

## 4 Practical Pointers For Litigating A Design Patent Case

By **Nathan Sabri** (October 20, 2021, 4:08 PM EDT)

The Patent Act states that the provisions relating to utility patents "shall apply to patents for designs, except as otherwise provided."

But as anyone who has litigated a design patent case knows, the two are worlds apart. In practice, the test for infringement is different; the test for invalidity is different; the remedies can be different; and many critical doctrines are relevant only to design patent cases.

Two recent design patent opinions from the U.S. Court of Appeals for the Federal Circuit, *Campbell Soup Co. v. Gamon Plus Inc.* in August<sup>[1]</sup> and *In re: SurgiSil LLP* in October,<sup>[2]</sup> underscore how different these worlds are. They are the only precedential, substantive design patent opinions in the Federal Circuit in 2021 so far.



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Both involve analyses particular to design patent cases: *Campbell Soup* relates to whether cited prior art created the same overall impression as the claimed design, and *SurgiSil* addresses whether a claimed design was limited to the identified article of manufacture. Those issues would never come up in a utility patent case.

Here are some tips for the intellectual property litigator preparing to dive into this area.

### **Prepare to educate the court**

From prosecution to litigation, design patents are far rarer than utility patents.

Despite the view expressed by some over the past few years that design patent filings are on the rise,<sup>[3]</sup> they remain a remarkably consistent fraction of total patent filings: generally in the 5-6% range all the way back to 1963 — the earliest year in the U.S. Patent and Trademark Office's U.S. patent statistics chart — spiking to above 7% in 1983-1989, 1991-1994, 1996-1997, and 2018-2020; and just reaching 8% once, in 1987.<sup>[4]</sup>

The litigation numbers are similar. Looking at a dataset from 2000 to 2016, a study last year concluded that "cases where only design patents are asserted represent only 4.44% of patent litigation cases."<sup>[5]</sup> Adding in cases that include both design patents and utility patents increases that number to only 6.16%.<sup>[6]</sup>

As a result, in contrast with utility patents, your judge may never have handled a design patent case — or, at most, will have done so very rarely.

U.S. District Judge Alan D. Albright of the U.S. District Court for the Western District of Texas, for example, is well known as one of the busiest judges in the country. Law360 reported in March that he was overseeing 20% of new patent cases.[7] A search on Westlaw returns about 400 orders attributed to Judge Albright. None refers to a design patent or the ordinary observer test for design patent infringement.

Other district court judges known for their busy dockets show similar results on Westlaw. Of over 2,000 opinions attributed to U.S. District Judge Leonard Stark in the U.S. District Court for the District of Delaware, only three mention design patent or the ordinary observer standard: two from the same case[8] and one from an opinion referring to a design patent in passing in a footnote.[9]

Of over 1,300 opinions attributed to U.S. District Judge James Rodney Gilstrap of the U.S. District Court for the Eastern District of Texas, only one refers to design patent: an order on a motion for summary judgment of no recoverable damages based on the marking statute.[10]

Of course, these are not the busiest design patent venues. According to Lex Machina statistics published a few years ago, those would include the U.S. District Courts for the Central District of California, the Southern District of New York and the Northern District of Illinois.[11]

A search in each of those venues for design patent-related opinions from the longest-serving judge, using the same criteria discussed above, yields sparse results: 10 for U.S. District Judge Stephen Wilson of the Central District of California, appointed in 1985; two for U.S. District Judge John Koeltl of the Southern District of New York, appointed in 1994; and four for U.S. District Judge Charles R. Norgle Sr. of the Northern District of Illinois, appointed in 1984.

All of this means you must be prepared to educate the court much more than in the typical utility patent case. Depending on your venue, even a judge who handles utility patent cases regularly may not have seen a design patent case in years, if ever. Keep that in mind when laying out legal standards, and consider emphasizing the differences in the areas of law if the court is likely to be familiar with other types of intellectual property.

### **Be creative with prior art searches**

In a utility patent case, prior art must teach every element of a claim to anticipate and invalidate a claimed invention. This naturally leads practitioners to prioritize patents, patent applications and printed publications for references with sufficient discussion and disclosure, as well as product art, if possible.

A design patent, however, protects the ornamental aspects of an article of manufacture, not how the article works. There are no written elements to walk through and check off, making the written disclosures of prior art references largely irrelevant.

While this narrows the field in some respects, including because design patent applications are generally not published, it opens the door to creative searches in others. Figures in a patent for an invention that is otherwise quite different, the look of a product that differs in key functional ways, and even concept art or published images may show that a claimed design is not novel.

## **Think about claim construction differently**

Utility patent litigators are accustomed to claim construction being a major, sometimes case-dispositive, part of a patent matter. In design patent cases, however, claim construction has far more limited utility, if it even occurs.

Immediately after its 1995 *Markman v. Westview Instruments* decision, the Federal Circuit, in *Elmer v. ICC Fabricating Inc.*, confirmed that claims in a design patent case must also be construed to determine their meaning and scope.[12] The 2008 en banc *Egyptian Goddess Inc. v. Swisa Inc.* opinion clarified, however, that the preferable course for a district court is ordinarily "not to attempt to 'construe' a design patent by providing a detailed verbal description of the claimed design." [13]

Subsequent opinions reinforced this approach, like the 2010 *Crocs Inc. v. International Trade Commission* decision, which emphasized the "dangers of reliance" on a detailed construction [14] and 2016 *Sport Dimension Inc. v. Coleman Co.* decision, which emphasized the fact that "[a] design patent's claim is thus often better represented by illustrations than a written claim construction." [15]

The U.S. District Court for the District of New Jersey even expressly carves design patents out of its local rules addressing claim construction, although it does not set out a separate claim construction process. [16]

The net result is that litigators should not expect a design patent claim construction process that looks anything like the typical utility patent process and certainly should not expect to construe a design patent into a list of elements. Claim construction can be useful for specific questions bearing on claim scope: functionality, disclaimed material, drawing conventions. But your court may decide there is no need for claim construction at all.

## **Consider how to deal with less certainty**

Although there is often plenty of room for argument in utility patent cases — especially after taking into account contrary views of claim term interpretation — many elements will, or will not, be met as a factual matter.

An element of a claim to a chemical compound requiring a particular percentage of a given component generally either is, or is not, met. In a technology case, one might engage a tear-down or testing vendor to determine whether particular claim elements are met.

In a design patent case, by contrast, the test for infringement is subjective, not objective, as the U.S. Supreme Court stated in *Gorham Co. v. White* in 1871:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing ... purchase [of] one supposing it to be the other, the first one patented is infringed by the other. [17]

This is not a test that can be provably true or false; it will nearly always leave room for interpretation and argument.

Many have remarked on the challenge of ambiguity in design patent litigation. University of Oklahoma College of Law professor Sarah Burstein has noted that the very language of design patent governance is

ambiguous, observing that it is even unclear what "new and original" means in the design patent context.[18]

Researchers Charles Mauro and Chris Morley and attorney Perry Saidman have recently described design patent case law as "highly unstable and unpredictable" and noted the "persistent presence of high levels of subjective variability in design patent litigation." [19]

A solution proposed to this unpredictability is to rely more heavily on large-sample consumer surveys, which tend to be little used.[20] Counsel for Egyptian Goddess in the landmark *Egyptian Goddess v. Swisa* case made the same push nearly 10 years ago.[21]

In addition to the use of surveys, consider focus groups or early engagement of design experts. Even if solely for internal use, additional viewpoints beyond the team litigating the case or the client can provide eye-opening insights from less biased sources.

In sum, litigating a design patent case takes more of a shift in thinking than looking up the different standards and remembering to put a "D" before the patent number — although that is also important; referring to a design patent as "the '123 patent" instead of "the D'123 patent" is a surefire way to reveal yourself as a dabbler. These tips will get you started in the right direction.

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[1] [https://cafc.uscourts.gov/opinions-orders/20-2344.OPINION.8-19-2021\\_1821952.pdf](https://cafc.uscourts.gov/opinions-orders/20-2344.OPINION.8-19-2021_1821952.pdf).

[2] [https://cafc.uscourts.gov/opinions-orders/20-1940.OPINION.10-4-2021\\_1843781.pdf](https://cafc.uscourts.gov/opinions-orders/20-1940.OPINION.10-4-2021_1843781.pdf).

[3] See, e.g., <https://www.mcandrews-ip.com/the-perfect-storm-that/>; <https://www.jdsupra.com/legalnews/the-rise-of-design-patents-insights-64123/>; <https://www.whitecase.com/publications/article/design-patents-growing-trend-hardware-space>.

[4] [https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us\\_stat.htm](https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm).

[5] David Schwartz & Xaviere Giroud, "An Empirical Study of Design Patent Litigation," *Alabama Law Review* 72:2:417, at 443.

[6] *Id.*

[7] <https://www.law360.com/articles/1361071/judge-albright-now-oversees-20-of-new-us-patent-cases>.

[8] *SZ DJI Technology Co., Ltd. v. Autel Robotics, USA LLC*, Case No. 16-706-LPS, 2019 WL 6840357 (D. Del. Dec. 16, 2019); *SZ DJI Technology Co., Ltd. v. Autel Robotics, USA LLC*, Case No. 16-706-LPS, 2021 WL 3403930 (D. Del. Aug. 4, 2021).

[9] Arendi Holding Ltd. v. Microsoft Corp., Case No. 09-119-JJF-LPS, 2010 WL 1050177, at \*8 n.8 (D. Del. Mar. 22, 2010).

[10] Grand Overseas, Inc. v. Dollar General Corp., Case No. 2:11-cv-468-JRG, 2013 WL 11522059 (E.D. Tex. Aug. 21, 2013).

[11] <https://www.ipwatchdog.com/2016/10/26/design-patent-litigation-correlation-trademark-infringement/id=74097/>.

[12] Elmer v. ICC Fabricating, Inc., 67 F.3d 1571 (Fed. Cir. 1995).

[13] Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc).

[14] Crocs, Inc. v. ITC, 598 F.3d 1294, 1301 (Fed. Cir. 2010)

[15] Sport Dimension, Inc. v. Coleman Co., 820 F.3d 1316, 1321 (Fed. Cir. 2016).

[16] See, e.g., D.N.J. L. Pat. R. 4.1.

[17] Egyptian Goddess, 543 F.3d at 670 (quoting Gorham Co. v. White, 81 U.S. 511, 528 (1871)).

[18] "Expert analyzes lack of clear standard for design patents at IPIL's 26th Annual Fall Lecture," <https://www.law.uh.edu/news/fall2019/1211IPIL.asp>.

[19] Charles Mauro, Chris Morley, and Perry Saidman, "Design Patent Litigation: Increasing the Probability of Success in Infringement Outcomes," <https://www.straffordpub.com/products/design-patent-litigation-increasing-the-probability-of-success-in-infringement-outcomes-2021-09-09>.

[20] Id.

[21] "Design Patent Perspective: Surveys for Design Patent Litigation," Intellectual Property Today, April 2012, available at [https://www.oake.com/uploads/8/0/9/6/80961810/10\\_surveys\\_-\\_part\\_1\\_-\\_april\\_2012.pdf](https://www.oake.com/uploads/8/0/9/6/80961810/10_surveys_-_part_1_-_april_2012.pdf).