

Semiannual Guide to Expert Witnesses

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Eye of the Beholder

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by James Juo

THE EYE OF THE BEHOLDER

In determining design patent infringement, exaggerated importance should not be given to small differences in detail

A design patent protects a product's ornamental appearance—in other words, the look of a product. This may include the shape and configuration of the product as well as any surface decoration. Design patents are used to protect products such as toys, clothing and apparel, jewelry and jewelry boxes, home furnishings and appliances, motor vehicles and automobile parts, and office equipment. A design patent consists primarily of drawings that illustrate the ornamental appearance to be protected.¹

For years, well-established case law held that for a claim of design patent infringement to succeed, the accused design must appear substantially the same as the patented design to an “ordinary observer.”² Over time, however, the law became more convoluted, particularly regarding an additional test for infringement—the “point of novelty” test.

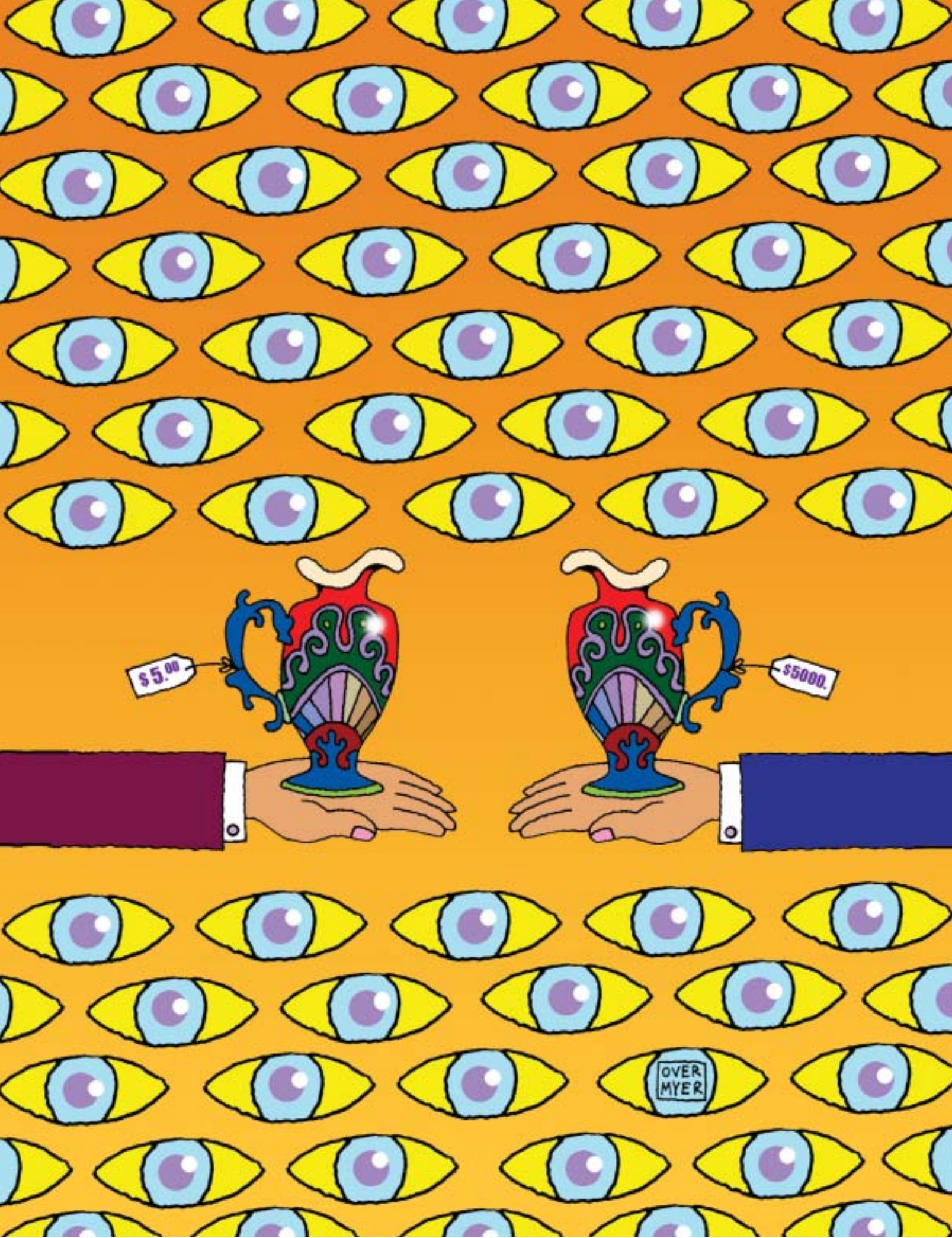
In *Egyptian Goddess, Inc. v. Swisa, Inc.*, the Federal Circuit, in an en banc decision, abolished point of novelty as a separate test and held that the ordinary observer test is the sole test for design patent infringement.³ With *Egyptian Goddess*, the Federal Circuit has taken

a more flexible approach to considering prior art in the infringement analysis for design patents. By doing so, the court was returning to the earlier guidance of the U.S. Supreme Court's decisions in *Gorham Manufacturing Company v. White*⁴ and *Smith v. Whitman Saddle Company*.⁵

In *Gorham*, a case decided in 1871, the Supreme Court gave its seminal test for design patent infringement. The case involved a defendant who was accused of infringing the plaintiff's design patent for spoon and fork handles.⁶ The Supreme Court noted that the issue was whether the determination of infringement hinged on the perspective of an ordinary observer or an expert accustomed to comparing designs side by side. The Court held that the viewpoint of an ordinary observer, rather than an expert, was determinative,⁷ noting that an expert was more likely to distinguish counterfeits that were

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intended to deceive the less discerning eye of an ordinary purchaser.⁸ Indeed, patent protection for designs would be destroyed “if, while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, by those who buy and use, are sufficient to relieve an imitating design from condemnation as an infringement.”⁹

Moreover, the *Gorham* Court held “that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”¹⁰ Nevertheless, although categorically stating that infringement was based on the “eye of an ordinary observer” rather than that of an expert, the Court relied upon testimony from tradesmen “familiar with designs” to establish how ordinary purchasers would view the patented and accused designs—and found no infringement.¹¹

Some 20 years later, the Supreme Court revisited the law of design patents in *Whitman Saddle*.¹² The design patent at issue was for a saddle, which the Court described as a combination of two known saddles.¹³ The cantle (or back) of the saddle was substantially the same as the saddle known as the Jenifer tree, while the pommel (or front) of the saddle was substantially that of the well-known Granger tree—except that the disputed saddle did not feature the “slight curved drop” at the rear of the pommel that was typical of the Granger saddle but instead had a sharp drop (that is, “a nearly perpendicular drop of some inches”).¹⁴

The Court found that “the Jenifer cantle was used upon a variety of saddles.”¹⁵ The Court stated that “we do not think that the addition of a known cantle to a known saddle, in view of the fact that such use of the cantle was common, in itself involved genius or invention, or produced a patentable design.”¹⁶

Described as “being substantially the Granger saddle with the Jenifer cantle,”¹⁷ the saddle in dispute was comparable to the patented Whitman design, except that the saddle had a slight curved drop at the rear of the pommel consistent with the Granger saddle instead of Whitman’s sharp drop at the rear of the pommel.¹⁸ The Court held that if the Whitman saddle’s sharp drop at the rear of the pommel was “material to the design,” it would render Whitman’s design “patentable.” Otherwise, the patented design would be no different from an old saddle with an old cantle added—“an addition frequently made.” The Court found that the lack of the sharp drop at the rear of the pommel “was so marked that in our judgment the defendant’s saddle could not be mistaken for the [patented] saddle.”¹⁹

Pre-Federal Circuit Decisions

After the Supreme Court decisions in *Gorham* and *Whitman Saddle*, circuit courts proceeded to further develop the infringement analysis for design patents with reference to the prior art. For example, in *Applied Arts Corporation v. Grand Rapids Metalcraft Corporation*, the Sixth Circuit in 1933 addressed the question, “What does the ordinary observer...know of the prior art?” and concluded, “A careful analysis of *Gorham v. White* and other adjudicated cases supplies the answer.”²⁰

The ordinary observer is not any observer, but one who, with less than the trained faculties of the expert, is “a purchaser of things of similar design,” or “one interested in the subject.” The mythical prudent man in negligence cases is not the Hottentot or Abyssinian who has never seen a locomotive or driven an automobile, but one who has average familiarity with such instrumentalities, and can form a reasonable judgment as to their speed and mode of operation. So is the average observer not one who has never seen an ash tray or a cigar lighter, but one who, though not an expert, has rea-

sonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it. This view is confirmed by the factual analysis which the Supreme Court gave to the evidence in the *Gorham* Case, laying its greatest stress upon the evidence of sameness there given by the large number of witnesses “familiar with designs, and most of them engaged in the trade.”²¹

The court concluded that “while there is some similarity between the patented and alleged infringing design, which without consideration of the prior art might seem important,” such similarity “is no greater” than that between the patented design and the prior art.²² Recognizing that infringement of a design patent “is not to be determined by making too close an analysis of detail,” the court nonetheless concluded that “where in a crowded art the composite of differences presents a different impression to the eye of the average observer (as above defined), infringement will not be found.”²³

Relying on the *Whitman Saddle* and *Applied Arts* precedents, the Eighth Circuit in 1944 stated in *Sears, Roebuck and Company v. Talge* that whether “the appearance of two designs is substantially the same” involves two considerations.²⁴ First, “the identity of appearance, or sameness of effect as a whole upon the eye of an ordinary purchaser must be such as to deceive him, inducing him to purchase one, supposing it to be the other.” Second, “the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.”²⁵ In view of these two considerations, a determination of infringement requires “a comparison of the features of the patented device with the prior art and with the accused design.”²⁶ Thus, the pre-Federal Circuit decisions applied the ordinary observer test in light of the prior art—although some courts, such as the Eighth Circuit in *Sears, Roebuck*, were starting to identify the prior art as a separate consideration.

From Litton Systems to Egyptian Goddess

The Federal Circuit in *Litton Systems, Inc. v. Whirlpool Corporation* relied on *Sears, Roebuck* for the proposition that “no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.”²⁷ This proposition was christened the “point of novelty” test.²⁸

The design patent that was alleged to be infringed was for a microwave oven. The court referred back to its prior validity analysis, which had identified the microwave oven’s patentable combination as a three-stripe door frame, a door without a handle, and a latch release lever on the control panel. None of the elements of the combination were present in the allegedly infringing Whirlpool design.²⁹ To further support its conclusion that the differences between the two designs were not minor, the court cited *Applied Arts* in finding that the differences between the patented and accused designs were as great as between the patented design and the prior art—which was “crowded with many references relating to the design of the same type of appliance.”³⁰

Subsequent Federal Circuit decisions further developed the point of novelty test as a distinct test separate from *Gorham*’s ordinary observer test of the design as a whole.³¹ Generally, the point of novelty test requires an identification of the differences between the prior art and the patented design, and a determination of whether the accused design has appropriated the novel ornamental features that distinguished the patented design from the prior art.³² The more points of novelty that are identified, the more opportunities exist for a defendant to argue that its accused design does not infringe because it has not appropriated *all* the points of novelty.³³

As a practical matter, patentees and accused infringers proceeded to cherry-pick features to be designated as points of novelty in sup-

port of their respective positions regarding infringement. As these cases proceeded, the original three-member panel for *Egyptian Goddess* in 2007 presented a refinement of the point of novelty test in which the patentee would have to prove that the point of novelty was a “non-trivial advance of the prior art.”³⁴

The En Banc Ruling

The Federal Circuit in 2008 heard *Egyptian Goddess* en banc “to address the appropriate legal standard to be used in assessing claims of design patent infringement.”³⁵ The patentee Egyptian Goddess, Inc. (EGI) and several of the amici argued that the proper approach was not a separate point of novelty test but instead “a three-way visual comparison between the patented design, the accused design, and the closest prior art.”³⁶ Swisa, the accused infringer, argued, on the other hand, that the point of novelty test was “soundly based on *Whitman Saddle*.”³⁷

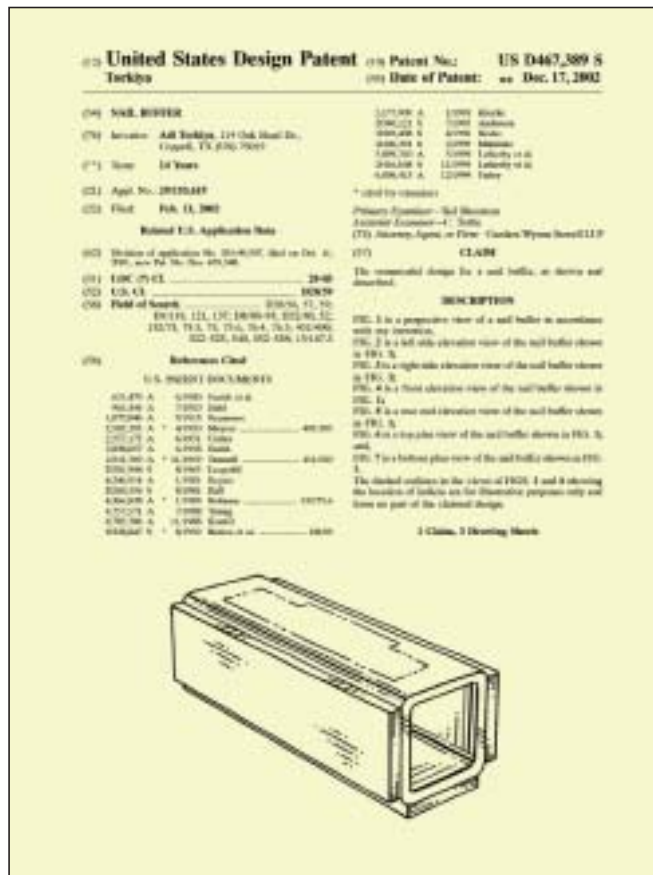
Addressing Swisa’s reliance on *Whitman Saddle*, the court noted that “[a] close reading of *Whitman Saddle* and subsequent authorities indicates that the Supreme Court did not adopt a separate point of novelty test for design patent infringement cases.” The court held that “the point of novelty test, as a second and free-standing requirement for proof of design patent infringement, is inconsistent with the ordinary observer test laid down in *Gorham*.”³⁸

The court approvingly discussed the *Applied Arts* court’s reading of *Gorham* that the ordinary observer was a nonexpert who had reasonable familiarity with similar articles in the prior art:³⁹ “The context in which the claimed and accused designs are compared, i.e., the background prior art, provides such a frame of reference and is therefore often useful in the process of comparison.” An ordinary observer conversant with the prior art “will attach importance to differences between the claimed design and the prior art depending on the overall effect of those differences on the design.” Moreover, “the ordinary observer test does not present the risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty.” The court concluded that “the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed.”⁴⁰

The designs at issue in *Egyptian Goddess* involved nail buffers. EGI’s patented nail buffer design was rectangular with raised buffing pads on three sides, while the nail buffer by Swisa had raised buffing pads on all four sides. Both the patented and accused designs were hollow and had square cross-sections. The prior art included the Nailco Buffer, which was a hollow triangular (or prism-shaped) nail buffer with raised buffing pads on all three sides, and the Falley Buffer Block, which was a solid rectangular nail buffer with raised buffing pads on all four sides.

Swisa’s expert declared that “four-way” buffers with four different abrasive surfaces have long been on the market, and “[t]he difference between a buffer with abrasive on three sides—a ‘three-way buffer’—and a buffer with abrasive on four sides—a ‘four-way buffer’—is immediately apparent to any consumer used to buying nail buffers.”⁴¹ In contrast, EGI’s expert opined that Swisa’s design constituted infringement because, like EGI’s patented design, Swisa’s also had square cross-sections and “multiple” raised buffer pads. Despite this claim, the court found that the expert “failed to address the fact that the design of the [prior art] Nailco patent is identical to the accused device except that the Nailco design has three sides rather than four.”⁴² The court suggested that the prior art Nailco buffer also closely resembled the accused design in that both designs have a hollow tube and multiple rectangular sides with buffer pads mounted on each side.⁴³

Endorsing the district court’s conclusion that “[i]n the context of nail buffers, a fourth side without a pad is not substantially the



Nail buffer in *Egyptian Goddess, Inc. v. Swisa, Inc.*

same as a fourth side with a pad,” the en banc panel held that no reasonable trier of fact could find that an ordinary observer would believe the accused design to be the same as the patented design.⁴⁴ The prior art was used to establish a distinguishing ornamental feature that the hypothetical ordinary observer would emphasize when viewing similar products in the marketplace.

Applying the New Test

A few months later, a U.S. district court in *Arc’Teryx Equipment, Inc. v. Westcomb Outerwear, Inc.* relied on the ordinary observer test from the *Egyptian Goddess* decision in granting summary judgment of non-infringement for a curvilinear zipper.⁴⁵ The court characterized the patented design as having two sections—“a straight section and a diagonal section.” The accused product, however, was characterized as having three sections—“a straight section, a diagonal section, and a second straight section.”⁴⁶

The prior art included a German jumpsuit with a zipper that has a long straight section, extending from the middle of the jumpsuit to the upper chest area, before it curves into a short diagonal section that loops back into a straight section near the top of the jumpsuit. In addition, the prior art contained a jacket with a zipper that has a long straight section over most of the jacket before it curves into a short diagonal section beginning at the collar. Thus, the prior art included a jacket zipper containing “one straight and one diagonal section,” and a jumpsuit zipper containing “a straight section, curving into a diagonal section, which curves into a second straight section.”⁴⁷

Assessing the prior art and the patented design, the court concluded that “it is the number, length, and placement of the straight and diagonal sections which differentiate” the designs. In particular, there were at least two different types of curvilinear zipper designs in the prior art—and one had two sections (straight and curved), and the



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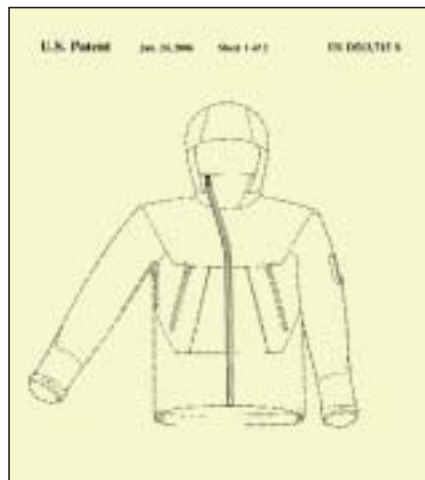
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Zipper in *Arc'Teryx Equipment, Inc. v. Westcomb Outerwear, Inc.*

other had three (a curved section located between two straight sections). The court found that an ordinary observer, familiar with the prior art, would not be deceived into confusing the accused three-section zipper with the patented two-section zipper.⁴⁸ As in *Egyptian Goddess*, in which the Federal Circuit concluded that the number of abrasive pads in a nail buffer was a distinguishing ornamental feature to consumers based on the prior art, the district court relied on the prior art in *Arc'Teryx* to find the number of curved and straight sections in a curvilinear zipper to be a distinguishing ornamental feature.

A claim of design patent infringement must show that the patented and allegedly infringing designs are sufficiently the same in general appearance and effect in light of the prior art that the designs would appear to be identical to an ordinary observer.⁴⁹ The ordinary observer test is the sole test for design patent infringement now that the Federal Circuit has abolished the point of novelty test as a separate test for infringement.⁵⁰ Using the prior art to suggest which ornamental features an ordinary observer would emphasize may provide a basis for a finding of noninfringement. But lifting the burden of having to prove a separate point of novelty test for design patent infringement should strengthen design patents drafted with careful attention to the novel ornamental features of the design. ■

¹ A utility patent, on the other hand, typically contains a significant amount of text, including claims defining the scope of patent protection for the substance of an invention. A utility patent can protect the structure or function of an invention beyond its ornamental appearance. Unscrupulous invention promotion companies, however, will routinely file design patents instead of utility patents. See *Bender v. Dudas*, 490 F. 3d 1361 (Fed. Cir. 2007). The U.S. Patent and Trademark Office also maintains a public forum for complaints regard-



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ing invention promoters at <http://www.uspto.gov/web/offices/com/iip/complaints.htm>.

² Egyptian Goddess, Inc. v. Swisa, Inc., 543 F. 3d 665, 678 (Fed. Cir. 2008) (en banc).

³ *Id.*

⁴ Gorham Mfg. Co. v. White, 81 U.S. 511, 512 (1871).

⁵ Smith v. Whitman Saddle Co., 148 U.S. 674 (1893).

⁶ Gorham, 81 U.S. at 512.

⁷ *Id.* at 527 (“There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another—so like that an expert could not distinguish them.”).

⁸ *Id.* at 527-8 (“No counterfeit bank note is so identical in appearance with the true that an experienced artist cannot discern a difference.”); *see also* Ashley v. Weeks-Numan Co., 220 F. 899, 902 (2d Cir. 1915) (Side-by-side comparison of the accused product with the patented design “is not a proper test” for infringement.).

⁹ Gorham, 81 U.S. at 528; *cf.* Arminak & Assoc., Inc. v. Saint-Gobain Calmer, Inc., 501 F. 3d 1314, 1322 (Fed. Cir. 2007) (For trigger sprayers sold as components to producers of liquid household products, the court held that the ordinary observer was an institutional or corporate buyer rather than an end-user consumer.).

¹⁰ Gorham, 81 U.S. at 528; *see also* Jennings v. Kibbe, 10 F. 669, 670 (C.C. N.Y. 1882).

¹¹ Gorham, 81 U.S. at 530.

¹² Smith v. Whitman Saddle Co., 148 U.S. 674 (1893).

¹³ *Id.* at 676.

¹⁴ *Id.* at 680, 682. The tree or saddletree is the frame of a saddle. THE AMERICAN HERITAGE COLLEGE DICTIONARY 1199 (3d ed. 1997).

¹⁵ Whitman Saddle, 148 U.S. at 681.

¹⁶ *Id.*

¹⁷ *Id.* at 680.

¹⁸ *Id.* at 682.

¹⁹ *Id.*

²⁰ Applied Arts Corp. v. Grand Rapids Metalcraft Corp., 67 F. 2d 428, 429-30 (6th Cir. 1933).

²¹ *Id.* at 430.

²² *Id.*; *see also* Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co., 114 F. 362, 363 (C.C.D. Conn. 1902) (“The shape of defendants’ bell differs from plaintiff’s more widely than plaintiff’s differs from the [prior art], and therefore defendants’ construction does not infringe [plaintiff’s patented design].”).

²³ Applied Arts, 67 F. 2d at 430.

²⁴ Sears, Roebuck & Co. v. Talge, 140 F. 2d 395, 395 (8th Cir. 1944).

²⁵ *Id.* at 395-96.

²⁶ *Id.* at 396.

²⁷ Litton Sys., Inc. v. Whirlpool Corp., 728 F. 2d 1423, 1444 (Fed. Cir. 1984) (quoting Sears, Roebuck, 140 F. 2d at 396).

²⁸ *Id.* (citation omitted).

²⁹ *Id.* at 1443.

³⁰ *Id.* at 1444 (citing Applied Arts Corp. v. Grand Rapids Metalcraft Corp., 67 F. 2d 428, 430 (6th Cir. 1933)).

³¹ *See* Unidynamics Corp. v. Automatic Prods. Int’l, Inc., 157 F. 3d 1311, 1323-24 (Fed. Cir. 1998) (The ordinary observer and point of novelty tests are “two distinct tests,” and “the merger of the point of novelty test and the ordinary observer test is legal error.”); *see also* Sun Hill Indus., Inc. v. Easter Unlimited, Inc., 48 F. 3d 1193, 1197 (Fed. Cir. 1995); Winner Int’l Corp. v. Wolo Mfg. Corp., 905 F. 2d 375, 376 (Fed. Cir. 1990).

³² *See* Bernhardt, L.L.C. v. Collezione Europa USA, Inc., 386 F. 3d 1371, 1384-85 (Fed. Cir. 2004).

³³ *See* Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F. 3d 1113, 1121 (Fed. Cir. 1998); *see also* Karl G. Hanson, *Intellectual Property Strategies for Protecting the Looks of a New Product*, 81 J. PAT. & TRADEMARK OFF. SOC’Y 887, 901 (“The inclusion of too many novel elements in Goodyear’s design patent effectively limited the patent’s scope, making it easier

for Hercules to avoid infringement.”).

³⁴ Egyptian Goddess, Inc. v. Swisa, Inc., 498 F. 3d 1354, 1357 (Fed. Cir. 2007).

³⁵ Egyptian Goddess, Inc. v. Swisa, Inc., 543 F. 3d 665, 668 (Fed. Cir. 2008) (en banc).

³⁶ *Id.* at 672.

³⁷ *Id.*

³⁸ *Id.*; *see also* Elmer v. ICC Fabricating, Inc., 67 F. 3d 1571, 1578 (Fed. Cir. 1995) (“Under *Gorham*, the focus is on the overall ornamental appearance of the claimed design, not selected ornamental features.” (emphasis in original)).

³⁹ Egyptian Goddess, 543 F. 3d at 675. The Federal Circuit also held that while the patentee has the ultimate burden of proving infringement, the accused infringer has the initial burden of production of prior art to be considered in the ordinary observer test. *Id.* at 678.

⁴⁰ *Id.* at 676-78.

⁴¹ *Id.* at 682.

⁴² *Id.*

⁴³ *Id.*

⁴⁴ *Id.*; *see also* Applied Arts Corp. v. Grand Rapids Metalcraft Corp., 67 F. 2d 428, 430 (6th Cir. 1933) (“[W]here in a crowded art the composite of differences presents a different impression to the eye of the average observer [familiar with the prior art], infringement will not be found.”).

⁴⁵ ArcTeryx Equip., Inc. v. Westcomb Outerwear, Inc., 89 U.S.P.Q. 2d 1894, 1896 (D. Utah 2008).

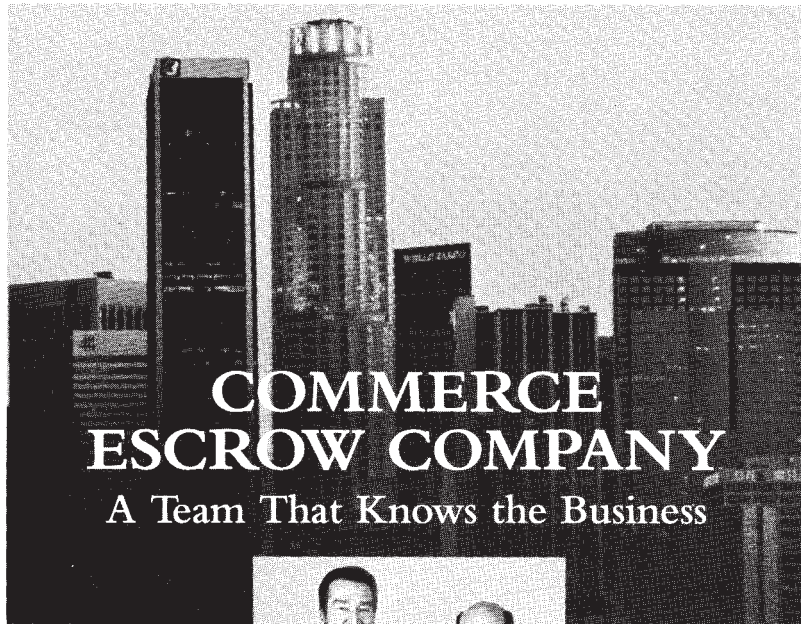
⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ *Id.*; *cf.* Egyptian Goddess, 543 F. 3d at 682 (In view of the prior art, the number of abrasive pads differentiated the nail buffer designs.).

⁴⁹ Egyptian Goddess, 543 F. 3d at 672.

⁵⁰ *Id.*



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