

DESIGN PATENT PERSPECTIVE: Surveys for Design Patent Litigation PART 2



BY ROBERT G. OAKE, JR.

Robert G. Oake, Jr. specializes in patent litigation. He is a registered patent attorney and is board certified as a civil trial advocate by the National Board of Trial Advocacy. Robert earned a master of laws degree in patent and intellectual property law (with highest honors) from The George Washington School of Law, a general master of laws with concentrations in international business and technology transfer law from the SMU School of Law, and a J.D. from South Texas College of Law, where he was school moot court champion his first year and state moot court champion his third year.

Robert served as lead trial and appellate counsel for *Egyptian Goddess, Inc.* in *Egyptian Goddess v. Swisa (en banc)*. Robert maintains legal websites at www.oake.com and www.designpatentschool.com. He may be contacted at rgo@oake.com.

In part 1 we considered why surveys are seldom used in design patent cases and why they may be of more value after *Egyptian Goddess*.¹ We also identified the biggest challenges in design patent survey construction and discussed why most surveys are rejected. Now we are ready to review the general and specific requirements of a design patent infringement survey and consider construction principles that likely will make a survey acceptable to a court and helpful to a jury.

The general requirements for an admissible survey are: (1) a proper “universe” must be defined; (2) a representative sam-

ple must be selected; (3) appropriate questions must be asked in a clear, precise, and non-leading manner; (4) sound interview procedures must be followed by competent interviewers who have no knowledge of the litigation or the purpose for which the survey was conducted; (5) the data must be properly gathered and accurately reported; (6) the data must be analyzed in accordance with accepted statistical principles; and (7) the objectivity of the entire process must be assured.² The specific requirements for a design patent infringement survey are discussed under point (3) below.

(1) The first step in survey construction is defining a proper “universe.” In *Competitive Edge, Inc. v. Staples, Inc.*,³ a case involving a calculator design patent, the court stated “[t]he probative value of a survey depends in large part upon the ‘universe’ of respondents, and the reliability of the survey is diminished if the universe of desired respondents is erroneous or undefined.”⁴ In general, the proper universe in a design patent case consists of ordinary observers who intend to purchase the patented design or who are interested in the subject.⁵

A universe also may include end-users who did not purchase the patented design, but whose perspective was considered when the purchase was made.⁶ When end users are included, purchasers also must be included or the survey evidence will not raise an issue of fact to defeat a motion for summary judgment.⁷ When a patented design is only a component of a retail product, the ordinary observer may be the industrial purchaser of the patented design component and not the retail purchaser of the finished product.⁸

In *Competitive Edge, supra*, the court criticized the survey expert for not initially defining the universe. When the expert later defined the universe as “the general purchasing public with an ability to perceive,” the court stated “[t]he reliability of the survey is diminished by [the expert’s] failure to define his target universe, and

its relevance is greatly harmed by his failure to focus the survey on the consumers in the market at issue in this case.⁹

(2) The second step in survey construction is selecting a sample population that accurately represents the universe. If a sample is unrepresentative, then the survey will be inadmissible.¹⁰ If a sample is under inclusive, then the survey’s reliability will be seriously diminished,¹¹ and such a survey may not be capable of raising an issue of fact to avoid summary judgment.¹²

A survey participant need not intend to actually purchase a product containing the patented design because there is no requirement that the product must have been offered for sale.¹³ But survey participants should be members of the public who are interested in the type of product containing the patented design.¹⁴

In *Competitive Edge, supra*, although the identified universe was “the general purchasing public with an ability to perceive,”¹⁵ the selected sample consisted only of college students. The survey noted that college students were selected because “they were familiar with calculators” and based on “common sense” the students represented “a conservative population.”¹⁶ The survey did not discuss the differences between the identified universe and the selected sample or the consequences that resulted from the difference. The court found that “[w]ithout a more adequate justification ... the underinclusive sample population seriously diminishes the reliability of the survey.”¹⁷

(3) Once a universe is identified and the representative sample is selected, a survey must be constructed that (a) includes appropriate questions framed in a clear, precise, and non-leading manner.¹⁸ In a design patent survey, the following additional specific requirements are important as well:

- (b) only the patented design must be compared to the accused design;
- (c) confusion must result from the designs and not from the sources;
- (d) functional aspects of the designs must be factored out;
- (e) the overall ornamental designs must be compared;
- (f) comparison must be made in light of the relevant prior art;
- (g) the comparison must be reasonable;
- (h) questions must avoid use of terms such as “substantial similarity”; and

(i) time and space logistics of the comparison must be appropriate.

(a) A reliable survey avoids use of confusing, ambiguous, or leading questions.¹⁹ The survey also should include filter questions and “don’t know” or “no opinion” alternative answers.²⁰ If a survey only allows for “yes” or “no” answers to close-ended questions, then the reliability of the survey will be significantly compromised.²¹

In *Brainard v. Custom Chrome*,²² the plaintiff moved for a preliminary injunction and offered a videotaped survey to show that an ordinary observer would perceive the patented and accused motorcycle throttle grip designs to be substantially the same. The videotape depicted twenty-one individuals who responded to whether certain motorcycle throttle grips “resemble,” “substantially resemble,” or “substantially look like” what appeared to be a drawing of plaintiff’s patented design. The court denied the motion for preliminary injunction and stated “[t]his ‘survey’ is wholly unscientific, highly suggestive, and of no use to resolving the issues raised on this motion.”²³

(b) Unlike trade dress or trademark surveys where market conditions are considered, the sole focus in a design patent infringement survey is on the patented and accused designs. All aspects of the designs that are visible during the article’s useful life are considered, including all views of the design.²⁴ When only a portion of an article of manufacture is claimed, the focus for infringement is only on the claimed portion and not on the entire article.²⁵

(c) Likelihood of confusion as to source is not an appropriate factor for determining design patent infringement.²⁶ In *Am. Harvest, Inc. v. Icon Health & Fitness, Inc.*,²⁷ survey participants were asked whether products were “from the same company, . . . or from two different companies.” The court stated such a survey would likely be highly relevant to claims of trade dress infringement, but “the survey does little to shed light on whether an ordinary observer would be induced to purchase the [accused design] believing it to be the [patented] design”²⁸

(d) As discussed in part I, a significant survey construction challenge exists if the patented design contains both ornamental and “functional” features. Before the patented design and accused design are compared, the functional portions of the design must be “factored out.”²⁹ If they are not, the

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survey will be flawed because it will not be clear whether the perceived similarity is based in part on the functional features.³⁰

The functionality issue in survey construction is challenging for several reasons. It is unclear whether the standard for functionality is a “dictated by” standard, or whether it includes considerations such as whether the design is the “best” design such as in trade dress functionality.³¹ Further, the principles for determining what the “function” of an article is remain unclear, and it is not settled whether functionality in the claim construction context is a question of law for the court or a question of fact for the jury.³²

If the functionality issue is treated as a matter of law, then an advance ruling can be requested from the court on what, if any, portions of the design are functional before the survey is constructed. If functionality is treated as a factual issue for the jury, then options may be (i) bifurcation, (ii) multiple surveys, and (iii) an educated prediction.

It also is unclear how the “factoring out” process is to be incorporated into a survey. At least two general approaches may be possible. First, survey respondents can be asked expressly to ignore the functional

design elements. For example, in *OddzOn Products v. Just Toys*,³³ a case involving a design for a football with tail and fins, the court stated “the survey did not ask the respondents whether they believed that there was overall similarity apart from the fact that both the design and the accused products were essentially footballs with tails and fins.”³⁴ This statement suggests that a potential way to solve the functionality problem in surveys is to expressly ask participants about the basis for similarity. The advantage of this method is that it is easy to do. A disadvantage may be that it introduces a conscious and seemingly artificial mental step into the decision-making process.

A second approach that might work in some circumstances is to build functionality into the survey so respondents need not make a *conscious* choice to ignore functional elements. A functional design might be added to the mix of prior art designs that an ordinary observer can distinguish from the patented design. For example, in the *OddzOn Products* case, a generic football with a generic tail and fins could have been one of the designs the survey respondents were shown (and were able to distinguish

from the patented design) before they made the comparison between the patented and accused designs.³⁵ If the respondents saw the generic design and were able to distinguish it from the patented design, and if the respondents still showed confusion between the patented and accused designs, then it would be reasonable to conclude that the confusion resulted from ornamental similarity apart from the patented and accused designs being “essentially footballs with tails and fins.”

(e) The ordinary observer test requires consideration of all ornamental features of the design *as a whole* and not merely isolated portions of the patented design.³⁶

(f) In *Egyptian Goddess v. Swisa*,³⁷ the Federal Circuit held that under the ordinary observer test, the patented and accused designs must be compared in light of the relevant prior art. As discussed in part 1, the prior art requirement makes a survey challenging because the typical real world purchaser (and survey participant) usually is not familiar with all relevant prior art designs. Survey participants must be educated on the prior art and demonstrate an ability to distinguish the patented design from the prior art (so they possess the ordinary observer’s presumed ability to make such distinctions). If the survey improperly includes or omits relevant prior art, its probative value likely will be significantly affected. Therefore, a pre-survey ruling from the court on relevant prior art should be helpful.

(g) A survey must contain reasonable comparisons. If it does not, it likely will be rejected. In *Competitive Edge, supra*, an embodiment of the patented calculator design was compared against the accused design. The embodiment was purple, and of all the calculators used for comparison, only the accused calculator was purple. The court stated that since the patented and accused calculators were the only two purple calculators used in the experiment, “there is no way to determine whether the students were remembering anything about the design of the calculator that they had previously seen as opposed to merely recalling its color.”³⁸

In *Spotless Enters. v. A&E Prods. Group L.P.*,³⁹ the patented design was a hanger with a dominant design feature of upswept arms. Survey participants were shown a drawing of the patented design. Participants then were shown a collection of other hangers (including the accused

design) and asked “[d]o you think any of these hangers are the same as the hanger in the drawing?”⁴⁰ The court found the survey to be severely flawed because none of the hangers shown in the survey, other than the accused hanger, had upswept arms.

In *Black & Decker, Inc. v. Pittway Corp.*,⁴¹ survey participants were shown a print advertisement displaying a variety of household products including only one flashlight, which was an embodiment of the patented design. The advertisement was removed and participants were asked what items they recalled. Participants who recalled a flashlight were taken to a room with a number of household products on display, including only one flashlight, which was the accused design. The participants then were asked which products on display they had seen in the advertisement. According to the survey, 88% of the people incorrectly identified the accused design as the patented design. The court found the survey to be non-probative of any confusing resemblance between the patented and accused designs and stated the survey “suggests only that the respondents identified both the [patented and accused designs] as rechargeable flashlights.”⁴²

(h) Courts have rejected surveys that use legal terms such as “substantial similarity” when it is unclear whether the survey participant had the proper definition in mind when responding. For example, in *Minka Lighting, Inc. v. Craftmade International, Inc.*,⁴³ a survey was rejected because it did not include a precise definition for the term “substantial similarity.” The court could not determine whether some respondents had found substantial similarity between the patented and accused design simply by applying some standard of their own.

(i) The ordinary observer test asks whether the resemblance between a patented and accused design is such that an ordinary observer, who gives such attention as a purchaser usually gives, will be deceived into purchasing the accused design supposing it to be the patented design. It is not yet clear from the case law how the time and space logistics of this hypothetical purchasing decision are to be replicated in a survey.

In *Crocs, Inc. v. ITC*,⁴⁴ the Federal Circuit stated “[t]he proper comparison requires a side-by-side view of the ... patent design and the accused products.”⁴⁵ However, this view seems inconsistent with the Supreme Court’s opinion in *Gorham*

v. White.⁴⁶ In *Gorham*, the Supreme Court relied heavily on expert testimony, and several experts based their opinions on comparisons that were *not* conducted side-by-side.

In *Competitive Edge, supra*, certain calculators were shown to survey participants on one day. Then two days later, other calculators were shown and the participants were asked if they thought they had seen the same calculators more than once. The court criticized the procedure and stated there was no evidence “that a 48-hour delay has any bearing on the conditions under which purchasers of the products, whom Plaintiffs admit to be sophisticated consumers of advertising and promotional specialties, make their buying decisions.”⁴⁷ The court then engaged in its own analysis of the differences between the patented and accused designs without explaining whether its own comparative process had any bearing on the conditions under which purchasers made their buying decisions.

One approach that appears reasonable is to match the survey protocol with what typically happens in real life. For example, in *Amerock Corp. v. Unican Sec. Systems Corp.*,⁴⁸ the designs involved kitchen cabinet hardware. Testimony at trial established that the ordinary observer was the ultimate consumer. The testimony also established that the hardware consumers generally did not have the opportunity to view different designs of hardware simultaneously. The court stated “[t]herefore, differences between the patented and the accused design that are apparent in a side-by-side comparison will not necessarily dictate a finding of non-infringement.”⁴⁹

In addition to the matter of how much time and distance should exist between viewing the patented design in light of the prior art and viewing the accused design, an issue exists of how much time and attention survey participants should be allowed when viewing the designs. Current case law suggests that a purchaser normally gives less attention to products that are less expensive and bought on impulse.⁵⁰

(4) To be reliable, a survey should be conducted in a double-blind manner where neither the interviewers nor the respondents are aware of the purpose of the survey or its sponsor.⁵¹ Double-blind conditions are essential “because if the respondents know what the interviewer wants, they may try to please the interviewer by giving the desired answer, and if the interviewer knows what his employer wants, he may consciously

or unconsciously bias the survey through variations in the wording or the tone of his questions.⁵² When both the administrators and the respondents know the survey is intended for use in a patent infringement case, the reliability of the survey is limited.⁵³

(5) The data from a survey must be gathered properly and then recorded and classified consistently and accurately. When there are inconsistencies in the testimony concerning how the data was collected, multiple people administering the survey with no uniform method of administration, and a possibility that respondents took the survey more than once, a court's confidence in the reliability of the survey's collected data will be gravely diminished.⁵⁴

(6) The data gathered in a survey must be analyzed according to accepted statistical principles.⁵⁵

(7) As a general matter, the entire survey process must be objective. In addition to the above requirements, the survey must be conducted independently of the attorneys litigating the case.⁵⁶

A survey for design patent infringement must be carefully constructed to measure the one issue relevant in a design patent case - whether the accused design infringes the patented design under the ordinary observer test. Since the comparison must be made in light of the relevant prior art with any functional features of the patented design factored out, the survey is different from surveys used in trademark and trade dress law.

Design patent surveys have many challenges and most survey results have not been well received by the courts. But post-*Egyptian Goddess*, the value of surveys should be reconsidered. For litigants who want to offer the court and jury more than just the patented and accused designs, the prior art, and argument, design patent infringement surveys hold promise for persuasive empirical evidence that may well be worth the effort. **IP**

ENDNOTES

1. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc).
2. See *Weight Watchers Int'l, Inc. v. Stouffer Corp.*, 744 F. Supp. 1259, 1272 (S.D.N.Y. 1990) (citing *Toys R Us, Inc. v. Canarsie Kiddie Shop, Inc.*, 559 F. Supp. 1189, 1205 (E.D.N.Y. 1983)); *Pittsburgh Press Club v. United States*, 579 F.2d 751, 758 (3rd Cir. 1978).
3. 763 F. Supp. 2d 997, 1006-1010 (N.D. Ill. 2010).
4. *Id.* at 1008.
5. See *Arminak & Assocs. v. St.-Gobain Calmar, Inc.*, 424 F. Supp. 2d 1188 (C.D. Cal. 2006); *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. Mich. 1933); *Puritan-Bennet Corp. v. Penox Technologies Inc.*, 2004 U.S. Dist. LEXIS 6896, 2004 WL 866618 (S.D. Ind., March 2, 2004).
6. See *Puritan-Bennett Corp. v. Penox Techs., Inc.*, 2004 U.S. Dist. LEXIS 6896 (S.D. Ind. Mar. 2, 2004), *affirmed*, *Puritan-Bennett Corp. v. Penox Techs., Inc.*, 121 Fed. Appx. 397 (Fed. Cir. 2005) (court unwilling to rule as completely irrelevant survey evidence accounting for patients' perspective when purchaser of equipment admitted that patients' needs as communicated through durable medical equipment suppliers was relevant to its decision to purchase an ultra-light portable oxygen unit design).
7. *Id.* at *77. (when universe of ordinary observers did not include purchasers of medical equipment, the survey was not broad enough to create an issue of fact on infringement).
8. See *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1324 (Fed. Cir. 2007).
9. 763 F. Supp. 2d at 1008.
10. See *Jaret Intern., Inc. v. Promotion in Motion, Inc.*, 826 F. Supp. 69, 74 (E.D.N.Y. 1993) (finding a trade dress confusion survey inadmissible because of, among other flaws, "its unrepresentative sample and its untrustworthy methodology.")
11. See *Competitive Edge, supra*, at 1008.
12. See footnote 7, *supra*.
13. See *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986); *Am. Harvest, Inc. v. Icon Health & Fitness, Inc.*, 1997 U.S. Dist. LEXIS 24146, 18-21 (D. Minn. June 16, 1997).
14. See *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. Mich. 1933) ("The ordinary observer is not any observer, but one who, with less than the trained faculties of the expert, is 'a purchaser of things of similar design,' or 'one interested in the subject.'")
15. 763 F. Supp. 2d at 1008.
16. *Id.*
17. *Id.*
18. See, e.g., *Nat'l Football League Props., Inc. v. ProStyle, Inc.*, 57 F. Supp. 2d 665, 668 (E.D. Wis. 1999).
19. See *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 452 F. Supp. 2d 772, 778 (W.D. Mich. 2006).
20. See *LG Elecs. USA, Inc. v. Whirlpool Corp.*, 661 F. Supp. 2d 940, 954 (N.D. Ill. 2009) (survey's inclusion of a "don't know" option as an answer to an otherwise close-ended question mitigated concerns about its reliability).
21. 763 F. Supp. 2d at 1008.
22. 872 F. Supp. 39 (W.D.N.Y. 1994).
23. *Id.* at 43.
24. See *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1323 (Fed. Cir. 2007) ("the ordinary observer test requires ... the comparing of the accused and patented designs from all views included in the design patent, not simply those views a retail customer seeking to buy would likely see when viewing the product at the point of sale.")
25. See *Metrokane, Inc. v. Wine Enthusiast*, 185 F. Supp. 2d 321, 329 (S.D.N.Y. 2002).
26. See *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986).
27. 1997 U.S. Dist. LEXIS 24146, 18-21 (D. Minn. June 16, 1997).
28. *Id.* at *18.
29. See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293, 1294 (Fed. Cir. 2010).
30. See *OddzOn Products v. Just Toys*, 122 F.3d 1396, 1400-1407 (Fed. Cir. 1997).
31. Compare *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) ("dictated by") with *Berry Sterling Corp. v. Prescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997) ("best design").
32. Compare *Carson Chang v. AIM Sports, Inc.*, 2011 U.S. Dist. LEXIS 42462 (C.D. Cal. 2011) (question of law) with *Black & Decker (U.S.) v. Pro-Tech Power*, 1998 U.S. Dist. LEXIS 9162 (E.D. Va. 1998) (question of fact) and *Colgate-Palmolive Co. v. Ranir L.L.C.*, 2007 U.S. Dist. LEXIS 55258 (D. Del. 2007) (question of fact).
33. 122 F.3d 1396 (Fed. Cir. 1997).
34. *Id.* at 1406.
35. A survey participant's ability to distinguish between the patented design and prior art or functional designs might be taught or tested for in an initial screening process.
36. See *Braun, Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 820 (Fed. Cir. 1992); *Hosley Int'l Trading Corp. v. K Mart Corp.*, 237 F. Supp. 2d 907, 910-911 (N.D. Ill. 2002).
37. 543 F.3d 665 (Fed. Cir. 2008) (en banc).
38. 763 F. Supp. 2d at 1010.
39. 294 F. Supp. 2d 322 (E.D.N.Y. 2003).
40. *Id.* at 347.
41. 636 F. Supp. 1193, 1201-1203 (N.D. Ill. 1986).
42. *Id.* at 1202.
43. 2002 U.S. Dist. LEXIS 8693, *15 (N.D. Tex. 2002), *aff'd*, 93 Fed. Appx. 214 (Fed. Cir. 2004) (nonprecedential), cert. denied, 543 U.S. 814 (2004).
44. 598 F.3d 1294 (Fed. Cir. 2010).
45. *Id.* at 1304.
46. 81 U.S. 511 (1871).
47. 763 F. Supp. 2d at 1010.
48. 1981 U.S. Dist. LEXIS 17467, 4-7 (E.D.N.C. 1981).
49. *Id.* at 6.
50. See *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1446 (Fed. Cir. 1984) ("The ordinary consumers of such [expensive] goods would exercise much more discriminating care in their purchases of those items than would the purchaser of an inexpensive, routinely purchased product such as a desk-style checkbook."); *Braun, Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 820 (Fed. Cir. 1992) (testimony that product was inexpensive and purchased on impulse helped support jury verdict of design patent infringement).
51. See *Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Cons. Pharms. Co.*, 290 F.3d 578, 590-91 (3rd Cir. 2002) (upholding reliance on a survey "during which both the respondents and the interviewees [were] unaware of the purpose of the survey or its sponsor.")
52. *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1330-1331 (N.D. Ga. 2008).
53. *Competitive Edge, Inc. v. Staples, Inc.*, 763 F. Supp. 2d 997, 1009 (N.D. Ill. 2010).
54. *Id.*
55. See *Manual for Complex Litigation* (Fourth) § 11.493 (2004).
56. See *Pittsburgh Press Club v. United States*, 579 F.2d 751, 758 (3d Cir. 1978).