

Richardson v. Stanley Works, Inc.

No. 09-1354, Fed. Cir. (Lourie,* Dyk, Kendall)

The ordinary observer test similarly applies in cases where the patented design incorporates numerous functional elements. In evaluating infringement, we determine whether “the deception that arises is a result of the similarities in the overall design, not of similarities in ornamental features in isolation.”

On March 9, 2010, the Federal Circuit affirmed the district court’s judgment that Stanley did not infringe U.S. Patent D507,167, which related to a multi-function carpentry tool known as the Stepclaw that combines a conventional hammer with a stud climbing tool and a crowbar. The Federal Circuit stated:

The district court here properly factored out the functional aspects of Richardson’s design as part of its claim construction. By definition, the patented design is for a multi-function tool that has several functional components, and we have made clear that a design patent, unlike a utility patent, limits protection to the ornamental design of the article. If the patented design is primarily functional rather than ornamental, the patent is invalid. However, when the design also contains ornamental aspects, it is entitled to a design patent whose scope is limited to those aspects alone and does not extend to any functional elements of the claimed article.

Richardson’s multi-function tool comprises several elements that are driven purely by utility. As the district court noted, elements such as the handle, the hammer-head, the jaw, and the crowbar are dictated by their functional purpose. The jaw, for example, has to be located on the opposite end of the hammer head such that the tool can be used as a step. The crowbar, by definition, needs to be on the end of the longer handle such that it can reach into narrow spaces. The handle has to be the longest arm of the tool to allow for maximum leverage. The hammer-head has to be flat on its end to effectively deliver force to the object being struck. As demonstrated by the prior art, those are purely functional elements whose utility has been known and used in the art for well over a century. . . . We find no error in the court’s claim construction. . . .

We agree with the court’s finding of noninfringement. Design patent infringement is a question of fact, which a patentee must prove by a preponderance of the evidence. In *Egyptian Goddess*, we held that “the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed.” The patentee must establish that an ordinary observer, familiar with the prior art designs, would be deceived

into believing that the accused product is the same as the patented design. In our recent Crocs decision, we set out in detail how an ordinary observer analysis could be conducted to determine infringement. In analyzing whether a design patent on footwear was infringed, noting the various differences that could be found between the two pieces of footwear in question, we compared their overall effect on the designs. We looked to ornamental elements such as the curves in the design, the strap assembly, and the base portion of the footwear. We concluded that both the claimed design and the accused designs contained those overall ornamental effects, thereby allowing for market confusion.

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We do not agree with Richardson that the district court failed to apply the ordinary observer test in finding no infringement. . . . We also agree that, ignoring the functional elements of the tools, the two designs are indeed different. Each of the Fubar tools has a streamlined visual theme that runs throughout the design including elements such as a tapered hammer-head, a streamlined crow-bar, a triangular neck with rounded surfaces, and a smoothly contoured handled. In a side-by-side comparison with the '167 patent design, the overall effect of this streamlined theme makes the Fubar tools significantly different from Richardson's design. Overall, the accused products clearly have a more rounded appearance and fewer blunt edges than the patented design. The court therefore was not clearly erroneous in concluding that the accused products embody an overall effect that cannot be found in the '167 patent design and hence cannot cause market confusion.

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