

**The “New” Standard For Determining Design Patent Infringement Announced in
Egyptian Goddess, Inc. v. Swisa, Inc. – A Return to Supreme Court Precedent?**

By Edward E. Vassallo and Jessica Hiney¹

The Federal Circuit’s en banc decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (hereinafter *Egyptian Goddess II*) established a new standard for determining infringement of design patents by:

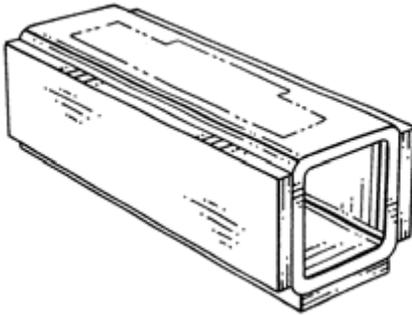
1. Establishing a new version of the “ordinary observer test” as the sole test for determining design patent infringement, and requiring that the ordinary observer be informed by a comparison of the patented design and the accused design in light of the prior art;
2. Eliminating the “point of novelty test” and the “non-trivial advance test”;
3. Eliminating the requirement that district courts must provide detailed verbal claim construction and in fact discouraging district courts from doing so; and
4. Leaving to “future cases” to what extent, if any, a design patentee has a burden of coming forward with prior art that demonstrates the novelty of the patented design.

This article discusses the procedural history of *Egyptian Goddess II*, the old and new standards for determining design patent infringement, and the future implications and questions raised by *Egyptian Goddess II*.

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A. **Procedural History of *Egyptian Goddess***

On December 14, 2005, the Northern District of Texas decided *Egyptian Goddess v. Swisa*, Civil Action No. 3:03-CV-0594-N (N.D. Tex. Dec 14, 2005) (2005 WL 5873510). Plaintiff Egyptian Goddess, Inc. (hereinafter “EGI”) asserted that Defendant Swisa, Inc. and Dror Swisa’s (collectively “Swisa”) nail buffer infringed EGI’s U.S. Design Patent No. 467,389 (hereinafter “the ‘389 patent”). The buffer disclosed in the ‘389 patent consists of a rectangular hollow tube featuring buffer surfaces on three of its four sides. The Swisa buffer is a rectangular hollow tube featuring buffer surfaces on all four of its sides. *Egyptian Goddess, Inc.*, 2005 WL 5873510 at *1. Pictures of the patented and accused nail buffers are below.



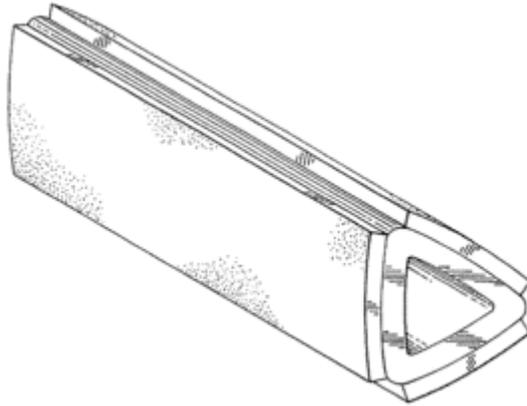
‘389 patent



Swisa buffer

Defendant Swisa moved for summary judgment of non-infringement of the ‘389 patent. EGI countered that Swisa’s nail buffer infringed the ‘389 patent under both the “ordinary observer test” and the “point of novelty test.” To prove the latter, it identified “four elements in its design and for each element it identified prior art that did not embody that element,” and argued that each element was present in defendant’s product. Those four elements included (1) an open and hollow body; (2) a square cross-section; (3) raised rectangular buffer pads; and (4) exposed corners. 2005 WL 5873510

at *2. The District Court did not address EGI's argument that the "point of novelty" is the combination of these four elements because the court found that a single prior art reference, referred to as the Nailco buffer (shown below), showed all but one of the elements of the '389 patent, namely it lacked a fourth side (*i.e.*, a square cross section), which was without a pad.



Nailco buffer

Thus, the District Court found that the "point of novelty" -- the only element not present in the Nailco buffer -- was the "addition of a fourth side without a pad" and because the Swisa buffer did not incorporate this "point of novelty" it granted Swisa summary judgment of no infringement. 2005 WL 5873510 at *2. The "point of novelty test" means that the "accused design must also appropriate the novelty of the claimed design in order to be deemed infringing." 543 F.3d at 679.

EGI appealed the Texas District Court's decision to the Federal Circuit, which in a panel decision, *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1355 (Fed. Cir. 2007) (hereinafter *Egyptian Goddess I*) affirmed and further required that in applying the "point of novelty test" when determining infringement of a design patent, the "point of novelty" found in defendant's design must be a "non-trivial advance over

the prior art.” *Id.* at 1357. In light of the prior art, the panel determined that “no reasonable juror could conclude that EGI’s asserted point of novelty constituted a non-trivial advance over the prior art.”² *Id.* This new “non-trivial advance test” added a new element to the “point of novelty test,” which left many owners of design patents uncertain as to the scope of their rights.

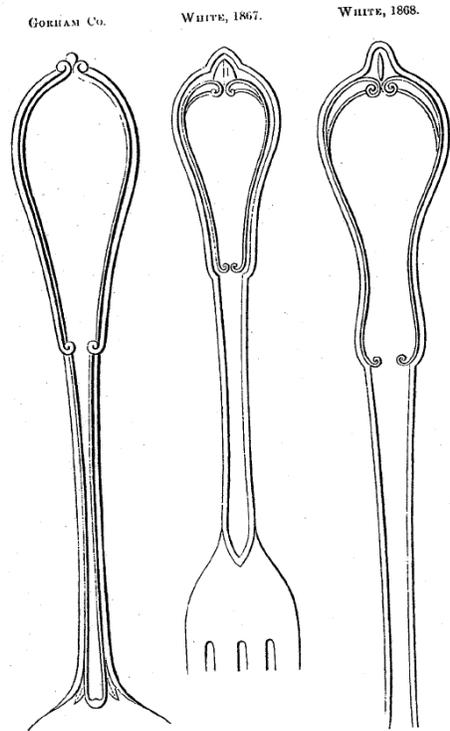
1. The Origins of the “Ordinary Observer Test” And the “Point of Novelty Test”

The “ordinary observer test” was established in 1871 by the Supreme Court’s decision in *Gorham Co. v. White*, 81 U.S. 511 (1871). There, the Supreme Court overruled the trial court’s finding that the determination of substantial similarity should be made by the “eye of an expert” in the relevant trade, one “who sees and examines the articles containing them side by side.” *Id.* at 527. To so hold “would destroy all the protection which the act of Congress intended to give.” *Id.* Rather, the determination should be made by “observers of ordinary acuteness” giving the “degree of observation” that a purchaser usually gives, as it is such persons, not experts, “who are the principal purchasers” of such articles. *Id.* at 528. In the oft quoted words:

We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other. *Id.*

Applying its ordinary observer test, the Supreme Court found both of the White designs for spoons and forks to be infringements of the Gorham patent as below:

² Again, this non-trivial advance over the prior art requirement is in the context of determining infringement, not validity of the asserted patent.



Two decades later, however, in *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893), the Supreme Court found no infringement where the accused saddle design did not contain the single feature that was material to distinguishing the patented design from the prior art. After noting that the material difference between the patented saddle design and the prior art was “the sharp drop of the pommel” of the patented saddle design, it concluded “[i]f, therefore, this drop was material to the design, and rendered it patentable as a complete and integrated whole, there was no infringement” as the accused saddle did not have “the sharp drop.” *Id.* at 682. According to the Federal Circuit, “[t]he point the Court was making was that, viewed in light of the similarities between the prior art and the patented design, the accused design did not contain the single feature that would have made it appear distinctively similar to the patented design rather than like the numerous prior art designs.” *Egyptian Goddess II*, 543 F.3d at 673-74.

Whitman Saddle was applied in subsequent cases which interpreted “the ordinary observer test of *Gorham* to require that the perspective of the ordinary observer be informed by a comparison of the patented design and the accused design in light of the prior art, so as to enable the fact-finder to determine whether the accused design had appropriated the inventiveness of the patented design.” 543 F.3d at 673-74.

For example, *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428 (6th Cir. 1933) involved a design patent on a combination of an ash tray and electric lighter. The District Court found infringement by two of defendant’s designs because the resemblance between the patented design and the accused design was such as to deceive the ordinary observer. *Id.* at 429; *Egyptian Goddess II*, 543 F.3d at 674. As *Egyptian Goddess II* stated, the court in *Applied Arts* explained that the ordinary observer of *Gorham* was not one “who has never seen an ash try or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects and is capable of assessing the similarity of the patented and accused designs in light of the similar objects in the prior art.” 543 F.3d at 674-5, citing *Applied Arts Corp.*, 67 F.2d at 430. “After noting the similarities between the patented design and prior art designs, the court concluded that the differences between the two ‘are no greater than those that exist between the patented design and the alleged infringing designs.’”³ *Egyptian Goddess II*, 543 F.3d at 674-5, citing *Applied Arts Corp.*, 67 F.2d at 430. Thus, the Sixth Circuit concluded that defendant’s designs do not infringe and reversed the District Court. *Applied Arts Corp.*, 67 F.2d at 431.

³ Stated differently, *Egyptian Goddess II* construed *Applied Art Corp.* as finding that the accused design was no closer to the patented design than was the prior art to the patented design as a basis for finding no infringement.

In *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395 (8th Cir. 1944), the Eight Circuit reversed the trial court's finding that defendant's home fruit juicer infringed plaintiff's patents on fruit juicer designs. The court stated that to determine design patent infringement: (1) it must apply the "ordinary observer test" and (2) "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art," a determination made by "a comparison of the features of the patented designs with the prior art and with the accused design." *Id.* at 395-96.

Applied Arts and *Sears, Roebuck* became the principal precedents relied upon in *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), the case that perhaps was the first to enunciate a separate "point of novelty test." The court in *Litton Systems* stated:

For a design patent to be infringed...no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.' That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art.

Id. at 1444 (citations omitted). Many cases following *Litton Systems* interpreted this language to require "that the test for design patent infringement consider both the perspective of the ordinary observer and the particular novelty in the claimed design."

Egyptian Goddess, II, 543 F.3d at 671. See e.g., *Bernhardt, LLC v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1383 (Fed. Cir. 2004); *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002); *Unidynamics Corp. v. Automatic Prods. Int'l, Inc.* 157 F.3d 1311, 1323-24 (Fed. Cir. 1998); *Oakley, Inc. v. Int'l Tropic-Cal., Inc.*, 923

F.2d 167, 16 (Fed. Cir. 1991); *Avia Group, Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988).

After *Litton Systems*, some “court’s described the ordinary observer test and the point of novelty test as ‘conjunctive.’” *Egyptian Goddess II*, 543 F.3d at 671. However, the Federal Circuit thereafter made clear that the “ordinary observer test” and the “point of novelty test” are “two distinct tests” and stated that the “merger of the point of novelty test and the ordinary observer test is legal error.” *Id.* at 671, citing *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002); *Unidynamics Corp. v. Automatic Prods. Int'l, Inc.* 157 F.3d 1311, 1323-24 (Fed. Cir. 1998); *Lawman Armor Corp. v. Winner Int'l, LLC*, 436 F.3d 1383, 1384 (Fed. Cir. 2006).

As a result of confusion in the case law and uncertainty among design patent owners, the Federal Circuit granted rehearing en banc of *Egyptian Goddess I* “to address the appropriate legal standard to be used in assessing claims of design patent infringement.” The Federal Circuit asked for interested parties to submit amicus curia briefs and asked that the briefs address several questions, including:

1. Whether the “point of novelty test” should continue to be used as a test for infringement of a design patent;
2. Whether the court should adopt the “non-trivial advance test” as a means of determining whether a particular design feature qualifies as a point of novelty;
3. How the “point of novelty test” should be administered, particularly when numerous features of the design differ from certain prior art designs; and

4. Whether district courts should perform a detailed verbal claim construction in design patent cases. *Egyptian Goddess II*, 543 F.3d at 670.

Sixteen parties submitted amicus briefs, including, among others, Apple, Inc., Nike, Inc., Electrolux Home Products, Inc., the AIPLA and the Federal Circuit Bar Association. Most of the amici argued in favor of eliminating the “point of novelty test.” Indeed, ten of the sixteen briefs were in favor of eliminating the “point of novelty test,” three were in favor of maintaining the test and three parties did not provide an opinion on the issue. Those in favor of eliminating the “point of novelty test” argued that it complicates design patent litigation; it lacks precedence and it fails to consider the appearance of the design patent as a whole. Several of the amici argued that the proper approach for determining infringement of a design patent is “a three-way visual comparison between the patented design, the accused design and the closest prior art.” 543 F.3d at 672.

Some of the amici also argued that allowing a defendant to dispute the patent owner’s point of novelty by combining the disclosures of multiple prior art references makes design patents unenforceable and “uninfringeable.” Specifically, Electrolux Home Products, Inc., Nike, Inc. and Federation Internationale Des Conseils En Propriete Industrielle (“FICPI”) argued that “because the patentee must define a point of novelty as part of its threshold infringement case, the accused infringer can reduce the design patent to having no enforceable scope merely by showing that the selected point of novelty exists (or substantially exists) in the prior art” by combining multiple references. Brief of Amicus Curiae *Electrolux Home Products, Inc. and Nike, Inc.*, 2008 WL 644361 (Fed. Cir 2008) at *3 and FICPI, 2008 WL 644 359 (Fed. Cir. 2009) at *3. They argued:

The facts in *Lawman Armor Corp. v. Winner Int'l, LLC* exemplify this problem. In response to a motion for summary judgment of non-infringement, the patentee identified eight elements of his patented steering wheel lock design that he defined as specific points of novelty. 437 F.3d 1383, 1384 (Fed. Cir. 2006). The court adopted the accused infringer's point of novelty argument and, in effect, stripped the design patent of all enforceable scope and effectively rendered it unenforceable by identifying each of those features in respective individual prior art designs. *Id.* at 1385-86. In essence, the court converted a valid design patent into one that could never be infringed.

Id. at*3-4.

Consequently, because most of the amici were in favor of eliminating the “point of novelty test,” most also favored eliminating the “non-trivial advance test.” Several of the amici also supported the concept of not requiring the district court to provide a detailed verbal claim construction.

B. The Federal Circuit’s En Banc Decision

On September 22, 2008, in a unanimous en banc decision, the Federal Circuit affirmed the District Court’s summary judgment decision of no infringement, but in so doing abandoned its own case law for determining infringement of design patents. Specifically, the Federal Circuit eliminated the “point of novelty test”; eliminated the “non-trivial advance test”; eliminated the requirement that district courts must provide detailed verbal claim construction; and “clarified” that the “ordinary observer” is one who is “informed by” the prior art.

1. Establishing a new version of the “ordinary observer test” as the Standard for Determining Design Patent Infringement

Egyptian Goddess II established a new version of the “ordinary observer test” as the sole test for determining design patent infringement. Despite the fact that the

courts, led by the Federal Circuit, had applied a separate “point of novelty test” subsequent to *Litton*, the Federal Circuit stated:

“*Litton* and the predecessor cases on which it relied are more properly read as applying 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. When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is so close to the prior art designs, small differences between the accused device and the claimed design are likely to be important to the eye of the hypothetical observer.”

543 F.3d at 676 (emphasis added). Thus, eliminating the “point of novelty test” was consistent with precedent. *Id.* at 676-77. Also, its elimination removed the “risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty,” and avoided “the debate over the extent to which a combination of old design features can serve as a point of novelty under the point of novelty test.”⁴ *Id.* at 677-78.

In addition, *Egyptian Goddess II* appears to render unclear whether the patentee still has the burden of establishing the novel features of its patented design, as part of its infringement proofs. Before *Egyptian Goddess II* and unlike utility patent cases, the patentee had the burden to introduce prior art under the point of novelty test,

⁴ The en banc decision of *Egyptian Goddess II* enunciates the “ordinary observer test” many times. Indeed, the test is discussed at least eight different times. See *Egyptian Goddess, Inc.*, 543 F.3d at 670, 672, 674, 676-78. The wording of each iteration of the test is slightly modified from the previous occurrence, however, it appears that the heart of the test appears to be the same for each.

for the purpose of showing that one or more aspects of the patented ornamental design was novel. *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1384 (“to establish the points of novelty in a design patent infringement action, we hold that the patentee must introduce into evidence, at a minimum, the design patent at issue, its prosecution history, and the relevant prior art references cited in the prosecution history; and must present, in some form, its contentions as to points of novelty”). In *Egyptian Goddess II*, however, the Federal Circuit stated that under the ordinary observer test (the only remaining test for infringement) “it makes sense to impose the burden of production as to any comparison prior art on the accused infringer” which has a dual fold incentive to do so – to show that the patented design is invalid as anticipated or obvious, as well as non-infringing by showing “the prior art that an ordinary observer is most likely to regard as highlighting the differences between the claimed and accused design.” 543 F.3d at 678-79. Indeed, the Federal Circuit stated that it will leave to future cases to clarify to what extent if any a design patentee has a burden of coming forward with prior art (lacking the novel features of the patent design that are present in the accused one) as part of its infringement proofs. *Id.* at 679.

2. Detailed Verbal Claim Construction is No Longer Required, And Is Discouraged

The Federal Circuit also eliminated the requirement that district courts must provide a detailed verbal claim construction in design patent cases. The Court recognized that “design patents ‘typically are claimed as shown in drawings,’ and that claim construction ‘is adopted accordingly.’” 543 F.3d at 679 (citation omitted).

Moreover, the Court stated that the Supreme Court has recognized that “a design is better

represented by an illustration ‘than it could be by any description and a description would probably not be intelligible without the illustration.’” *Id.* (citation omitted). Thus, the Federal Circuit stated that the “preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design”.⁵ *Id.*

Thus, it is in the district court’s discretion as to whether it should provide a detailed verbal claim construction or not. If a district court decides to provide such a construction, *Egyptian Goddess II* warns that the court “should recognize the risks entailed in such a description, such as the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.” 543 F.3d at 680. *Egyptian Goddess II* also points out that “apart from attempting to provide a verbal description of the design, a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those include such matters as describing the role of particular conventions in design patent drafting, such as the role of broken lines...assessing and describing the effect of any representations that may have been made in the course of the prosecution history;...and distinguishing those features of the claimed design that are ornamental and those that are purely functional...” *Id.*

⁵ The Federal Circuit in *Egyptian Goddess II* saw no inaccuracy in the District Court’s verbal claim construction, which described the patented design as follows: A hollow tubular frame of generally square cross section, where the square has sides of length S , the frame has a length of approximately $3S$, and the frame has a thickness of approximately $T = 0.1S$; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately $1.25T$, and the inner corner of the cross section rounded on a 90 degree radius of approximately $0.25T$; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare. *Egyptian Goddess, Inc.* 543 F.3d at 680, citing *Egyptian Goddess, Inc.*, 2005 WL 5873510 at *1.

As the *Egyptian Goddess II* decision made these points in the context of an infringement analysis, the question remains whether a district court must or should provide a verbal claim construction as part of its validity analysis. At least one court has addressed this issue and determined that a detailed verbal claim construction *is* required when determining invalidity. *International Seaway Trading Corp. v. Walgreens Corp.*, 2009 WL 159805 (S.D.Fl. 2009).

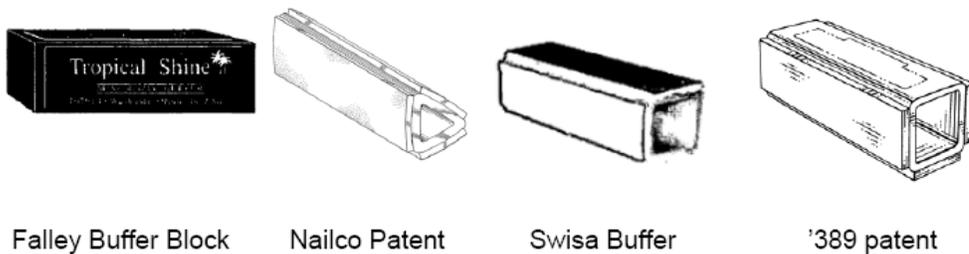
3. The Non-Infringement Holding of *Egyptian Goddess II*

While some commentators have expressed the view that *Egyptian Goddess II* is “pro design patentee” by eliminating one of the two proofs for infringement, one needs to remember that the Court affirmed a summary judgment finding of non-infringement! Indeed, it did so in circumstances where one might conclude that the accused design (a 4 sided hollow nail buffer with pads on all 4 sides) was closer to the patented design (a 4 sided hollow nail buffer with pads on 3 sides) than it was to either of the two closest prior art references (a 3 sided hollow nail buffer with pads on all (3) of its sides and a 4 sided solid nail buffer with pads on all (4) sides).

In any event, the Federal Circuit posed the question before the court as:

whether an ordinary observer, familiar with the prior art Falley and Nailco designs, would be deceived into believing the Swisa buffer is the same as the patented buffer. 543 F.3d at 681.

To answer this question, the Federal Circuit displayed all four designs, placing the accused design between the prior art and the patented design, as follows:



Then, the Court seems to have conducted a three-way comparison as some of the amici had advocated, in that it stated, as a basis for affirming the District Court’s non-infringement finding, that “Nothing about [EGI’s expert’s] declaration explains why an ordinary observer would regard the accused design as being closer to the claimed design than to the Nailco prior art patent.” *Id.* at 682 (emphasis added). To the contrary, in the Federal Circuit’s view, the accused design was more like the prior art than it was like the patented design. The Court also stated that its “analysis largely tracks” the District Court’s analysis:

After analyzing the Nailco patent and the claimed design, as they related to the accused design, the district court concluded that ‘in the context of nail buffers, a fourth side without a pad is not substantially the same as a fourth side with a pad.’ While the district court focused on the differences in the particular feature at issue rather than the effect of those differences on the appearance of the design as a whole, we are satisfied that the difference on which the district court focused is important, viewed in the context of the prior art. *Id.*

At its most basic level, it seems fair to ask – how exactly is the trier of fact to determine if an ordinary purchaser “informed of the prior art,” will believe that the “two designs are substantially the same...inducing him to purchase one supposing it to be the other...” per the *Gorham* test? Presumably, a jury given this task will be provided the patented design, the accused design, and the most relevant prior art on which the accused

infringer relies. Then, does the jury first look at the prior art, and then compare the accused design with the patented one? Or, does the jury conduct a “three way visual comparison” as recommended by some of the amici. The “three way visual comparison” appears to ask the trier of fact to compare the accused design on the one hand with the patented design, and on the other hand with the prior art. If the accused design is “closer” to the claimed design than it is to the prior art, then a finding of infringement is more likely. Conversely, if the accused design is “closer” to the prior art, then a finding of no infringement is more likely.

4. Additional Considerations

a. Will *Egyptian Goddess II* help some design patent owners prove infringement?

It does seem that *Egyptian Goddess II*'s elimination of the separate point of novelty test will assist at least some design patent owners in proving infringement. Now, it may not be necessary for a design patent owner, as part of its affirmative proofs of infringement, to define how its patented design differs from the prior art. Instead, an accused infringer has the burden of going forward – for both validity and non-infringement purposes – to show that the prior art prohibits a finding of infringement, either because the patent is invalid, or because to find infringement gives the patented design too broad a scope.

b. How does the test for design patent infringement compare to the test for trademark infringement

While the *Gorham* test asks whether an ordinary observer would be induced to purchase the accused product because its design is substantially the same as

the plaintiff's patented design, the law has developed in ways to make clear that the confusion that supports design patent infringement is different from that which supports trademark infringement. Indeed, a "clear line...exists between the test for infringement of a design patent and the 'likelihood of confusion' test for infringement of a trademark." *Unitee Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986), *Contessa*, 282 F.3d at 1380. Conceptually, the trademark infringement analysis focuses on "real world" purchasers of plaintiff's and defendant's goods. The design patent infringement analysis is not intended to do that. Indeed, the patent holder need not be selling any product for a finding of infringement, *Unitee*, 285 F.2d at 1029, whereas a trademark plaintiff must sell or authorize others to sell at least some type of product or service before defendant's activities can create confusion.

The ordinary observer of the design patent infringement analysis is more akin to the person of ordinary skill in the utility patent analysis --- a hypothetical entity with knowledge of the closest prior art. It appears not at all relevant whether that closest prior art would be known to real world purchasers of defendant's product -- an Australian paper patent design counts as much as a successful U.S. product design actually in the marketplace. This is not the case in a trademark infringement analysis, where third-party activities must be known to purchasers before the activities play a role in the infringement analysis—a defendant who argues that a third party trademark registration weakens plaintiff's trademark must show that real world purchasers of defendant's product would know of the third party mark. See e.g., *Daddy's Junky Music Stores v. Big Daddy's Family Music Center*, 109 F.3d 275, 281; *The Sports Authority, Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 961 (2d Cir. 1996).

Also, while trademark law gives emphasis to defendant's use of its accused trademark at the point of purchase, this is not the case in design patent law, as perhaps best shown in *Contessa*, 282 F.3d at 1370, a case involving a design patent on a display of shrimp on a tray. There, the trial court emphasized the substantial similarity to the way defendant's shrimp on a tray appeared at the point of sale, and indicated that "we must bear in mind that the attention of the ordinary observer at the point of sale is far more likely to focus on the arrangement of shrimp than minor features of the structure of the underlying tray, for the simple reason that the shrimp cover and obscure most structural features of the tray." The Federal Circuit took issue with this common sense statement, finding it not relevant to the design patent infringement issue, and reversed the trial court's infringement finding. The proper inquiry is whether the accused design is substantially the same as the patented design when viewed in normal use, not just at the point of sale. *Id.* at 1379-80.

c. The role of surveys in design patent infringement proofs

Perhaps in part due to the non real-world nature of the design patent infringement inquiry, surveys offered to prove design patent infringement have not been well received by the courts.

In *Oddzon Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997), the Federal Circuit affirmed a finding of summary judgment of non-infringement by the district court, despite: (a) evidence of actual confusion showing that defendant's tossing balls were returned to plaintiff, and (b) a survey purportedly showing that respondents stated there was overall similarity between the patented and accused designs.

Id. at 1400-01. But the court rejected the survey evidence because the survey was not directed to the ornamental aspects of the designs, apart from functional features, and thus, it was unclear what features accounted for the similarity perceived by the survey participants. *Id.* at 1406. Likewise, in *Spotless Enterprises v. A&E Products Group L.P.*, 294 F. Supp.2d 322 (EDNY 2003), plaintiff offered a survey to show that only defendant's hanger was selected from an array of hangers as being the same design as depicted in plaintiff's design patent. The court called the survey "severely flawed" because only the defendant's product in the array had "upswept arms," the "dominant feature of the patent," and it did not demonstrate that respondents' choice was based on the ornamental aspect of defendant's hanger. *Id.* at 347.

In *Minka Lighting, Inc. v. Craftmade Int'l, Inc.*, 2002 U.S. Dist. LEXIS 8693 (N.D. Tx 2002), plaintiff offered a consumer survey in opposition to defendant's motion for summary judgment of non-infringement. Plaintiff's survey showed that 71% of 220 respondents stated that plaintiff's and defendant's ceiling fans had "substantially the same design" and 94% of the 71% attributed the similarities to the "curves and contours" of the fan. Nonetheless, the court granted summary judgment of non-infringement! It stated that the survey was "problematic" in the absence of a precise definition of "substantial similarity" which, relying on copyright concepts (*Warner Bros., Inc. v. American Broadcasting Co.*, 720 F.2d 231, 245 (2d Cir. 1983), it found to be "not a concept familiar to the public at large," quoting *Warner Bros.* 2002 U.S. Dist LEXIS at 8693, 13.

In sum, there is no clear model for offering survey evidence in a design patent case.

Conclusion

After more than 20 years of jurisprudence in which the Federal Circuit required a design patent holder to meet two separate tests for infringement, the Court has changed its law and harmonized it with Supreme Court precedent by dropping the point of novelty test. In addition, it correctly has relieved trial courts from the burden of detailed verbal descriptions of the ornamental features of the patented design, which can distract the trier of fact from determining whether the designs at issue in their entirety are “substantially the same.” Moreover, the court seems to have placed on the accused infringer the burden of going forward with evidence to show that the prior art limits an expansive scope of the claims, just as in utility patent cases.