

ASPEN PUBLISHERS

MAY/JUNE 2010
VOLUME 16 NUMBER 3

DEVOTED TO
INTELLECTUAL
PROPERTY
LITIGATION &
ENFORCEMENT

*Edited by the Law Firm of
Grimes & Battersby*

Litigator



Wolters Kluwer
Law & Business

The New Test for Design Patent Infringement Is Resulting in Summary Judgment Rulings

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Following the Federal Circuit's *en banc* ruling in *Egyptian Goddess, Inc. v. Swisa, Inc.*,¹ several commentators and practitioners predicted an easier road for design patent holders to prove infringement. Indeed, many believed that the Federal Circuit's elimination of the point of novelty test would streamline the test for design patent infringement favoring the patentee. However, the spate of summary judgment of non-infringement rulings since *Egyptian Goddess* may suggest otherwise. The district courts' rulings suggest that the scope of design patents is narrow, particularly when there is close prior art. And, these rulings suggest that there are no easy victories for design patent holders, even under the new test.

However, in February, 2010, the Federal Circuit, in *Crocs, Inc. v. Int'l Trade Comm.*,² reversed the US International Trade Commission's (ITC) grant of summary judgment of noninfringement (for the popular Crocs shoes) and instead found that the design patent was infringed.³ The Court focused on the patented design "as a whole" and reversed the ITC's ruling finding that it improperly focused on "minor differences between the patented design and the accused products to prevent a finding of infringement."

Analysis

Egyptian Goddess' Emphasis on Prior Art

In *Egyptian Goddess*, the Federal Circuit rejected the two-pronged test for design patent infringement: (1) the "ordinary observer" test set down in *Gorham v. White*,⁴

which required proof that the patented design and the accused design would appear substantially similar to "the eye of the ordinary observer" and (2) the point of novelty test, which required plaintiffs also to prove that the accused design appropriated the patented design's "points of novelty"—the innovative features that distinguished it from the prior art.⁵

While this initially appeared to be a significant change to the test for design patent infringement, a closer reading of *Egyptian Goddess* revealed that the essence of the point of novelty test, with its focus on the degree to which the patented design departs from the prior art, was incorporated into the ordinary observer test. The Court noted that "the perspective of the ordinary observer [must] be informed by a comparison of the patented design and the accused design in light of the prior art, so as to enable the fact-finder to determine whether the accused design had appropriated the inventiveness of the patented design."⁶ Now, the test for design patent infringement consists of a single inquiry: "whether an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design."⁷

The Federal Circuit further emphasized the importance of prior art such that when the patent and the prior art are particularly close, the scale of comparison between the accused and patented designs shrinks.⁸ That is,

[w]hen the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And 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....⁹

The Federal Circuit further explained that consideration of prior art is not required in every case, but only when the accused and claimed designs appear "substantially the same" in the first instance. As it stated,

In 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 the ordinary observer.... 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....¹⁰

Crocs’ Emphasis on Overall Impression or Effect

Applying the *Egyptian Goddess* test, the Federal Circuit reversed the district’s finding of no infringement and faulted the district court for its “concentration on small differences in isolation[, which] distracted from the overall impression of the claimed ornamental features.” The Court also found error in the district court’s detailed written claim construction, which included features that were not found in the patent.

Instead, the Court emphasized the importance of side-by-side comparisons of the patent drawings and accused products. In its own analysis of the infringement issue, which included a side-by-side comparison (see Exhibit 1), the Federal Circuit held that “an ordinary observer, familiar with the prior art designs, would be deceived into believing the accused products are the same as the patented design” and thus “the overall effects of the design[s]...are the same.” Despite referencing prior art designs, the Court’s analysis did not include a discussion of the similarity of the prior art to the patented design.

In looking at the “overall effect of the designs,” the Court identified “the interaction between the strap assembly portion and the base portion of the shoes where the strap is attached to the base.” The Court found this was a

“focal point” attracting the eye of the ordinary observer. The Court also identified the “visual theme” as “rounded curves and ellipses.” The Court held that “both the claimed design and the accused designs have these overall effects.” Indeed, the Court said “if the claimed design and the accused designs were arrayed in matching colors and mixed up randomly, this Court is not confident that an ordinary observer could properly restore them to their original order without very careful and prolonged effort.”¹¹

Summary Judgment Rulings Following *Egyptian Goddess* Emphasize Prior Art

After the Federal Circuit affirmed the District Court’s grant of summary judgment of noninfringement in *Egyptian Goddess*, but before the Federal Circuit’s ruling in *Crocs*, eight district courts granted summary judgment of noninfringement under the new *Egyptian Goddess* test.¹² Conversely, two district courts have denied defendant’s motions for summary of noninfringement.¹³

It is interesting to consider whether the Federal Circuit’s reversal in *Crocs* and directive to look at the design as a whole and the overall impression or effect would have changed the outcome in these cases discussed below. Notably, in several of the district court rulings, prior art played a key role in the finding of no infringement.

In *Arc’Teryx Equipment, Inc. v. Westcomb Outerwear, Inc.*,¹⁴ involving a zipper design for a jacket, the court found that the accused design was not substantially similar to the patented design in light of the prior art. (See Exhibit 2.)

The Court stated:

The 715 Patent is much closer to the [prior art jacket] in that they both contain one straight and one diagonal section. Defendant’s Mirage Jacket,

Exhibit 1

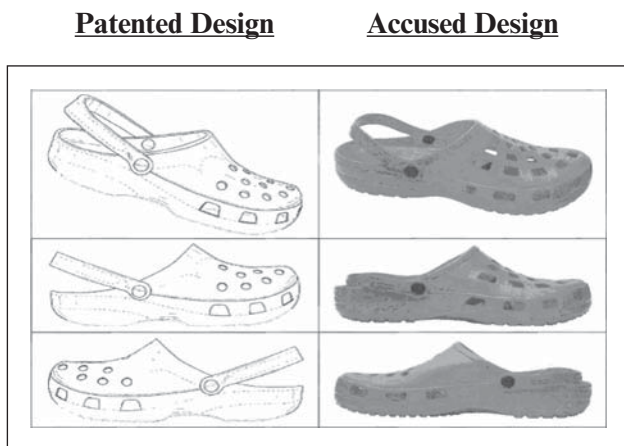
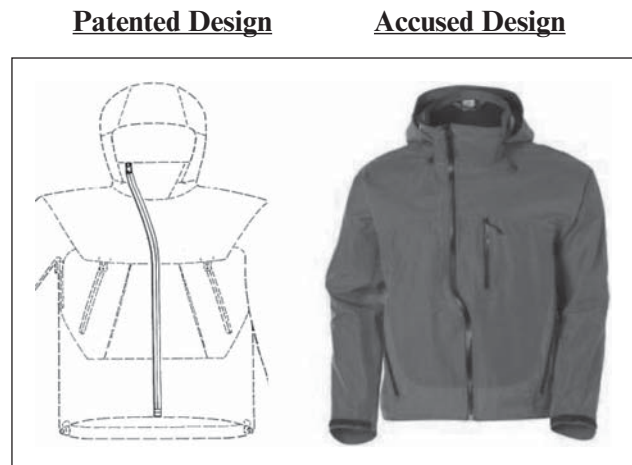


Exhibit 2



on the other hand, is similar to the DE 356 [prior art] Patent in that both designs contain a straight section, curving into a diagonal section, which curves into a second straight section.

The court found no reasonable jury could find an ordinary observer familiar with the prior art would be deceived into confusing the patented design with the design of the accused jacket's zipper. (See Exhibit 3.)

In *Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.*,¹⁵ plaintiff asserted three design patents involving an exterior lamp housing, a lamp support arm, and an interior light globe.

Exhibit 3

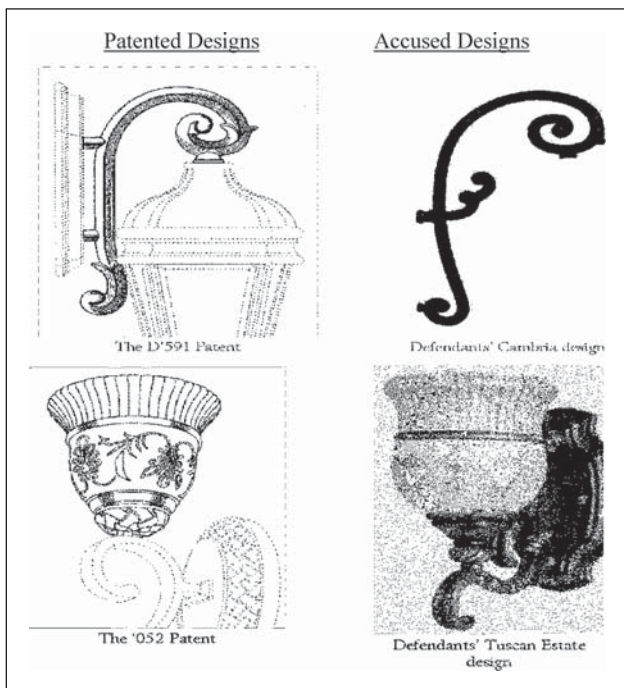
Prior Art Designs



Exhibit 4

Patented Design

Accused Design



For the arm and globe patents and accused products (Exhibit 4), the Court found that the overall visual impressions were distinct (even without reference to the prior art), and determined that it was “readily apparent that an ordinary observer would not be confused.” The court cautioned against reading design patents too broadly: “[w]ere the Court to find infringement by Defendants’ dissimilar product, it would effectively broaden the scope of Plaintiff’s patent to cover all lamp support arms that incorporate a scroll design.” Here, it appears that the court focused on individual design details such as the added swirl design element in the center of the arm shown in Exhibit 4 and the decorative embellishments on the globe.

For the housing patent (Exhibit 5), the court was satisfied that the defendant’s accused design was readily distinguishable and that “any similarity between the defendant’s accused design and the ’052 Patent is no greater than the similarities between the designs of the ’052 patent and the prior art.” Here, the Court focused on prior art to narrow the scope of the patented housing design.

In *HR US LLC v. Mizco International, Inc., et al.*,¹⁶ involving a design patent for a Palm Pilot holder, (see Exhibit 6) the court granted summary judgment finding that specific ornamental features substantially impact

Exhibit 5

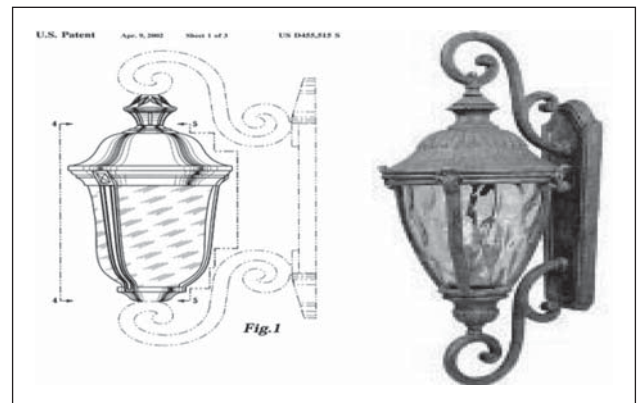
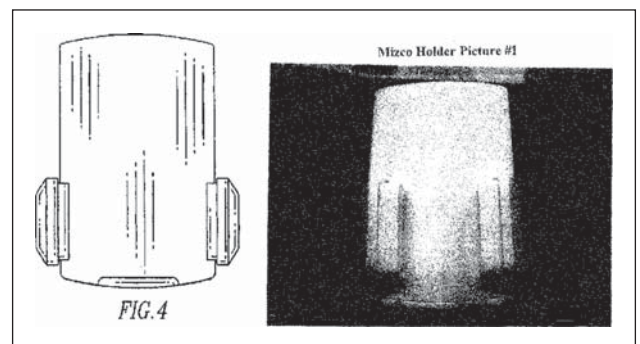


Exhibit 6



the overall design of the accused product and distinguish the overall design of the accused product from the patented design.

In *Chef'n Corporation v. Trudeau Corporation*,¹⁷ which involved a design patent on a steamer, the court held “[a] visual comparison of the ’503 design and the Trudeau steamer demonstrates certain similarities, but an ordinary observer with knowledge of the prior art would not confuse the two.” (See Exhibit 7.) Note one of the distinct differences between the two designs is the handles, which are shown in dashed lines and thus, not claimed in the patent.

The court found two striking visual distinctions between the ’503 Patent and the accused product: a flat center and one change in concavity in the accused steamer versus multiple degrees of concavity in the patent. The court found the visual distinctions were “not simply isolated differences and an ordinary observer would not confuse the two.” Here, the court focused on individual design features that could arguably be considered small differences in the two designs, as opposed to features that impacted the overall effect of the patented design.

In *Rainworks Limited v. The Mill Rose Company*,¹⁸ the court found that the overall appearance of the defendant’s gutter filter was substantially different from the patented design. Moreover, the court held there could be no infringement because the patented design “includes a laterally trimmed bristle portion,” which feature is not in the accused product. If the laterally trimmed bristle

portion has a significant impact on the overall effect of the patented design, the court’s ruling was likely consistent with *Crocs*.

On October 3, 2009, the court in *Wing-Shing Products Co. Ltd. v. Sunbeam Products, Inc.*,¹⁹ granted summary judgment of noninfringement to the defendant on plaintiff’s claim for infringement of a patent covering the ornamental design of a coffee maker. (See Exhibit 8.) The court conducted a side by side analysis of the patented design in the accused design and noted two major differences, the base and the top. Again, the court focused on individual design features, as opposed to the overall impression. The court noted that despite “manifest differences in the overall appearance of the [patented design and the accused design]” it further reviewed the “cluttered world of the drip-coffee makers”—the prior art “for context.” The court found that when the prior art was used as a frame of reference, the tops and bases of the devices in question dominated the overall visual impressions that they made.

On January 22, 2010, in *Seat Sack, Inc. v. Childcraft Ed. Corp.*,²⁰ the Southern District of New York District Court granted summary judgment of noninfringement to defendant finding “Plaintiff has utterly failed to show that her design patent contains ‘novel, ornamental aspects,’ or that [defendant’s] design [the Seat Pocket] appears to be ‘substantially the same.’” The design patent at issue is for “ornamental design for sack for hanging on the back of a chair.” (See Exhibit 9.)

Exhibit 7

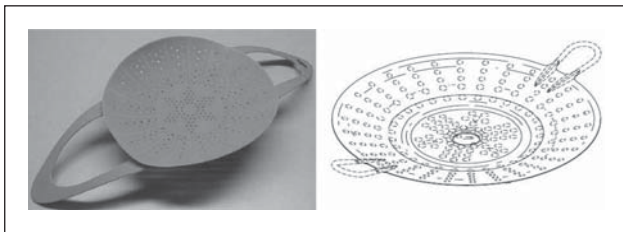
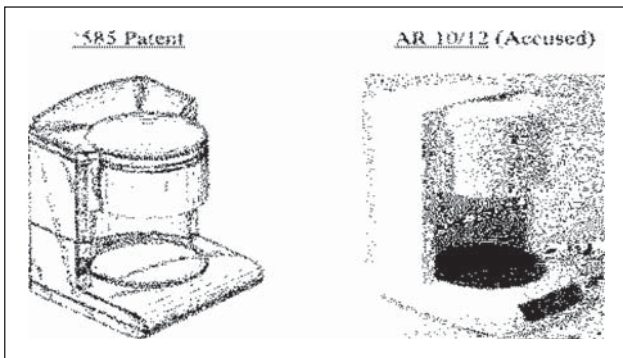


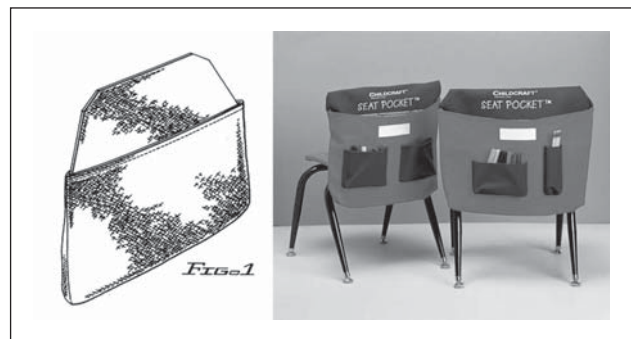
Exhibit 8



Conclusion

District courts looking at the scope of design patents under the *Egyptian Goddess* test for design patent infringement have found that the scope of design patents is narrow. The summary judgment rulings described in this article show that prior art played a key role in determining the scope of the protected design. However, the Federal Circuit’s ruling in *Crocs* stresses that the emphasis must be on the overall design, impression, or effect and not on differences in individual features.

Exhibit 9



1. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).
2. *Crocs, Inc. v. Int'l Trade Comm.*, 598 F.3d 1294 (Fed. Cir. 2010).
3. For the utility patent at issue, the Court reversed the ITC's finding of non-infringement and invalidity based on obviousness.
4. *Gorham v. White*, 14 Wall. 511, 81 U.S. 511, 20 L.Ed. 731 (1871).
5. *Egyptian Goddess*, 543 F.3d at 670-671.
6. *Id.* at 674 (emphasis added)
7. *Id.* at 672.
8. *See id.* at 676.
9. *Id.*
10. *Id.* at 678.
11. *Crocs*, 598 F.3d at 1306.
12. *See Arc-Teryx Equip., Inc. v. Westcomb Outerwear, Inc.*, Case No. 2008 WL 4838141 (D. Utah 2008); *Rainworks Ltd. v. Mill-Rose Co.*, Case No. 2009 WL 863993 (N.D. Ohio 2009); *HR U.S. LLC v. Mizco Int'l, Inc.*, Case No. 2009 WL 890550 (E.D.N.Y. 2009); *Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.*, 2009 WL 691594 (N.D. Tex. 2009); *Chef'n Corp. v. Trudeau Corp.*, 2009 WL 1564229 (W.D. Wash. 2009); *Wing-Shing Products Co. Ltd. v. Sunbeam Products, Inc.*, 2009 WL 3151195 (S.D. N.Y. October 3, 2009); *Richardson v. Stanley Works, Inc.*, 610 F.Supp.2d 1046 (D. Ariz. 2009), *aff'd* *Richardson v. Stanley Works, Inc.*, 2009-1354 (Fed. Cir. Mar. 9, 2010); *Seat Sack, Inc. v. Childcraft Ed. Corp.*, 2010 WL 245576 (S.D.N.Y. 2010).
13. *See Mondo Polymers Technologies, Inc. v. Monroeville Indus. Moldings, Inc.*, 2009 WL 3698432 (S.D. Ohio 2009) ("drawing all reasonable inferences in Plaintiff's favor [including expert testimony], . . . an ordinary observer, taking into account the prior art, could believe the accused design to be the same as the patented design. The overall visual similarity of the blocks [used in guardrails] is significant."); *Dexas Intern. Ltd. v. Tung Yung Intern. (USA) Inc.*, 2008 WL 5773608 (E.D. Tex. 2008) (defendant's focus on a calculator-clip was improper because the clip was not part of the patented-ornamental design for a "slim case"—"considering common ornamental features... a reasonable jury could find that a corporate buyer could confuse the '599 patent's design with the accused product without the calculator-clip.")
14. *Arc-Teryx Equip., Inc. v. Westcomb Outerwear, Inc.*, 2008 WL 4838141 (D. Utah 2008).
15. *Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.*, 2009 WL 691594 (N.D. Tex. 2009).
16. *HR US LLC v. Mizco Int'l, Inc., et al.*, 2009 WL 890550 (E.D.N.Y. 2009).
17. *Chef'n Corporation v. Trudeau Corporation*, 2009 WL 1564299 (W.D. Wash. 2009).
18. *Rainworks Limited v. The Mill Rose Company*, 622 F.Supp.2d 650 (2009).
19. *Wing-Shing Products Co. Ltd. v. Sunbeam Products, Inc.*, 2009 WL 3151195 (S.D.N.Y. 2009).
20. *Seat Sack, Inc. v. Childcraft Ed. Corp.*, 2010 WL 245576 (S.D.N.Y. 2010).

Reprinted from *IP Litigator* May/June 2010, Volume 16, Number 3, pages 6-10,
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