

REVIVING ORNAMENTALITY

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The Patent Act requires that a patentable design be, among other things, “ornamental.” In determining whether a claimed design satisfies this requirement, the Federal Circuit has incorrectly conceptualized “ornamental” as the opposite of “functional” and will not invalidate a design unless it is dictated primarily or solely by function—*i.e.*, unless there are no alternative designs. Because there are almost always alternative designs, this test effectively reads the ornamentality requirement out of the statute. As a result, the PTO is granting—and courts are upholding—design patents for product designs that do not promote the progress of the decorative arts.

This article demonstrates how the Federal Circuit has gone astray and argues that the design patent requirement of ornamentality should not be viewed as a mere non-functionality requirement. Instead, it should be viewed as a requirement that the claimed design make a material aesthetic contribution to the finished product. That is not to say that a design must be “artistic” or “beautiful” or objectively attractive. But the appearance of the product—or the claimed part of the product—must at least plausibly matter to the ordinary end user for aesthetic, as opposed to utilitarian, reasons. Under this view, a design for a spare part for a car engine, a spine implant and the shape of an Apple Lightning connector would not qualify as ornamental, but a sleek design for a chair would. This conceptualization of ornamentality would better reflect the statutory language and would help prevent design patents from being used as *de facto* utility models by channeling any useful inventions into the utility patent regime, where they belong.