

# Curver Reaffirms Alice Analogue for Design Patents

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In ***Curver Luxembourg, SARL v. Home Expressions Inc.*** (No. 2018-2214, Fed. Cir. Sept. 12, 2019), the Federal Circuit affirmed the dismissal of a design patent infringement suit that alleged infringement of U.S. Des. Pat. No. D677,946 (the “’946 Design”), entitled “Pattern for a Chair.” The plaintiff sought to enforce the ’946 Design that claimed an ornamental design shown in the context of a chair against a *basket* that was alleged to use the claimed pattern. In essence, the plaintiff was seeking to protect its design in the abstract. The Federal Circuit agreed with the district court that the scope of the claim was limited to the article of manufacture that embodied the claimed ornamental design and affirmed the order dismissing the case for failure to state a claim under Fed. R. Civ. 12(b)(6).

Although 35 U.S.C. § 171 permits patents protecting “a new, original and ornamental design for *an article of manufacture*,” the figures of the ’946 Design did not identify any such article. Nonetheless, both the district court and the Federal Circuit construed the scope of ’946 Design as being limited to a chair based on its title of “Pattern for a Chair” and the claim’s recitation of “The ornamental design for a pattern for a chair, as shown and described.” As such, the claim scope did not encompass other articles of manufacture, such as baskets, even if the design on the basket was identical to the claimed design. The Federal Circuit emphasized that it “has never sanctioned granting a design patent for a surface ornamentation *in the abstract* such that the patent’s scope encompasses every possible article of manufacture to which the surface ornamentation is applied.” Slip op. at 7 (emphasis added).

Speaking more broadly and recognizing the longstanding position in precedent, USPTO practice, and regulation “that design patents are granted only for a design applied to an article of manufacture and not a design *per se*,” the Federal Circuit held that “the claim language can limit the scope of a design patent where [it] supplies the only instance of an article of manufacture that appears nowhere in the figures.” *Id.* at 8. The Federal Circuit explained that this served to “provide[] more accurate and predictable notice about what is and is not protected by the design patent.” *Id.* at 9 & n.3.

*Curver* seems most applicable to patented designs directed to “surface ornamentation,” rather than those directed to, for example, the shapes of particular parts or components. Nevertheless, portfolio owners should be aware that even design patents directed to the shapes of components themselves could be vulnerable under *Curver* if they are asserted against articles of manufacture distinct from those claimed - or even disclosed - in the design patent.

Given the procedural posture of the case—a Motion to Dismiss for failure to state a claim under FRCP 12(b)(6)—and the attack on the breadth of the patent as directed to an abstract design rather than the design for a particular article of manufacture, *Curver* can be viewed as the design patent analogue of *Alice v. CLS Bank*, 573 U.S. 208 (2014), only applying 35 U.S.C. § 171 instead of 35 U.S.C. § 101. In defending design patent infringement claims, *Curver*

thus presents similar opportunities for early disposition of design patent infringement claims based on efforts to assert a patented design in the abstract rather than as limited to a particular concrete design *for a particular article of manufacture* as the corresponding subject matter statute requires.

From the prosecution and portfolio perspectives, *Curver* teaches that design applications should be carefully reviewed before filing to ascertain whether they are directed to a particular “article of manufacture” in the drawings, title, and claim, and if so, whether a broader “article of manufacture” (such as “a structural panel”) can potentially be substituted for a particular object (e.g., “a chair” or “a basket”). However, in *Curver*, the “a chair” language was suggested by the Examiner during prosecution, who found the Applicant’s original use of “Furniture Part” too broad in view of the 37 CFR § 1.153 and MPEP § 1503(I)’s requirement that the title designate a “particular article” for the design, so applicants can reasonably expect the USPTO to seek to require specific identification of particular articles of manufacture. Accordingly, design patent applicants may want to consider filing multiple applications directed to both broader articles of manufacture (“a supporting seating surface”) and the specific market products that they wish to protect (“a chair”) as a belt-and-suspenders approach so that they can potentially assert the broader design patent against ancillary products without risking the grant or validity of the design protection on the articles of greatest concern.

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