

*Appeal No. 2018-2214*

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IN THE  
**United States Court of Appeals**  
FOR THE FEDERAL CIRCUIT

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CURVER LUXEMBOURG, SARL,

*Plaintiff-Appellant,*

v.

HOME EXPRESSIONS INC.,

*Defendant-Appellee.*

—————  
*On Appeal from the United States District Court  
For the District of New Jersey, Case No. 2:17-cv-4079  
Honorable Kevin McNulty, Judge*

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**BRIEF ON BEHALF OF *AMICUS CURIAE*  
OPEN SOURCE HARDWARE ASSOCIATION  
IN SUPPORT OF DEFENDANT-APPELLEE  
AND AFFIRMANCE**

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*Date Completed: November 20, 2018*

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**CERTIFICATE OF INTEREST**

Pursuant to Federal Circuit Rules 29(a) and 47.4, counsel for *Amicus*

*Curiae* certifies that:

1. The full names of every party or *amicus* represented in the case by me are:  
The Open Source Hardware Association
2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:  
N/A
3. All parent corporations and any publicly held companies that own 10 percent or more of stock of any party or *amicus curiae* represented by me are:  
None
4. The names of all law firms and the partners or associates that appeared for the party or *amicus* now represented by me in the trial court or are expected to appear in this Court are:  
Erik Stallman and Jennifer M. Urban  
Samuelson Law, Technology and Public Policy Clinic  
University of California, Berkeley School of Law
5. Title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:  
None

November 20, 2018

Signed:           /s/ Jennifer M. Urban          

Jennifer M. Urban  
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**STATEMENT OF IDENTITY AND INTEREST OF AMICUS CURIAE<sup>1</sup>**

*Amicus curiae* the Open Source Hardware Association (“OSHWA”) is a non-profit organization that supports and advocates for the open-source hardware community. Open-source hardware designers make their project design files publicly available so that anyone can study, modify, or make the designs or hardware based on them.<sup>2</sup> The open-source hardware community is diverse. It consists of nonprofit organizations, businesses, and individual inventors, working everywhere from factories, to classrooms, to personal 3D printers in garages—but all members share a common interest in promoting innovation.

In order to foster the community’s growth and unite it around common principles, OSHWA hosts the Open Hardware Summit, provides a process for certifying hardware designs according to an agreed-upon definition of “open source,” and houses a directory of those certified hardware designs. OSHWA seeks to ensure that technological knowledge is accessible to everyone, and to encourage the collaborative development of technology that serves education, environmental sustainability, and human welfare.

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<sup>1</sup> No party’s counsel authored this brief in whole or in part. No person other than *amicus*, its members, or its counsel contributed money that was intended to fund preparing or submitting this brief. University of California, Berkeley, School of Law students George Laiolo and Kyle McLorg assisted in the preparation of this brief. Websites cited in this brief were last visited November 18, 2018.

<sup>2</sup> *About*, Open Source Hardware Association, <https://www.oshwa.org/about/>.

OSHTWA's only interest in this case is to preserve a balanced, clear scope of design patent protection. A large percentage of open-source hardware combines both ornamental and functional elements, and industrial design routinely involves applying design concepts from disparate fields in novel ways. To engage in this practice, open-source hardware designers need to know the universe of available source material and its limits. Further, understanding the licensing requirements of open-source hardware begins with understanding how the elements that make up that hardware may or may not be protected by existing law. Accordingly, while many creators of open-source hardware do not seek patent protection for their own creations, an understandable scope of design patent protection is nonetheless essential to their ability to collaborate with other innovators and innovate lawfully.

This brief is being tendered with a motion for leave to file this brief.



## **SUMMARY OF ARGUMENT**

A 3D-printed prosthetic hand that can be produced for under \$50. An electric fiddle that a user can 3D-print for \$250. A low-cost submersible drone that amateur explorers can build and use to visit unexplored ocean depths. A street-legal, café-racer-style motorcycle that can be built in a single weekend. Each of these creations owes its existence to the ingenuity of the open-source hardware community.

*Amicus* OSHWA endeavors to support these kinds of innovative projects and foster growth within the open-source hardware community. To engage in its collaborative model of innovation, this diverse community depends on a clear and balanced scope of design patent protection. Particularly as design patents attract interest from consumer technology manufacturers, design patent law must continue to reflect the interests of patent holders and the public, leaving room for collaboration.

Anchoring the patented design to the article of manufacture strikes the appropriate balance. It calibrates the scope of design patent protection to the patentee's contribution over the prior art. It avoids encumbering the novel and nonobvious *application* of prior designs to new articles of manufacture, a fundamental and inventive practice of industrial design. It aligns the scope of design patent protection with its purpose: encouraging the inventive application of

a design to an article of manufacture. And it is consistent with design patent law. The District Court in this case—and every district court that has considered the issue—correctly anchored the patented design to the article of manufacture when construing the patent.

By contrast, reading the article of manufacture out of the scope of the patented design would extend protection to abstract designs while significantly reducing the available design features open-source hardware and other innovators could use. This would burden innovation and thwart design patent law's underlying purpose. Yet expanding this protection to abstract designs would also be unnecessary: copyright already protects abstract designs.

Tethering the scope of design patent protection to the disclosed article of manufacture also helps fulfill design patent law's notice function. Untethering the scope of design patents from their disclosed articles of manufacture would compromise later innovators' ability to discern from patents what is protected, and what is not. Were the metes and bounds of protection so unclear, later designers could not predict what uses might infringe. This inability to ensure the legality of their own designs would mire later designers in uncertainty.

Such uncertainty would create particular difficulties for the open-source hardware community, which publicly shares and collaborates on designs. The heightened uncertainty that comes with ineffectual notice could drive designers to

share fewer design files. This would diminish the open-source hardware community's ability to innovate new designs and the public's ability to benefit from the community's innovations. The requirement that design patents cover designs as applied to specified articles of manufacture, however, strikes a careful balance between protection and notice that serves both.

For these reasons, it is important to preserve the existing connection between a protected design and its designated article of manufacture. *Amicus* respectfully requests that this Court affirm the District Court's decision.

### **ARGUMENT**

#### **I. The open-source hardware community is highly innovative and relies on clearly delineated design patent boundaries.**

In evaluating the important contributions of open-source software, this Court noted that “[o]pen source licensing has become a widely used method of creative collaboration that serves to advance the arts and sciences in a manner and at a pace that few could have imagined just a few decades ago.” *Jacobsen v. Katzer*, 535 F.3d 1373, 1378 (Fed. Cir. 2008). Open-source hardware designers replicate this manner and pace of innovation for hardware by making their designs publicly available so that anyone can study, modify, make, and innovate upon those designs.<sup>3</sup> This open and collaborative philosophy allows open-source hardware

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<sup>3</sup> *Definition*, Open Source Hardware Association, <https://www.oshwa.org/definition/>.

designers to debug, advance, and perfect their innovations with speed and efficiency.

The open-source hardware community unites around a commitment to openness; beyond that, it is highly diverse. All types of creators, from hobbyists to profitable companies, innovate with its principles in mind. A few examples illustrate:

The Open Hand Project makes 3D-printed robotic prosthetic hands for amputees.<sup>4</sup> Because its design files are freely shared and the prosthetic itself is manufactured using the same material as LEGO, the \$1000 price tag for Open Hand Project's Dextrus is \$99,000 lower than leading devices.<sup>5</sup> Other examples are even more dramatic. A \$30 kit for the Phoenix 3D-printed hand, designed by the e-NABLE volunteer community, uses less than \$10 in additional materials to produce a fully functional prosthetic hand.<sup>6</sup>

OpenROV is a submersible drone that can descend 100 meters into the ocean's depths.<sup>7</sup> In addition to selling out-of-the-box versions of the submarine,

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<sup>4</sup> *Open Hand Project*, Open Hand Project, <http://www.openhandproject.org>.

<sup>5</sup> *Id.*

<sup>6</sup> *Phoenix Hand by e-NABLE Assembly Materials Kit*, 3D Universe, <https://shop3duniverse.com/products/phoenix-hand-by-e-nable-assembly-materials-kit>.

<sup>7</sup> *About*, OpenROV, <https://www.openrov.com/about/>; Ben Gruber, *Underwater Robot to Raise Ocean Awareness*, Reuters (Oct. 27, 2015),

OpenROV shares all of its utility and ornamental design files online, allowing the open-source hardware community to separately develop and improve OpenROV.<sup>8</sup> At under \$1500, OpenROV's low-cost, open-source approach has created the largest ocean observation network in the world, from classrooms in Oakland, California, to communities in Papua New Guinea.<sup>9</sup>

Open-source innovators also cater to the growing market for modifiable, custom automotive designs. Open Motors, for example, shares design files for its Tabby EVO, which anyone can use to build a street-legal electric vehicle for around \$10,000.<sup>10</sup> Similarly, Fictiv shares design files for a road-ready, fully customizable motorcycle.<sup>11</sup>

Arduino's open-source programmable logic controllers provide the "brain" for countless hardware projects undertaken by students, hobbyists, artists, programmers, and professional designers.<sup>12</sup> Successful do-it-yourself e-commerce

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<https://www.reuters.com/article/us-usa-underwater-robot/underwater-robot-to-raise-ocean-awareness-idUSKCN0SL27D20151027>.

<sup>8</sup> *About, OpenROV*, <https://www.openrov.com/about/>.

<sup>9</sup> *About, OpenROV*, <https://www.openrov.com/about/>; Hilary Hudson, *This Low-Cost Robot Can Help You Explore the Ocean*, National Geographic, <https://video.nationalgeographic.com/video/ng-live/160905-sciex-nglive-lang-openrov-citizen-science-lecture>.

<sup>10</sup> *Frequently Asked Questions*, Open Motors, <https://www.openmotors.co/faq/>.

<sup>11</sup> *Open Source. Open Road*, Fictiv/FOSMC, <https://www.fictiv.com/blog/fosmc>.

<sup>12</sup> *What is Arduino?*, Arduino, <https://www.arduino.cc/en/Guide/Introduction>.

sites like SparkFun and AdaFruit provide the components necessary to incorporate Arduino's boards into new and inventive hardware designs.<sup>13</sup> AdaFruit's Sparkle Skirt, for example, is part of a growing field of open-source wearable technologies.<sup>14</sup> The skirt incorporates 12 color-changing NeoPixels, which light up in a colorful pattern as the wearer moves.

OSHWAs supports these and other members of the open-source hardware community by facilitating the sharing of hardware designs. OSHWA has grown steadily since it was founded in 2012 to help the open-source hardware community organize around shared values and encourage future innovation.<sup>15</sup> It does so in four important ways. First, it hosts an annual summit for open-source hardware designers. Second, it maintains an "open-source hardware" definition, a uniform understanding of the meaning and requirements of an open-source hardware

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<sup>13</sup> Joseph Flaherty, *Invisible Unicorns: 35 Big Companies That Started with Little or No Money*, Tech Crunch (July 1, 2017), <https://techcrunch.com/2017/07/01/invisible-unicorns-35-big-companies-that-started-with-little-or-no-money/>; Matt Weinberger, *How One Woman Turned Her Passion for Tinkering into a \$33 Million Business – Without a Dime of Funding*, Business Insider (Aug. 18, 2015), <https://www.businessinsider.com/adafruit-industries-limor-fried-on-bootstrapping-a-startup-2015-8>.

<sup>14</sup> *Spark Skirt*, AdaFruit (May 4, 2015), <https://learn.adafruit.com/sparkle-skirt/overview>.

<sup>15</sup> *About*, Open Source Hardware Association, <https://www.oshwa.org/about/>.

design.<sup>16</sup> Third, its certification program makes it easier for designers to indicate open-source compliance.<sup>17</sup> Finally, it houses a directory of open-source-compliant projects, making certified design files easily accessible for anyone who wants to use them.<sup>18</sup>

OSHWAs' certification and directory are intended to give follow-on innovators confidence that designs claiming "open-source" status are truly open-source, and are accompanied by the necessary design files and documentation. But certification alone cannot ensure the continued viability of the open-source hardware movement. Like other innovators, open-source hardware designers work within, and depend upon, a design patent system that provides reasonable and clearly delineated property rights. A clear scope of protection is important to open-source hardware designers for at least two reasons. First, regardless of whether they seek patents themselves, open-source hardware designers need reasonable certainty that the hardware they create does not infringe existing patents. Second,

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<sup>16</sup> *Definition*, Open Source Hardware Association, <https://www.oshwa.org/definition> ("Open Source Hardware (OSHW) is a term for tangible artifacts — machines, devices, or other physical things — whose design has been released to the public in such a way that anyone can make, modify, distribute, and use those things.").

<sup>17</sup> *OSHWA Certification 2.0 is Here*, Open Source Hardware Association, <https://www.oshwa.org/2018/09/27/oshwa-certification-2-0-is-here/>.

<sup>18</sup> *Certified Open Source Hardware Projects*, Open Source Hardware Association, <https://certification.oshwa.org/list.html>.

to the extent that they use design patents to require downstream users to maintain a design's openness, open-source hardware designers must be able to understand how far that requirement can extend.

To ensure that open-source hardware can maintain a similar manner and pace of innovation as this Court commended when discussing open-source software in *Jacobsen*, design patent protection must balance the interests of these important innovative contributors with those of design patent holders. *See Jacobsen*, 535 F.3d at 1378.

## **II. Design patents protect the application of a design to an article of manufacture, in line with design practice and law.**

The article of manufacture anchors a design patent. As this Court's predecessor observed in *In re Schnell*, "it is the *application of the design to an article of manufacture* that Congress wishes to promote . . . ." 46 F.2d 203, 209 (C.C.P.A. 1931) (emphasis supplied). The connection between the protected design and the article of manufacture ensures that design patents efficiently protect what the patentee has contributed over the prior art while leaving room for other novel and innovative design applications. Reading the article of manufacture out of the scope of the patented design would extend duplicative and unearned protection to the patentee at the expense of further innovative design practice.



**A. The novel application of existing designs to new articles is itself valuable innovation.**

In industrial design, innovation is not complete upon the creation or discovery of a novel design, or an abstract enhancement over the prior art. The inventive step is applying it to an article of manufacture in a way that enhances the article's value. "Designing products necessarily involves working within the particular degree of freedom for each product, because not every old design feature can work with and look good in a new product."<sup>19</sup> Indeed, "[t]he act of taking an existing appearance and adapting it to a new product is, in itself, a valuable act of design."<sup>20</sup>

One of the main goals of aesthetic industrial design is to differentiate the designer's product from competitors' products.<sup>21</sup> And one of the principal methods of achieving that differentiation is to draw from pre-existing designs in other fields.<sup>22</sup> Designers "regularly browse through photo books or other sources

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<sup>19</sup> Janice M. Mueller & Daniel Harris Brean, *Overcoming the "Impossible Issue" of Nonobviousness in Design Patents*, 99 Ky. L.J. 419, 481 (2011) (internal quotation marks omitted).

<sup>20</sup> Sarah Burstein, *The Patented Design*, 83 Tenn. L. Rev. 161, 209 (2015).

<sup>21</sup> See Karl T. Ulrich & Steven D. Eppinger, *Product Design and Development* 213 (5th ed. 2012) (listing visual product differentiation, pride of ownership, image, fashion, and design team motivation among aesthetic needs met by industrial design).

<sup>22</sup> See Mueller & Brean, *Nonobviousness in Design Patents*, 99 Ky. L. Rev. at 439 & n.82 (interviewing two designers expressing the view that "good design always

containing collections of designs, looking for prior design features to incorporate into their new designs, regardless of whether the designs are in any way related or analogous to the product they are presently designing.”<sup>23</sup>

Some designers apply design features from nonanalogous prior art for the sole purpose of producing a unique aesthetic effect. Other techniques, like “surface mimicry,” or “making a design look like something else,” specifically involve using designs from unrelated products to signal how part of the article functions.<sup>24</sup> For example, computer operating systems use software icons that resemble folders, documents, or recycling bins. Regardless of the specifics, the fundamental design practice of drawing upon prior art reflects the Supreme Court’s recognition that “imitation and refinement through imitation are both necessary to invention and the very lifeblood of a competitive economy.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 147 (1989).

Design patent No. D677,946 (the “’946 Patent”), at issue in this case, provides a good example of a designer applying an existing design in an innovative

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draws on the work of pre-existing design and looks to many sources for inspiration”).

<sup>23</sup> *Id.* at 440.

<sup>24</sup> William Lidwell et. al., *Universal Principles of Design* 156 (Rockport Publishing 2010) (“Mimicry is perhaps the oldest and most efficient method for achieving major advances in design.”).

way. The design it discloses is a modern application of ancient Y-shaped patterns that have been embodied in Islamic art and architecture for more than a thousand years.<sup>25</sup> The underlying “idea” of an overlapping “Y” pattern has public domain elements that any designer should be able to use, on a basket, a chair, or anything else. So long as Curver Luxembourg, SARL’s (“Curver”) application of that design with vertical bisecting lines to a chair would not have been obvious to the ordinary observer, Curver is entitled to patent protection on its contribution. *See Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1241 (Fed. Cir. 2009) (discussing the roles of the ordinary designer and ordinary observer in the test for obviousness in design patents). But widening the ’946 patent’s scope beyond the article of manufacture disclosed in the patent would disallow the type of applied design that design patent protection was intended to promote. Indeed, it would disallow the very type of design practice that Curver undertook.

**B. Untethering the patented design from the article of manufacture would unnecessarily protect abstract designs at the expense of innovative design practice.**

Under longstanding principle, the invention that design patents protect “is not the article and is not the design *per se*, but the design *applied*.” *Ex Parte Cady*, 1916 Dec. Comm’r Pat. 57, 63 (emphasis in original). Relegating the article of

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<sup>25</sup> Shannon Hall, *Material That Can Grow When Stretched is Inspired by Islamic Art*, New Scientist (Mar. 16, 2016), <https://www.newscientist.com/article/2081174-material-that-can-grow-when-stretched-is-inspired-by-islamic-art/>.

manufacture to a formality that does not inform the scope of the patented design would extend protection beyond what the patent discloses, the patentee’s inventive contribution over the prior art, and what the patentee even contemplated.<sup>26</sup>

The District Court in this case correctly anchored the patented design to the article of manufacture when it construed the patented design as “the ornamental ‘Y’ design as applied to a chair . . . .” *See* Appellant Appx. at 018. Unsurprisingly, every district court to consider the issue has similarly tied the patented design to the article of manufacture. *See P.S. Products, Inc. v. Activision Blizzard, Inc.*, 140 F. Supp. 3d 795, 803 (E.D. Ark. 2014); *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 671, 679-80 (E.D. Mich. 2003); *Vigil v. Walt Disney Co.*, No. 97-4147, 1998 U.S. Dist. LEXIS 22853 at \*9 (N.D. Cal. Dec. 1, 1998), *aff’d*, 2000 U.S. App. LEXIS 6231 (Fed. Cir. Apr. 5, 2000). This Court’s predecessor has also clarified that design protection could extend to a portion of an article of manufacture—in this case, the shank portion of a drill—only because the drill itself was “unquestionably an article of manufacture” and “thus applied design as distinguished from abstract design.” *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980).

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<sup>26</sup> As the District Court noted, the fact that Curver has applied the design to a basket “only confuses the issue.” Appellant Appx. at 016.

These holdings are consistent with the industrial design practice described in Section II.B above; they are also consistent with the Patent Act, its implementing regulations, and the Patent & Trademark Office's guidance to examiners. *See* 35 U.S.C. § 171(a) (extending patent protection to “any new, original and ornamental design for an article of manufacture”); *see also* 37 C.F.R. § 1.153(a) (requiring the claim to specify the name of the article of manufacture); MPEP § 1502 (9th ed. Rev. 08.2017, Jan. 2018) (clarifying that the patented design is “inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation”).

Extending design patent protection to abstract designs would foreclose a ubiquitous, useful, and creative method of design: applying existing designs to articles of manufacture in new and nonobvious ways. Protecting this innovative practice is vital to open-source hardware designers seeking to differentiate their products from competitors' even while they make the design files for those products freely available for use and modification. The existing diversity of innovative designs from which the open-source hardware community may draw would diminish substantially if the scope of protection for patented designs lost its connection to the article of manufacture. Fields of nonanalogous art would become unavailable even to apply to new articles of manufacture in new and unexpected ways. Open-source hardware designers would have fewer designs available for

adaption and modification, and more risk to bear if they add ornamental features to their designs.

Besides imposing these costs on open-source hardware designers, patent protection for abstract designs would be duplicative and unnecessary. Copyright already protects them. Copyright extends protection to designs for useful articles that can be “identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” *See* 17 U.S.C. § 101; *see also Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1012 (2017) (holding that a design is eligible for copyright protection if, “when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work . . .”). There is no need to encumber innovative design practices by duplicating protections for abstract designs.

### **III. Reading the article of manufacture out of design patent protection would undermine design patent law’s notice function and would chill innovation.**

For innovators, it is essential that published patents provide clear notice of what is patented and what is available for further innovation. Untethering the scope of a design patent from the article of manufacture would compromise the patent’s ability to define the patented design and give later innovators clear notice of its metes and bounds. Fundamental practices of industrial design would become inherently risky because later designers could not predict what is protected and

what is available for further innovation. Design innovation would mire in uncertainty.

**A. Patented designs must be tethered to their designated articles of manufacture in order for design patents to provide adequate notice of what they cover.**

As the Supreme Court observed, “[a] patent holder should know what he owns, and the public should know what he does not.” *Festo Corp. v Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002). Clear metes and bounds are as essential for design patents as they are for the utility patents at issue in *Festo*. This case provides a good example. Curver obtained a design patent on a Y-shaped pattern “for a chair” (as stated in the claim, figure descriptions, and title) shown in multiple figures. *See* ’946 Patent. The pattern is shown, and the embodiment of the claimed design is discernable. So far, so good. But now Curver is claiming infringement of this patent by a *basket* that uses a similar pattern.<sup>27</sup> How could the patent help a follow-on designer predict that? Were the metes and

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<sup>27</sup> This is quite different from cases where the written description differs somewhat from the figures, as in, for example, *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294 (Fed. Cir. 2010). There, minor differences between the written description and the figures threatened to “distort[] the infringement analysis by the ordinary observer viewing the design as a whole” if the figures did not control. *Id.* at 1302. Here, however, the articles of manufacture in question are completely different—a chair, a basket—leaving no danger of distortion, only the danger of ineffectual notice.

bounds of protection so unclear, later designers could never ensure the legality of their own designs.<sup>28</sup>

For the open-source hardware community specifically, this case is but one example of why it is crucial to maintain the connection between patented designs and the articles of manufacture in which they are embodied. Because almost all open-source hardware projects—whether underwater drones, low-cost prosthetic hands, or 3D-printed dresses—incorporate ornamental design elements, open-source hardware designers must be able to distinguish between those features that can be used, and those that are protected by existing design patents. Tying design patent protection to a specified article of manufacture accomplishes this by providing usable notice. But under a regime where the patent monopoly emanated

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<sup>28</sup> This also would be at odds with the “ordinary observer” test for design patent infringement, which preserves notice for later designers by requiring comparison between the *accused product or design* (which the later designer knows) and the *patented design* (which the later designer can discern from the patent). *See, e.g., Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010) (“[infringement depends on whether] an ordinary observer, familiar with the prior art designs, would be deceived into believing that the *accused product* is the same as the *patented design*.”) (emphasis supplied); *Payless Shoesource, Inc. v. Reebok Int’l Ltd.*, 998 F.2d 985, 990 (Fed. Cir. 1993) (“[p]roper application of the *Gorham* test requires that an accused design be compared to the claimed design, not to a commercial embodiment [citation omitted].”) The patentee’s product is not generally a point of comparison, though this is not necessarily error if—unlike here—the patentee’s product and the claimed design are substantially the same. *See, e.g., L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125-26 (Fed. Cir. 1993).



from abstract designs, distinguishing between protected and usable design elements would be an impossible task.

**B. Preserving notice of a design patent’s scope is essential to limiting uncertainty and promoting efficient investment in innovation.**

As clear metes and bounds map out the space in which later designers can innovate, they also promote innovation by reducing uncertainty and wasteful litigation costs. In practical terms, “a patent holder should know what he owns, and the public should know what he does not,” in part, to reduce fear of downside risk. Under a regime where abstract design protection could apply to any article of manufacture in any industry sector, innovators, unable to discern where freedom to operate exists and fearful of expensive lawsuits, would hesitate to release their designs to the public.

OSHOWA is particularly concerned about the negative effect of abstract design protection precisely because open-source hardware designers share their designs widely. OSHOWA certification requires that “hardware must be released with documentation including design files, and must allow modification and distribution of the design files.”<sup>29</sup>

This openness benefits the public by enabling the rapid, collaborative, and innovative production of hardware designs. However, the same openness also

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<sup>29</sup> *Definition*, Open Source Hardware Association, <https://www.oshwa.org/definition/>.

exposes open-source hardware innovators to litigation risk. Because certification requires the public disclosure of designs, inventors seeking to certify their creations must make them available for the world to view and use. Heightened uncertainty regarding the legality of their designs would force open-source innovators to weigh the benefits of the movement's collaborative philosophy against the dangers of potential infringement litigation. The open-source model's public benefit would diminish considerably if fear of liability discouraged certification and sharing. The heightened uncertainty that comes with ineffectual notice could drive designers away from sharing, decreasing the public value of their designs.

A design patent untethered to its article of manufacture would give inadequate notice as to what the patentee has contributed and owns, and as to what others are free to use, to improve, and to distribute to the public under an open license. The requirement that design patents cover designs as applied to specified articles of manufacture, however, strikes a careful balance between protection and notice that serves both. For this reason, it is important to preserve the existing connection between a protected design and its designated article of manufacture.

## CONCLUSION

Curver presents this court with what might appear to be a sympathetic situation: two plastic baskets with similar appearances—one Curver’s, one a competitor’s. *Amicus* takes no position on the relative merits of the parties’ actions in the marketplace. But Curver presses a design patent infringement suit that extends beyond the bounds of its actual design patent protection. If Curver were successful in its attempt to separate its design from the article of manufacture in its granted patent and secure protection for what is essentially an abstract design, it would receive a windfall beyond its actual inventiveness and leave far less source material for follow-on innovators in the public domain. This would both conflict with established design practice and distort the careful balance embodied in design patent law. Further, all innovators, including open-source hardware innovators, would lose their ability to discern what they may use and what they may not when creating new designs, ultimately chilling design innovation. That is why the existing connection between design patent protection and the relevant article of manufacture is essential.

The District Court applied the law correctly, and thereby preserved design patent law’s balance between protection and follow-on innovation, and the ability of the public to understand what a design patent covers and what it does not.

*Amicus* respectfully requests that this Court *affirm*.

Respectfully Submitted,

November 20, 2018

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**CERTIFICATE OF SERVICE**

I hereby certify that on November 20, 2018, I caused the forgoing Brief of Amicus Curiae Open Source Hardware Association in Support of Defendant-Appellee and Affirmance to be electronically filed with the Clerk of the Federal Circuit using the CM/ECF System, which will serve e-mail notice of such filing on the following attorneys:

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Upon acceptance by the Court of the e-filed document, I will cause six paper copies of the brief to be filed with the Court, via Federal Express, within the time provided in the Court's rules.

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**CERTIFICATE OF COMPLIANCE**

As counsel for *Amicus Curiae* Open Source Hardware Association, I hereby certify the brief contained herein complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the tpestyle requirements of Federal Rule of Appellate Procedure 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word 2016 and 14 point Times New Roman font.

I further certify that the body of this brief complies with the type-volume limitations of Federal Rule of Appellate Procedure 29(a)(5) because it contains 4,538 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

November 20, 2018

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