

## **Attys Looking To Justices To Resolve Design Patent 'Mess'**

By **Ryan Davis**

*Law360 (August 14, 2026, 10:36 PM EDT)* -- Following a sharply divided order where the full Federal Circuit declined to reconsider the standards for design patent infringement, attorneys tell Law360 they hope the deep disagreements among the judges spur the U.S. Supreme Court to clear up precedent one called a "total mess."

In a 7-4 precedential order on Tuesday, the appeals court rejected a petition for en banc rehearing by Range of Motion Products LLC of a panel decision upholding a summary judgment ruling that its massage device patent was not infringed by Armaid Co. Inc.

The order came with both a concurring opinion saying that the court's current approach to design patent infringement is in line with longstanding high court precedent, and a forceful dissent maintaining that the court is flouting the law by letting judges decide design patent issues that belong with juries.

Counsel for Range of Motion said the company expects to seek Supreme Court review. Attorneys who spoke with Law360 about the case said if the justices take it up, they could straighten out design patent standards that appear to have strayed from the statute and become confusingly complex.

"If you take the premise that you believe in design rights, I just don't see how this doesn't strike you as a total mess," said Dunstan Barnes of McDonnell Boehnen Hulbert & Berghoff LLP.

### **"Plainly Dissimilar"**

The order denying rehearing split the court on two issues in design patent law. The first is whether the court's approach to infringement conflicts with the Supreme Court's 1871 ruling in *Gorham Manufacturing Co. v. White*, which said the analysis requires determining if an "ordinary observer" would find the patent and the accused design to be "substantially the same."

Range of Motion argued that the Federal Circuit's 2008 en banc decision in *Egyptian Goddess Inc. v. Swisa Inc.*, which set the current standard on the issue, included language that "inverts" the high court precedent by suggesting that the analysis can involve deciding whether the two designs are "sufficiently distinct" or "plainly dissimilar."

Range of Motion maintained that such an approach leads courts to wrongly focus on differences in the two designs rather than similarities, but the concurring opinion by U.S. Circuit Judge Tiffany Cunningham said the analysis "necessarily involves accounting for the ways in which they are similar and different."

In contrast, the dissent by U.S. Circuit Judge Kimberly Moore said "we have messed up design patent infringement" and eliminated a role for jurors in key questions by holding that judges can decide the designs are plainly dissimilar, which she said is a factual issue suited for a jury.

Chris Carani of McAndrews Held & Malloy Ltd. said the "plainly dissimilar" wording "really was just an inadvertent piece of dicta from Egyptian Goddess that has taken a new life as a free-standing test."

That approach has a number of problems, he said, as it focuses on differences instead of similarities, does not address from whose perspective the designs must be dissimilar, and is applied by courts in a vacuum, without taking into consideration the prior art. Those older designs provide context for determining how similar the design at issue is to the patent, he said.

"The court just didn't address those fundamental flaws with the test, and I fully suspect that they're going to be aired out at the Supreme Court," Carani said.

Perry Saidman of Perry Saidman LLC said what typically happens is that "a judge will easily find four or five differences between the patented design and the accused product, and without more say, well, they are sufficiently distinct or plainly dissimilar," adding: "This makes no sense to me."

In addition to not considering prior art, which leaves the judge with no frame of reference for comparing the designs, "there are always differences between the two designs: otherwise, we wouldn't be in court in the first place," he said.

John Hemmer of Morgan Lewis & Bockius LLP said that in many cases, design patent infringement issues should go to a jury, and courts could "reserve something that's plainly dissimilar for the extreme cases," where the product at issue looks very different from the patented design.

"If the standard is substantial similarity to an ordinary observer, who better to make that decision than someone on a jury?" he said.

Hemmer said that when looking at Armaid's massage device alongside Range of Motion's patent, which the judge found to be plainly dissimilar, they "seem close enough to me."

"I think that ultimately needs to be decided by a jury," he said. "That'll be helpful for the Supreme Court to step in and say that's the case."

Unless the standard changes, there will be more noninfringement rulings on the ground that the accused product is plainly dissimilar from the design patent, "where it just seems like that test has kind of been stretched beyond the breaking point," said Barnes of McDonnell Boehnen.

## **Ornamental v. Functional**

The second issue that divided the Federal Circuit involved the idea that design patents are intended to protect only ornamental features, so the infringement analysis requires distinguishing between the ornamental elements and the functional elements.

The concurring opinion held that judges must engage in claim construction to determine which elements of a design patent are functional and which are ornamental, saying it "guides the jury like a trail guide,

placing flags and signposts to delineate the boundaries of the claimed design."

Judge Moore's dissent questioned how a judge is better equipped than a jury to make that determination. She added that it is "entirely unclear" what the standard is for how the attributes deemed to be functional should be treated, and whether they should be discounted or excluded, the latter of which she said would conflict with precedent.

"For me, the answer is simple: the question of functionality is inextricably intertwined with the ultimate patent infringement question for the jury," she wrote.

Attorneys said they questioned the basic premise that functional elements of a design patent should be filtered out as part of the infringement analysis, as every part of a design necessarily has some function.

Carani said the functionality issue has been "wreaking havoc" on design patent law and has no basis in the statute, noting that attorneys have filed amicus briefs challenging the court's approach as far back as 2010.

"We've been jumping up and down waving our arms and saying SOS for well over a decade," he said.

When a design patent is issued, "you have a right to that indivisible whole" that was examined by the patent office, Carani said, "not some judicially edited version of that ... where you're hacking off and lopping off large portions of the design."

Saidman likewise said, "I've been beating this drum for years" that "virtually all designs consist of utilitarian elements, that is, elements which perform some sort of function."

The appearance of the entire design patent claim, including those elements, "must be taken into account in determining infringement," he said, adding: "They are not to be minimized, they are not to be factored out, they are not to be set aside and they're not to be ignored."

The precedent the court has cited to find that functional elements should be filtered out stood only for the concept that design patents don't protect the utility or those elements, only their appearance, Saidman said.

Carani said that in the en banc denial, the Federal Circuit judges debated whether judges or juries get to filter out functional elements, which he maintained is "like arguing who gets to use the scissors, without first asking whether anyone is entitled to cut up the picture."

A claim construction process that eliminates functional aspects of a design patent means that what is being compared to the accused product is only a "skeleton" of what was actually invented, Carani said, adding: "That's not claim construction. That's claim destruction."

Barnes said the idea of going through claim construction to discount functional elements of design "has bothered me for a long time."

After doing that with many design patents, "you would have zero claim scope because everything has some sort of function," he said, adding: "If it didn't have any function, we wouldn't be talking about a design patent. We'd be talking about a painting or a sculpture that's in an art gallery."

The odds are low of the Supreme Court taking any given case, and it has agreed to hear very few design patent cases. Still, attorneys said they could see a path for a certiorari grant in this case, particularly given the divide on the only appeals court that hears patent cases.

Saidman said the Supreme Court could be attracted to the issues since they involve the Seventh Amendment right to a jury trial on disputed factual issues, as well as the high court's 1996 precedent that claim construction in utility patent cases is an issue for the judge.

That decision was based on a finding that judges are better suited to interpret the words of patent claims, but design patents don't include words, only images, he pointed out.

Barnes said it's not clear whether the Supreme Court would agree to hear the case, but the issues seem like a promising candidate for review, given that "there certainly seems to be a pretty major rift between how the Federal Circuit judges are dealing with it."

The case is Range of Motion Products LLC v. Armaid Co. Inc., case number 23-2427, in the U.S. Court of Appeals for the Federal Circuit.

--Editing by Brian Baresch.