



DESIGN

LAW

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Design Patent Inventorship: A Square Peg in a Round Hoop

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Hoop v. Hoop

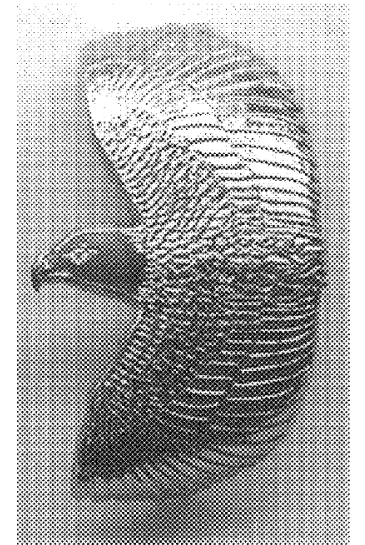
279 F.3d 1004 (Fed. Cir. 2002)

- Hoop brothers “conceive of” and sketch eagle-shaped fairing guard design
- Hoop brothers hire Hoop cousins to create detailed drawings
- Nov. 1999: Hoop brothers apply for patent with drawings created by cousins
- Mar. 2000: Hoop cousins apply for patent with photos of the same design

Hoop brothers’
design



Hoop cousins’
design



Hoop v. Hoop

279 F.3d 1004 (Fed. Cir. 2002)

- Federal Circuit applies utility standard of inventorship to design patents:
 - The inventor is the “person or persons who conceived the patented invention”
- Assisting the true inventor after conception of the claimed invention does not make one an inventor
- Ultimate test for inventorship: whether the second invention is “substantially similar” to the first to an “ordinary designer”
- Changes made to the design should be substantive and not merely superficial

Hoop v. Hoop

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- Considerations:
 - What does it mean to “conceive” of a design?
 - Can we fairly say the Hoop brothers "conceived of" all the details in the final drawings?
 - The design concept here: "eagle fairing guard with outstretched wings"

Hoop brothers'
design



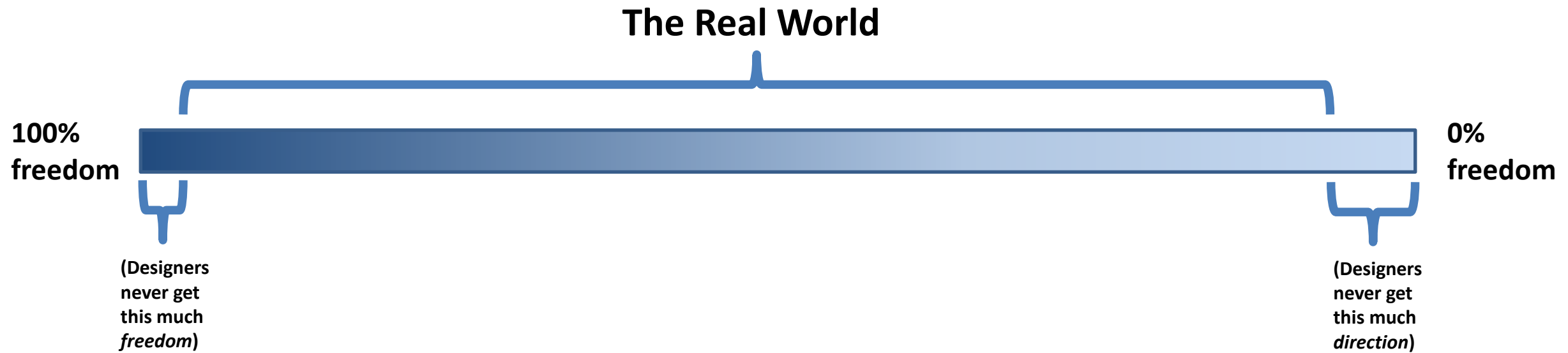
Hoop cousins'
design



Industrial Design

The Spectrum of Design Freedom

The Spectrum of Design Freedom



The Spectrum of Design Freedom

Example 1 – Highest Design Freedom

Brief:

- Sports Car
- "Sleek and Modern"
- Must have "standard car elements" - four wheels and windows

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Concept: A "Sleek and Modern" Sports Car



The Spectrum of Design Freedom

Example 2 – Higher Design Freedom

Brief:

- Unicorn Plush Toy
- Must be based on horse shape
- Must have one horn
- Must be white in overall color

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Concept: A unicorn plush toy



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Example 3 – High Design Freedom

Brief:

- Table Lamp
- Must have Mickey Mouse sculpture on base
- Must have a traditional lampshade shape

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Concept: A lamp with a Mickey Mouse character



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Example 4 – Medium Design Freedom

Brief:

- Ornament must be jaguar-shaped and shown "leaping"
- Must be made of highly polished metal
- Must fit on the front of an automobile hood

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Concept: A shiny, metal, leaping jaguar automobile hood ornament.



1930s Jaguar Hood Ornament



Later Jaguar Hood Ornament

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Example 5 – Lower Design Freedom

Brief:

- Spherical television unit
- Must have round fluted base with smooth transitions
- Must have controls on right side in recessed area
- Must be white in color

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Concept: A spherical television



The Spectrum of Design Freedom

Example 6 – Lowest Design Freedom

Brief:

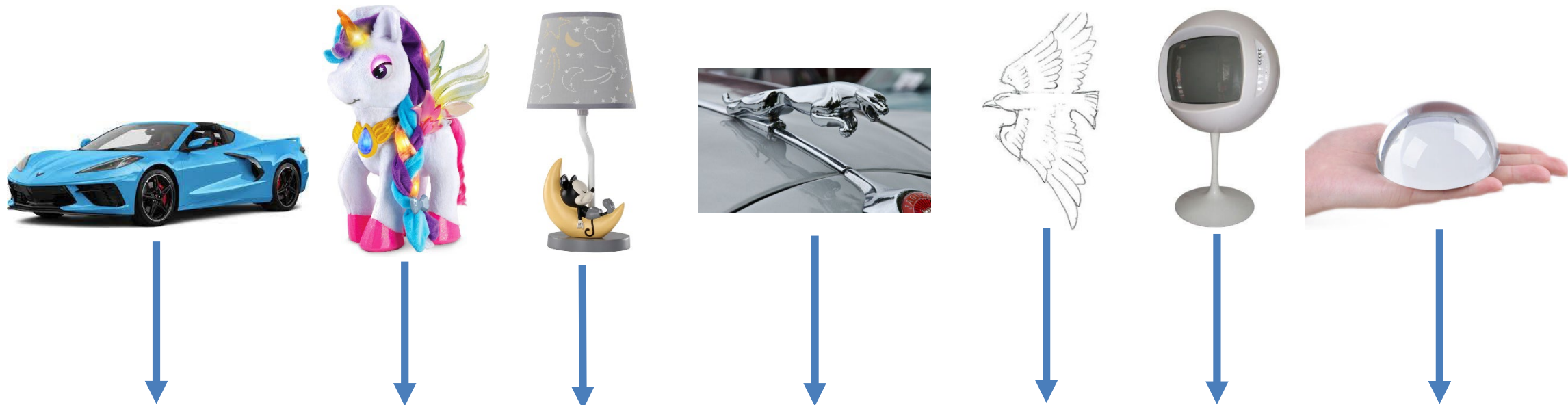
- Paperweight that is half a sphere
- Must have clear glass with no texture/decoration
- Must have sharp edges
- Must have opaque white base

The Spectrum of Design Freedom

Concept: A hemi-spherical, clear, glass paperweight w/ opaque white base



The Spectrum of Design Freedom



100%
freedom

0%
freedom

If any reasonable level of design freedom remains, design "input" *is not* design "conception"

If no more than *de minimis* level of design freedom remains, design "input" *is* design "conception"

After *Hoop*, what constitutes design patent inventorship and should it be based on utility patent “conception” principals?

Key passages from Hoop majority holding:

- Design patents may be obtained by “[w]hoever invents any new, original and ornamental design for an article of manufacture.” [35 U.S.C. § 171](#) (1994). *Hoop* at 1007.
- An inventor under the patent laws is the “person or persons who conceived the patented invention.” *C.R. Bard, Inc. v. M3 Sys.*, [157 F.3d 1340, 1352](#) (Fed. Cir. 1998). *Hoop* at 1007.
- “Minor differences between the prior art and the new claim will not suffice. *In re Zemon*, [40 C.C.P.A. 1051](#), [205 F.2d 317, 320](#), [98 USPQ 223, 224](#) (CCPA 1953). The differences here must be substantial and not just superficial; the new design must contain an inventive concept. *Id.*” *Hoop* at 1007.
- **“Noting the strong similarity between the drawings, the [district] court reasoned that [the Hoop cousins] merely refined and perfected the Hoop brothers’ concept.”** *Hoop* at 1008 (affirming) (emphasis added).

Key passages from Judge Lourie’s dissent:

- “The undisputed facts are that the Hoop brothers made a sketch of an eagle fairing design and asked [the Hoop cousins] to make three-dimensional drawings and models of that design. **In doing so, [the cousins] made a different design, one that differed from the original design of the brothers in several respects.**” *Hoop* at 1008 (emphasis added).
- “Design patents do not claim concepts. They claim specific designs set forth in their claims, which invariably refer to the appearance of what is illustrated in the patent’s drawings. [37 C.F.R. § 1.153\(a\)](#) (2001).” *Hoop* at 1009.
- Contrary to the conclusion of the district court, as the invention is not the concept of an eagle design, but only the specific claimed representation of that eagle, the “concept” of the design is not what one must look at in determining whether the inventions are one and the same or separate. *Hoop* at 1009.
- “What matters in determining whether the brothers are the inventors of the claimed design is whether, from the standpoint of an ordinary designer, the claimed design is the same as or different and patentably distinct from the brothers’ original design. See *In re Nalbandian*, [661 F.2d 1214](#) (Fed. Cir. 1981).” *Hoop* at 1009-10.

concept ≠ "conception"



How do we get back on the right path?

- Reinterpret "conception" in the caselaw not to mean appreciation of a design "concept"—since this isn't what design patents cover—but instead to mean appreciation of a specific, ornamental design.