

Presenting a live 90-minute webinar with interactive Q&A

Functionality in Design Patent Prosecution and Litigation

Evaluating Ornamentality vs. Functionality, Overcoming Obviousness Challenges,
Leveraging Recent Court Treatment

TUESDAY, FEBRUARY 22, 2022

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

Today's faculty features:

Tracy-Gene Durkin, Director, **Sterne Kessler Goldstein & Fox PLLC**, Washington, DC

Daniel A. Gajewski, Director, **Sterne Kessler Goldstein & Fox PLLC**, Washington, DC

Lance Rake, Professor, School of Architecture & Design,
The University of Kansas, Lawrence, KS

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Navigating Functionality in Design Patent Prosecution and Litigation

Tracy-Gene G. Durkin

Daniel A. Gajewski

Lance G. Rake

Technical Minds. Legal Muscle.

The “Functionality” Requirement

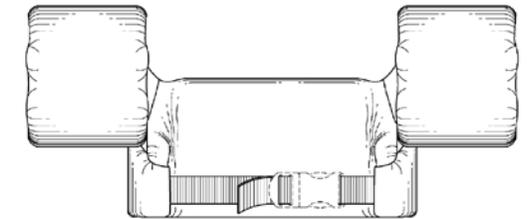
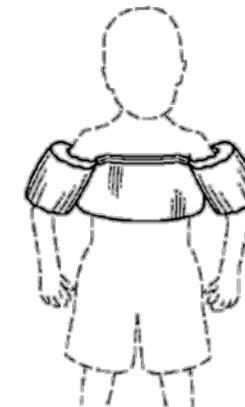
- 35 USC § 171: “Whoever invents any new, original and **ornamental** design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”
- Functionality is not mentioned in the statute or rules, it is a doctrine from case law interpreting the word “ornamental”
- Functionality arises in two contexts:
 - **Validity** challenges to patentability under § 171
 - **Claim construction** before the court and at the USPTO

The Functionality Doctrine in Practice

- Patentability / validity: Is the **design as a whole** ineligible under § 171 for not being ornamental?
- Claim construction: How to construe a claim that includes elements that serve a functional purpose?



US Patent No. D327,636
"Portion of a Key Blade Blank"
Best Lock Corporation



US Patent No. D623,714
"Personal Flotation Device"
The Coleman Company

The Functionality Doctrine in the Case Law

- “a design patent’s claim protects an article of manufacture, which **‘necessarily serves a utilitarian purpose.’**”
- “a design patent cannot claim a **purely functional** design—a design patent is invalid if its overall appearance is **‘dictated by’ its function.**”
- “as long as the design is not **primarily functional**, the design claim is not invalid, even if certain elements have functional purposes.”
- ““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.””

Sport Dimension v. Coleman, 820 F.3d 1316 (Fed. Cir. 2016)

The Functionality Doctrine - Factors

- 5 factors generally considered:
 1. whether the protected design represents the **best design**
 2. whether **alternative designs** would adversely affect the utility of the specified article
 3. whether there are any related **utility patents**
 4. whether the **advertising** touts particular features of the design as having specific utility
 5. whether there are any elements in the design or an overall appearance clearly **not dictated by function**
- These factors were developed to assist courts in determining whether a claimed design was dictated by function and thus invalid, but also serve as a useful guide for dealing with functionality in claim construction as well.
 - *Sport Dimension v. Coleman*, 820 F.3d 1316 (Fed. Cir. 2016)

Contrast with Trademark Functionality

- Lanham Act precludes functional marks from gaining trademark protection without ever defining what “functional” means
 - “**comprises any matter that, as a whole, is functional**”

15 U.S.C. §§ 1052(e)(5)

- Court’s have developed the doctrine to prevent the use of a product feature as a trademark where such use would put competitors at a significant **non-reputation-related disadvantage**
- Doctrine’s application is disparate among the circuits

TM Functionality

- A product feature is considered functional, and cannot serve as a trademark, if it is:
 - **essential to the use or purpose** of the article or if it **affects the cost or quality** of the article (**utilitarian** functionality)
 - if it is **competitively necessary** to use the feature of the design in the relevant market (**aesthetic** functionality)

Qualitex Co. v. Jacobsen Products Co., Inc., 514 U.S. 159 (1995).

Utilitarian Functionality

- *Disc Golf* Factors:
 - whether the design yields a **utilitarian advantage**
 - whether **alternative designs** are available
 - whether **advertising** touts the utilitarian advantages of the design, and
 - whether the particular design results from a comparatively simple or inexpensive **method of manufacture.**”

Blumenthal Distrib., Inc. v. Herman Miller, Inc., 963 F.3d 859, 859 (9th Cir. 2020)



Aesthetic Functionality

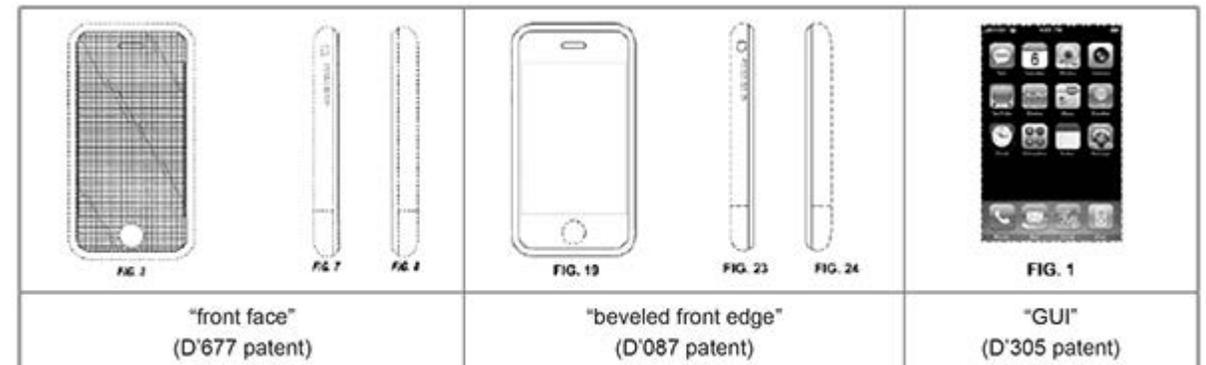
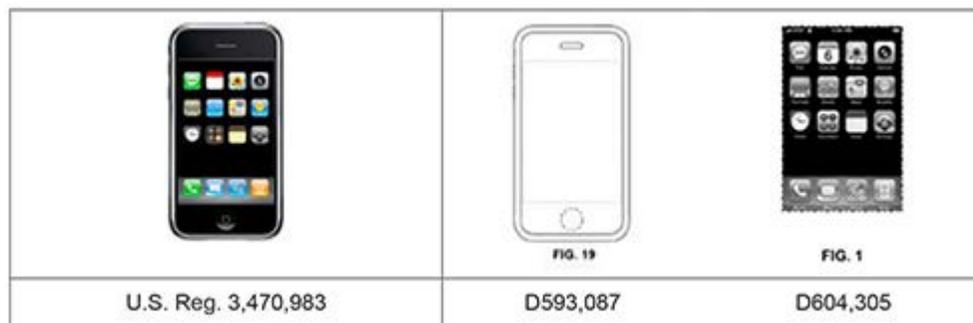
- Typically only considered when utilitarian functionality is not shown
- Commonly invoked when the mark is:
 - the principal decorative feature of the product (slogans on a T-Shirt or a pattern on china), or
 - is the product itself (such as the heart shape of a Valentine's candy box)



Different Treatment in the Courts

- Apple asserted both registered and unregistered trade dress in the iPhone smartphone design and its GUI, as well as design patents covering the same designs
- The trade dress was found to be functional
- The design patents were found to be valid and infringed

Apple Inc. v. Samsung Elecs. Co., Ltd., No. 14-1335, slip op. at 7 (Fed. Cir. May 18, 2015)



Aesthetic Functionality and Design Patents

- Fed Cir rejected the argument that aesthetic functionality should apply design patents
- The competitive considerations that drive the doctrine in trademark law do not apply to design patents, which “expressly grant to their owners exclusive rights to a particular aesthetic for a limited period of time”

Auto. Body Parts Ass’n v. Ford Glob. Techs., LLC, 930 F.3d 1314, 1320 (Fed. Cir. 2019), cert. denied, 140 S. Ct. 1298 (2020)



Eligibility

Design Patent Eligibility

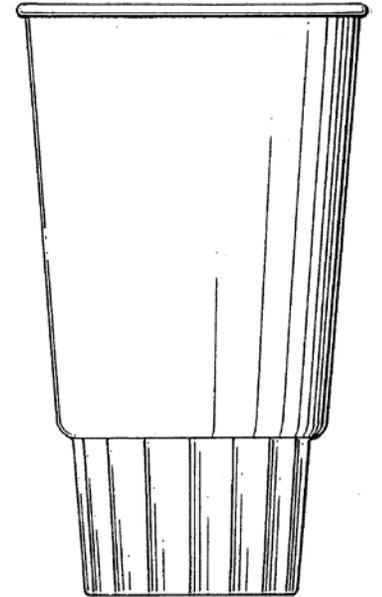
- A design patent is invalid if “the claimed design is **dictated by** the utilitarian purpose of the article”
 - i.e., the design is primarily functional
- “the fact that a patented article serves a function is a prerequisite of design patentability, not a defeat thereof”
- “functionality of the article itself must not be confused with functionality of the article’s design”
 - *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F. 2d 1117 (Fed. Cir. 1993)
- When the **overall appearance** of a design is **dictated by its function** it is not ornamental

Design Criteria Are Not Functional Limitations

Berry Sterling Corp. v. Pescor Plastics, Inc., 122 F.3d 1452 (Fed. Cir. 1997)

Berry Sterling's design for a "Container to Fit a Vehicle Cup Receptacle" was designed to meet criteria for Coca-Cola's "Coke to Go" program. To qualify, it had to

- (1) have a 32 oz capacity
- (2) have a spill-proof lid
- (3) fit in a majority of car cup holders
- (4) be short enough to fit under the valve of a soda dispenser
- (5) have a low production cost



US Patent No. D362,368
Berry Sterling Corporation

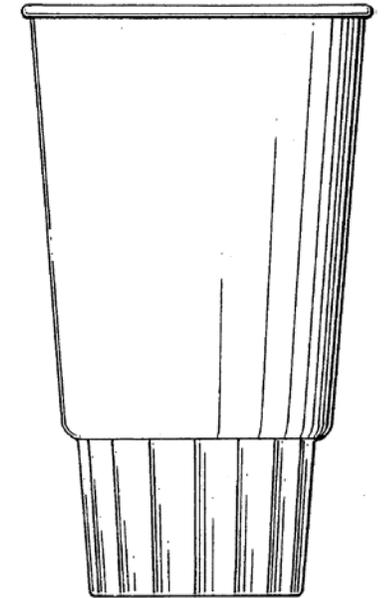
Design Criteria Are Not Functional Limitations

Berry Sterling Corp. v. Pescor Plastics, Inc., 122 F.3d 1452 (Fed. Cir. 1997)

The district court found the patent invalid on functionality grounds, finding that the design was “dictated by the function of” meeting the Coke to Go program criteria.

The Federal Circuit disagreed with the district court.

- The requirements of the Coke to Go program are **not in the patent** and are not imposed by the claim.
- Limitations of the commercial embodiment do not impose limits on the scope of the design patent.



US Patent No. D362,368
Berry Sterling Corporation

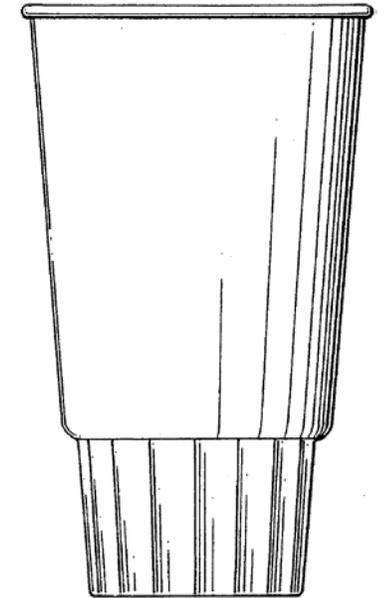
Design Criteria Are Not Functional Limitations

Berry Sterling Corp. v. Pescor Plastics, Inc., 122 F.3d 1452 (Fed. Cir. 1997)

The Federal Circuit faulted the district court for:

- performing an element-by-element analysis of the design, rather than considering its overall appearance
- failing to consider the presence of alternative designs

The Federal Circuit identified the five factors still used today for assessing whether a design as a whole—its overall appearance—was dictated by functional considerations.



US Patent No. D362,368
Berry Sterling Corporation

Design constraints for a commercial embodiment do not equate to functional limitations on a design.

Functionality is considered for the overall appearance of a design as a *whole*, not element-by-element.

Dictated by Function

Best Lock Corp. v. Ilco Unican Corp., 94 F. 3d 1563 (Fed. Cir. 1996)

Best Lock’s design for a “Portion of a Key Blade Blank” was designed to fit within a corresponding keyway for a lock.



US Patent No. D327,636
Best Lock Corporation

Best Lock argued that there are a variety of possible shapes for interfaces between keys and locks, so this one is not dictated by its function. (Judge Newman agreed, in dissent.)



The Federal Circuit disagreed, finding that **no alternative** blank key blade would fit the **corresponding lock**.

The claimed design was invalid as **dictated solely by functional** concerns.

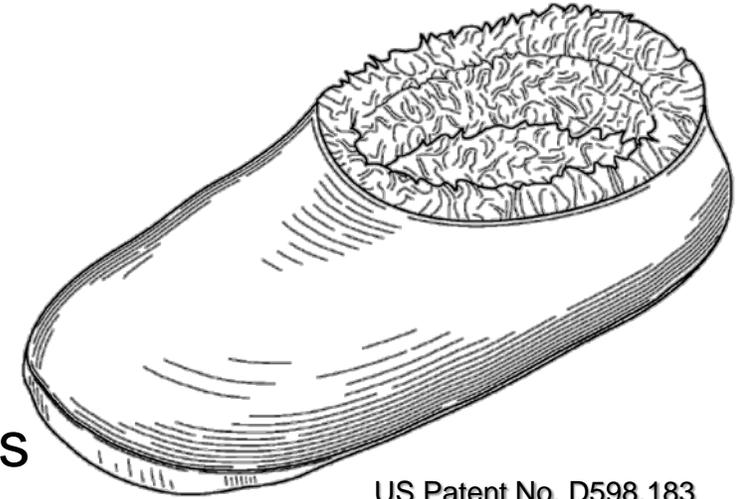
A Functional Article ≠ A Functional Design

High Point Design LLC v. Buyers Direct, Inc., 730 F.3d 1301 (Fed. Cir. 2013)

The district court found Buyers Direct’s slipper design invalid for being **primarily functional** rather than **primarily ornamental**.

The district court concluded that “all major characteristics of th[e] slipper [in the ‘183 patent] are functional”

- covers the foot to provide warmth and protection
- fuzzy interior for comfort



US Patent No. D598,183
Buyer’s Direct

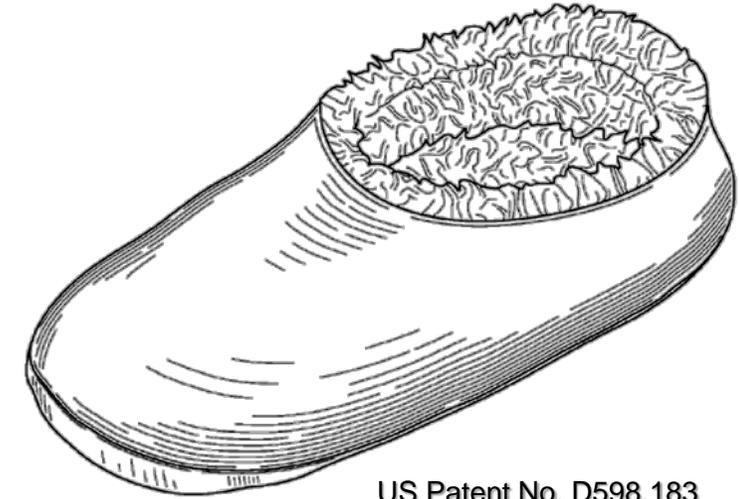


A Functional Article ≠ A Functional Design

High Point Design LLC v. Buyers Direct, Inc., 730 F.3d 1301 (Fed. Cir. 2013)

The Federal Circuit reversed.

Whether the *article itself* is functional is **not the relevant question**. Serving a function is “a *prerequisite* of design patentability, not a defeat thereof. **The function of the article itself must not be confused with ‘functionality’ of the design of the article.**”



US Patent No. D598,183
Buyer's Direct

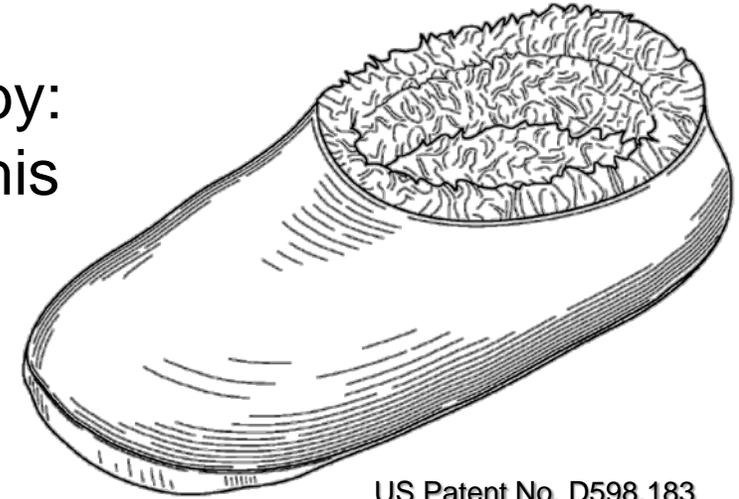


Functional article = OK
Design *dictated by* the article's function = not OK

Expert Assistance

An expert can help support the **ornamentality** of a design by:

- Providing design **alternatives** that don't alter function. This might include drawings or models of alternative configurations.
- Point to design features that draw **viewer's attention**



US Patent No. D598,183
Buyer's Direct

An expert can help show the **functionality** of a design by:

- Show how the dominant design cannot be altered without changing **product performance**

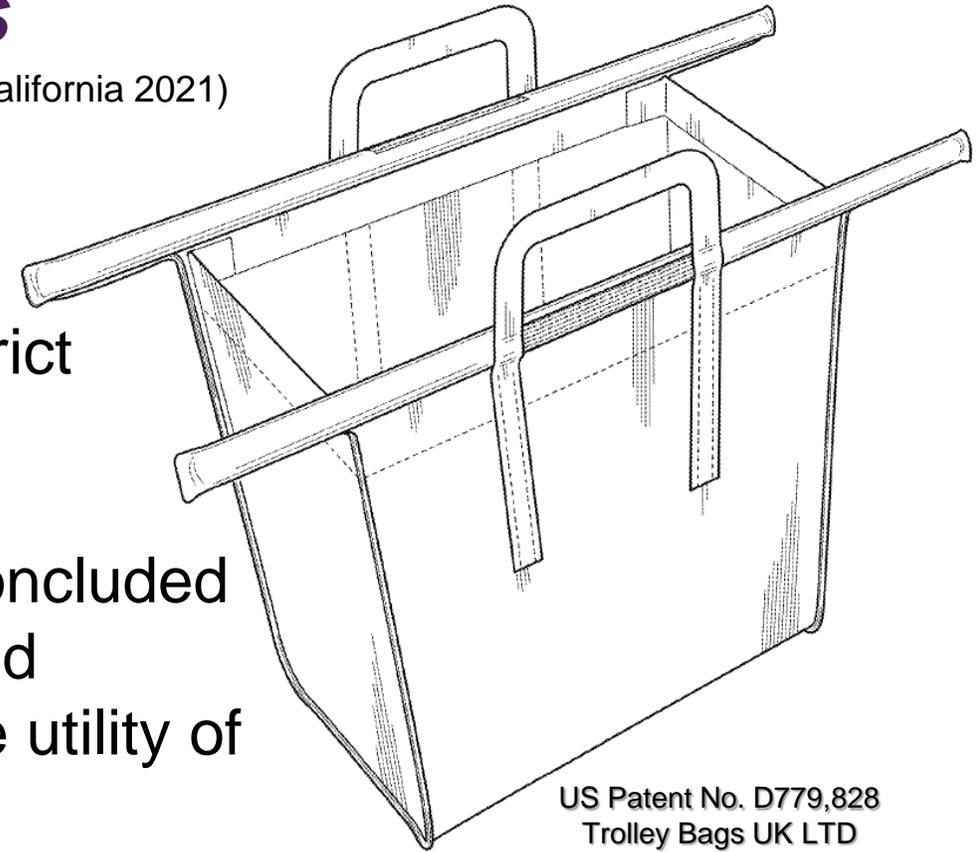


Golden Eye Media v. Trolley Bags

Golden Eye Media USA, Inc. v. Trolley Bags UK Ltd., 525 F.Supp.3d 1145 (S.D. California 2021)

Trolley Bags' design for a "Foldable Bag" was designed to fit in some shopping carts. The district court found it invalid as **dictated by function**.

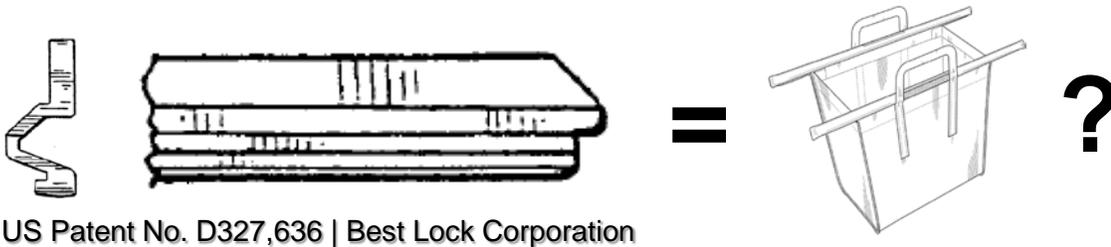
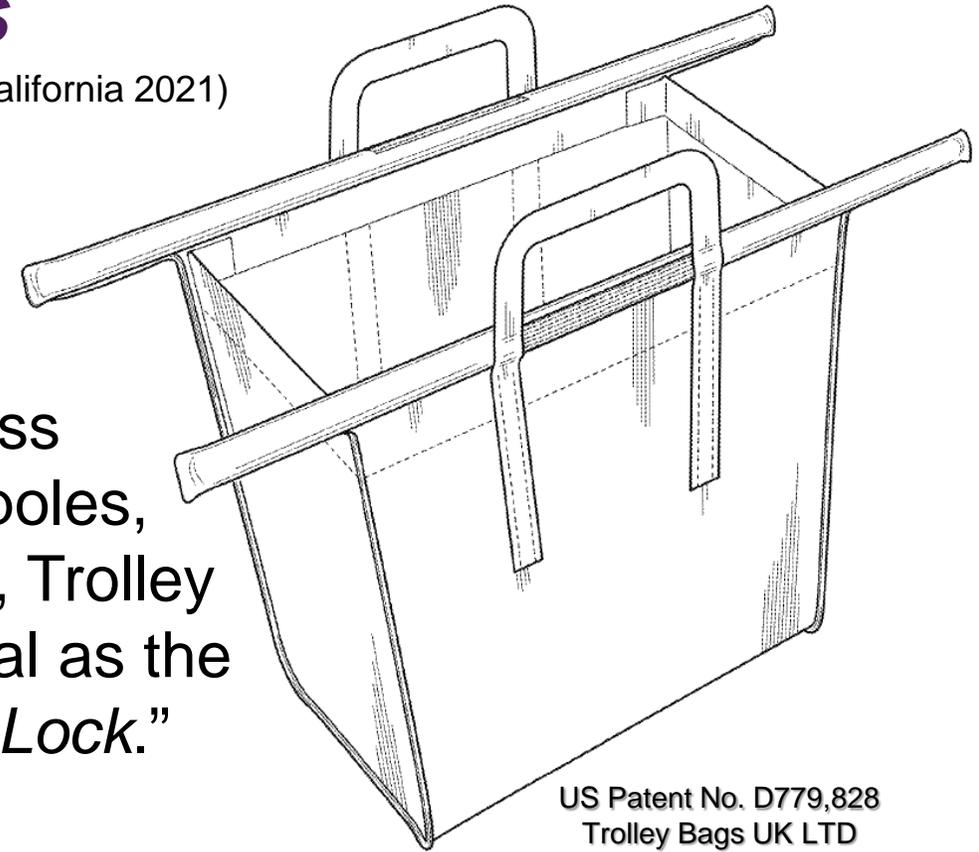
Applying the *Berry Sterling* factors, the court concluded that the design "represents the **best design**" and "**alternative designs** would adversely affect the utility of the specific article."



Golden Eye Media v. Trolley Bags

Golden Eye Media USA, Inc. v. Trolley Bags UK Ltd., 525 F.Supp.3d 1145 (S.D. California 2021)

“an alternative design—such as differently shaped bags ... would directly impact the functionality of the bags by requiring more or less bags, preventing ease of use of the horizontal poles, or making the bags more difficult to carry. Thus, Trolley Bags’ products seems [sic] equally as functional as the key blade found invalid for functionality in *Best Lock*.”



Did the court properly separate functionality of the *article* from functionality of the *design*, as outlined in *High Point*?

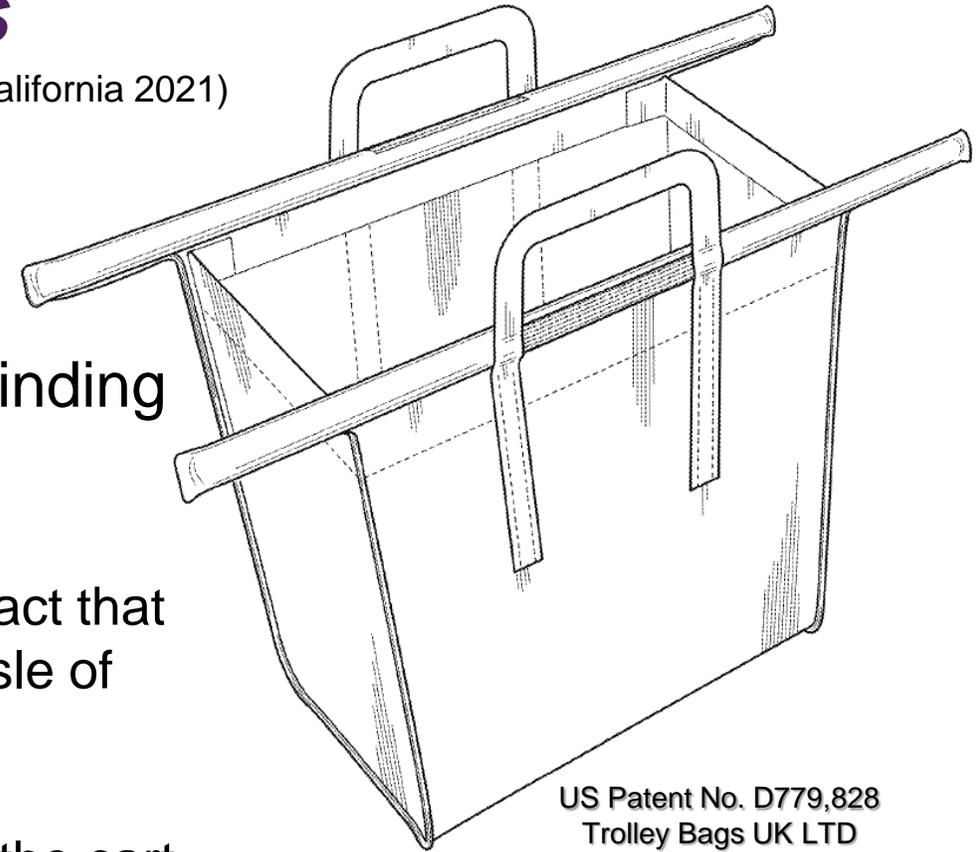
Golden Eye Media v. Trolley Bags

Golden Eye Media USA, Inc. v. Trolley Bags UK Ltd., 525 F.Supp.3d 1145 (S.D. California 2021)

The court also concluded that Trolley Bags’ **advertising** “tout[s] functional features of the design. As a result, this factor weighs in favor of a finding of functionality.”

“the advertisements reference the durability of the bags, the fact that they can expedite checkout time, and that they ease ‘the hassle of holding bags open.’ These advertisements emphasize purely functional rather than ornamental features. Further, the advertisements tout how the bags fan out and spread across the cart, which is due to the horizontal poles.”

Trolley Bags is on **appeal to the Federal Circuit**. Stay tuned.



Does the court conflate features of the commercial product with functional limitations on the design as a whole?



Claim Construction

Design Patent Claim Construction

“The preferable course ordinarily will be for a district court **not to attempt to ‘construe’ a design patent claim** by providing a detailed verbal description of the claimed design.”

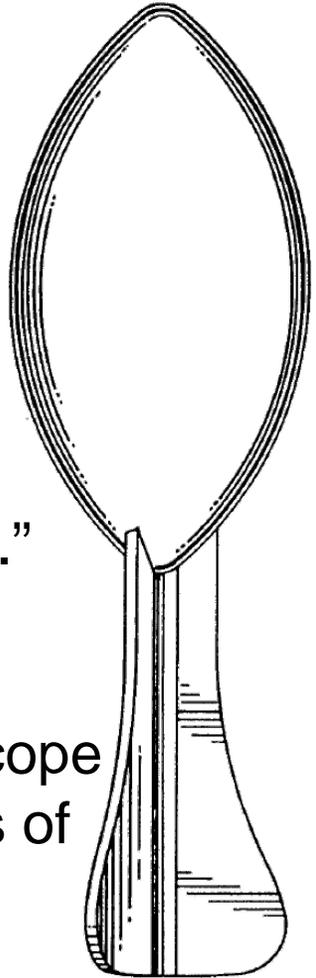
BUT...

The trial court “can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. These include such matters as ... **distinguishing between those features of the claimed design that are ornamental and those that are purely functional.**”

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F. 3d 665 (Fed. Cir. 2008)

“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”

OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396 (Fed. Cir. 1997)



Richardson v. Stanley Works

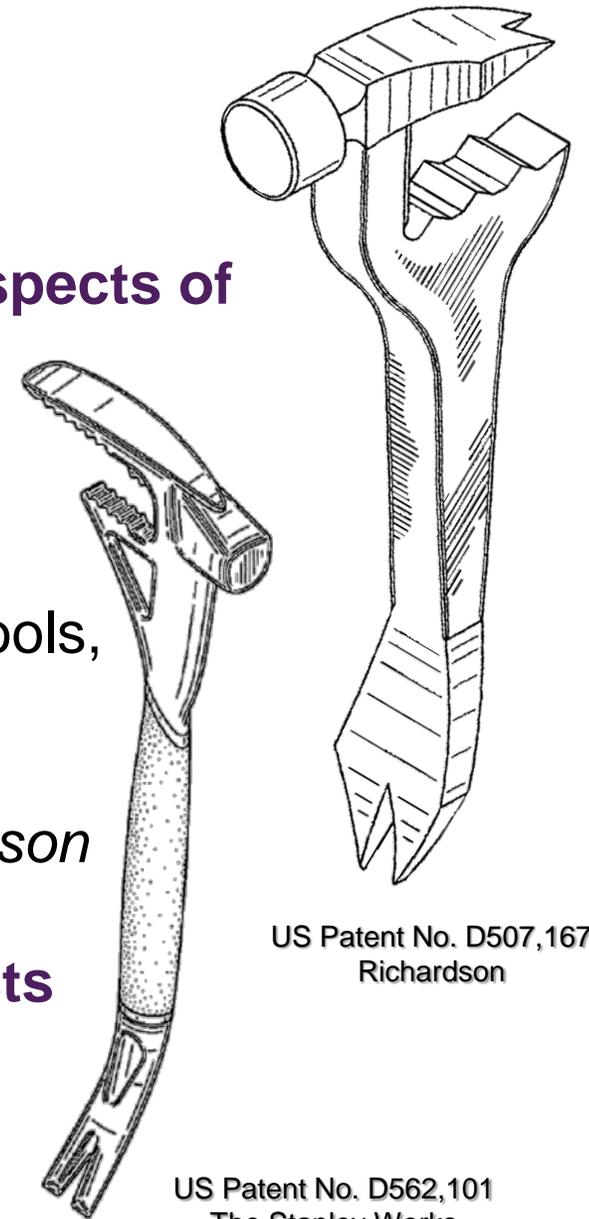
Richardson v. Stanley Works, Inc., 597 F. 3d 1288 (Fed. Cir. 2010)

“The district court here **properly factored out the functional aspects of Richardson’s design** as part of its claim construction.”

handle, hammerhead, jaw, crowbar

“We also agree that, **ignoring the functional elements** of the tools, the two designs are indeed different.”

The Federal Circuit clarified in *Apple v. Samsung* that in *Richardson* it was **not “excluding” or “ignoring” functional components**. “Rather, the claim construction **included the ornamental aspects** of those components.”

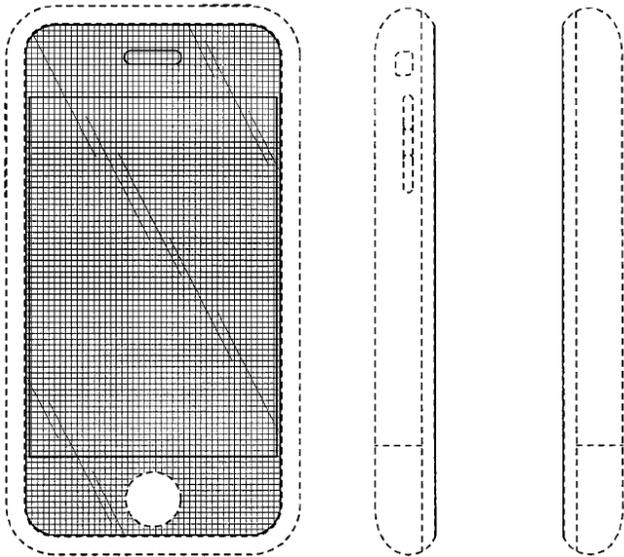


Apple v. Samsung

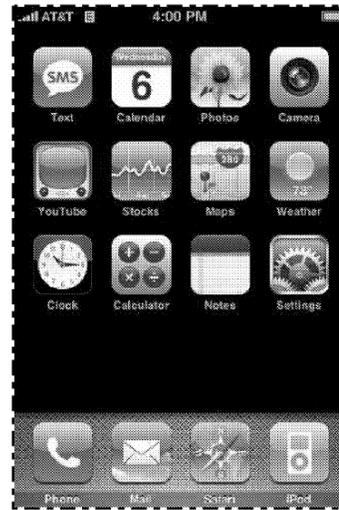
Apple Inc. v. Samsung Electronics Co., Ltd., 786 F. 3d 983 (Fed. Cir. 2015)

Apple sued Samsung for infringement of 3 design patents.

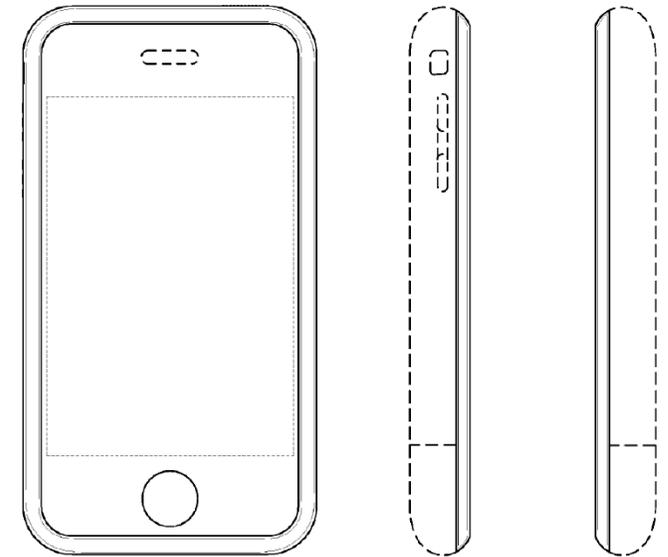
On appeal, Samsung argued that under *Richardson* the identified functional aspects of the patented designs should be **ignored** from the claim scope.



US Patent No. D618,677
Apple Inc.



US Patent No. D604,305
Apple Inc.



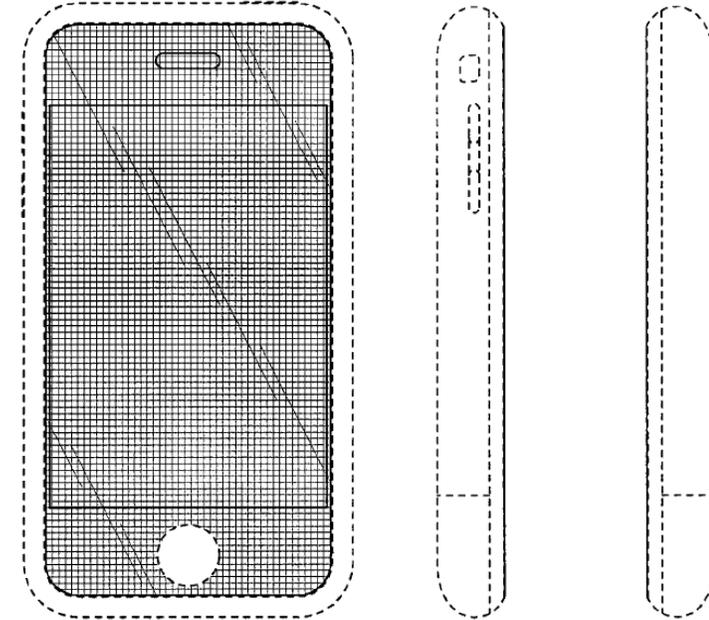
US Patent No. D593,087
Apple Inc.

Apple v. Samsung

Apple Inc. v. Samsung Electronics Co., Ltd., 786 F. 3d 983 (Fed. Cir. 2015)

Sample jury instruction on claim construction:

The D'677 Patent claims the ornamental design of an electronic device as shown in Figures 1-8. The broken lines in the D'677 Patent constitute unclaimed subject matter. The use of solid black surface shading on the D'677 Patent represents the color black. The use of oblique line shading on the D'677 Patent is used to show a transparent, translucent, or highly polished or reflective surface.



US Patent No. D618,677
Apple Inc.

Apple v. Samsung

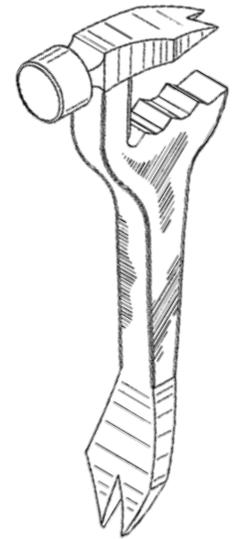
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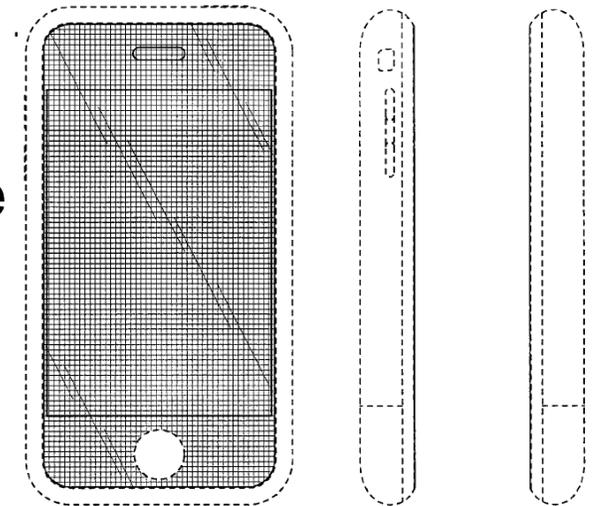
“Rather, the claim construction included the **ornamental aspects** of those components:

‘the standard shape of the hammer-head, the diamond-shaped flare of the crow-bar and the top of the rounded neck, the orientation of the crow-bar relative to the head of the the plain, undecorated handle.’”

Discounting functional elements must not convert overall infringement test to an element-by-element comparison



US Patent No. D507,167
Richardson



US Patent No. D618,677
Apple Inc.

Sport Dimension v. Coleman

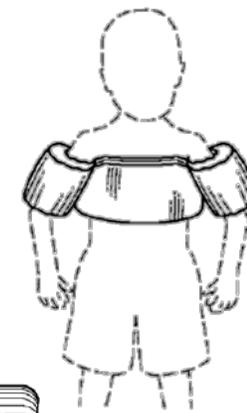
Sport Dimension Inc. v. Coleman Co., 820 F.3d 1316 (Fed. Cir. 2016).

The district court construed Coleman’s design for a “Personal Flotation Device” to exclude “the left and right armband, and the side torso tapering,” as “**functional and not ornamental.**”

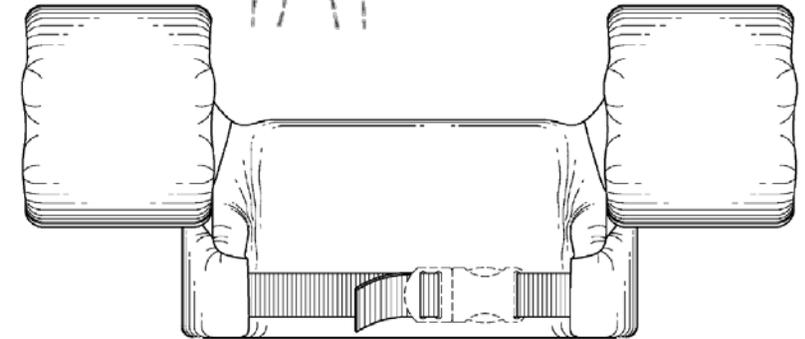
The Federal Circuit found fault with this:

“In *OddzOn*, *Richardson*, and *Ethicon*, we construed design patent claims so as to assist a finder of fact in **distinguishing** between functional and ornamental features. But **in no case did we entirely eliminate a structural element from the claimed ornamental design, even though that element also served a functional purpose.**”

The district court’s construction in this case conflicts with that principle of design patent claim construction because it **eliminates whole aspects** of the claimed design.”



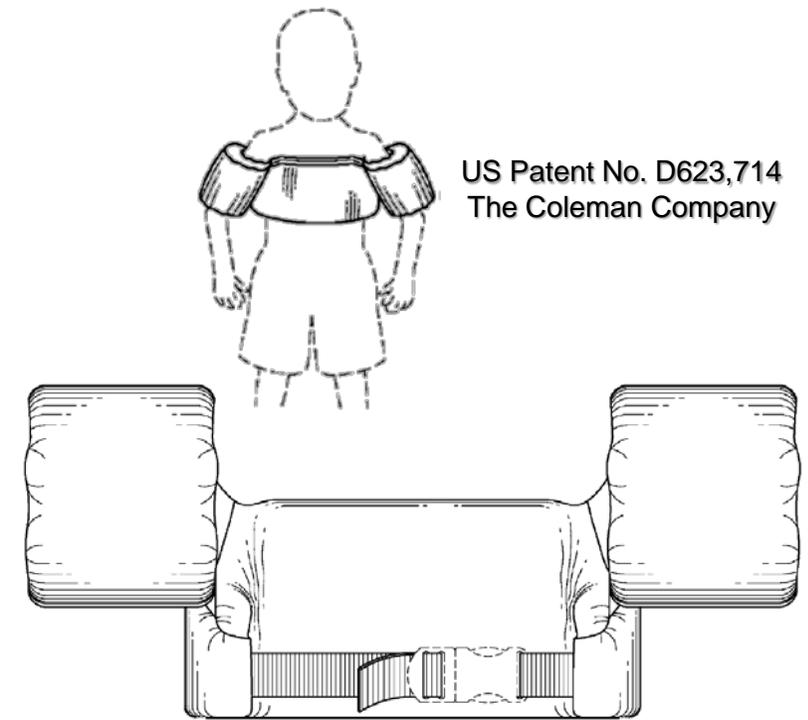
US Patent No. D623,714
The Coleman Company



Sport Dimension v. Coleman

Sport Dimension Inc. v. Coleman Co., 820 F.3d 1316 (Fed. Cir. 2016).

“The design includes the shape of the armbands and side torso tapering, to the extent that they contribute to the overall ornamentation of the design.... However, the armbands and side torso tapering serve a functional purpose, so the fact finder should not focus on the particular designs of these elements when determining infringement, but rather focus on what these elements contribute to the design’s overall ornamentation.”



Expert Assistance

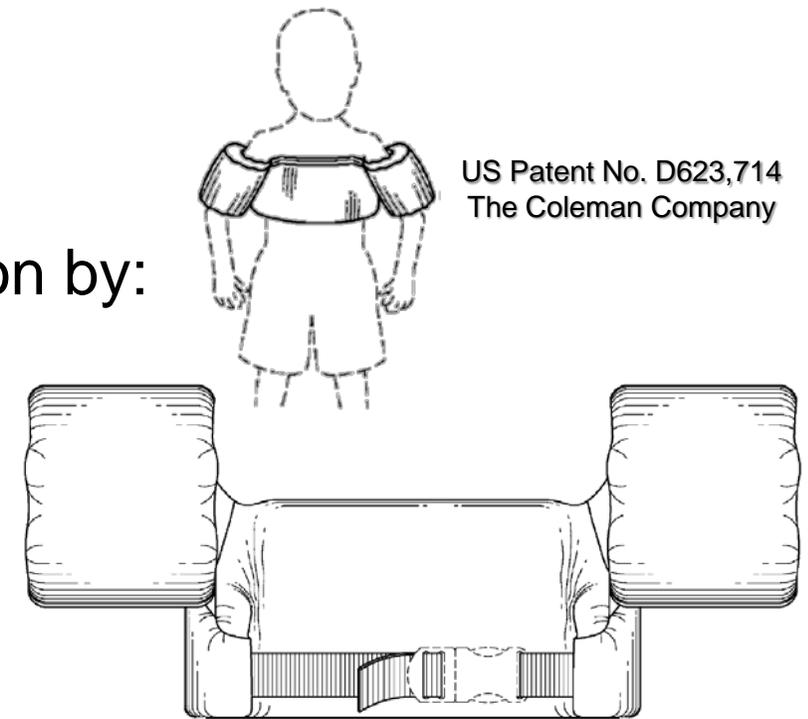
An expert can help support a proposed claim construction by:

- Speaking to the visual features of the design from the perspective of the **Ordinary Observer**.

What would *they* notice?

An expert should have experience with products of the type at issue.

- Certain products, **especially those with unique technologies, might require** specific knowledge of the functional features of a product to understand the relationship with the ornamental features.

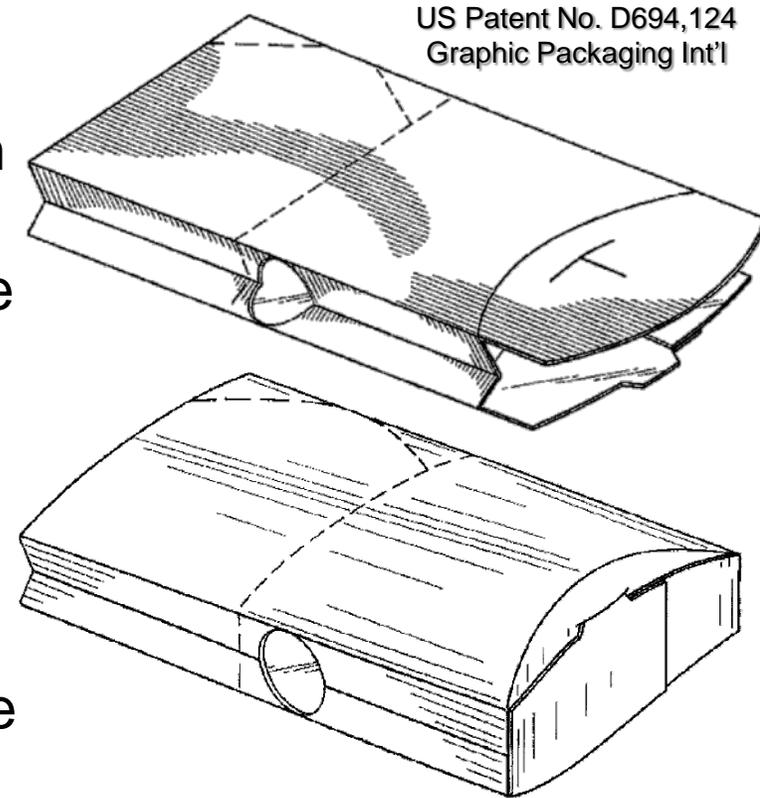


Graphic Packaging v. Inline Packaging

Graphic Packaging International, LLC v. Inline Packaging, LLC, 2019 WL 4786148 (D. Minnesota, 2019).

Graphic Packaging’s design for a “Carton” was designed for heating and carrying food products like HOT POCKETS. At claim construction, Inline Packaging contended that the designs were primarily functional and should be construed as having “no scope because there are no non-functional aspects of the design.”

The court rejected Inline’s construction. Inline misunderstands ornamental as the opposite of functional. “But the law is clear that **‘ornamental’ and ‘functional’ are not opposite**; a design or its elements may serve a function and still possess protectable ornamentation.”

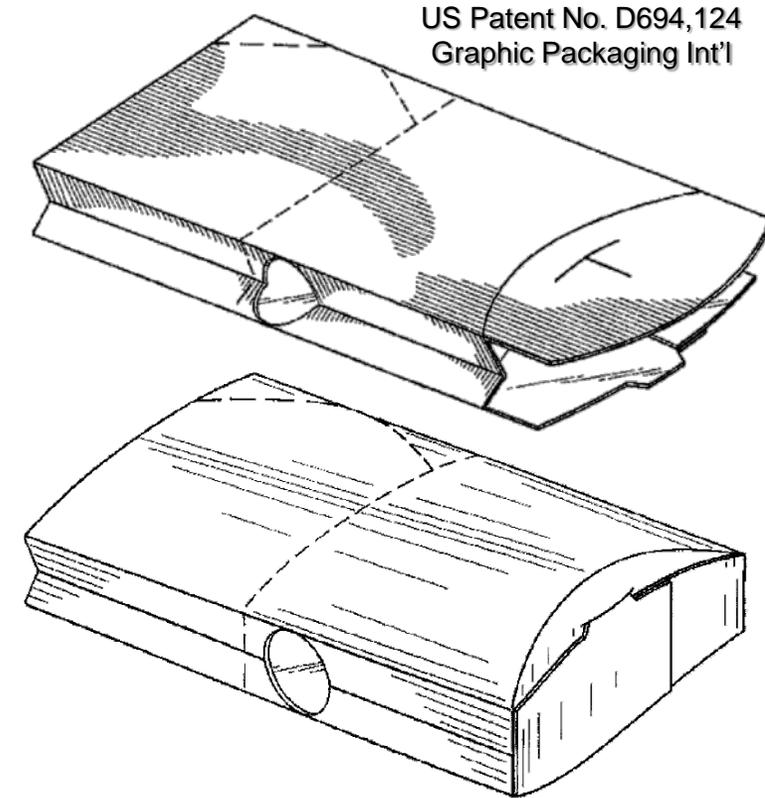


Graphic Packaging v. Inline Packaging

Graphic Packaging International, LLC v. Inline Packaging, LLC, 2019 WL 4786148 (D. Minnesota, 2019).

The court found the presence of **alternative designs** to be the most important factor in the assessing functionality, and that it weighed in favor of patentability here.

There was **evidence** of alternative designs, which Inline appears to have admitted would have the same functionality as the claimed design. But Inline thought that this proved that the design was functional, when in fact it proved the opposite.

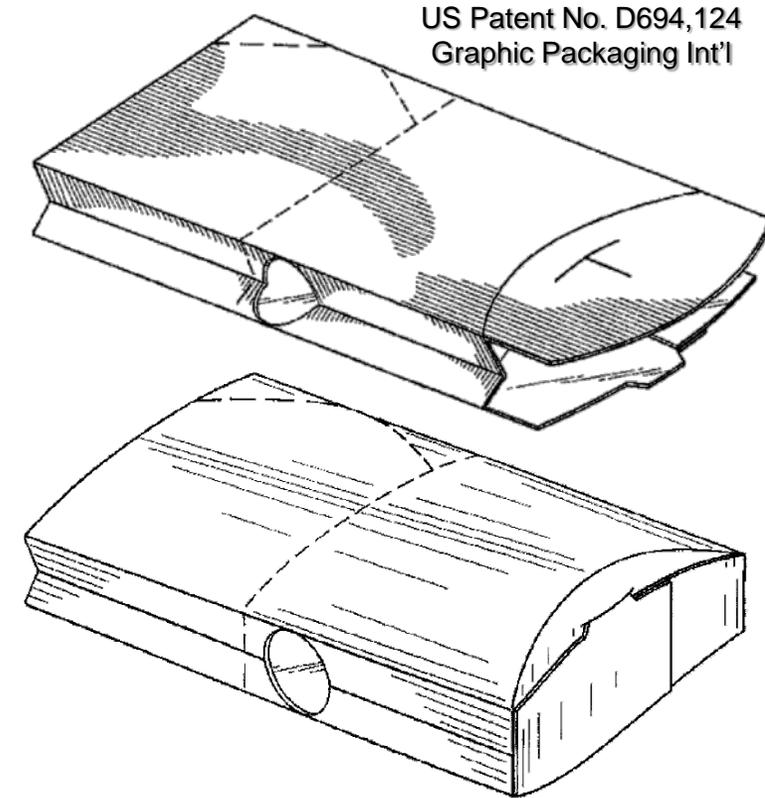


Graphic Packaging v. Inline Packaging

Graphic Packaging International, LLC v. Inline Packaging, LLC, 2019 WL 4786148 (D. Minnesota, 2019).

The court ultimately adopted Graphic’s proposed construction: the visual appearance of the susceptor sleeves as shown in the claim drawings.

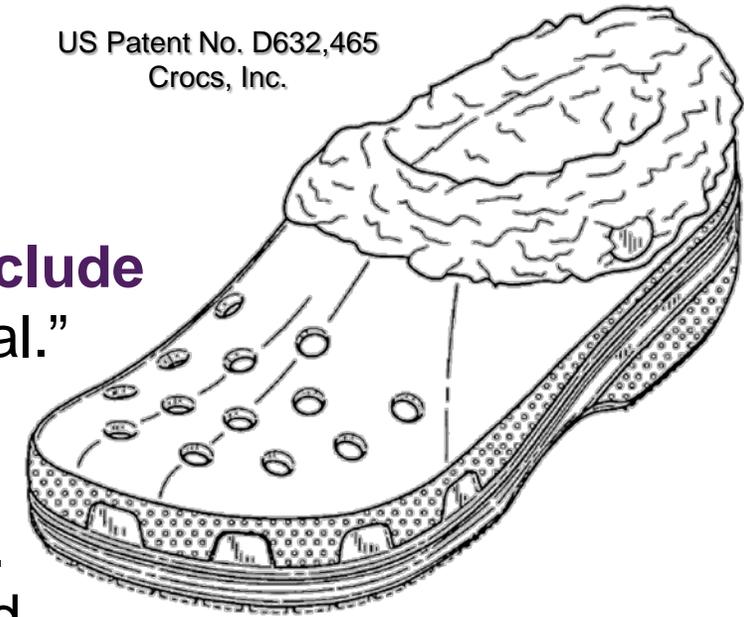
“This is a case where verbal elaboration construing the claimed designs is not necessary or helpful.” Doing so would “risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.”



Crocs v. Effervescent

Crocs, Inc. v. Effervescent, Inc. et al., 2021 WL 952231 (D. Colorado, 2021).

US Patent No. D632,465
Crocs, Inc.



The court considered whether the claim construction “should **exclude** the presence of the fur ‘in-sock’ because that feature is functional.”

Defendants argued that the fur lining was a “functional element that is **dictated by** its functional purpose”—to keep a foot warm. And that “fleece or fur is universally recognized as functional and without any ornamental purpose.”

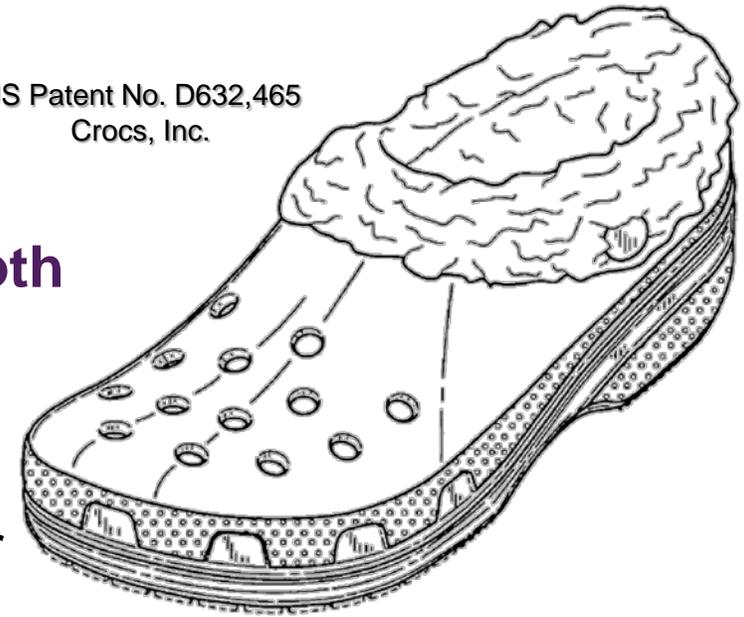
Crocs countered that fur can be “utilized in **placement and style**” in different ways, indicating that its specific placement in the ‘465 patent may have ornamental value distinct from its functional purpose.

Both Crocs and Defendants referred to Crocs’s **advertising** and **utility patents** to support their positions.

Crocs v. Effervescent

Crocs, Inc. v. Effervescent, Inc. et al., 2021 WL 952231 (D. Colorado, 2021).

US Patent No. D632,465
Crocs, Inc.



The Court found Crocs’s **advertising** to show that fur **can be both functional and ornamental**: The fur gives “Crocs’ original clog *design a cozy twist*”

The Court found none of the cited utility **patents** to show that fur is **only for** warmth.

Ultimately the Court agreed with Crocs: “**the fact that the fur may serve a function – warmth – does not mean that the Court must exclude the fur from the design patent**.... Were warmth the only reason for the lining, it is not clear fur or fleece that hangs over the sidewall would be the ‘best’ design or the most effective.”

The court appears to put primacy on the availability of alternative designs.

The court emphasizes that a feature can have *both* functional and ornamental aspects.

Takeaways

- Functionality can be a **defense** to patent infringement and a **factor** in claim construction
- In either case, the design must be considered **as a whole**, not element-by-element
- Fact that an article **performs a function** (e.g., warms the foot) does not make its design ineligible for patent protection
- Carefully prosecute related **utility patent** applications
- Carefully review **advertising** claims touting useful features of a design
- **All ornamental aspects** of a design must be considered in claim construction, even those of functional features
- A best practice for patent applicants may be to not claim **purely functional** features in prosecution to avoid the issue



Doctrine in Prosecution

Functionality at the USPTO

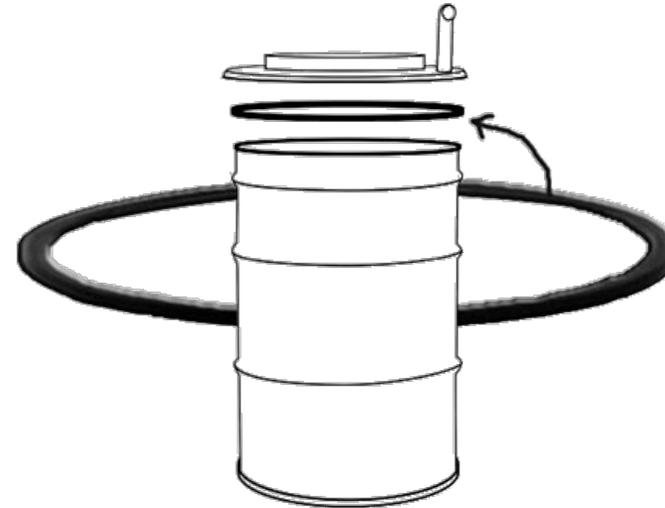
- Rejections under § 171
 - Lacks ornamentality
 - Hidden in use

- Rejections under §§ 102 & 103
 - Ignoring portions that lack ornamentality or are hidden in use

§ 171 Rejection: Lacks Ornamentality

- USPTO relies on *In re Carletti* for the proposition that designs must be “created for the **purpose of ornamenting**”
 - But *Carletti* actually says the reverse. It *concludes* an article was not created for purpose of ornamenting when its design was dictated solely by function

In re Carletti, 328 F. 2d 1020 (CCPA 1964)



§ 171 Rejection: Lacks Ornamentality

- USPTO cites *L.A. Gear* for the proposition that designs must be **“primarily ornamental”**
- But *L.A. Gear* holds the ultimate question to be whether the design is **dictated by “utilitarian purpose”**

L.A. Gear, Inc. v. Thom McAn Shoe Company, 988 F. 2d 1117 (Fed. Cir. 1993)

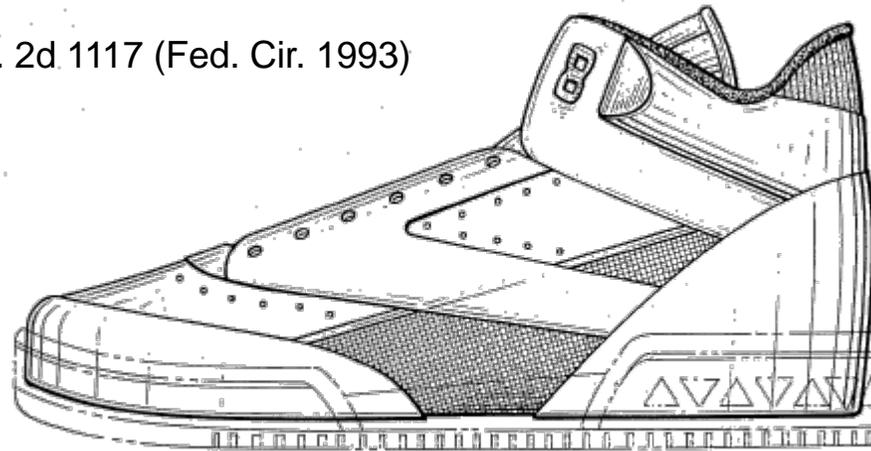


Fig. 1.

US Patent No. D299,081
L.A. Gear, Inc.

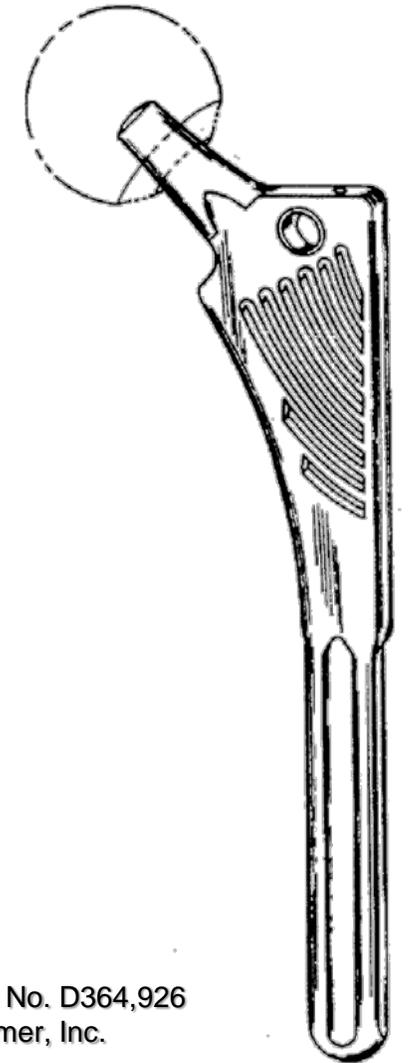
§ 171 Rejection: Hidden in Use

- The USPTO may reference *In re Stevens* in support of a rejection that uses a design's **lack of visibility** during its “normal and intended use” to show that its design is not a “matter of concern.”

In re Stevens, 173 F.2d 1015 (CCPA 1949)

- The Fed Cir, in *In re Webb* (1990) considers “normal and intended use” to include **any point in the article’s useful life** from manufacture to destruction, including sale and display.

In re Webb, 916 F.2d 1553 (Fed. Cir. 1990)



US Patent No. D364,926
Zimmer, Inc.

FIG. I

Ornamentality in §§ 102 and 103 rejections

MPEP § 1504.03 (citing CCPA and district court decisions from the 1950s):

- “When a claim is rejected under 35 U.S.C. 102 as being unpatentable over prior art, those features of the design which are functional and/or hidden during end use may not be relied upon to support patentability.”
- “When a claim is rejected under 35 U.S.C. 103 as being unpatentable over prior art, features of the design which are functional and/or hidden during end use may not be relied upon to support patentability.”

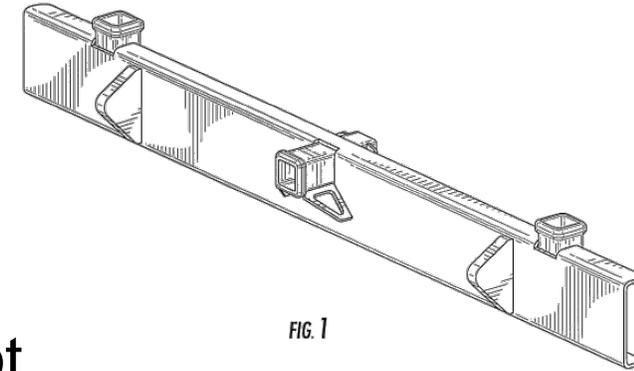


FIG. 1

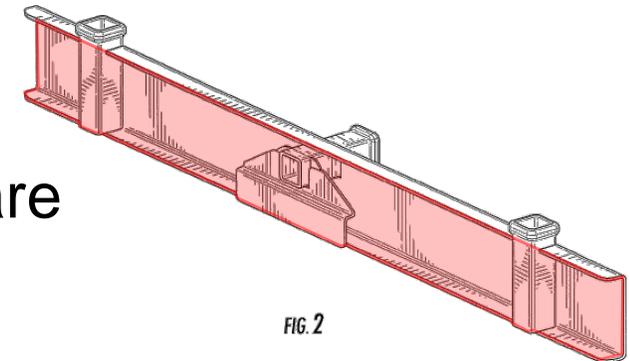


FIG. 2

Ornamentality in §§ 102 and 103 rejections

- Should the ornamentality doctrine be applied to “**factor out**” claimed parts of a design when determining scope for patentability before the Office?
 - *Apple v. Samsung*: Functional features not excluded
 - *L. A. Gear*: View the claimed design in its entirety
- At what point in an obviousness analysis is factoring out permitted (if at all)?
 - *In re Rosen*: Claimed design **as a whole** must be considered to identify a primary reference

In re Rosen, 673 F.2d 388 (CCPA 1982)

Takeaways

- When confronted with a functionality challenge, remember:
 - **Ornamentality** is the threshold, not “non-functionality”
 - Ornamental and functional can largely **overlap**

- Ask: Is the **design** really **dictated by** its function?

Takeaways

- Level of **abstraction**
 - Is the USPTO considering too specific a “function”?
- Sale and display, third-party commentary
 - Show the design is a “**matter of concern**”
- **Alternative designs**
 - Show the design is not dictated solely by its function
 - Show evidence that alternative designs are possible
 - Expert declaration, other patents, third party advertising, commissioned work, etc.

Thank you

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