



Klarquist Sparkman, LLP

# Design Patent Infringement After *Egyptian Goddess*

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Klarquist Sparkman, LLP  
March 3, 2010

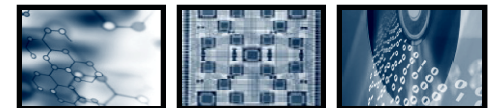
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# Design Patent Requirements

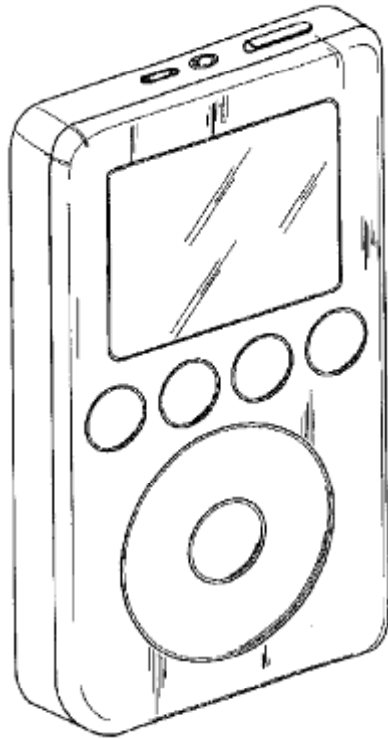
- Design patents protect the appearance of a product, while a utility patent protects the way a product functions, is made, or is used.
- “Whoever invents any **new, original** and **ornamental** design for an **article of manufacture** may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 171.



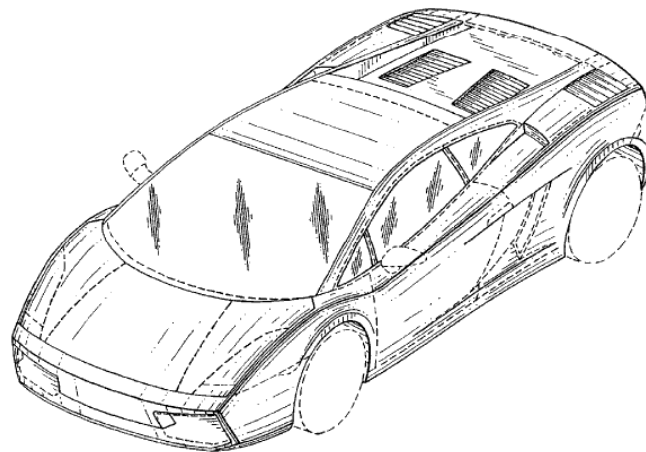


# Examples

Electronics



Automotive



Sporting equipment

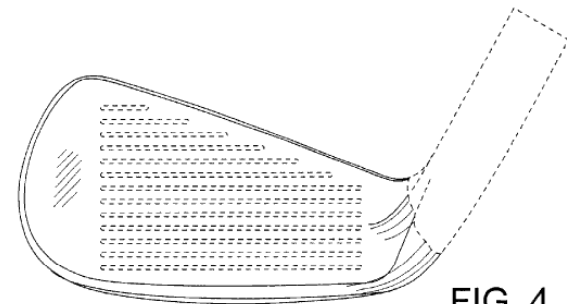
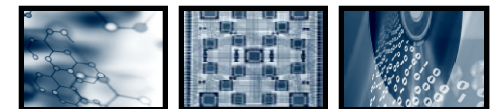


FIG. 4



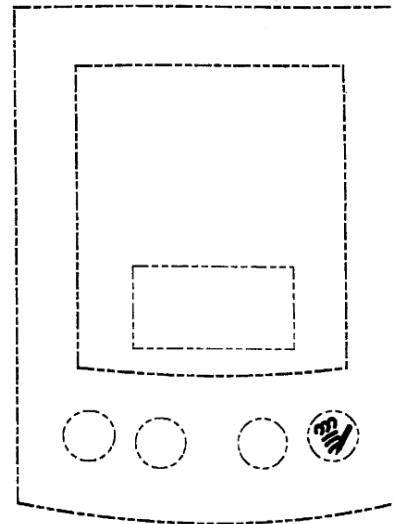


# Examples – less obvious

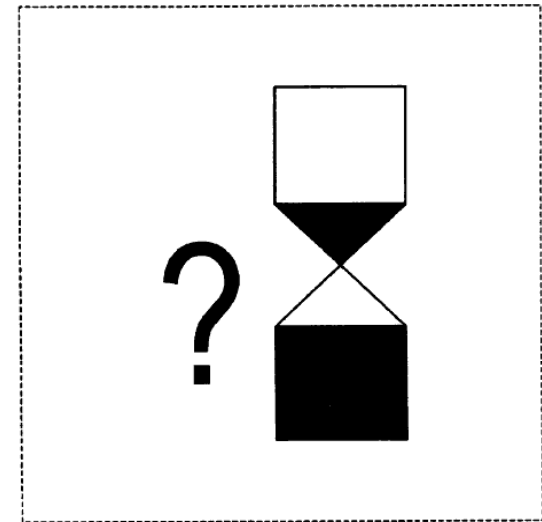
## Web pages



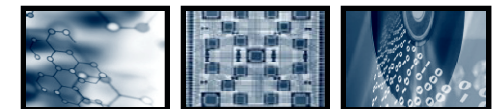
## Icon (surface ornamentation on a button)



## Icon for a computer screen



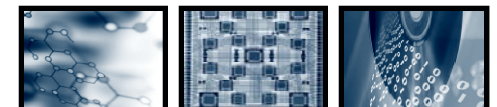
**Copyright added**





# Infringement Analysis- Historical Perspective

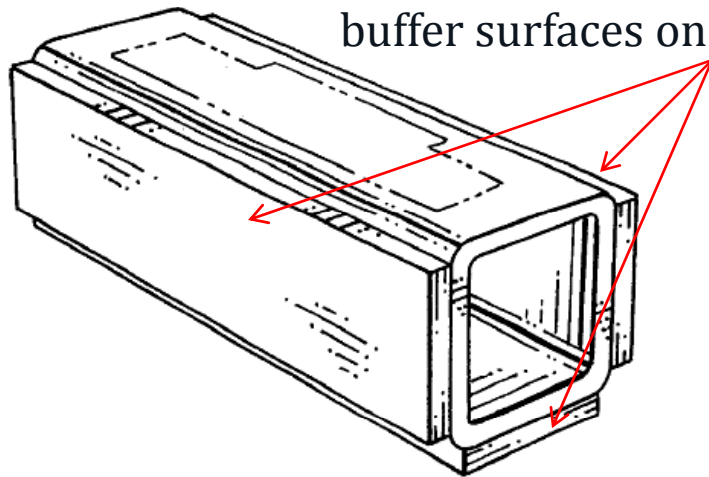
- In 1871 the Supreme Court articulated the “**ordinary observer**” test of infringement. *Gorham Co. v. White* 81 US 511, 528 (1871).
  - That test required that “if, in the eye of an **ordinary observer**, giving such attention as a purchaser usually gives, two designs are substantially the same, if 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.”
- Shortly, after its formation, the Federal Circuit introduced a second test called the “**point-of-novelty**” test. *Litton Systems v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984).
  - That test required that: “For a design patent to be infringed . . . 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.**” 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.



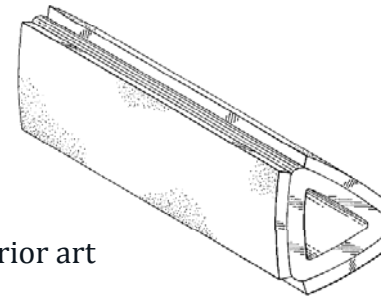


# Infringement Analysis- Egyptian Goddess, Inc. v. Swisa, Inc. – Sept. 2008

4 sided tubular frame, with  
buffer surfaces on 3 sides



D467,389  
(patent in suit)

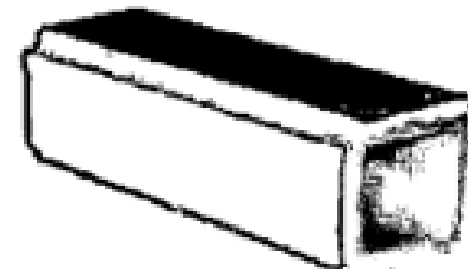


Prior art

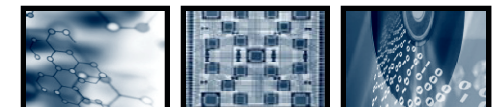


Prior art

Falley Buffer Block

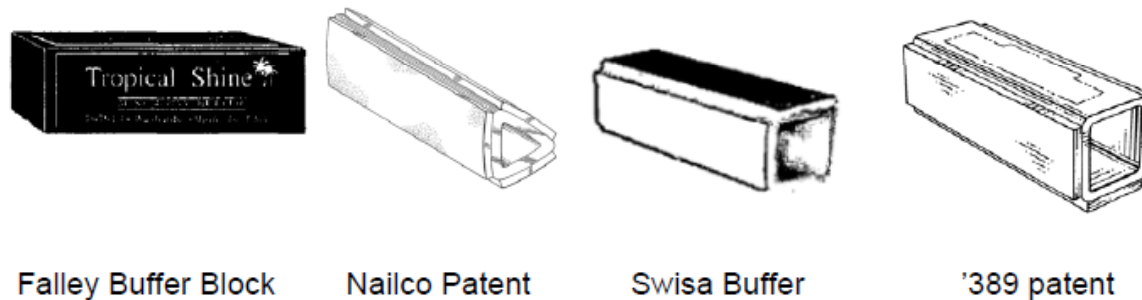


Swisa's accused nail buffer has 4  
sided tubular frame, with buffer  
surfaces on all 4 sides



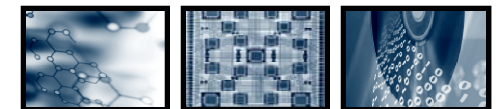


# Infringement Analysis- Egyptian Goddess Case – Sept. 2008



Fed. Cir. held that the point-of-novelty test is inconsistent with the ordinary observer test

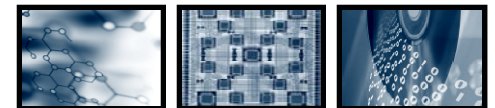
- “The attention of the court may be focused on whether the accused design has appropriated a single specified feature of the claimed design, rather than on the proper inquiry, *i.e.*, whether the accused design has appropriated the claimed design as a whole.”





# Infringement Analysis- Egyptian Goddess Case – Sept. 2008

- **Ordinary observer is the sole test for infringement; however, the ordinary observer should take into account the prior art:**
  - The comparison of the claimed design and accused design, “including the examination of any novel features, must be conducted as part of the ordinary observer test, not part of a separate test focusing on particular points of novelty that are designated only in the course of litigation.”
  - “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. At the same time, unlike the point of novelty test, the ordinary observer test does not present the risk of assigning exaggerated importance to small differences between the accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty.”
  - Note on claim construction: “Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for the district court not to attempt to “construe” a design patent claim by providing a detailed verbal description of the claimed design.”





# Infringement Analysis- Egyptian Goddess Case – Sept. 2008



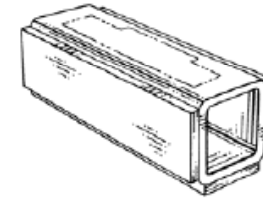
Falley Buffer Block



Nailco Patent



Swisa Buffer

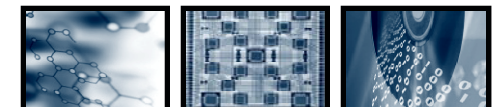


'389 patent

## Result:

**A buffer with pads on all four sides does not infringe a design for a buffer with pads on only three sides:**

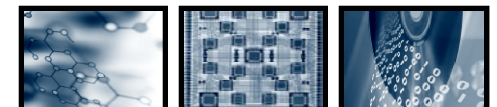
“The accused design could not reasonably be viewed as so similar to the claimed design that a purchaser *familiar with the prior art* would be deceived by the similarity between the claimed and accused designs inducing him to purchase one supposing it to be the other.”





## Subsequent Case Law

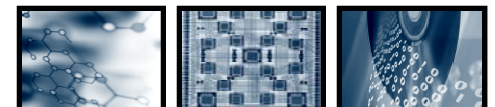
- *Arc'Teryx Equip., Inc. v. Westcomb Outerwear, Inc.*: The District Court for the District of Utah applied the ordinary observer test from the viewpoint of an outdoor clothing customer who is “more discerning” than an average consumer. Under this analysis, the court found that the accused device did not infringe.
- *Mondo Polymers Techs., Inc. v. Monroeville Indus. Moldings, Inc.*: The District Court for the Southern District of Ohio declined to provide a detailed verbal claim construction, and instead simply refers to the drawings of the patent for its claim construction.
- *Dexas International, Ltd. v. Office Max Inc.*: The District Court of the Eastern District of Texas adopts following claim construction for one patent at issue: “A clipboard adapted to hold documents of a certain design, as shown in Figures 1-7.”





## Effect of Egyptian Goddess

- District courts not applying detailed claim construction identifying any points of novelty.
- Competitors may find it more difficult to design around a design patent by avoiding one or more minor points of novelty.
- Practitioners may find it more difficult to advise clients on design patent infringement.

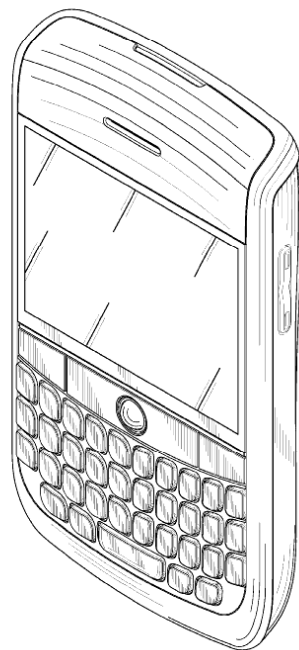




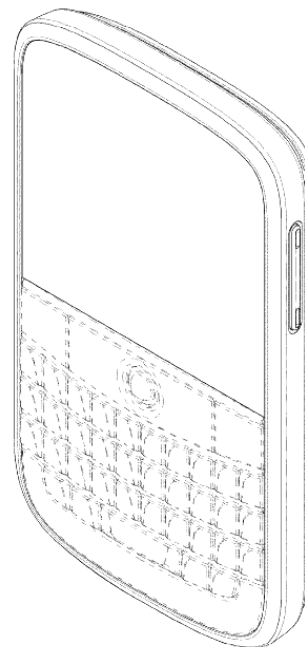
## Discussion Issue #1

### What is effect of broken lines?

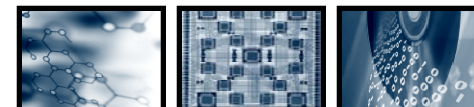
- Broken lines used to show environment or portions of the design that are not intended to be claimed.



D603,404



D603,401

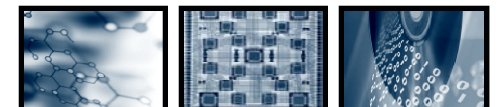
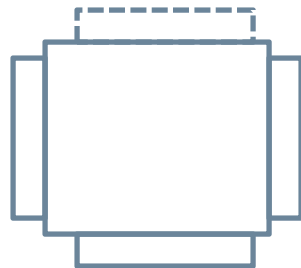




## Discussion Issue #1

### What is effect of broken lines?

- If a buffer with four pads does not infringe a claim for a buffer with three pads, what if Egyptian Goddess also asserted a related design patent for a buffer with three pads and an optional fourth pad:



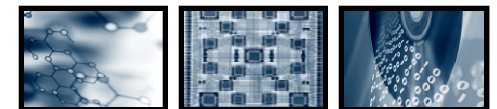


## Discussion Issue #2

# Doctrine of Equivalents?

Does the Doctrine of Equivalents apply to design patents?

- *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.* (Fed. Cir. 1995):  
The doctrine of equivalents applies to design patent cases “only when the accused product includes features equivalent to the novel claimed design features.” “A patentee cannot invoke the doctrine to evade the scrutiny of the point of novelty test, because to do so would eviscerate the purpose of the point of novelty approach.”
- *Egyptian Goddess*: Under the ordinary observer test, “infringement will not be found unless the accused article ‘embod[ies] the patented design or any colorable imitation thereof.’”





# QUESTIONS?

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