DESIGN PATENT PERSPECTIVE:
The Fascinating Design Patent

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Robert served as lead trial and appellate counsel for Egyptian Goddess, Inc. in Egyptian Goddess v. Swisa *(en banc).*

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Do you like how Apple's iPhone looks? If so, you're not alone. At the iPad 2 Event held in early March 2011, Apple announced that one million iPhones had been sold worldwide. In 2007, *Time Magazine* remarked that the iPhone "changed the way we think about how mobile media devices should look, feel and perform."[1] Apple's new design helped company value soar, and assured Apple's continued reputation as a leader in innovative product design.[2]

But what if there was no legal protection available for the iPhone design and competitors were free to market similar or identical looking phones?[3] Would Apple have dedicated the same resources it did to develop such a revolutionary new design?

This was the situation faced by industrial designers in the United States in 1840. At the time, no body of law protected a design that was part of an article of manufacture. In an effort to remedy the situation, in 1841 Commissioner of Patents Henry Ellsworth began lobbying Congress for increased design protection. In 1842, Congress passed the first design patent statute.

It is not entirely clear why protection for industrial designs was placed within the general framework of the utility patent statutes. But over the years, it has become increasingly clear that the relationship between utility patent law and design patent law is problematical. Utility patent law is concerned primarily with function, and design patent law is concerned primarily with appearance. Perhaps even more fundamental to the poor relationship is the basic incompatibility of objective legal principles to subjective artistic design.[4]

Despite the problems, a number of useful legal principles have emerged in the case law. In *Gorham v. White*,[5] the Supreme Court explained that infringement was determined not through the eyes of an expert, but rather through the eyes of an "ordinary observer." In *Smith v. Whitman Saddle*,[6] the Supreme Court introduced the concept that designs are to be compared against each other in light of prior art designs. In *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*,[7] the court further developed the prior art concept by explaining that "a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent from the prior art."[8]

In *Litton Systems, Inc. v. Whirlpool Corporation*,[9] the Federal Circuit's first design patent infringement case, the court interpreted the prior art principle as requiring a test separate and apart from the ordinary observer test. The separate test became known as the "point of novelty" test and required that the confusing similarity between two designs resulted from the novelty that distinguished the patented design from the prior art.

Although the point of novelty approach was a well-intended effort to bring objec-

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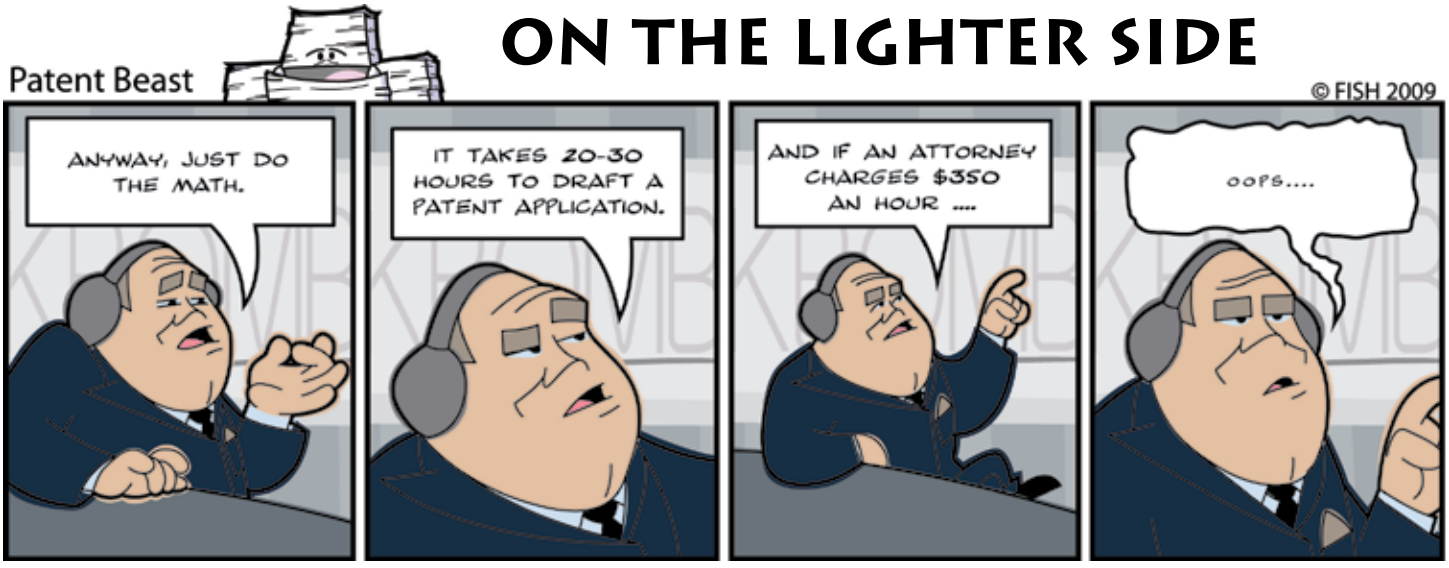

tivity to an inherently subjective area of law, the test ultimately proved unworkable in practice. When a patented design was compared to the accused design in light of several prior art designs, each of which had multiple and varied design elements, it became impossible to consistently identify a single point of novelty. Due to this and other problems, the Federal Circuit finally abandoned the point of novelty test in *Egyptian Goddess v. Swisa*.[10]

Elimination of the point of novelty approach properly returned the infringement test back to its *Gorham* roots. But the *Gorham* ordinary observer test remains general in nature and the twenty-five year presence (1984-2008) of the point of novelty test made largely unnecessary further refinement of the ordinary observer test. The holding in *Egyptian Goddess* is highly fact specific and relies heavily on the Federal Circuit's interpretation of an expert declaration drafted before the law was changed. Unfortunately, *Egyptian Goddess* does not provide a clear and comprehensive analytical framework to fill the void left by the abandoned point of novelty approach.

But *Egyptian Goddess* and its progeny do provide a developing foundation upon which to determine whether one design infringes another. In future design patent columns, we will explore this developing foundation and try to identify the infringement principles emerging from the case law. We also will attempt to tackle other vexing issues in design patent law. For example, should functionality be determined element-by-element or by considering the design as a whole? What is the proper test for design patent validity in light of *KSR v. Teleflex*?[11] Is obviousness determined with an ordinary observer standard or with an ordinary designer standard? What is the proper role of experts in design patent litigation? When can a design patent have multiple embodiments? And what is an effective claiming strategy to obtain both broad and narrow design patent claims?

As we address these and other issues, we also will explore the emerging field of visual science and what application it may have to design patent law. For example, in *Egyptian Goddess*, the court noted "as a general matter, [district] courts should not treat the process of claim construction as requiring a detailed verbal description of the claimed design…"[12] Although the court did not express it, this non-verbalized approach might also be suggested by a phenomenon studied in visual science known as "verbal overshadowing."[13] Under this effect, when a non-verbal comparative process is disrupted by a task involving verbalization, the non-verbal comparative process is adversely affected. For example, studies have shown that when people are asked to describe a face after seeing it, they are worse at later recognizing the face than those who saw the face, but who did not describe it.

As a final note, I would like to thank the editors at Intellectual Property Today for agreeing to let me share my thoughts with you on design patent law. I first became acquainted with this area of law in early 2003 when a potential client walked through the door with a fingernail buffer patent. I took the case thinking it would be an interesting one to try. Five years later, I was honored to argue before the Federal Circuit the case of *Egyptian Goddess v. Swisa*, the only design patent case the court has accepted and decided en banc. In the years following my first encounter with that now famous fingernail buffer, I've found design patent law to be both challenging and fascinating, and I look forward to exploring it with you every month in this column. IPT

ENDNOTES

1. Time Magazine - 12 Dec 2007.
2. Apple overtook Microsoft as the world's most valuable technology company in 2010, and on May 9, 2011, global brands agency Millward Brown announced that Apple had overtaken Google as the world's most valuable brand.
3. Fortunately for Apple, legal protection currently exists for industrial designs. On April 15, 2011 Apple, Inc. sued Samsung Electronics Co., LTD. et al., for, *inter alia*, design patent infringement in Case No. 5:11-cv-01846 filed in the United States District Court for the Northern District of California. The iPhone design patents involved are D627,790, D602,016, and D618,677.
4. For an interesting article on the adversarial relationship between law and art, *see* Duong, *Law is Law and Art is Art and Shall the Two Ever Meet? Law and Literature: The Comparative Creative Processes*, 15 Southern California Interdisciplinary Law Journal 1 (2005-2006).
5. 81 U.S. 511 (1871).
6. 148 U.S. 674 (1893).
7. 67 F.2d 428 (6th Cir. 1933).
8. *Id.* at 429.
9. 728 F.2d 1423 (Fed. Cir. 1984).
10. 543 F.3d 665 (Fed. Cir. 2008).
11. 550 U.S. 398 (2007).
12. 543 F.3d at 680.
13. *See* Meissner and Memon, *Verbal Overshadowing: A Special Issue Exploring Theoretical and Applied Issues*, 16 Applied Cognitive Psychology 869-872 (2002).

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