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## **Design Patent Litigation and Procurement** ***Post-Egyptian Goddess***

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**Design Patent Litigation and Procurement Post-*Egyptian Goddess***

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## I. Introduction<sup>1</sup>

The Federal Circuit's decision in *Egyptian Goddess v. Swisa* to eliminate the "point of novelty" element of design patent infringement proof impacts the way in which practitioners procure and litigate design patents. The Federal Circuit's decision also included other elements that will impact the way in which practitioners procure and litigate patents. This paper examines both design patent procurement and litigation issues post-*Egyptian Goddess*. First, this paper discusses relevant case law following *Egyptian Goddess*, including *Egyptian Goddess*, other relevant Federal Circuit cases following *Egyptian Goddess*, and subsequent district court cases citing *Egyptian Goddess*. Next, this paper offers design patent litigation strategies to litigators post-*Egyptian Goddess*. Lastly, this paper offers design patent prosecution and procurement strategies to practitioners following *Egyptian Goddess*.

## II. Background – Relevant Case Law

### A. *Egyptian Goddess*

On September 22, 2008, the Federal Circuit issued its first *en banc* decision in a design patent case, *Egyptian Goddess, Inc. v. Swisa, Inc.*<sup>2</sup> *Egyptian Goddess* represents one of the most important decisions for design patent prosecution and litigation.<sup>3</sup> The Federal Circuit's decision addresses three important issues that have and will continue to influence the landscape of design patents. First, the Federal Circuit eliminated the "point of novelty" test<sup>4</sup> thereby making the "ordinary observer" test the only test required to prove design patent infringement.<sup>5</sup> Second, the Federal Circuit held that district courts are not required to provide verbal or written claim constructions in a design patent case.<sup>6</sup> Third, the Federal Circuit provided procedural guidance on how prior art may be used in claim construction and in the "ordinary observer" test.<sup>7</sup>

#### i. Elimination of the Point of Novelty Test

In *Egyptian Goddess*, the Federal Circuit defined the legal standard for district courts when evaluating design patent infringement.<sup>8</sup> The court held "the 'point of novelty' test should no longer be used in the analysis of a claim of design patent infringement."<sup>9</sup> While eliminating the point of novelty test, the court also held "that the 'ordinary observer' test should be the sole

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<sup>2</sup> 543 F.3d 665 (Fed. Cir. 2008).

<sup>3</sup> Carani, Christopher V., *Design Law and Footwear: Landmark Case Fundamentally Alters Design Patent Enforcement*, SHOE RETAILING TODAY, July-Aug. 2009, at 26-27.

<sup>4</sup> *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (defining the point of novelty test as "even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art").

<sup>5</sup> *Egyptian Goddess*, 543 F.3d at 678.

<sup>6</sup> *Id.* at 679.

<sup>7</sup> *Id.* at 678.

<sup>8</sup> *Id.* at 668 ("[T]he appropriate legal standard to be used in assessing claims of design patent infringement.").

<sup>9</sup> *Id.* at 678.

test for determining whether a design patent has been infringed.”<sup>10</sup> To prove design patent infringement under the “ordinary observer” test, in *Gorham Manufacturing, Inc. v. White*,<sup>11</sup> the Supreme Court held that:

[I]f, 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 as observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.<sup>12</sup>

## ii. Verbal/Written Claim Construction Not Necessary

In addition to eliminating the point of novelty test and essentially simplifying the proof of design patent infringement, the Federal Circuit also simplified design patent claim construction. The Federal Circuit in *Egyptian Goddess* noted that although trial courts have a duty to conduct claim construction in design patent cases as in utility patent cases, they need “not attempt to provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents.”<sup>13</sup> The court reasoned that “[g]iven the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.”<sup>14</sup> The court further stated that a district court’s decision on the level of detail used in describing a claimed design “is a matter within the court’s discretion.”<sup>15</sup> However, the court cautioned trial courts that inherent risks may exist associated with providing a detailed description for design patent claim construction.<sup>16</sup> These risks may include “the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.”<sup>17</sup>

Apart from providing a verbal description of the design, the Federal Circuit stated that a trial court may guide the jury on a number of other issues that bear on the scope of the claim.<sup>18</sup> Those matters may include: describing the role of design patent drafting conventions, such as broken lines; assessing and describing the effect of representations made during prosecution; and “distinguishing between those features of the claimed design that are ornamental and those that are purely functional.”<sup>19</sup> However, there is substantial debate regarding whether *Egyptian*

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<sup>10</sup> *Id.*

<sup>11</sup> 81 U.S. 511 (1871).

<sup>12</sup> *Id.* at 528. See also *Egyptian Goddess*, 543 F.3d at 681.

<sup>13</sup> *Egyptian Goddess*, 543 F.3d at 679.

<sup>14</sup> *Id.*

<sup>15</sup> *Id.* One significant question this leaves open is how does a patent owner establish prejudice when a court, in its “discretion,” translates the claim into words?

<sup>16</sup> *Id.* at 679-80.

<sup>17</sup> *Id.* at 680.

<sup>18</sup> *Id.*

<sup>19</sup> *Id.*

*Goddess*' reference to functionality was obiter dicta or now is within district courts' discretion to discuss during claim construction.<sup>20</sup>

### iii. Prior Art

In addition to eliminating the point of novelty test for proving design patent infringement, the Federal Circuit also provided procedural guidance, albeit limited guidance, on how prior art can be used in the claim construction process. The Federal Circuit stated that since *Gorham* the "ordinary observer" test has always been conducted "in light of the prior art"<sup>21</sup> or "with reference to prior art"<sup>22</sup> or "in the context of the prior art."<sup>23</sup> In particular, the Federal Circuit said the accused infringer bears the burden of prior art production, because it is motivated to point out close prior art.<sup>24</sup> However, the patentee still bears the burden of proof of infringement.<sup>25</sup> Also, the court said that if the patented design and accused products are so dissimilar, then courts may not need to look at the prior art at all.<sup>26</sup>

## B. Other Relevant Federal Circuit Cases Following *Egyptian Goddess*

Two recent post-*Egyptian Goddess* Federal Circuit decisions have further defined design patent landscape -- *Titan Tire Corp. v. Case New Holland, Inc.*<sup>27</sup> and *International Seaway Trading Corp. v. Walgreens Corp.*<sup>28</sup>

In *Titan Tire*, the Federal Circuit addressed the issue of whether eliminating the point of novelty test in *Egyptian Goddess* should affect the design patent invalidity analysis under 35 U.S.C. § 103. However, the Federal Circuit determined that "[w]e need not decide that issue to decide this case."<sup>29</sup> In not deciding this issue, the court withheld a definitive holding on the

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<sup>20</sup> *Id.* See also *Depaoli v. Daisy Mfg. Co.*, 2009 WL 2145721 at \*3 (D. Mass. July 14, 2009); Perry J. Saidman, *Functionality and the Test for Design Patent Infringement: Rarely the Twain Should Meet*, 77 PAT., TRADEMARK & COPYRIGHT J. 201 (2008); Frederick Linton Medlin, *Recent Decision Reads Egyptian Goddess Correctly: Functionality is Critical to Design Patent Analysis*, 78 PAT., TRADEMARK & COPYRIGHT J. 17 (2009); Perry J. Saidman, *The Ornamental/Functional Dichotomy in Design Patent Law is Akin to the Idea/Expression Dichotomy in Copyright Law*, 78 PAT., TRADEMARK & COPYRIGHT J. 199 (2009); Nathan Pollard, *AIPLA Panelists Discuss Design Protection, and Egyptian Goddess Impact*, 78 PAT., TRADEMARK & COPYRIGHT J. 744 (2009).

<sup>21</sup> *Egyptian Goddess*, 543 F.3d at 669, 674, 676, 677, 678, and 683.

<sup>22</sup> *Id.* at 677.

<sup>23</sup> *Id.* at 675 and 683.

<sup>24</sup> *Id.* at 678 ("However, if the accused infringer elects to rely on the comparison prior art as part of its defense against the claim of infringement, the burden of production of that prior art is on the accused infringer.").

<sup>25</sup> *Id.* ("Thus, as is always the case, the burden of proof as to infringement remains on the patentee.").

<sup>26</sup> *Id.* ("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.").

<sup>27</sup> 566 F.3d 1372 (Fed. Cir. 2009). Patentee, Titan Tire, appealed a denied motion for a preliminary injunction. *Id.* at 1374.

<sup>28</sup> 2009 WL 4842608 (Fed. Cir. Dec. 17, 2009). Patentee, International Seaway Trading, appealed a finding of invalidity for anticipation that was based solely on the "ordinary observer" test without applying the point of novelty test. *Id.* at \*1.

<sup>29</sup> *Titan Tire*, 566 F.3d at 1384. Based on the procedural posture and date of the trial court's decision of this case, the court held the "trial court correctly looked to our existing precedents, in particular *Durling*, in rendering its judgment," and based on the court's review of the evidence, the trial court did not abuse its discretion. *Id.*

elimination of the point of novelty test in an obviousness analysis. The court concluded by stating that “even though this court has reestablished the ordinary observer test as the controlling doctrine applicable to design patent infringement, it is not clear to what extent, if any, the doctrine applicable to obviousness should be modified to conform to the approach adopted by this court in *Egyptian Goddess*.”<sup>30</sup>

Following *Titan Tire*, in *International Seaway*, the Federal Circuit similarly confronted the issue of whether eliminating the point of novelty test in *Egyptian Goddess* affects the design patent anticipation invalidity analysis under 35 U.S.C. § 102. In deciding this issue, the Federal Circuit considered whether the anticipation analysis required a change similar to the change *Egyptian Goddess* made to the design patent infringement analysis; namely, using the “ordinary observer” test as the sole test and eliminating the point of novelty test. The Federal Circuit concluded that *Egyptian Goddess* requires a change in the anticipation standard. Specifically, the court concluded that “the ordinary observer test must logically be the sole test for anticipation as well.”<sup>31</sup> With this decision, the court attempted to prevent an inconsistency from developing between the infringement and anticipation analyses by continuing “our well-established practice of maintaining identical tests for infringement and anticipation.”<sup>32</sup>

It is important to note that *International Seaway* only discusses invalidating a design patent by anticipation. The Federal Circuit did not make it clear whether the anticipation analysis from *International Seaway* now applies to obviousness analyses (as discussed in *Titan Tire*).

### C. District Court Cases Citing *Egyptian Goddess*

As of this writing, there have been at least twenty-one separate district court design patent opinions following the *Egyptian Goddess* decision. In twelve of these opinions, district courts provided a claim construction analysis (or *Markman* analysis) of the design patent claims.<sup>33</sup> In four opinions, the district courts simply provided an “ordinary observer” infringement analysis (without including a *Markman*-type claim construction).<sup>34</sup> In five other

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<sup>30</sup> *Id.* at 1384.

<sup>31</sup> *Int’l Seaway*, 2009 WL 4842608 at \*3-4.

<sup>32</sup> *Id.* at \*4.

<sup>33</sup> See *Hoffman v. Impact Confections, Inc.*, No. 08cv1597 BTM(NLS) (S.D. Cal. Jan. 6, 2010); *Hoodlums Welding Hoods, LLC v. Redtail Int’l, Inc.*, 2009 WL 3617479 (E.D. Mo. Oct. 28, 2009); *Unique Indus., Inc. v. 965207 Alberta, Ltd.*, 2009 WL 2185555 (D. D.C. July 22, 2009); *Depaoli v. Daisy Mfg. Co.*, 2009 WL 2145721 (D. Mass. July 14, 2009); *Shop\*TV v. Bed Bath & Beyond, Inc.*, 2009 WL 1965494 (D. Colo. July 8, 2009); *Motorola, Inc. v. Vtech Comms., Inc.*, 2009 WL 2026317 (E.D. Tex. July 6, 2009); *Dexas Int’l, LTD v. Tung Yung Int’l (USA) Inc.*, 2009 WL 838174 (E.D. Tex. Feb. 25, 2009); *Dexas Int’l, LTD v. Office Max Inc.*, 2009 WL 252164 (E.D. Tex. Jan. 30, 2009); *Mondo Polymers Techs., Inc. v. Monroeville Indus. Moldings, Inc.*, 2009 WL 230123 (S.D. Ohio Jan. 30, 2009); *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 599 F. Supp. 2d 1307 (S.D. Fla. 2009); *Degelman Indus., LTD v. Pro-Tech Welding and Fabrication, Inc.*, 630 F. Supp. 2d 273 (W.D.N.Y. 2008); *Trover Group, Inc. v. Diebold Inc.*, 2008 WL 5771322 (E.D. Tex. Oct. 21, 2008).

<sup>34</sup> See *Mondo Polymers Techs., Inc. v. Monroeville Indus. Moldings, Inc.*, 2009 WL 3698432 (S.D. Ohio Nov. 3, 2009); *Kellogg v. NIKE, Inc.*, 2009 WL 316559 (D. Neb. Sept. 30, 2009); *Chef’n Corp. v. Trudeau Corp.*, 2009 WL 1564229 (W.D. Wash. June 4, 2009); *Rainworks Ltd. v. Mill-Rose Co.*, 622 F. Supp. 2d 650 (N.D. Ohio 2009).

opinions, the district courts provided both a claim construction analysis and an “ordinary observer” infringement analysis.<sup>35</sup>

Eight of the nine “ordinary observer” decisions were decisions on summary judgment motions. Seven of those eight district courts granted the defendant’s motion for summary judgment of non-infringement, and only one of the district courts denied the defendant’s motion for summary judgment of non-infringement. When conducting the “ordinary observer” analysis, many of the district courts utilized a two level analysis: “a level-one or ‘threshold’ analysis to determine if comparison to the prior art is even necessary, and a second-level analysis that accounts for prior art in less obvious cases.”<sup>36</sup> The “threshold” analysis considers whether the accused and claimed designs appear “substantially similar,” while the second level analysis compares the claimed and accused designs with the prior art.<sup>37</sup> However, some of the district courts, even when finding the claimed and accused designs are not substantially similar, still compared the prior art to the claimed and accused designs stating that “references to the prior art may help to inform a full analysis.”<sup>38</sup> See the below table for a summary of these cases.

**Infringement Analysis – District Court Summary**

Court	Date	Parties	D Motion for S.J. Granted?	Subst. Similar?	Use Prior Art
S.D. Ohio	11/3/2009	<i>Mondo Polymers Techns., Inc. v. v</i>	No	Yes	No – did not analyze prior art
S.D.N.Y.	10/1/2009	<i>Wing Shing Prods. (BVI) Co. v. Sunbeam Prods., Inc.</i>	Yes	No	Still looks to prior art
W.D. Wash.	6/4/2009	<i>Chef'n Corp. v. Trudeau Corp.</i>	Yes	No	-
D. Ariz	4/6/2009	<i>Richardson v. Stanley Works, Inc.</i>	Yes	No	-
E.D.N.Y	3/31/2009	<i>HR U.S. LLC v. Mizco Int'l, Inc.</i>	Yes	No	Not needed
N.D. Ohio	3/31/2009	<i>Rainworks Ltd. v. Mill-Rose Co.</i>	Yes	No	-
N.D. Tex	3/16/2009	<i>Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.</i>	Yes	No	Still looks to prior art
D. Utah	11/4/2008	<i>Arc'teryx Equip., Inc. v. Westcomb Outerwear, Inc.</i>	Yes	No	Still looks to prior art

<sup>35</sup> See *Wing Shing Prods. v. Sunbeam Prods., Inc.*, 2009 WL 3151195 (S.D.N.Y Oct. 1, 2009); *HR U.S. LLC v. Mizco Int'l, Inc.*, 2009 WL 890550 (E.D.N.Y. March 31, 2009); *Richardson v. Stanley Works, Inc.*, 610 F. Supp. 2d 1046 (D. Ariz. 2009); *Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.*, 2009 WL 691594 (N.D. Tex. Mar. 16, 2009); *Arc'teryx Equip., Inc. v. Westcomb Outerwear, Inc.*, 2008 WL 4838141 (D. Utah Nov. 4, 2008).

<sup>36</sup> *Wing Shing Prods.*, 2009 WL 3151195 at \*4.

<sup>37</sup> *Id.* See also *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008).

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 questions 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.

*Id.*; *Mizco Int'l*, 2009 WL 890550 at \*10.

<sup>38</sup> *Minka Lighting*, 2009 WL 691594 at \*8. See also *Egyptian Goddess*, 543 F.3d at 678 (stating that a full analysis for the “ordinary observer” infringement analysis may include “comparison of the claimed and accused designs with the prior art”).



For the claim construction (*Markman* analysis) opinions, twelve of the seventeen district courts followed the Federal Circuit’s preferable course of not attempting to construe a design patent claim by providing a detailed verbal description of the claimed design. Each of these district courts generally decided the claim construction to be: “the ornamental design for a \_\_\_\_\_, as shown in figures \_\_ through \_\_ of the \_\_\_\_\_ patent.”<sup>39</sup> Two of the district courts decided to use a previously determined detailed description (determined prior to the *Egyptian Goddess* decision). The three remaining district courts decided it was necessary, and within their discretion, to provide a detailed verbal discussion for the claim construction. See the below table for a summary of these cases.

**Claim Construction Analysis – District Court Summary**

Court	Date	Parties	No Detailed CC	Detailed CC
S.D. Cal.	1/6/2010	<i>Hoffman v. Impact Confections, Inc.</i>	Yes	
D. Utah	11/4/2008	<i>Arc'teryx Equip., Inc. v. Westcomb Outerwear, Inc.</i>	Yes	-
E.D. Mo.	10/28/2009	<i>Hoodlums Welding Hoods, LLC v. Redtail Int'l, Inc.</i>	Yes	-
S.D. N.Y.	10/1/2009	<i>Wing Shing Prods. v. Sunbeam Prods., Inc.</i>	Yes	-
D.D.C.	7/22/2009	<i>Unique Indus., Inc. v.</i>	No	Minimal
D. Mass	7/14/2009	<i>Depaoli v. Daisy Mfg Co., Inc.</i>	Yes	-
D. Colo.	7/8/2009	<i>Shop*TV, Inc. v. Bed Bath &amp; Beyond, Inc.</i>	Yes	-
E.D. Tex	7/6/2009	<i>Motorola, Inc. v. Vtech Comms., Inc.</i>	Yes	-
D. Ariz	4/6/2009	<i>Richardson v. Stanley Works, Inc.</i>	No	Yes
E.D.N.Y	3/31/2009	<i>HR U.S. LLC v. Mizco Int'l, Inc.</i>	Yes	-
N.D. Tex	3/16/2009	<i>Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.</i>	No	Used previous description
E.D. Tex	2/25/2009	<i>Dexas Int'l, LTD v. Tung Yung Int'l (USA) Inc.</i>	No	Used previous description
E.D. Tex	1/30/2009	<i>Dexas Int'l, LTD v. Office Max Inc</i>	Yes	-
S.D. Ohio	1/30/2009	<i>Mondo Polymers Techs., Inc. v. Monroeville Indus. Moldings, Inc.</i>	Yes	-
S.D. Fla	1/22/2009	<i>Int'l Seaway Trading Corp. v. Walgreens Corp.</i>	No	Yes
W.D.N.Y.	12/23/2008	<i>Degelman Indus., LTD. v. Pro-Tech Welding and Fabrication, Inc.</i>	Yes	-
E.D. Tex	10/21/2008	<i>Trover Group, Inc. v. Diebold Inc.</i>	Yes	-

Additionally, for claim construction analysis opinions, the district courts have had differing views on what precisely the Federal Circuit meant regarding functional design elements and/or prosecution history and whether they are “fair game” in the claim construction process. Two district courts have specifically addressed this issue.

In *Richardson v. Stanley Works, Inc.*,<sup>40</sup> the District Court for the District of Arizona quoted the *OddzOn* Federal Circuit decision stating: “[w]here a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the

<sup>39</sup> See *Wing Shing Prods.*, 2009 WL 3151195 at \*2; *Hoodlums Welding Hoods*, 2009 WL 3617479 at \*13.

<sup>40</sup> 610 F. Supp. 2d 1046 (D. Ariz. 2009).



non-functional aspects of the design as shown in the patent.”<sup>41</sup> This statement from *OddzOn*, which was quoted in *Egyptian Goddess*, was the main focus of the district court’s claim construction analysis. In fact, the *Richardson* court did not even mention *Egyptian Goddess*’ preferred claim construction approach, or the risks associated with including a detailed verbal description. The *Richardson* court removed the non-functional aspects from the claim construction and stated that the design patent protects the ornamental aspects of the design.<sup>42</sup>

In contrast to *Richardson*, in *Depaoli v. Daisy Manufacturing Co.*,<sup>43</sup> the District Court for the District of Massachusetts held that claim construction was not the appropriate stage for the court to resolve the limiting effect of prosecution history and functionality on the scope of a design patent’s claim.<sup>44</sup> The defendant in *Depaoli*, Daisy Manufacturing, contended “that prosecution history and functionality issues should be incorporated into the claim construction adopted by the court at this stage, arguing that such an approach would best assist the fact finder in determining infringement.”<sup>45</sup> However, the court did not agree, stating:

To provide the jury with a verbalized construction of the ‘840 design patent’s [claim] which directs their attention to the two illustrations in the patent and then describes *only* those elements that are implicated by prosecution history and functionality would place undue emphasis on those few elements. This is precisely the danger against the *Egyptian Goddess* court cautioned.<sup>46</sup>

The district court concluded by stating: “to the extent the scope of the claim must be limited by prosecution history or functionality, I will address those issues definitively if and when they are raised at some later stage in these proceedings, such as resolution of motions for summary judgment or as part of the jury instructions at trial.”<sup>47</sup>

### III. Litigation Strategies

Because *Egyptian Goddess* has eliminated the point of novelty test and has arguably simplified claim construction, litigators will have to use different strategies when litigating design patent infringement cases. The below section discusses three potential strategies

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<sup>41</sup> *Id.* at 1049 (quoting *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)).

<sup>42</sup> *Richardson*, 610 F. Supp. 2d at 1049-50. The court stated that the design: “incorporates four primarily utilitarian elements: the handle, the hammer-head, the jaw, and the cross bow. The overall configuration of these four elements is dictated by the functional purpose of the tool and therefore is not protected by his design patent.” *Id.* at 1050. In addition, the court stated: “the ‘167 patent does not protect the configuration of the handle, hammer-head, jaw, and crow-bar utilized in the Stepclaw.” *Id.* The court concluded stating:

That basic, wrench-like design is functional and therefore not protected by the ‘167 patent. The ‘167 patent does protect the ornamental aspects of Richardson’s design, which include among other things, the standard shape of the hammer-head, the diamond-shaped flare of the crow-bar and the top of the jaw, the rounded neck, the orientation of the crowbar relative to the head of the tool, and the plain, undecorated handle.

*Id.*

<sup>43</sup> 2009 WL 2145721 (D. Mass. July 14, 2009).

<sup>44</sup> *Id.* at \*5.

<sup>45</sup> *Id.* at \*3.

<sup>46</sup> *Id.* at \*5.

<sup>47</sup> *Id.*

attorneys and commentators suggest for design patent infringement cases following the *Egyptian Goddess*: 1) use prior art as a defense to infringement allegations, 2) use prior art to prove infringement, and 3) prepare jury instructions early in the litigation.

### A. Use Prior Art as a Defense to Infringement Allegations<sup>48</sup>

Notwithstanding the Federal Circuit's rejection of the point of novelty test, prior art may still be relevant in the design patent infringement analysis.<sup>49</sup> On the surface, the Federal Circuit appears to have strengthened the coverage of design patents by reducing the test for infringement down to a single test: Is the accused design substantially similar to the patented design in the eye of the "ordinary observer"? At least one commentator suggests the Federal Circuit, however, may have also complicated that single test by requiring two levels of analysis.<sup>50</sup> The first level analysis and "threshold" question analyzes whether the accused and claimed designs appear substantially similar, while the second level analysis compares the claimed and accused designs with the prior art.<sup>51</sup>

Before the Federal Circuit decided *Egyptian Goddess*, accused infringers often focused their defense on requiring the patent holder to specify its claimed points of novelty.<sup>52</sup> Then, to support their non-infringement contentions, the accused party would either identify prior art that revealed those points of novelty, or show how the accused product did not have them.<sup>53</sup> Many cases were resolved on summary judgment.

For example, a patent holder specifies points of novelty A, B, and C with the accused infringer utilizing prior art that shows elements A, B, and C. In this case, the accused infringer could obtain summary judgment by proving that the patent holder does not satisfy the point of novelty test as a matter of law because the claimed design had no point of novelty.<sup>54</sup>

In *Egyptian Goddess*, the Federal Circuit made it clear that the preferable way to deal with overly broad infringement claims is by "relying on the ordinary observer test, conducted in light of the prior art."<sup>55</sup> The court placed the burden of producing prior art on the accused infringer. Therefore, an accused infringer should still search for prior art and produce it during

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<sup>48</sup> Gollwitzer, Arthur III., *Has the Federal Circuit Strengthened Design Patent Protection?*, 15 NO. 2 INTELL. PROP. STRATEGIST (2008).

<sup>49</sup> *Id.*

<sup>50</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008).

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 questions 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.

*Id.*

<sup>51</sup> *Id.* See also *HR U.S. LLC v. Mizco Int'l, Inc.*, 2009 WL 890550 at \*10 (E.D.N.Y. Mar. 31, 2009); *Wing Shing Prods. v. Sunbeam Prods., Inc.*, 2009 WL 3151195 at \*4 (S.D.N.Y. Oct. 1, 2009).

<sup>52</sup> Gollwitzer, *supra* note 48.

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> *Egyptian Goddess*, 543 F.3d at 678.

discovery. Thereafter, the patent owner bears the burden of proving infringement under the “ordinary observer” test, and must do so in light of the prior art.

Though the court said “in light of the prior art,”<sup>56</sup> “with reference to prior art,”<sup>57</sup> and “in the context of prior art,”<sup>58</sup> it expressly left it up to the district courts to develop what this standard means. The Federal Circuit did not clearly articulate how prior art should be used. Some district courts have utilized different standards of using the prior art with the “ordinary observer” test.

For example, the District Court for the District of Utah in *Arc'teryx Equipment v. Westcoubt Outerwear*, used what appears to be a sliding scale to utilize the prior art, finding infringement if the accused design is closer to the patented design than it is to the prior art.<sup>59</sup> In *Minka Lighting v. Maxim Lighting International*, the District Court for the Northern District of Texas used the prior art by comparing the accused product to the patented design to “an ordinary observer aware of the great number of similar prior art designs.”<sup>60</sup> Lastly, in *Wing Shing Products v. Sunbeam Products*, the District Court for the Southern District of New York discarded the sliding scale test by stating that “whether the accused device is ‘closer’ to the patented design than to the prior art is not the controlling inquiry.”<sup>61</sup> Instead, the court utilized the prior art by assessing how “the prior art will impact the ordinary observer’s perception of the accused and claimed designs” and held that “no reasonable juror could dispute that an ordinary observer familiar with the Accel [prior art] would not believe the AR 10/12 [accused design] to be the ‘same as’ the ‘585 patent.”<sup>62</sup>

One commentator has observed that obtaining summary judgment based on proving the accused design is practicing the prior art may be more difficult than in the past, because of the inherently factual nature of the “ordinary observer” comparison.<sup>63</sup> Nevertheless, the accused infringer may still use prior art in the non-infringement analysis on summary judgment, or at trial. That is, the accused infringer can use the prior art to attack the patent-in-suit without taking on the required heavy burden of invalidating the patent. In effect, the accused infringer may attempt to prove that their accused design is practicing the prior art. Based on the Federal Circuit’s decision in *Egyptian Goddess*, it now appears that practicing the prior art may be a defense to design patent infringement.<sup>64</sup>

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<sup>56</sup> *Id.* at 669, 674, 676, 677, 678, and 683.

<sup>57</sup> *Id.* at 677.

<sup>58</sup> *Id.* at 675 and 683.

<sup>59</sup> 2008 WL 4838141 at \*3 (D. Utah Nov. 4, 2008) (“The 715 Patent is much closer to the Lowe Alpine Black Ice Jacket in that they both contain one straight and one diagonal section.”).

<sup>60</sup> 2009 WL 691594 at \*7 and \*9 (N.D. Tex. Mar. 16, 2009). Although the court determined that the accused designs and the patents were “readily distinguishable to an ordinary observer,” the court still held that a full analysis “may include a comparison of the claimed and accused designs with the prior art.” *Id.* at \*6. See also *Egyptian Goddess*, 543 F.3d at 678.

<sup>61</sup> 2009 WL 3151195 at \*6 (S.D.N.Y. Oct. 1, 2009).

<sup>62</sup> *Id.* See also *Egyptian Goddess*, 543 F.3d at 676, 678.

<sup>63</sup> Gollwitzer, *supra* note 48.

<sup>64</sup> *Id.* The authors note that while “practicing the prior art” may be a defense to design patent infringement for one patent, if the prior art is a valid patent owned by another, the accused infringer may be liable for infringing another’s patent.

## B. Use Prior Art to Prove Infringement

In addition to using prior art as a defense to infringement allegations, prior art can also be used by the patentee to prove infringement if the facts are correct. *Egyptian Goddess* does not prohibit the patentee from presenting its own prior art for the “ordinary observer” comparison as discussed above. The patentee may use its own prior art to show the overall assimilability between the patented design and the accused design if the prior art is different than both the patented design and the accused design. For example, if the design patent is directed to a lion and the accused device looks like a tiger, and if the closest prior art is an elephant and a giraffe; it may help the patentee to show overall assimilability to put the lion and the tiger next to a giraffe and an elephant.

## C. Prepare Jury Instructions Early in Your Case

In 2009, the Intellectual Property Owner’s Association’s [“IPO”] Design Rights Committee drafted “Proposed Design Patent Model Jury Instructions” in response to the anticipated impact of the *Egyptian Goddess* decision. These proposed model jury instructions may fulfill a need for a set of model design patent jury instructions, which until now, have not existed.<sup>65</sup> These instructions, while not approved by the IPO Board of Directors as of this writing, could be a basis for future model jury instructions for design patents. These jury instructions define infringement as being a “complex test” announced in *Egyptian Goddess*, include “an analysis as the ordinary observer in light of the prior art,”<sup>66</sup> and include three guidelines to assist the jury in comparing the claimed design, accused design, and prior art.<sup>67</sup>

## IV. Prosecution Strategies

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<sup>65</sup> THE INTELLECTUAL PROPERTY OWNERS ASSOCIATION, IPO MODEL DESIGN PATENT JURY INSTRUCTIONS—DRAFT, Appendix, pg. 1 (Revised Nov. 17, 2009).

<sup>66</sup> *Id.* at Appendix, pg. 2. See also *Id.* at Jury Instruction No. 8.3 – Direct Infringement, pg. 25.

To determine infringement, you must compare the overall appearances of the accused design and the claimed design. . . . Before conducting your infringement analysis, you must familiarize yourself with all of the prior art designs that have been brought to your attention in this litigation. In view of this prior art, if you find that, by a preponderance of evidence, the overall appearance of the accused design is substantially the same as the overall appearance of the claimed design, then you must find that the accused design infringes the design patent.

*Id.*

<sup>67</sup> *Id.* The three guidelines include:

1. When the claimed design is visually close to the prior art designs, small differences between the accused design and the claimed design may be important to your analysis as to whether the overall appearance of the accused design is substantially the same as the overall appearance of claimed design.
2. If the accused design includes a particular feature of the claimed design that departs conspicuously from the prior art, you may find the inclusion of that feature important to your analysis as to whether the overall appearance of the accused design is substantially the same as the overall appearance of claimed design.
3. If the accused design is visually closer to the claimed design than it is to the closest prior art, you may find this comparison important to your analysis as to whether the overall appearance of the accused design is substantially the same as the overall appearance of claimed design.

*Id.*

*Egyptian Goddess* not only affects design patent litigation, but also impacts design patent procurement. The below section discusses three proposed strategies to achieve this goal: 1) provide picture claims, 2) utilize portion practice for design patent claims, and 3) claim different design elements using multiple applications.

### A. Provide Picture Claims<sup>68</sup>

One prosecution strategy to consider post-*Egyptian Goddess* is to submit design patent applications with “picture claims.” The phrase “picture claim” is mostly known with utility patent applications as claiming the invention in considerable detail and is used because the Patent and Trademark Office is more likely to allow a detailed utility claim.<sup>69</sup> For design patent applications, picture claiming has a similar meaning by describing an article in increased detail through the use of detailed figures. An applicant may use this approach in design patent claim drafting when the applicant expects or foresees the competitors copying the patented design or product in great detail.<sup>70</sup>

However, excessive detail provided by a picture claim in a design patent could provide design-around options for competitors. In many instances, a competitor may manufacture or sell a product that is a design-around to a detailed picture claim of a design patent. Additionally, providing a picture claim may complicate infringement proofs, particularly if the design is applied to an article that has utilitarian function. To prevent a competitor from providing easy design-arounds and complicating infringement proof, the applicants may present multiple applications with claims covering designs of varying scopes.<sup>71</sup>

### B. Utilize Portion Practice for Design Patent Claims

Practitioners can change the scope of the claim in a design patent by using portion practice as another strategy in light of the *Egyptian Goddess* decision.<sup>72</sup> There are two techniques practitioners can use to present design patents so as to protect a portion of an article.<sup>73</sup> The technique most commonly used to focus a design claim on a portion or portions of a design is the use of dashed (*i.e.*, broken) lines.<sup>74</sup> In particular, a patent applicant may attempt to limit the impact of any prior art on the “ordinary observer” test by using broken lines or phantom lines in the design patent.<sup>75</sup> Applicants may use broken lines to show “environment,” which represents a portion of the design that is not intended to form part of the claimed invention.<sup>76</sup> The applicant should draw distinctive portions of the invention using solid lines, and represent

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<sup>68</sup> Kugler, Bruce A. and Craig W. Mueller, *A Fresh Perspective on Design Patents*, 38 COLO. LAW. 71, (2009).

<sup>69</sup> *Id.* at 75.

<sup>70</sup> *Id.*

<sup>71</sup> *Id.*

<sup>72</sup> Robert S. Katz, *Design Patents*, in DRAFTING PATENTS FOR LITIGATION AND LICENSING 561, 568-69 (Bradley C. Wright, ed., 2008).

<sup>73</sup> *Id.* at 568.

<sup>74</sup> *Id.* at 569.

<sup>75</sup> Juo, James, *Egyptian Goddess: Rebooting Design Patents and Resurrecting Whittman Saddle*, 18 FED. CIRCUIT B.J. 429, 446-47 (2009).

<sup>76</sup> Kugler and Mueller, *supra* note 68 at 75 (citing Manual of Patent Examining Procedure, § 1503.02 (2009)).

portions of the invention not considered part of the claimed design with broken lines.<sup>77</sup> Using broken lines can effectively change the scope of the design patent by excluding unnecessary or extraneous features from the claimed design.<sup>78</sup>

The second technique to further change the scope of a design claim is to omit portions of articles completely.<sup>79</sup> Practitioners should submit figures that show the important ornamental portions of an invention while omitting the less-important and/or novel features.<sup>80</sup> This technique is especially easy and helpful when the portions correspond to views.<sup>81</sup> For example, the back and/or bottom sides of many articles form no part of the aesthetic portion to be protected.<sup>82</sup> In these situations, it is permissible and recommended to merely omit the rear or bottom view.<sup>83</sup> The scope of the design claim will then cover what the figures represent.<sup>84</sup> Use of portion practice by either broken lines or omission can be essential to more accurately focus the drawings and the design claim on the desired regions of an article.<sup>85</sup>

Furthermore, the use of broken lines in a design patent may affect the “ordinary observer” infringement analysis. In the following example proposed by one commentator, Design Patent A and Design Patent B are compared to a hypothetical accused design that contains ornamental features from each design patent.<sup>86</sup>

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<sup>77</sup> Katz, *supra* note 72 at 569. See also Juo, *supra* note 75 at 447; In re Zahn, 617 F.2d 261, 267 (C.C.P.A. 1980). As part of the court’s obligation to construe the claimed invention as a matter of law, a trial court can usefully guide the finder of fact by “describing the role of particular conventions in design patent drafting, such as the role of broken lines.” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (citing 37 C.F.R. § 1.152 (2008)).

<sup>78</sup> Juo, *supra* note 75 at 447 (citing Zahn, 617 F.2d. at 267). See also In re Salmon, 705 F.2d 1579, 1582-83 (Fed. Cir. 1983) (Nichols, J. dissenting) (arguing that drawing “immaterial variations” of a design “in solid, instead of dotted lines” is “a trap for the unwary”); Hanson, Karl G., *Intellectual Property Strategies for Protecting the Looks of a New Product*, 81 J. PAT. & TRADEMARK OFF. SOC’Y 887, 898 (“[E]ach solid line [in the drawings of a design patent] can be another limitation that effectively narrows the scope of the claim.”).

<sup>79</sup> Katz, *supra* note 72 at 569.

<sup>80</sup> Juo, *supra* note 75 at 447.

<sup>81</sup> Katz, *supra* note 72 at 569.

<sup>82</sup> *Id.*

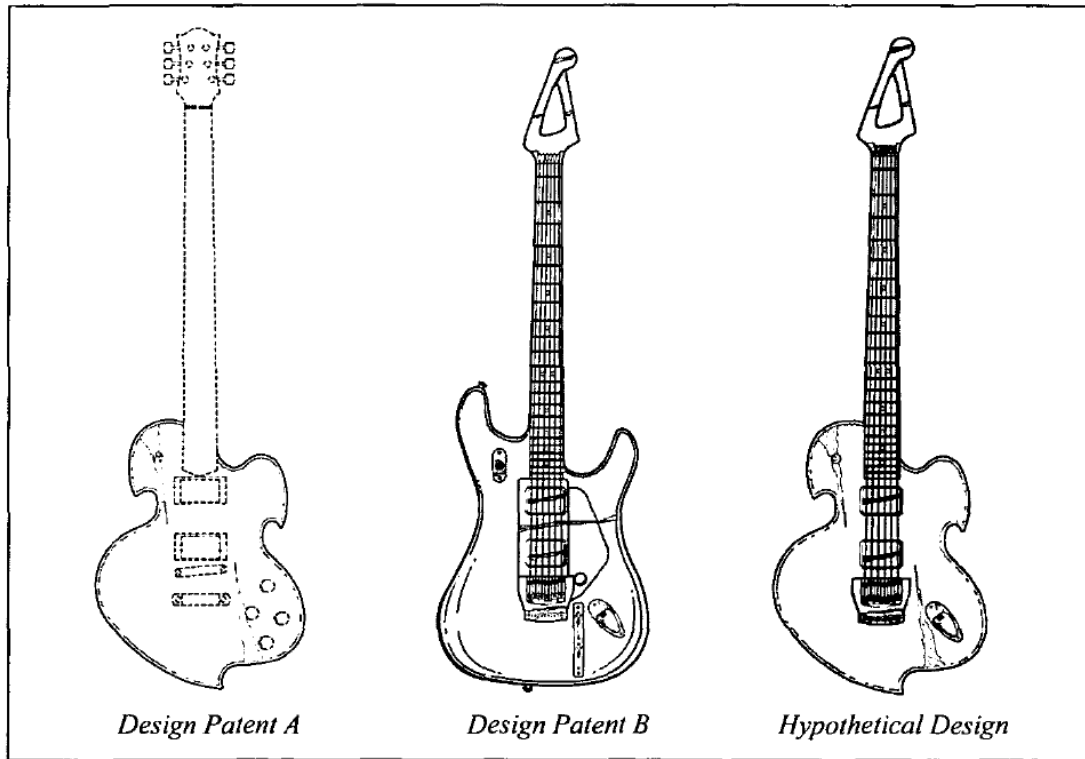
<sup>83</sup> *Id.*

<sup>84</sup> *Id.*

<sup>85</sup> *Id.* at 570.

<sup>86</sup> Juo, *supra* note 75 at 448-49.





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The body of the guitar in Design Patent A contains solid lines, while the neck and headstock contain broken lines. The broken lines indicate that the neck and headstock of the guitar in Design Patent A do not form part of the claimed design. The neck and headstock of the guitar in Design Patent A does not need to be present in the accused design to find infringement. The body of the hypothetical accused design is exactly the same as that of the guitar in Design Patent A. Accordingly, one could make a strong case that the hypothetical accused design infringes Design Patent A.<sup>88</sup>

Alternatively, in Design Patent B, the body, the neck, and the headstock contain solid lines. The entire guitar in Design Patent B contains solid lines with nothing appearing in broken lines, thereby making every illustrated feature part of the claimed design. Therefore, even though the neck and headstock in the hypothetical accused design is the same as that illustrated in Design Patent B, the difference in the guitar body between the two designs may make for a weaker case of infringement. If the guitar body in Design Patent B contained broken lines, then it is probable that the fact finder could find that the guitar body is not part of the claimed design and therefore, the differences between the guitar bodies would not be an infringement issue.<sup>89</sup>

<sup>87</sup> *Id.* at 448.

<sup>88</sup> *Id.* at 448-49.

<sup>89</sup> *Id.* at 449.



### C. Claim Different Design Elements Using Multiple Applications

Another design patent prosecution strategy to consider post-*Egyptian Goddess* is to cover the design with multiple applications containing claims of differing scope.<sup>90</sup> For most innovative or commercially successful designs, one design patent application will prove inadequate.<sup>91</sup> The incentive for potential infringers to copy these designs is high, and the designs require corresponding greater protection by using multiple applications.<sup>92</sup>

For this strategy, the practitioner might file multiple design patent applications with varying degrees of coverage. Simply put, the practitioner might file one application with detailed figures and another application with figures that include broken lines and/or omit features. However, in practice, especially for complex designs, the practitioner may file multiple applications with differing detailed figures showing different important elements of the design. The practitioner may also file multiple applications with differing figures that include different elements having broken lines or different elements omitted. With this strategy, the patent holder would then have a portfolio of design patents for one design concept with varying levels of coverage, thereby strengthening the patent holder's ability to pursue potential infringers.<sup>93</sup>

There are drawbacks and benefits associated with filing multiple applications. One drawback of filing multiple applications is the increased cost associated with preparing additional drawings and figures. Similarly, a drawback of filing multiple applications is the increased cost associated with filing the applications, such as filing fees, etc. One of the benefits to filing multiple applications is to increase and strengthen the coverage of one design concept, thereby giving the patent holder greater protection for the design concept and flexibility to utilize one or more patents against a potential infringer.

### V. Conclusion

Design patent litigation and prosecution are evolving as a result of *Egyptian Goddess* and its progeny. Court's are using their discretion both in the claim construction process and in applying the "ordinary observer" infringement test. As a result, attorneys have many tools available to creatively procure and litigate design patent cases.

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<sup>90</sup> Katz, *supra* note 72 at 573-74.

<sup>91</sup> *Id.* at 573.

<sup>92</sup> *Id.*

<sup>93</sup> *Id.*