

# Alerts & Publications

## Federal Circuit Clarifies Scope of Design Patent Protection: *Richardson v. Stanley Works, Inc.*



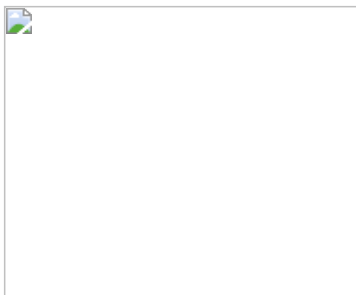
January 1, 0001

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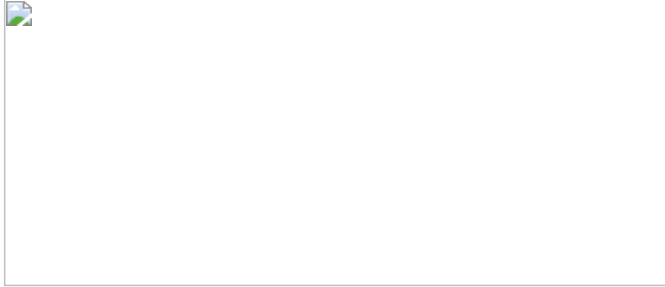
On March 9, 2010, the Federal Circuit helped resolve a lingering concern over the proper scope of design patents by affirming that courts should compare only the ornamental features of products when analyzing the products for design patent infringement. *Richardson v. Stanley Works, Inc.*, No. 2009-1354, (Fed. Cir. Mar. 9, 2010). Design patents provide protection for new ornamental designs for manufactured products, but they are not intended to cover functional elements. To properly restrict the scope of design patents to ornamental features, courts formerly employed a two-step analysis. First, courts would examine whether the overall visual appearance of the designs was deceptively similar. Second, courts would also look to a "point of novelty" test in which the court identified the new ornamental features of the patented design, and looked to see if those features were also found in the accused product. The court would find infringement only upon satisfying both tests.

But in 2008, the Federal Circuit rejected the point of novelty test and held that the sole test in design patent cases compares of the overall similarity of the designs, such that an ordinary purchaser paying ordinary attention to the design could be deceived into purchasing the infringing product by thinking it was the patented design. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008). Unfortunately, many products look similar to the ordinary observer *because* of their functional requirements, which are not supposed to be protected by design patents. Thus, relaxing the infringement test in *Egyptian Goddess* created a very real possibility of expanding the scope of design patents to include the appearance of functional elements of products.

In *Richardson*, the Court helped lessen this concern in a case that resolved whether a patented design for a multi-function carpentry tool—a hammer/crowbar combination tool—was infringed by a product sold by Stanley works:



**Patented Design (Above)**



**Stanley Works Design (Above)**

Although the Court cautioned against an *element-by-element* comparison solely of the ornamental features, it affirmed the district court's decision to ignore the functional elements to examine the "overall visual effect" of the ornamental features. The Court agreed that rejecting functional similarity and looking only at the ornamental features was consistent with the requirements of *Egyptian Goddess. Richardson*, No. 2009-1354, slip at 10. The court pointedly stated that "ignoring the functional elements of the tools, the two designs are indeed different." *Id.* Infringement will be found only when an ordinary observer, familiar with the prior art designs *and ignoring the functional elements of the products*, would be deceived into believing that the accused product is the same as the patented design. Thus, the courts are instructed to disregard the similarity of appearance caused by functional requirements, and focus solely on whether the ornamental aspects of the two designs are substantially similar.