

## Federal Circuit Bolsters Validity of Design Patents

By Alan Herda<sup>1</sup>

The value of design patents increased this week when the U.S. Court of Appeals for the Federal Circuit reversed the trial court's ruling that the SNOOZIES® slippers design patent was invalid. *High Point Design LLC v. Buyer's Direct, Inc.*, No. 2012-1455 (Fed. Cir. Sept. 11, 2013). The lower court had ruled on summary judgment that the design patent was invalid on two separate grounds, namely (1) obviousness and (2) functionality. In reversing both rulings, the Federal Circuit has made it harder for infringers to invalidate design patents.

Regarding invalidation based on obviousness, the Federal Circuit clarified that whether a claimed design is obvious must be assessed from the viewpoint of an ordinary designer, rather than an ordinary observer. In doing so, the Federal Circuit neutralized its anti-design patent obviousness discussion in *Int'l Seaway Trading Corp. v. Walgreens Corp.*,<sup>2</sup> which had referenced an ordinary observer test when evaluating obviousness. In *High Point*, the Federal Circuit stated that, regardless of what the *Int'l Seaway* court had in mind, the court could not rewrite the precedent setting forth the designer of ordinary skill standard. This is good news for design patent owners because that which may be considered obvious to an ordinary observer may not be necessarily obvious to a designer of ordinary skill of the articles involved. Indeed, such a designer who spends their career meticulously developing and refining designs will not consider many changes obvious, while the ordinary observer may find such designs all look the same.

In overturning the lower court's ruling that the design patent was invalid based on functionality, the Federal Circuit reminded us of two important points: (1) design patents are supposed to protect products that serve a function; and (2) more is required to find a design patent invalid for functionality. In particular, the claimed design must be found to be primarily functional, that is, dictated by function rather than the product serving a purpose. Factors that may help in determining whether a claimed design is dictated by function include, among others, whether the claimed design represents the best design, and whether alternative designs would adversely affect the utility of the article. This is also good news for design patent owners, because the Federal Circuit expressly acknowledged that it is 100 percent appropriate for a design patent to protect an ornamental design of a utilitarian article of manufacture – that's the point of design patents!

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<sup>2</sup> 589 F.3d 1233 (Fed. Cir. 2009).