

KT Design Patent Primer

Patent Eligibility of Articles “Hidden in Use”



Is an article “hidden in its normal use” eligible for design patent protection?



Yes, an article “hidden in use” is protectable so long as the ornamental features are of consumer concern at some point in its commercial lifetime.

35 USC 171: Eligibility of Articles Hidden in Use for Design Patents

- Articles being hidden in normal/final use is not, alone, a *prima facie* showing of ineligible subject matter for design patents.
 - One must consider the entirety of its commercial life from the moment manufacturing/assembling ends.¹
- To issue a §171 rejection, the examiner must demonstrate *prima facie* that a claimed design lacks ornamentality based on an evaluation of the appearance of the design itself.²
 - Ex: Vacuum cleaner brush replacement, in commercial lifetime, often are not noticed for ornamentality and assessed only for functionality, even if the brush may be visible.³ MAYBE not ornamental.
 - Ex: Vitamin tablets, or caskets, are often noticed for ornamentality, despite being hidden entirely in ultimate use. YES ornamental.

Validity Challenge for Design Patents in Litigation

- Aesthetic-functionality recently declined to extend to design patents.⁴
- Infringer must demonstrate by “clear-and-convincing” standard that patent protects function rather than ornamentation.⁵
 - Matter-of-concern test: does a consumer care about the particulars of design/ornamentation at some point in its commercial life?

¹ *In re Webb*, 916 F.2d 1553 (Fed. Cir. 1990).

² *Prima facie* showing requires wholistic examination with sufficient evidentiary basis.

³ In determining this, the court decided that this was a true replacement, as opposed to a part designed on the basis of its matching part, as in *Motorola v. Alexander Mfg. Co.*, which discussed a design patent for a battery cover being made for its respective housing being design patent eligible.

⁴ *Automotive Body Parts Assoc. v. Ford Global Tech., LLC*, 293 F. Supp.3d 690 (E.D. Mich. 2018).

⁵ *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 13123, 1328 (Fed. Cir. 2015).