Design Patents after *Egyptian Goddess v. Swisa*

MIPLA Feb. 2010

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Why patent designs?

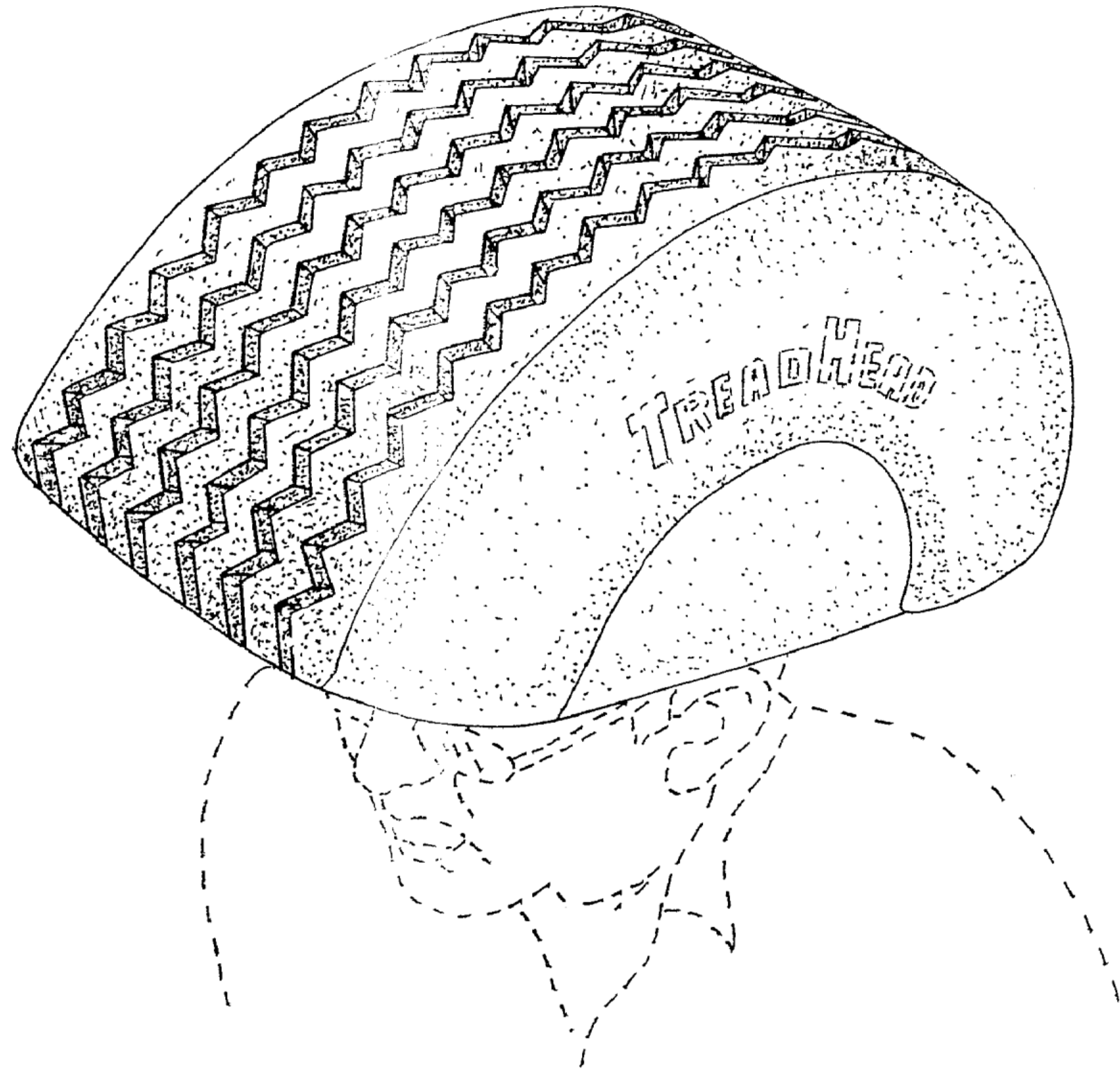
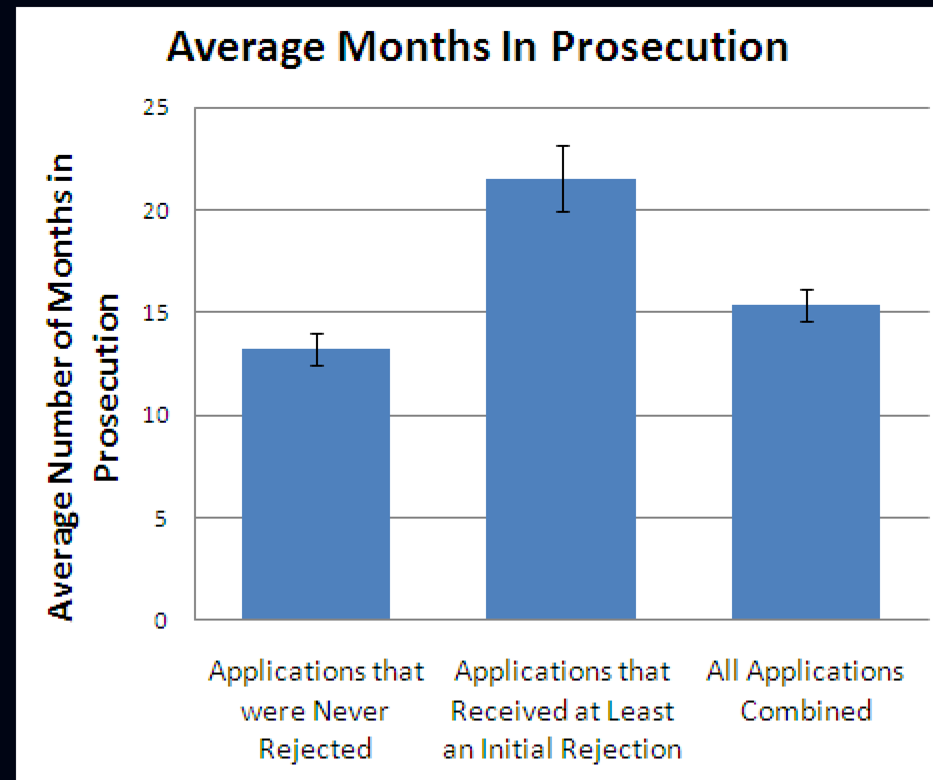


FIG. 1

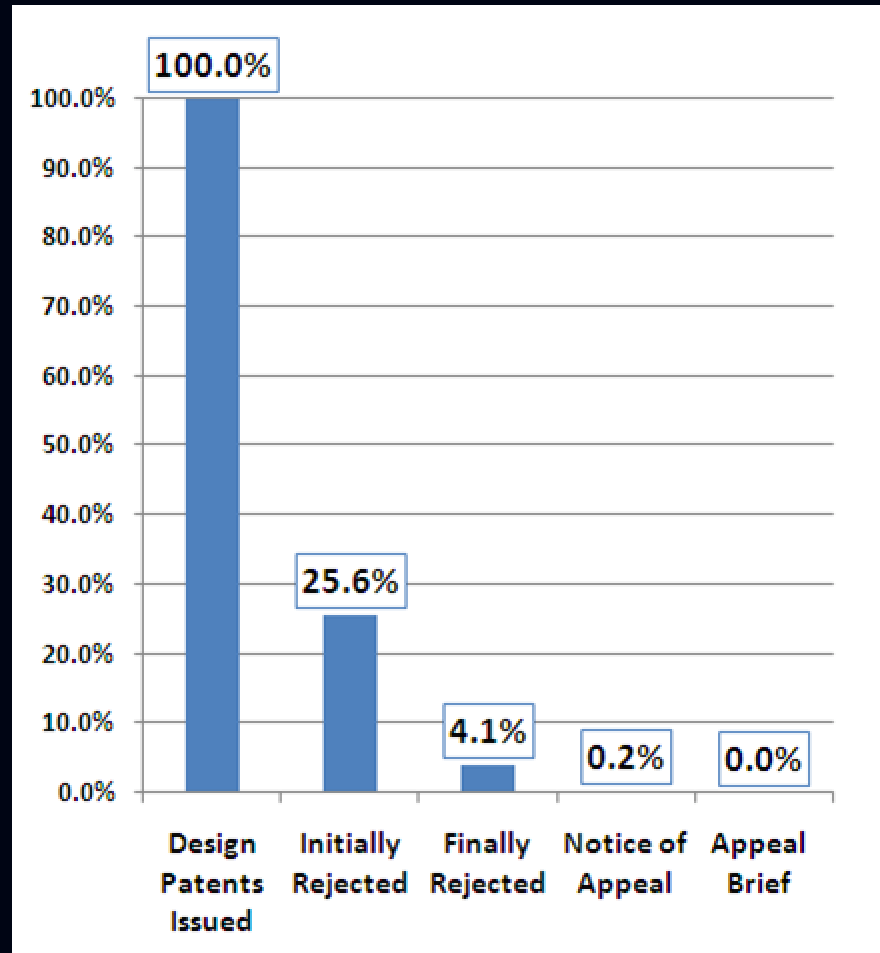
- ***Wal-Mart* effect**

- 15-mo. Average pendency
- Expedited examination available (37 CFR 1.155)



Dennis Crouch, Patently-O, Apr. 2, 2009

- less complex (less expensive?) prosecution



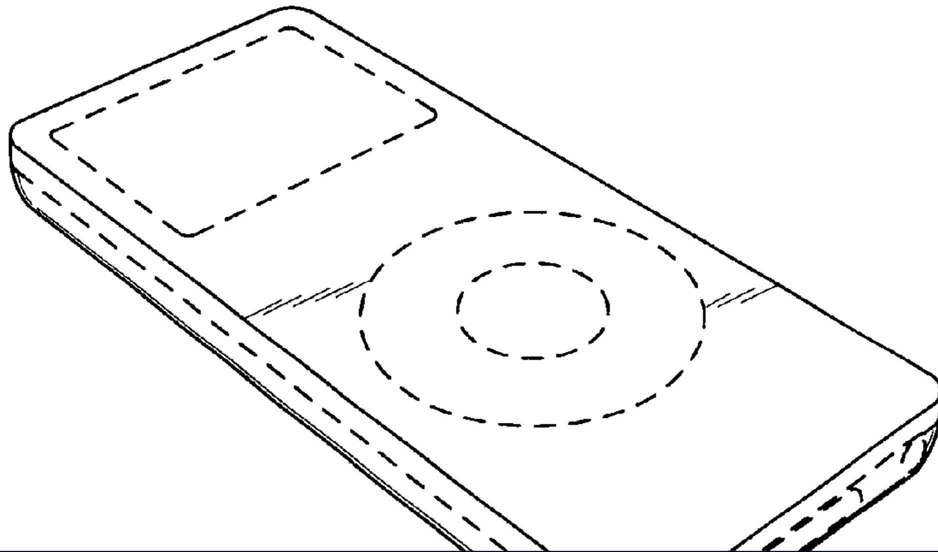
Dennis Crouch, Patently-O, Apr. 2, 2009

- **profits**

35 U.S.C. § 289. Patents for designs

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his entire profit. . .

- **everyone else is**



U.S. Patent Jun. 5, 2007 Sheet 1 of 4 US D543,681 S

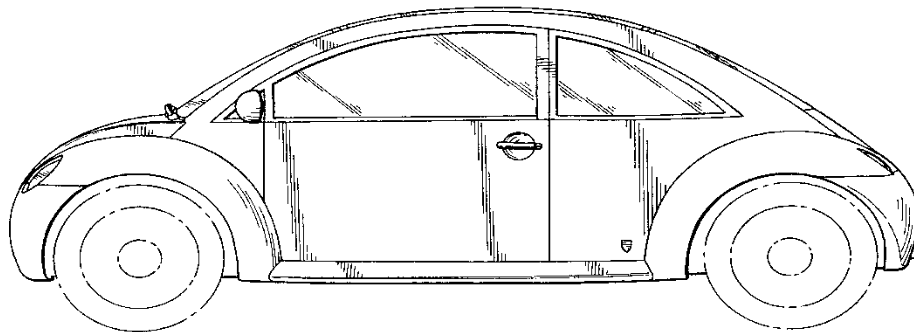


FIG. 6

U.S. Patent Feb. 27, 1996 Sheet 6 of 6 Des. 367,440

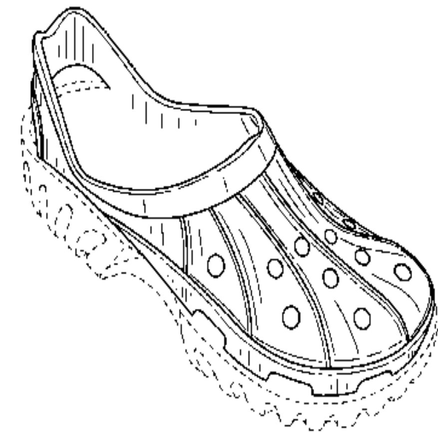
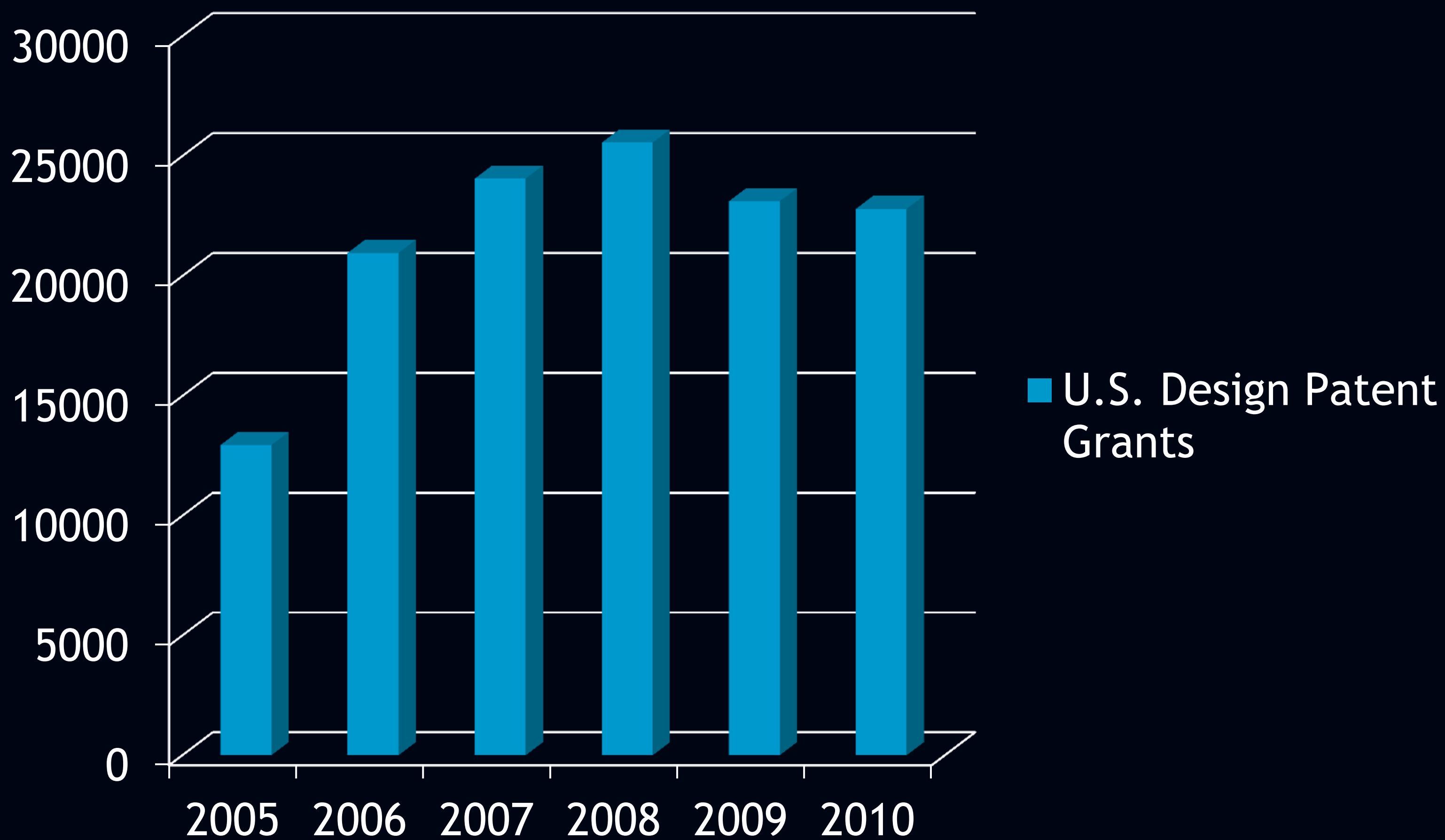


FIG.1

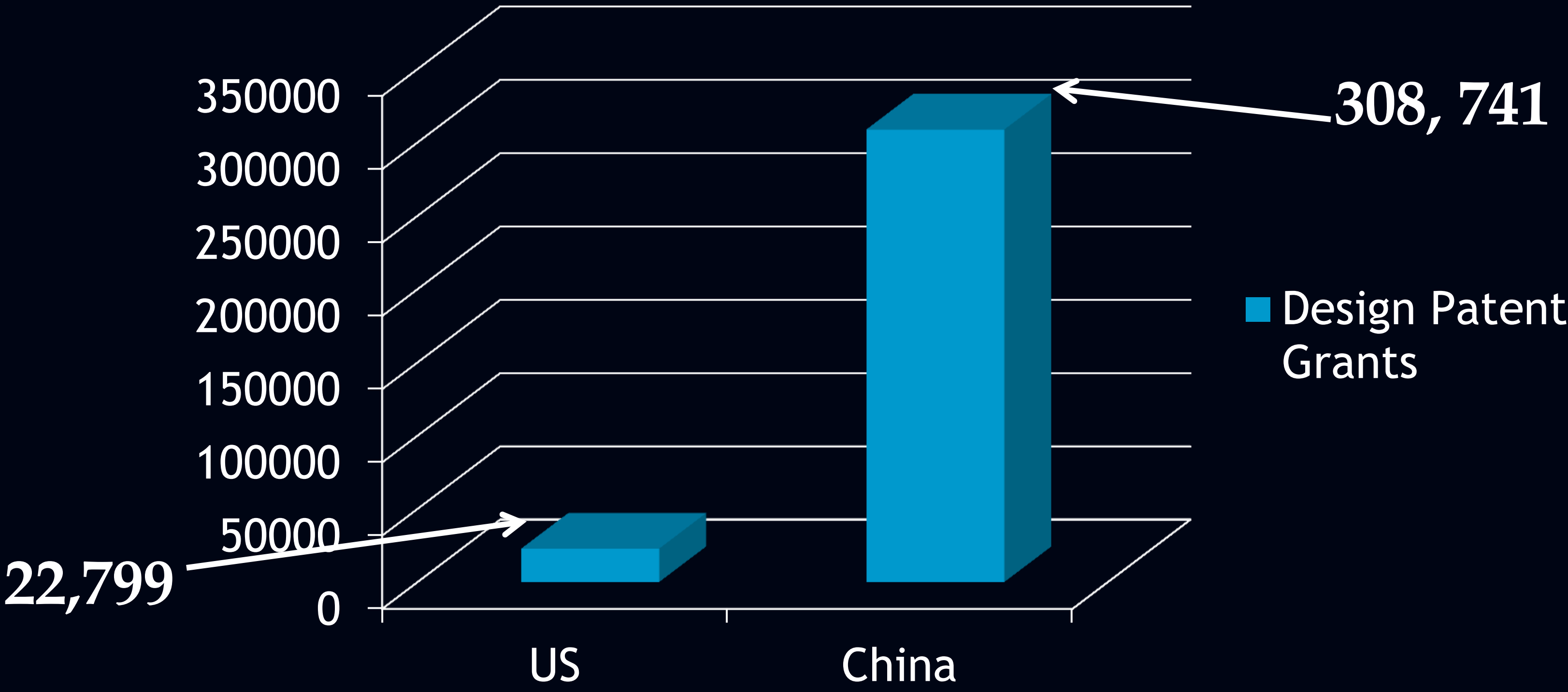
Top recipients of U.S. Design Patents 1977-2009

(1) Sony
(2) Samsung
(3) Nike
(4) Matsushita
(5) Goodyear
(6) Motorola
(7) Procter & Gamble
(8) Canon
(9) Black & Decker
(10) Sharp

USPTO Design Patent Report (2010)



USPTO Design Patent Report (2010); USPTO 2010 Patent Statistics



USPTO Patent Statistics; SIPO statistics Dec. 23, 2010

Design patent infringement after *Egyptian Goddess v. Swisa* (Fed. Cir. 2008) (*en banc*)

Gorham v. White (US 1871) ordinary observer test

"We hold, therefore, 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."

Gorham v. White (US 1871) ordinary observer test

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Federal Circuit point-of-novelty test

Accused design must also appropriate the points of novelty of the claimed design.

criticisms of the point-of-novelty test

-more points of novelty = narrower scope?

-overall appearance as a point of novelty?

-point of “novelty and nonobviousness” required?

Egyptian Goddess infringement rules

- "the 'point of novelty' test should no longer be used in the analysis of a claim of design patent infringement"

-the *Gorham* test "should be the sole test for determining whether a design patent has been infringed"

Egyptian Goddess infringement rules

-rule for "easy" cases: "In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more" that the designs are not similar under the *Gorham* test

-rule for "hard" cases: "In 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"

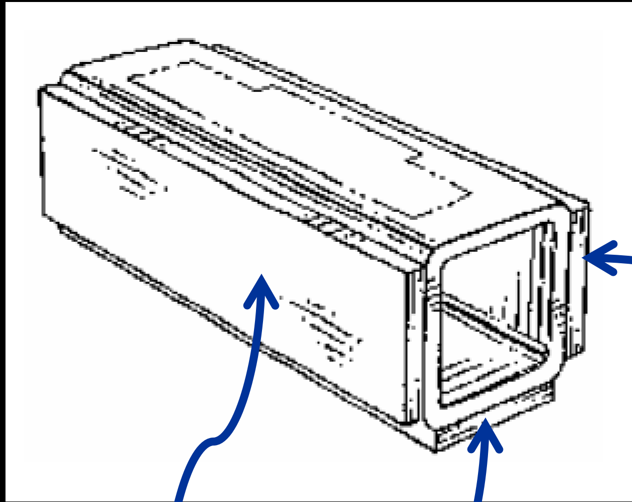
Egyptian Goddess infringement rules

-rule for "easy" cases: "In some instances, the claimed design and the accuse[...] distinct that it will be [...] designs are not simila[...]

accused infringer has the burden of producing evidence as to the prior art

-rule for "hard" cases: "In 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 <u>a comparison of the claimed and accused designs with the prior art</u>"

claimed:



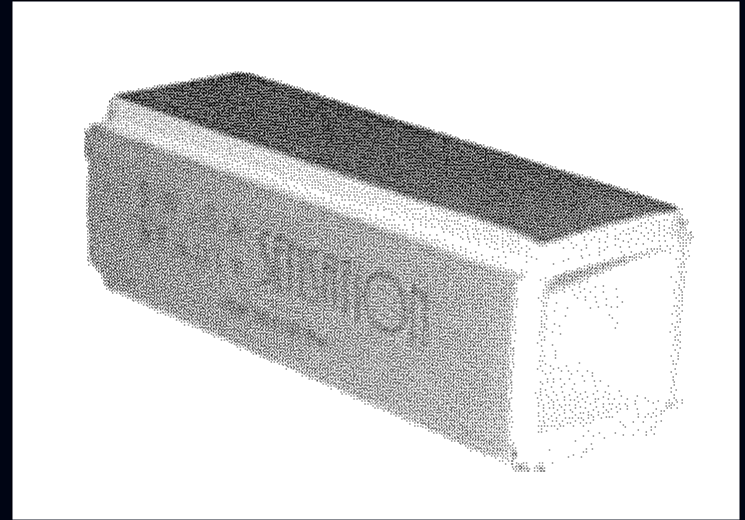
3

1

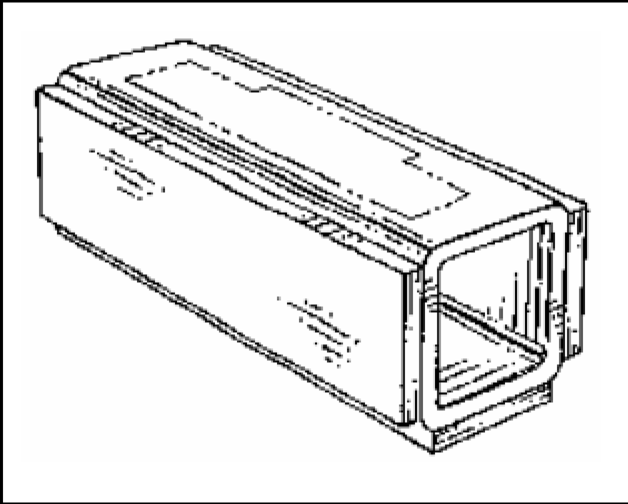
2

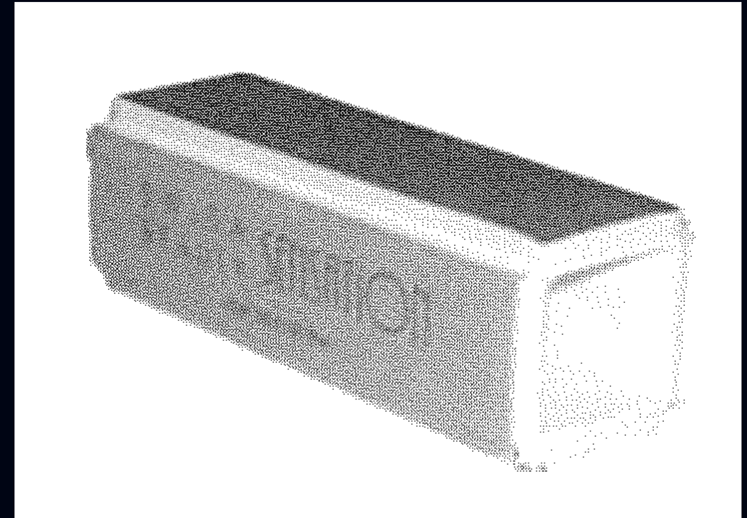
3 sides have abrasive surfaces

accused:



4 sides have abrasive surfaces

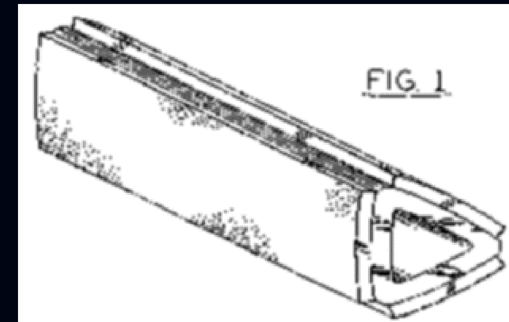




prior art:

Falley Buffer Block

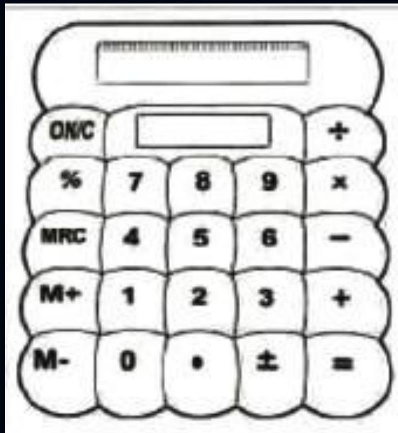
square cross-section



abrasive surfaces on 3 sides

“easy case” – “plainly dissimilar”?

claimed:



accused:

Competitive Edge, Inc. v. Staples, Inc. (N.D. Ill. 2010)

how discerning is the ordinary observer?

Crocs, Inc. v. Int'l Trade Comm'n (Fed. Cir. 2010)

claimed:

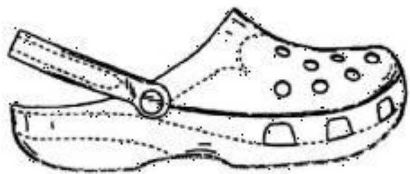


Figure 2

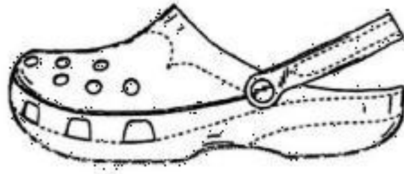


Figure 3

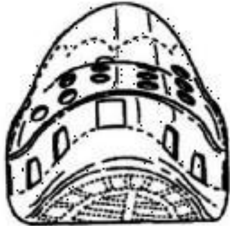


Figure 4

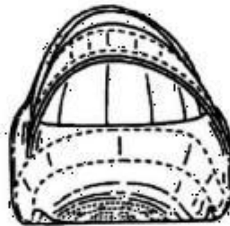


Figure 5

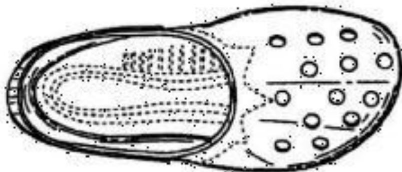


Figure 6

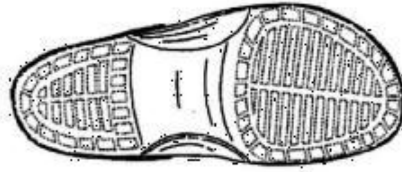


Figure 7

Crocs, Inc. v. Int'l Trade Comm'n (Fed. Cir. 2010)

-side-by-side view:

for infringement analysis, "the proper comparison requires a side-by-side view of the drawings of [the design patent] and the accused product"

-overall effect:

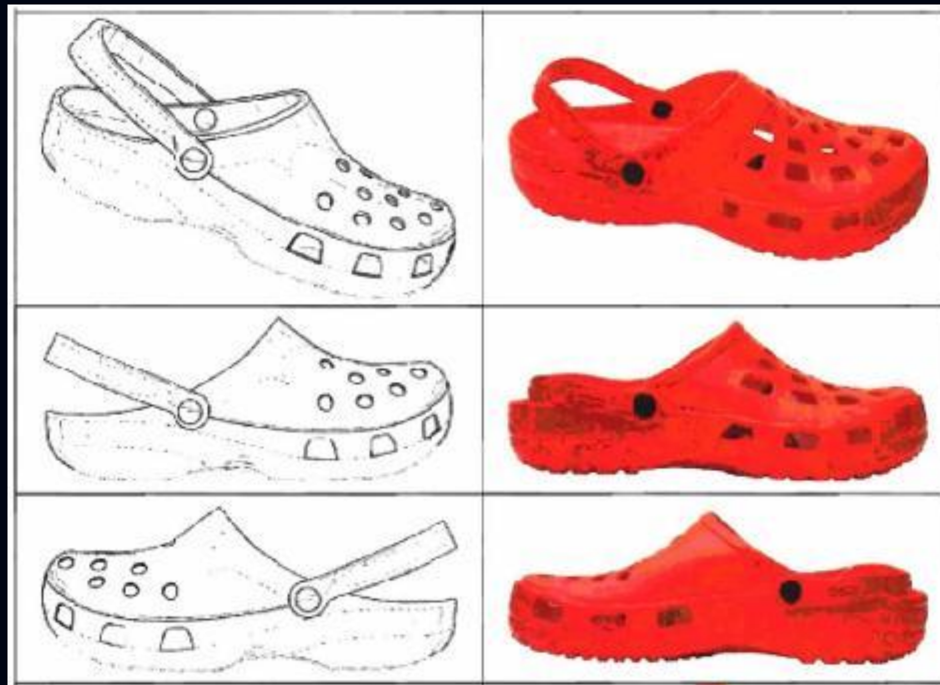
-ordinary observer test applies to design "in its entirety"

-ordinary observer attaches importance to small differences only to the extent that they affect overall appearance

- "Even if the claimed design simply combines old features in the prior art, it may still create an overall appearance deceptively similar to the accused design."

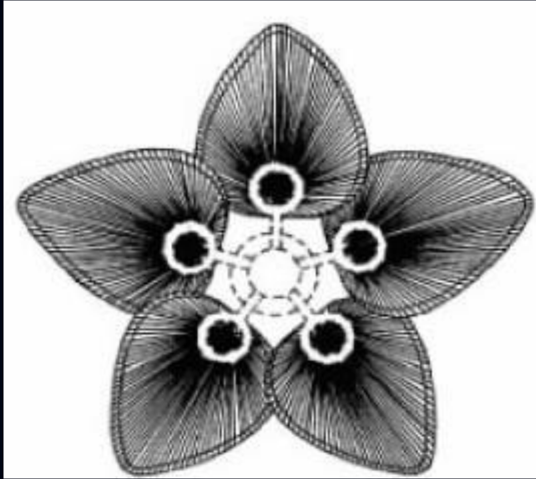
Crocs, Inc. v. Int'l Trade Comm'n (Fed. Cir. 2010)

claimed: accused:

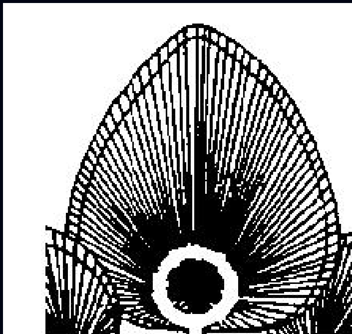


how discerning is the “ordinary observer”?

claimed:



accused:

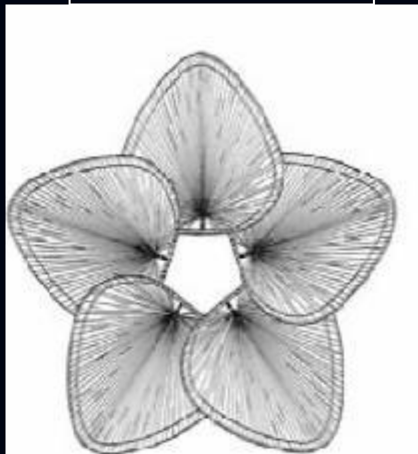
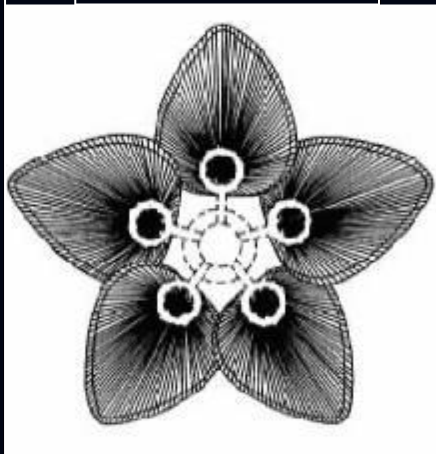
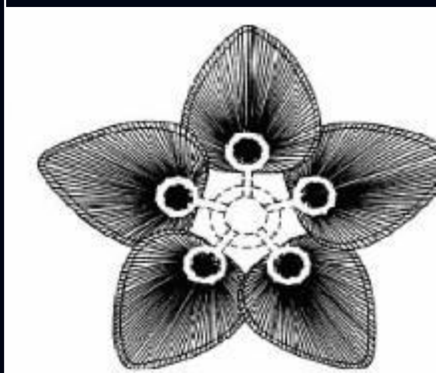
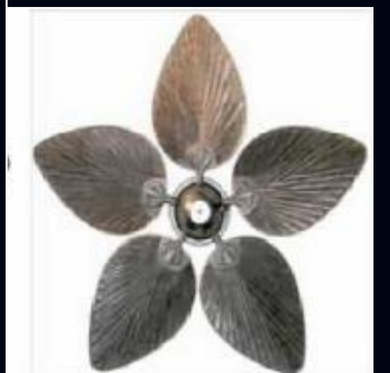


Fanimation v. Dan's Fan City (S.D. Ind. 2010)

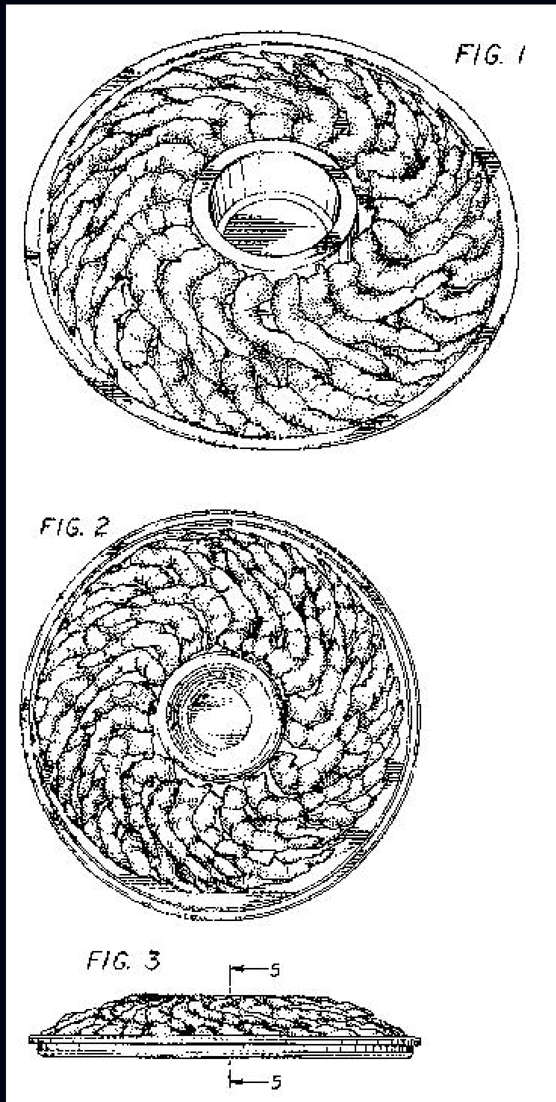
-persnickety?:

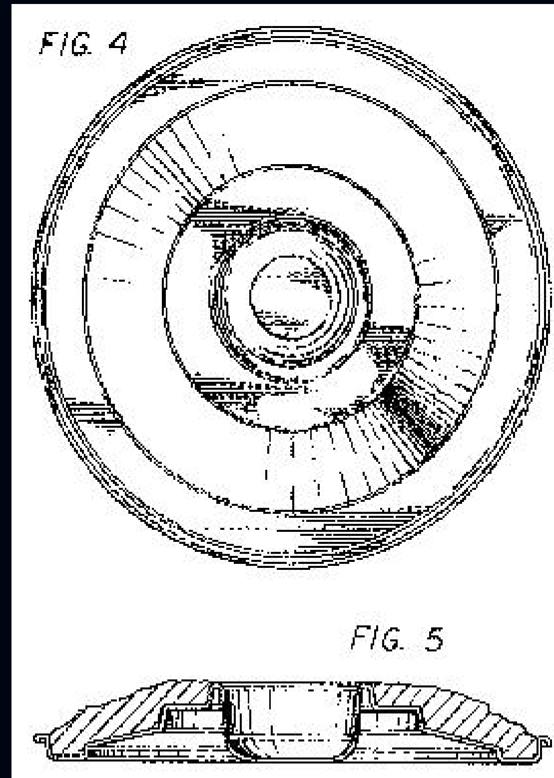
The hypothetical ordinary observer while perhaps not persnickety, is more discerning than [plaintiff] portrays. This ordinary observer is conversant in the prior art and examines *all* features of the product."

Fanimation v. Dan's Fan City (S.D. Ind. 2010)

prior art:	claimed:	accused:
		
		

who is the "ordinary observer"?

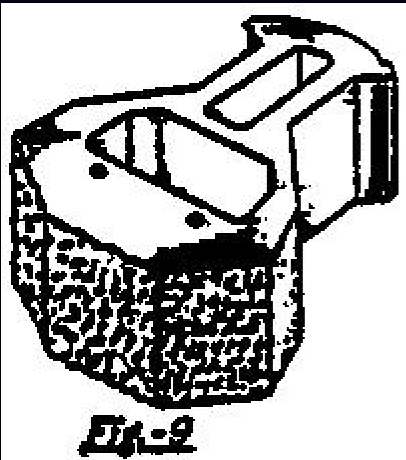




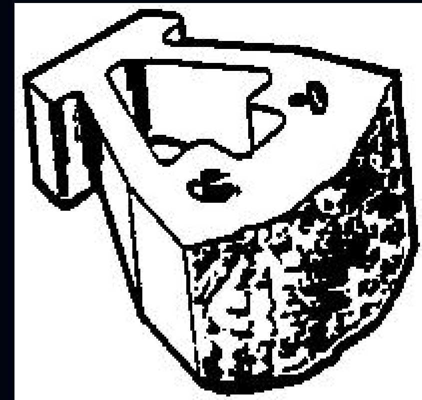
***Contessa Food Products, Inc. v. Conagra, Inc*. (Fed. Cir. 2002)**

who is the "ordinary observer"?

claimed:



accused:



KeyStone Retaining Wall v. Westrock **(Fed. Cir. 1993)**

has *Egyptian Goddess* resulted in more generous infringement analysis?

". . .because design patents have limited scope," the fact issue of infringement "is often resolved by summary judgment"

Great Neck Saw Mfrs. v. Star Asia USA (W.D. Wash. 2010)

Principles of Design Patent Claim Construction from *Egyptian Goddess*

(1) “Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to “construe” a design patent claim by providing a detailed verbal description of the claimed design.”

(2) “While it may be unwise to attempt a full description of the claimed design, a court may find it helpful to point out, either for a jury or in the case of a bench trial by way of describing the court's own analysis, various features of the claimed design as they relate to the accused design and the prior art.”

(3) “[A] trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim” including:

-role of drafting conventions

-statements in prosecution history

- “distinguishing between those features of the claimed design that are ornamental and those that are purely functional. . .”

are courts choosing to render verbal claim constructions of design patents?

-“excessive reliance” on “a detailed verbal claim construction” may lead to error because it may divert attention away from the overall design, and instead concentrate attention on ornamental features in isolation

Crocs, Inc. v. Int’l Trade Comm’n **(Fed. Cir. 2010)**

The '052 Patent

Defendants' Tuscan Estate design

***Minka Lighting, Inc. v. Maxim Lighting Intern., Inc.*, 2009 WL 691594 (N.D. Tex. March 16, 2009)**

“The claim of the '052 patent is ‘[t]he ornamental design for a light globe, as shown and described.’ The design of the light globe in the '052 patent is a combination of an upper portion, a central body, and a base. The upper portion's rim is open and flares outwardly. The outer surface of the upper portion contains a plurality of vertical, rounded rectangular ridges separated evenly by spaced recesses around its circumference. The upper portion has a rounded ridge at its lower edge that abuts the central body. The central body is tulip shaped; its surface is covered by an evenly spaced, repeated, leaf-like design. The leaf-like design is comprised of a vertical leaf-like design and an immediately adjacent, inverted leaf-like design. The leaves of the leaf like design are connected to each other via a vine design. The base portion includes a ring below which is a cup-shaped bottom portion, with a cross-hatched surface appearance. The base portion is substantially smaller than the upper portion and the central body.”

Design Patent Anticipation Before and After *Egyptian Goddess*

Door-Master test:

-is the claimed design substantially similar to the prior art design from the perspective of the ordinary observer?
-does the claimed design contain the "points of novelty" found in the prior art design?

***Door-Master Corp. v. Yorktowne, Inc.* (Fed. Cir. 2001)**

International Seaway test:

-is the claimed design substantially similar to the prior art design from the perspective of the ordinary observer?

~~-does the claimed design contain the "points of novelty" found in the prior art design?~~

International Seaway Trading Corp. v. Walgreen's **(Fed. Cir. 2009) (eliminates point of novelty prong of anticipation test)**

International Seaway Trading Corp. v. Walgreen's (Fed. Cir. 2009)

claimed:

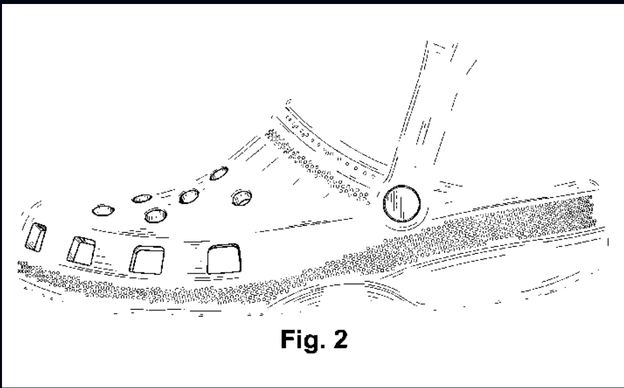


Fig. 2

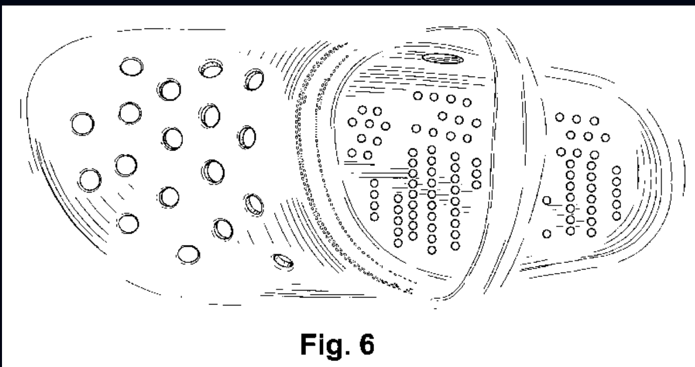


Fig. 6

prior art:

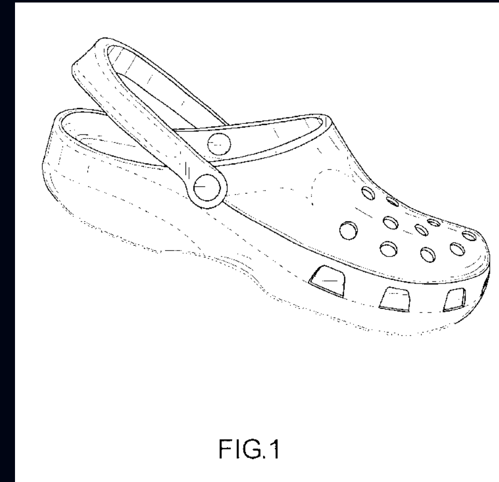


FIG.1

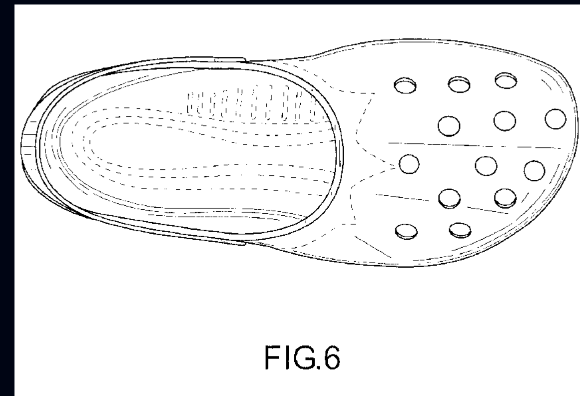


FIG.6

International Seaway Trading Corp. v. Walgreen's (Fed. Cir. 2009)

-majority: although ordinary observer test requires consideration of design as a whole, "this does not prevent the district court. . .from determining that individual features of the design are insignificant from the point of view of the ordinary observer and should not be considered as part of the overall comparison."

-dissent (Clevenger, J.): majority endorses "dissection of design as a whole into its component pieces" and "invites the problems we sought to eliminate by rejecting the 'point of novelty' test"

Design Patent Obviousness Before and After *Egyptian Goddess*

35 U.S.C. § 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

e.g., non-obviousness

-applying obviousness to designs is “impossible”

In re Nalbandian **(CCPA 1981) (Rich, J., concurring)**

ordinary designer v. ordinary observer

obvious to the "ordinary designer"

"In design cases we will consider the fictitious person identified in s 103 as 'one of ordinary skill in the art' to be the designer of ordinary capability who designs articles of the type presented in the application."

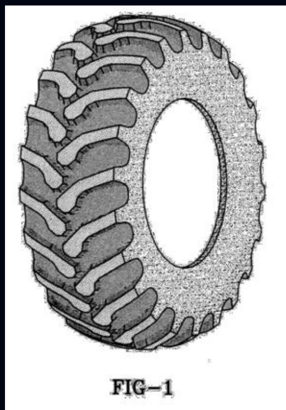
In re Nalbandian **(C.C.P.A. 1981)**

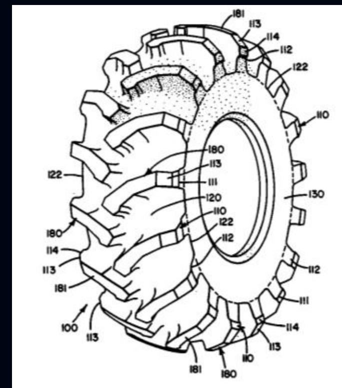
ordinary designer v. ordinary observer

still obvious to the "ordinary designer"????

"[E]ven though this court has reestablished the ordinary observer test as the controlling doctrine applicable to design patent infringement, it is not clear to what extent, if any, the doctrine applicable to obviousness should be modified to conform to the approach adopted by this court in *Egyptian Goddess*."

***Titan Tire Corp. v. Case New Holland, Inc.* (Fed. Cir. 2009)**





ordinary designer v. ordinary observer

still obvious to the "ordinary designer"????

"For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine [prior art references] or to modify a single prior art reference. Once that [task has been completed], obviousness, like anticipation, requires application of the ordinary observer test, not the view of one skilled in the art."

International Seaway Trading Corp. v. Walgreens Corp. **(Fed. Cir. 2010) (dicta)**

motivation to combine

-there must be primary reference "the design characteristics of which are basically the same as the claimed design."

-secondary references are only combinable with the primary reference if the two are so closely related "that the appearance of certain ornamental features in one would suggest the application of those features to the other."

***Durling v. Spectrum Furniture,* 101 F.3d 100 (Fed. Cir. 1996)**

motivation to combine

"Design patents, like utility patents, must meet the nonobviousness requirement of 35 U.S.C. § 103, and it is not obvious that the Supreme Court necessarily intended to exclude design patents from the reach of *KSR*."

***Titan Tire Corp. v. Case New Holland, Inc.* (Fed. Cir. 2009)**

motivation to combine

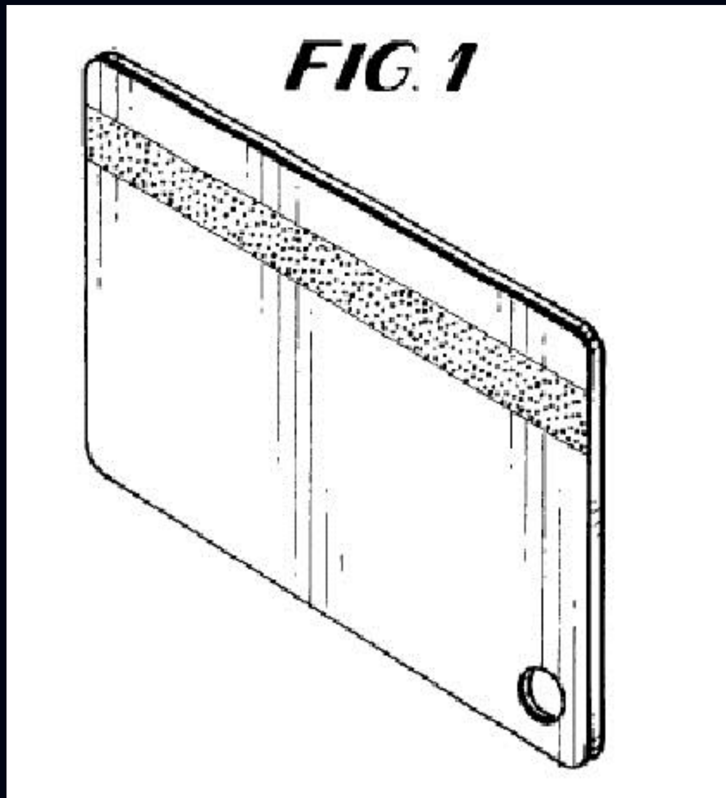
"Design patents, like utility patents, must meet the nonobviousness requirement of 35 U.S.C. § 103, and it is not obvious that the Supreme Court necessarily intended to exclude design patents from the reach of *KSR*."

***Titan Tire Corp. v. Case New Holland, Inc.* (Fed. Cir. 2009). . .**

***. . .but contra Vanguard Id. Sys. v. Kappos* (Fed. Cir. Jan. 24, 2011) (per curiam)????**

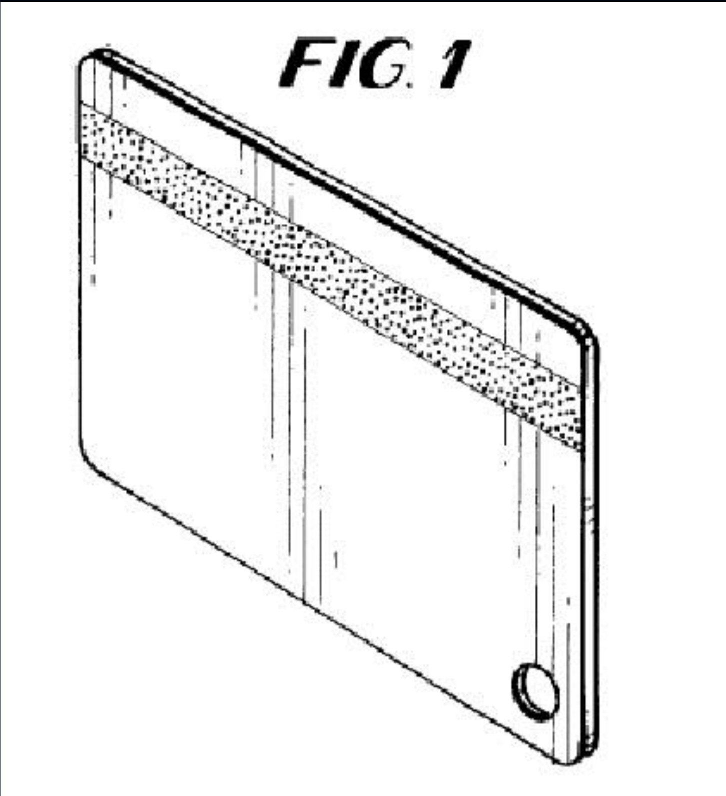
Vanguard Id. Sys. v. Kappos (Fed. Cir. Jan. 24, 2011) (per curiam)

claimed:

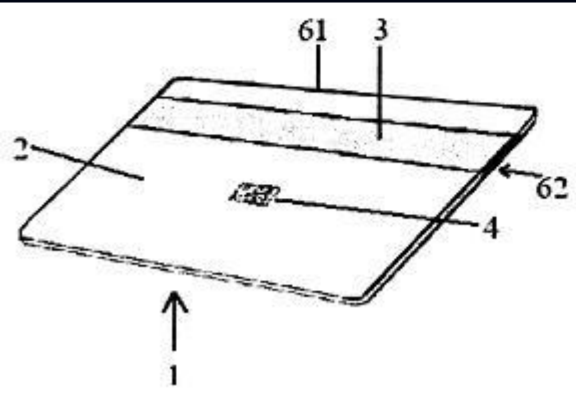


Vanguard Id. Sys. v. Kappos (Fed. Cir. Jan. 24, 2011) (per curiam)

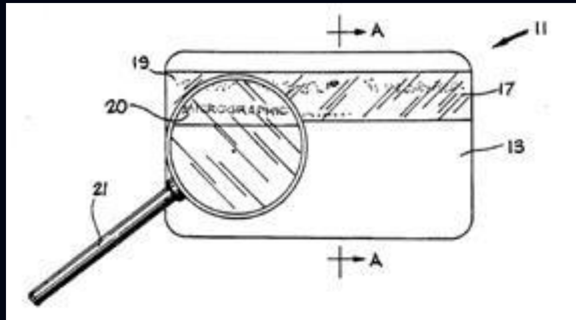
claimed:



asserted primary refs:



Keller

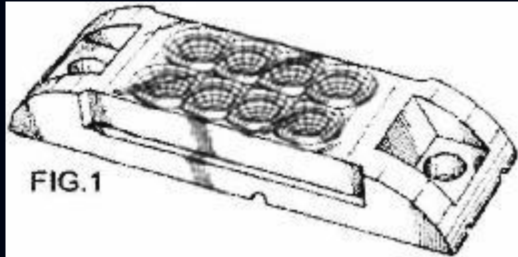


Drexler

motivation to combine

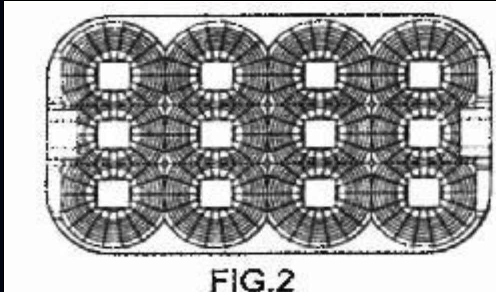
Vanguard Id. Sys. v. Kappos **(Fed. Cir. Jan. 24, 2011) (per curiam affirmance) (judgment below: neither Keller nor Drexler qualifies as a primary reference under the *Durling* standard)**

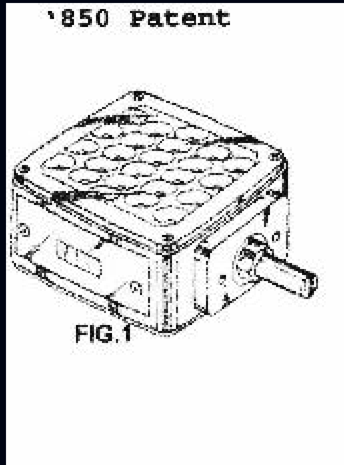
Grand Gen'l Accessories v. United Pacific Indus. (C.D. Cal. 2010)



'670 patent

prior art:





'850 patent

Design Patent Functionality

35 U.S.C. § 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

functionality as a validity doctrine

If the patented design is primarily functional rather than ornamental, the patent is invalid.

The design of a useful article is deemed to be functional when the appearance of the claimed design is dictated by the use or purpose of the article.

Best Lock Corp. v. Ilco Unican Corp. (Fed. Cir. 1996); PHG Techs. v. St. John Cos. (Fed. Cir. 2006)

functionality as a validity doctrine

whether the protected design represents the best design;

whether alternative designs would adversely affect the utility of the specified article;

whether there are any concomitant utility patents;
whether the advertising touts particular features of the design as having specific utility; and

whether there are any elements in the design or an overall appearance clearly not dictated by function.

factual considerations from *Berry Sterling v. Pescor* *(Fed. Cir. 1997)*

functionality as a validity doctrine

A patented design is functional for design patent purposes "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article")

Amini Innovation Corp. v. Anthony California, Inc. **(Fed. Cir. 2006)**

functionality as a scope doctrine

-claim construction necessarily precedes any functionality analysis - ***Berry Sterling Corp. v. Pescor Plastics, Inc.*** **(Fed. Cir. 1997)**

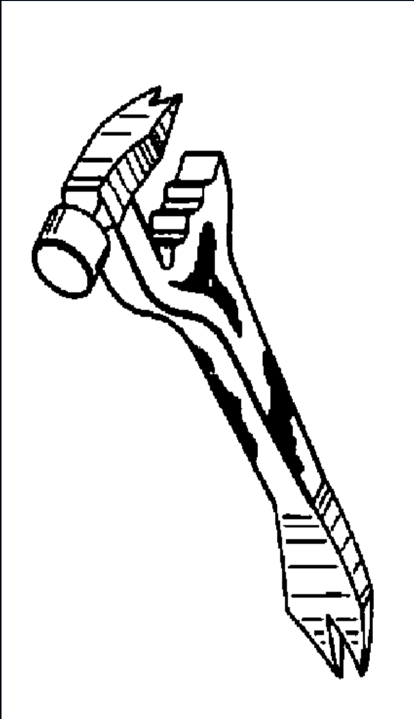
-where a design is composed of both ornamental and functional features, the patent owner must prove that the ordinary observer would be deceived by reason of the common features in the claimed and accused designs which are ornamental – ***Read Corp. v. Portec Inc.*****(Fed. Cir. 1992)**

functionality as a scope doctrine

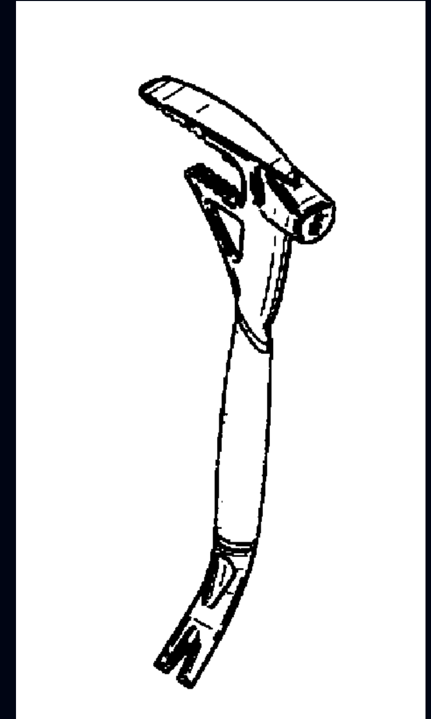
"a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. . .[such as] distinguishing between those features of the claimed design that are ornamental and those that are purely functional, *see Oddzon Prods., Inc. v. Just Toys, Inc.,* 122 F.3d 1396, 1405 (Fed. Cir. 1997) ("Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.")"

***Egyptian Goddess v. Swisa* (Fed. Cir. 2008) (en banc)**

Richardson v. Stanley Works (Fed. Cir. 2010)



patent-in-suit

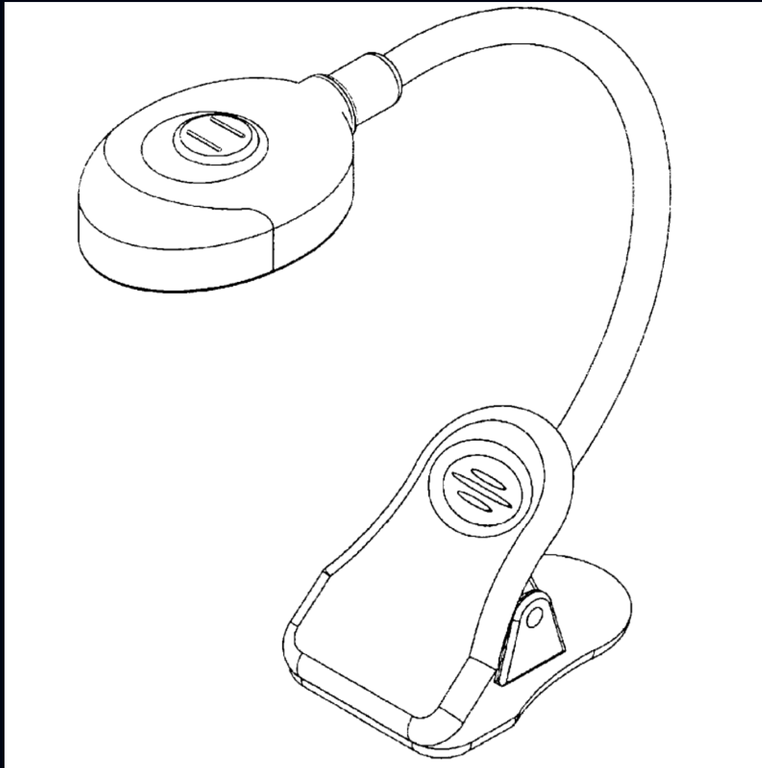


accused

-it was proper to “factor out” the functional aspects of a claimed design as part of the claim construction analysis, and it was proper to ignore those functional aspects when carrying out the ordinary observer test for infringement

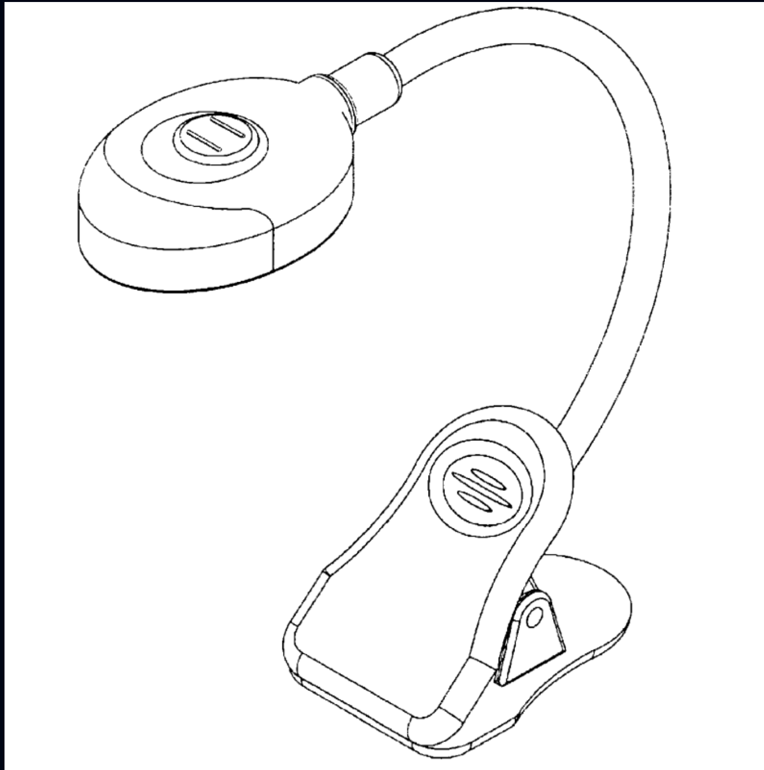
Richardson v. Stanley Works **(Fed. Cir. 2010)**

Good Sportsman Mktg. v. Li & Fung Ltd. (E.D. Tex. 2010)



-pltf's proposed claim construction: "ornamental design for a clip light as shown in Fig. 1"

Good Sportsman Mktg. v. Li & Fung Ltd. (E.D. Tex. 2010)



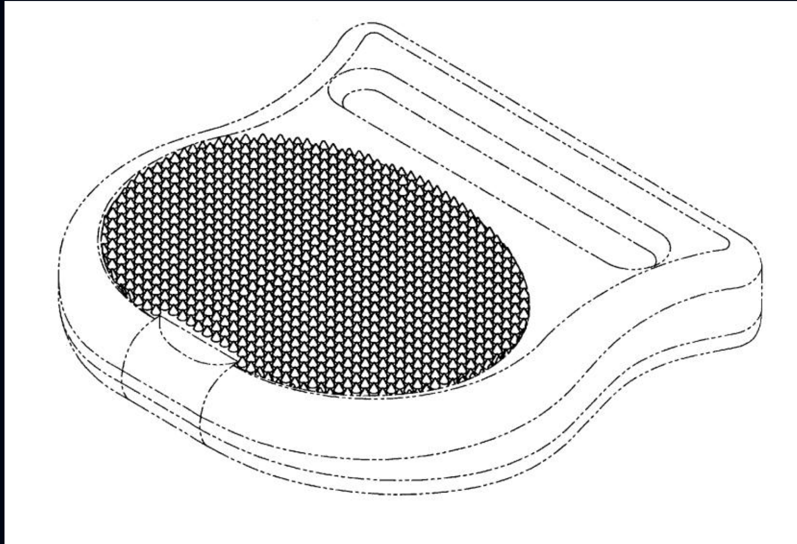
-pltf's proposed claim construction: "ornamental design for a clip light as shown in Fig. 1"

-deft's proposed claim construction: "ornamental design for a clip-on book light [excluding] the clip, the headlamp, the on-off switch, or the flexible wire. . ."

Good Sportsman Mktg. v. Li & Fung Ltd. (E.D. Tex. 2010)

-*Richardson* does not "compel[] the Court to wholly 'factor out' any element that serves a functional purpose. . .The utility of individual elements is irrelevant to the question of functionality, as it is the design in its entirety that provides the basis for the patent. . . .While the identified components may have functions, they need not be excluded simply because they perform functions, *e.g.*, the clip need not be excluded because it fulfills the clipping function, and the same rationale applies to the other elements." (adopting plaintiff's construction)

Universal Trim Supply Co. Ltd. v. K&K Cos. (D. Utah 2010)



<u>Applicant's statement in prosecution history</u>: "“The decorative member enables the zipper tab to be easily pulled, as the design prevents slippage of the wearer's fingers when using the zipper tab. ”

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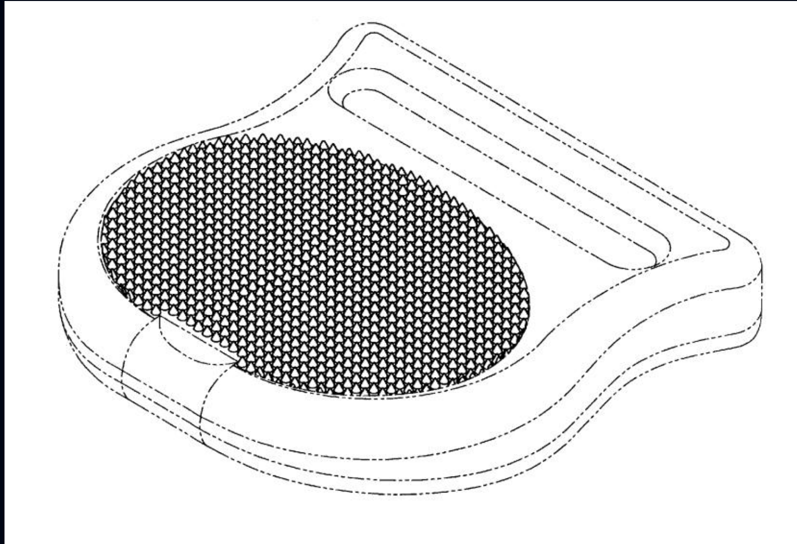

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court's functionality analysis: not "primarily functional"; design admittedly has a functional advantage, but shape and arrangement of pins might still be ornamental.