

Design Patent Infringement Gets a Manicure

Egyptian Goddess, Inc. v. Swisa, Inc.
No. 2006-1562 (Fed. Cir. Sept. 22, 2008)

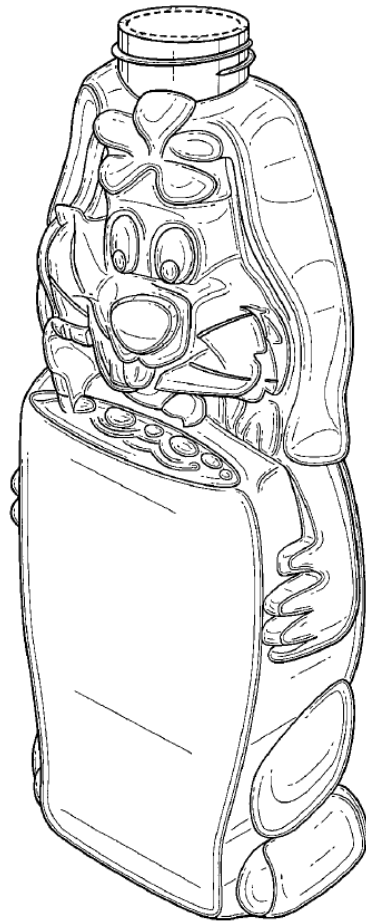


Presented by:
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Amber L. Neilson

Design Patents

- Protect the way an item **looks**, whereas utility patents protect the way an article is **used and works**.
 - <http://www.uspto.gov/web/offices/pac/design/index.html>
 - http://www.uspto.gov/web/offices/pac/mpep/documents/1500_1504_01_c.htm#sect1504.01c
- 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.

Examples of Design Patents



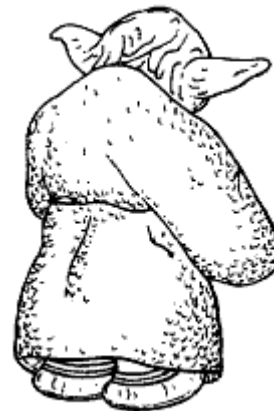
FUNNY BUNNY BOTTLE
US D460,914

Examples of Design Patents

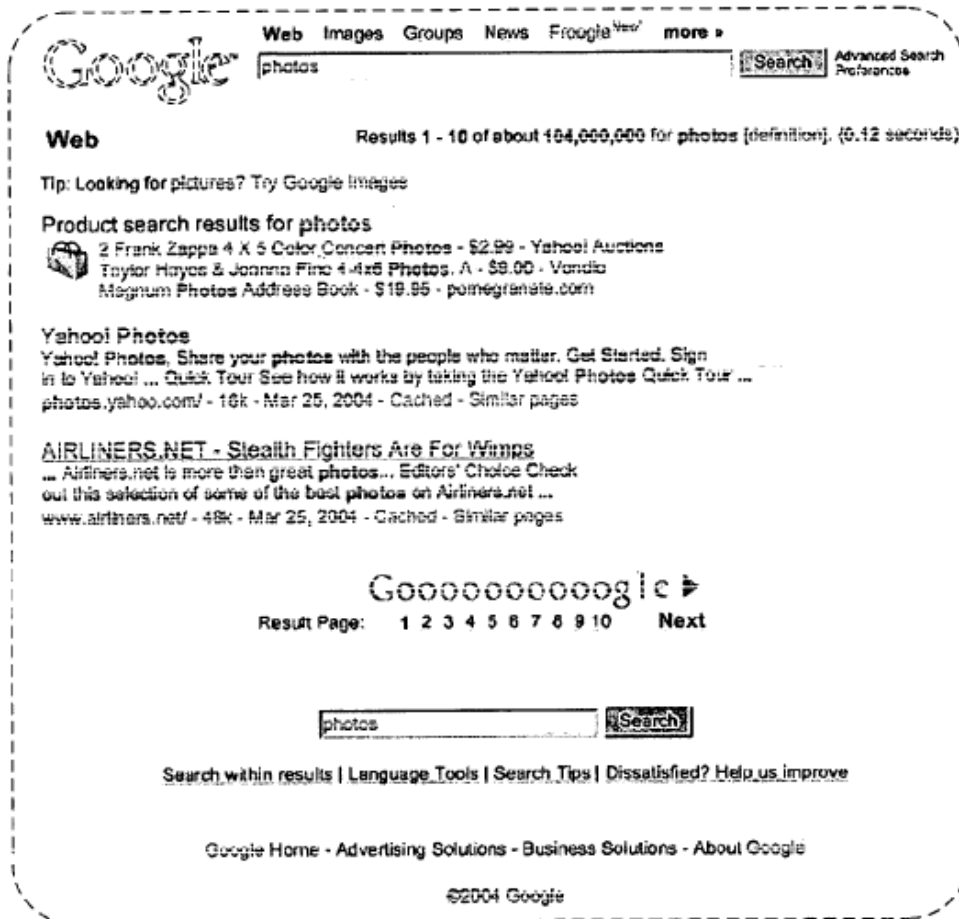


TOY FIGURE (aka "Yoda")

US D265,754



Examples of Design Patents



GRAPHICAL USER INTERFACE
US D533,561

Infringement

Before *Egyptian Goddess*:

- Two Tests Must Be Met for Infringement:
 - Ordinary Observer Test
 - Point of Novelty Test

Infringement

- Ordinary Observer test
 - *Gorham Co. v. White*, 81 U.S. 511 (1871)
 - “We hold therefore, that if, in the eye of the **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.”
 - Prior art and novel elements not considered(?)

Infringement

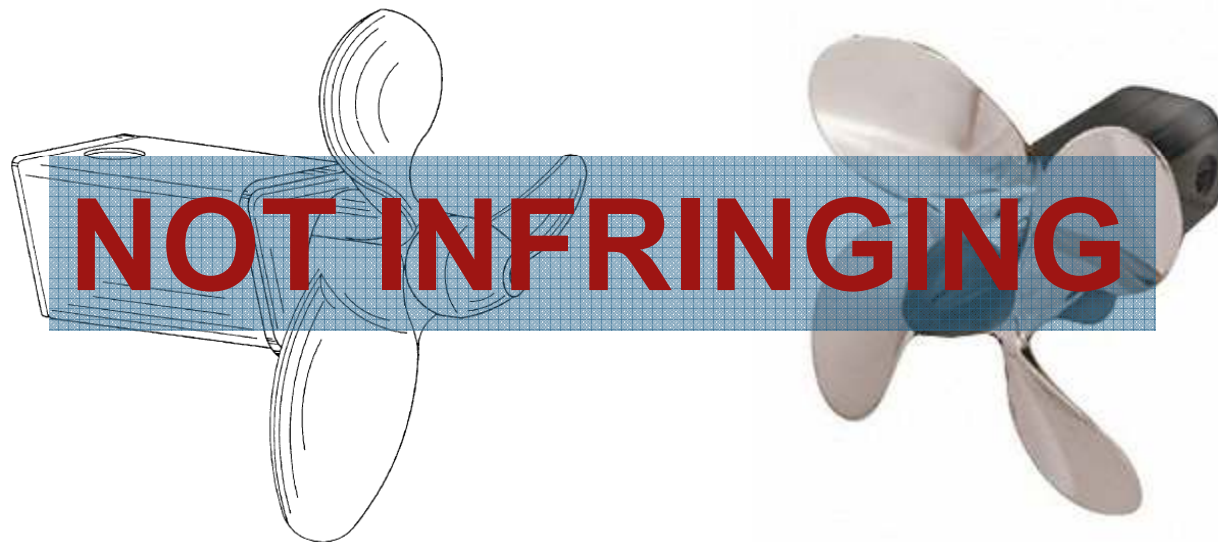
- Ordinary Observer test – what is observed?
 - All figures in the patent are used to determine the appearance of the design as a whole – in its entirety.
 - Claimed features must be visible during normal use (but such features are not limited to those visible at the point of sale).
 - *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002)

Infringement

- Ordinary Observer test – application
 - Analysis under the "ordinary observer" test is to be conducted with the "ordinary observer" and not the expert designer in mind.
 - "the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give." (*Contessa* citing *Gorham*)
 - The overall features of the top, side and underside of the accused products must be compared with the patented design as a whole as depicted in all of the drawing figures to determine infringement.
 - *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1381 (Fed. Cir. 2002)

Infringement

- Ordinary Observer test – application
 - *Hartco Engg, Inc. v. Wang's Int'l, Inc.*, 142 Fed. Appx. 455 (Fed. Cir. 2005)



Patented Design

Accused Design

Infringement

- Point of Novelty test
 - *Smith v. Whitman Saddle*, 148 U.S. 674 (1893)
 - Patented design combined the front half of the “Granger” saddle and the back half of the “Jenifer” saddle.
 - “...the design of the patent had two features of difference as compared with the Granger saddle...”
 - One difference was the “sharp drop” of the pommel which was missing from the accused design.
 - “...and unless there was infringement as to [the sharp drop] there was none at all.”

Infringement

- Point of Novelty test
 - *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984)
 - First Federal Circuit case to adopt “point of novelty”
 - Design for microwave ovens.
 - “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’.”

Infringement

- Point of Novelty test - Problems
 - Gave defendants the ability to essentially argue validity issues during an infringement analysis by attacking so-called points of novelty in the patented design.
 - No points of novelty = obvious (validity)
 - No points of novelty = nothing for accused infringer to infringe! (infringement)
 - *Lawman Armor v. Winner* (E.D. Pa. 2005) – the combination of non-novel design elements cannot create a separate point of novelty.
 - Contradicted other Fed. Cir. Cases stating that combination of elements could, in appropriate circumstances, become a distinct point of novelty. ***Supplemental opinion issued that said combination can be a point of novelty, but the “overall appearance” can not be a point of novelty.

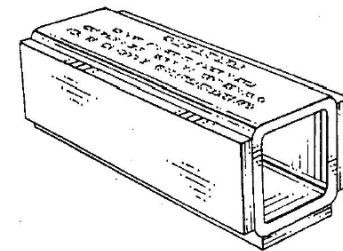
Why We're Here...



Nail Buffers!

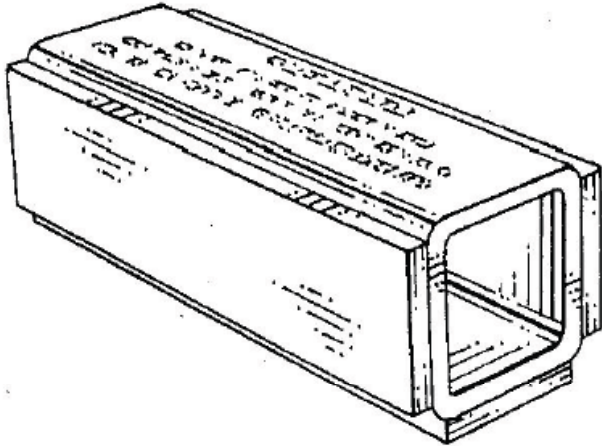
(More Than You Wanted to Know About the)
Development of Nail Buffers

- 1987 – Michael Falley designs original 4-way nail buffer
- 1998 – Nailco asks Falley to design 3-sided buffer. Nailco resells to EGI and also obtains design patent for 3-sided buffer.
- 2001 – Falley designs 4-sided buffer for Swisa – WITH pad on 4th side.
- 2001 – EGI obtains design patent for 4-sided buffer WITHOUT pad on the 4th side.



Point of Novelty?

Patented Design



Accused Design



VS.

Egyptian Goddess argued:

An open and hollow body +
A square cross-section +
Raised rectangular pads +
Exposed corners =

New point of novelty

Swisa argued:

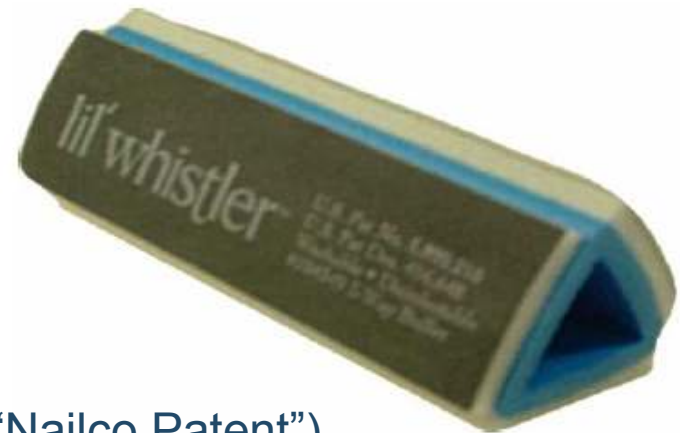
- Square fourth side without pad is the only point of novelty in the D '389 patent, and the Swisa buffer does NOT have such a side – we have a pad.

Closest Prior Art

According to EGI...



According to Swisa...



(“Nailco Patent”)

EGI – Procedural History

- District Court granted Swisa summary judgment:
 - “[The prior art] disclosed a nail buffer with an open and hollow body, raised rectangular pads, and open corners...EGI cannot claim the combination of those three elements in the D’389 patent as novel when they were already combined in the [prior art]. The only point of novelty in the D’389 patent over the [prior art] is the addition of the fourth side without a pad, thereby transforming the equilateral triangular cross-section into a square.”
 - “In the context of nail buffers, a fourth side without a pad is not substantially the same as a fourth side with a pad. Because the Swisa product does not include the point of novelty of the D’389 Patent -- a fourth side without a pad -- there is no infringement. Accordingly, the Court grants Swisa’s motion for summary judgment.”

Egyptian Goddess, Inc. v. Swisa, Inc., 2005 U.S. Dist. LEXIS 32931 (N.D. Tex. Dec. 14, 2005) (emphasis added)

EGI – Procedural History

- Egyptian Goddess appealed
 - Federal Circuit affirmed re. the pad/no pad distinction, and added:
 - EGI’s point of novelty is not only not novel due to the existence of prior art showing square cross-sections, but the *combination* of EGI’s points of novelty is not novel because they do not constitute a **non-trivial advance** over the prior art.
 - DISSENT – What are you guys talking about? Adding “non-trivial advance” to infringement analysis conflates infringement and validity. Patentee would have to prove validity (non-obvious) to prove infringement, when it’s the accused infringer’s burden to prove (in)validity.
 - *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354 (Fed. Cir. 2007).

EGI – Procedural History

- Federal Circuit agrees to rehear the case en banc – first time ever for a design patent infringement case.
 1. Should the “point of novelty” be a test for infringement of a design patent?
 2. If so:
 - a. should the court adopt the **non-trivial advance test** adopted by the panel majority in this case;
 - b. should the point of novelty test be part of the **patentee’s burden** on infringement or should it be an available **defense**;
 - c. should a design patentee, in defining a point of novelty, be permitted to divide closely related or, ornamentally integrated features of the patented design to **match features contained in an accused design**;
 - d. should it be permissible to find **more than one “point of novelty”** in a patented design; and
 - e. should the **overall appearance** of a design be permitted to be a point of novelty? See *Lawman Armor Corp. v. Winner Int’l, LLC*, 449 F. 3rd 1190 (Fed. Cir. 2006)
 3. Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? See *Elmer v. ICC Fabricating, Inc.*, 67 F. 3d 1571, 1577 (Fed. Cir. 1995)

EGI – The En Banc Rehearing

- Swisa wants to retain the point of novelty test – remember, the only point of novelty in the patented design is a “bare” fourth side, and the accused Swisa design has a pad on the fourth side.
- Egyptian Goddess, and many amici, argued that the point of novelty test is unworkable and unnecessary – the prior art is taken into consideration when performing the ordinary observer test.

EGI – The En Banc Rehearing

- “We conclude 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*, is not mandated by *Whitman Saddle* or precedent from other courts, and is not needed to protect against unduly broad assertions of design patent rights.”
- The ordinary observer test can and should include the observer “comparing the patented and accused designs in the context of similar designs found in the prior art.”

EGI – The En Banc Rehearing

- “When the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.”
- Prior art is still important to the analysis, but it is the *observer* who gets to weigh the importance of the prior art:
 - “If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing.”

EGI – The En Banc Rehearing

- Concerning the abuse of determining points of novelty and why the test should be abolished:
 - “the more novel the design, and the more points of novelty that are identified, the more opportunities there are for a defendant to argue that its design does not infringe because it does not copy all of the points of novelty, even though it may copy most of them and even though it may give the overall appearance of being identical to the claimed design.”
- By using this new modified ordinary observer test in which the ordinary observer has knowledge of the prior art, the results of the observer’s analysis should be “more in line with the purposes of design patent protection” (which is overall similarity and deception of consumers).

EGI – The En Banc Rehearing

- The court also cleared up whether a combination of features can serve as a point of novelty:
 - “If the claimed design consists of a combination of old features that creates an appearance deceptively similar to the accused design, even to an observer familiar with similar prior art designs, a finding of infringement would be justified.”

EGI – The En Banc Rehearing

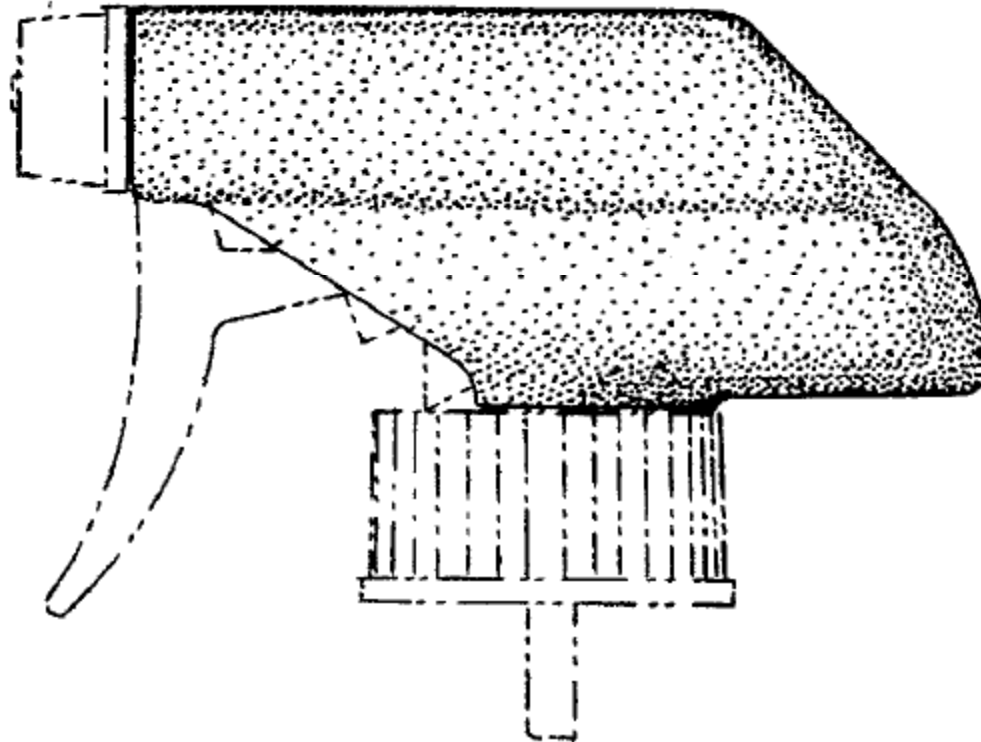
- Also important – the burden of proof of infringement remains with the patentee, but “if the accused infringer elects to rely on the comparison [of] prior art as part of its defense against the claim of infringement, **the burden of production of that prior art is on the accused infringer.**”

EGI – The En Banc Rehearing

- The court also addressed whether or not trial courts should conduct **claim construction** in design patent cases.
 - The drawings and figures should speak for themselves.
 - By attempting to verbalize or write down a detailed claim construction, trial courts can engage in the very thing that abolishing the point of novelty test seeks to correct, namely, assigning too much importance to elements of a design that the ordinary observer would not have focused on.
 - BUT – the trial courts are still encouraged to “guide the finder of fact” by examining the prosecution history and “distinguishing between those features of the claimed design that are ornamental and those that are purely functional.”

EGI – The En Banc Rehearing

- The trigger sprayer shroud design is as represented in the five drawings contained in the [581 Patent](#). It does not include the nozzle, trigger, or closure cap. Viewed from the side, the shroud has a horizontal top surface which ends in a perpendicular line at the frontmost portion and descends, approximately two-thirds of the way to the back of the shroud, in an obtuse angle into a downwardly sloping rear portion. The rear edge extends downward from the top portion at an approximately 135 degree angle, and then curves more vertically downward to intersect with the base of the shroud very slightly above the level of the closure cap. The bottom edge of the shroud extends horizontally backward from the nozzle for a short distance before it intersects with the shroud, a line extends horizontally forward from the base of the nozzle to the front edge of the shroud, and then bulges out in a desired extend vertically downward from the shroud, to the nozzle and back edges. The rear edge, the back edge, in be seen extending forward [**18] of shroud, of the rectangular top surface inward until a short distance before the nozzle.



Viewed from the front, the shroud has a curved and convex manner extending downward from the top edge, and intersects with the closure cap.

Viewed from above, the shroud has a rectangular top surface. Behind the rectangular top surface, the back surface slopes down to the rear portion, which widens significantly and curves more dramatically downward. The sides have approximately a 135 degree angle and curve more dramatically downward a short distance before the nozzle.

Viewed from below, the shroud has a rectangular top surface. The rear edge, the back edge, in be seen extending forward [**18] of shroud, of the rectangular top surface inward until a short distance before the nozzle.

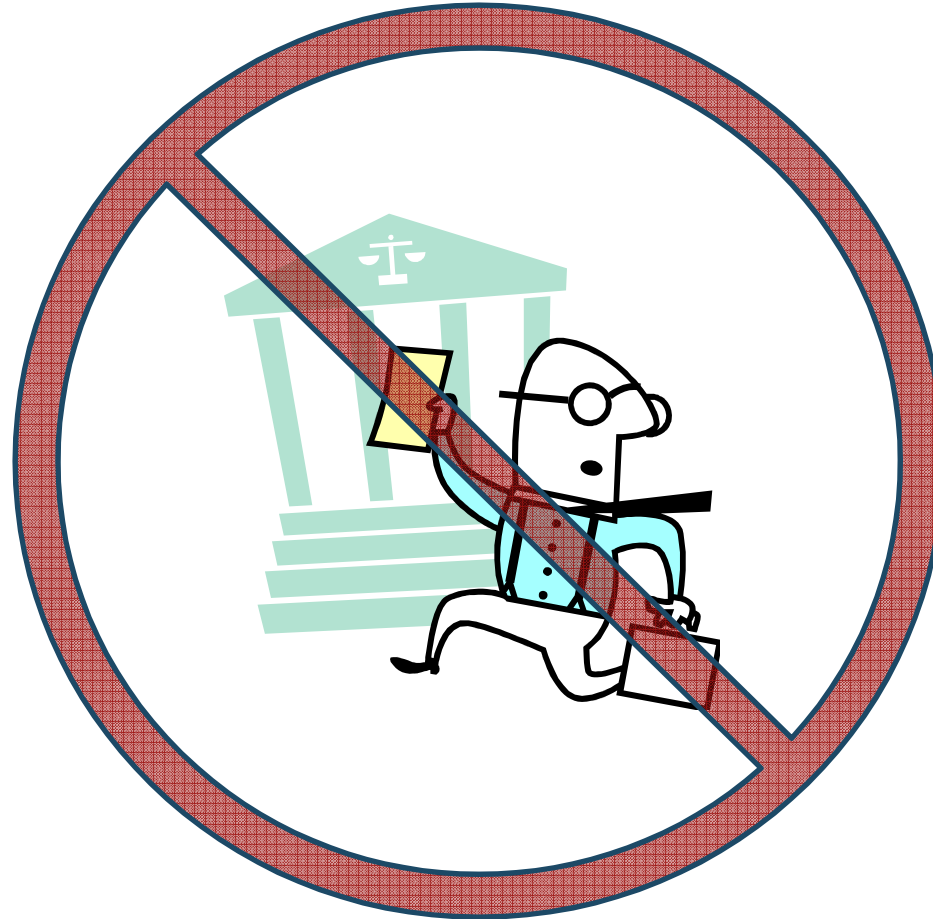
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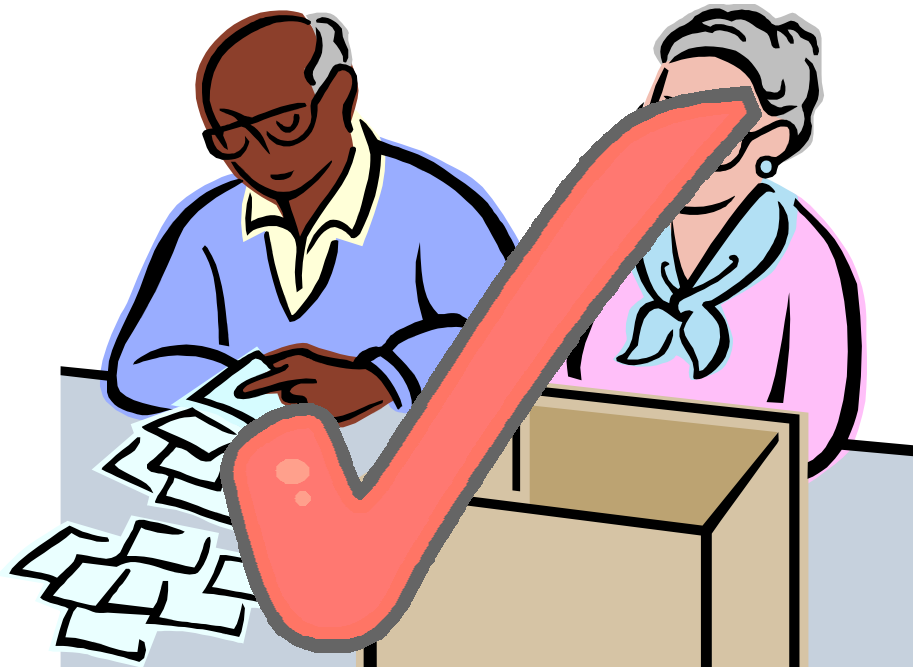
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Viewed from below, the shroud has a rectangular top surface. The rear edge, the back edge, in be seen extending forward [**18] of shroud, of the rectangular top surface inward until a short distance before the nozzle.

Nutshell?



Nutshell?



Post-Egyptian Goddess

Arc'Teryx Equip., Inc. v. Westcomb Outerwear, Inc., 2008 U.S. Dist. LEXIS 90228 (D. Utah Nov. 3, 2008)

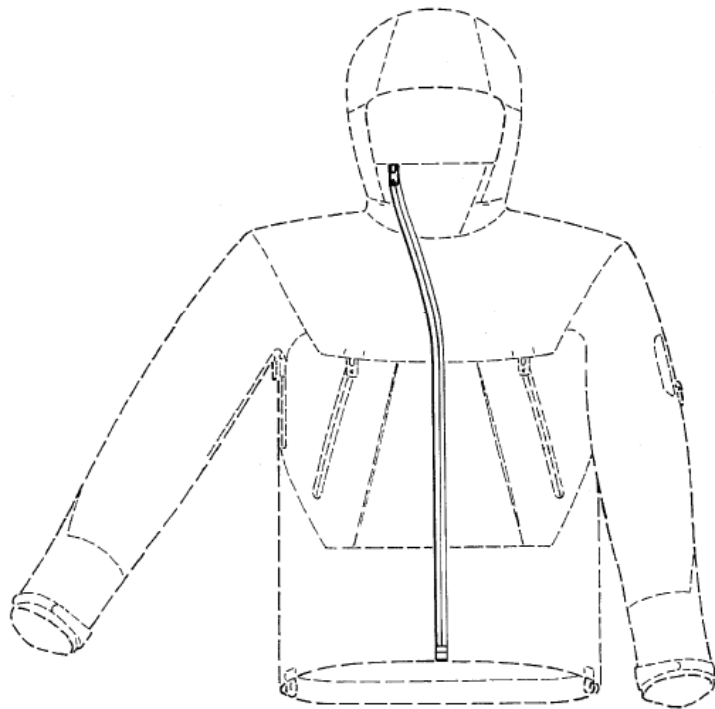


FIG. 1

Patented Design



Accused Design

Post-Egyptian Goddess

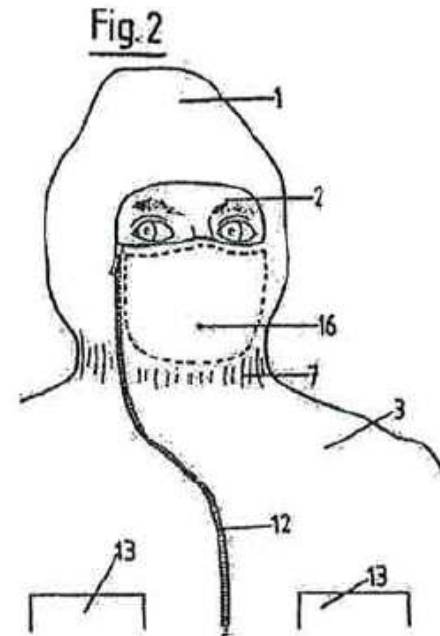
- “An ordinary observer of the Patent No. 513,715 (the “715 Patent”) would be left with the impression that the zipper contains **two sections**: a straight section which extends from the bottom of the zipper to the chest area and a diagonal section extending from [*7] the chest area to the collar. While it is true that the *Patent No. 513,715* (the “715 Patent”) contains a second straight section which begins and ends in the collar area, that second straight section is not immediately apparent to an ordinary observer.”
- “An ordinary observer of Defendant's product would be left with the impression that Defendant's zipper consists of **three sections**: a straight section which extends from the bottom of the zipper to the stomach area, a short diagonal section in the stomach area, and a second straight section extending from the stomach area to the top of the collar.”

Post-Egyptian Goddess

Prior Art



Low Alpine Black Ice Jacket



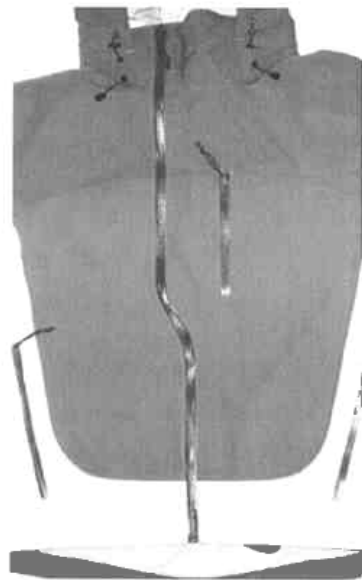
DE '356 Patent

Post-*Egyptian Goddess*

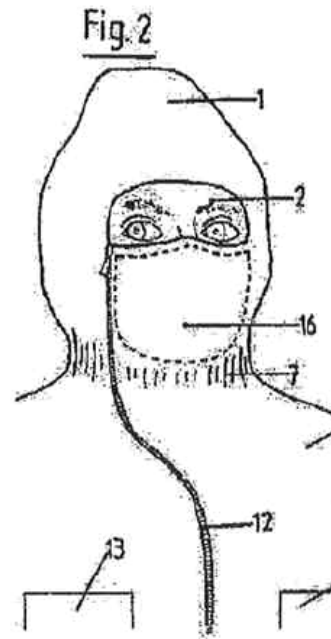
- The parties agree that the prior art in this case consists of German patent DE 40 18 356 (DE 356 Patent) and Lowe Alpine's Black Ice Jacket.
- The DE 356 Patent discloses a long straight section which begins in the middle of a jumpsuit and continues to the upper chest area before it curves into a short diagonal section. The diagonal section curves back into a straight section to the end of the zipper.
- The Lowe Alpine Black Ice Jacket has a long straight section which makes up most of the jacket before it curves into a short diagonal section which begins at the bottom of the collar and ends at the top of the collar.

Post-Egyptian Goddess

Accused design compared to patented design in view of the prior art:



Westcomb Design



Prior Art - DE '365

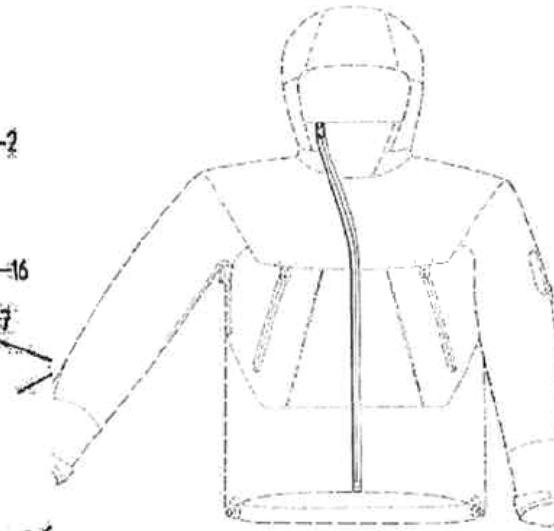


FIG. 1
715 Patent Design

Post-Egyptian Goddess

- The *Patent No. 513,715* (the "715 Patent") is much closer to the Lowe Alpine Black Ice Jacket in that they both contain one straight and one diagonal section.
- Defendant's Mirage Jacket, on the other hand, is similar to the DE 356 Patent in that both designs contain a straight section, curving into a diagonal section, which curves into a second straight section.
- The Court finds, based on the differences set forth above, that no reasonable jury could find that an ordinary observer, familiar with the prior art, would be deceived into confusing the design of Defendant's Mirage Jacket with the *Patent No. 513,715* (the "715 Patent").

Post-Egyptian Goddess

Arc'Teryx Equip., Inc. v. Westcomb Outerwear, Inc., 2008 U.S. Dist. LEXIS 90228 (D. Utah Nov. 3, 2008)

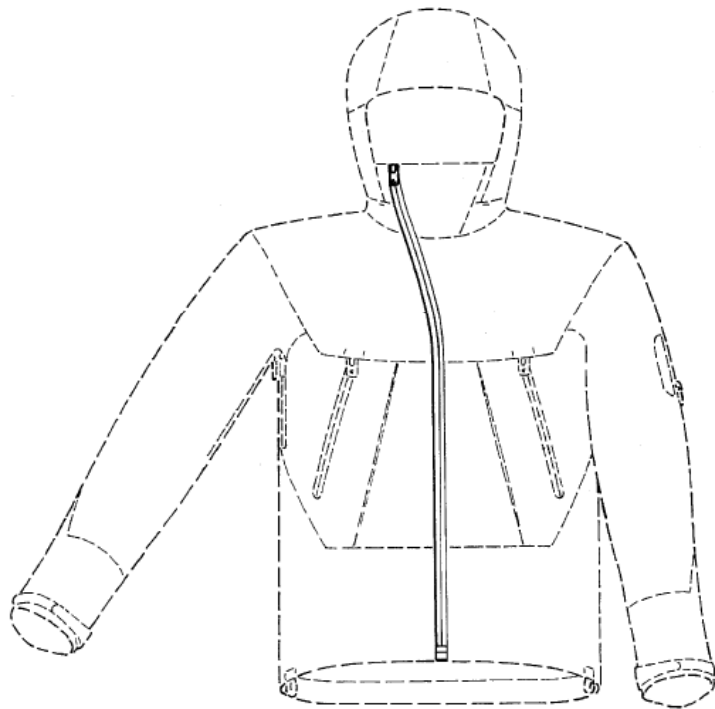


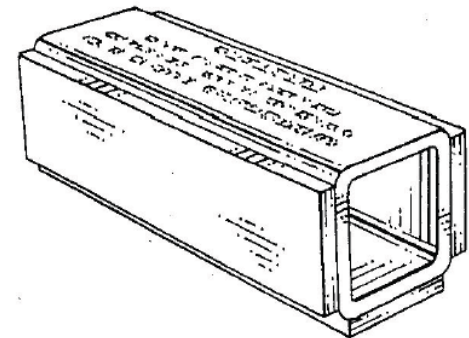
FIG. 1

Patented Design



Accused Design

Would the District of Utah's Analysis Have Worked in *EGI*?



The Three-Way Test

- Why are we concerned with the three-way test when the court articulated the familiar ordinary observer?
- “Nothing about Ms. Eaton’s declaration explains why an ordinary observer would regard the accused design as being closer to the claimed design than to the Nailco prior art patent.”

The Three-Way Test

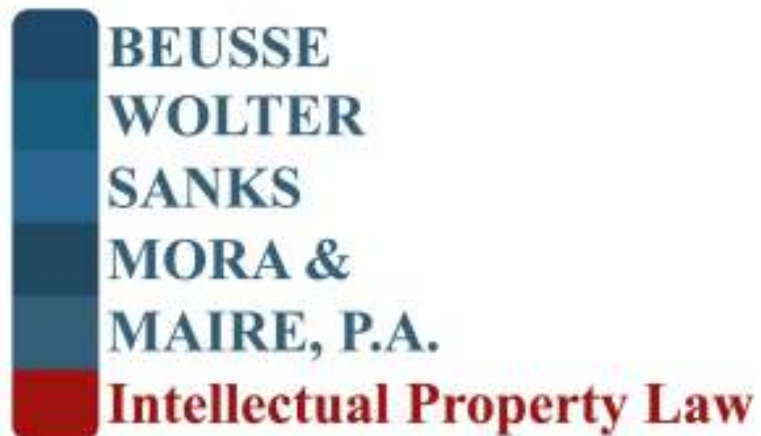
- Does the three-way test run afoul of *Hartco Engg, Inc. v. Wang's Int'l, Inc.*, 142 Fed. Appx. 455, 458 (Fed. Cir. 2005)?
- How? By granting protection to the *concept* of a design patent versus the specific ornamental aspects of the patented design.

The Three-Way Test

- “...only these ornamental aspects of Hartco’s patented hitchcover design, not the broader, general hitchcover concept that merely mimics a propeller, are protected...Therefore, Hartco’s design patent does *not* cover any hitchcover shaped as a propeller with any number of blades, regardless of its ornamental features.”
 - *Hartco Engg, Inc. v. Wang's Int'l, Inc.*, 142 Fed. Appx. 455, 458 (Fed. Cir. 2005)

Final Thought

- Will this influence the way you draft design patents?
- Is it better to claim a smaller portion of your design as a way to 1) force the ordinary observer to focus on what you want them to see, and 2) prevent more visible non-novel features from spoiling the ordinary observer's impression?



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