

# Client Alert

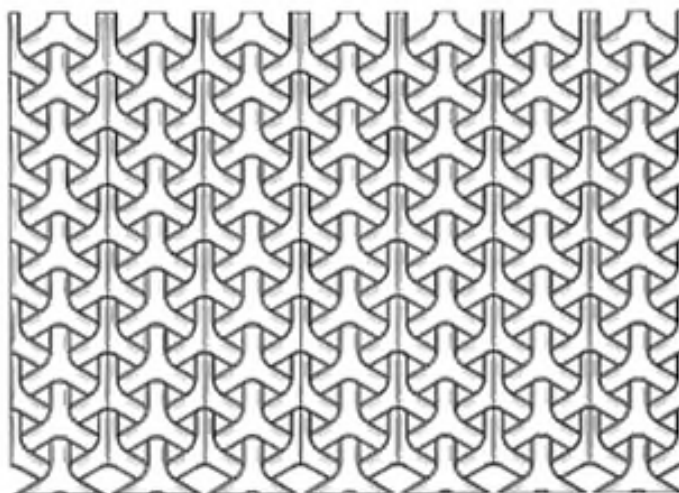
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## Are You Sitting Down? Design Patent Claim Language Limits Scope of Protection

On September 12, 2019, in a case of first impression, the United States Court of Appeals for the Federal Circuit issued its [opinion](#) in *Curver Luxembourg, SARL v. Home Expressions Inc.*, concluding that the claim language of a US design patent that specifies an article of manufacture can limit the scope of the design patent, even if the specified article of manufacture is not illustrated in any of the design patent's drawings.

By way of background, a design patent is intended to protect a “new, original and ornamental design for an article of manufacture.” 35 U.S.C. § 171(a). Critically important is that a design patent does not protect a design *per se*; instead a design patent is granted only for a design applied to an article of manufacture. Moreover, the scope of a design patent is defined by its claim, which “shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.” 37 C.F.R. § 1.153(a).

The *Curver* case involved Curver's design patent, U.S. Design Patent No. D677,946, entitled “Pattern for a Chair.” Despite its title, the figures of the '946 patent illustrate an “overlapping ‘Y’ design” disembodied from any article of manufacture, including a chair. Figure 1 of the '946 patent is reproduced below:



**FIG. 1**

Consistent with § 1.153(a), the claim of the '946 patent states, “The ornamental design for a pattern for a chair, as shown and described.” However, when originally filed, the claim stated, “The ornamental design for a rattan design for a furniture part, as shown and described.” Upon examination at the United States Patent and Trademark Office, the Examiner suggested changing “rattan design for a furniture part” to “pattern for a chair,” on the basis that a “part” is “not an article of manufacture and is too vague.” Curver made the suggested change, whereupon the application proceeded to grant.

Curver sued Home Expressions in the United States District Court for the District of New Jersey for infringement of the '946 patent, alleging that Home Expressions infringes based on the manufacture and sale of baskets, as shown below, “that incorporate an overlapping ‘Y’ design similar to the pattern disclosed in the '946 patent.”



The district court granted Home Expressions’s motion to dismiss Curver’s complaint for failing to set forth a plausible claim of infringement, after construing the '946 patent claim to be limited to the design pattern illustrated in the patent’s figures as applied to a *chair*. The court concluded that an ordinary observer would not purchase Home Expressions’s *basket* with the ornamental “Y” design believing that the purchase was for an ornamental “Y” design applied to a *chair*, as protected by the '946 patent. Curver appealed, arguing that the district court improperly relied on the claim language referring to “a chair” rather than focusing on the figures, which are devoid of any chair illustrations.

The Federal Circuit affirmed the district court’s grant of Home Expressions’s motion to dismiss, “address[ing] for the first time whether claim language specifying an article of manufacture can limit the scope of a design patent, even if that article of manufacture is not actually illustrated in the figures” and holding that “claim language can limit the scope of a design patent where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures.”

In reaching its conclusions, the Federal Circuit recognized that a design patent only protects an article of manufacture, as opposed to a design *per se*. The Federal Circuit also relied on the prosecution history of the '946 patent, particularly the fact that Curver was required to designate a specific article of manufacture to secure grant of the patent, holding that “the scope of the '946 patent is limited by [Curver’s] amendments, notwithstanding the [Curver’s] failure to update the figures to reflect those limiting amendments.”

In light of this decision, it is clear that, in certain circumstances, the textual description in a design patent’s specification and claims may affect the scope of the design patent. As seen in *Curver*, this is particularly important when it comes time to assert—or defend against allegations of—infringement of a design patent in litigation.

## Contact

**Clifford A. Ulrich**  
culrich@HuntonAK.com

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