

DESIGN PATENT PERSPECTIVE: Prior Art and the Ordinary Observer Test PART 3



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In Part 2 we concluded that since the ordinary observer test occurs in the context of a potential purchase, it makes sense to restrict the prior art used as a comparative frame of reference to designs of the same type and that have the same purpose as the patented and accused designs. In Part 3 we address the question of whether this more limited prior art approach may create a problem of adversely affecting 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”¹ (an issue discussed in *Egyptian Goddess*).

Let’s start by understanding the importance of the question. The ordinary observer

test provides the framework for comparing an accused design against the patented design to determine whether infringement exists. The test is “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.”²

The *Gorham* ordinary observer test does not expressly state the role of prior art in the analysis. But the prior art must play some role. Because if it does not, then designs obvious over the prior art can be captured as infringements, which then expands the enforceable scope of the design patent beyond what could have been patented originally.

One of the primary purposes of the “point of novelty” test was to prevent the ordinary observer test from capturing as infringements designs that were obvious over the prior art. Unfortunately, the point of novelty test was flawed because in complex designs containing multiple potential points of novelty and combinations of points of novelty, it was difficult if not impossible to consistently and predictably identify what the “point of novelty” was. The patentee typically chose points of novelty shared by the patented and accused designs (to obtain a finding of infringement) and the defendant chose points of novelty not contained in the accused design (to obtain a finding of non-infringement). The outcome of the case depended upon what “points of novelty” the court subjectively chose. In *Egyptian Goddess v. Swisa*, the Federal Circuit recognized the problem and solved it by (i) eliminating the separate point of novelty test and (ii) comparing the patented and accused designs in light of the prior art.

With prior art back into the comparative analysis, the question then becomes what the appropriate scope of the prior art should be. Which in turn brings us to the question

addressed in this Part 3, which is whether the limited prior art approach suggested in Part 2 renews the problem of potentially capturing as infringements designs that are obvious over the prior art. Is there a potential problem? The differences in the tests for obviousness and infringement suggest there might be.

As discussed in Part 1, an obviousness determination begins with first trying to find a primary reference that is “basically the same” as the claimed design.³ If a primary reference can be found, then secondary references can be combined in appropriate circumstances to render the claimed design obvious.⁴ When searching for a primary reference, the art must be analogous,⁵ which means the reference must be (1) from the same field of endeavor as the claimed invention, or (2) reasonably pertinent to the particular problem with which the inventor is involved,⁶ and (3) so related to the claimed design that the appearance of certain ornamental features in one would suggest the application of those features to the other.⁷ The standard for determining obviousness is that of a person of ordinary skill in the art, i.e., an ordinary designer.⁸

Under these principles and standards, the scope of prior art for obviousness is wider than the more limited scope suggested for the ordinary observer test in Part 2. A case example mentioned in Part 1 is *In re Rosen*,⁹ which involved a coffee table design. In *Rosen*, 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. Under the more limited prior art approach suggested for the ordinary observer test, the desk would not be prior art because an ordinary observer purchaser of a coffee table would not necessarily have been an ordinary observer purchaser of a desk.

In theory, the difference in scope of prior art can create a problem because a prior art design considered analogous and included in the obviousness analysis might not be considered in the infringement determination if it is not of the same type and is not for the same purpose as the claimed design. Therefore, an ordinary observer test with a limited scope of prior art might be able to capture as infringing a design that would be considered obvious when the full scope of analogous prior art is considered.

Consider an example. Assume three different designs (design A - prior art for obviousness, design B - accused, and design C - patented). Accused design B is obvious over prior art design A and cannot receive a patent. Patented design C is not obvious over design A and therefore is not invalid.

If design A is not of the same type and purpose as design C, then under our conclusion of limited prior art for the ordinary observer test, design A cannot be used as prior art in the comparative analysis. And without design A in the comparative analysis, it may be more likely that accused design B will be considered an infringement of patented design A. If accused design B is found to infringe, then patented design A protects a design (B) that the patentee otherwise originally could not have received through a patent.

Is there anything wrong with such a result? Under general principles of patent law, this result is considered unacceptable as it destroys the general symmetry between patent validity and patent infringement. The classic statement of such symmetry is “that which [literally] infringes if later, anticipates if earlier.”¹⁰ Although an equivalent statement in the non-literal infringement context, i.e., “that which non-literally infringes if later, renders obvious if earlier” is not technically appropriate due to the differences in determining infringement and obviousness, such a general approach is sound based on the equitable principle of patent law that a patentee should not be not allowed to capture as an infringement a design that cannot be patented as obvious over the prior art. But what prevents such a result if the prior art is limited in the ordinary observer test?

Fortunately, as a practical matter, the nature of the obviousness test often will prevent the problem from occurring. Recall that the first step in the obviousness determination for design patents is finding a prior art reference that is “basically the same” in appearance as the claimed design. If a prior art reference has an appearance that is “basically the same” as a claimed design, the prior art reference usually will be of the same type and will have the same purpose as the claimed design. It therefore can be included in the ordinary observer test prior art, keeping symmetry intact.

The problem arises only if the primary reference is “basically the same” as the claimed design, but has a different purpose than the claimed design. This can occur when a claimed article design with purpose

A is adapted from a prior art article design that has purpose B. If the claimed and prior articles exist in analogous arts under the test described above, then the prior art with purpose B can qualify as prior art under an obviousness analysis, but may not qualify as prior art under the ordinary observer test.

To prevent this and its potential asymmetric result from occurring, in this circumstance should the ordinary observer test prior art be expanded to include prior art that could be used in an obviousness determination? Such a pragmatic approach might preserve symmetry by preventing a design obvious over the prior art from being captured as infringing, but using an infringement test with an ordinary observer standard to accomplish a goal designed for the obviousness test with an ordinary designer standard improperly conflates the tests. Indeed, the Federal Circuit recently reaffirmed that despite the confusion created by *International Seaway Trading Corp. v. Walgreens Corp.*,¹¹ the test for obviousness uses the ordinary designer standard and not the ordinary observer standard.¹²

A more appropriate approach might be to use the obviousness test itself to prevent designs obvious over the prior art from being captured as infringements when the situation described above arises in design patent law. Such an approach has been used in utility patent law. In *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*,¹³ the Federal Circuit described a “hypothetical claim construction” technique. The principle underlying the technique is that a patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims and since prior art always limits what an inventor could have claimed, it limits the range of permissible equivalents of a claim.

The court in *Wilson Sporting Goods* expressed the test as follows:

“Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer. To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope to literally cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain

that coverage in an infringement suit under the doctrine of equivalents. If the hypothetical claim could have been allowed, then prior art is not a bar to infringement under the doctrine of equivalents.”¹⁵

The court further stated “[v]iewing the issue in this manner allows use of traditional patentability rules and permits a more precise analysis than determining whether an accused product (which has no claim limitations on which to focus) would have been obvious in view of the prior art.” *Id.*

Is the hypothetical claim construction analysis suitable for use in design patent cases? And if so, how is it done? As discussed above, the principle that a patentee should not be able to obtain coverage through an infringement analysis that could not be obtained initially through the patent office is valid for design patents as well. Applying the technique, a hypothetical claim could be constructed that covers the accused design. This step is relatively easy because in design patent law, the claim typically is the design itself.¹⁶ The second step determines whether the hypothetical claim would have been allowed over the prior art. If it would have been allowed, then the prior art is not a bar to the design being captured under an infringement analysis.

The second step involves conducting a design patent validity analysis. As discussed above, the validity analysis involves the two-step process of (1) finding a primary reference that is “basically the same” as the claimed design and (2) if such a primary reference can be found, using “other [secondary] references [] to modify it to create a design that has the same overall visual appearance as the claimed design.”¹⁷ The secondary references may be used to modify the primary reference only if they are “so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.”¹⁸

It appears that the hypothetical claim analysis is appropriate for use in design patent cases. And since it appears to be appropriate, it should be useful in the situation discussed previously when a primary prior art reference is “basically the same” as the claimed design, but has a different purpose than the claimed design.

The overall thesis of this three part series has been that since the ordinary observer test occurs in the context of a potential purchase, it makes sense to restrict the prior art used as a comparative frame of

reference to designs of the same type and that have the same purpose as the patented and accused designs. But as we have seen, an ordinary observer test with a limited prior art scope might create the problem of capturing as infringing a design that would be considered obvious when the full scope of analogous prior art is considered.

Rather than expanding and improperly conflating the ordinary observer test with the obviousness test in an effort to avoid the problem, it makes more sense to address obviousness with a test designed to analyze obviousness. The hypothetical claim construction technique appears capable of doing just that, and does so in the correct way by requiring a full obviousness analysis with consideration of primary and secondary references. With the point of novelty test eliminated, the hypothetical claim construction technique appears to be a workable alternate method 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”¹⁹

test’ must be modified to: That which would literally infringe if later in time anticipates if earlier than the date of invention.”).

11. 589 F.3d 1233 (Fed. Cir. 2009).
12. See *High Point Design LLC v. Buyer’s Direct, Inc.*, (Fed. Cir. Sept. 11, 2013).
13. 904 F.2d 677 (Fed. Cir. 1990).
14. *Id.* at 684.
15. *Id.*
16. The court still would have to perform claim construction duties such as interpreting broken lines and factoring out functional design elements.
17. See *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996).
18. *In re Borden*, 90 F.3d at 1575).
19. 543 F.3d 678.

ENDNOTES

1. 543 F.3d 678.
2. *Id.* at 528.
3. See *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982).
4. See *In re Borden*, 90 F. 3d 1570, 1572 (Fed. Cir. 1996).
5. See MPEP § 1504.03(I)(A), p. 1500-28, 29. Note that with regard to secondary references, when the *shape* of a primary reference is modified with a secondary reference, the secondary reference also must be from an analogous art. See MPEP § 1504.03(I)(A), p. 1500-29. But when only the surface of a primary reference is modified, the secondary reference need not be from analogous art. *Id.*
6. 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. See *Innovation Toys, LLC v. MGA Entm’t, Inc.*, 637 F.3d 1314, 1321(Fed. Cir. 2011)).
7. *In re Clavas*, 230 F.2d 447 (CCPA 1956).
8. 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.” Such a person 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).
9. 673 F.2d 388 (CCPA 1982).
10. In *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889) the Supreme Court stated “[i]hat which infringes, if later, would anticipate, if earlier.” In recognition of current obviousness law under 35 U.S.C. § 103, the Federal Circuit changed the *Peters* language to “that which *literally* infringes, if later, would anticipate, if earlier.” See *Lewmar Marine, Inc. v. Bariant, Inc.*, 827 F.2d 744, 747 (Fed. Cir. 1987) (“While ‘the classic test of anticipation’ was indeed as stated, [footnote omitted] under the current statute ‘anticipation’ does not carry the same meaning as before, and the ‘classic