Looks Matter...

Legally. ®
U.S. Design Patent Infringement

Stanford Program in Law, Science & Technology

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Egyptian Goddess v. Swisa
543 F.3d 665 (Fed. Cir. 2008)
HELD: [T]he point of novelty test should no longer be used in the analysis of a claim of design patent infringement.

[T]he “ordinary observer” test should be the sole test for determining whether a design patent has been infringed.
ORDINARY OBSERVER TEST:

...if, in the eye of an ordinary observer... two designs are *substantially the same*...[then] the ... one patented is infringed by the other.
Gorham v. White
(U.S. Supreme Court, 1871)

White, 1867 accused design

Gorham Co.’s patented design

White, 1868 accused design
**NEW LAW:** The ordinary observer is deemed to view the differences between the patented design and the accused product *in the context of the prior art.*
GUIDELINE #1:

1. When the claimed design is close to the prior art designs, small differences ... are likely to be important to the eye of the ... ordinary observer.
GUIDELINE #2:

2. If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is more likely to be regarded as infringing.
GUIDELINE #3:

3. 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.
Egyptian Goddess v. Swisa
(en banc Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #4:

4. In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the two designs do not look “substantially the same” to the ordinary observer.
Egyptian Goddess v. Swisa
(en banc Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #5:

5. [W]hen the claimed and accused designs are not plainly dissimilar, resolution of the question…will benefit from a comparison of the claimed and accused designs with the prior art.
GUIDELINE #6:

6. Where there are many examples of similar prior art designs … differences … that might not be noticeable … can become significant to the … ordinary observer who is conversant with the prior art.
GUIDELINE #7:

7. An ordinary observer, comparing the claimed and accused designs in light of the prior art, will attach importance to differences between the claimed design and the prior art depending on the overall effect of those differences on the design.
The 3-Way Visual Test
(Saidman formulation)

1. If claimed or accused design is closer to prior art than to each other = no likely infringement.

2. If claimed and accused designs are closer to each other than to prior art = infringement is more likely.
Egyptian Goddess v. Swisa
(en banc Fed. Cir. 2006-1562, Sept. 22, 2008)

PRIOR ART IS A FACTOR TO BE CONSIDERED IN 6 OUT OF 7 EGYPTIAN GODDESS GUIDELINES:

1…. close to the prior art designs …
2…. departs conspicuously from the prior art..
3…. familiar with similar prior art designs …
4.------
5…. comparison of the claimed and accused designs with the prior art …
6…. Where there are many examples of similar prior art designs …
7…. differences between the claimed design and the prior art …
PRIOR ART IS NOT CONSIDERED IN ONE OF THE EGYPTIAN GODDESS GUIDELINES:

1. close to the prior art designs …
2. departs conspicuously from the prior art …
3. familiar with similar prior art designs …
4. SUFFICIENTLY DISTINCT …
5. comparison of the claimed and accused designs with the prior art …
6. Where there are many examples of similar prior art designs …
7. differences between the claimed design and the prior art …
Minka Lighting v. Maxim Lighting
(N.D. Tex. March 16, 2009)

COURT: [In EG] the Federal Circuit has effectively divided cases into two categories:

1. In some instances, the claimed and accused designs will be sufficiently distinct that it will be clear without more that there’s no infringement (ed. note: no need to look at the prior art!).
COURT: [In EG] the Federal Circuit has effectively divided cases into two categories:

1. In some instances, the claimed and accused designs will be *sufficiently distinct* that it will be clear without more that there’s no infringement *(ed. note: no need to look at the prior art!).*

2. In other instances, when the claimed and accused designs are *not plainly dissimilar*, resolution of infringement will benefit from having a look at the prior art *(court emphasis).*
Post-Egyptian STATS

NUMBER OF DESIGN PATENTS WHERE INFRINGEMENT WAS CONSIDERED

42
Post-Egyptian STATS

NUMBER OF DESIGN PATENTS WHERE INFRINGEMENT WAS CONSIDERED 42

A. NO DETERMINATION 15
Post-Egyptian STATS

NUMBER OF DESIGN PATENTS WHERE INFRINGEMENT WAS CONSIDERED

A. NO DETERMINATION 15
B. NUMBER FOUND NOT INFRINGED 25
Post-Egyptian STATS

NUMBER OF DESIGN PATENTS WHERE INFRINGEMENT WAS CONSIDERED  42
A.  NO DETERMINATION  15
B.  NUMBER FOUND NOT INFRINGED  25
C.  NUMBER FOUND INFRINGED
Post-Egyptian STATS

NUMBER OF DESIGN PATENTS WHERE INFRINGEMENT WAS CONSIDERED 42
A. NO DETERMINATION 15
B. NUMBER FOUND NOT INFRINGED 25
C. NUMBER FOUND INFRINGED 2
Post-Egyptian STATS

why?
Post-Egyptian STATS

III. NUMBER OF DESIGN PATENTS WHERE INFRINGEMENT WAS CONSIDERED

TOTAL OF ALL CASES:

Prior art NOT considered,
  i.e., “sufficiently distinct”
THE PRIOR ART HAS DISAPPEARED IN 2/3 OF THE CASES!
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Post-Egyptian Decisions
1. sufficiently distinct ... 

... it’s clear without more that there’s no infringement ...
COURT:

The patented and accused designs are sufficiently distinct, thus no need to look at the prior art….
Let’s have a look at the prior art anyway…
Minka Lighting v. Maxim Lighting
(N.D. Tex. March 16, 2009)

Patented Design

Accused Design

Prior Art
2. **not plainly dissimilar**

... resolution of infringement will benefit from having a look at the prior art ...
Fanimation, Inc. v. Dan’s Fan City, Inc.
(S.D. Ind., Dec. 16, 2010)

Patented Design

Accused Design

Prior Art
COURT: ...the prior art appears to employ a blade shape far more similar to the patented design than the accused product... and the prior art also shows the overlapping fan blades as in the patented design...
Kimber Cakeware v. Bradshaw Int’l
(N.D.Ohio, filed March 1, 2013)
THE PRIOR ART HAS DISAPPEARED IN 2/3 OF THE CASES!
1. *sufficiently distinct* ...  

... it’s clear without more that there’s no infringement ...
District Court: Because this is not a particularly close case, the court does not need prior art as a “frame of reference” to apply the “ordinary observer test”. PI denied.
D. Ct.: First, the shape of the lenses ... are different ... a [patented] lens could not fit into the [accused] goggles.
Second, the bridge of the [patented] goggles is concave … crowned by six vents … with a stylized “R” … In contrast, the bridge of the [accused] goggles protrudes outward, has no vents, and displays the Balboa “B” logo.
Third, the [patented] goggles have hexagonal vents located in two staggered rows. In contrast, the venting on the [accused] goggles is circular, occupies two to three rows, and dips at the bridge.
Revision Military v. Balboa Mfg.
(D.Vt. Aug. 31, 2011)

Patented Designs

Accused Design

Sufficiently distinct?
Let’s have a look at the prior art anyway…
Revision Military v. Balboa Mfg.  
(D.Vt. Aug. 31, 2011)

Patented Designs

Accused “Bravo” Design

Prior Art
Revision Military v. Balboa Mfg.
(Fed. Cir., Nov. 27, 2012)

FED CIR: Although individual features may indeed serve in assessing the impact on the overall appearance... it is often helpful to refer to prior art familiar to an ordinary observer.
Revision Military v. Balboa Mfg.  
(Fed. Cir., Nov. 27, 2012)  

Patented Designs  
Accused “Bravo” Design  
Prior Art  

FED. CIT. The district court did not consider the prior art ... Although the court stated that this was not a particularly close case, the record suggests otherwise. On remand, the court may re-determine the question, applying the design-as-a-whole standard....
2. *not plainly dissimilar*...

... resolution of infringement will benefit from having a look at the prior art ...
The court finds that the Nebelli bench end frame is not plainly dissimilar to that depicted in the patent.

The Nebelli design so nearly resembles that of the patent that an ordinary observer, familiar with prior art designs, would be unable to easily distinguish them in a side-by-side comparison without unusually careful effort. Infringement found.
1. sufficiently distinct ... 

... it’s clear without more that there’s no infringement ...
[T]he Court finds that the Necati bench end frame design is not substantially the same as that depicted in the Patent.
Even though the design of the Necati bench is, in part, based on the Nebelli (infringing) design, there are obviously distinguishing features. No infringement.

Let’s have a look at the prior art anyway…
The Court finds that an ordinary purchaser of benches, using a reasonable degree of care, would distinguish between the Necati and the Patent product without much effort. No infringement.
2. *not plainly dissimilar...*

... resolution of infringement will benefit from having a look at the prior art ...
Arc’Teryx Equip. v. WestcombOuterwear
(D. Utah Nov. 4, 2008)
Court: “The 715 patent is *much closer to* the Lowe Alpine jacket … they both contain one straight and one diagonal section. The accused design *is similar to* the DE356 patent in that both contain a straight section, curving into a diagonal section, which curves into a 2\(^{nd}\) straight section.”
1. sufficiently distinct ...

... it’s clear without more that there’s no infringement ...
COURT: Patented design is limited to a surface with three different slopes and a depressed center ring. Accused design has only one change in concavity, and no center ring. Defendant’s MSJ of non-infringement granted.
Chef’n Corp. v. Trudeau Corp.
(W.D.Wash., 2009)

Let’s have a look at the prior art anyway…
Chef’n Corp. v. Trudeau Corp.
(W.D. Wash., 2009)
2. not plainly dissimilar...

... resolution of infringement will benefit from having a look at the prior art ...
Wing Shing v. Sunbeam
(S.D.N.Y., Oct. 3, 2009)
Wing Shing v. Sunbeam
(S.D.N.Y., Oct. 3, 2009)

COURT: ... [I]n the “cluttered world of drip coffeemakers, it seems senseless to attempt to determine whether the ordinary observer would confuse two designs without looking to the prior art for a point of reference.”
Wing Shing v. Sunbeam
(S.D.N.Y., Oct. 3, 2009)

COURT: The rounded “bullnose” base is the most prominent difference. In contrast, the prior art has an angular base with a trapezoidal cross-section. The accused design and the patented design differ at the very feature that distinguishes the patented design from the prior art: NO INF.
1. sufficiently distinct ...

... it's clear without more that there's no infringement ...
"A side-by-side comparison shows that the two designs, taken as a whole, create overall visual impressions that would appear plainly dissimilar to the ordinary observer."

MSJ of non-infringement granted.
Competitive Edge, Inc. v. Staples, Inc.
(N.D. Ill., March 29, 2010)

The Court did not mention the similarity of the claimed rear view

Patented Design

Accused Design
“When the patented and accused design are plainly dissimilar, as in this case, there is no need to look to the prior art...“
Let’s have a look at the prior art anyway…
Competitive Edge, Inc. v. Staples, Inc.
(N.D. Ill., March 29, 2010)
1. sufficiently distinct ... 

... it's clear without more that there's no infringement ...
Great Neck Saw Mfg., Inc. v. Star Asia U.S.A., LLC
(W.D. Wash, 2010)

7 Design Patents!

Accused Design
COURT: The Court concludes that the TITAN product is sufficiently distinct from at least four of the seven design patents, namely those involving a segmented u-shaped clip, to render unnecessary, as to those designs, any examination of prior art.

Defendant’s MSJ of non-infringement granted.
Great Neck Saw Mfg., Inc. v. Star Asia U.S.A., LLC  
(W.D. Wash, July 23, 2010)

Let’s have a look at the prior art anyway…
Great Neck Saw Mfg., Inc. v. Star Asia U.S.A., LLC
(W.D. Wash, July 23, 2010)

Accused Design

Patented Designs
D510,250
D526,877
D543,822

Prior Art
Perry Saidman is a recognized pioneer in design law. His boutique firm specializes in obtaining and enforcing US design patents, copyrights in the visual arts, and trade dress for three dimensional product designs. He has been engaged by other litigators as a consultant and expert in dozens of design infringement actions, and has also developed an extensive network of design law experts in various countries throughout the world.

At the beginning of his career in design law, Perry handled the seminal design patent infringement case of Avia Group Int’l, Inc. v. LA Gear California, Inc., 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988). More recently, he authored an Amicus Curiae brief on behalf of Apple Inc. in Egyptian Goddess v. Swisa, 543 F.3d 665 (Fed. Cir. 2008) - Apple’s brief was the only amicus brief cited by the Court in its ground-breaking en banc decision.

Perry has a master’s degree in electrical engineering from the University of Pennsylvania and received his law degree (with honors) from the George Washington University’s Law School where he has taught Design Law as an adjunct professor. He was the founder and first chair of the Industrial Designs Committee of the American Intellectual Property Law Association (AIPLA) and the Design Protection Committee of the Industrial Designers Society of America (IDSA). He is very active on the Design Rights Committee of the Intellectual Property Owners Association (IPO), where he has served as vice-chair, as well as on the Design Rights Subcommittee of the Related Rights Committee of INTA serving on the Planning Committee of the 2012 International Design Conference in Copenhagen. He speaks frequently to various bar groups and designer organizations, both domestically and internationally. He has testified before the U.S. Congress on the so-called “Crash Parts” bill. He has authored many articles on design law, most recently “Design Patents Sunk in International Seaway” (83 PTC 278) as well as other Amicus briefs before the Federal Circuit and Supreme Court in design patent cases (Minka Lighting, PHG, and Arminak) that involve core design patent issues such as obviousness and functionality.
Looks Matter... Legally. ®