

Design Patent Infringement

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Scope of Today's Presentation

- Overview of U.S. Design Patents
- Two (2) Step Test For Design Patent Infringement
 - Construing the Claims of the Patent
 - The role of *Markman* hearings - *Markman v. Westview Instruments*
 - The “All Elements Rule” - *Elmer v. ICC Fabricating, Inc.*
 - Two standards for determining whether the accused product infringes the patent. Both standards must be satisfied.
 - The “ Ordinary Observer Test” - *Gorham v. White*
 - The “ Point of Novelty” Test - *Litton Systems, Inc. v. Whirlpool Corp.*
- Doctrine of Equivalents
- Toy Automobiles

Design Holder May Obtain More than One Form of IP Protection

- Design Patent Protection May Overlap with Other Forms of Intellectual Property
 - Trademark/Trade Dress/Unfair Competition
 - Copyright
 - Utility Patent
- Design Holder May Obtain Both Utility and Design Patent Protection on the Same Article, So Long as Statutory Requirements are Met

Design Patents in the U.S.

- Statutory Protection Since 1842
- Definition of a Design:
 - A design consists of the visual ornamental characteristics embodied in, or applied to, an article of manufacture
 - A design patent protects the way an article looks, while a utility patent protects the way an article is used and works

Design Patents in the U.S. (cont.)

- Design patents can relate to:
 - Configuration or shape of an article , i.e., the non-functional aspects of the configuration or shape
 - Surface ornamentation or indicia applied to an article, i.e., two-dimensional markings applied to a three-dimensional object
 - A combination of the above two

Design Patents in the U.S. (cont.)

- Elements of a U.S. Design Patent
 - Preamble (optional)
 - Description of the figure(s) of the drawing
 - Feature description (optional)
 - A single claim
 - Figures (drawings and/or photographs) with contain enough views to completely describe the design

What Design Patents Cannot Protect

- Designs Primarily Dictated by Function
 - When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.
 - *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir. 1993).
- Non-Ornamental Designs
- Offensive Designs “Which Disclose Subject Matter Which could Be Deemed Offensive to Any Race, Religion, Sex, Ethnic Group, or Nationality....”

Determining Infringement of a Design Patent

- “Design patents have almost no scope. The claim at bar, as in all design cases, is limited to what is shown in the application drawings.”
 - *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 36 USPQ2d 1417, 1421 (Fed. Cir. 1995), quoting, *In re Mann*, 861 F.2d 1581, 8 USPQ2d 2030 (Fed. Cir. 1988).

Infringement Analysis

- Two step infringement analysis:
 - Step 1: First, the court construes (interprets) the design patent claim.
 - Claim interpretation is a question of law to be decided by the trial judge, not the jury. *Markman v. Westview Instruments*, 517 US 370, 38 USPQ2d 1461 (1996).
 - Step 2: Next, the fact finder (court or jury) determines whether the accused product design infringes the design patent claim, as construed, employing both the ‘ordinary observer’ test and the ‘point of novelty’ test.
 - *Bernhardt LLC v. Collezione Europa USA Inc.*, 72 USPQ2d 1901,1906 (Fed. Cir. 2004).

Infringement Analysis: Step 1

Construing (Interpreting) the Design Patent

- The court may interpret the design patent claim at the same stages of a litigation as would be normal for the court to interpret a utility patent claim.
- *Markman* hearings may be used in design patent cases. See, e.g., *Contessa Foods Products Inc. v. Conagra Inc.*, 62 USPQ2d 1065 (Fed. Cir. 2002).
- Determining points of novelty is a fact question which can be decided by a jury.

Infringement Analysis: Step 1

Construing (Interpreting) the Design Patent

- Scope of the claimed invention is its “overall ornamental visual impression, rather than ... the broader general design concept.” *Contessa Foods Products Inc. v. Conagra Inc.*, 62 USPQ2d 1065 (Fed. Cir. 2002):
 - View the claimed design in its entirety
 - Identify functional and non-functional features. *Bernhardt LLC*, 72 USPQ2d at 1911.
 - “All elements rule.” Design includes all non-functional (ornamental) features visible during any stage of normal use of the product from completion of manufacture to destruction.
- Interpret the claim without looking at the accused design.

Infringement Analysis: Step 2 Determine if accused product infringes the construed design

- “Ordinary Observer” Test
 - “[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 an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”
 - *Gorham Co. v. White*, 81 U.S. (14 Wall) 511, 528 (1871).
 - “Under *Gorham*, the focus is on the overall ornamental appearance of the claimed design, not selected ornamental features.” *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 36 USPQ2d 1417, 1421 (Fed. Cir. 1995)(an “All Elements Rule”).

Infringement Analysis: Step 2

“All Elements Rule”

- The “ordinary observer” test:
 - compares (1) all the ornamental features of the patented design, as shown in all of the drawings, to (2) to all the ornamental features of the accused product visible at any time during normal use of the product; and
 - determines if the resemblance is enough to deceive the ordinary observer.
 - *Contessa Food Products Inc. v. Conagra Inc.*, 62 USPQ2d 1065 (Fed. Cir. 2002).
 - Comparison is not merely at point of sale.
- No infringement of specific features if the overall appearance of the designs are dissimilar. *OddzOn Products Inc. v. Just Toys Inc.*, 43 USPQ2d at 1647.

Infringement Analysis: Step 2

Who is the Ordinary Observer?

- A person giving the amount of attention to the product that a purchaser of ordinary intelligence usually gives.
- Not experts in design.
- The type of product, the price of the product and the expertise of the “pertinent observer” are important factors.
 - Example: *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 48 USPQ2d 1767 (Fed. Cir. 1998):
 - Ordinary Observer was a trucker or fleet operator who purchases tires regularly, and not purchasers of tires generally.
 - The reason: the general purchaser of tires may be “less discriminating” than the average purchaser of the patentee’s design for tires meant for a truck.

Infringement Analysis: Step 2

Point of Novelty Test

- If there is infringement under the “Ordinary Observer” test then we apply the “Point of Novelty” test.
 - *Contessa Food Products Inc. v. Conagra Inc.*, 62 USPQ2d 1065 (Fed. Cir. 2002), citing, *Litton Sys. Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984).
- It is legal error to merge the two tests.
 - For example, it is legal error to rely on the claimed overall design as the point of novelty.
- The “Point of Novelty” test requires
 - Determining which feature or features distinguish the patented design from prior art; and
 - Determining whether the accused design uses these “points of novelty”.

Doctrine of Equivalents?

- There might be no need to distinguish between literal infringement and infringement under the doctrine of equivalents. D. Chisum, *Chisum on Patents*, § 1.04[4][g].
 - The “ordinary observer” test requires substantial similarity.
 - The “point of novelty” test requires similarity of the “points of novelty”.

Some Courts Suggest the Concept of Equivalents Can Apply to Design Patents

- Ordinary Observer Test
- “While the way/function/result test of *Graver Tank* ... is not directly transferable to design patents, it has long been recognized that the principles of equivalency are applicable under *Gorham* While ... infringement can be found for designs that are not identical to the patented design, such designs must be equivalent in their ornamental, not functional, aspects.”
 - *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1190, 5 USPQ2d 1625, 1628 (Fed. Cir. 1988).

Some Courts Suggest the Concept of Equivalents Can Apply to Design Patents

- Point of Novelty Test
- “While the doctrine of equivalents applies to design patent cases, ... it applies only when the accused product includes features equivalent to the novel claimed design features. A patentee cannot evoke the doctrine of equivalents to evade scrutiny of the point of novelty....”
 - *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1199, 33 USPQ2d 1925, 1926, 1929 (Fed. Cir. 1995).

Doctrine of Equivalents May Be Limited

- “Where, as here, a field is crowded with many references relating to the design of the same type of appliance, we must construe the range of equivalents very narrowly.”
 - *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984).
- Prosecution history estoppel can limit the scope of a design patent claim.
 - *Victus Ltd. Collezione Europa USA Inc.*, 48 USPQ2d 1145, 1148 (M.D. N.C. 1998).

Applying Motor Vehicle Designs to Toys

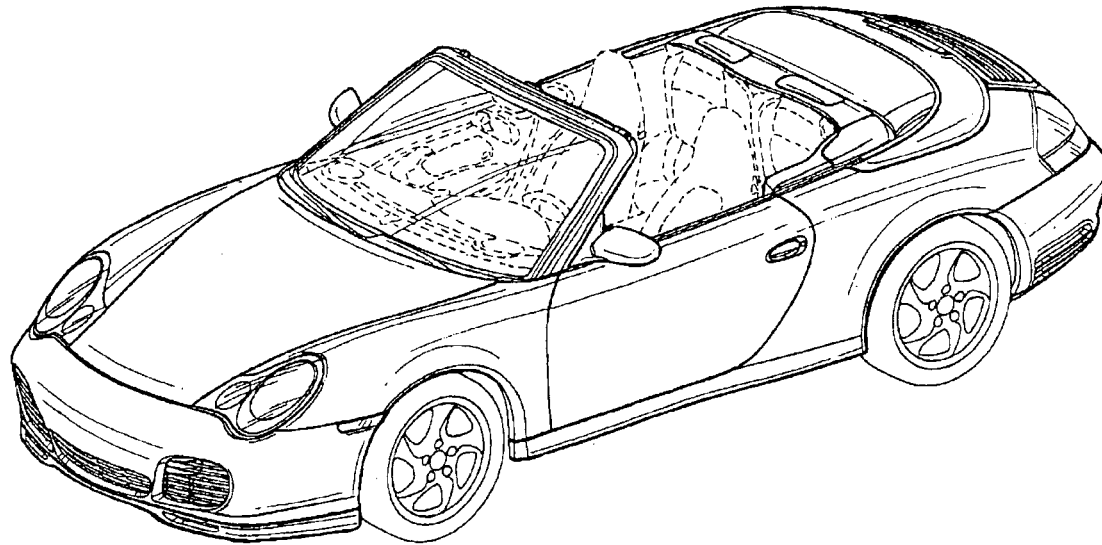
- A design patent is interpreted in view of its claim.
- The claim refers to the drawings in the patent.
- Features such as size of the actual commercial product do not limit the claim unless they are part of the patent.
 - *See, Sun Hill Industries Inc. v. Easter Unlimited Inc.*, 33 USPQ2d 1295, 1297 (Fed. Cir. 1995)(case involving Halloween pumpkin shaped bags).
- If the US design patent claims a shape or configuration for ONLY a motor vehicle it might not cover a toy motor vehicle (*Author's opinion at this time*).
- However, the US Patent Office permits a single design patent to claim motor vehicles and toys.
 - These patents cover full size motor vehicles and toys.

Sample Claims For Motor Vehicles and Toys

- “The ornamental design for a motor vehicle and/or toy replica thereof, as shown and described.”
 - US Design Patent Nos. D500,710; D500,711; D500,645; D497841
- “The ornamental design for a car including toy-car, motor-car, replica-car and scale-model car, as shown and described.”
 - US Design Patent Nos. D498,437; D497840
- “The ornamental design for a surface configuration of a vehicle, toy, and miscellaneous consumer products incorporating the design, as shown and described.”
 - US Design Patent No. D485,211

Sample Claim from D497327

- “The ornamental design for a surface configuration of a vehicle, toy and/or other replicas, as shown and described.”



Thank You