

# DESIGN PATENT PERSPECTIVE: The Ordinary Observer Test

## PART 3



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In parts 1 and 2, we reviewed the history of the ordinary observer test and the reasons for the rise and fall of the separate “point of novelty” test. We now are prepared to examine the current status of the ordinary observer test and to contemplate its future.

*Gorham v. White*<sup>1</sup> is the most authoritative case on the ordinary observer test. In the words of the Supreme Court: “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.” The primary purpose of the test is to protect the market the design patent was granted to secure.

Since the purpose of the test is to protect the market, the test focuses on potential purchasers, which in turn means the objective standard is that of an ordinary observer and not that of an expert. The comparison is made by viewing each design as a whole and not by comparing individual design elements without considering their effect on each entire design. Even if an expert can detect differences in detail when viewing the patented and accused designs side by side, if an ordinary observer is deceived into thinking the accused design is the patented design because the overall visual effects of the designs are substantially the same, then infringement exists.

The ordinary observer compares the patented and accused design in light of the relevant prior art<sup>2</sup> to determine what is “distinctive in appearance” about the visual effect of the patented design and whether the two designs share this distinctive appearance to a substantial degree. The comparison also considers what aspects of the distinctive appearance are “most impressive to the eye” and whether these are shared by the patented and accused designs. Although individual design elements are considered, the ultimate question remains whether the overall visual effects of the designs are substantially the same.

The *en banc Egyptian Goddess*<sup>3</sup> opinion expresses the “distinctive appearance” concept from *Gorham* in terms of “common conspicuous feature” and “common combination.” *Egyptian Goddess* states “[i]f the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing” and “[i]f 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.”<sup>4</sup> Note that while these concepts may at first appear to be sliding back to a “point of novelty” approach, the critical difference is that the distinctive appearances ultimately must be considered in the context of the entire designs. The old “point of novelty” approach of comparing features directly by separating them from their integrated design is not permitted.

The hypothetical ordinary observer is familiar with the relevant prior art and has the presumed ability to distinguish between the patented design and prior art designs when making purchasing decisions. For this reason, the prior art plays a critical role in the comparative analysis. *Egyptian Goddess* identifies two effects of the prior art on the perceptive ability of the ordinary observer. First, “[w]hen the differences between the claimed and accused designs are viewed in light of the prior art, the attention of the hypothetical ordinary observer may be drawn to those aspects of the claimed design that differ from the prior art.”<sup>5</sup> Second, when the patented design is close to the prior art and the prior art is crowded, the ordinary observer has a greater ability to notice smaller differences between the patented design and the prior art during the hypothetical purchasing process.<sup>6</sup> This ability gives the ordinary observer a greater ability to notice smaller differences between the patented and accused designs.

Expert testimony and other evidence concerning whether an ordinary observer likely would be deceived is important. Indeed, the Supreme Court relied heavily on expert testimony when making the decision in *Gorham*. Significantly, several experts in *Gorham* based their opinions on comparisons that were *not* conducted side-by-side. One expert testified an ordinary observer would be deceived after seeing the patented design at one end of a table and the accused design at the other end (another used the term “counter” rather than table).<sup>7</sup> Another testified that “[t]he patterns are substantially different, but ordinary purchasers, seeing them apart, would mistake one for the other.”<sup>8</sup> Further, the *Gorham* opinion specifically cites expert testimony that “seven out of ten customers who buy silverware would consider them the same.”<sup>9</sup> This excerpt is

drawn from the testimony of Martin Smith, merchant jeweler dealing in silver spoons and forks for ten years, that “[i]n my judgment, if the White pattern were placed in a store different from that in which they had before seen the cottage pattern, seven out of ten customers who buy silverware, would consider it the same pattern.”<sup>10</sup> (emphasis added). In light of this *Gorham* testimony, the correctness of the statement in *Crocs* that “[t]he proper comparison requires a side-by-side view of the ... patent design and the accused products”<sup>11</sup> is called into question.

The *Egyptian Goddess* opinion appears to suggest a two-step analysis where the court first compares the patented and accused designs to determine if the designs are “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, as required by *Gorham*.”<sup>12</sup> To be sure, designs may be so different in appearance that any reference to the prior art in an infringement analysis is unnecessary. However, such a separate first step appears not to have support in Supreme Court precedent and appears to be inconsistent with the Federal Circuit’s own holding that “the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed.”<sup>13</sup> Since the ordinary observer test is the sole test for infringement, and an ordinary observer is necessarily familiar with all relevant prior art designs, it should follow that any comparison of the patented and accused designs necessarily must be done in light of the prior art.

An initial side-by-side comparison without review of the prior art also may adversely influence the observer’s ability to make judgments concerning the patented and accused designs under the ordinary observer test.<sup>14</sup> In such an initial comparison, the observer will not have the mindset of an ordinary observer familiar with the prior art. As the courts have recognized, familiarity with the prior art affects the way an ordinary observer perceives the similarities and differences between designs. Further, the observer in such a first step will be looking carefully and specifically for similarities and differences in two designs laid side by side. But this is not what an ordinary observer does. Once such a comparison is made, the mind of the observer has been imprinted with a visual experience that an ordinary observer by defini-

tion does not have, and that may affect the observer’s ability, either consciously or not, to view and compare the designs later under the ordinary observer test.

The ordinary observer test should be applied in a comprehensive manner. In *Egyptian Goddess*, the court affirmed a summary judgment of non-infringement based largely on an analysis of an expert declaration drafted before the law was changed. The court reasoned that although the expert declared the patented and accused nail buffers were similar because both had square cross sections and multiple raised buffer pads, the expert could just as easily have said that a prior art buffer triangular in cross section (the Nailco buffer) “‘is like the accused design because both designs have a hollow tube, have multiple rectangular sides with raised rectangular pads mounted on each side that do not cover the corners of the tube,’ in which case the Nailco prior art buffer would be seen to closely resemble the accused design.”<sup>15</sup> This analysis equates the visual impact of a square versus triangular cross section with the visual impact of four versus three buffer pads without any effort to determine whether one may be “more impressive to the eye” than the other. The infringement analysis would have been more complete had this additional aspect been considered.

In the recent case of *Richardson v. Stanley Works*,<sup>16</sup> the Federal Circuit stated “[t]he ordinary observer test similarly applies in cases where the patented design incorporates numerous functional elements.”<sup>17</sup> A design element is “functional” when it is dictated by functional considerations only. Functional aspects of a design are not considered to be ornamental and protectable under design patent law. The hypothetical ordinary observer is deemed capable of ignoring the functional aspects of a design without eliminating the functional element entirely.<sup>18</sup>

As mentioned in *Egyptian Goddess*, a useful practical guide for determining infringement is whether the accused design differs more widely from the patented design than the patented design differs from the prior art. If so, infringement likely does not exist. This practical guide makes sense. Since a hypothetical ordinary observer is able to distinguish a patented design from the prior art, if the differences between the accused design and the patented design are greater than the differences between the patented design and the prior art, then the ordinary observer also is able to distinguish

between the accused and patented designs. This practical guide can help identify cases where summary judgment of non-infringement may be appropriate. However, it does not help particularly when the accused design is closer to the patented design than the accused design is to the prior art, but still different enough to trigger an initial subjective judgment of non-infringement in the court’s mind. For this situation, a greater set of comparative analytical tools is needed.

Fortunately, recent case law has begun to fill this need, and is developing more effective and objective ways to compare the overall visual effects of the patented and accused designs. In *Crocs, Inc. v. ITC*,<sup>19</sup> a case involving footwear, the court emphasized the importance of “focal points” and “visual themes.” The court stated “[m]ultiple major design lines and curves converge at [the point where the strap attaches to the base] creating a focal point attracting the eye of the ordinary observer when viewing the overall effect of the design” and “[a]nother overall effect of the design is a visual theme of rounded curves and ellipses throughout the design ...”<sup>20</sup> The court found that both the patented and accused designs had these overall visual effects and held that infringement existed.

This approach appears to be consistent with how the mind of an ordinary observer works when designs are being viewed and compared against designs previously viewed and held in the mind. Additional development would be beneficial as well - and the field of visual science may be helpful in this regard. In their article *Configuration Protection Harmonized*, coauthors Jerre B. Swann and Michael J. Tarr state “[a] remarkable feature of the history of design protection is that it has evolved largely without resort to empirically verified models of how consumers react to configurations generally - it has proceeded as if there is no body of learning of how consumers perceptually encode and cognitively process design information.”<sup>21</sup> The authors state “[i]n fact, there is a vast amount of such learning, [footnote omitted] ranging from the elementary to the complex.”<sup>22</sup> Some examples given are that consumers “prefer the simplest valid interpretation of a configuration,” “have a bias to perceive objects as coherent wholes, rather than as separable parts,” “tend to regularize, not particularize,” and “do not carry design details in memory.”<sup>23</sup> Additional potentially relevant visual science concepts are

cue redundancy (multiple differences in designs), meaningfulness (how important particular design components are to the observer), interference (confusion due to the memory of other related visual patterns), and inference (the difficulty of distinguishing between what is remembered and what is inferred).<sup>24</sup>

Finally, in addition to the development of objective “entire design” comparative principles and visual science concepts, design patent law may find it beneficial to borrow from comparative techniques used by other areas of intellectual property law. For example, in utility patent law, the concepts of “known interchangeability”<sup>25</sup> and hypothetical claim construction<sup>26</sup> have been useful comparative tools.<sup>27</sup> In trademark law, a non-exclusive list of factors is used to determine the likelihood of confusion between two marks.<sup>28</sup> Some of these factors already are being used in the design patent infringement analysis, such as “degree of similarity,”<sup>29</sup> “degree of care,”<sup>30</sup> “actual confusion,”<sup>31</sup> and “identity of purchasers.”<sup>32</sup> Other factors may be useful as well.<sup>33</sup>

*Egyptian Goddess* and its progeny are building a comparative analytical framework to replace the flawed “point of novelty” test. The goal of the emerging framework is to make determination of design patent infringement more objective and predictable – for inventors, businessmen, lawyers, and judges alike. At present, the test appears to remain too subjective and unpredictable. Concepts from visual science and comparative techniques from related areas of law may hold promise for further refining the test. And with the demise of the point of novelty approach, the ordinary observer test now is free to benefit from further keen judicial insight and creative legal argument – which, after all, may be the two best developmental tools of all.

## ENDNOTES

1. 81 U.S. 511 (1871).
2. The issue of determining what is relevant prior art will be addressed in a future column.
3. 543 F.3d 665 (Fed. Cir. 2008).
4. *Id.* at 677, 678 (Fed. Cir. 2008).
5. *Id.* at 676.
6. *Id.*
7. 81 U.S. 511 (prior history).
8. *Id.*
9. 81 U.S. at 530.
10. 81 U.S. 511 (prior history).
11. *Crocs, Inc. v. ITC*, 598 F.3d 1294, 1304 (Fed. Cir. 2010).
12. 543 F.3d at 678.
13. *Id.* (emphasis added).
14. As a practical matter, a plaintiff has the ability to produce prior art designs in the initial pleadings that will give a court the proper mental frame of reference.
15. 543 F.3d at 682.
16. 597 F.3d 1288 (Fed. Cir. 2010).
17. *Id.* at 1295.
18. The topic of functionality in design patent law will be the subject of a future column.
19. 598 F.3d 1294 (Fed. Cir. 2010).
20. *Id.* at 1306.
21. 94 Trademark Rep. 1182, 1190 (2004).
22. *Id.*
23. *Id.* at 1190-1192.
24. See Nickerson and Adams, *Long-Term Memory for a Common Object*, *Cognitive Psychology* 287-307 (1979). The topic of visual science and design patent law will be the subject of a future column.
25. See *Abraxis Bioscience, Inc. v. Mayne Pharma Inc.*, 467 F.3d 1370, 1382 (Fed. Cir. 2006).
26. See *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677 (Fed. Cir. 1990).
27. It appears a number of district courts already are considering “known interchangeability” as a factor to be considered in design patent infringement analysis. See *Rosco, Inc. v. Mirror Lite Co.*, 2003 U.S. Dist. LEXIS 26209 (E.D.N.Y. July 8, 2003), reversed on other grounds, *Rosco, Inc. v. Mirror Lite Co.*, 120 Fed. Appx. 832 (Fed. Cir. 2005). (“Plaintiff failed to prove at trial that any of the ornamental aspects of the accused products are known to be interchangeable with those of the claimed design.”); *Victus, Ltd. v. Collezione Europa U.S.A.*, 1998 U.S. Dist. LEXIS 14230, footnote 3 (M.D.N.C. Aug. 3, 1998) (If prosecution history estoppel did not apply to the design patent, it may have been relevant that glass and wood tabletops were considered interchangeable within the industry).
28. See, e.g., *Scott Fetzer Co. v. House of Vacuums, Inc.*, 381 F.3d 477, 484, 485 (5th Cir. Tex. 2004).
29. See *Egyptian Goddess*, 543 F.3d at 683.
30. See *Braun, Inc. v. Dynamics Corp. of America*, 975 F.2d 815 (Fed. Cir. 1992).
31. See *OddzOn Prods. v. Just Toys*, 122 F.3d 1396, 1406, 1407 (Fed. Cir. 1997).
32. An ordinary observer is the purchaser of the patented design and not necessarily the purchaser of the finished product. See *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1324 (Fed. Cir. 2007).
33. Although the Federal Circuit has cautioned against using trademark analysis in a design patent infringement determination due to the fundamental differences between trademarks and design patents, see *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986), it seems worth the effort to explore whether other factors might further contribute to the objectiveness and predictability of the design patent infringement test. The consideration of whether utility patent and trademark law comparative concepts may be helpful in the design patent context will be the subject of a future column.