

A Proposal for a Major Overhaul of the Legal Standards for the Prosecution and Infringement of U.S. Design Patents

Goals to be achieved:

1. Reduce design patent examination pendency to less than two weeks,
2. Examine many more design patent applications with far fewer examiners,
3. Assure greater accuracy and consistency in obviousness rejections,
4. Substantially reduce the cost of design patent applications,
5. Assure more thorough and accurate prior art searches, and
6. Harmonize the standards for obtaining and infringing design patents.

By, Cooper C. Woodring, FIDSA®

ccwoodring@cox.net

I am not an attorney. I'm an industrial designer.

I have served as an expert witness in design patent litigation for over 20 years and in over 100 cases involving such diverse product designs as smartphones, artificial fingernails, tire treads, dog food, scrunchies (elastic pony-tail holders), bubble-wrap, toilet paper, bricks, and cork-screws, to name a few. I am also the recipient of several dozen U.S. patents. I know how the USPTO currently prosecutes design patent applications; I know how design patent infringement is determined in U.S. District Courts; and I have given considerable thought as to how both processes could and should work in the future. Lets start with infringement then move on to the issue of prosecution of U.S. design patents.

The process of determining design patent infringement requires answering a few simple questions, "How close is too close, how is that determined, and whose opinion is it that matters?" This is not as easy as it might at first seem. The standard for determining infringement is whether the patented and accused designs are "substantially the same" in the eye of an ordinary observer. Technically, the U.S. Supreme Court's *Gorham v. White* infringement standard is:

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 to deceive such an observer, inducing him [or her] to purchase one supposing it to be the other, the first one patented is infringed by the other.

And, as the United States Court of Appeals for the Federal Circuit made clear in our post *Egyptian Goddess v. Swisa* world, the ordinary observer is "familiar with the prior art". This sounds pretty straight forward, but it is actually very subjective for at least the following half-dozen or so reasons.

First, the hypothetical "ordinary observer" is not an expert, but rather an observer of "ordinary acuteness" who brings to the examination "that degree of observation which men of ordinary intelligence give".

Second, the claimed design may be only a small portion of a product for which there has never been, and will never be, a “purchaser”, although prior case law suggests we improperly substitute the purchaser of the entire product.

Third, the ordinary observer must be familiar with probably a dozen or more prior art designs, requiring the ordinary observer to have the ability to evaluate and determine the nature, scope and effect of the prior art on the comparison of the patented and accused designs.

Next, the “giving such attention as a purchaser usually gives” requires the ordinary observer to take into account whether the design is a “need”, a “want” or even an impulse purchase, and to consider the product’s cost, value, retail selling environment, availability, life-expectancy, warranty, etc.

Next, the ordinary observer must understand the meaning of design patent drawing conventions such as “tangential-edge line shading”, “brackets”, “cross-sections”, “stippling”, “broken lines” and “oblique line shading” to name a few.

Also, the Gorham test includes such vague terms as “usually”, “resemblance”, “deceive”, “inducing”, and “supposing”, all words of nuance subject to multiple interpretations and all potential traps for the unwary.

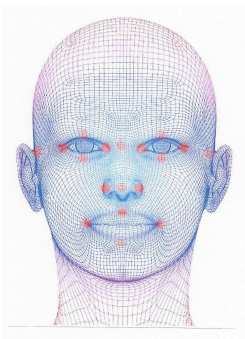
And, lastly, the ordinary observer must fully understand what the United States Supreme Court really meant by “substantially the same” in *Gorham v. White*.

In light of this degree of subjectivity and complexity, it seems unreasonable to think that a judge or a jury of ordinary observers can determine design patent infringement with any degree of fairness, correctness and consistency. Evidence of their inability to do so lies in the frequency with which the Federal Circuit has overturned a lower district court’s findings.

So, the challenge is to develop an entirely new system of determining infringement and of prosecution of a U.S. design patent that is comprehensible, consistent and even predictable. Let’s examine some technology already available that could achieve such a lofty goal.

Facial recognition systems are computer applications for automatically identifying a person from a single digital image. The U.S. Department of State operates one of the world's largest facial recognition systems with well over 120 million face photographs. Most were collected from passports and state's driver's licenses. Yours is undoubtedly there. At Super Bowl XXXV, 13 years ago, police in Tampa Bay used facial recognition software to search for potential terrorists in attendance at the event. They didn't find any, but they did find 19 people wanted for minor offences and they were all arrested, but were allowed to stay to watch the Baltimore Ravens defeat the New York Giants 34 to 7.

The way facial recognition works is a digital photograph is taken of the person's face from up to about 50 yards away and up to about 20 degrees off of a straight-on view, often without the person's knowledge. That image is computer compared with a database and the person is identified, usually within less than one minute, and the degree of certainty of the identification is also verified, usually being above 99.8 percent certainty. This is the same type of identification system that was **not** used by the lost Malaysia Airlines that allowed two passengers to board Flight 370 with stolen passports. More responsible countries check all passport photographs against an Interpol database in usually 30 to 45 seconds. These systems have improved over the years until they are now capable of identifying each of two identical twins more accurately than are human participants. There are, however, some limitations to facial recognition systems such as the wearing of dark sunglasses or the person is simply not in the database. Plastic surgery will usually not avoid identification.



So, what does facial recognition systems have to do with determining design patent infringement, or how we would prosecute design patents in the future.

We can utilize that same digital image recognition technology to determine design patent infringement. If an accused design is suspected of infringing a patented design, a computer comparison will be made of the two designs. The accused design will be photographed in black and white and in the exact same elevation views as the design patent's views. Then, corresponding line drawings will be computer generated from the accused design's photographs. The accused design's newly created digital images will then be computer compared to the patent's claimed design's digital images. The accused design will infringe if the computer analysis finds it to be 83.50 percent or more visually similar to the patent's claimed design; or it will not infringe if found to be 83.49 percent or less similar to the patent's claimed design.

In the computer comparison, all views of the patented and accused designs are considered of equal importance and drawing conventions such as broken lines or oblique line shading is recognized, understood and considered. If there are any inconsistencies among the various views of the application, the computer will identify them so that they can be computer corrected.

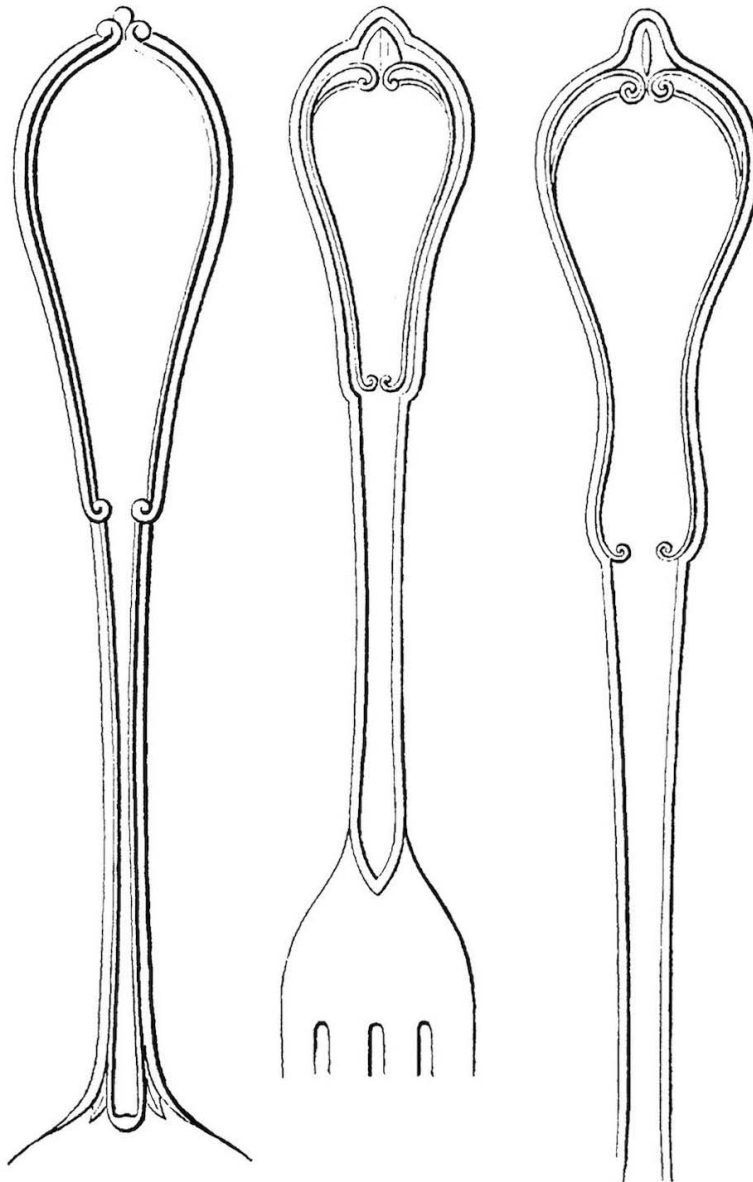
You are probably wondering how the magical 83.50 percent number was arrived at. It was not arbitrarily established. To establish the 83.50 percent number, a computer comparison was made of White's accused design to Gorham's patented design to determine what the Supreme Court Justices actually meant by "substantially the same", or how different the two designs were while still being considered "substantially the same" in the eye of an ordinary observer and thus, infringing. Being 83.50 percent the same in overall appearance is also being 16.50 percent different in overall appearance.

But before this *Gorham v. White* comparison could be made, we had to first determine what White's accused design actually looked like, as Westlaw and other similar organizations have improperly, but knowingly, substituted one or both of White's design patents for photographs of White's actual design. Following is an a visual example of Westlaw's improperly comparing one of Gorham's design patent's drawings to both of White's design patent drawings to determine whether infringement had occurred.

GORHAM CO.

WHITE, 1867.

WHITE, 1868.



Copr. © West 1999 No Claim to Orig. U.S. Govt. Works

Westlaw®

The reason Westlaw and others improperly substituted White's patent drawings, is because a physical example of White's actual accused spoon was lost to history over 100 years ago, and the 1871 *Gorham v. White* trial was 17 years **before** George Eastman invented and patented the camera. As a result, we did not know what White's design actually looked like; we did not know who manufactured it; and, we did not know what the tableware pattern was named. We only had his patent drawings.

After a ten-year search to discover White's actual spoon's design, I was able to photograph it in the exact same views as were shown in Gorham's design patent. Those photographs were computer converted to line drawings that were then computer compared to the line drawings in Gorham's design patent. This process established the Supreme Court's meaning of "substantially the same" or infringing as being 83.50 percent visually similar or 16.49 percent visually different from Gorham's patented design.

See the next page for the 1872 Gorham brochure, discovered in the Gorham Archives at Brown University Library in Providence, Rhode Island that identified White's design as "the Gothic pattern" (5 lines up from the bottom).

United States Supreme Court.

AN IMPORTANT DECISION RELATING TO THE FUTURE OF THE FINE ARTS.

In the decision of the suit of the Gorham Manufacturing Company *vs.* White, the Supreme Court of the United States has rendered signal and important service to the progress of the fine arts. By the statute of 1842 Congress authorized the Commissioner to grant letters patent to those "whose industry, genius, efforts and expense" should produce new designs for printing, statues, bas reliefs: in short, for all forms of ornamentation. It was the intent of this act that the art of decoration should enjoy the fostering care and protection which has conferred such conspicuous benefit upon the American inventions in the mechanic arts; and in construing this law in such a manner as to give practical protection to the designer, the Court has, doubtless, lent a valuable impulse to the artistic culture of the country.

Although passed twenty years ago, this act has remained almost wholly a dead letter. Very few suits were brought under it at the Circuit, and, until the present, none have been carried to the Supreme Court.

The result has been that infringements of design patents have become almost universal. No sooner did a pattern, devised and introduced at great expense, become popular in the market, than it was copied by other manufacturers, who thus, without risk, and almost without loss of business consideration, enjoyed the fruits of the genius and enterprise of others. This became at last a serious evil, which seemed to threaten the very existence of American design, for no one could afford to employ a corps of artists and incur the cost to bringing new goods into the market, if his property in the result was open to be shared by all the world.

This was the state of the business which the Gorham Manufacturing Company undertook to remedy. They were, as every one knows, foremost among American silversmiths for the beauty and novelty of their goods. Undismayed by the growing practice of infringement which disgraced the trade, they kept a large corps of artists in their employ, whose business it was to devise new and beautiful forms and decorations. They were, as a general rule, copied by others, and the Gorham Company resolved to see whether the law which had promised them protection was adequate to furnish them relief against this great and serious mischief. They have carried on this good fight for art and their rights for six years, unaided, save by the moral support of the trade, and the decision of the Supreme Court has at last crowned their courage and endurance with brilliant triumph. They selected, as the ground on which to make their fight, the patent for the design of the well-known Cottage Pattern of spoons and forks. The infringers called their goods the Gothic Pattern, and had, also, a patent, but the Gorham Company charged that this was an evident copy of their design, varied only for the purpose of escaping the law. It was an additional grievance in this case, that the Cottage goods were in silver, while the imitation was in base metal.

It then became easy to determine that Rogers & Brothers (today known as International Silver) manufactured “the Gothic pattern”. And to add insult to injury, White’s copycat design was in “base metal” while Gorham’s original design was available only in coin or sterling silver (see last line of brochure).

I was concerned that after identifying White’s actual spoon, I might never find any, as old silver-plated spoons are rarely collected and are worth very little. Replacements, Ltd., however, had seven of White’s Gothic pattern teaspoons in mint condition for \$17.99 each. I bought them all and have since found several more on eBay. While searching Replacements, Ltd., I also looked to see if I could find one of Gorham’s patented Cottage pattern spoons in coin or sterling silver. They had one, in mint condition, and they discounted the price by 50% because it was monogrammed “CW”, my initials. It was meant to be, and I bought it as well. I have since given away several of White’s actual spoons to prominent design patent attorneys and to a Senior Judge at the Federal Circuit so that they could **see** what the Supreme Court’s Justices were actually looking at when they determined that White’s design infringed Gorham’s patented design. Infringement is a visual test, not a verbal test. Remember, the Gorham test, states: “If in the **eye**”, not, “If in the **ear**”. This is why we have photographs of ourselves on our drivers’ licenses rather than written descriptions of what we look like. It is simply a faster and far more accurate means of communicating what a person or a product looks like.

Now, let’s turn to the prosecution or the design patent examination process at the USPTO. In the future, we will depict the various elevation views of the design we wish to patent in black on white line drawings, just as we do today. Then we will electronically submit the drawings to the USPTO, just as we do today. Then the design patent examiner will subject the design patent application’s digital images to a computer comparison of several million prior art references for anticipation/obviousness and a patent will be issued if the computer analysis finds the new design to be no closer than 83.50 percent visually similar to the closest prior art design. The closest prior art reference will also be computer identified and recorded on the face of the newly issued patent

as the “Primary Reference” in lieu of the dozens of somewhat similar prior art references, as is the case today. This anticipation/obviousness examination will normally take less than one minute and the result will be consistent, accurate and fair. It also eliminates the current requirement for the patentee to submit any prior art that he or she thinks might be “material to the examination” as the computer-aided prior art database will find any similar designs. An average design patent examiner could easily “examine” a dozen or more design patent applications in a typical day.

Now the standard for obtaining a design patent and the standard for infringing a design patent will be the same. Therefore, a patented design can no longer infringe a patented design, as was demonstrated in the *Gorham v. White* case as both John Gorham and LeRoy White had design patents; in fact, White had two.

This process eliminates the subjectivity and complexity of both obtaining and of determining infringement of design patents that currently exists and it makes any appeal to Federal Circuit unnecessary, as retrying the same case, with the same standards, in the same way, will produce the same result.

Once this new system is implemented by the USPTO, further software can then be developed that will improve the product design creation process by alerting the designer that his design is infringing some prior art designs, and it will suggest changes to the design being created to avoid infringement of any prior art design. When the new design is below the 83.50 percent similarity threshold, the designer will know the new design is not only not infringing, but is also patentable over the closest prior art reference. This will allow the designer to assure the client that they are receiving a potentially award winning design rather than an inadvertent design patent infringement suit.

Unfortunately, copycats will also use the same software in a nefarious way to reverse-design a successful design, by changing one relatively insignificant element at a time, until the 83.49 percent non-infringement threshold has been reached. Then, the copycat may proceed without fear of being sued for design

patent infringement, but at least the copycat's design will be 16.50 percent or more different in overall appearance from the prior successful patented design.

So, the USPTO's design examiners won't like it because most of them will lose their jobs, many patent attorneys won't like it for the same reason, especially those who specialize in design patents. Those of us who serve as expert design witnesses won't like it either, and within a few years there will probably be no more design patent infringement suits, or if there are, they will be resolved indisputably and inexpensively. However, the USPTO's director will love it because it dramatically increases efficiency, Congress will love it because it reduces cost, or increases the profitability of the USPTO, and most industrial designers will love it because it eliminates the legal risks associated with creating new industrial designs. And, unfortunately, copycats will probably also love it because it establishes a clear boundary for them as to how closely they can copy a successful patented prior design.

To reiterate, the goals achieved by this new system are:

1. Reduce design patent examination pendency to less than two weeks,
2. Examine many more design patent applications with far fewer examiners,
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(2,600 words)