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Carl J. Hall

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A PATENTLY OFFENSIVE TEST: PROPOSING CHANGES TO THE TEST FOR DESIGN PATENT INFRINGEMENT

“A country without a patent office and good patent laws is just a crab and can't travel any way but sideways and backwards.” – Mark Twain¹

I. INTRODUCTION

Imagine a clothing designer toiling over creating a new shoe design.² After months of work, she creates a new and innovative shoe that involves a stylish new strap design that is truly innovative and unlike any other. The shoe is produced and is a massive hit due to the design of the new strap. Thousands are sold, and it becomes hard for stores to keep stock of the shoes to keep up with consumer demand. A second designer then decides to copy the design of the shoe's external strap and puts it onto a shoe that her company already produces. The second designer then sells the shoe, attempting to profit from the popularity of designer one's innovative strap design. The first designer then stops making the shoe altogether because her design has been copied and consumers are no longer able to get the original shoe.

If the above scenario seems unfair, no need to worry; design patents can prevent this scenario.³ Design patents affect consumers every day without them ever knowing.⁴ As a consumer, anyone reading this Note is likely either using a product or wearing an article of clothing that is protected by a design patent.⁵ That is because design patents protect the innovative design aspects of thousands of products from your cell phone to the clothes and shoes we wear every day.⁶ In this respect, design

¹ *Mark Twain Quotes*, YOUR DICTIONARY (Oct. 22, 2017), <http://quotes.yourdictionary.com/author/mark-twain/568288> [<https://perma.cc/PN4M-W95T>].

² This is a hypothetical situation created by the author to show the harm of failing to protect designs through the loss of products in the market.

³ See Alis Anita Manaila, *Design Patents Are a Boon for the Fashion Industry*, CREATIVE ARTS ADVOCATE (2013), <http://creativeartsadvocate.com/design-patents-are-a-boon-for-the-fashion-industry/> [<https://perma.cc/28V2-B5CT>] (advising that designers are obtaining design patents to protect their designs).

⁴ See Lindsey Gilroy & Tammy D'Amato, *How Many Products Does it Take to Build an iPhone?*, (2009), <https://inovorg2011-2.wikispaces.com/file/view/2.1-How+many+patents+does+it+take+to+build+an+iPhone.pdf> [<https://perma.cc/WY8S-3D68>] (outlining the over 200 patents of an iPhone).

⁵ See *U.S. Patent Statistics Chart Calendar Years 1963–2015*, USPTO (Oct. 28, 2017), https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm [<https://perma.cc/SFV8-8DQQ>] (showing that in 2015, the Patent & Trademark Office issued over 25,000 design patents).

⁶ *Cf. id.*

patents have an enormous effect on our everyday lives because they affect the marketplace that runs our economy and influences our purchasing decisions.⁷ Therefore, we must rely on the design patent system to prevent the above scenario through the protection of innovative designs.⁸ Failure to protect these designs through the patent system will result in an unfortunate stifling of innovation and, as noted above, could result in our favorite products not even being sold anymore.⁹

Part II of this Note presents a background that explains the history of the test for design patent infringement and how the current test for design patent infringement operates.¹⁰ Next, Part III of this Note analyzes the problems with the current test for design patent infringement.¹¹ Part IV of this Note proposes a new test for design patent infringement.¹² Finally, Part V of this Note concludes by summarizing the key aspects discussed.¹³

II. BACKGROUND

During their existence, design patents have held a precarious position within the framework of intellectual property protections.¹⁴ To begin, Part II.A explores where design patents come from and what gives the federal government the power to issue design patents and control infringement.¹⁵

⁷ See Gene Quinn, *Why Patents Matter for Job Creation and Economic Growth*, IP WATCHDOG (Jan. 2, 2011), <http://www.ipwatchdog.com/2011/01/02/why-patents-matter-job-creation-economic-growth/id=14170/> [https://perma.cc/2RCF-XFTL] (advising that patents are good for the economy).

⁸ See John R. Boule III, Comment, *Redefining Reality: Why Design Patent Protection Should Expand to the Virtual World*, 66 AM. U. L. REV. 1113, 1125 (2017) (providing that design patents protect the innovative designs of a product).

⁹ See Susana Monseau, *The Challenge of Protecting Industrial Design in a Global Economy*, 20 TEX. INTELL. PROP. L.J. 495, 497 (2012) (advising that critics of U.S. design protections state that design protections in the U.S. have been hostile and cause companies to stifle innovation).

¹⁰ See *infra* Part II (establishing the background of the design patent infringement test and how the current test established under *Egyptian Goddess* is applied).

¹¹ See *infra* Part III.

¹² See *infra* Part IV.

¹³ See *infra* Part V.

¹⁴ See *infra* Part II (outlining the history of design patents, what is required to obtain a design patent, and what design patents protect; then examining the evolution of the design patent infringement test). See also Ralph D. Clifford & Richard J. Peltz-Steele, *The Constitutionality of Design Patents*, 14 CHI-KENT J. INTELL. PROP. 553, 573 (2015) (questioning the constitutionality of design patents under the umbrella of utility patents that has served as the justification for design patents); Jason J. DuMont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837, 841 (2013) (advising that most of the design patent system is derived from the utility patents systems, however, design patents have yet to even come close to establishing the dominate protections of utility patents).

¹⁵ See *infra* Part II.A (exploring the Constitution and federal statutes that allow issuance of design patents and allow the federal courts to decide design patent infringement cases).

Second, Part II.B explains what a design patent is and what the design patent protects.¹⁶ Third, Part II.C discusses the design patent infringement test before *Egyptian Goddess*.¹⁷ Last, Part II.D details the current test for design patent infringement established by the Federal Circuit Court in *Egyptian Goddess*.¹⁸

A. *Constitutional and Statutory Provisions Governing Design Patents and Design Patent Infringement*

With only general dispute, the power for issuance of design patents is derived from the United States Constitution, which states that "Congress shall have the power . . . to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."¹⁹ This authority has been used by Congress to expand the patent system to create design patents and shape the design patent system. This started with the first United States design patent law, which was passed by Congress in 1842.²⁰

¹⁶ See *infra* Part II.B (explaining the requirements for getting a design patent).

¹⁷ See *infra* Part II.C (discussing the three steps to the pre-*Egyptian Goddess* test for design patent infringement that included a claim construction, ordinary observer test, and point of novelty test).

¹⁸ See *infra* Part II.D (detailing the new test for design patent infringement created by the Federal Circuit, and suggesting a three-way visual comparison during claim construction, applying an elevated ordinary observer test, and eliminating the point of novelty test completely).

¹⁹ U.S. CONST. art. I, § 8, cl. 8. See Clifford & Peltz-Steele, *supra* note 14, at 556 (2015) (stating that the power to issue patents is derived from article I, section 8, clause 8 of the Constitution). Though it is usually a surprise to many, the "useful arts" language actually applies to patents, while the "science" language of the provision actually establishes the copyright rights for authors. *Id.* at 559. Article I, Section 8, Clause 8 of the United States Constitution has broadly been referred to as the "Intellectual Property Cause" because it is used as the framework from where Congress has derived the power to regulate intellectual property rights. See Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272, 274 (2004) (providing an overview of Congressional authority to regulate intellectual property rights, referring to Article 1, Section 8, Clause 8 as the Intellectual Property Clause, and discussing how it gives Congress broad authority to regulate and create regimes of intellectual property protection).

²⁰ See Clifford & Peltz-Steele, *supra* note 14, at 557; *Gorham Co. v. White*, 81 U.S. 511, 511-12 (1871) (quoting language from the 1842 Act). *Gorham* provides that the Act applies to anyone:

who by his, her, or their own industry, genius, efforts[,] and expense may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief, or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and

The current statute governing the issuance of design patents allows for patents on designs for “[w]hoever invents any new, original and ornamental design for an article of manufacture.”²¹ The current term for a design patent is also governed by this section and affords a fifteen year monopoly on the design during which the design patent holder can assert his rights against any infringer.²² This monopoly is important because the patent holder is the only one allowed to use the product design aspects protected by the design patent during the term, and this affords the patent holder time to develop secondary meaning in the design.²³ Secondary

useful pattern, or print, or picture to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before.

Id. See also J. Michael Jakes, *Design Patents Take Center Stage*, FINNEGAN (Nov. 16, 2016), <https://www.finnegan.com/en/insights/design-patents-take-center-stage.html> [<https://perma.cc/3QG8-EQ4T>] (providing that the design patent system has afforded protections to product designs since its creation in 1842).

²¹ 35 U.S.C. § 171 (2012). See Peter Lee & Madhavi Sunder, *Design Patents: Law Without Design*, 17 STAN. TECH. L. REV. 277, 281 (2013) (providing that to get a design patent, the applicant must show the requirements of Section 171 and is subject to the requirements of novelty and nonobviousness); Sara Burnick, *The Importance of the Design Patent to Modern Day Technology: The Supreme Court's Decision to Narrow the Damages Clause in Samsung v. Apple*, 18 N.C. J.L. & TECH. 283, 285 (2017) (advising that in order to protect innovative designs, Congress established the federal statute establishing design patents to afford protections for preventing designs from being copied or stolen and incorporated in new product designs); *Poly-Am., LP v. API Indus., Inc.*, 74 F. Supp. 3d 684, 688–89 (D. Del. 2014) (showing that Section 171 sets forth the requirements for a design patent and is the most current statute regarding issuance and validity); *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988) (finding that by limiting the protections of the design patent in this case, the patent holder was limited to the protections of ornamental designs because that was all that was protected under Section 171).

²² See 35 U.S.C. § 173 (2012) (setting a fifteen-year term of limit on the time that a design patent protects a product design). See also *Hoberman Designs, Inc. v. Gloworks Imp., Inc.*, cv 14-6743 DSF (SHx), 2015 WL 10015261, at *3 (C.D. Cal. Nov. 3, 2015) (advising that the patent holder has the right to exclude others from using his design patent or utility patent for 15 years for a design patent and 20 years for a utility patent); *Adams Mfg. Corp. v. Rea*, No. 12-1430, 2014 WL 978116, at *1 (W.D. Pa. Mar. 12, 2014) (providing that the design holder was granted a monopoly on the design of a suction cup design as well as a utility patent).

²³ The fifteen-year monopoly granted by Section 173 is the best reason to continue the issuance of design patents and the design patent system in general because it allows the patent holder the most valuable resource he can have, time, and allows him to use that time to establish secondary meaning, which will allow him to protect his design as trade dress under the trademark rights protections for an indefinite amount of time. See Tracy-Gene G. Durkin & Julie D. Shirk, *Design Patents & Trade Dress Protection: Are the Two Mutually Exclusive?*, 87 J. PAT. & TRADEMARK OFF. SOC'Y 770, 779–80 (2005) (providing that though the Supreme Court has yet to speak on the matter, there are many cases from lower courts holding that trade dress protections can be used to extend the life of an expired design patent even though it appears to extend the monopoly). See, e.g., *Hubbell Inc. v. Pass & Seymour, Inc.*, 883 F. Supp. 955, 959 (S.D.N.Y. 1995) (holding that trade dress protections can extend a

meaning can lead to indefinite protections of the design after the term of the design patent has expired under trade dress protections of trademark law.²⁴

Once a designer has been issued a design patent, he can assert his rights through the design patent infringement statute, which states that:

whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.²⁵

The patent holder must show that the infringer violated the statute by a preponderance of the evidence because infringement is a question of fact decided using the design patent infringement test established by the

design patent even when the design patent has expired because the purpose of the design patent laws and the trade dress laws support different positions in what they protect).

²⁴ In looking at the big picture of design patent protections, trade dress plays an important role and it is important to have an understanding that trade dress rights available under trademark law are available to extend the design patent when it is expired if the design patent holder can develop secondary meaning, which means that when a consumer sees the product they identify the product with the source of the good that produces it so that the company and the product are intertwined. *See, e.g., Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000) (setting the rule that for trade dress protections the product must have developed secondary meaning in the market, and that the product itself cannot be inherently distinctive). *See also* Ronald J. Horta, Note, *Without Secondary Meaning, Do Product Design Trade Dress Protections Function as Infinite Patents*, 27 SUFFOLK U. L. REV. 113, 133 (1993) (explaining that when trade dress protections are found, they can be used to extend a design patent for an indefinite amount of time to provide protections to the product design); Durkin & Shirk, *supra* note 23, at 776 (outlining numerous cases in which the lower courts have held that a design patent can be extended by the protections available under trade dress rights of trademark law).

²⁵ 35 U.S.C. § 289 (2012). *See also* Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC, 739 F.3d 694, 701 (Fed. Cir. 2014) (addressing the design patent infringement statute and discussing how infringement does not have to be literal infringement but instead just has to be substantial because the statute only requires there to be a colorful imitation of the protected design incorporated into another product); Sofpool LLC v. Kmart Corp., No. CIV. S-10-3333 LKK/JFM, 2013 WL 2384331, at *1 (E.D. Cal. May 30, 2013) (discussing the design patent infringement statute and how it does not include all designs that look like the accused design, but that it can include imitations of the patented design if it is incorporated into the design of another product).

courts.²⁶ However, before asserting any rights, one must get issued a design patent.²⁷

B. *How Do You Get a Design Patent and What Does the Design Patent Protect?*

To get a design patent, an applicant must file an application with the United States Patent and Trademark Office.²⁸ The Patent and Trademark Office then researches the application and drawings submitted with the application to make sure it complies with the requirements of the statutes and ensures that the design is “new, original, and ornamental.”²⁹ The drawings are important because they are the embodiment of the design

²⁶ See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010) (stating that the patent holder has the burden of showing design patent infringement by a preponderance of the evidence because the infringement test is a question of fact); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993) (advising that the patent holder must show infringement by a preponderance of the evidence that the design protected by the design patent and the accused design are substantially similar); *Mannesman Demag Corp. v. Engineered Metal Prod. Co.*, 793 F.2d 1279, 1282 (Fed. Cir. 1986) (reciting the requirement that the plaintiff has the burden of showing infringement by a preponderance of the evidence); *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 819 (Fed. Cir. 1992) (providing that the plaintiff has the burden of showing infringement through the design patent infringement test).

²⁷ See *infra* Part II.B.

²⁸ See United States Patent & Trademark Office, *Design Patent Application Guide: Filing an Application*, USPTO (Aug. 13, 2012), <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide#elements> [<https://perma.cc/D6WT-PZ7C>] (providing an overview of the application requirement and describing how to fill out the application to completeness and send it back in to the Patent and Trademark Office for review). Cf. Perry Saidman, *Design Patentees: Don't Get Unglued by Elmer or the Simple Most Important Thing to Know About the Preparation of Design Patent Applications*, 78 J. PAT. & TRADEMARK OFF. SOC'Y 311, 312 (1996) (noting the importance of completing the drawing for submission of the design patent application because the design is later used for the claim construction, and a poor drawing can skew the design patent infringement test).

²⁹ See 35 U.S.C. § 171 (2012); United States Patent & Trademark Office, *Design Patent Application Guide: Examination*, USPTO (Aug. 13, 2012), <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide#elements> [<https://perma.cc/5P5V-AXWF>] (outlining how the Patent and Trademark Office examines the design patent application for completeness, then does a comparison of the drawing with the prior patented art). See also Karl G. Hanson, *Intellectual Property Strategies for Protecting the Looks of a New Product*, 81 J. PAT. & TRADEMARK OFF. SOC'Y 887, 894 (1999) (discussing the different objectives in the drawing submitted with the design patent application and suggesting that each novel component of the design get its own design application because the application should only include one claim because that single claim is all that can be issued to a design patent at one time); Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 STAN. TECH. L. REV. 107, 116–17 (2013) (outlining the requirement that the design patent application sent to the U.S. Patent and Trademark Office must contain a drawing and can't generally just contain a picture in place of the drawing).

claim, and the drawings are used in both the claim construction step and the infringement decision analysis (see Figure 1).³⁰ The Patent and

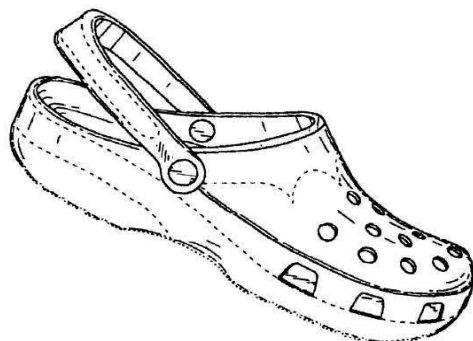


Figure 1

Source: Crocs, Inc., v. Int'l Trade Comm'n, 598 F.3d 1294, 1299 (Fed. Cir. 2010)

Trademark Office ensures that the design meets the three major requirements set forth in the statutes by making sure the design meets three standards before issuing the design patent.³¹

First, the design must be novel for it to receive any design

patent protections.³² Novelty has been an important measuring bar for the

³⁰ Figure 1 is from the drawings submitted from the design patent for Crocs shoes. See *Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1299 (Fed. Cir. 2010). Figure 1 also illustrates the confusion associated with using the drawing in the scope and infringement decision where the factfinder must decide what is being protected but must know the intricacies of the design patent drawings and what the different lines and shading means. Because this is such an intricate drawing system, it is reasonable to conclude that it is difficult to define just what exactly is being protected. See *How to Prepare and File a Design Patent*, MY DESIGN PATENT (Jan. 14, 2018), <http://mydesignpatent.com/preparing-the-application/the-drawings.html> [<https://perma.cc/6VRW-MUJ9>] (explaining how dotted lines, shading, and distinctive patterns are used in the drawings and how each indicates a specific, special meaning).

³¹ See Aaron Cook, Note, *Points of Novelty, Lawman Armor, and the Destruction of Design Patents*, 12 J. TECH. L. & POL'Y 103, 107 (2007) (explaining that there are three major requirements for getting the Patent and Trademark Office to issue a design patent: patentable material, novelty, and non-obviousness, which all must be shown to receive a design patent); *Application of Johnson*, 175 F.2d 791, 792 (C.C.P.A. 1949) (stating that to issue a design patent, the design must be novel in that it can't already exist in another product design regardless of which marketplace the design exists because if the applicant's design incorporates an already present design it is not patentable); *Application of Cornwall*, 230 F.2d 457, 459 (C.C.P.A. 1956) (invalidating a design patent where the design in question was already present in the marketplace due to a similarity in the substantive portion of the vent tube).

³² See Rebecca Tushnet, *The Eye Alone Is the Judge: Images and Design Patents*, 19 J. INTELL. PROP. L. 409, 409-11 (2012) (stating that to receive design patent protections an applicant must send an application to the U.S. Patent and Trademark Office and that the visual nature of design patent issuance is like that of infringement, where the non-novel aspects should not be afforded protections although they are commonly mixed with the novel design aspects of the design that need protected); Andrew Beckerman-Rodau, *Design Patent Evolution: From Obscurity to Center Stage*, 32 SANTA CLARA HIGH TECH. L.J. 53, 57 (2015) (discussing the application process for design patents and that the application is only

issuance of design patents because the design patent system itself is undermined by protections of product design aspects that are not original.³³ A lack of novelty will result in a denial of the issuance of the design patent, or, even if the design patent is issued, the patent could be invalidated in a later lawsuit.³⁴

Second, the subject matter of the design must be patentable.³⁵ Patentable materials for a design patent must be ornamental features that are embodied into the product of manufacture, or they can be the overall

approved if it is established that the design has novel aspects that are protectable by the design patent system).

³³ See 35 U.S.C. § 102(a) (2012) (setting forth the novelty requirement that, to get a design patent, the design must not be already patented, explained in a publication for the public to see, or available to the public before trying to get the design patent); Cook, *supra* note 31, at 108–09 (detailing the novelty requirement for the issuance of a design patent and stating that it is not sufficient enough that the subject matter is patentable or not; if it is not novel then there should not be a design patent issued, and the application should be denied for a lack of novelty). See also *Oddzon Prod., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (requiring that there be a showing of novelty for the issuance of a design patent by the Patent and Trademark Office because the product design must be original for a design to be afforded protections).

³⁴ See *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1328 (Fed. Cir. 2015) (explaining that the defendant can challenge the validity of the design patent during a suit for design patent infringement but that after issuance of the design patent, there is an assumption of validity that must be overcome by the defendant for the court to invalidate the design patent); *Oddzon*, 122 F.3d at 1403 (outlining the invalidation attempt by the defendant where there were questions as to whether the design patent should be invalidated based on the work of fellow employees that were working together to create a product design and invalidated the novelty of the design by making the design public); *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1376 (Fed. Cir. 2004), *abrogated by* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (displaying an argument for invalidation of a design patent for furniture design aspects because they were not novel as they had been previously used in other pieces of furniture).

³⁵ See Cook, *supra* note 31, at 107 (stating that one of the three requirements for the Patent and Trademark Office to issue a design patent is that the design to be protected by the design patent must be a patentable subject matter); William J. Seymour & Andrew W. Torrence, *(R)evolution in Design Patentable Subject Matter: The Shifting Meaning of “Article of Manufacture,”* 17 STAN. TECH. L. REV. 183, 194 (2013) (providing a discussion of proper subject matter for issuance of a design patent, including that a design aspect that is not visible is not protectable by a design patent). Cf. Rajnish Kumar Rai, *Patentable Subject Matter Requirements: An Evolution of Proposed Exclusions to India’s Patent Law in Light of India’s Obligations Under the Trips Agreement and Options for India*, 8 CHI.-KENT J. INTELL. PROP. 41, 54 (2008) (discussing the subject matter requirement for patents in the context of the Trips Agreement and how the subject matter cannot be beyond what is described for the issuance of a valid patent to an inventor).

design of a product of manufacture.³⁶ In either circumstance, however, the design feature must not be a purely functional aspect of the design.³⁷

Third, a design patent will not issue if the design is obvious.³⁸ The requirement for nonobviousness for the issuance of a design patent comes from utility patents.³⁹ Furthermore, the standard of evaluation has also

³⁶ See Application of Bartlett, 300 F.2d 942, 943–44 (C.C.P.A. 1962) (issuing a design patent for the incorporation of a design into tiles that was similar to a marbling design); Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1116 (Fed. Cir. 1998), *abrogated by* Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) (finding that the design patent covers the tread designs of the tire that incorporated it instead of the tire itself). See also Keystone Retaining Wall Sys., Inc. v. Westrock, 997 F.2d 1444, 1451 (Fed. Cir. 1993) (deciding that the design patent at issue in this case was issued for the landscaping blocks that make up a retaining wall and not the whole wall itself).

³⁷ See Sport Dimension, Inc. v. Coleman Co., 820 F.3d 1316, 1320 (Fed. Cir. 2016) (providing that a design patent cannot protect a product design that is purely functional because the functionality outweighs the ornament that the design patent protects). Although the design patent does not cover purely functional design elements, the product design can contain both functional and non-functional design aspects and still be issued a design patent because, during the claim construction phase, the scope of the design patent can separate the functional and non-functional design aspects to ensure that the functional aspects are not afforded protections during the design patent infringement analysis that follows claim construction. See, e.g., *Oddzon*, 122 F.3d at 1405 (stating that the functional and non-functional aspects of the product design, which the design patent protects, must be separated so that the factfinder can identify which aspects are the non-functional protected aspects of the design).

³⁸ See 35 U.S.C. § 103 (2012); Janice M. Mueller & Daniel Harris Brean, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 Ky. L.J. 419, 425 (2011) (discussing the obviousness inquiry undertaken by the Patent and Trademark Office by analyzing the difficulties it has in deciding whether a design is obvious or not, which leads to just issuing the design patent without adequate assurance that the design patent is not obvious). See also Application of Glavas, 230 F.2d 447, 450 (C.C.P.A. 1956) (analyzing the issuance of a design patent and considering whether the prior design suggested the design that was seeking protections); *Hadco Prod., Inc. v. Walker Kiddle & Co.*, 462 F.2d 1265, 1268 (3d Cir. 1972) (providing that the nonobviousness determination for design patents is a very important question in deciding whether the design patent is invalidated or is a valid design patent); *Cook*, *supra* note 31, at 109–10 (advising that the Patent and Trademark Office must analyze the design patent to decide whether it is obvious before issuance).

³⁹ See Mueller & Brean, *supra* note 38, at 424 (explaining that the nonobviousness requirement for issuance of a design patent “was implemented in response to dissatisfaction with nineteenth-century efforts to gauge patent-worthiness via a nebulous test of invention”); *Cook*, *supra* note 31, at 110 (advising that the standard is the same for a design patent and a utility patent in regard to the nonobviousness requirement for issuance of either patent). See also *Contico Intern., Inc. v. Rubbermaid Com. Prod., Inc.*, 665 F.2d 820, 823 (8th Cir. 1981) (stating that design patents are subjected to the same requirements as utility patents in many respects, including the nonobviousness requirement); *MRC Innovations, Inc. v. Hunter MFG., LLP*, 921 F. Supp. 2d 800, 804 (N.D. Ohio 2013) (stating that, like the nonobviousness requirement of utility patents, design patents are also subjected to the same nonobviousness requirement).

been taken directly from utility patents.⁴⁰ That standard involves deciding whether the design patent is obvious through the perspective of an ordinary designer.⁴¹ If, in the eyes of an ordinary designer, the design is an induction of another prior design, the design is obvious and the Patent and Trademark Office will not issue the design patent.⁴²

After meeting the above requirements, the patent holder is issued a design patent, which affords protections to the novel aspects of the claimed design.⁴³ Design patents protect the aesthetic, ornamental aspects of the patented design and prevent others from incorporating that design

⁴⁰ See *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1441 (Fed. Cir. 1984) (applying the same test for nonobviousness to a design patent as is applied for utility patents); *Cook*, *supra* note 31, at 110 (stating that the test for nonobviousness for design patents is the same test as the test applied to decide whether a utility patent is obvious). See also Daniel Adam Nadel, *The Elusive Point of Novelty Test Leaves Design Patent Infringement in Limbo: A Critique of Lawman Armor Corporation v. Winner International, LLC*, 17 FED. CIR. B.J. 343, 344 (2008) (advising that the validity tests for design patents, including nonobviousness, are the same for design patents as they are for utility patents).

⁴¹ See *Graham v. John Deere Co.*, 383 U.S. 1, 13 (1966) (outlining the nonobviousness inquiry for a utility patent for a revision of a patent on a plow and stating that, by deciding if the patent is for the next logical step through nonobviousness, the decision should be whether the revision was the next logical step to a person having an ordinary ability in the art); *In re Rosen*, 673 F.2d 388, 390 (C.C.P.A. 1982) (stating that the Patent and Trademark Office determines nonobviousness by making the decision if the design would be a logic next step to a designer of ordinary skill in the art); *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981) (holding that the determination for nonobviousness should be made by using a designer that has ordinary skill in the art in which involves the market that the product design is in).

⁴² See *In re Sum Nan Cho*, 813 F.2d 378, 382 (Fed. Cir. 1987) (explaining that the design patent is obvious if the references suggest the application of one design into the design of another product); *Mueller & Brean*, *supra* note 38, at 424–25 (discussing the difficulties in deciding the nonobviousness standard as applied to design patents and stating that the test used to decide nonobviousness for design patents is the same as utility patents in that the decision involves whether the person having ordinary skill in the art would find the new design to be an obvious application of the design to the new product design); *Cook*, *supra* note 31, at 110 (stating that the test for obviousness is through the lens of the ordinary designer who has experience with the prior art associated with the market in which the patented design exists). See also *Sidewinder Marine, Inc. v. Starbuck Kustom Boats & Prods., Inc.*, 597 F.2d 201, 208 (holding that the decision for design patent obviousness must be from the perspective of an ordinary designer in the art and not from the prospective of the ordinary person that has no knowledge of product designs in that area).

⁴³ See *Tushnet*, *supra* note 32, at 411 (describing the problem with affording protections to non-novel or functional design aspects of a design patent); Peter Lee & Madhavi Sunder, *The Law of Look and Feel*, 90 S. CAL. L. REV. 529, 557 (2017) (noting the novelty requirement for issuance of a design patent for a design). See also *Cinna, S.A. v. Futura S.R.L.*, No. 03 Civ. 31(JSR), 2003 WL 22671466, at *1–2 (S.D.N.Y. Nov. 12, 2003) (focusing the infringement on the novel aspects of the claimed design and whether those novel aspects were incorporated into the accused design to find infringement).

into any part of their product design.⁴⁴ Therefore, most importantly, obtaining the design patent gives the patent holder the ability to protect the patented design through an infringement suit.⁴⁵

Design patents are sometimes confused with trade dress protections afforded through trademark law because they afford similar protections.⁴⁶ While the two are similar in many respects, design patents and trade dress protections seek to accomplish different goals.⁴⁷ Trade dress, as a

⁴⁴ See Thomas B. Lindgren, *The Sanctity of the Design Patent: Illusion or Reality? Twenty Years of Design Patent Litigation Since Compro v. Day-Brite Lighting, Inc., and Sears, Roebuck & Co. v. Stiffel Co.*, 10 OKLA. CITY U. L. REV. 195, 197 (1985) (expounding that design patents protect the ornamental features of a design that leave an impression on the mind, and ornamentation in design patents is the aesthetic aspects of the design, which are protected); Steven A. Church, Note, *The Weakening of the Presumption of Validity for Design Patents: Continued Confusion Under the Functionality and Matter of Concern Doctrines*, 30 IND. L. REV. 499, 505–06 (1997) (stating that design patents are for ornamental designs of products and discussing the issues with showing that the design is completely ornamental and not functional). Because design patents only protect the ornamental design aspects of a product, it is possible for the same product to have both a design patent and a utility patent or other intellectual property law protections to protect the non-ornamental aspects of the product. See *id.* at 504.

⁴⁵ See Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. 107, 117 (2016) (advising that, similar to utility patents, a design patent, once issued, gives the patent holder the right to prevent others from “making, using, selling, or offering to sell the patented design”); Clifford & Peltz-Steele, *supra* note 14, at 576 (providing that a design patent affords the patent holder the ability to exclude use of the design and allows the patent to be enforced whenever anyone tries to incorporate the design). Cf. *Morrow v. Microsoft Corp.*, 499 F.3d 1332, 1339 (Fed. Cir. 2007) (discussing the utility patent holder’s right to exclude others and the constitutional harm that occurs when the patented invention is used); *Fairchild Semiconductor Corp. v. Power Integrations, Inc.*, 630 F. Supp. 2d 365, 370 (D. Del. 2007) (holding that a utility patent holder has the right to exclude others, and the patent holder incurs harm from the use of his patent by others).

⁴⁶ Trade dress and its protections are established under § 43(a) of The Lanham Act, and trade dress is the overall commercial appearance that distinguishes a product’s source and makes the product distinct in that you associate the appearance of the product or its packaging with the company that made it. See Kerrie A. Laba, Note, *Have Trade Dress Infringement Claims Gone Too Far Under the Lanham Act?*, 42 WAYNE L. REV. 1649, 1652 (1996) (providing that § 43(a) of the Lanham Act affords trade dress protections by allowing civil action against infringers who intend to cause consumer confusion); Horta, *supra* note 24, at 129 (discussing the convergence of trade dress and design patents as a result of the increased protections that have been bestowed upon trade dress rights by the courts treading on the design patent rights); David S. Welkowitz, *Trade Dress and Patent – The Dilemma of Confusion*, 30 RUTGERS L.J. 289, 306–07 (1999) (noting the similar approaches that are often used when assessing design patent and trade dress standards, blurring the line between the separation of the two protections). See also *Duraco Prods. Inc. v. Joy Plastic Enter., Ltd.*, 40 F.3d 1431, 1447 (3rd Cir. 1994) (warning that Congress has not intended to give perpetual protection to product designs through Section 43(a) of the Lanham Act, and courts should not try to attempt to undermine Congress by combining patent and trademark laws that should be kept separate).

⁴⁷ See *Rubbermaid Com. Prods., Inc. v. Contico Intern., Inc.*, 836 F. Supp. 1247, 1261 (W.D. Va. 1993) (holding that Rubbermaid’s design is novel, and therefore, their design patent is

protection of trademark law, prevents copying an overall appearance by protecting the source of the good from consumer confusion.⁴⁸ In contrast, design patents are issued for artistic ornamentation with the goal of incentivizing designers to create novel decorative designs for products.⁴⁹ Even the courts, however, have trouble dealing with the interplay of design patents and trade dress, which blurs the line between the two.⁵⁰

C. *The Test for Design Patent Infringement Prior to Egyptian Goddess*

The design patent infringement test before *Egyptian Goddess* was a two-part inquiry that involved three steps.⁵¹ First, before the court

valid and enforceable, but that because the design itself does not identify Rubbermaid as the source of the good, the defendant has not infringed any trade dress protections). Compare *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 375 (2d Cir. 1997) (stating that the reason for the Lanham Act is to protect consumers and companies that make products from deception through the source of the goods), with *Avia Grp. Intern., Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988) (advising that the purpose of the design patent statute is to encourage designers to push innovation in the decorative arts).

⁴⁸ See *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 629 (6th Cir. 2002) (stating that to win an infringement suit for trade dress infringement under § 43(a) of The Lanham Act, the plaintiff must show that the distinctiveness of the product indicates the source of the product it dresses); *Forschner Grp., Inc. v. Arrow Trading Co., Inc.* 124 F.3d 402, 409 (2d Cir. 1997) (discussing that, when looking at the consumer confusion element of trade dress infringement, the overall image is considered when deciding whether the trade dress indicates the source of the product); *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1175 (N.D.N.Y. 1995) (advising that trade dress infringement protects the source of the good through the likelihood of confusion test, which seeks to decide if the consumer would be confused as to the source of the good).

⁴⁹ See Burstein, *supra* note 45, at 135 (advising that the design patent system incentivizes the advancement of the decorative arts by promoting the production of products that have innovative designs because the designers are awarded with a design patent to protect the novel design created); Lee & Sunder, *Design Patents*, *supra* note 21, at 289-90 (advising that design patents and their protection of exclusive rights have the objective of incentivizing designers to create new designs). Cf. Abby J. Quele, *Transcript of Presentation – The Design Patent: A Sleeping Giant?*, 16 FLA. COASTAL L. REV. 139, 144 (2014) (inferring that the reason a designer gets a design patent is that there is an incentive to get the protection the design patent affords because of the substantial amount of resources that go into developing the new design).

⁵⁰ See Horta, *supra* note 24, at 128 (stating that courts have expanded the definition of trade dress and converged the design patent and trade dress objectives and protections). Cf. Vuong Nguyen, *Opting for Flexibility: How the Existence of a Design Patent Should Shape Evidentiary Burdens in Litigation Over Trade Dress Protection for the Same Features*, 82 U. CHI. L. REV. 2249, 2278-82 (2015) (advising that some courts are persistent in finding a strong link between design patents and trade dress in deciding functionality even though one is a bad indication of functionality in the other because they can cover different aspects).

⁵¹ See *Rockport Co. v. Deer Stags, Inc.*, 65 F. Supp. 2d 189, 193 (S.D.N.Y. 1999) (going through the design patent infringement test and advising that there is a two-part inquiry for design patent infringement: the claim construction of the design patent; and application of the ordinary observer test and the point of novelty test). See also *Torpedo Hockey Int'l, Inc. v. Kor Hockey Ltd.*, 491 F. Supp. 2d 871, 873-74 (D. Minn. 2007) (advising that there are two

actually applies any of the infringement tests, the initial inquiry was to construe the design patent through claim construction.⁵² During claim construction, the court determines the scope of the design patent, usually defining the ornamental aspects of the design.⁵³ Before *Egyptian Goddess*, the claim construction stage involved construing the scope of the design patent primarily through a written description of the protected elements written by the court and a focus on the patent drawing submitted with the application.⁵⁴

steps to the design patent infringement test: claim construction; and application of the two infringement tests, the ordinary observer test and the point of novelty test); *Lentek Intern. Inc., v. Sharper Image Corp.*, 164 F. Supp. 2d 1302, 1305–06 (M.D. Fla. 2001) (proceeding through the claim construction step of the design patent infringement inquiry, then applying the ordinary observer test and the point of novelty tests in the second part of the inquiry to find infringement of the patented design); *Child Craft Indus., Inc. v. Simmons Juvenile Prods. Co.*, 990 F. Supp. 638, 640–42 (S.D. Ind. 1998) (outlining the design patent infringement test and starting with the claim construction step before moving into the two-part infringement inquiry where the ordinary observer test and the point of novelty tests were applied).

⁵² The claim construction step is not actually a part of the infringement analysis itself in that it does not actually decide if the infringement has taken place, but it is a separate step of the overall infringement decision because the jury must know the scope of the design patent before they decide if the defendant's design is infringing the plaintiff's design in the patent. See *Mobile Hi-Tech Wheels v. CIA Wheel Grp.*, 514 F. Supp. 2d 1172, 1192 (C.D. Cal. 2007) (implying that there cannot be a meshing of the claim construction step with the infringement step because it could prejudice the jury). Even though claim construction is intended to define the scope of the patent, the courts have a difficult job accomplishing this, and it should ideally be construed by the patent applicant when submitting the application to the Patent and Trademark Office and when the design patent is being researched and issued. See *infra* Section IV.B.1 (arguing that because the Patent and Trademark Office has failed to stem the issuance of design patents and issues them without a thorough investigation into whether the design is novel or not, and that the courts and the patent holder must pick up the slack and define the scope of the patent during claim construction so that the factfinder can make an informed infringement decision knowing exactly what is being protected in the design patent and not including unprotected design aspects).

⁵³ See *Ashley Furniture Indus. Inc. v. Lifestyle Enter. Inc.*, 574 F. Supp. 2d 920, 927–28 (W.D. Wis. 2008) (discussing the claim construction step in the context of design patents and stating that the claim construction of a design helps separate the ornamental protected design elements from the other elements). The claim construction step can happen at various times, but the court does not have complete ability to decide the scope of the design whenever it wants. See *CytoLogix Corp. v. Ventana Med. Sys., Inc.*, 424 F.3d 1168, 1172 (Fed. Cir. 2005) (stating that the district court has wide discretion on resolving issues of claim construction of the design patent when it sees fit to decide them). But see *Exxon Chem. Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995) (holding that, even though the district court has discretion on when to conduct the claim construction of the design patent, it must still be complete before the jury instructions so that the jury knows what the scope of the claim is before they are to make the infringement decision).

⁵⁴ See Perry J. Saidman, *Egyptian Goddess Exposed – But Not in The Buff(er)*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 859, 863 (2008) [hereinafter Saidman, *Egyptian Goddess*] (explaining that before *Egyptian Goddess* claim construction, courts would verbalize the drawings of the design patent in order to put into words the claimed design as depicted in the drawings,

Next, the second part of the design patent infringement inquiry began with the ordinary observer test.⁵⁵ Having the scope of the claim before them, the jury would compare the plaintiff's design with the defendant's design.⁵⁶ If, after the comparison, the factfinder found that in the:

eye of an ordinary observer, giving such attention as a purchaser usually gives, [the] 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.⁵⁷

The factfinder, therefore, made the infringement decision by putting himself into the position of a normal consumer of the item and then decided if the product designs were so substantially similar that he would purchase one thinking that it was the other.⁵⁸ The ordinary observer

tending to over-verbalize the patent claim). *See also* *Oddzon Prod., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (upholding the written verbalized description given during claim construction even though it narrowed the scope of the design patent to the appearance of the football at issue instead of footballs like this in general).

⁵⁵ *See* *Gorham Co. v. White*, 81 U.S. 511, 528 (1871) (holding that the ordinary observer test is the test for deciding whether a design patent has been infringed); *Henry Hanger & Display Fixture Corp. Am. v. Sel-O-Rak Corp.*, 270 F.2d 635, 640 (5th Cir. 1959) (applying the ordinary observer test to decide design patent infringement after the claim construction step of the infringement analysis). *See also* *Metrokane, Inc. v. Wine Enthusiast*, 185 F. Supp. 2d 321, 326 (S.D.N.Y. 2002) (stating that the ordinary observer test is applied to the properly claimed designs to decide whether the designs are substantially similar to each other before the last part of the infringement test is applied to see if the design incorporates the points of novelty).

⁵⁶ *See* *Durbin v. Kuryakyn Holdings, Inc.*, 440 F. Supp. 2d 921, 933 (W.D. Wis. 2006) (advising that for the ordinary observer test, the patented design is compared to the accused design to decide if they are substantially similar for the infringement test). *See also* *Dexas Intern., Ltd. v. Tung Yung Intern., Inc.*, No. 6:07-cv-334, 2008 WL 5773601, at *3 (E.D. Tex. July 29, 2008) (stating that the ordinary observer test should be decided by looking at all the ornamental features in the figures included in the analysis); *PHG Tech., LLC v. St. John Co., Inc.*, 529 F. Supp. 2d 852, 864 (M.D. Tenn. 2007) (holding that the ordinary observer test involves a comparison of the claimed design and the accused design, not a commercial embodiment of the patented design).

⁵⁷ *Gorham*, 81 U.S. at 528. *See* Christopher V. Carani, *The New "Extra-Ordinary" Observer Test for Design Patent Infringement – On a Crash Course with the Supreme Court's Precedent in Gorham v. White*, 8 J. MARSHALL REV. INTELL. PROP. L. 354, 362 (2009) (advising *Gorham's* standard for the ordinary observer test for design patent infringement); Ryan Bowen, *Much Ado About Nail Buffers: A Critical Analysis of the Federal Circuit's En Banc Decision in Egyptian Goddess, Inc. v. Swisa, Inc.*, 19 FED. CIR. B.J. 141, 142–43 (2006) (discussing the ordinary observer test and how it decides infringement of a design patent through the eyes of an ordinary purchaser who may buy the product).

⁵⁸ *See* *Brookfield Athletic Shoe Co. v. Chi. Roller Skate Co.*, 607 F. Supp. 241, 249 (N.D. Ill. 1984) (applying the ordinary observer test and finding that the ordinary consumer of the

before *Egyptian Goddess* was said to be a person of “ordinary acuteness” and was not an expert in the designs.⁵⁹

Last, after application of the ordinary observer test in the infringement analysis, the court would apply the point of novelty test.⁶⁰ The point of novelty test was conducted completely separate from the ordinary observer test.⁶¹ Even if the factfinder found that the defendant’s design infringed the plaintiff’s design through the ordinary observer test, the factfinder still must find infringement through the point of novelty test.⁶²

roller skates would not be deceived into buying one set of skates thinking that it was the defendant’s skates, and therefore there was no infringement of the roller skate design patent). *See also* *Tropicana Prods., Inc. v. Land O’Lakes, Inc.*, 286 F. Supp. 2d 343, 345 (D. Del. 2003) (accepting *Tropicana’s* argument that the ordinary observer would not be deceived by the bottle designs in question because the ordinary consumer of the drinks in question would be able to tell the difference between the bottles when buying them as a regular buyer).

⁵⁹ *Gorham*, 81 U.S. at 528. *See Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 679 (E.D. Mich. 2003) (stating that the ordinary observer is a lay observer of ordinary acuteness that has ordinary intelligence); *Minka Lighting, Inc. v. Craftmade Intern., Inc.*, No. 3-00-cv-0888-x, 2001 WL 1012685, at *14 (N.D. Tex. Aug. 20, 2001) (discussing the ordinary observer and stating that the infringement test should not look through the lens of an expert but instead should make the infringement decision looking through eyes of men generally). *See also* *Nebel Knitting Co. v. Sanson Hosiere Mills*, 214 F.2d 781, 782–83 (4th Cir. 1954) (advising that the ordinary observer is not an expert to be deceived but instead is the regular consumer of ordinary acuteness with the level of intelligence that a regular person has).

⁶⁰ *See* *Sylvia Ngo, Egyptian Goddess v. Swisa: Patently Obvious? Reconciling the Ordinary Observer and Point of Novelty Tests*, 10 HOUS. BUS. & TAX L.J. 110, 116 (2010) (providing that the point of novelty test is the second test applied in the infringement analysis prior to *Egyptian Goddess* and that the test is applied after the substantial similarity determination of the ordinary observer). *See also* *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (establishing that the point of novelty test is applied after the ordinary observer in the design patent infringement test); *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944) (applying the point of novelty test in the design patent infringement analysis after the ordinary observer test).

⁶¹ *See* *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002), *abrogated by* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (proclaiming that the ordinary observer test and the point of novelty tests are separate tests to be applied in the design patent infringement test and they should not be conducted together); *Torpsco Hockey*, 491 F. Supp. 2d at 874 (stating that the ordinary observer test and the point of novelty test are distinct tests and that intermingling the tests is legal error). *See also* *Unidynamics Corp. v. Automatic Prods. Intern., Ltd.*, 157 F.3d 1311, 1324 (Fed. Cir. 1998), *abrogated by* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (reversing the district court’s finding of summary judgment because the district court mixed the ordinary observer test and the point of novelty test and then remanding the case back to the district court for the court to reapply the ordinary observer separate from the point of novelty test).

⁶² *See* *Lawman Armor Corp. v. Winner Intern., LLC*, 437 F.3d 1383, 1384–85 (Fed. Cir. 2006) *abrogated by* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (advising that the point of novelty test must be satisfied as well as the ordinary observer test in order for a finding of infringement); *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (failing to decide whether the defendant’s design had appropriated the point of novelty from the plaintiff’s design because the ordinary observer test had not been

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The point of novelty test involved separating the novel aspects of the design from the overall design of the product.⁶³ The factfinder then looked to the defendant's product to identify if it had incorporated the points of novelty identified in the protected design.⁶⁴ If the factfinder found that the novelty had been incorporated, then the defendant's product design infringed the plaintiff's design patent.⁶⁵ A finding of infringement through both the ordinary observer test and the point of novelty tests resulted in a finding of infringement of the design patent by the factfinder.⁶⁶

satisfied, so there was no need to advance to the point of novelty test because the factfinder must find infringement in both tests for the design patent to be infringed); *Sharper Image Corp. v. Target Corp.*, 425 F. Supp. 2d 1056, 1069 (N.D. Cal. 2006) (stating that there are two tests for design patent infringement and that, even if the factfinder finds infringement through substantial similarity by the ordinary observer test, the point of novelty test must next be satisfied also for a finding of design patent infringement).

⁶³ See *Litton Sys.*, 728 F.2d at 1444. See also *Sun Hill Indus. Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir. 1995) *abrogated by* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (affirming that the point of novelty cannot be a product's overall design and must instead be the separate points identified during claim construction as construed by a comparison against the prior art); *Winner Intern. Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990) (rejecting the argument that the overall product design can qualify as a point of novelty); *Brainard v. Custom Chrome, Inc.*, 872 F. Supp. 39, 42 (W.D.N.Y. 1994) (stating that, when considering the point of novelty, the overall product design cannot be considered a point of novelty).

⁶⁴ See *Sun Hill*, 48 F.3d at 1197 (discussing the point of novelty test and the requirement that the plaintiff show that the novel features of the patented design have been appropriated in the design of the defendant's product). See also *Catalina Lighting, Inc. v. Lamps Plus, Inc.* 295 F.3d 1277, 1286-87 (Fed. Cir. 2002) (advising that the point of novelty test involves deciding whether the defendant's design has incorporated the points of novelty that distinguish the plaintiff's design and the closest prior art); *Brown Jordan Intern., Inc. v. Mind's Eye Interiors, Inc.*, 236 F. Supp. 2d 1152, 1156 (D. Haw. 2002) (allowing the design patent infringement suit in this case because it appeared that the ordinary observer test and the point of novelty test were satisfied because the point of novelty had been sufficiently incorporated into the defendant's design).

⁶⁵ See *Nike, Inc. v. Meitac Int'l Enter. Co.*, No. 2:06-CV-00934-PMP-PA, 2006 WL 3883278, at *3 (D. Nev. Oct. 11, 2006) (finding that Meitac infringed Nike's patented design because Meitac incorporated the point of novelty from the patented design into its product design); *Am. Custom Golf Cars, Inc. v. Ecoblue Corp.*, No. SACV 06-699 JVS(RNBx), 2006 WL 4704619, at *2 (C.D. Cal. 2006) (holding that the defendant infringed the plaintiff's design patent because it incorporated all the design features of the design patent including the points of novelty).

⁶⁶ See *Herbko Int'l, Inc. v. Gemmy Indus. Corp.*, 916 F. Supp. 322, 325 (S.D.N.Y. 1996) (advising that the ordinary observer and the point of novelty test are sometimes intertwined but that they both must be satisfied for there to be a finding of infringement). See also *Cotapaxi Custom Design & Mfg., LLC v. Corp. Edge, Inc.*, No. 06-5183 (JAG), 2007 WL 2908265, at *3 (D.N.J. Oct. 1, 2007) (stating that the ordinary observer and point of novelty tests must both be satisfied to find infringement of the design patent); *Boone Supply Co. v. Cambria Cty. Ass'n Blind & Handicapped*, No. CIV.A. 2:01-0420, 2002 WL 1796970, at *2 (S.D.

D. The Current Test for Design Patent Infringement

In 2008, the Federal Circuit Court set forth the current test for design patent infringement in *Egyptian Goddess v. Swisa*.⁶⁷ The court retained the overall two-step structure of the design patent infringement test; however, both steps underwent significant changes.⁶⁸

First, the court retained the requirement of undergoing claim construction of the design patent.⁶⁹ The court recognized that it had required district courts to undergo the claim construction step, but it had provided little guidance on how the claim should be construed.⁷⁰

W. Va. July 26, 2002) (providing that the ordinary observer and the point of novelty test are separate tests that both must be applied).

⁶⁷ See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008) (changing the design patent infringement test by suggesting that the court use drawings in the comparison in claim construction, elevating the ordinary observer in the ordinary observer test, and eliminating the point of novelty test from the infringement analysis altogether). See also *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1237 (Fed. Cir. 2009) (stating that the test for design patent infringement has been changed by *Egyptian Goddess*, where the point of novelty test has been eliminated and the ordinary observer test is now the only test for design patent infringement); *MSA Prods. Inc. v. Nifty Home Prods., Inc.*, 883 F. Supp. 2d 535, 541 (D.N.J. 2012) (applying only the ordinary observer test in the design patent infringement analysis); *Sofpool LLC v. Intex Recreation Corp.*, No. 2008-1498, 2009 WL 1285262, at *1 (Fed. Cir. 2009) (remanding a case in which the jury found no infringement prior to *Egyptian Goddess*, which was sought because of the change to the design patent infringement test where the point of novelty test was used).

⁶⁸ See Shin Chang, *The Proper Role of Functionality in Design Patent Infringement Analysis: A Criticism of the Federal Circuit Decision in Richardson v. Stanley Works, Inc.*, 19 TEX. INTELL. PROP. L.J. 309, 313 (2011) (explaining that in *Egyptian Goddess* the Federal Circuit stated that it was encouraging the use of illustrations in claim construction and discouraging the use of verbalized descriptions); *A New Test for Determining Design Patent Infringement Favors Patent Owners and Informs Design Strategies*, RATNERPRESTIA (Oct. 28, 2017), <https://www.ratnerprestia.com/2009/07/01/a-new-test-for-determining-design-patent-infringement-favors-patent-owners-and-informs-design-strategies/> [<https://perma.cc/M33T-U4FG>] (stating that, after the change to the design patent infringement test in *Egyptian Goddess*, the new ordinary observer test departs from the earlier ordinary observer that was created by the US Supreme Court in *Gorham*).

⁶⁹ See *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 783 F. Supp. 2d 216, 220 (D. Mass. 2011) (applying the claim construction inquiry to the design patent infringement analysis after the Federal Circuit decision in *Egyptian Goddess*); *Anchor Wall Sys. v. Rockwood Retaining Walls, Inc.*, 610 F. Supp. 2d 998, 1017 (D. Minn. 2009) (advising that the design patent infringement analysis involves a claim construction step at the beginning to construe the claim even after the change to the design patent infringement test). See also *Saverglass, Inc. v. Vitro Packaging, LLC*, 130 F. Supp. 3d 747, 751 (E.D.N.Y. 2015) (employing claim construction as the first inquiry in the design patent infringement analysis after the Federal Circuit's decision in *Egyptian Goddess*).

⁷⁰ See *Egyptian Goddess*, 543 F.3d at 679 (advising that, though claim construction is mandated, the district courts have had leeway to conduct the claim construction inquiry as the court sees fit); *Unique Concepts, Inc. v. Manuel*, No. 85 C 4181, 1986 WL 8039, at *4 (N.D. Ill. July 16, 1986) (addressing the inconsistencies of the claim construction inquiry in the design patent infringement analysis). Cf. *Continental Conveyor & Equip. Co. v. Prather*

Therefore, the court sought to clarify its position and supported a visual comparison of the designs through drawings and pictures of the accused and claimed designs as the preferred method of claim construction.⁷¹ Although the court did not foreclose the use of a written description, they opined that its use should be limited.⁷²

Next, the court addressed the two tests used to decide infringement.⁷³ First, the court decided that the ordinary observer test should be the only test used for design patent infringement, thereby eliminating the point of novelty test as the second test for deciding infringement.⁷⁴ The court stated that the point of novelty test had proven too unworkable and that the ordinary observer test could accomplish the goals of the point of

Sheet Metal Works, Inc., 709 F.2d 403, 405 (5th Cir. 1983) (noting that for a proper patent infringement inquiry, claim construction is required because the patent claim must be construed).

⁷¹ See *Nordock Inc. v. Systems Inc.*, 927 F. Supp. 2d 577, 587 (E.D. Wis. 2013) (finding that the preferred method of claim construction is using illustrations and not a detailed verbal description); *Safco Prods. Co. v. Welcome Prods., Inc.*, 799 F. Supp. 2d 967, 977 (D. Minn. 2001) (noting that the district court in this case was aware that the Federal Circuit warned against using a detailed verbal description of the design patent during the claim construction of the patented design). See also *Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1299, 1303-06 (Fed. Cir. 2010) (exemplifying the side-by-side comparisons of the drawing of the protected design and the accused design to establish the scope of the claim and infringement).

⁷² See *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 202 F. Supp. 3d 1186, 1191-92 (D. Or. 2016) (advising that the ordinary course of claim construction for the district court is not to attempt to construe a design patent through detailing a verbal description of the design); *P.S. Prods., Inc. v. Activision Blizzard, Inc.*, 140 F. Supp. 3d 795, 802 (E.D. Ark. 2014) (stating that the claim construction step does not have to include a detailed verbal description and that illustrations are preferred during claim construction for embodying the design); Chang, *supra* note 68, at 312-13 (detailing the claim construction step after the Federal Circuit Court's decision in *Egyptian Goddess* and how the court decided that the claim construction step could still include a detailed description, but the court should routinely refrain from a written description in favor of the design patent figures).

⁷³ See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124-25 (Fed. Cir. 1993) (applying both the ordinary observer test and the point of novelty test in the design patent infringement analysis); *John O. Butler Co. v. Block Drug Co.*, 620 F. Supp. 771, 777 (N.D. Ill. 1985) (discussing two tests for design patent infringement – the point of novelty test and the ordinary observer test – because the case was decided before *Egyptian Goddess*). See also Marta Kowalczyk, *Design Patent Infringement: Post Egyptian Goddess*, 2010 U. ILL. J.L. TECH. & POL'Y 239 (2010) (noting that both the ordinary observer test and the point of novelty tests were used in making the design patent infringement decision prior to the Federal Circuit Court eliminating the point of novelty test).

⁷⁴ See *Degelman Indus. Ltd. v. Pro-Tech Welding & Fabrication, Inc.*, No. 06-CV-6346, 2011 WL 6754051, at *15 (W.D.N.Y. May 27, 2011) (utilizing the ordinary observer test in the infringement analysis of a design patent and stating that the use of the ordinary observer test as the only test for design patent infringement was affirmed in *Egyptian Goddess*). See also *Cobra Fixations CIE Ltee-Cobra Anchors Co. v. Newell Operating Co.*, No. 1:09CV436, 2011 WL 1399785, at *3 (M.D.N.C. Apr. 13, 2011) (advising that the ordinary observer test is the only test that is applied in the design patent infringement analysis).

novelty test by ensuring that the person through which the infringement decision was being made was an ordinary observer educated in the prior art.⁷⁵

In effect, the Federal Circuit's decision in *Egyptian Goddess* collapsed some of the point of novelty test into the ordinary observer test.⁷⁶ The effect was that the ordinary observer standard was elevated because the court's version of the test implemented "a version of the ordinary observer test in which the ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art."⁷⁷ The ordinary observer's increased knowledge of the prior art presumes that the ordinary observer is knowledgeable about what is novel in the design and can then make an informed infringement decision based on this increased knowledge.⁷⁸ In this respect, the Federal Circuit's attempt to clarify the design patent infringement test in *Egyptian Goddess* created a whole new infringement analysis of the design patent infringement test with an elevated ordinary observer as the consumer and an eliminated point of novelty test.⁷⁹

⁷⁵ See Steve Kim, *Egyptian Goddess, Inc. v. Swisa, Inc.* 543 F.3d 665 (Fed. Cir. 2008), 19 DEPAUL J. ART, TECH. & INTELL. PROP. L. 173, 179 (2008) (providing that the point of novelty test's objective can be achieved by the ordinary observer test if the ordinary observer has knowledge of the prior art and stating that *Litton Systems'* point of novelty test was really the elevated ordinary observer test that the court applies now).

⁷⁶ See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (advising that the ordinary observer test can serve the function of the point of novelty test after the court's decision changed the ordinary observer by providing that the ordinary observer has knowledge of the prior art); Myshala E. Middleton, *Egyptian Goddess, Inc. v. Swisa, Inc.: Design Patent Infringement Revolutionized by an Egyptian Goddess*, 17 U. BALT. INTELL. PROP. L.J. 179, 185 (2009) (stating that aspects of the point of novelty test are still alive in the new ordinary observer test because the court incorporated some of the point of novelty test into the new ordinary observer test).

⁷⁷ Carani, *supra* note 57, at 374. See *Egyptian Goddess*, 543 F.3d at 676-77 (noting that the ordinary observer in the new design patent infringement test has knowledge of the prior art and is therefore more likely to focus on the novelty in the protected design). See also *Crocs*, 598 F.3d at 1303 (pointing out that the ordinary observer is familiar with the prior art when making the comparison of designs for the infringement decision).

⁷⁸ See Evan Szarenski, Note, *Egyptian Goddess, Inc. v. Swisa Inc.: A Dramatic Change in the Law of Design Patents?*, 8 PIERCE L. REV. 89, 107 (2009) (stating that under the modified ordinary observer created in *Egyptian Goddess* the ordinary observer has knowledge of the prior art that elevates the ordinary observer to a level more than what was presumed before, thereby incorporating some of the point of novelty test into the new ordinary observer test); Carani, *supra* note 57, at 376 (discussing the elevated ordinary observer test and advising that the new ordinary observer in the infringement test is extra-ordinary because of the knowledge of the prior art which risks giving the ordinary observer the knowledge closer to an expert than a person of ordinary intelligence as expressed in *Gorham*).

⁷⁹ See Carani, *supra* note 57, at 374 (advising that the elevated ordinary observer in the new design patent infringement test can be one of possibly four different versions: "(1) Straight *Gorham*; (2) Contextual Test; (3) Sliding Scale Test; and (4) Extra-Ordinary Observer Test").

III. ANALYSIS

The ordinary observer test the courts now rely on suffers from three main fundamental problems.⁸⁰ First, Part III.A discusses the problem with considering the whole product in the design patent infringement analysis.⁸¹ Second, Part III.B presents the problem of using the ordinary observer standard when making the infringement determination.⁸² Third, Part III.C analyzes the court's misplaced focus of the design patent infringement test on protecting consumers from deception.⁸³

A. *Problems Viewing the Products as a Whole in the Infringement Analysis Without Requiring Attention to the Points of Novelty*

The courts have remained steadfast in their decision to allow the factfinder making the infringement decision to view both the claimed design and the accused design as a whole in the infringement analysis.⁸⁴ Although well situated in some respects, analyzing each design as a whole without defining the points of novelty of each design undermines the purpose of design patents.⁸⁵ First, making the infringement determination

See also Anthonla Pomrening, Jori R. Fuller & George T. Lyons III, *The Analysis for Design Patent Infringement Post-Egyptian Goddess*, MBHB (2014), <https://www.mbhb.com/pubs/xpqPublicationDetail.aspx?xpST=PubDetail&pub=284> [<https://perma.cc/U5X9-PZP5>] (providing that it remains to be seen if the new ordinary observer test with the ordinary observer having the knowledge of the prior art will be a good test for the design patent infringement analysis).

⁸⁰ See *infra* Parts III.A–III.C.

⁸¹ See *infra* Part III.A (discussing how allowing the factfinder to look at the whole product when making an infringement determination leads to inconsistent findings).

⁸² See *infra* Part III.B (presenting the problem with viewing the infringement analysis through the lens of the ordinary observer).

⁸³ See *infra* Part III.C.

⁸⁴ See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008) (stating that the correct inquiry into the infringement decision should include whether the accused design encompasses the claimed design as a whole and that claim construction sets the protections); *Hutzler Mfg. Co., Inc. v. Bradshaw Int'l, Inc.*, No. 11 Civ. 7211(PGG), 2012 WL 3031150, at *4–7 (S.D.N.Y. July 25, 2012) (separating the infringement analysis from the claim construction step). See also *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010) (focusing the infringement analysis on whether the products as a whole are substantially similar). A familiarization of terms commonly used by the courts in design patent cases is helpful in understanding some of the terms in this Note. Courts routinely refer to the infringed design in infringement cases as the “claimed” design, while the alleged infringing design is called the “accused” product. See, e.g., *Torpso Hockey Int'l, Inc. v. Kor Hockey Ltd.*, 491 F. Supp. 2d 871, 873 (D. Minn. 2007) (referring to Torpso's skate as the accused product in which Kor must prove that its claimed design was infringed by). These terms will be used throughout this section to refer to the respective designs.

⁸⁵ See *Beckerman-Rodau*, *supra* note 32, at 72–73 (discussing the novelty requirement as a condition of getting design patent protection for a design). See also *Gorham Co. v. White*, 81 U.S. 511, 526 (1871) (explaining that the infringement analysis must hinge on the substantial

based on the whole design affords protections to non-novel aspects of a particular design.⁸⁶ Second, without making a factual determination of which parts of the design are novel and drawing attention to those aspects from the rest of the design, the factfinder is free to consider those non-novel aspects in the infringement analysis.⁸⁷

The first problem with looking at the whole product in the design patent infringement analysis is that doing so affords unwarranted protections to the non-novel aspects of the product.⁸⁸ The infringement analysis should center around the novel aspects of the claimed design.⁸⁹

similarity of the products from the “eye alone”). From early in the creation of the infringement analysis, the Supreme Court focused the test on whether the whole design was substantially similar based on the appearance of the designs. *Gorham's* approach to the infringement test involved making the infringement analysis through a side-by-side prior art analysis of the pictures instead of reading a written description of the design. See, e.g., *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (employing the *Gorham* approach to claim construction by utilizing a visual comparison of the claimed design).

⁸⁶ See Lee & Sunder, *Design Patents*, *supra* note 21, at 280–81 (providing that design patents were created to protect the ornamental features of a design); DuMont & Janis, *Origins*, *supra* note 14, at 838 (stating that design patents are “patents on a product’s visual appearance, not merely on the inventive components that make it work”). See also Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed. Cir. 1988) (noting that the ornamental features must be copied to find infringement of a design patent); Nicole R. Townes & Robert Roby, *Design Patents – The Often Forgotten, but Useful Protection for Accessories and a Designer’s Timeliness and Staple Pieces*, KNOBBE MARTENS (Feb. 6, 2017), <https://www.knobb.com/news/2017/02/design-patents---often-forgotten-useful-protection-accessories-and-designer's-timeless> [<https://perma.cc/4L67-W3Z5>] (reporting that design patents must be novel and merely ornamental). Understanding the ornamental features requirement of design patents is important in distinguishing design patents from their counterparts, utility patents. See, e.g., Amar Sehmi, *Do You Know the Difference Between a Utility Patent and a Design Patent?*, INVENTIA (Dec. 20, 2012), <http://inventiapatent.com/2012/12/20/do-you-know-the-difference-between-a-utility-patent-and-design-patent/> [<https://perma.cc/46KM-TWLC>] (pointing out the differences between utility patents and design patents and stating that design patents do not affect the function of the products but are instead the ornamental aspects of the product).

⁸⁷ See Tushnet, *supra* note 32, at 411–12 (explaining that viewing the design as a whole in the infringement analysis allows for the inclusion of non-novel or even functional aspects of the design to be erroneously considered by the factfinder when making the ultimate decision on whether the accused design infringed the claimed design). See also *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104 (Fed. Cir. 1996) (finding that the district court considered the claimed design too broadly by considering non-protected design aspects).

⁸⁸ See Tushnet, *supra* note 32, at 411–12 (positing that non-novel aspects should be afforded no protections in the infringement analysis); Cook, *supra* note 31, at 108–09 (outlining the novelty requirement for a design to be patentable).

⁸⁹ See *Cinn, S.A. v. Futura S.R.L.*, No. 03 Civ. 31(JSR), 2003 WL 22671466, at *1–2 (S.D.N.Y. Nov. 12, 2003) (focusing the infringement analysis on whether the novel aspects of the claimed design were present in the accused product); *Elmer*, 67 F.3d at 1577 (claiming that whether there is infringement depends on whether the accused design has incorporated the novel ornamental aspects of the claimed design). See also *Egyptian Goddess*, 543 F.3d at 678 (finding that comparison of the novel features of the claimed and accused designs is still part

However, the court's insistence on emphasizing a comparison of the whole claimed and accused designs without discussion of the novelty affords unnecessary protections to the non-novel aspects of the product not protected by the design patent.⁹⁰ Many times the products in question contain boilerplate, non-novel aspects that are incorporated into the overall design.⁹¹ These non-novel aspects should not be protected under design patent law and, as such, should not be afforded protections merely because the infringement decision is trying to decide whether the novelty of the designs are substantially similar.⁹² Protecting non-novel aspects of the design erroneously affords protections to design aspects already in manufacture and not patentable.⁹³ Protection of non-novel designs is in stark contrast to what design patents are intended to protect.⁹⁴ As one

of the infringement analysis but must be done through the ordinary observer test, not a separate isolation test).

⁹⁰ See *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1335 (Fed. Cir. 2015) (discussing the requirement for the infringement analysis to include viewing the "claimed design as a whole, and not in the context of separate elements in isolation"); *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006) (holding that it is considered legal error not to view the designs as a whole); *Deckers Outdoor Corp. v. J.C. Penny Co.*, 45 F. Supp. 3d 1181, 1186 (C.D. Cal. 2014) (stating that the infringement analysis should include a visual comparison of the claimed and accused designs as a whole).

⁹¹ See, e.g., *Sofpool LLC v. Kmart Corp.*, No. CIV. S-10-3333 LKK/JFM, 2013 WL 2384331, at *4-5 (E.D. Cal. May 30, 2013) (comparing two pools that were almost exactly the same except that one was smaller than the other); *Wing Shing Prods. Co. Ltd. v. Sunbeam Prods., Inc.*, 665 F. Supp. 2d 357, 365-67 (S.D.N.Y. 2009) (evaluating the design patents on two coffeemakers that were exactly the same except that the base on one of the coffeemakers was round and the other was square).

⁹² See *DuMont & Janis, Origins*, *supra* note 14, at 878-79 (outlining the novelty requirement for issuance of a design patent); *Saidman, Egyptian Goddess*, *supra* note 54, at 871-72 (discussing the novelty requirement for design patent protections and finding that the test for design patent infringement is substantial similarity to the ordinary observer); *Gorham Co. v. White*, 81 U.S. 511, 528 (1871) (establishing the test for design patent infringement as whether the claimed and accused designs are substantially similar to an ordinary observer).

⁹³ See *Tushnet*, *supra* note 32, at 411 (expressing concern over how "factfinders [are] to avoid potentially broadening the scope of the design patent too far when an accused design looks like a patented design because of similarities in . . . unprotectable features"); *Saidman, Egyptian Goddess*, *supra* note 54, at 871 (mentioning briefly the issue with overbroad assertions by the factfinder to include non-protected design aspects in the infringement analysis). See also *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104 (Fed. Cir. 1996) (reversing the infringement decision because the district court incorrectly viewed the claimed design too broadly); *A.C. Dike, Egyptian Goddess v. Swisa: What Is the Point*, 8 NW. J. TECH. & INTELL. PROP. 116, 124 (2009) (stating that the infringement analysis "fails to address the issue of design patent protection in instances where the accused design does not contain the novel features that rendered the design patentable"). Feasibly, the accused product could be found to be infringing on the claimed design despite the fact that it didn't copy any of the novel features that the design patent is protecting because they look substantially similar in appearance as a whole.

⁹⁴ See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 6:11 (5th ed.) (discussing design patents and trademarks and outlining what a design patent does

author has stated, “[i]t is no longer the law that the defendant must incorporate the very thing that makes the patented invention patentable. That can’t possibly be the right rule.”⁹⁵

Second, allowing the factfinder to consider the product as a whole in the infringement analysis allows the factfinder to make the infringement determination including these non-novel aspects of the design.⁹⁶ As stated above, these aspects should not be afforded protections by the court because design patents only protect innovative novel design elements.⁹⁷ The infringement analysis is skewed by allowing the factfinder to include these boilerplate design aspects because often similar products will contain the same non-novel design aspects.⁹⁸ Therefore, it becomes too

not cover); Arnold B. Silverman, *What Are Design Patents and When Are They Useful?*, JOM (1993), <http://www.tms.org/pubs/journals/JOM/matters/matters-9303.html> [<https://perma.cc/BGJ3-WQVG>] (stating that to “qualify for a design patent, the subject must be new in the sense that no single, identical design exists in the prior art, it must satisfy the ornamental standards, and it must be original to the inventor or inventors seeking protection”); United States Patent & Trademark Off., *General Information Concerning Patents*, USPTO (Oct. 2015), <https://www.uspto.gov/patents-getting-started/general-information-concerning-patents#heading-30> [<https://perma.cc/AT6Q-76NM>] (providing that design patents protect the appearance of the novel ornamental design aspects of a product).

⁹⁵ Mark A. Lemley, *Point of Novelty*, 105 NW. U. L. REV. 1253, 1271 (2011).

⁹⁶ See *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1303–04 (Fed. Cir. 2010) (explaining that the factfinder will likely attach added importance to the differences in the overall effect of the design); Tushnet, *supra* note 32, at 420 (noting that we should “want to prevent findings of infringement when two designs are only similar in non-novel aspects”); Thomas Leach, *What Features Matter in a Design Patent Case?*, LAW 360 (Feb. 9, 2015), <https://www.merchantgould.com/portalsresource/Leach-WhatFeaturesMatterInADesignPatentCase-Law360.pdf> [<https://perma.cc/6ZMA-H3WD>] (“[C]ases suggest that some courts take into account . . . unclaimed feature(s), but at least one court has refused to do so explaining the infringement inquiry focuses on the appropriation of the patented design, and an additional, unclaimed element does not prevent infringement.”).

⁹⁷ See *Nadel*, *supra* note 40, at 355 (discussing the court’s finding of non-infringement when the design aspects of the claimed design are not unique and therefore not afforded protections). See also *Horwitt v. Longines Wittnauer Watch Co., Inc.*, 388 F. Supp. 1257, 1260 (S.D.N.Y. 1975) (stating that the claimed design “must produce a new impression upon the eye”). For an example of the novelty requirement, imagine that a designer files an application for a design patent on the overall design of a new keyboard. The factfinder should not include the general layout of the keyboard—unless it is atypical—in the infringement analysis because the usual organization of a keyboard is not novel as keyboard designers use the same basic letter arrangement on keyboards so that you can become familiar with the layout and type quicker.

⁹⁸ See *Wing Shing Prods. Co. Ltd. v. Sunbeam Prods., Inc.*, 665 F. Supp. 2d 357, 364–65 (S.D.N.Y. 2009) (viewing two coffeemakers for the purpose of infringement of the claimed coffeemaker’s design patent and holding that there was not infringement even though the coffeemakers contained all the same boilerplate parts of a coffeemaker and only differed in the shape of the base at the bottom of the coffeemakers). See also *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1335–36 (Fed. Cir. 2015) (analyzing health care equipment that contained almost the exact same boilerplate parts but were different in style); *Sofpool LLC v. Kmart Corp.*, No. CIV. S-10-3333 LKK/JFM, 2013 WL 2384331, at *4–5 (E.D. Cal. May

easy for the factfinder to find that the overall appearance of the designs “just look alike to me” even though the novel aspects of the designs are very different.⁹⁹ This misplaced focus can steer factfinders into making incorrect determinations of infringement.¹⁰⁰

Without requiring the design patent holder to identify the novel points of his design, there is nothing tethering the factfinder to focus on the novelty in making the infringement decision.¹⁰¹ Instead, the factfinder can find infringement when the accused design looks like the claimed design but doesn’t even incorporate any of the aspects the design patent protects.¹⁰²

B. Problems Associated with Using the Current Ordinary Observer Standard

The use of the ordinary observer in the infringement analysis has been said to be “more easily stated than applied.”¹⁰³ After *Egyptian Goddess*, the court applies the infringement analysis exclusively through the lens of an ordinary observer familiar with the prior art.¹⁰⁴ The ordinary observer in

30, 2013) (looking at two pools that were the same in every aspect except that they were not in the same proportions).

⁹⁹ Tushnet, *supra* note 32, at 417. See *Arc’teryx Equip. v. Westcomb Outerwear Inc.*, No. 2:07-CV-59 TS, 2008 WL 4838141, at *3 (D. Utah Nov. 4, 2008) (finding non-infringement of a zipper on outerwear because of the small differences in the zipper’s characteristics and placement). *But see Crocs*, 598 F.3d at 1303–04 (overturning the U.S. Trade Commission’s finding of non-infringement because the Commission looked at the small differences in isolation and decided that the shoes in question were not substantially similar because the novel designs contained differences sufficient to find that they were not substantially similar).

¹⁰⁰ See Tushnet, *supra* note 32, at 420 (explaining that we should “want to prevent findings of infringement when two designs are only similar in non-novel aspects”). See also *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1296 (Fed. Cir. 2010) (stating that deceptive similarity can result from an overbroad view of the overall design of the claim and accused designs); *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104 (Fed. Cir. 1996) (explaining that an overbroad construction of the claimed or accused designs can lead to an erroneous finding of infringement).

¹⁰¹ See Ngo, *supra* note 60, at 130–31 (providing a detailed analysis of the ordinary observer and point of novelty tests and stating that without having to show any points of novelty, the patent holder easily avoids summary judgement and therefore eliminates the point of novelty test, lowering the bar for design patent infringement for the patent holder).

¹⁰² See sources cited *infra* note 136 (discussing how the design patent infringement test after *Egyptian Goddess* has turned its focus on substantial similarity of the designs without any focus on the novel aspects of the design that the design patent requires to get issued and that design patents therefore protect).

¹⁰³ *Hutzler Mfg. Co., Inc. v. Bradshaw Int’l, Inc.*, No. 11 Civ. 7211 (PGG), 2012 WL 3031150, at *4–7 (S.D.N.Y. July 25, 2012).

¹⁰⁴ The term “prior art” refers to the prior knowledge of products that are in the same marketplace as the accused and claimed designs. See Gene Quinn, *What Is Prior Art?*, IPWATCHDOG (Oct. 2, 2010), <http://www.ipwatchdog.com/2010/10/02/what-is-prior-art/id=12677/> [<https://perma.cc/3B32-PCFE>] (discussing what the term prior art means in

this context is a consumer who has some knowledge about the market in which the accused and claimed products exist because he is familiar with the prior art.¹⁰⁵

The use of an ordinary observer in the design patent infringement analysis creates two problems.¹⁰⁶ First, the ordinary observer test created in *Egyptian Goddess* is too hard to apply, requiring the factfinder to adjust what an ordinary observer is on a sliding scale based on the ordinary observer's knowledge of the market.¹⁰⁷ Second, viewing the infringement test through the elevated ordinary observer standard created in *Egyptian Goddess* eliminates jurors from making infringement determinations based on their own perceptions.¹⁰⁸

the patent context). The factfinder uses the prior art for a three-part comparison through the lens of the ordinary observer. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (holding that “the ordinary observer test should be the sole test for determining whether a design patent has been infringed” and holding that the infringement analysis should be a three-part comparison involving the prior art.). See also Bowen, *supra* note 57, at 149 (explaining how the Federal Circuit made the ordinary observer test the sole test for design patent infringement); Carani, *supra* note 57, at 370–71 (discussing the new ordinary observer test that was created in *Egyptian Goddess* and how it operates in relation to the previous ordinary observer test).

¹⁰⁵ See *Egyptian Goddess*, 543 F.3d at 672–74 (discussing how the ordinary observer is one that is presumed to have knowledge of the prior art); *Keystone Retaining Wall Sys., Inc. v. Westrock*, 997 F.2d 1444, 1450 (Fed. Cir. 1993), (applying the ordinary observer as an ordinary buyer of retaining wall blocks); *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933) (stating that the ordinary observer is “someone who has average familiarity with such instrumentalities” but is not an expert). See also Paula Natasha Chavez, *The Standard for Determining Infringement of a Design Patent*, 73 J. PAT. & TRADEMARK OFF. SOC'Y 843, 844 (1991) (quoting *Gorham's* explanation of how the ordinary observer test operates in the infringement analysis).

¹⁰⁶ See Bowen, *supra* note 57, at 154–55 (explaining problems with the ordinary observer and how much knowledge of the prior art the ordinary observer should have when considering whether the accused design has infringed the claimed design); Danielle E. Baudhuin, *Siri v. Google: Updating the “Ordinary Observer” Test for Design Patent Litigation in the United States in Response to the Apple v. Samsung Disputes*, 33 WIS. INT'L L.J. 290, 312–13 (2015) (pointing out that the ordinary observer test underestimates how much consumers know about the products that they buy); Carani, *supra* note 57, at 370–71 (summarizing the new ordinary observer test that was created in *Egyptian Goddess* and how it operates in relation to the previous ordinary observer test).

¹⁰⁷ See Bowen, *supra* note 57, at 153–56 (discussing the restrictions of using the ordinary observer in the infringement analysis because it undervalues consumer knowledge); Baudhuin, *supra* note 106, at 312–13 (stating that the ordinary observer test underestimates consumer's knowledge about products that they buy). See also *Braun, Inc. v. Dynamics Corp. Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992) (holding that consumers may be more easily deceived because of the unsophisticated nature of blender purchases). But see *Cardiac Pacemakers, Inc. v. Coratomic, Inc.*, 535 F. Supp. 280, 286 (D. Minn. 1982) (elevating the knowledge of the ordinary observer because the market of the claimed and accused designs were pacemakers, which are expensive to buy).

¹⁰⁸ See Carani, *supra* note 57, at 370–71 (elaborating on the new ordinary observer test that was created in *Egyptian Goddess* and how it operates in relation to the previous ordinary

To begin with, the court's use of the ordinary observer in the infringement analysis is too difficult to apply.¹⁰⁹ The ordinary observer test presumes that the consumer, with whom the infringement analysis is decided, has some knowledge about the market for the claimed and accused designs.¹¹⁰ The ordinary observer's knowledge is limited, however, and can be as limited as someone who is familiar with the marketplace merely by shopping for like items.¹¹¹

Conversely, the ordinary observer has also been held to have knowledge almost commensurate to that of an expert in a sophisticated market.¹¹² It is between these sophisticated and ordinary product markets, however, that the ordinary observer floats in limbo like a ghost stuck between reality and the afterlife.¹¹³ It is the factfinder who then must

observer test on juries who are trying to make the infringement decision through the ordinary observer); Jeanna C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1301-02 (2014) (outlining the ordinary observer and the design patent infringement's shift away from a point of novelty and moving to a focus on consumers).

¹⁰⁹ See Md Reaz Uddin, Nusrat Zahan Lopa & Md. Oheduzzaman, *Factors Affecting Customers' Buying Decision of Mobile Phone: A Study on Khulna City, Bangladesh*, 5 INT'L J. MANAGING VALUE & SUPPLY, no. 2, June 2014 (discussing the various factors that consumers use when making a decision on which cellular phone they should purchase). A study about factors in cellular phone purchasing decisions is especially relevant in the realm of design patents where arguably the most mainstream case that put design patents in the spotlight for many was *Apple v. Samsung*. See also Elizabeth Mott, *Psychological Factors That Influence Consumer Buying Behavior*, CHRON. (Sept. 27, 2017), <http://smallbusiness.chron.com/psychological-factors-influence-consumer-buying-behavior-80618.html> [<https://perma.cc/F56F-XHZX>] (noting the many different psychological factors that go into why consumers make certain purchases).

¹¹⁰ See Jonathan E. Moskin, *The Shape of Things to Come—Emerging Theories of Design Protection*, 92 TRADEMARK REP. 681, 702-03 (2002) (stating that the ordinary observer is a non-expert but someone who has encountered or purchased a product in the claimed and accused design's marketplace). See also *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 202 F. Supp. 3d. 1186, 1191-92 (D. Or. 2016) (proclaiming that the ordinary observer is a retail consumer and is not a commercial purchaser).

¹¹¹ See *Hutzler*, 2012 WL 3031150, at *6 (explaining that the ordinary observer is someone who has not only purchased the item but also shopped for similar items in that marketplace in the past). *Hutzler* shows the great subjectivity the factfinder has when deciding to what extent the consumer is familiar with the prior art. *Id.* Someone who has merely shopped for an item in the past is not likely to have been exposed to the prior art enough to be an ordinary observer in almost any definition of the term the court wants to use. See, e.g., *Applied Arts*, 67 F.2d at 430 (including in the ordinary observer definition a consumer who is not a purchaser of products in the market but is "one interested in the subject").

¹¹² See *Cardiac Pacemakers*, 535 F. Supp. at 286 (elevating the ordinary observer's knowledge of the prior art in the case of infringement of pacemakers because pacemakers are expensive and the consumer is usually a specialized physician); Carani, *supra* note 57, at 359-63 (discussing the problems associated with the elevation of the ordinary observer to someone with knowledge in the prior art).

¹¹³ When the ordinary observer is clear because the patented designs are in a sophisticated or unsophisticated market, the factfinder has little trouble with defining who the ordinary

subjectively determine how much knowledge the ordinary observer has when it is clear that the ordinary observer in that market is not a sophisticated buyer who can distinguish among the product designs easily but is also not an unsophisticated buyer who will be easily deceived.¹¹⁴ Pinpointing the knowledge of the ordinary observer in this area is difficult for the factfinder, and the ordinary observer standard often becomes “too restrictive” and results in “not giv[ing] consumers enough credit for the knowledge they have about the products they choose to buy.”¹¹⁵

Although in some cases, the court has attempted to heighten the standard based on the elevated knowledge possessed by the ordinary observer, it has been challenging.¹¹⁶ The application of this elevated ordinary observer standard has resulted in inconsistent findings of how much prior knowledge the ordinary observer has.¹¹⁷

observer is. See *Cardiac Pacemakers*, 535 F. Supp. at 286 (elevating the ordinary observer’s knowledge of the prior art when there was a sophisticated market and a sophisticated buyer). But see *Hutzler*, 2012 WL 3031150, at *6 (stating that the ordinary observer should be viewed as less knowledgeable about the market because the product was inexpensive); *Braun*, 975 F.2d at 820 (lowering the knowledge of the ordinary observer when the claimed and accused designs were blenders and the court took note of testimony that purchasers of blenders usually bought them as impulse buys without any prior thought).

¹¹⁴ See *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, No. 6:12-cv-33-Orl-28DAB, 2013 WL 12156465, at *6 (M.D. Fla. Jan. 4, 2013) (finding that the ordinary observer is the ultimate purchaser of the boat that incorporated the windshield in question and was not the boat builders that purchased the windshield and put them onto the boats during the building process). See generally *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1321 (Fed. Cir. 2007), *abrogated by* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008) (pointing out that the “question that is central to this case, and every design patent case, is the identity of the ordinary observer of the design at issue”).

¹¹⁵ See *McIntire v. Sunrise Specialty Co.*, 944 F. Supp. 2d 933, 938 (E.D. Cal. 2013) (explaining first that the ordinary observer is a man of ordinary intelligence, but then stating that the ordinary observer “must not be too ordinary” and has knowledge of the prior art of the marketplace in which the accused product and claimed design exist).

¹¹⁶ See *Minka Lighting, Inc. v. Craftmade Intern., Inc.*, No. 3-00-cv-0888-x, 2001 WL 1012685, at *11 (N.D. Tex. Aug. 20, 2001) (reasoning that “because the qualifications of the ordinary observer may change depending on the nature of the accused infringing product, at least in theory, the scope of a design patent claim could therefore change as well, *i.e.*, a relatively sophisticated or discerning ordinary observer would presumably accord less scope to a design patent claim than an unsophisticated ordinary observer”). See also *Cardiac Pacemakers, Inc. v. Coratomic, Inc.*, 535 F. Supp. 280, 286 (D. Minn. 1982) (holding that the ordinary observers of pacemakers are the physicians that buy them, not the patients who pay for them).

¹¹⁷ Compare *Spotless Enters., Inc. v. A & E Prods. Grp. L.P.*, 294 F. Supp. 2d 322, 347 (E.D.N.Y. 2003) (ruling that the buyer of the patented design product was not the general consumer purchasing the product but instead was the sophisticated company in the garment industry), with *Puritan-Bennett Corp. v. Penox Tech., Inc.*, No. IP02-0762-C-M/S, 2004 WL 866618, at *4 (S.D. Ind. Mar. 2, 2004) (finding that the ordinary observers of portable liquid oxygen devices were chronic obstructive pulmonary disease patients and not the medical

For example, in *Apple v. Samsung*, a jury awarded over one billion dollars to Apple in a patent lawsuit against Samsung that included infringing the design patents on Apple's smartphones and tablets.¹¹⁸ The jury applied the ordinary observer test and found that an ordinary observer of the smartphone and tablet market would be deceived into buying a Samsung smartphone or tablet, thinking it to be an Apple product.¹¹⁹ The jury failed to elevate the ordinary observer to the level of practical knowledge for this market.¹²⁰ Apple's smartphone and tablet consumers are immensely knowledgeable about this market and would have been highly knowledgeable of the design differences, including the difference in the rounded corner design protected by Apple's design patent.¹²¹ Knowledge of the market should have been an extraordinary

equipment dealers that usually purchase the devices before selling them to the patients for use), and *Pacific Coast*, 2013 WL 12156465, at *6 (stating that the ordinary observer of a windshield on boats was the ultimate boat purchaser and not the company that purchased the windshields to assemble the boat).

¹¹⁸ See News Desk, *Apple Wins \$1 Billion Patent Infringement Suit Against Samsung*, PBS NEWSHOUR (Aug. 24, 2012), <http://www.pbs.org/newshour/rundown/court-ruling-on-apple-samsung-lawsuit-over-patent-infringements/> [<https://perma.cc/5L9K-HLGV>] (summarizing the facts of the lawsuit and the subsequent award for Apple, including infringement of some of its design patents on smartphones and tablets); Nick Wingfield, *Jury Awards \$1 Billion to Apple in Samsung Patent Case*, N.Y. TIMES (Aug. 24, 2012), <http://www.nytimes.com/2012/08/25/technology/jury-reaches-decision-in-apple-samsung-patent-trial.html> [<https://perma.cc/WAK8-PQ4W>] (outlining Apple's one billion dollar award for infringement of Apple's patents including design patents).

¹¹⁹ See *Apple, Inc. v. Samsung Electronics Co.*, 678 F.3d 1314, 1320 (Fed. Cir. 2012) (stating that "the court found that both the Galaxy S 4G and the Infuse 4G phones had an overall design that an ordinary observer would likely find substantially the same as the claimed . . . design and that those phones were likely to infringe"). See also Charles Babcock, *Apple Wins \$1.05 Billion in Samsung Patent Case*, INFO. WEEK (Aug. 24, 2012), [https://www.informationweek.com/mobile/mobile-devices/apple-wins-\\$105-billion-in-samsung-patent-case/d/d-id/1105973](https://www.informationweek.com/mobile/mobile-devices/apple-wins-$105-billion-in-samsung-patent-case/d/d-id/1105973) [<https://perma.cc/ZA92-9Q3Z>] (advising that the jury had found that Samsung had willfully violated four of Apple's design patents).

¹²⁰ Cf. Stephen Zoeller, *How Apple Uses Consumer Behavior Marketing to Win*, STEPHEN ZOELLER'S MARKETING BLOG (June 23, 2017), <http://www.stephenzoeller.com/how-apple-consumer-behavior-marketing/> [<https://perma.cc/H4SE-9X59>] (saying that the "brand loyalty of Apple dominates the physical environment and therefore captures significant attention and focus in the retail (consumer) environment"); Stuart Elliot, *Apple Passes Coca-Cola as Most Valuable Brand*, N.Y. TIMES (Sept. 29, 2013), <http://www.nytimes.com/2013/09/30/business/media/apple-passes-coca-cola-as-most-valuable-brand.html> [<https://perma.cc/Q2V7-AA5C>] (setting out how Apple has become the most valuable brand in the World).

¹²¹ Apple's smartphones and tablets are so popular it is hard to imagine how the ordinary observer could be deceived by Samsung's smartphones and tablets. See Jordan Golson, *51% of U.S. Households Own an Apple Product*, MACRUMORS (Mar. 28, 2012), <https://www.macrumors.com/2012/03/28/51-of-us-households-own-an-apple-product/> [<https://perma.cc/K4ZA-W9XW>]; Sam Costello, *How Many iPhones Have Been Sold Worldwide?*, LIVEWIRE (July 1, 2017), <https://www.lifewire.com/how-many-iphones-have->

hurdle for Apple to overcome in showing that the ordinary observer would be deceived in this marketplace.¹²² However, the jury still found infringement, and, as a result, the consumers of these electronics were the real losers. Samsung predicted that the court's finding of infringement would result in higher prices for Samsung products.¹²³ This exemplifies the problem that the factfinder faces when trying to define how much knowledge the ordinary observer is supposed to have about the prior art in the marketplace.¹²⁴

Finally, the ordinary observer standard created by the Federal Circuit in *Egyptian Goddess* does not encourage jurors to make the infringement decision based on whether they think the accused design has incorporated the novelty of the claimed design.¹²⁵ Instead, jurors must detach

been-sold-1999500 [<https://perma.cc/RTE6-TUKN>] (showing that one billion iPhones have been sold worldwide).

¹²² See Golson, *supra* note 121 (stating that over half of all households in the U.S. have an Apple product); Costello, *supra* note 121 (reporting that one billion iPhones have been sold worldwide).

¹²³ See *Apple*, 678 F.3d at 1320 (stating the jury found that Samsung smartphones infringed the design patents on Apple's smartphones); Wingfield, *supra* note 118 (quoting a statement from Samsung that "the decision was a loss for the American consumer [and i]t will lead to fewer choices, less innovation, and potentially higher prices").

¹²⁴ Compare *Apple*, 678 F.3d at 1320 (presenting that a jury found that an ordinary observer that buys Apple smartphones would be deceived into buying a Samsung phone thinking it to an Apple phone), with *Poly-Am., LP v. API Indus., Inc.*, 74 F. Supp. 3d 684, 694 (D. Del. 2014) (holding that the ordinary observer's knowledge in this case included the disassembly of the box in question for recycling in deciding whether the consumer would be confused). If the ordinary observer test was extended to whether the ordinary observer would be deceived not just from viewing the product on the shelf, but extended further to include the box the product comes in, it is even harder to imagine that a consumer of Apple smartphones would be confused when its new smartphone came in a Samsung box or failed to come in a distinctly marketed Apple box, which Apple claims is a part of the Apple experience. See Kirk McElhearn, *Wrapping It Right: In Praise of Apple's Packaging*, MACWORLD (Aug. 20, 2015), <https://www.macworld.com/article/2973339/tech-events-dupe/wrapping-it-right-in-praise-of-apple-s-packaging.html> [<https://perma.cc/JF89-QPB4>] (discussing the great experience that consumers have when getting and unpacking their new Apple products and is the first step in the Apple experience); *How Packaging Gives Apple's Buyers a Sensory Experience That Reinforces Brand*, PERSONALICS (Feb. 3, 2016), <https://www.personalics.com/2016/02/03/sensory-design-packaging/> [<https://perma.cc/Y5S6-TAKE>] (reporting on the sensory experience Apple consumers go through when they receive an Apple product and how Apple's packaging is perceived by consumers to be part of product).

¹²⁵ See Carani, *supra* note 57, at 362-63 (scrutinizing the elevated ordinary observer and stating that juries should be able to make their own determinations as people of ordinary sensibilities). But see *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820-21 (Fed. Cir. 1992) (stating that the jury may not always require empirical evidence that the ordinary observer would find infringement if the jury makes a determination that the claimed and accused design side-by-side are not substantially similar); *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1371-72 (Fed. Cir. 2006) (ruling that jurors can serve as the ordinary observers and decide the infringement analysis on whether they would be deceived). These two cases, *Braun* and *Amini*, are in the small minority of cases where jurors

themselves from the analysis and attempt to put themselves into the body of the hypothetical ordinary observer with prior knowledge of the art.¹²⁶ This elevated ordinary observer is contrary to the Supreme Court's precedent in *Gorham*, which established the use of the ordinary observer, and, as noted above, is difficult for juries to pinpoint.¹²⁷

Unfortunately, jurors must put their "sensibilities and perceptions" aside and attempt to decide if someone else would find that the design patent has been infringed.¹²⁸ This creates an undue burden on jurors who must already attempt to learn about the complexities involved in the scope of the design patent litigation.¹²⁹ These jurors are then asked to make an infringement decision assuming the knowledge of an ordinary observer,

were held to be competent to act as ordinary observers and decide whether they thought the designs were substantially similar enough to find infringement. See James L. Buckwalter, Annotation, *Application of Ordinary Observer Test in Action for Infringement of Design Patent*, 52 A.L.R. Fed. 2d 353 (2011) (listing *Braun* and *Amini* as the only two cases under which the jurors were able to serve the role of ordinary observer in making the design patent infringement determination).

¹²⁶ See *Tecumseh Prod. Co. v. Briggs & Stratton Corp.*, 295 F. Supp. 2d 902, 912 (E.D. Wis. 2003) (suggesting that the jury should decide infringement of design patent for a motor from the perspective of a retail purchaser of lawnmowers). See also *Nordick Inc. v. Systems Inc.*, 927 F. Supp. 2d 577, 599 (E.D. Wis. 2013) (outlining the argument of one of the parties that the ordinary observer for dock levelers should have special knowledge about the appearance of the front of the levelers because it is important to consumers that purchase them).

¹²⁷ See *Gorham Co. v. White*, 81 U.S. 511, 528 (1871) (describing the ordinary observer as a person who is of "ordinary intelligence" and not "a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side"). See also Carani, *supra* note 57, at 362–63 (discussing how the new ordinary observer test deviates from the test created in *Gorham*); Mueller & Brean, *Impossible Issue*, *supra* note 38, at 527–28 (explaining the *Gorham* ordinary observer and suggesting that the ordinary observer contemplated in *Gorham* is closer to an ordinary person because the term ordinary was used instead of the other option, which was to view the infringement analysis through the lens of an expert observer who would be able to view small differences in the accused and claimed designs and would be much less likely to find infringement of a design).

¹²⁸ Carani, *supra* note 57, at 377. See *Cardiac Pacemakers, Inc. v. Coratomic, Inc.*, 535 F. Supp. 280, 286 (D. Minn. 1982) (elevating the ordinary observer and requiring the factfinder to put themselves into the role of a doctor who is familiar with the prior art of pacemakers in making the decision about whether the design patent for the pacemaker was infringed). See also *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 424 F. Supp. 2d 1188, 1199 (C.D. Cal. 2006) (stating that ordinary observers can be experts if they are ordinary consumers, which would force the factfinder into making the infringement decision as an expert in the prior art of the marketplace of the accused product and the claimed design).

¹²⁹ See, e.g., Susan F. Farley, Christopher V. Carani, Alan N. Herda, Matthew W. Jupina, Thomas T. Moga, Damian D. Porcari & Chris Renk, *Model Design Patent Jury Instructions*, INTELL. PROP. OWNERS ASS'N (Aug. 19, 2010), <http://www.ipo.org/wp-content/uploads/2013/03/Juryinstructionsarticle.pdf> [<https://perma.cc/67C3-HKQA>] (comprising sixty-nine pages of potential jury instructions that should be given to the jury in a design patent lawsuit).

though, the jurors themselves may lack the requisite knowledge of the ordinary observer for that product.¹³⁰

The ordinary observer standard is, at best, a slippery concept that the factfinder will struggle to grasp.¹³¹ Asking the factfinder to pinpoint this hypothetical observer overreaches what should be required of jurors and neglects the fact that jurors are well qualified to make the infringement decision based on their own sensibilities.¹³²

C. *Design Patent Infringement's Misplaced Focus on Consumer Deception*

The last step in the current design patent infringement analysis is deciding whether the ordinary observer would be deceived into buying one product thinking it to be the other.¹³³ If the factfinder finds that the accused product is substantially similar to the claimed design as to create this deception, then the accused product infringes on the patented design.¹³⁴ In tying the substantial similarity finding to the deception of

¹³⁰ The ordinary observer can even have knowledge of the products that are outside what the factfinder, especially a juror, would even have access to during the trial. *See, e.g.,* *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1381 (Fed. Cir. 2002) (expanding the ordinary observer's knowledge of the products to include anything that would be visible during normal use of the product, not just the ornamental features that the factfinder would observe in viewing the products in the visual comparison).

¹³¹ *Compare* *Middleton*, *supra* note 76, at 180 (advising that the ordinary observer in *Gorham* is not an ordinary observer with expert knowledge but is instead an ordinary purchaser of products in the market of the designs), *with* *Spotless Enters., Inc. v. A & E Prods. Grp. L.P.*, 294 F. Supp. 2d 322, 347 (E.D.N.Y. 2003) (holding that the buyer of the patented design product was the sophisticated garment industry company instead of the consumer that ultimately purchased the garments).

¹³² *See* *Carani*, *supra* note 57, at 377 (discussing that jurors are more than able to make the infringement decision themselves as the ordinary observers). *See also* sources cited *supra* note 59 (citing sources discussing the knowledge that the ordinary observer may have and how the jury can possess enough knowledge to make the infringement decision).

¹³³ *See* *Chang*, *supra* note 68, at 316 (explaining the ordinary observer test created in *Egyptian Goddess* and stating that the test for design patent infringement involves deciding whether the ordinary observer would be deceived into buying one product thinking it to be the other product for a finding of infringement). It is only required that the factfinder determine that the ordinary observer is likely to be deceived because the product's designs are substantially similar, and there is no requirement that there actually be shown that anyone was deceived into buying the product thinking that it was the other product. *See* *Apple, Inc. v. Samsung Elec. Co., Ltd.*, 786 F.3d 983, 999–1000 (Fed. Cir. 2015) (holding that Apple was not required to show that any Apple customers were actually deceived into buying a Samsung phone thinking that it was an Apple phone, but that the phones were so substantially similar that it was likely that the ordinary observer would be deceived).

¹³⁴ *See* *Hosley Int'l Trading Corp. v. K Mart Corp.*, 237 F. Supp. 2d 907, 910 (N.D. Ill. 2002) (applying the ordinary observer test established in *Gorham*, and advising that to find infringement the ordinary observer must find that the products are substantially similar as to deceive the ordinary observer into thinking one is the other); *Moen Inc., v. Foremost Int'l Trading Inc.*, 19 F. Supp. 2d 854, 855 (N.D. Ill. 1998) (stating that the test for design patent

the ordinary observer, the courts are utilizing a consumer approach to the infringement analysis seemingly unfit for design patents.¹³⁵

Using consumer deception as the lynchpin to the finding of infringement unmoors the infringement analysis from protecting the innovative aspects of designs and instead hinges protections on the consumer of the product.¹³⁶ Protection through the lens of the consumer is more consistent with the goal of trademark law than that of design patent law.¹³⁷ By focusing the infringement analysis on the consumer, courts have interwoven the trademark objectives into the design patent

infringement involves a determination of whether the ordinary observer would be deceived by the infringing product design); *Herbko Int'l, Inc. v. Gemmy Indus. Corp.*, 916 F. Supp. 322, 326 (S.D.N.Y. 1996) (holding that a game design was not infringed because the aspects of the design that were incorporated in the accused design were not sufficient to deceive the ordinary observer into buying one of the games thinking that the other game had been purchased).

¹³⁵ See Fromer & Lemley, *supra* note 108, at 1274 (advising that the infringement test for design patents, like the trademark test, comprises an audience composed of reasonable purchasers of the products and that the audience in design patents is just merely asked a different question); Horta, *supra* note 24, at 129 (discussing the erroneous overlap of trade dress and design patents even though they seek to protect different things and have very different protection objectives).

¹³⁶ Mark A. Lemley, *Point of Novelty*, 105 NW. U. L. REV. 1253, 1271 (2011) (criticizing the elimination of the identification of the novelty of the claimed design in the design patent infringement analysis and stating that infringement can be found when the accused design does not incorporate the point of novelty but does deceive the ordinary observer who is the everyday consumer in the marketplace in which the accused and claimed designs exist). See Fromer & Lemley, *supra* note 108, at 1301-02 (outlining how *Egyptian Goddess* has shifted the design patent infringement analysis almost completely to market substitution instead of concentrating on the similarities in the accused and claimed designs to determine infringement).

¹³⁷ See Andrew Corydon Finch, *When Imitation Is the Sincerest Form of Flattery: Private Label Products and the Role of Intention in Determining Trade Dress Infringement*, 63 U. CHI. L. REV. 1243, 1246-47 (1996) (detailing the consumer confusion requirement for trade dress infringement in trademark law, and how the consumer confusion standard is applied in different cases). See also *Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1209-10 (9th Cir. 2012) (discussing the application of the likelihood of confusion test for trademark infringement and stating that the test involves deciding whether the consumer would be confused about the source or origin of the good bearing of the trademark); *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1142 (9th Cir. 2011) (stating that the court is "mindful that the sine qua non of trademark infringement is consumer confusion"). The likelihood of confusion test typically involves several factors that help decide whether the consumer is likely to confuse the goods that bear the similar trademarks. A non-exhaustive list of factors includes:

similarity of the conflicting designations; relatedness or proximity of the two companies' products or services; strength of the marks; marketing channels used; degree of care likely to be exercised by purchasers in selecting goods; intent in selecting the mark; evidence of actual confusion; and likelihood of expansion in product lines.

Brookfield Comm., Inc. v. West Coast Enter. Corp., 174 F.3d 1036, 1053-54 (9th Cir. 1999).

infringement test.¹³⁸ Trademark law centers its infringement test on thwarting those who would try to succeed in the marketplace through siphoning off the goodwill of already successful designs.¹³⁹ This is not a concern of design patents, which unlike trademarks, are intended to protect innovative product designs created by designers and to incentivize the creation of innovative designs.¹⁴⁰ Untethering the design patent infringement test from protections of the design similarities and instead looking through the lens of consumer deception undermines the integrity of design patents.¹⁴¹ “The justification for granting a design

¹³⁸ See Debra D. Peterson, *Seizing Infringing Imports of Cinderella’s Slippers: How Egyptian Goddess Supports U.S. Customs and Border Protection’s Enforcement of Design Patents*, 90 J. PAT. & TRADEMARK OFF. SOC’Y 888, 905 (2008) (explaining that U.S. Customs and Border Protection should be able to make design patent infringement determinations because they are already making determinations regarding trademark infringement and advising that it would be an easy transition for U.S. Customs and Border Protection to start this procedure because the infringement test for design patents is very similar to the test for trademark infringement); David S. Welkowitz, *Trade Dress and Patent – The Dilemma of Confusion*, 30 RUTGERS L.J. 289, 306–07 (1999) (analyzing whether trade dress protections under trademark law are engulfing design patent law and advising that there needs to be separation between the two infringement tests because they should be trying to protect different things).

¹³⁹ See *Defiance Button Mach. Co. v. C & C Metal Prod. Corp.*, 759 F.2d 1053, 1059 (2d Cir. 1985) (providing that a trademark symbolizes the goodwill of a company because it is the representation of the company and the quality of products or work sold by the company, and therefore others should be prevented from using the trademark on their own goods to benefit off that goodwill); *Visa, U.S.A., Inc. v. Birmingham Trust Nat’l Bank*, 696 F.2d 1371, 1375 (Fed. Cir. 1982) (explaining that trademarks are inseparable from the goodwill that is associated with that mark because it identifies the source of the mark). See also Elke Elizabeth Werner, *Are We Trading Our Lanham Act Away? An Evaluation of Conflicting Provisions Between NAFTA and North American Trademark Law*, 2 SW. J.L. & TRADE AMERICAS 227, 254 (1995) (advising that trademarks are merely representative of the companies’ goodwill for symbolizing the reputation that the owner of the trademark has built within the market and that trademarks are worthless without goodwill).

¹⁴⁰ See Kaitlyn N. Pytlak, *The Devil Wears Fraud-A: An Aristotelian-Randian Approach to Intellectual Property Law in the Fashion Industry*, 15 VA. SPORTS & ENT. L.J. 273, 274, 285–86 (2016) (stating that designers invest valuable resources into their designs, and in that respect, deserve to have their designs protected extensively and advising that design patents are an avenue for those designers to protect the innovative designs created by designers in the fashion industry). See also Erin Greiger Smith, *Fashion Designers Look to Patents to Fight Knockoffs*, REUTERS (Sept. 12, 2013), <https://www.reuters.com/article/us-usa-fashion-newyork-patents/fashion-designers-look-to-patents-to-fight-knockoffs-idUSBRE98B0H420130912> [<https://perma.cc/RWM8-54TU>] (outlining how fashion designers have turned to design patents to protect them from having their designs being copied and used to make a knockoff product).

¹⁴¹ See *Hupp v. Siroflex Am., Inc.*, 122 F.3d 1456, 1465 (Fed. Cir. 1997) (holding that even though there was customer confusion of the claimed and accused designs, there was not infringement because the product designs were not substantially similar). *Hupp* suggests that even when evidence is present that an ordinary observer would likely be deceived into thinking one product is the other because it incorporates the patented design, the factfinder should still not find infringement unless the look of the claimed and accused product designs

patent is not the patent holder's desire to own a market but the supposed novelty of the design."¹⁴² Therefore, by using consumer deception as the bar for design patent infringement, the courts ignore technical similarity, which "divorces the assessment of infringement from the justification for having the design patent in the first place."¹⁴³ If design patents are going to continue as a mode of protection available for designs in the future, courts must ensure that the infringement test is consistent in protecting the very reason the designer has sought the patent to begin with.¹⁴⁴ That reason certainly does not pertain to making sure that the ordinary consumer is protected from source confusion.¹⁴⁵ Instead, the design patent infringement test should seek to ensure that designers are not able to steal and incorporate protected designs and place them into their own products.¹⁴⁶ Tying the infringement analysis to deception of the ordinary

are substantially similar to each other, suggesting that the similarity of the appearance is the most important decision for the factfinder during the ordinary observer test portion of the design patent infringement analysis. *Id.* But see PHG Tech., LLC v. St. John Co., Inc., 529 F. Supp. 2d 852, 865 (M.D. Tenn. 2007) (tying the infringement analysis to deception of the ordinary observer and finding infringement because the similarity would deceive the ordinary observer into thinking one product was the other).

¹⁴² Fromer & Lemley, *supra* note 108, at 1302.

¹⁴³ *Id.*

¹⁴⁴ See Daniel H. Brean, *Enough Is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 TEX. INTELL. PROP. L.J. 325, 374 (2008) (detailing that design patents are not needed because Copyright and Trademark laws can provide adequate protection for product designs). Though it may be argued that designs can be protected without design patents, design patents play a vital role in the longevity of design protections because design patents grant the patent holder a 15-year monopoly that provides time to develop secondary meaning for trade dress protections under trademark law. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000) (holding that a showing of secondary meaning is required to receive trade dress protections); Elizabeth D. Ferrill & Sydney N. English, *Yin and Yang: Design Patents and Trade Dress Rights*, FINNEGAN (July 27, 2015), <https://www.finnegan.com/en/insights/yin-and-yang-products-design-patents-and-trade-dress-rights.html> [<https://perma.cc/C6F7-K4JU>] (discussing the protections afforded by design patents and trade dress and explaining how design patents in the short term provide the time to develop secondary meaning to gain infinite trade dress protections).

¹⁴⁵ Cf. Jay Dratler, Jr., *Trade Dress Protection for Product Configurations: Is There a Conflict with Patent Policy?*, 24 AIPLA Q.J. 427, 558 (1996) (suggesting that the design infringement decision should be made without extensive views of the commercial marketplace, but instead the focus should be on the design aspects of the pictures of the claimed and accused designs).

¹⁴⁶ See Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & TECH. 251, 293-94 (2011) (explaining how design patents provide a valuable deterrent against designers creating knockoff products incorporating the protected design). Cf. Scott D. Locke, *Fifth Avenue and the Patent Lawyer: Strategies for Using Design Patents to Increase the Value of Fashion and Luxury Goods Companies*, 5 J. MARSHALL REV. INTELL. PROP. L. 40, 42 (2005) (outlining the steps a designer can take to get the broadest protections under the design patent system).

consumer pushes design patents into the unwelcomed waters of trademark's trade dress protections.¹⁴⁷ Though overlapping of protections is not itself unwelcomed, design patents and trade dress have very different objectives.¹⁴⁸ Therefore, a separation of design patent infringement from consumer deception is needed to focus on those who should be protected, the designers.¹⁴⁹

When considering all these problems taken as a whole, one comes to the conclusion that the current design patent infringement test strays from protecting what the design patent is supposed to protect, creates confusion as to what level of knowledge the person making the infringement decision is supposed to have, and erroneously uses the deception of the ordinary purchaser in the substantial similarity decision.¹⁵⁰ Given the problems with the current infringement test, the test needs to be revised to provide remedies for the dysfunction and align the infringement test with what design patents do and who they are intended to protect by simplifying the infringement test to provide clarity.¹⁵¹

IV. CONTRIBUTION

The test for design patent infringement must strike a balance between providing ardent protections for designs without stifling the creativity of those who will create innovative new designs. This balance is struck by a test that incorporates the design novelty in the infringement decision instead of eliminating it from the inquiry completely. The contribution section of this Note is separated into two subsections.¹⁵² Part IV.A presents a new approach to the design patent infringement test that seeks

¹⁴⁷ See *supra* notes 137–38 and accompanying text (describing how the design patent infringement test and the trademark infringement test both look to the consumer to make its infringement decision).

¹⁴⁸ See Burnick, *supra* note 21, at 285 (stating that design patents are intended to protect designers from having designs stolen and then incorporated into another product); Karina K. Terakura, *Insufficiency of Trade Dress Infringement Litigation in the Fashion Industry*, 22 U. HAW. L. REV. 569, 572 (2000) (advising that under trade dress protections of trademark, designers are not given any protections for their designs).

¹⁴⁹ See *supra* notes 137–38 and accompanying text (discussing the overlap of design patent and trademark protections and how they should be separated more).

¹⁵⁰ See *supra* Part III (outlining the three fundamental problems with the current infringement test created under *Egyptian Goddess*).

¹⁵¹ See Burnick, *supra* note 21, at 285 (advising that design patents protect from having an inventor's design taken or copied by other designers and placed into another product's designs).

¹⁵² See *infra* Parts IV.A, IV.B (proposing a new test for design patent infringement then providing commentary on the changes as to why the changes should be made).

to remedy the issues discussed earlier.¹⁵³ Next, Part IV.B provides commentary on the new proposed changes to the design patent infringement test.¹⁵⁴

A. *Proposed Test for Design Patent Infringement*

The new proposed test for design patent infringement retains the current two-part inquiry. The first part is the claim construction step. The new test proposes that, during claim construction, the patent holder must provide a written description of what is novel in the design and is therefore being protected by the design patent. This description is then used with the drawings to construe the scope of the claimed protected design.

The second part of the inquiry involves deciding if the accused design has been infringed. The new proposed test has two prongs. First, the factfinder determines if the protected novel aspects of the design identified by the patent holder are present in the infringing design. If the identified protected elements are present, then the factfinder next decides if the accused design has sufficiently appropriated the protected elements to find infringement. In deciding whether the protected design has been sufficiently incorporated, the factfinder will consider two factors. First, what is the prominence of the protected design in the accused design? Second, what is the level of substantiality at which the protected elements are present in the accused design?¹⁵⁵ If the accused design has sufficiently appropriated the protected elements of the claimed design, the accused design is infringing the patented design.¹⁵⁶

¹⁵³ See *infra* Part IV.A (putting forth a new test for design patent infringement that presents three changes to the current test: requiring the patent holder to prove his design is novel by a comparison between the claimed design and the closest prior art during claim construction; eliminating the ordinary observer from the infringement test and allowing jurors to make the infringement decision; and removing the consumer deception element from the substantial similarity framework).

¹⁵⁴ See *infra* Part IV.B (addressing the concerns associated with: requiring the patent holder to show the novelty in his design that affords it protections against infringement; the ordinary observer portion of the infringement test; and the misplaced tying of the infringement decision to consumer deception).

¹⁵⁵ The terminology for the factors utilized in the author's contribution are based upon two factors used to determine damages for design patent infringement. See *Apple, Inc. v. Samsung Elecs. Co.*, No. 11-cv-01846, 2017 WL 4776443, at *11 (N.D. Cal. Oct. 22, 2017).

¹⁵⁶ This is the author's contribution, embodying the intent of creating a fair design patent infringement test that protects innovative designs and encourages the creation of new innovative designs without erroneously focusing the infringement decision. See *supra* Part III.A (outlining the problems associated with viewing the whole product instead of just the protected novel design); *supra* Part III.B (analyzing the problems with using the ordinary observer standard through which the infringement decision is made); *supra* Part III.C (discussing the problems with tying the infringement decision to consumer confusion).

B. Commentary

Part IV.B of this Note provides commentary on the author's proposed contribution.¹⁵⁷ Section IV.B.1 provides the benefits of requiring a written description of the novelty of the design patent.¹⁵⁸ Section IV.B.2 explains why removing the ordinary observer from the infringement analysis improves the infringement test.¹⁵⁹ Section IV.B.3 explores how the author's contribution would unmoor the infringement test from consumer confusion.¹⁶⁰ Last, Section IV.B.4 explains how the factors of the author's proposed test would remedy problems identified in the old point of novelty test.¹⁶¹

1. Requiring a Written Point of Novelty Description During Claim Construction

The first proposed change to the design patent infringement test is requiring the patent holder to identify the novel designs during the claim construction by providing a written description of what the design patent covers, which will be used when comparing the claimed design to the closest prior art.¹⁶² During claim construction, the court determines the scope of the design patent.¹⁶³ Therefore, identifying the novelty points in the claimed design during the claim construction would be a natural fit, as it would direct the claim to the novel design aspects that are being protected by the design patent.¹⁶⁴ The written description is then used in

¹⁵⁷ See *infra* Sections IV.B.1–IV.B.4 (providing commentary on the author's proposed test for design patent infringement).

¹⁵⁸ See *infra* Section IV.B.1 (explaining the benefits of requiring a written description of the novelty of the claimed design during claim construction).

¹⁵⁹ See *infra* Section IV.B.2.

¹⁶⁰ See *infra* Section IV.B.3 (exploring how removal of the consumer confusion focus of the current design patent infringement test would align the infringement test back to what design patents were intended to protect).

¹⁶¹ See *infra* Section IV.B.4.

¹⁶² See *supra* Part IV.A (outlining the proposed changes to the design patent infringement test including a showing of novelty by the patent holder during claim construction by comparing the patented design to the closest prior art to show what is novel about the design). The Federal Circuit has refused to extend validity of the design patent to claim construction thus far.

¹⁶³ See *Unique Indus., Inc. v. 965207 Alberta Ltd.*, 722 F. Supp. 2d 1, 8 (D.D.C. 2009) (explaining the claim construction step at the outset of the infringement analysis and stating that claim construction determines the scope of the claimed design).

¹⁶⁴ See *supra* notes 89–94 (discussing the novelty requirement and that the design patent is issued only if the design is novel and therefore protects the novel aspects of the design that are truly innovative).

conjunction with the drawings to ensure that the jury knows exactly what the design patent is protecting from being appropriated.¹⁶⁵

Requiring a written description of the points of novelty to be used with the drawings during claim construction affords two potential benefits.¹⁶⁶ First, this focuses the factfinder's attention on the novel aspects of the design that are protected, ensuring that they focus on the novel aspects in making the later infringement decision.¹⁶⁷ Focusing the factfinder on the novelty eliminates the harm of allowing the whole product to be considered in the infringement analysis because it steers juries away from including the non-novel aspects in the infringement analysis.¹⁶⁸

Second, requiring the patent holder to provide a description of what the design patent covers sheds light on what the patent holder was trying to protect with the design patent and identifies just what is being protected.¹⁶⁹ Moreover, requiring the patent holder to identify the novel aspects of the design will encourage the patent office to require more written descriptions of what the design patent will cover and make sure the product design is worth protection before issuing a design patent.¹⁷⁰

2. Eliminating the Ordinary Observer from the Infringement Test

The second step in the new design patent infringement test is comparing the claimed and accused designs with each other for the

¹⁶⁵ Currently the court's do not require both a written description and use of drawings during claim construction. However, the Federal Circuit Court has encouraged use of drawings in construing the claim, unlike utility patents which include a detailed description of what the utility patent covers. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679–80 (Fed. Cir. 2008) (stating that there is no requirement for a detailed description of the design patent as is typical with utility patents).

¹⁶⁶ See *supra* Part IV.A (proposing a new requirement during the claim construction step that the patent holder must identify the points of novelty in his design through a comparison of the prior art).

¹⁶⁷ See Perry J. Saidman, *What Is the Point of the Point of Novelty Test for Design Patent Infringement? Nail Buffers and Saddles: An Analysis Fit for an Egyptian Goddess*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 401, 402 (2008) (discussing the requirements for the now excluded point of novelty test and advising that the point of novelty was introduced to ensure that the accused product incorporated the novelty of the accused design as defined by a comparison with the prior art).

¹⁶⁸ See *supra* Part III.A.

¹⁶⁹ See *supra* note 97 (outlining the need for novelty in the claimed design for it to be protected by a valid design patent because if the claimed design lacks novelty the design patent should not have been issued and is invalid).

¹⁷⁰ See Jenell Smith, *To an 'Ordinary Observer,' Design Patents Flunk the Test*, R STREET (Feb. 5, 2014), <http://www.rstreet.org/2014/02/05/design-patents-flunking-ordinary-observer-test/> [<https://perma.cc/S543-S268>] (describing how the patent office is issuing design patents "like candy" and that the result will be that "innovation will continue to be stifled because of inventors' fear of litigation").

factfinder to decide if the accused product has the protected novel aspects present in the product design.¹⁷¹ The new test would eliminate the ordinary observer as the lens through which the infringement analysis is viewed, instead letting the juries make the infringement decision as persons of ordinary intelligence.¹⁷²

Eliminating the ordinary observer serves two objectives. First, eliminating the ordinary observer standard allows jurors to make the infringement decision based on their own sensibilities, instead of having to put themselves into the shoes of a hypothetical ordinary observer.¹⁷³ This standard is more consistent with *Gorham's* ordinary observer as a person of ordinary knowledge of the marketplace because general consumers are more knowledgeable of products in the market than ever before, thanks to extensive product marketing campaigns.¹⁷⁴ We live in a society of consumerism and the reasonable person is the ordinary observer contemplated by the Supreme Court in the 1871 *Gorham* decision.¹⁷⁵ Moreover, the proposed claim construction will identify the points of novelty well enough to sufficiently inform the factfinder of the products to make the factfinder as knowledgeable as the ordinary observer contemplated in *Gorham*.¹⁷⁶

Second, eliminating the ordinary observer standard will make the infringement decision more consistent because the factfinder no longer has to elevate the ordinary observer at a whim, based on the consumer's knowledge.¹⁷⁷ Combined with the new initial burden of describing the novelty in the claim construction, this strikes a workable balance between

¹⁷¹ See *supra* Part IV.A.

¹⁷² See *supra* Part III.B (providing the reasons why the ordinary observer standard should not be utilized in the design patent infringement test).

¹⁷³ See *supra* note 132 and accompanying text (discussing how jurors are capable of making the infringement decision in design patent infringement cases as people of ordinary sensibilities).

¹⁷⁴ See *Engaged, Informed Consumers to Be a Major 2013 Shopping Trend*, GLOB. COSMETIC INDUS. (Feb. 8, 2013), <http://www.gcimagazine.com/marketstrends/consumers/women/Engage-Informed-Consumers-to-Be-a-Major-2013-Shopping-Trend-190370621.html> [<https://perma.cc/ZJ9F-SRP6>] (suggesting that consumers are more informed and connected to the consumer marketplace than ever before).

¹⁷⁵ See *id.* (noting the elevated information that consumers have available and take advantage of about products being sold). See also *supra* note 127 (discussing that the ordinary observer in *Gorham* was a consumer of basic knowledge of the prior art).

¹⁷⁶ See *supra* Section IV.B.1 (providing commentary on the reasons justifying the requirement of identifying the points of novelty during the claim construction phase). See also Carani, *supra* note 57, at 378 (presenting how even jurors uneducated about the subject can be educated about the matter in order to make an infringement decision).

¹⁷⁷ See Kowalczyk, *supra* note 73, at 253–54 (stating that the effect of *Egyptian Goddess* has been that the patent holder has an easier time protecting his patent); *supra* note 116–17 (giving examples of cases in which the ordinary observer has been hard to identify and has led to contradictory findings in different cases).

affording protections to patented designs and encouraging new designers to push design innovation forward.¹⁷⁸

3. Eliminating Consumer Deception from the Infringement Analysis

The proposed test eliminates consumer deception from the infringement analysis.¹⁷⁹ Taking out the deception framework removes the market element from the infringement test and makes the test more congruent by focusing on protecting innovative designs and not consumers.¹⁸⁰

Refocusing the infringement analysis aligns design patent infringement in two ways.¹⁸¹ First, it creates more separation between design patents and trademark law.¹⁸² Tying the design patent infringement to the market, even slightly, blurs the line between design patents and trade dress protections.¹⁸³ Removing the consumer deception element promotes distinction between two different forms of protection that strive to protect different aspects of a product.¹⁸⁴

Second, removing consumer deception allows the factfinder to make the infringement decision based on whether the design's novelty has been taken.¹⁸⁵ The crux of the design patent is protection of ornamental aesthetics of the product's design.¹⁸⁶ Therefore, the goal of the infringement test should be just that: does the infringing product incorporate the patented design aspects sufficiently?¹⁸⁷ Asking jurors to determine if the novel aspects of a design, identified during claim

¹⁷⁸ See *supra* note 170 (warning that a balance should be drawn in issuing design patents because the issuance of too many stifles innovation of new design). See also Bruce A. Kugler & Craig W. Mueller, *A Fresh Perspective on Design Patents*, 38 COLO. LAW. 71, 73 (2009) (advising that in *Egyptian Goddess* the Federal Circuit broadened the protections for design patents holders).

¹⁷⁹ See *supra* Part IV.A.

¹⁸⁰ See *supra* note 140.

¹⁸¹ See *supra* Part III.C (providing an argument on why the design patent infringement test needs to be refocused away from the consumer).

¹⁸² See *supra* note 138 (discussing the necessity for separation between the trademark and design patent infringement test because they protect different elements).

¹⁸³ See *supra* note 136 (explaining how tying design patent infringement analysis to the market negatively affected the design patent infringement analysis by allowing findings of infringement when the accused design does not even incorporate the novel points of the design).

¹⁸⁴ Compare *supra* note 139 (advising that trade dress protections are tied to protecting the goodwill of the product that has been established by the company), with *supra* note 140 (discussing how design patents are used to protect designers and their innovative designs).

¹⁸⁵ See *supra* note 133 (providing information of how the court applies the consumer deception standard with the substantial similarity requirement in the infringement analysis).

¹⁸⁶ See *supra* note 86.

¹⁸⁷ See *supra* note 85 (providing that substantial similarity from the eye of the person in the infringement analysis is essential to a finding of infringement).

construction, are present in the accused design is certainly within the abilities of juries in our legal system.¹⁸⁸

4. Remedying Key Problems with the Old Point of Novelty Test

Two pervasive arguments have plagued the old point of novelty test.¹⁸⁹ First, critics argue that it was too hard for the factfinder to decide infringement when the point of novelty of the claimed design had been incorporated into another design.¹⁹⁰ Second, an infringer could avoid liability in a case in which there were multiple points of novelty by arguing that the accused design did not copy all the points of novelty.¹⁹¹ The test proposed in this Note remedies these issues with the second prong of the infringement test coupled with the factors for the jury to use in deciding whether the second prong has been satisfied.¹⁹²

The second prong of the infringement test gives juries two factors to use when deciding if the accused design has sufficiently incorporated the protected design elements of the claimed design.¹⁹³ First, the jury considers the prominence of the claimed design in the accused design.¹⁹⁴ This factor allows jurors to consider whether copied design elements are prominently displayed in the accused design, or not prominently displayed but instead incorporated into a new design.¹⁹⁵ This provides flexibility for the factfinder in deciding whether the prominence of the protected design elements is displayed sufficiently to find infringement,

¹⁸⁸ See *supra* note 132 (describing how jurors are qualified to make the infringement decision, as well as other complicated legal determinations).

¹⁸⁹ See *supra* note 75 (explaining that the Federal Circuit Court replaced the point of novelty test with the ordinary observer test as the sole test for design patent infringement because the ordinary observer test could accomplish what the point of novelty test did but with less issues).

¹⁹⁰ See Kowalczyk, *supra* note 73, at 247–48 (outlining how the point of novelty test was too difficult to apply when the accused design had a combination of protected points of novelty, creating confusion about whether this created a new point of novelty or not).

¹⁹¹ See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008) (holding that the point of novelty test would not be used in the design patent infringement analysis because it allowed potential infringers to escape liability by showing that the accused design did not incorporate all the points of novelty identified in the claimed design).

¹⁹² See *supra* Part IV.A (proposing a new test for design patent infringement including two factors for the jury to use in deciding whether the accused design has sufficiently appropriated the protected design).

¹⁹³ See *supra* Part IV.A.

¹⁹⁴ See *supra* Part IV.A.

¹⁹⁵ The Federal Circuit Court avoided completely resolving this issue by merely concluding that the new ordinary observer test would resolve this issue because the factfinder would be focused on whether the overall appearance is the same. See Kowalczyk, *supra* note 73, at 247–48.

or if the design has been incorporated less prominently.¹⁹⁶ If the factfinder finds that the protected elements are not prominently displayed in a new design, and are instead incorporated with other new design elements to create a new design, the accused design has not infringed on the protected design elements of the claimed design.¹⁹⁷

Second, the proposed test remedies the problem of a designer escaping liability when there would be several different points of novelty in the claimed design.¹⁹⁸ The second factor jurors would use in deciding infringement in part two of the proposed infringement analysis is the substantiality of what the accused design has incorporated from the protected design.¹⁹⁹ This factor also provides flexibility to the factfinder by allowing a finding of infringement if the accused design has incorporated less than all of the points of novelty of the protected design but still taken a substantial part of the protected design.²⁰⁰ This would close the loophole inherent in allowing a would-be infringer to avoid liability simply because he did not copy all the protected design.²⁰¹ Instead, the factfinder can find infringement if the accused design has incorporated even a single protected element of the claimed design if it is of substantial importance to the accused design, despite the fact that other protected elements of the claimed design were not used.²⁰²

V. CONCLUSION

Protecting innovative designs through the design patent system is important to incentivize designers to create new ornamental product

¹⁹⁶ See Nadel, *supra* note 40, at 347-52 (giving examples of cases in which the point of novelty test resulted in inconsistent findings of whether a combination of protected elements of a design can be combined to create a new point of novelty). The proposed test seeks to clear up the confusion by using prominence as the key factor for the jury to use in deciding whether the combination creates a new design. It allows flexibility for the validity of these "combination designs" but does not allow for the designer to prominently display one protected design element prominently in the new design. See *supra* Part IV.A.

¹⁹⁷ See *supra* Part IV.A (proposing a prominence of display factor in the second prong of the infringement test).

¹⁹⁸ See *supra* note 191 (explaining that the Federal Circuit Court eliminated the point of novelty test because of the problem of accused designers avoiding liability in cases in which there were several points of novelty).

¹⁹⁹ See *supra* Part IV.A.

²⁰⁰ See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008) (explaining that the Federal Circuit Court's decision to eliminate the point of novelty test was based in part on the court's worry that potential infringers would escape liability by arguing that not all the points of novelty identified were appropriated).

²⁰¹ See Ngo, *supra* note 60, at 122-23 (discussing the Federal Circuit Court's worry that a case may hinge on whether less than all the points of novelty have been taken).

²⁰² See *supra* Part IV.A (setting out the substantiality factor of the proposed infringement test that would allow a finding of infringement if what was taken from the claimed design was substantial to the claimed design).

designs. Strong protection, however, must not come at the cost of an infringement test that undermines the purpose and protections afforded by design patents. The design patent infringement test must be a balance that protects what patents aim to protect while allowing other designers the freedom to advance product designs. Fairness in these competing interests will only be resolved by an infringement test that can be applied in a consistent manner while affording the protections that the design patent system seeks to protect.

Currently, the design patent infringement test accomplishes this task poorly. The current test strays from protecting the novel design aspects of the design in contradiction to what design patents are intended to protect. Next, the ordinary observer test employed by the courts creates a difficult standard for the factfinder to define, creating inconsistent results. Then, the infringement decision ends by focusing on substantial similarity of the design but finding infringement if it would deceive the ordinary consumer, which hinges the infringement decision erroneously on a consumer focus.

Administering a fair and effective infringement test for design patents is an important objective. Without an effective test, designers will stop creating the innovative designs that we have come to expect from our favorite products. It is hard to imagine where a company like Apple would be if it were not for the ability to keep others from copying its innovative designs. It is time for the courts to ensure that a fair test for infringement is applied by changing the infringement test to employ the changes proposed in this Note. Nothing less than the existence of our favorite products hangs in the balance.

Carl J. Hall*

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