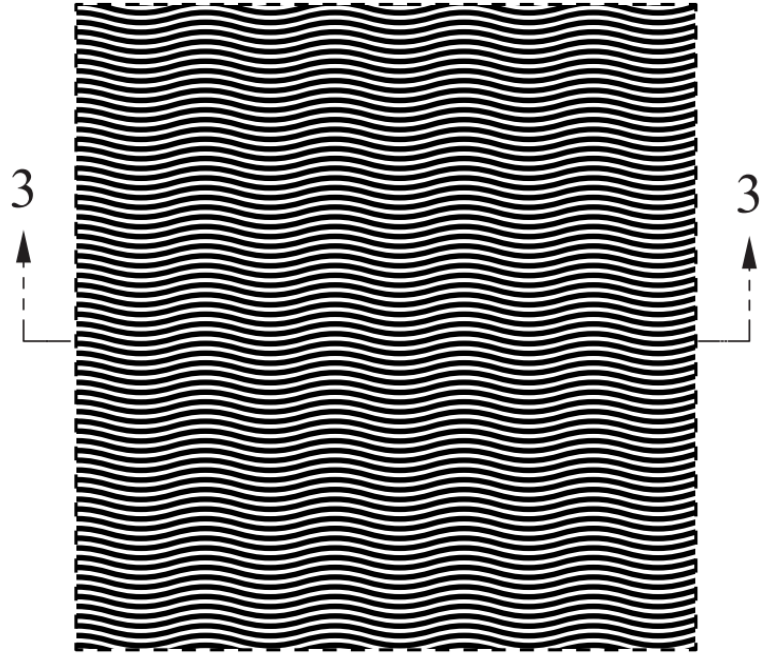


FIG. 1

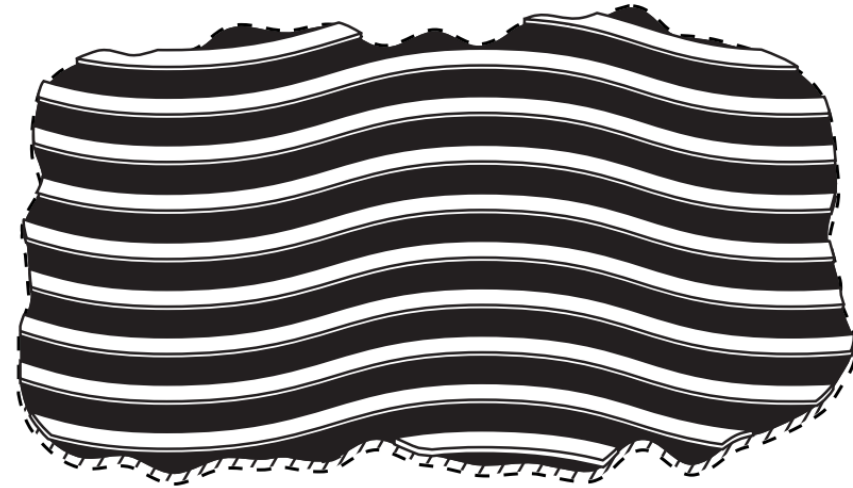


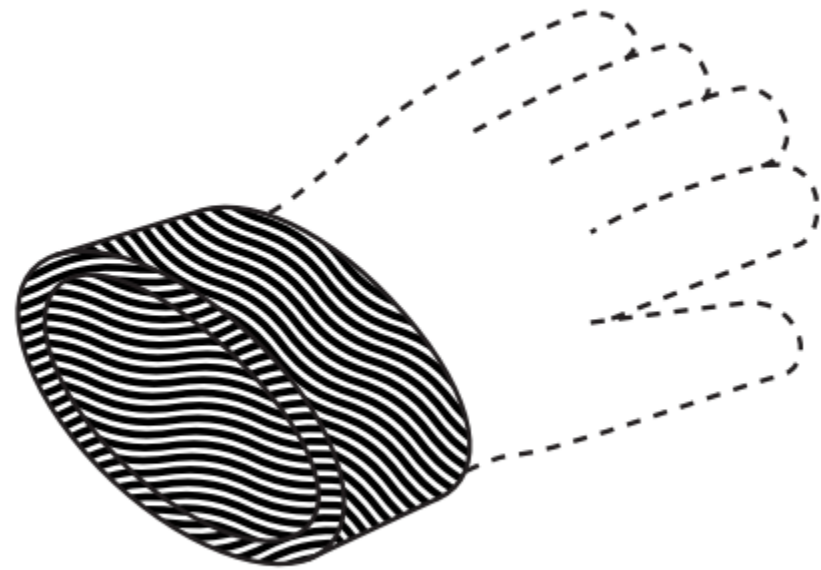
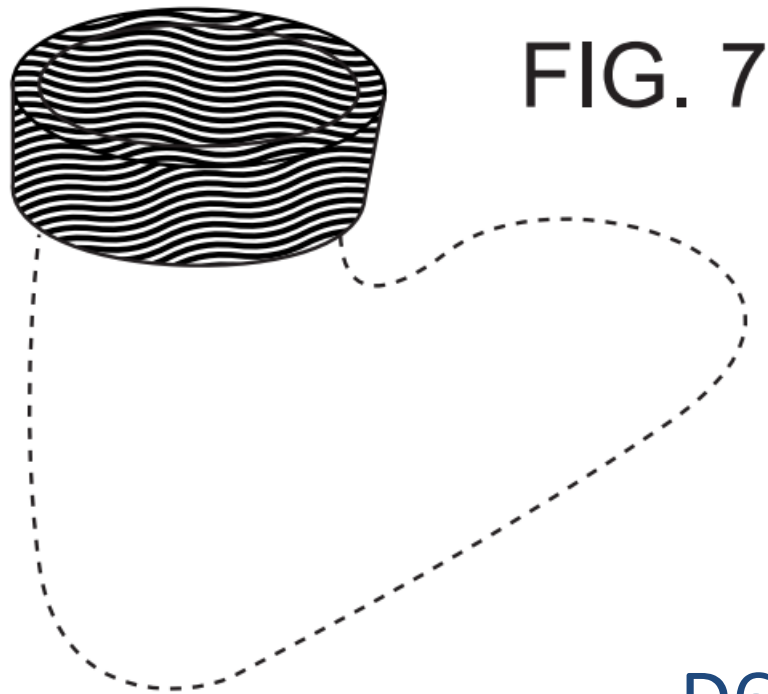
FIG. 2

D657,093

Title/Claim: HEAT REFLECTIVE MATERIAL

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*Columbia Sportswear North America, Inc. v.
Seirus Innovative Accessories, Inc.*



D657,093

FIG. 8

Title/Claim: HEAT REFLECTIVE MATERIAL

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ISSUE:

Is the “article of manufacture”
upon which “total profit” will be
based a heat reflective material
or socks/gloves?

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TITLE: Heat Reflective Material

CLAIM: The ornamental design of a heat reflective material.

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35 U.S.C. 289

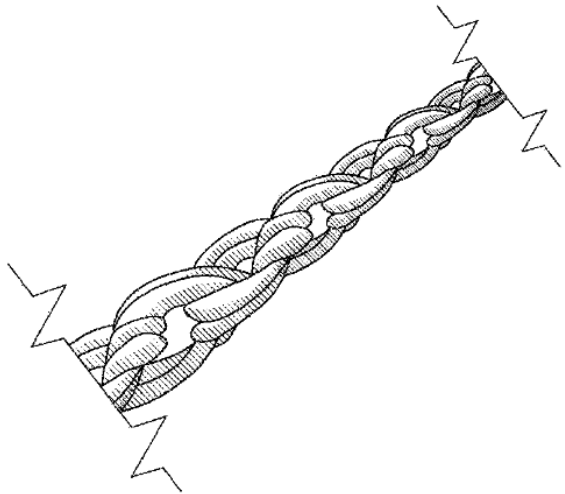
Whoever ... sells ... any article of manufacture to which the patented design ... *has been applied* shall be liable to the owner to the extent of his total profit ...

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TITLE: Heat Reflective Material Applied To Socks and/or Gloves

CLAIM: The ornamental design of a heat reflective material **applied to socks and/or gloves.**

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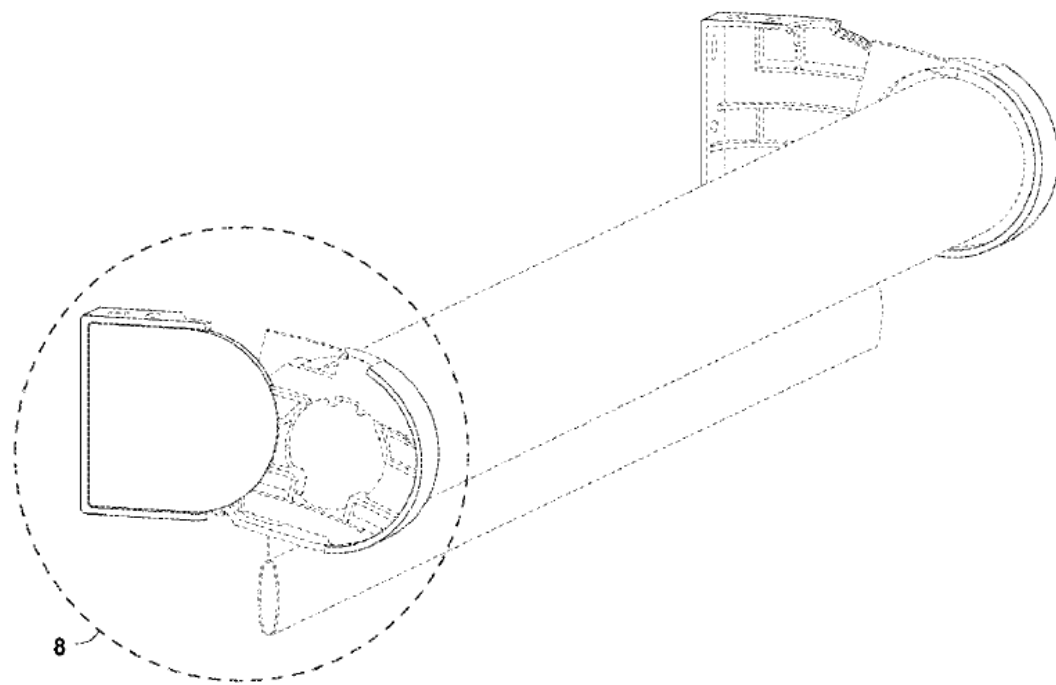


D779,355

TITLE/CLAIM:

The ornamental design for a **rope** formed by interlocking stitches for use in jewelry, clothing, accessories, or **applied to the surface of articles of manufacture**, as shown.

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D1,008,785

TITLE/CLAIM:

The ornamental design for a **bracket set applied to a window treatment**, as shown and described.

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DESIGN
LAW
2024

MPEP NOW

Titles -- MPEP NOW

- The title of the design identifies the article in which the design is embodied by the name generally known and used by the public and may contribute to defining the scope of the claim.
- When a design is embodied in an article having multiple functions or comprises multiple independent parts or articles that interact with each other, the title must clearly define them as a single entity, for example, combined or combination, set, pair, unit assembly.

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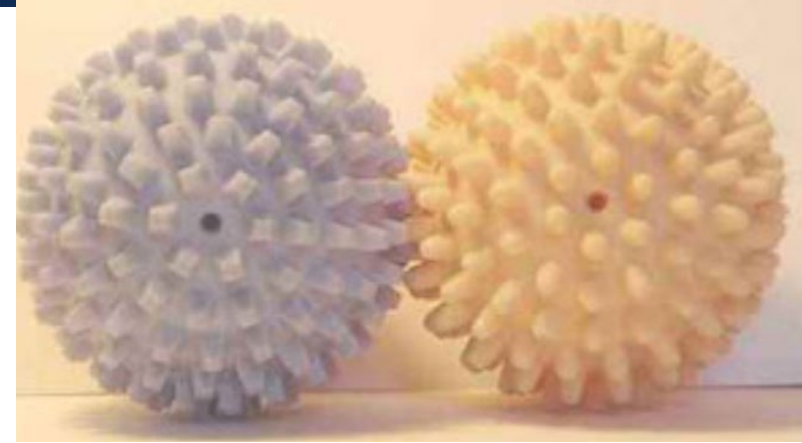
Titles - MPEP NOW

- The use of language such as “or the like” or “or similar article” in the title when directed to the environment of the article embodying the design will not be the basis for a rejection of the claim under 35 U.S.C. 112.
- However, such language is indefinite when it refers to the area of articles defining the subject matter of the design. An acceptable title would be “door for cabinets, houses, or the like,” while the title “door or the like” would be unacceptable and the claim will be rejected under 35 U.S.C. 112.

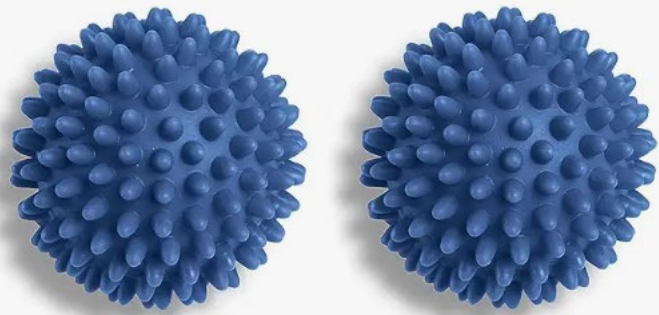
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Green Lane Products Ltd v. PMS International Group plc [2008] EWCA Civ 358

- Green Lane made and sold spiky balls (top) for use as laundry aids, and obtained registered designs
- PMS had previously been selling very similar spiky balls (bottom), but sold as massage aids.
- Could Green Lane claim that PMS infringed their design if they sold their spiky balls specifically as laundry aids?
- It would be nonsensical to consider validity only in relation to the field in which the right was to be registered. It made complete sense, therefore, that the prior art available for attacking novelty should also extend to all kinds of goods
- Limited exception of prior art availability



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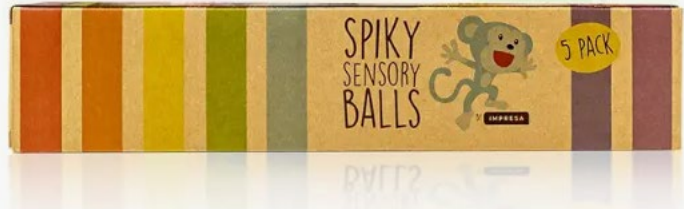


Spiky Ball Mania



Whitmor **Dryer Balls** - Eco Friendly Fabric Softener Alternative (Set of ...)

Bouncy Light Up Ball for Kids - LED Flashing Spiky Sensory Stress Balls for Toddlers 1-3 2.55inch



VITEVER 3.5" Squeaky **Dog Toy** Balls (6 Colors) Puppy Chew Toys for Teething, BPA Free Non-Toxic, Spikey Medium, Large & Small...

Sponsored ⓘ

Spiky Massage Balls for Feet, Back, Hands, Muscles - Firm, Medium and Soft Spiked Massager Roller...

[5 Pack] Spiky Sensory Balls - Squeezy and Bouncy **Fidget Toys** - Sensory Toys - No BPA Phthalates



DESIGN
LAW
2024

Discussion and Hypotheticals

Strategies and Topics

- Strategies for picking a title
 - We rarely know the prior art or how the “design” will be copied
 - Do we use the goldilocks strategy? Ideas?
- Adjectives/Intended Use/Slicing it Thin
 - “edible” straw; “reclining” chair; etc.
- Compound or Alternative Titles
 - Should we do it? How do we do it?
 - Will the USPTO accept it? should they? why or why not?

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Strategies and Topics

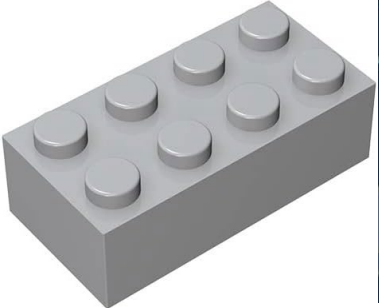
- USPTO Objections/Rejections
 - Examiner preferences
 - Additional costs to argue
 - Why can't Applicants pick their scope?
 - Estoppel concerns?

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Strategies and Topics

- Bad Faith Issues
 - Getting design patents on someone else's design but alleging a different title?
 - Selling copies but advertising different uses?
 - Should the law be different on this point for patentability or infringement?

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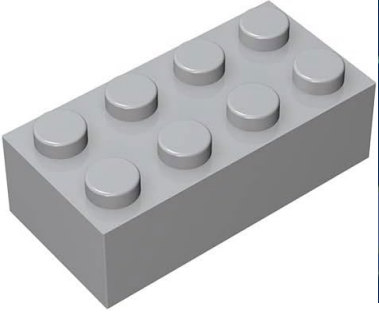
Blocks

- INTERLOCKING CONCRETE BLOCKS
- QUICK, EASY AND COST-EFFECTIVE
- PERMANENT AND TEMPORARY WALLS AND BAYS



- Hypothetical #1
- Toy block is in prior art (can commercially called toy block)
- Builder Corp. makes concrete block in same shape
- File design patent application claiming
 - “Construction Block”
 - “Concrete Construction Block”
 - “Concrete Block for Residential, Commercial, and Industrial Buildings”
 - “Concrete or Masonry Block for Residential, Commercial, and Industrial Buildings”
- Is it novel? Is it non-obvious?
- Does it matter if Builder Corp copied exactly?

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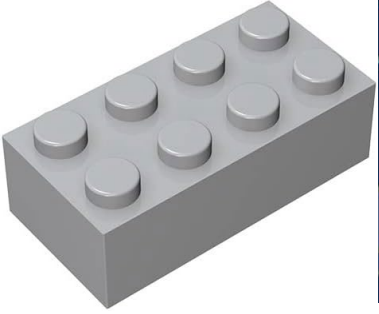
Blocks

- INTERLOCKING CONCRETE BLOCKS
- QUICK, EASY AND COST-EFFECTIVE
- PERMANENT AND TEMPORARY WALLS AND BAYS



- Hypothetical #2a
- Toy Co. gets a design patent on its “Toy Block”
- Builder Corp. makes building block in same shape
 - Does Builder Corp infringe?
 - Would it matter if the design patent was entitled “Block”
 - Does it/should it matter if it copied the design exactly?
 - Assuming some differences, what prior art should be used for comparison prior art purposes

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Blocks

- INTERLOCKING CONCRETE BLOCKS
- QUICK, EASY AND COST-EFFECTIVE
- PERMANENT AND TEMPORARY WALLS AND BAYS



- Hypothetical #2b
- What if the prior art includes the following play mini-building set with concrete blocks in a different (non-interlocking) shape
- To what extent do concepts matter?



Acacia Grove Mini Cinder Blocks with Pallet, 1/12 Scale (24 Pack)

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24 Pack \$15.79 ✓prime	48 Pack \$23.79 ✓prime
------------------------------	------------------------------

Blocks

- Hypothetical #3
- Toy Co. now has a new block
- What title should you use?
 - Block
 - Interlocking Block
 - Toy Construction Block
 - Plastic Interlocking Toy Construction Block
- Can you limit the applicable prior art for 102 or 103?
- Do you care about copyists in other fields such as the building constructions trade?



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Blocks

- Hypothetical #4
- Person A at Toy Co. now has a toy block design
- At a meeting, Person B says “that would make a great concrete construction block”
- Who is/are the inventors if the design title is
 - Interlocking Block
 - Construction Block
 - Toy or Building Block
- How do you handle it? What strategies?



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Thank you!

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