BASIC CONSIDERATIONS IN AN INFRINGEMENT ANALYSIS FOR U.S. DESIGN PATENT

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I. INTRODUCTION

The following is a summary of the basic issues, which should be considered in an infringement analysis of a U.S. design patent. While remedies (i.e., damages and injunctions) for infringement of a U.S. design patent and a U.S. utility patent are essentially the same, the test for evaluating infringement of a U.S. design patent is different due to the inherent differences in the subject matter to be protected by a U.S. design patent versus the subject matter to be protected by a U.S. utility patent.

II. GENERAL INFRINGEMENT TEST FOR A U.S. DESIGN PATENT

The general standard for determining infringement of a U.S. design patent has existed for many years and is set forth in the U.S. Supreme Court decision in Gorham Co. v. White, 81 U.S. 511 (1872).

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

The Federal Circuit later articulated a specific two-part test for evaluating the infringement of a U.S. design patent in its decision of Litton Systems, Inc. v. Whirlpool Corp., 728 F.2d 1423 (Fed. Cir. 1984). The Federal Circuit 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.”
Litton Systems, 728 F.2d at 1444 (citations omitted). Thus, in creating what became known as the “point of novelty test,” infringement of a design patent was based on:

1. Whether in the eye of the ordinary observer two designs are “substantially the same” and that similarity deceives a prospective purchase inducing him to purchase one supposing it to be the other; and

2. Whether the accused device appropriated the “novelty” in the patented design which distinguished it from the prior art. Id.

The “point of novelty test” however, was recently abandoned by the Federal Circuit in a unanimous en banc decision on September 22, 2008. In the case of Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008), the Federal Circuit held that the “point of novelty” test should no longer be used in the analysis of a claim of design patent infringement. The Federal Circuit held that the “ordinary observer” test should be the sole test for determining whether a design patent has been infringed. Id. Under that test, infringement will not be found unless the accused article “embod[ies] the patented design or any colorable imitation thereof.” Id. (citing Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1116-17 (Fed. Cir. 1998); Arminiak & Assocs., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1319 (Fed. Cir. 2007)).

The Federal Circuit did not eschew consideration of the prior art altogether however. The Federal Circuit noted that in circumstances where the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art; thus, Egyptian Goddess represents a “modified ordinary observer” test where the ordinary observer may be required to be familiar with the prior art. Egyptian Goddess, 543 F.3d at 678. “Where there are many examples of similar prior art designs . . . differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.” Id. (citing Smith v. Whitman Saddle Co., 148 U.S. 674 (1893)).
The modified ordinary observer test of *Egyptian Goddess* has been applied in a recent Federal Circuit decision, *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233 (Fed. Cir. 2009). The Court abided by the test in *Egyptian Goddess* by rejecting the point of novelty test and applying the modified ordinary observer test. *Id.* In applying the ordinary observer test, the majority stressed the overall appearance of the design of the clog footwear design at issue. *Id.* at 1244. However, a single feature of the shoe at issue—the insole—supported the holding that there was no anticipation in the prior art designs, leading the dissent to argue that the majority essentially applied the modified ordinary observer test in the same fashion as the point of novelty test by comparing a single feature of the design with the prior art. *Id.* at 1245 (Clevenger, J., dissenting).

In summary, an accused design infringes a design patent when it is so similar to the claimed design that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, “inducing him to purchase one supposing it to be the other.”

III. INFRINGEMENT ANALYSIS

A. CLAIM INTERPRETATION

Infringement analysis of a U.S. design patent first must begin by interpreting the claimed design. This is done by looking at the drawings of the patent which is the subject of the claim, i.e., the drawings are the claim and define the scope of protection.

In *Egyptian Goddess*, the Federal Circuit acknowledged that claim construction with respect to a design patent differs significantly from claim construction for utility patents. Accordingly, while trial courts have a duty to conduct claim construction in design patent cases, the Federal Circuit does not require that the trial court attempt to provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents. *Egyptian Goddess*, 543 F.3d at 679. The Federal Circuit noted 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.* (citing *Dobson v. Dorman*, 118 U.S. 10, 14 (1886)). Therefore, the Federal Circuit left the question of verbal
characterization of the claimed designs to the discretion of trial judges, stating that generally, “courts should not treat the process of claim construction as requiring a detailed verbal description of the claimed design.” Egyptian Goddess, 543 F.3d at 680. District court decisions post-Egyptian Goddess indicate that trial courts are following the Federal Circuit’s guidance, and some are avoiding verbal descriptions altogether.¹

In the case of a U.S. design patent, the claim is to the ornamental design for the article, thus emphasizing that the claim is directed to the ornamentation of the product and not the functional features. Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent. OddzOn Products, Inc. v. Just Toys, Inc. 122 F.3d 1396, 1405 (Fed. Cir. 1997) (citations omitted). Thus, it is the non-functional design aspects of the product that are pertinent to analyzing infringement. A design may embody functional features and still be patentable; but in order to attain valid design patent status, the design must have an ornamental, pleasing appearance distinct from that dictated solely by functional considerations. As explained in In re Carletti, 328 F.2d 1020, 1022, 140 U.S.P.Q. 653, 654 (CCPA 1964):

"Many well-constructed articles of manufacture whose configurations are dictated solely by function are pleasing to look upon, for example a hexnut, a ball bearing, a golf club, or a fishing rod, the pleasure depending largely on one's interests. But it has long been settled that when a configuration is the result of functional considerations only, the resulting design is not patentable as an ornamental design for the simple reason that it is not "ornamental" -- was not created for the purpose of ornamenting."

To determine whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety. The ultimate question in determining whether the claimed design is dictated by the utilitarian purpose of the article depends on the overall

appearance of the article, not the functional or decorative aspect of each separate feature. L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) overruled on other grounds by Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008). A distinction exists between the functionality of an article or features thereof and the functionality of the particular design of such article or features thereof that perform a function. Avia Group Intern., Inc. v. L.A. Gear California, Inc., 853 F.2d 1557, 1563 (Fed. Cir. 1988). When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose. Id.

B. ANALYSIS OF "SIMILARITY OF DESIGNS" FOR THE FIRST INFRINGEMENT TEST

After interpretation of the claimed design by identifying the non-functional, design aspects, one must then analyze the similarity of the designs. Under the Federal Circuit's newly articulated infringement test of Egyptian Goddess, which is in accord with the Supreme Court's decision of Gorham, the criteria for infringement is whether the alleged infringing product produces upon the eye of the ordinary observer the same aesthetic effect as the claimed design. In essence, it is the reaction of the ordinary purchaser and not an expert. Differences between the patented design and the accused design that may be apparent from a side-by-side comparison do not necessarily dictate a finding of non-infringement. That is, differences in the details of the designs will not negate infringement when the two designs create substantially the same overall impression.

Therefore, the focus on the non-functional features of the design during claim construction, as developed in OddzOn, 122 F.3d at 1405, is wholly consistent with the modified ordinary observer test in Egyptian Goddess, as demonstrated in recent Federal Circuit decisions, see Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010); see also Crocs, Inc. v. ITC, 598 F.3d 1294 (Fed. Cir. 2010). The court in Richardson strove to reconcile the two tests. 597 F.3d at 1293 ("while it is proper to factor out the functional aspects of various design elements, that discounting of functional elements must not convert the overall infringement test to an element-by-element comparison")
The legal theories of "literal infringement" and infringement by "Doctrine of Equivalents" remain alive and well for a U.S. design patent, but in a slightly different context than for a U.S. utility patent. Even if there are differences sufficient to negate literal infringement, infringement can be found under the Doctrine of Equivalents. As stated by the Federal Circuit in Lee v. Dayton-Hudson, 838 F.2d 1186, 1189-90 (Fed. Cir. 1988):

"Indeed, the standard set forth in Gorham itself requires that infringement be found where "two designs are substantially the same", 81 U.S. (14 Wall) at 528, thus using words associated with equivalency. While the way/function/result test of Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 608, 85 USPQ 328, 330 (1950) is not directly transferable to design patents, it has long been recognized that the principles of equivalency are applicable under Gorham. In Schnadig Corp v. Gaines Mfg. Co., 494 F.2d 383, 391-92, 181 USPQ 417, 423 (6th Cir. 1974), the court applied Gorham in affirming that the differences between the patented design and accused device were minor, stating that:

'We are mindful of the oft-quoted words of the Supreme Court in Graver Tank [339 U.S. at 607, 85 USPQ at 330]:

One who seeks to pirate an invention, like one who seeks to pirate a copy-righted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement.'

See also Sanson Hosiery Mills, Inc. v. Warren Knitting Mills, Inc., 202 F.2d 395, 397, 96 USPQ 247, 249 (3rd Cir. 1953) (design patents are entitled to a range of equivalents)."

Thus, the Federal Circuit has held that infringement can be found for designs that are not identical to the patented design, but such designs must be equivalent in their ornamental, not functional, aspects. See In re Garbo, 287 F.2d 192, 193, 129 USPQ 72, 73 (CCPA 1961). The accused devices must meet the Gorham test of similarity of ornamental appearance such that an ordinary observer would be likely to purchase one thinking it was the other.
C. COMPARISON OF THE CLAIMED AND ACCUSED DESIGNS WITH THE PRIOR ART

The Federal Circuit held in Egyptian Goddess that the “point of novelty” test should no longer be used in the analysis of a claim of design patent infringement. In some instances however, where the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art. Egyptian Goddess, 543 F.3d at 678. Where there are many examples of similar prior art designs, differences between the claimed design and the accused design may become significant to the hypothetical ordinary observant who is familiar with the prior art. Id.

1. Prior Art Considerations

The Federal Circuit made a comparison of the claimed and accused designs with the prior art in Egyptian Goddess. In that case Egyptian Goddess accused Swisa of infringing its design patent (“the ‘389 patent”), which was directed to a nail buffer made of a hollow tube, rectangular in shape, with slightly raised buffers on three of its four outer surfaces. The Swisa buffer similarly was comprised of a hollow tube and rectangular in shape, but it had buffers on all four of its outer surfaces. Prior art buffers included a triangular buffer with buffers on all three sides, and a “four-way” nail buffer that was a solid, rectangular shaped block with buffers on all four of its surfaces.
The Federal Circuit reasoned that in light of the prior art, when comparing the buffer of the ‘389 patent with the Swisa buffer, the ordinary observer (such as a purchaser of buffers) would not consider them to be substantially similar. *Egyptian Goddess*, 543 F.3d at 682. The Court found that the triangular prior art buffer closely resembled the Swisa buffer, and noted that Egyptian Goddess’ expert never explained why an ordinary observer would regard the Swisa buffer as being closer to the claimed design of the ‘389 patent than to the triangular prior art buffer. *Id.* Further, the Federal Circuit agreed with the District Court 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." *Id.* Thus, the Federal Circuit affirmed the District Court’s summary judgment decision of non-infringement. *Id.* at 683.

In the post-*Egyptian Goddess* decision of *Arc’teryx Equipment, Inc. v. Westcomb Outerwear, Inc.*, 2008 WL 4838141, 89 U.S.P.Q.2d 1894 (D. Utah Nov. 4, 2008), the district court found that differences between the accused and patented designs became more apparent when viewed in light of the prior art. *Arc’teryx* alleged that Westcomb’s “Mirage Jacket” infringed *Arc’teryx’s* design patent, which was directed to an ornamental design for a curvilinear zipper. *Arc’teryx*, at *1.

The district court first noted that the parties agreed that the “ordinary observer” for the products at issue, was an outdoor clothing customer who was more discerning than the average retail shopper. *Id.*, at *2. The district court then found several differences between the accused and patented designs. *Id.* at *3. The first difference was that the patented design gave the impression there were only two sections – a straight section and a diagonal section, while the Mirage Jacket gave the impression that the jacket contained three sections – a straight section, a diagonal section, and a second straight section. *Id.* There were also differences in the placement of the diagonal sections of the zipper, in the length of the diagonal sections of each design, and in the lengths of the straight sections. *Id.*
The district court found that those differences became important when considering the prior art, which included a German patent and a Lowe Alpine jacket. \textit{Id.} In reviewing the prior art and comparing it to the patented design, the district court found that the number, length, and placement of the straight and diagonal sections differentiated each of the items. \textit{Id.} The district court found the patented design to be much closer to the Lowe Alpine jacket in that they both contained one straight and one diagonal section. Westcomb's Mirage Jacket, on the other hand, was similar to the German patent in that both designs contained a straight section, curving into a diagonal section, which curves into a second straight section. In light of these differences, as informed by the prior art, the district court held that no reasonable jury could find that an ordinary observer, familiar with the prior art, would be deceived into confusing the design of Westcomb's Mirage Jacket with Arc'teryx's claimed design. \textit{Id.}

In summary, while the point of novelty test has been abandoned, the prior art cannot be ignored. A three-way comparison and analysis will almost always be made in light of the Federal Circuit's guidance in \textit{Egyptian Goddess}. This involves consideration of (1) the ornamental design of the patent, (2) the designs existing in the prior art, and (3) the accused design. In general, if the accused product is closer to the prior art than it is to the patent, it is less likely that infringement will be found. In other
words, like a U.S. utility patent, the “closeness” of the prior art provides guidance in
determining the scope of protection of the design patent for finding infringement.

2. Prosecution History Estoppel

Under the doctrine of prosecution history estoppel, similar to a U.S.
utility patent, a design patent owner is precluded from obtaining a broad scope of
protection for a patented design which would resurrect subject matter given up during
prosecution of the patent application. Since there are normally no amendments to the
claim of the U.S. design patent and no amendments to the design drawings on which the
claim is based, prosecution history estoppel normally arises when
the USPTO makes
rejections based on the prior art and the patent owner subsequently submits arguments to
overcome the rejection and obtains the design patent. There is no black-and-white rule
concerning the application of prosecution history estoppel in U.S. design patents to limit
the Doctrine of Equivalents, so prosecution history estoppel must be considered on a case-
by-case basis.

An example of application of the doctrine of prosecution history
estoppel in the context of design patents occurred in Australia Vision Services Pty. Ltd. v.
infringement suit related to the ornamental design for sunglasses, the district court found
that the patent examiner had explicitly rejected the addition of side lenses as new matter
and refused to allow the patent until they were removed. Id. at 1158. As a result, the
patentee expressly limited the claim of its design patent by eliminating the side lenses. Id.
The district court stated that “these ‘particular facts’ represent a classic example of when
to apply prosecution history estoppel to a claim of infringement.” Id. Because the patentee
had narrowed the claim to exclude side panel lenses, and the accused product contained

2 See also Victus Ltd. v. Collezione Europa U.S.A. Inc., 48 USPQ2d 1145, 1148 (M.D. N.C. 1998)
(prosecution history barred patentee’s assertion that a design patent on a table with a parquet tops
was infringed under the doctrine of equivalents by a table with a glass top); Arner v. Sharper Image
Corp., 39 U.S.P.Q.2d 1282, 1292 n.12 (C.D. Calif. 1995) (“prosecution history can ... be used to
1980) (applying estoppel where applicant added descriptive statement to written description to
emphasize particular feature of design and overcome rejection by examiner).
dark tinted lenses on the side panels, the district court estopped the patentee from alleging infringement and granted the defendant's motion for partial summary judgment of non-infringement. Id. at 1158-59.

In summary, prosecution history estoppel applies to design patents as well as utility patents. Therefore, the scope of equivalence for a design patent may not be inconsistent with arguments for patentability made by the patent owner during prosecution of the design patent application.

D. Infringement Evidentiary Standards

Similar to a U.S. utility patent, infringement of a design patent is an issue of fact to be proven by the patent owner. The patent owner must prove infringement by a "preponderance of the evidence." If prior art is to be considered in comparing the patented design and accused design under the three-way comparison analysis espoused by Egyptian Goddess, it is the accused infringer's burden to come forward with that prior art. Egyptian Goddess, 543 F.3d at 678-79.

IV. Remedies for U.S. Design Patent Infringement

The remedies for infringement of a U.S. design patent are generally the same as the remedies for infringement of a U.S. utility patent (e.g., 35 U.S.C. §§271, 281, 283, 284, 285, 286 and 287). Alternative remedies peculiar to a U.S. design patent are also provided under 35 U.S.C. §289, wherein the infringer is liable to the owner to the extent of the infringer's total profits, with a minimum of no less than $250.00. This is a significant basis for assessing damages, particularly if the patent owner is not a manufacturer. Rather than a reasonable royalty, the patent owner could obtain the net profits made by the infringer from the sales of the infringing design.

It is important to note that a patentee cannot collect damages under both § 289 (the infringer's total profits) and § 284 (damages adequate to compensate for infringement). The patentee must elect one or the other. Additionally, under § 289, a court may not award three times the infringer's total profits (i.e., treble damages), as is statutorily allowed under
\[ \text{§ 284. See Braun Inc. v. Dynamics Corp. of America, 975 F.2d 815, 824 (Fed. Cir. 1992)} \]

(stating that nothing in § 289 authorized an increase in a patentee's total profit, and holding that the district court erroneously concluded that the treble damage provision of § 284 also applied to “profits” awarded under § 289).

Additionally, a patentee may not recover infringer profits under §289 and also receive a reasonable royalty under § 284 when both a design patent and a utility patent have been infringed by the sale of a single product. Catalina Lighting, Inc. v. Lamps Plus, Inc., 295 F.3d 1277, 1291 (Fed. Cir. 2002). The language of § 289 prohibits a double recovery of an infringer's profits. While a patentee is entitled to damages for each infringement (for infringement of the utility and design patents), once the patentee receives profits under § 289 for each sale, the patentee may not be entitled to a further recovery from the same sale because the award of infringer profits under § 289 could constitute 'damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer.' Id. (citing § 284). Thus, the recovery of infringer profits resulting from the single act of infringement could satisfy the patentee's entitlement under § 289 as well as its entitlement under § 284. Id.

In summary, the same types of damages available for infringement of a U.S. utility patent are also available for infringement of a U.S. design patent. Namely, under § 284 a patentee may receive at least a minimum of a reasonable royalty or lost profits of the patent owner who is a manufacturer, as well as treble damages and attorney's fees for willful infringement under § 285. However, an alternative remedy available to a design patent owner is the net profits of the infringer under § 289. A patentee may not recover damages under both § 284 and § 289, nor receive a double recovery under § 289 for infringement of the same product that is covered by both a utility and design patent. Finally, like U.S. utility patents, preliminary and permanent injunctions are also available.
V. CHALLENGES TO THE VALIDITY OF A U.S. DESIGN PATENT

Issuance of a U.S. design patent carries a presumption of validity under U.S. Patent Statute 35 U.S.C. §282 similar to a U.S. utility patent. In an infringement action, it is not part of the patent owner's initial burden of going forward with proof of its case to submit evidence supporting validity. Rather, the burden is first on the challenger to introduce evidence which raises the issue of validity. Further, a challenger must establish facts, by clear and convincing evidence, which persuasively lead to the conclusion of invalidity.

The three patentability requirements for a U.S. design patent, under 35 U.S.C. §171, generally are:

1. The design must be "new";
2. The design must be "original"; and
3. The design must be "ornamental".

While all three of these factors can be challenged to invalidate a U.S. design patent, the "new" factor is usually challenged by alleging disclosure of the design in the prior art. The "ornamental" factor is usually challenged by alleging that the patented design is dictated solely by functionality and not aesthetics. The "original" factor is usually challenged by alleging that another person is the inventor.

A. NOVELTY AND OBVIOUSNESS

An accused infringer alleging that a prior art reference anticipates a design patent under 35 U.S.C. § 102 must show by clear and convincing evidence that the prior art reference is identical in all material respects. Hupp v. Siroflex of America Inc., 122 F.3d 1456, 1461 (Fed. Cir. 1997). In other words, "[i]f the general or ensemble appearance-effect of a design is different from that of others in the eyes of ordinary observers, novelty of design is deemed to be present. The degree of difference [from the prior art] required to establish novelty occurs when the average observer takes the new design for a different, and not a modified already-existing, design." In re Bartlett, 300 F.2d 942, 943-44 (CCPA 1962) (citations omitted).
A design patent may also be challenged on the basis of obviousness. Design patents must meet a non-obvious requirement identical to that applicable to utility patents. Accordingly, 35 U.S.C. §103 applies to determine whether the patented design would have been obvious to one of ordinary skill in the art. See, e.g., Litton Sys., 728 F.2d at 1440-41; In re Nalbandian, 661 F.2d 1214, 1215, 211 USPQ 782, 783 (CCPA 1981). To challenge validity, four factors are considered in determining obviousness: (1) the scope and content of the prior art, (2) the differences between the prior art and claims at issue, (3) the level of ordinary skill in the art when the invention was made, and (4) secondary indicia, such as commercial success and copying. See Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); Litton Sys., 728 F.2d at 1441. In determining obviousness, it is the overall appearance of the design that must be considered. In re Leslie, 547 F.2d 116, 192 USPQ 427 (CCPA 1977). The viewpoint from which obviousness of a design is determined is whether the design would have been obvious to a designer having ordinary skill with the claimed type of article. In re Nalbandian, 661 F.2d at 1216.

B. ORNAMENTAL VS. FUNCTIONAL CONSIDERATIONS

A stringent standard exists for invalidating a design patent on grounds of functionality: the design of a useful article is deemed functional where “the appearance of the claimed design is 'dictated by' the use or purpose of the article.” Rosco, Inc. v. Mirror Lite Co., 304 F.3d 1373, 1378 (Fed. Cir. 2002) (citing L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993)). “[T]he design must not be governed solely by function, i.e., that this is not the only possible form of the article that could perform its function.” Seiko Epson Corp. v. Nu-Kote Int'l, Inc., 190 F.3d 1360, 1368, 52 USPQ2d 1011, 1017 (Fed. Cir. 1999).

"When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose." L.A. Gear, 988 F.2d at 1123. That is, if other designs could produce the same or
similar functional capabilities, the design of the article in question is likely ornamental, not functional.

The design need not be aesthetically pleasing. A design patent is for a useful article, but patentability is based on the design of the article, not the use. The design may contribute distinctiveness or consumer recognition to the design, but an absence of artistic merit does not mean that the design is purely functional. Seiko Epson, 190 F.3d at 1368.

VI. CONCLUSION

As indicated above, this presents a brief overview of the basic issues involved in an infringement analysis of a U.S. design patent. It is not meant to be a comprehensive treatise on infringement. Each particular U.S. design patent and accused design will provide its own specific set of facts which will likely require a more detailed look of the considerations outlined above, and possibly a more detailed look at specific case law having facts parallel to the infringement situation being considered. Expert testimony and consumer surveys become important factors in evaluating design infringement due to the fact that there is no written claim description of the patented design. It is important, of course, to have a comprehensive written opinion rendered by U.S. counsel in the event an infringement issue is raised with respect to a U.S. design patent to prevent a U.S. court from finding willful infringement, thereby awarding treble damages and attorney's fees to the patent owner under 35 U.S.C. §284.
# Table of Authorities

## Cases

<table>
<thead>
<tr>
<th>Case</th>
<th>Citation</th>
<th>Pages</th>
</tr>
</thead>
<tbody>
<tr>
<td>Arminiak &amp; Assocs., Inc. v. Saint-Gobain Calmar, Inc.</td>
<td>501 F.3d 1314 (Fed. Cir. 2007)</td>
<td>2</td>
</tr>
<tr>
<td>Avia Group Intern., Inc. v. L.A. Gear California, Inc.</td>
<td>853 F.2d 1557 (Fed. Cir. 1988)</td>
<td>4</td>
</tr>
<tr>
<td>Braun Inc. v. Dynamics Corp. of America</td>
<td>975 F.2d 815 (Fed. Cir. 1992)</td>
<td>11</td>
</tr>
<tr>
<td>Catalina Lighting, Inc. v. Lamps Plus, Inc.</td>
<td>295 F.3d 1277 (Fed. Cir. 2002)</td>
<td>11</td>
</tr>
<tr>
<td>Crocs, Inc. v. ITC</td>
<td>598 F.3d 1294 (Fed. Cir. 2010)</td>
<td>5</td>
</tr>
<tr>
<td>Dobson v. Dornan</td>
<td>118 U.S. 10 (1886)</td>
<td>3</td>
</tr>
<tr>
<td>Egyptian Goddess, Inc. v. Swisa, Inc.</td>
<td>543 F.3d 665 (Fed. Cir. 2008)</td>
<td>2-5, 6-11</td>
</tr>
<tr>
<td>Goodyear Tire &amp; Rubber Co. v. Hercules Tire &amp; Rubber Co.</td>
<td>162 F.3d 1113 (Fed. Cir. 1998)</td>
<td>2</td>
</tr>
<tr>
<td>Gorham Co. v. White</td>
<td>81 U.S. 511 (1872)</td>
<td>1, 5</td>
</tr>
<tr>
<td>Hupp v. Siroflex of America Inc.</td>
<td>122 F.3d 1456 (Fed. Cir. 1997)</td>
<td>13</td>
</tr>
<tr>
<td>In re Bartlett</td>
<td>300 F.2d 942 (CCPA 1962)</td>
<td>13</td>
</tr>
<tr>
<td>In re Carletti</td>
<td>328 F.2d 1020, 140 U.S.P.Q. 653 (CCPA 1964)</td>
<td>4</td>
</tr>
<tr>
<td>In re Garbo</td>
<td>287 F.2d 192, 129 USPQ 72 (CCPA 1961)</td>
<td>6</td>
</tr>
<tr>
<td>In re Leslie</td>
<td>547 F.2d 116, 192 USPQ 427 (CCPA 1977)</td>
<td>13</td>
</tr>
<tr>
<td>In re Nalbandian</td>
<td>661 F.2d 1214, 211 USPQ 782 (CCPA 1981)</td>
<td>13</td>
</tr>
<tr>
<td>International Seaway Trading Corp. v. Walgreens Corp.</td>
<td>589 F.3d 1233 (Fed. Cir. 2009)</td>
<td>3</td>
</tr>
<tr>
<td>L.A. Gear, Inc. v. Thom McAn Shoe Co.</td>
<td>988 F.2d 1117 (Fed. Cir. 1993)</td>
<td>4, 14</td>
</tr>
<tr>
<td>Lee v. Dayton-Hudson</td>
<td>838 F.2d 1186 (Fed. Cir. 1988)</td>
<td>5</td>
</tr>
<tr>
<td>Litton Systems, Inc. v. Whirlpool Corp.</td>
<td>728 F.2d 1423 (Fed. Cir. 1984)</td>
<td>1, 2, 13</td>
</tr>
</tbody>
</table>
OddzOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396 (Fed. Cir. 1997)................................. 4
Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010).................................................. 5, 6
Rosco, Inc. v. Mirror Lite Co., 304 F.3d 1373 (Fed. Cir. 2002)................................. 14
Sanson Hosiery Mills, Inc. v. Warren Knitting Mills, Inc., 202 F.2d 395, 96 USPQ 247 (3rd Cir. 1953) 6
Seiko Epson Corp. v. Nu-Kote Int'l, Inc., 190 F.3d 1360, 52 USPQ2d 1011 (Fed. Cir. 1999)........ 14
Smith v. Whitman Saddle Co., 148 U.S. 674 (1893)...................................................................... 2
Victus Ltd. v. Collezione Europa U.S.A. Inc., 48 USPQ2d 1145 (M.D. N.C. 1998)..................... 10

STATUTES
35 U.S.C. § 102 ......................................................................................................................... 13
35 U.S.C. § 103 ......................................................................................................................... 13
35 U.S.C. § 171 ........................................................................................................................ 12
35 U.S.C. § 271 ........................................................................................................................ 11
35 U.S.C. § 282 ........................................................................................................................ 12
35 U.S.C. § 283 ......................................................................................................................... 11
35 U.S.C. § 284 ......................................................................................................................... 11, 12, 15
35 U.S.C. § 285 ......................................................................................................................... 11, 12
35 U.S.C. § 286 ......................................................................................................................... 11
35 U.S.C. § 287 ........................................................................................................................ 11
35 U.S.C. § 289 ......................................................................................................................... 11, 12
DESIGN INFRINGEMENT ANALYSIS FLOWCHART

1. INTERPRET (CONSTRUE) THE DESIGN CLAIM

2. DOES PROSECUTION HISTORY ESTOPPEL PRECLUDE INFRINGEMENT?
   - NO
   - D.O.E. ANALYSIS

3. ARE DESIGNS EQUIVALENT IN THEIR ORNAMENTAL, RATHER THAN FUNCTIONAL ASPECTS?
   - NO
   - ARE THE DIFFERENCES BETWEEN THE CLAIMED DESIGN AND ACCUSED DESIGN INSUBSTANTIAL?
   - YES
   - PERFORM THREE-WAY COMPARISON BETWEEN CLAIMED DESIGN, PRIOR ART, AND ACCUSED DESIGN
   - ACCUSED DESIGN CLOSER TO CLAIMED DESIGN THAN PRIOR ART?
   - NO
   - LITERAL INFRINGEMENT
   - INFRINGEMENT UNDER DOCTRINE OF EQUIVALENTS
   - NO INFRINGEMENT

- YES

- NO