A Brief Journey through Design Patent Infringement Law

By: Robert G. Oake, Jr.*

In the Beginning, a need for design patent law arose because utility patent law, trademark-trade dress law, and copyright law did not protect the appearance (ornamentation and shape or configuration) of manufactured articles. Utility patent law protected useful and functional inventions, copyright law protected designs that are "separable" from functional features, and trademark-trade dress law protected designs that are not legally "functional." But there was no body of law protecting a design that was part of an article of manufacture. To remedy this situation, in 1842 Congress enacted the first design patent law.[1] Lawmakers decided to place protection for such designs into the general framework of utility patent law. However, since utility patent law is concerned primarily with function and not appearance, natural conflicts and tensions arose between design and utility patent law that exist to this day.

The first important Supreme Court case involving design patent law was *Gorham v. White*.[2] This case established two important rules. First, infringement was determined not through the eyes of an expert, but rather through the eyes of an "ordinary observer." Second, when comparing two designs, it was the effect upon the eye that was important, and not the specific

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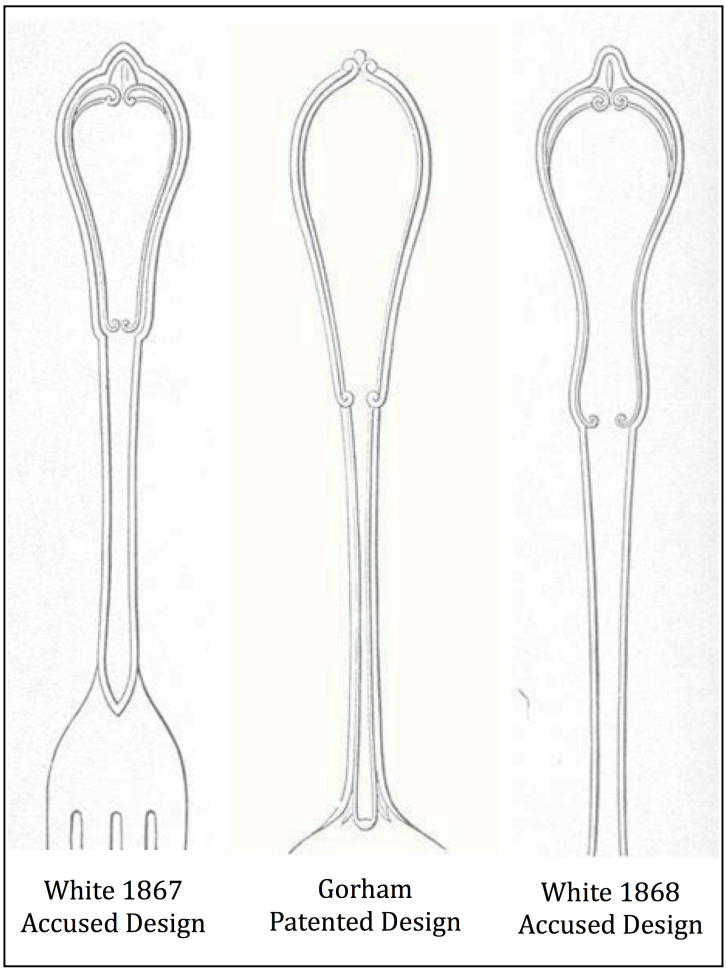
* Registered Patent Attorney, Board Certified Civil Trial Advocate – National Board of Trial Advocacy, LL.M in Patent and Intellectual Property (*with highest honors*), George Washington University School of Law. Robert served as lead counsel for Egyptian Goddess, Inc. Comments may be sent to rgo@oake.com.

[1] The 1842 statute provided in relevant part "* * * Any citizen * * * who by his * * * own industry, genius, efforts, and expense, way have invented or produced any new and original [1] design for a manufacture, whether of metal or other material or materials, or any new and original [2] design for the printing of woolen, silk, cotton, or other fabrics, or any new and original [3] design for a bust, statute, or bas relief or composition in alto or basso relievo, or any new and original [4] impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful [5] pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original [6] shape or configuration of any article of manufacture not known or used by others before his * * * invention * * * may make application * * * to the Commissioner of Patents * * * and the commissioner * * * may grant a patent therefor * * *. (Italics and numbers ours.)" *In re Schnell*, 18 C.C.P.A. 812, 814-815 (C.C.P.A. 1931).

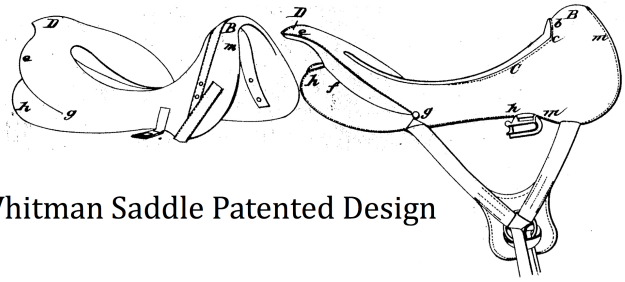
[2] 81 U.S. 511 (1871).

details of the designs. *Gorham* gave us the so-called "ordinary observer" test, which is "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." 81 U.S. at 528. The Court explained that the "controlling consideration" was whether the "effect" of the designs was the same. *Id.* at 525, 526. ("We do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect."). The "main test of substantial identity of appearance" was considered to be "sameness of effect upon the eye." *Id.* at 527.



Although *Gorham* established the important principles of substantial (and not exact) similarity though the eyes of an ordinary observer (and not an expert), it did not provide much in the way of specifics for determining infringement. Some have viewed the patented and accused spoon designs in *Gorham* and concluded that there are fairly significant visual differences in the designs. That may be true. However, the case can be placed in context and understood by remembering that the defendant was arguing infringement should be determined by considering the details of the design through the eyes of an expert. The Court rejected that argument and, based upon the testimony of such prominent witnesses as C. L. Tiffany, head of the house of Tiffany & Co., held for the plaintiff Gorham.

The second important Supreme Court case involving design patent law was *Whitman Saddle.*[3] This case introduced the concept that designs are to be compared against each other in light of the prior art (prior designs). In *Whitman Saddle*, a saddle design patent was held invalid as being obvious in light of the prior art. The Court also explained that even if the saddle design patent was not invalid, there was no infringement because the one design element that differed from previous saddle designs (a sharp drop in the rear of the pommel) was missing in the accused saddle design. This observation generally introduced the concept that patented and accused designs are to be compared in light of the prior art (previous saddle designs) and not simply against each other.



Whitman Saddle Patented Design

Although there have been no significant Supreme Court cases since *Gorham* and *Whitman Saddle* to clarify the principles of when a design infringes a patented design, following *Whitman Saddle* the lower courts began to develop a set of clarifying principles. In *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428 (6th Cir. 1933), the court explained "that on the issue of infringement 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." *Id.* at 429. The court found no conflict between the *Gorham* ordinary observer test and the requirement that the accused design must present the appearance that distinguished the patented design from the prior art. The court reasoned that the ordinary observer, who already possessed reasonable familiarity with the

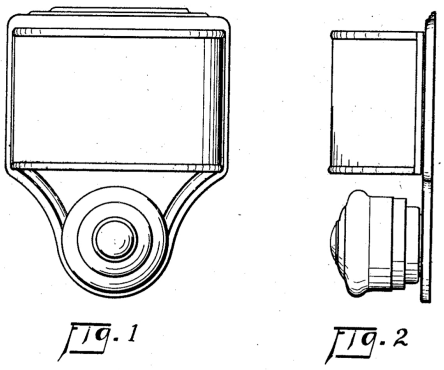
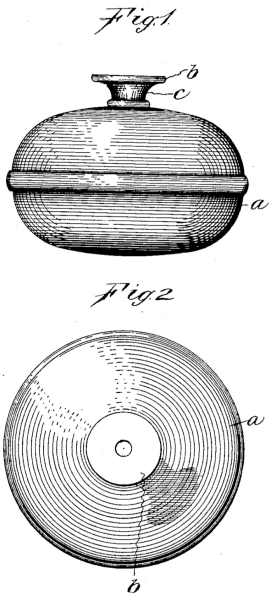


Fig. 1 Fig. 2

Applied Arts
Combination Ash Receiver
and Electric Lighter

[3] 148 U.S. 674 (1893).

prior art, necessarily made the comparison in relation to the prior art. The requirement that the accused design must present the appearance that distinguished the patented design from the prior art was not a second test distinct from the ordinary observer test, but was rather *part of the ordinary observer test* and a necessary requirement of infringement. The court explained it was important to make the comparison in relation to the prior art because designs that may appear similar in isolation may appear different when compared in light of the prior art.

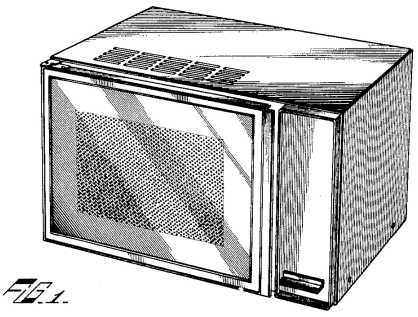


Bevin Bros. Bell Design

The court in *Applied Arts* also used a practical test for analyzing infringement. When the accused design differed from the patented design more widely than the patented design differed from the prior art, there was no infringement. This practical test had been used in other cases as well. For example, in *Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co*., 114 F. 362, 363 (U.S. Court of Appeals 1902), the court stated "[t]he shape of defendants' bell differs from plaintiff's more widely than plaintiff's differs from the [prior art bell shaped] door knob, and therefore defendants' construction does not infringe the patent." The practical test made sense because if the ordinary observer was able to distinguish the patented design from the prior art, and the differences between the accused design and the patented design were greater than the differences between the patented design and the prior art, then the ordinary observer also was able to distinguish between the accused and patented designs.

The Court in *Applied Arts* also made a useful observation concerning the ability of an ordinary observer to distinguish designs when the prior art was crowded. The court stated "[w]e are quite aware that similarity is not to be determined by making too close an analysis of detail, yet 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." *Id.* at 430. This made sense because an ordinary observer accustomed to making distinctions based on relatively minor differences in a crowded field was less likely to be confused by general design similarities.

In sum, the test for design patent infringement as expressed in *Gorham, Whitman Saddle,* and *Applied Arts* was whether the appearance of the patented and accused designs had such similar effect upon the eye that an ordinary observer would purchase the accused design thinking that it was the patented design. The comparison was made in relation to the prior art, which as a practical matter meant three things. First, to infringe, the accused design had to present the appearance that distinguished the patented design from the prior art. Second, if the accused design differed from the patented design more widely than the patented design differed from the prior art, then there was no infringement. Third, when the prior art was crowded, the ordinary observer made a more discriminative examination and comparison of the patented and accused designs, which meant that the scope of the design patent was construed more narrowly in a crowded field of prior art.



Litton Systems Microwave Oven

In 1981, Congress created the Court of Appeals for the Federal Circuit and gave it exclusive jurisdiction over patent appeals to "provide nationwide uniformity in patent law. H. R. Rep. No. 97-312, p. 20 (1981)." *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 162 (U.S. 1989). The Federal Circuit's first design patent case involving issues of infringement[4] was *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423 (Fed. Cir. 1984). In *Litton Systems,* the court acknowledged the *Gorham* and *Applied Arts* principles that (1) the *Gorham* "ordinary observer" test was the test for design patent infringement, (2) to infringe the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art, (3) if the accused design differed from the patented design more widely than the patented design differed from the prior art, then there was no infringement, and (4) when the prior art was crowded with generally similar designs, the range of equivalents[5] was construed narrowly.

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[4] Two earlier design patent cases before the Federal Circuit involved issues of validity (*In re Salmon*, 705 F.2d 1579 (Fed. Cir. 1983) and double patenting (*Carman Industries, Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983)).

[5] The court has stated that "it has long been recognized that the principles of equivalency are applicable under *Gorham*." *Lee v. Dayton-Hudson Corp*., 838 F.2d 1186, 1189 (Fed. Cir. 1988)).

However, in *Litton Systems* the court did not state that the "novelty" requirement was part of the ordinary observer test. Rather, the court appeared to treat the novelty requirement as separate from the ordinary observer test. The court stated:

> For a design patent to be infringed, however, 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." [cite omitted]. *That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art.*

Litton Systems, supra, at 1444. (emphasis added).

The quoted italicized statement suggested that the test for design patent infringement is performed in two distinct steps. First, a court compares the two designs through the eye of an ordinary observer. Second, if the designs are confusingly similar to an ordinary observer, then to find infringement a court must attribute the similarity to the novelty that distinguished the patented design from the prior art. The "two distinct tests" approach is, in fact, the way the Federal Circuit expressed the design patent infringement test after *Litton Systems*. *See Shelcore, Inc. v. Durham Industries, Inc*., 745 F.2d 621, 629 (Fed. Cir. 1984) (*Litton* … supplements the [ordinary observer] test with the requirement that "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art."); *Sun Hill Indus. v. Easter Unlimited*, 48 F.3d 1193, 1197 (Fed. Cir. 1995) ("Beyond the substantial similarity requirement of Gorham and L.A. Gear, design patent infringement requires that the accused product 'appropriate the novelty in the patented device which distinguishes it from the prior art.'") (quoting *Litton*); *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1320 (Fed. Cir. 2007) ("In a separate and distinct inquiry, the 'point of novelty' test requires proof that the accused design appropriated the novelty which distinguishes the patented design from the prior art.").

The separate point of novelty test was an example of the Federal Circuit's well-intended but ultimately flawed approach of attempting to objectify inherently subjective determinations through overly rigid tests. For another example, *see KSR v. Teleflex*, 550 U.S. 398, 417-419 (2007), where the

Supreme Court rejected the Federal Circuit's "teaching, suggestion, motivation" test for obviousness as being overly rigid. The first problem with the separate point of novelty test was that the overall patented and accused designs no longer were compared in relation to the prior art. This eliminated the infringement requirement that the accused design presented the substantial overall appearance (visual effect to the eye) that distinguished the patented design from the prior art. A separate and distinct point of novelty test therefore departed from the infringement principles discussed in *Gorham* and *Visual Arts.*

Further, a separate and distinct point of novelty test created two additional problems. First, often it is difficult to identify a "point of novelty." A design with several design elements may have several points of novelty over any given prior art design. The number depends on whether the points of novelty may be individual design elements, combinations of design elements, and whether the overall design can be identified as a point of novelty. When the patented design is compared against more than one prior art design, each of which has multiple and varied design elements, the difficulty of identifying a single and precise point of novelty increases. Under these circumstances, it becomes extremely difficult, if not impossible, to consistently and predictably identify a single point of novelty. When multiple points of novelty are available, the plaintiff patentee usually chooses one that is in the accused design,[6] and the accused infringer usually chooses one that is not in accused design.

The second problem is that when the "novelty" (distinctiveness from the prior art) requirement is separated from the ordinary observer test, designs that are in the prior art or obvious over the prior art can satisfy the ordinary observer test. Although the separate "point of novelty" test prevents exact prior art designs from being captured under the infringement test,[7] there is nothing to prevent designs obvious in light of the prior art from being

[6] This so-called "shopping list" approach has been condemned by district courts. *See Hosley Int'l Trading Corp. v. K Mart Corp*., 237 F. Supp. 2d 907, 911-13 (N.D. Ill. 2002); *Bush Indus., Inc. v. O'Sullivan Indus., Inc.,* 772 F. Supp. 1442, 1452 (D. Del. 1991).

[7] An accused design that is an exact copy of a prior art design will not possess the "point of novelty" that distinguishes the patented design from the copied design.

considered infringements.[8] The need to provide such protection may have motivated the Federal Circuit to create the "non-trivial advance" test.[9] However, the "non-trivial advance" test,[10] having substantive similarities to an obviousness test, is not the proper solution for the reasons stated by Judge Dyk in his dissent in *Egyptian Goddess*. 498 F.3d at 1359.

Due to the many problems created by the separate point of novelty test, the Federal Circuit finally agreed to reconsider the test. In *Egyptian Goddess, Inc. v. Swisa, Inc*., 543 F.3d 665 (Fed. Cir. 2008), a case involving fingernail buffers, the Federal Circuit rejected the "point of novelty" approach and held that the "ordinary observer" test should be the sole test for determining whether a design patent has been infringed.

The *Egyptian Goddess* Court discussed four core principles that are useful when applying the *Gorham* ordinary observer test. First, "[i]n some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear 'substantially the same' to

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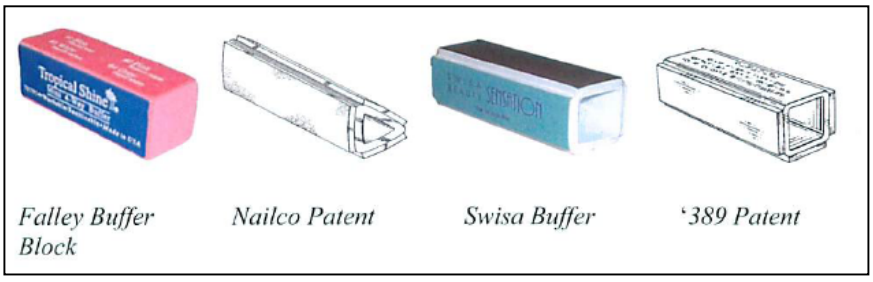
[8] Such a result can be prevented in utility patent cases through a hypothetical claim obviousness analysis. *See Key Mfg. Group, Inc. v. Microdot, Inc.,* 925 F.2d 1444, 1449 (Fed. Cir. 1991).

[9] Another motivation may have been the instinctive and common sense desire to make the initial visual comparison between the patented and accused designs in relation to the prior art, a requirement that had been removed from the ordinary observer test after *Litton Systems*. Such a comparative instinct was demonstrated by Egyptian Goddess expert witness Kathleen Eaton when she stated in her May 3, 2005 Declaration that "[i]n my opinion an ordinary observer and purchaser of nail buffers would consider that the patented design and the accused nail buffer have a substantially similar appearance in overall design, *particularly in light of other nail buffers*, such as a solid block buffer and the hollow triangular Nailco buffer." (emphasis added).

[10] The Federal Circuit cited *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893) as support for the "non-trivial advance" test. 498 F.3d at 1357. Following the case citation, the court added the parenthetical "(analyzing whether the accused device contained the aspects of the claimed design that 'rendered it patentable as a complete and integral whole')". *Id.* The quoted phrase from *Whitman Saddle* is better understood as the Supreme Court determining whether the accused saddle substantially appropriated the distinctive overall appearance of the patented saddle design that distinguished it from the prior art (and made it patentable). The Court did not just identify a "point of novelty" in the patented saddle design and then determine whether the identified point of novelty was in the accused saddle. Rather, the Court considered the novel aspect of the saddle design as being inseparable from "a complete and integral whole" for purposes of an infringement comparison with the accused saddle.

the ordinary observer, as required by *Gorham.*" 543 F.3d at 678. Second, "[i]n other instances, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art…." *Id.* Third, "[w]here there are many examples of similar prior art designs, as in a case such as *Whitman Saddle*, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art." *Id.* Fourth, "if the accused infringer elects to rely on the comparison prior art as part of its defense against the claim of infringement, the burden of production of that prior art is on the accused infringer." *Id.*

The Court in *Egyptian Goddess* also alluded to a fifth principle, arguably the most historically important, when determining whether to uphold a summary judgment of non-infringement. This fifth principle is whether the accused design is closer in appearance to the patented design than the accused design is to the prior art. If it is not, then summary judgment of non-infringement is appropriate. Unfortunately, the Federal Circuit did not apply this test to the facts of the *Egyptian Goddess* case. If the Court had, the case would have been reversed and remanded for trial because the accused nail buffer is clearly closer in appearance to the patented design than it is to the prior art.



The *Egyptian Goddess* case corrects the Federal Circuit's "point of novelty" mistake, but the result is inconsistent with pre-Federal Circuit case law. Further, the case does not provide a clear and comprehensive framework for analyzing whether one design infringes another design. Lower courts, lawyers, and businessmen are now left to wonder what legal principles eventually will fill the void left by the now abandoned "point of novelty" test. A suggested way to fill this void is the subject of the paper "Rethinking Design Patent Infringement Law" by Robert G. Oake, Jr.