

# DESIGN PATENT PERSPECTIVE: Prior Art and the Ordinary Observer Test PART 1



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The test for design patent infringement requires an ordinary observer to compare the patented and accused designs in light of the prior art. But just what “prior art” is considered in the comparison? Is it the same “prior art” formerly used in the now abandoned “point of novelty” test? Or has a change in the ordinary observer test also changed the scope of prior art considered? Let’s begin our investigation of these questions by first understanding their importance.

In *Egyptian Goddess v. Swisa*,<sup>1</sup> the Federal Circuit held that when determining whether design patent infringement exists, an ordinary observer compares the patented and accused designs in light of the prior art. Prior to *Egyptian Goddess*, the infringement

test took place in two separate and distinct steps. First, the patented and accused designs had to appear substantially similar as a whole to an ordinary observer. Second, and independently, the accused design had to “contain substantially the same points of novelty that distinguished the patented design from the prior art.”<sup>2</sup> The separate point of novelty test proved unworkable in practice because it was difficult, if not impossible, to consistently and predictably identify points of novelty, particularly in complex designs with multiple prior art references. The solution was to introduce the prior art as an integral part of the ordinary observer test, i.e., to make the comparison in light of the prior art.

Since the prior art provides a frame of reference for the comparison, its scope can make a significant difference in the infringement determination. As explained in *Egyptian Goddess*: “Where there are many examples of similar prior art designs ... differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.”<sup>3</sup> Stated differently, an ordinary observer familiar with many similar prior art designs will view the patented and accused designs more discriminately and in close cases a finding of infringement will become less likely.

Consider an example. *Egyptian Goddess* involved a nail buffer design. What if the buffer design also included a nail clipper that retracted into the plastic frame but was still visible? And suppose the accused buffer/clipper design was identical to the new patented design but had one more buffer pad (the same difference as in *Egyptian Goddess*). Should the field of “analogous” prior art still include nail buffers without nail clippers? If not, then the field of prior art would be far less crowded and a finding of infringement more likely. How then should the scope of the prior art be determined for infringement purposes under the ordinary observer test? Before exploring

possible answers, let’s first review how the scope of prior art is determined in the validity context for both anticipation and obviousness.

A design patent is not anticipated, or is novel, “when the average observer takes the new design for a different, and not a modified, already existing design.”<sup>4</sup> A design is anticipated if there is a single prior art reference that is “identical in all material respects” to the claimed design.<sup>5</sup> When determining anticipation, the average observer test does not require that the prior art reference and the claimed design be from analogous arts (defined below).<sup>6</sup> Rather, if a design exists somewhere in the prior art (either analogous or non-analogous) and the design is “identical in all material respects” to the claimed design, then the claimed design lacks novelty and is not patentable.

With obviousness the analysis is different. 35 U.S.C. § 103 currently provides in relevant part that “[a] patent for a claimed invention may not be obtained ... if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious ... to a person having ordinary skill in the art to which the claimed invention pertains.” The MPEP states “[t]he scope of the relevant prior art for purposes of evaluating obviousness under 35 U.S.C. 103(a) extends to all ‘analogous arts.’”<sup>7</sup>

In the utility patent context an art is analogous if the reference (1) is from the same field of endeavor as the claimed invention, or (2) is reasonably pertinent to the particular problem with which the inventor is involved.<sup>8</sup> A reference is reasonably pertinent if it, as a result of its subject matter, logically would have commended itself to an inventor’s attention in considering his problem.<sup>9</sup> In the design context, these general principles are supplemented with the requirement from *In re Glavas*<sup>10</sup> that “[t]he question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.”<sup>11</sup> Whether a prior reference is analogous is a question of fact.<sup>12</sup>

The MPEP also draws a distinction between analogous and non-analogous arts in the differing contexts of primary and secondary references. Recall that in general an

obviousness determination in design patent law begins with first finding a primary reference that is “basically the same” as the claimed design.<sup>13</sup> If such a reference can be found, then secondary references can be combined in appropriate circumstances to render the claimed design obvious.<sup>14</sup> When searching for a primary reference, the art must be analogous.<sup>15</sup> If the design involves configuration (shape), then the nature of the article of manufacture must be considered when determining whether the art is analogous.<sup>16</sup> If the design involves surface decoration only, then all other surface designs are considered as being analogous art regardless of the nature of the article of manufacture.<sup>17</sup>

When modifying the *shape* of a primary reference with a secondary reference, both the primary and secondary references must be from analogous arts.<sup>18</sup> But when the surface of a primary reference is modified, “it is immaterial whether the secondary reference is analogous art, since the modification does not involve a change in configuration or structure and would not have destroyed the characteristics (appearance and function) of the primary reference.”<sup>19</sup>

Note that in all the above determinations, the standard is that of a person of ordinary skill in the art, i.e., an ordinary designer. This standard is mandated by section 103(a), which provides that obviousness is determined by “a person having ordinary skill in the art to which the claimed invention pertains.”<sup>20</sup> The ordinary designer standard makes sense when determining whether prior art is analogous in the obviousness context because ordinary designers often look to analogous arts while in the process of designing. For example, in *In re Rosen*,<sup>21</sup> a case involving a coffee table design, the Court held that designs for a desk and a circular glass tabletop were analogous arts because they reasonably fell within the knowledge of a coffee table designer of ordinary skill. Conversely, in *In re Butera*,<sup>22</sup> a case involving a spherical design for a combined insect repellent and air freshener, the Federal Circuit held that a design for a metal ball anode was non-analogous art. The Court stated “[a] prior design is of the type claimed if it has the same general use as that claimed in the design patent application . . . . One designing a combined insect repellent and air freshener would therefore not have reason to know of or look to a design for a metal ball anode.”<sup>23</sup> In short, the scope of the prior art for obviousness purposes is deter-

mined by the principles arising from and related to the ordinary designer standard.

What then should be the scope of the prior art for the ordinary observer test? Since the ordinary designer standard determines the scope of the prior art for obviousness, does it similarly make sense to use the ordinary *observer* standard to determine the scope of the prior art for infringement under the ordinary observer test? And if so, how would such a test work and what would it mean to the infringement determination?

In *Gorham v. White*,<sup>24</sup> a case involving a silverware handle pattern, the Supreme Court set forth the now familiar “ordinary observer” test. In *Gorham*, the only prior art references mentioned or used when applying the ordinary observer test were other silverware designs. Similarly, in *Smith v. Whitman Saddle*,<sup>25</sup> a case involving horse saddle designs, the only prior art references mentioned by the Supreme Court when applying the infringement test were other horse saddle designs. It therefore appears, at least according to Supreme Court precedent, that the only prior art framing the comparison between the patented and accused designs is limited to articles of the type being purchased. Such a scope is more limited than that considered by an ordinary designer. A more limited scope makes sense because although an ordinary *designer* may consider a desk when designing a coffee table, an ordinary *observer* typically will not be thinking about desk designs when shopping for a coffee table.

While a limited prior art scope for infringement purposes appears to be supported by Supreme Court precedent, has such a limitation been applied by Circuit Courts of Appeal in other significant cases decided before creation of the Federal Circuit? Let’s review those mentioned in *Egyptian Goddess v. Swisa*.

In *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*,<sup>26</sup> a design patent case involving a combination ashtray and cigarette lighter for an automobile, the court posed the following question: “What does the ordinary observer, at least in the common acceptance of that phrase, know of the prior art?”<sup>27</sup> Answering its own question, the court stated “[a] careful analysis of *Gorham v. White*, and other adjudicated cases supplies the answer. 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.’”<sup>28</sup> The court continued: “the average

observer [is] not one who has never seen an ash tray or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it.”<sup>29</sup> Notably, the only prior art used by the court for comparison purposes in the case consisted of *combinations* of ashtrays and cigarette lighters. Similarly, in *Sears, Roebuck & Co. v. Talge*,<sup>30</sup> a case involving designs for household fruit juicers, the only prior art references considered by the court for comparison were the same rack-and-pinion type of fruit juicer presented by the patented and accused designs.

The third case, *Bevin Brothers Manufacturing Co. v. Starr Brothers Bell Co.*<sup>31</sup> involved a design for an automotive bell with a body in the form of an oblate spheroid. The court, sitting in equity, decided that the patent was both invalid and not infringed in view of prior art that included a doorknob having the same oblate spheroid shape. The court stated: “In design patents the test of identity, on questions of anticipation and infringement, is the eye of the ordinary observer. And in determining this question the court may avail itself of such common knowledge as is possessed by the general public.”<sup>32</sup>

The fourth and final case, *Zidell v. Dexter*,<sup>33</sup> involved a design for children’s rompers. The district court found the design patent valid and infringed by some accused designs, but not by others. The findings of non-infringement were appealed, and the court affirmed. In the infringement analysis, both courts considered only similar type garments as comparative prior art. The appellate court stated: “The differences in designs, which under the patent law will avoid infringement, are differences which will attract the attention of the ordinary observer, giving such attention as the purchaser usually gives in buying articles of the kind in question and for the purposes for which they are intended.”<sup>34</sup> (emphasis added).

The holdings and rationales of the preceding four cases are not entirely consistent. *Applied Arts*, *Sears*, and *Zidell* suggest in general that the scope of the prior art for the ordinary observer test for infringement should be limited to articles of the same type and that have the same purpose as the patented and accused designs. *Bevin Brothers* suggests that the scope of the prior

art considered by the ordinary observer should not be so restricted, and should extend to designs of articles that may not have the same purpose as the patented and accused designs, *e.g.*, a doorknob as prior art for a bell.

The above case law from the Supreme Court and the various Courts of Appeal can be analyzed and interpreted in different ways to mean a variety of things, but one overriding factor appears to emerge. When the ordinary observer test is considered as occurring in a purchasing environment (as originally expressed in *Gorham*), then the prior art is more likely to be limited to articles “of the kind in question and for the purposes for which they are intended.” But if the ordinary observer test is considered as merely an abstract comparison unrelated to a purchasing environment, then it is more likely that a broader range of prior art will be considered.

Which approach makes more sense and is more firmly grounded in precedent? Which approach is more appealing as a matter of policy and which approach, if either is the Federal Circuit currently favoring? Finally, might a more limited prior art approach adversely affect the ability of the ordinary observer test “to cabin unduly broad assertions of design patent scope by ensuring that a design that merely embodies or is substantially similar to prior art designs is not found to infringe” (an issue discussed in *Egyptian Goddess*). These questions will be taken up in the next column.

## ENDNOTES

1. 543 F.3d 665 (Fed. Cir. 2008) (en banc).
2. *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998).
3. 543 F.2d at 678.
4. *In re Bartlett*, 300 F.2d 942, 943 (CCPA 1962) (quoting Shoemaker, *Patents for Designs*, page 76).
5. *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456 (Fed. Cir. 1997).
6. *See In re Glavas*, 230 F. 2d 447, 450 (CCPA 1956); *see also* MPEP § 1504.02, p. 1500-21.
7. MPEP § 1504.03(I)(A), p. 1500-28.
8. *See Invention Toys, LLC v. MGA Entm't, Inc.*, 637 F.3d 1314, 1321(Fed. Cir. 2011)).
9. *Id.*
10. 230 F.2d 447 (CCPA 1956).
11. *Id.* at 450.
12. *See In re Clay*, 966 F.2d 656, 658, (Fed.Cir.1992).
13. *See In re Rosen*, 673 F.2d 388, 391 (CCPA 1982).
14. *See In re Borden*, 90 F. 3d 1570, 1572 (Fed. Cir. 1996).
15. *See* MPEP § 1504.03(I)(A), p. 1500-28, 29.
16. *See* MPEP § 1504.03(I)(A), p. 1500-29.
17. *Id.*
18. *In re Glavas*, 230 F.2d 447 (CCPA 1956).
19. *Id.*
20. “[A] person having ordinary skill in the art to which the claimed invention pertains” in design cases is a “designer of ordinary capability who designs articles of the type presented in the application.” *In re Nalbandian*, 661 F.2d 1214, 1216 (CCPA 1981).
21. 673 F.2d 388 (CCPA 1982).
22. 1 F.3d 1252 (Fed. Cir. 1993) (nonprecedential).
23. *Id.*
24. 81 U.S. 511 (1872).
25. 148 U.S. 674 (1893).
26. 67 F.2d 428 (6th Cir.).
27. *Id.* at 429, 430.
28. *Id.* at 430.
29. *Id.*
30. 140 F.2d 395 (8th Cir. 1944).
31. 114 F. 362 (C.C.D. Conn 1902).
32. *Id.* at 363.
33. 262 F. 145 (9th Cir. 1920).
34. *Id.* at 147.