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THE EYE ALONE IS THE JUDGE: IMAGES AND DESIGN PATENTS

Rebecca Tushnet*

Design patents are an area of intellectual property law focused entirely on the visual, unlike copyright, patent, trademark, trade secret, or the various sui generis protections that have occasionally been enacted for specific types of innovation.¹ The law's traditional bias against, even fear of, the visual² may help explain why design patents have been of less interest to many intellectual property scholars than other bodies of IP law.³ Christopher Buccafusco has argued that “[p]atent law most directly confronts the sense of sight in the field of design patent law,” but that the result has been “considerable confusion and unhappiness among courts and commentators.”⁴ He attributes this anxiety to the discomfort that patent judges have “deciding questions of visual aesthetics,”⁵ and I would simply strike “patent” from his description: Judges and lawyers in general are highly uncomfortable with images, yet design patents force direct legal engagement with images. This short piece offers an outsider's view of what design patent law has to say about the use of images as legal tools, why tests for design patent infringement are likely to stay unsatisfactory, and what lessons other fields of intellectual property, specifically copyright, might take from design patent.

Design patent offers a way to protect the aesthetic, nonfunctional elements of a product design. Unlike copyright, which attaches to original works automatically, design patent requires examination and registration by the Patent and Trademark Office. A design patent itself is granted based on the drawing, which defines the protected material, rather than on the written description that predominates in utility patents.⁶ The law requires a “written description”⁷ of

* Professor, Georgetown Law. Thanks to participants at Georgia's conference, including Stacey Dogan, Jason Du Mont, Mark Janis, and Mark McKenna, and to Greg Vetter, who provided helpful comments.

¹ Proposals for fashion design protection in the U.S., if enacted, would add a design patent-like protection for fashion also focusing on the visual.

² See Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright Law*, 125 HARV. L. REV. 683 (2012).

³ See Janice M. Mueller & Daniel Harris Brean, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 423–24 (2010–2011) (contrasting design patent's popularity with patents with its relative judicial and scholarly inattention).

⁴ Christopher Buccafusco, *Making Sense of Intellectual Property Law*, 97 CORNELL L. REV. 501, 524 (2012); see also *id.* at 527 (suggesting that “technophile” Federal Circuit judges “are particularly anxious about the ‘subjective’ nature of visual pleasure”).

⁵ *Id.* at 524.

⁶ See U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1503.01 (8th ed. rev. Oct. 2005) [hereinafter MPEP] (“No description of the design in the

patent claims, but the drawing is the written description for design patents. Though the Federal Circuit purported to reject the “linguist[ic]” distinction between drawing and writing, it then concluded that the drawing in a design patent is the key and the words are incidental: not a rejection but a reversal of the usual valuation of words over images in law.⁸ Words purporting to claim a design’s characteristic features cannot serve as a basis for patentability; overall appearance is the key.⁹

The standard for infringement is also purely visual. In *Gorham Co. v. White*, the Supreme Court stated 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.¹⁰

Quoting an English case, the Court held that “the eye alone is the judge of the identity of the two things.”¹¹

But what does it mean for the eye to be the judge in a legal system organized around words? How can the report of an eye be turned into a verdict, and further into a reviewable judgment? In recent years, the Federal Circuit has

specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description.” (citing *In re Freeman*, 23 App. D.C. 226 (D.C. Cir. 1904)); *Unidynamics Corp. v. Automatic Prods. Int’l*, 157 F.3d 1311, 1323 (Fed. Cir. 1998) (a design patent has “almost no scope beyond the drawings”); *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988) (a design patent is limited to what is shown in drawings); *Application of Laverne*, 356 F.2d 1003, 1006 (C.C.P.A. 1966) (“The test is inherently a visual test, for the design is nothing more than appearance, and the appearance is that of the article as a whole.”).

⁷ 35 U.S.C. § 112 (2006).

⁸ *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998) (“It is the drawings of the design patent that provide the description of the invention. Although linguists distinguish between a drawing and a writing, the drawings of the design patent are viewed in terms of the written description requirement of § 112.” (citations and internal quotations omitted)); *Concept Innovation v. CFM Corp.*, No. 04 C 3345, 2004 WL 2812109, at *1 (N.D. Ill. Dec. 7, 2004) (“Unlike utility patents, design patents do not describe claimed designs in words: ‘[n]o description, other than a reference to the drawing, is ordinarily required’” (citations omitted)); see also MPEP, *supra* note 6 (“[W]hile not required, such a [textual] description is not prohibited . . .”).

⁹ MPEP, *supra* note 6, § 1503.01 (citing *In re Rosen*, 673 F.2d 388 (1982)). Moreover, “if a description is presented, it must only describe the appearance of the article illustrated in the drawings and not the construction or function of the claimed design.” Ronald L. Panitch, *Design Patents*, C602 ALI-ABA 295, 303 (1991) (internal quotations omitted).

¹⁰ *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 20 L. Ed. 731, 528 (1871).

¹¹ *Id.* at 526 (quoting *Holdsworth v. McCrea*, 2 A.C., (H.L.), 388 (U.K.)).

struggled with these questions. After experimenting, post-*Markman*,¹² with written descriptions as claim construction,¹³ the court determined that written descriptions of a design patent should be avoided where possible.¹⁴ In *Egyptian Goddess, Inc. v. Swisa, Inc.*, the en banc Federal Circuit held:

As the Supreme Court has recognized, 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.” . . . Given the recognized difficulties entailed in trying to describe a design in words, 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.¹⁵

The key problem with this approach can be briefly stated, though not easily resolved: Many designs involve non-novel or functional features, and are only protectable because of other novel features, or because of a novel combination of otherwise familiar features. But if the overall effect of the design on the eye is the measure of infringement, how are factfinders to avoid potentially broadening the scope of the design patent too far when an accused design looks like a patented design because of similarities in these unprotectable features?¹⁶

¹² *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) (setting out a standard for claim construction in utility patent cases).

¹³ See *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (“Unlike the readily available verbal description of the invention and of the prior art that exists in a utility patent case, a design patent case presents the judge only with visual descriptions. Given the lack of a visual language, the trial court must first translate these visual descriptions into words—i.e., into a common medium of communication. From this translation, the parties and appellate courts can discern the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design.” (footnote omitted)); *id.* at 103 n.2 (“When properly done, this verbal description should evoke the visual image of the design.”); *Concept Innovation v. CFM Corp.*, No. 04 C 3345, 2004 WL 2812109, at *3 (describing the court’s role as “consider[ing] the patent’s ornamental features and visual pictures as a whole to translate the patent’s visual descriptions into words that evoke the visual image” (citations omitted)); Perry J. Saidman & Alison Singh, *The Death of Gorham Co. v. White: Killing it Softly with Markman*, 86 J. PAT. & TRADEMARK OFF. SOC’Y 792 (2004).

¹⁴ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc); see also *Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, No. 03-1162, 2004 U.S. App. LEXIS 770, at *5 (Fed. Cir. Jan. 16, 2004) (“[A] district court need not always verbally construe at length a design patent’s drawings. The infringement analysis essentially involves comparing the drawings to an accused device; a verbal description of the drawings does not necessarily aid such a comparison.”).

¹⁵ *Egyptian Goddess*, 543 F.3d at 679 (citations omitted).

¹⁶ See, e.g., *Durling*, 101 F.3d at 104 (finding that a district court construed the claimed design “too broadly” and that the description “merely represents the general concept of a sectional sofa

(The same problem comes up in copyright, where similarities in unprotectable ideas or standard tropes should not suffice for liability, yet the gestalt substantial similarity test risks holding defendants liable because of such commonalities.)

A written description requirement seemed to offer some hope of managing the problem, since the factfinder could identify the novel elements of the design in writing; only a defendant who copied those elements would infringe. A written description requirement, that is, inherently limited the scope of a design patent, serving as a screening device in the same way that courts' increasingly common demand for a written description for an unregistered trade dress now does in trademark law.¹⁷

But the word and the image were in serious conflict. Critics noted that "it is difficult to properly and precisely describe with words a design that consists of anything more than simple geometric shapes. Usually the scope of the description will be too broad, too narrow, or too ambiguous."¹⁸ Given a single picture, different people would produce very different written descriptions.¹⁹ Occasionally, courts suggested that *judges* in particular, untrained in art, couldn't perform the necessary translations,²⁰ or that design patent drawings were different from other types of images in ways that made them hard to describe: "Setting down into words what visual impression is created by a fitting for plastic troughs carrying fiber optic cables is a remarkably different endeavor than describing

with integrated end tables").

¹⁷ Rebecca Tushnet, *Looking at the Lanham Act: Images in Trademark and Advertising Law*, 48 HOUS. L. REV. 861, 886–87 (2011).

¹⁸ Brief of Plaintiff Appellant Egyptian Goddess, Inc. for En Banc Appeal at 30 *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (2008) (No. 2006-1562), 2008 WL 545145, at *30 [hereinafter *Egyptian Goddess en banc brief*]. *Egyptian Goddess en banc brief*, at 30; *see also* *Dobson v. Dorman*, 118 U.S. 10, 14 (1886) ("[The design] is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration."); *In re Freeman*, 23 App. D.C. 226, 229 (D.C. Cir. 1904) ("Undoubtedly, in the matter of application for a patent for a design, a picture of the design serves to convey a greatly more adequate idea of the design than any verbal description could possibly do; and, in the presence of the picture, a superadded verbal description is generally useless and oftentimes confusing."); Corrected Brief of Amicus Curiae Apple Inc. in Support of Neither Party (Supporting Reversal), *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (2008) (No. 2006-1562), at *5 n.7 [hereinafter *Apple Brief*] ("[T]he standard that verbal descriptions of designs be 'properly done [in order to] evoke the visual image of the design' has proven unattainable; words simply cannot evoke accurate visual images." (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 n.2 (Fed. Cir. 1996))).

¹⁹ *See* *Egyptian Goddess en banc brief*, *supra* note 18, at 30–31.

²⁰ *See* *Friedley-Voshardt Co. v. Reliance Metal Spinning Co.*, 238 F. 800, 801 (S.D.N.Y. 1916) ("[I]t is very difficult to put in words a description which so differentiates [the claimed design] from the prior art as to convey any vivid impression to one reading this opinion. This is largely due to the inherent difficulty of describing visual impressions in words, which is, of course, heightened where the person attempting it is without technical training in drawing or art.").

one's visual impression of Rembrandt's 'The Syndics of the Drapers' Guild.' . . . [A] picture is its own best description."²¹ The easily interpretable image might be out there somewhere, in art class, but not before the court.

Other courts suffered logorrhea in trying to write legalistically precise descriptions of designs, when pictures would be much clearer in practice.²² Compare the picture below with the description immediately following, if you can force your way through it:

Ceiling Fan
U.S. Pat. No. D380,539



Fig. 1, Perspective View

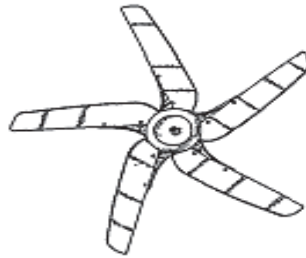


Fig. 7, Bottom View

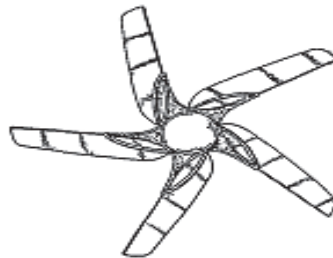


Fig. 8, Top View

²¹ ADC Telecomm., Inc. v. Panduit Corp., 200 F. Supp. 2d 1022, 1032–33 (D. Minn. 2002).

²² See, e.g., Bernardo Footwear, L.L.C. v. Fortune Dynamics, Inc., 2007 WL 4561476, at *2 (S.D. Tex. 2007) (detailed description of ornamental design for a thong sandal); Durdin v. Kuryakyn Holdings Inc., 440 F. Supp. 2d 921, 932 (W.D. Wis. 2006) (long description of ornamental design for a motorcycle brake or clutch lever).

The '539 design patent claim is directed to an ornamental design for a combined ceiling fan and light having fan blades that overlie corresponding arms of a central bracket. The central bracket has a circular central opening through which a light fixture dome protrudes downward. The bracket has curved, fin-shaped arms, each of which sweeps outward from its base at the central opening and each of which terminates in a slightly rounded tip. The arms of the bracket are equally spaced about the central opening, and the length of each bracket arm is roughly one-third the length of the corresponding blade. The light fixture dome exhibits a partial sphere that transitions into a generally cylindrical portion adjacent the central bracket. A central housing, located above the fan blades, exhibits a generally cylindrical portion just above the fan blades that transitions into a concave portion.

When viewed from below, the fin-shaped arms of the central bracket [sweep] outward from the central opening in a clockwise direction, which gives the appearance of a "running" pointed star. A symmetrical, elongated, generally football shaped cutout appears behind the leading edge of each arm. The fan blades are also swept in the clockwise direction, with the leading edges of the blades forming a sweeping curve near the bracket central opening. The trailing edges of the blades are straight but slightly offset from a diameter of the bracket central opening. The trailing edge of each blade smoothly transitions into the trailing edge of the corresponding bracket arm, which further forms a curved transition into the leading edge of the next bracket arm. A gently receding arc in front of each bracket arm's leading edge runs from the tip of each arm to the middle of the smooth transition. Each fan blade terminates in a gently rounded corner on the leading edge and a sharply angled, rounded corner on the trailing edge. From its tip, the trailing edge of each bracket arm flares inwardly and rearwardly away from the straight trailing edge of the corresponding blade until it intersects the leading edge of the following blade. Due to the sweep of the bracket arms, the leading edge of each fan blade is substantially more exposed than in the trailing edge of each fan blade.

When viewed from above, the fan blades are swept in the counter-clockwise direction, which also gives the appearance of a pointed “running” star. Also when viewed from above, the trailing edge of the bracket arm is visible at the base of each fan blade.²³

In this case, a picture is worth over 400 words. Which artifact, the image or the text, provides a clearer understanding of the protected matter?

It’s not that the problem of ambiguity is unknown to text, of course—ambiguities abound in contract cases, advertising law cases, and myriad other legal disputes based on text. Still, critics of written descriptions in design patent cases maintained that images were routinely harder to translate into words than other artifacts such as the products or processes claimed by utility patents.²⁴

In addition, those who advocated avoiding written descriptions invoked the concept of “verbal overshadowing.”²⁵ Though they did not use the term or cite the scientific literature on the ways in which using words can change perceptions of nonverbal stimuli,²⁶ they made the same argument as found in that literature: People who produce a verbal description of a visual object do not see that object in the same way as people who just look at it.²⁷ Opponents of written descriptions thus argued that fact finders’ decisions would be distorted by words, giving too much or too little emphasis to features of a design depending on the words chosen.²⁸ The result, Apple Computer claimed

²³ Minka Lighting, Inc. v. Craftmade Int’l, Inc., 2002 WL 1331883, at *3 (N.D. Tex. 2002).

²⁴ See Corrected Brief of Amicus Curiae The Houston Intellectual Property Law Association in Support of Neither Party, at 19, Egyptian Goddess, Inc. v. Swisa, Inc., No. 2006-1562, 2008 WL 699184, at *20 [hereinafter Houston Brief] (arguing that Markman’s claim construction holding was based on precedent dealing solely with judicial construction of written instruments, not “visually defined” patent grants).

²⁵ See Tushnet, *supra* note 2, at 735.

²⁶ *Id.* at 691.

²⁷ *Id.* at 735–38.

²⁸ See, e.g., Saidman & Singh, *supra* note 13, at 793 (arguing that verbalization leads factfinders to compare the accused design with the verbalization, not with the patented design, thus further leading them to require a finding of all the elements verbalized in the description before infringement can be found, which obscures the reaction of the ordinary observer to the design as a whole); Egyptian Goddess en banc brief, *supra* note 18, at 31 (“[W]hen a drawing is described in words, the words have a tendency to make all portions of the drawing perceptively equivalent unless the words expressly increase or decrease the visually perceptive importance of a particular feature, i.e., by using adjectives and adverbs and by using descriptive terms such as major, minor, prominent, dominant, etc. . . . However, when descriptive words are used to increase or decrease the visually perceptive importance of a particular design feature, the drawing then is not being merely observed by the jury, but rather is being observed by the jury as *the design has been interpreted and expressed in words by the court*. The problem with this is that a jury (after being properly

in its amicus brief in *Egyptian Goddess*, was that defendants won summary judgments eight times more often than plaintiffs did, because of written descriptions that distorted the scope of design patents.²⁹

Of course, this is only a defect if you own design patents. For those who feared being sued more than they wanted to sue, written descriptions were correspondingly more popular.³⁰ However, it's not particularly attractive to set

instructed on the ordinary observer test) may or may not place the same perceptive emphasis on a design element as the court." (emphasis in original)); Brief of Amicus Curiae American Intellectual Property Law Assoc. in Support of Neither Party at 25, *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 2006-1562, 2008 WL 644360, at 34 (Fed. Cir. 5, 2008) [hereinafter AIPLA Brief] ("A juror's perception of the overall appearance of the claimed design may very well differ from the court's expressed verbalization (and for that matter the court's perception). It is also possible that a juror's perception may change after reading the court's construction. Even if the court only provides the written instruction as a guide, the same problems of undue influence or changed perception may arise. Such a predicament is bound to yield inconsistent and compromised results."); Apple Brief, *supra* note 18, at 9–10 ("Since words are a poor substitute for how a design actually appears to the eye, a verbalized design patent claim can only divert the task of the jury from its age-old mandate. . . . [T]he jury is likely to check whether each of the words in the verbalization are found in the accused design, akin to a literal infringement test, rather than whether the designs are visually substantially the same. Thus, verbalization derogates how the claimed design actually appears to the eye." (citation omitted)); Brief of Amici Curiae Electrolux Home Products, Inc. and Nike, Inc. in Support of Neither Party (Supporting Reversal) at 20, *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 2006-1562, 2008 WL 644361 (Fed. Cir. Feb. 5, 2008) ("[I]t is difficult, if not impossible, to describe with clarity the 'meaning' of the patented design as a whole. Indeed, verbalization of the design elements often can lead to certain elements being emphasized to the exclusion of others, all because of the word choice made by the court during the claim construction process. The jury may be confused and erroneously believe that emphasis should be given to certain design elements, while at the same time being instructed to focus on the overall appearance of the design as shown in the drawings."); Brief for Amicus Curiae Industrial Designers Society of America in Support of the Reversal Sought by Plaintiff-Appellant at 1, *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 2006-1562, 2008 WL 644362 (Fed. Cir. Feb. 1, 2008) [hereinafter Industrial Designers Brief] ("It serves no purpose to construe the design patent drawings in words, and then to compare those words to the accused design. The words will necessarily either broaden or restrict the scope of the design patent claim, in an unpredictable manner."); Houston Brief, *supra* note 24, at 20–21 ("[V]erbalization of design patent claims . . . invites improper violation of a design patent litigant's jury trial right. . . . It is not appropriate for the fact finder to compare a court's detailed description of the patented design with the accused design. Overly detailed description of a design patent's drawings, however, invites the fact finder to not observe, i.e., to not conduct the fundamental exercise required to determine whether infringement exists." (citations omitted)).

²⁹ See Apple Brief, *supra* note 18, at 10 & n.12.

³⁰ See, e.g., Brief of Amici Curiae Lkg Corp. et al., *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 2006-1562, 2008 WL 1376324 (Fed. Cir. Mar. 18, 2008). Reliance on images favors the patentee at the infringement stage: It's easier to identify differences between designs using words. But this same characteristic has a different valence when novelty is assessed. When seeking a patent, the applicant is likely to want to identify specific details that differentiate a design from the prior art.

a standard with the aim of causing one side to lose more often, unless we actually have a good reason to want that result. The difficulty of describing a design may have nothing to do with how novel it is or how likely another design is to be confusingly similar to it.³¹

The written description does at least attempt to create a reviewable record and to ask questions that can sometimes be answered on summary judgment.³² As with copyright infringement, the ordinary observer test makes design patent infringement findings harder to review and analyze; as gestalts, they are difficult to dissect.³³ As a result, favoring visual comparison over written descriptions will be likely to favor design patent owners over accused infringers.³⁴ With visual comparisons, it's easier to say "these just look alike to me" (and harder to grant summary judgment or a motion to dismiss based on a lack of similarity) whereas written descriptions require more precise identification of the design's novelty compared to earlier designs. This subjectivity predictably increases a defendant's costs of even a successful defense, making it more likely that legitimate competition will be suppressed by legal threats. (The force of this conclusion will depend on one's assessment of the relative prevalence of infringers and legitimate competitors in the market; with enough of the former around, we might be willing to sacrifice a few of the latter, and vice versa.)

This argument about uncertainty as encouragement to less meritorious plaintiffs did not convince the Federal Circuit in *Egyptian Goddess*. One reason may be that images often seem transparent to us: They seem so clearly to mean one thing that we doubt that other people will see them differently—even though people do see the same image in very different ways, and even though we understand that different people will produce very different verbal descriptions of the same image.³⁵ This supposed transparency allowed proponents of an image-based standard to contend that focusing on images would make outcomes *easier* to predict: Anyone could look and see whether two

Later, with the patent in hand, pictures and generalities will be more appealing.

³¹ Cf. Rebecca Tushnet, *Looking at the Lanham Act: Images in Trademarking and Advertising Law*, 48 HOUS. L. REV. 861, 890 (2011) (discussing this problem with respect to trade dress).

³² See *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) ("From this translation, the parties and appellate courts can discern the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design.").

³³ See Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement* 28 (Stanford Public Law Working Paper No. 1661434), available at <http://ssrn.com/abstract=1661434> (copyright infringement).

³⁴ See Perry J. Saidman, *Egyptian Goddess Exposed! But Not in the Buff(er)*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 859, 884–85 (2008).

³⁵ Tushnet, *supra* note 2, at 688–93.

designs were too similar.³⁶ The history of the ordinary observer test in copyright cases involving images is, to put it mildly, not promising on this point.³⁷ Unfortunately, it may be very difficult for any given observer to understand how, in the absence of bad faith, another person could see something else in that image; obviousness cuts off analysis.

Moreover, images are themselves highly manipulable. In a design patent, by controlling how the design looks in the patent—which representational conventions to observe—the patentee can influence judgments about whether similar designs are sufficiently similar to infringe:

[F]or a given selected design, a number of different sets of drawings can be prepared. For example, phantom lines can be applied to “prior art” aspects of a design, so that a patent holder can focus attention, for that particular embodiment, on the new feature or “point of novelty.” If there are a number of such features, by showing those features as solid lines and other portions in phantom, again the patent holder can direct attention where desired, with respect to the evaluation of infringement.”³⁸

Nonetheless, the en banc Federal Circuit largely endorsed the idea that the images should be allowed to speak for themselves. There remained the problem of functional and non-novel features, as well as of special characteristics of design patent drawings, such as the broken lines used to identify features that are not claimed as part of the design, and that a jury would not know how to interpret without instruction. In those cases, even opponents of written descriptions conceded that words ought to be used to clarify matters for the fact finder,³⁹ and the en banc *Egyptian Goddess* court agreed.⁴⁰

³⁶ Saidman & Singh, *supra* note 13, at 807–08.

³⁷ Tushnet, *supra* note 2, at 734.

³⁸ Randy A. Hillson & Julie R. Daulton, *Egyptian Goddess v. Swisa: A Tale of Two Tests*, in THE IP BOOK, at 9; *see also* Saidman & Singh, *supra* note 13, at 799 (claiming visual determinations make infringement easier to find because similarities are more apparent than when using verbal descriptions).

³⁹ *See, e.g.*, *Egyptian Goddess* en banc brief, *supra* note 18, at 52; Industrial Designers Brief, *supra* note 28, at 1–2 (functionality); *cf.* *Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, 2004 U.S. App. LEXIS 770, at *5 (more extensive verbalizations “may be helpful particularly if the drawings contain features that are not part of the patented design, e.g., if the drawings contain functional features or if there is a point of novelty issue to consider”).

⁴⁰ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc).

Later, the Federal Circuit approved a process of dissecting a design to screen out identified functional features before performing a holistic assessment.⁴¹ Unfortunately, these two steps are fundamentally contradictory, since analytic dissection interferes with gestalt evaluation.⁴² One sign of this incompatibility comes from cases that recite *Egyptian Goddess's* disavowal of written description as a means of defining and limiting the scope of a design patent, then use hundreds of words to describe why prior art is so similar to the accused design that there can be no infringement.⁴³ Pictures, it seems, routinely fail to speak for themselves.

This is not to say that concerns driving a two-step test are misguided: Those who argue that a proper infringement analysis shouldn't involve any dissection, because ordinary observers don't decompose designs into their constituent elements or filter out functional or unprotectable parts,⁴⁴ face difficulty when dealing with accused designs that are also highly similar to the prior art.⁴⁵ Even if a design patent's scope is essentially limited to the drawing, applying the infringement standard that ordinary observers would be deceived into thinking the plaintiff's and defendant's designs are the same will often require some reference to prior art, since non-expert observers would otherwise be tempted

⁴¹ See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294, 1295 (Fed. Cir. 2010).

⁴² See Shin Chang, *The Proper Role of Functionality in Design Patent Infringement Analysis: A Criticism of the Federal Circuit Decision In Richardson v. Stanley Works, Inc.*, 19 TEX. INTELL. PROP. L.J. 309, 325 (2011) ("Filtering or ignoring any element, let alone individual functional elements, from a construed claim before applying the ordinary observer test inevitably changes the overall appearance of the patented design."); Jason J. Du Mont & Mark D. Janis, *Designing the American Patent System* 41–42 & n.259, <http://ssrn.com/abstract=1862182> (pointing out the incompatibilities in this approach); see also Tushnet, *supra* note 2, at 736–38 (making the same point about the similar two-step process in copyright infringement doctrine).

⁴³ See *Arc'teryx Equipment, Inc. v. Westcomb Outerwear, Inc.*, 89 U.S.P.Q.2d 1894, 1895 (D. Utah 2008) ("[I]t is unnecessary to construe the . . . Patent by providing a detailed verbal description of the claimed design. Rather, the Court will rely upon the illustrations . . ., as they better represent the claimed design."); *id.* at 1896 (using 389 words to explain how the ordinary observer would see the patented and accused jackets, then providing further verbal descriptions of the prior art in the course of finding noninfringement).

⁴⁴ See, e.g., Christopher V. Carani, *The New "Extra-Ordinary" Observer Test For Design Patent Infringement—On a Crash Course With The Supreme Court's Precedent in Gorham v. White*, 8 J. MARSHALL REV. INTELL. PROP. L. 354, 357, 370 (2009); Sylvia Ngo, *Egyptian Goddess v. Swisa: Patently Obvious? Reconciling the Ordinary Observer and Point of Novelty Tests*, 10 HOUS. BUS. & TAX L.J. 110, 125 (2010).

⁴⁵ See Carani, *supra* note 44, at 378–79 (admitting that fact finders will have to be educated about prior art).

to lump too many things together.⁴⁶ “They all look alike to me” is a cliché for a reason.

We do not want a standard that lets a fact finder conclude that a copy of the prior art infringes a patented design. We have two possible ways of avoiding this result: We could have a validity/nonobviousness standard that invalidates design patents entirely in such cases, or we could have a rule requiring that the confusing similarity necessary for infringement must relate to the protectable elements of the patented design. The former standard would invalidate large numbers of design patents (and pose serious litigation challenges of its own); the latter seems like more of a compromise, allowing more design patents but limiting their scope and forcing us to administer their boundaries with greater care. But the resulting test will continue to seem unsatisfactory because it is trying to serve two masters: holistic assessment of confusing similarity and filtration of unprotectable elements.

Assuming we want to prevent findings of infringement when two designs are only similar in non-novel aspects, how can this best be done?⁴⁷ Instead of using only words, we could give the fact finder pictures of the prior art. If an accused design was more similar to the closest prior art than to the patented design, then there should be no infringement, as in the following case:

⁴⁶ See, e.g., *Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (infringement exists if an ordinary observer familiar with the prior art would be deceived into believing that the accused design is the same as the patented design).

⁴⁷ See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1296 (Fed. Cir. 2010) (holding that deceptive similarity must be the result of similarities in overall design, not of similarities in functional features); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (“For a design patent to be infringed, however, 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.” (citations omitted)).

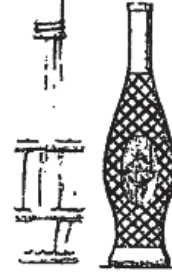
**PATENTED
DESIGN**



**ACCUSED
DESIGN**



PRIOR ART



48

The American Intellectual Property Law Association offered the following hypotheticals



Claimed Design



Accused Design

49

In a vacuum, the two designs look highly similar and the accused design seems likely to be infringing. Now suppose that, in fact, the prior art contains a design that looks almost exactly like the accused design—it's the heart in the top right corner of the patented design that is the novel feature. Once the prior

⁴⁸ *Coca-Cola Co. v. Whistle Co. of America*, 20 F.2d 955, 957 (D. Del. 1927) (“Save for such similarity as results from the common use of the ogee curve [found in the prior art] . . . , the most casual observer would find no difficulty in distinguishing [the patented] bottle from the [accused bottle].”).

⁴⁹ AIPLA Brief, *supra* note 28, at 2.

art is taken into account, a finding of noninfringement should follow.⁵⁰ But AIPLA made its case particularly easy by positing prior art just like the accused design. Suppose the prior art has a circle where the patented design has a heart: if the novelty consisted of changing the circle to a heart, does changing the circle to a star copy the novel aspect of the patented design? Pictures alone can't answer what are fundamentally normative and empirical questions about consumers' perceptions of confusing similarity.⁵¹ Fact finders will still have to make judgments about how far the penumbra of any particular design or piece of prior art extends.

Still, for an outsider to design patent law, the suggested multi-image comparison approach has obvious merits for limiting the scope of design patents to novel aesthetic innovations, at least where there is substantial prior art (as there will often be). For someone more familiar with copyright law, one natural question is whether a similar approach could help in copyright law, where substantial similarity as a test for copyright infringement is a mess.⁵²

I think we'd be better off without the doctrine of substantial similarity, and with a true reproduction right, with highly similar works dealt with as derivative works.⁵³ However, since that's unlikely to happen, it's worth thinking about whether substantial similarity doctrine could be improved by, in essence, placing the plaintiff's work alongside an array of prior art and trying to place the accused work in the "space" defined by the expressive universe.⁵⁴ When asking whether the similarity between two works is too great, we might then frame the question whether the similarity between the plaintiff's work and the accused work is any greater than the similarity between the accused work and other

⁵⁰ See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676 (Fed. Cir. 2008) (en banc) ("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 close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.").

⁵¹ In the context of invalidity for obviousness, the Federal Circuit has attempted to deal with the question of how far the "penumbra" of any given design extends by requiring a single primary reference "basically the same as the claimed design" before an obviousness challenge can be made. Then, the primary reference can be modified by other secondary references related to the primary reference. See *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1386 (Fed. Cir. 2009). The court specifically declined to opine on whether a similar approach should be used for infringement. In the example in the text, if the primary reference had a circle and the patented design had a heart, the *Titan Tire* approach would not seem to help determine whether a star was "too close" to the heart.

⁵² Lemley, *supra* note 33; Tushnet, *supra* note 2.

⁵³ See Tushnet, *supra* note 2, at 45–46.

⁵⁴ Cf. Ngo, *supra* note 44, at 128 (stating that copyright lacks the concept of prior art).

noninfringing expressions of the same idea, where other expressions have been identified.

The idea/expression distinction means that only expression can be owned, and ideas may be freely copied. Usually copyright cases formally use the distinction to compare two isolated works. Yet the concept of an unprotectable idea necessarily implies the existence of many other works, both actual and potential. Tropes, scènes à faire (events or characters standard in works of a particular type), and other generic features are unprotectable, but identifying them generally requires some concept of a “standard” work of the relevant type. Thus, in practice, defendants will often point to other works on the same topics and sharing the same similarities that plaintiffs claim show infringement of their particular works.⁵⁵

The barriers to using prior art as a useful addition to copyright’s arsenal are primarily two: First, unlike patent infringement, copyright infringement requires actual copying. Thus, even if two works are more similar to each other than to any pre-existing work, there will be no infringement unless the defendant actually copied the plaintiff’s work; inversely, if the defendant copied the plaintiff’s work, it is no defense to say that another work is, coincidentally, even more similar to the defendant’s work. Given the copying requirement, it can be conceptually muddled to bring in the idea of prior art, of which neither the defendant nor the plaintiff may actually have been aware, as a restriction on the scope of a copyright.⁵⁶ Thus, in copyright, the purpose of familiarizing a factfinder with the prior art as part of an infringement inquiry would have to be different than for design patents: Prior art might provide evidence that any similarities between the works are due not to the defendant’s copying but to the common cultural well from which both works drew.

⁵⁵ See, e.g., *Johnson v. Gordon*, 409 F.3d 12, 24 (1st Cir. 2005) (finding no copyright protection for the title/lyrics “You’re the One for Me” where “hundreds of composers have registered songs capturing the same sentiment in the same verbiage?”); *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 144 (2d Cir. 1998) (upholding district court’s finding that the phrase “you’ve got to stand for something, or you’ll fall for anything” was not protectable because it “enjoyed a robust existence in the public domain long before [plaintiff] employed it for his song’s title and in the key lyrics”); *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 720–21 (9th Cir. 1976) (common musical phrases); *Capcom Co. v. Mkr. Grp., Inc.*, 2008 WL 4661479 (N.D. Cal. Oct. 20, 2008) (zombie stories); *Columbia Pictures Industries, Inc. v. Embassy Pictures*, 1982 WL 1274, at *4 (C.D. Cal. May 27, 1982) (“[T]he pose of loving couples, even against a tropical background, is too common to constitute protectible expression.”).

⁵⁶ As for the plaintiff, as long as the plaintiff contributed expression of her own rather than copying, the fact that she produced a run-of-the-mill work is irrelevant to its protectability; there is no novelty requirement as in patent.

Second, design patent does not have an idea/expression distinction. The idea/expression distinction puts some parts of a copyrighted work immediately in the public domain even if they are entirely new: new ideas or new facts and discoveries.⁵⁷ Even if there is no relevant prior art, then, a copyright's scope is still more limited than that of a patent, which can protect new designs or discoveries. For example, the first person to write a story about a zoo filled with dinosaurs recreated from their DNA does not have a copyright monopoly on the overall concept, even if she was truly the first. Indeed, when two works use the same core idea, similarities in other plot elements that naturally follow—in order to create drama, the animals must escape, and so on—are also freely copiable.⁵⁸

For these reasons, I do not advocate for wholesale incorporation of design patent infringement analysis in copyright infringement analysis. However, the conceptual insight that is front and center in many design patent infringement inquiries could still be useful: Works exist within a field of other works. As a result, fact finders can get relevant information by assessing other works in the same field. This idea, though implicit in many copyright cases, could be made more explicit.⁵⁹ Looking at prior art in copyright could help define what constitutes protectable expression and what is merely an idea or concept that should not be subject to any single creator's control. Distance from existing works should not be the sole test for substantial similarity in copyright, for the reasons noted above, but it could help make the elusive distinction between idea and expression more concrete in specific cases, such as the multiple infringement claims against the hit film *Avatar*, each arguing that *Avatar* copied the plaintiff's story of a military type who rebels against his superiors in order to save an endangered civilization.⁶⁰

⁵⁷ Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 LAW & CONTEMP. PROBS., Winter/Spring 2003, at 147.

⁵⁸ See *Williams v. Crichton*, 84 F.3d 581, 589–90 (2d Cir. 1996).

⁵⁹ For a contrasting approach, see Shyamkrishna Balganesh, *The Normativity of Copying in Copyright Law*, 62 DUKE L.J. (forthcoming 2012), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2014395. Balganesh suggests that courts should determine the conceptual “thickness” of a plaintiff's copyright without reference to the defendant's work because what's protectable “can be gleaned entirely from the plaintiff's work, perhaps with the aid of external evidence such as expert testimony.” *Id.* at 24. Balganesh assumes that conventions can routinely be inferred from single exemplars, and skims over the insufficiencies of that approach by referring vaguely to “expert testimony,” which will presumably explain which parts of the plaintiff's work are common. But that's a vital part of the process, not an add-on: Someone who'd never encountered a Western could have great difficulty distinguishing generic features from unique scenarios, much like someone who'd never encountered the designs discussed in text.

⁶⁰ Eriq Gardner, *Know Your 'Avatar' Lawsuits: Meet Three Plaintiffs Who Hope to Win Billions*,

In fact, the contrast between copyright and design patent helps illuminate the problems with Samson Vermont's idea that uniqueness is the key to copyright.⁶¹ Because copyright protects expression, not ideas, having a really novel idea (while it might justify a broad utility or design patent) does not justify a broad copyright. As Judge Kozinski has written, "I can't publish unauthorized copies of, say, *Presumed Innocent*; I can't make a movie out of it. But I'm perfectly free to write a book about an idealistic young prosecutor on trial for a crime he didn't commit."⁶² In such cases, we would recognize the immediate source of the second author's idea while also recognizing that his work was a very different expression of that idea. While Vermont argues that the high concept "prairie dog meets seahorse on Pluto" is so unique that it should be protected against copying,⁶³ the cases correctly hold that copying a premise is simply insufficient to infringe.⁶⁴ Dinosaur zoos; zombies in a mall; snakes on a plane: All are entertaining ideas, but not as such protected copyrighted works even at the point at which only the plaintiff's and the defendant's work embody those ideas. As a result, one key implication of the idea/expression distinction is that, while design patent cases consider only existing prior art,⁶⁵ in copyright we must also consider other possible noninfringing expressions of the same idea, to help define the metes and bounds of a particular expression.

Prior art, even in pictures instead of words, is no more a panacea in design patent than it is in copyright. In the end, a picture may be worth a thousand words, but it cannot substitute for a final judgment about how close is too

HOLLYWOOD REPORTER, Dec. 20, 2011, <http://www.hollywoodreporter.com/thr-esq/avatar-lawsuits-james-cameron-new-plaintiffs-275707>.

⁶¹ Samson Vermont, *The Sire Qua Non of Copyright is Uniqueness, Not Originality*, available at <http://ssrn.com/abstract-1906047>. Vermont argues that patents are different from copyrights because inventions, unlike expressive works, are "constrained by shared reality." *Id.* at 34. His analysis therefore ignores design patents, not to mention the social constraints that makes "utility" much more about human choices than about the laws of physics, chemistry, and biology. See Mark P. McKenna, *(Dys)Functionality*, 48 HOUSTON L. REV. 823, 853–54 (2011) (explaining that utilitarian functionality is often a matter of socially constructed desires and expectations).

⁶² *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512, 1514–15 (9th Cir. 1993) (Kozinski, J., dissenting from denial of reh'g en banc).

⁶³ Vermont, *supra* note 61, at 59–60.

⁶⁴ See, e.g., *Benay v. Warner Bros. Ent'mt Inc.*, 607 F.3d 620 (9th Cir. 2010) (American becomes samurai in Meiji Japan); *Funky Films, Inc. v. Time Warner Ent'mt Co.*, 462 F.3d 1072 (9th Cir. 2006) (small funeral home taken over by two brothers after their father's death).

⁶⁵ Design patent obviousness determinations can involve hypothetical prior art created by combining references. See *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009). Nonetheless, even these hypotheticals must be created by combining existing designs.

close. Design patent cases suggest the difficulties embedded even in the most apparently limited images. While design patents are in theory limited almost precisely to the image shown in the patent, and therefore patentees may even submit photos instead of more manipulable drawings,⁶⁶ difficult questions of scope continue to arise as patentees assert the right to prevent more than pure copying. Indeed, in the recent Apple/Samsung litigation, the jury held Samsung liable for over a billion dollars in damages, in significant part because of Apple's design patents on portions of its products, rather than on their overall appearance.⁶⁷ If substantial similarity is sufficient for infringement, we need to know what's enough to be substantial, and what constraints there will be on the factfinder, especially when some kinds of copying (such as copying elements already in the public domain) are supposed to be favored by public policy. Punting to the overall impression of the image is not enough, even though it's always a temptation.

⁶⁶ See William J. Rankin, *The "Person Skilled in the Art" Is Really Quite Conventional: U.S. Patent Drawings and the Persona of the Inventor, 1870-2005*, in MAKING AND UNMAKING INTELLECTUAL PROPERTY: CREATIVE PRODUCTION IN LEGAL AND CULTURAL PERSPECTIVE 55, 60 (Mario Biagioli, Peter Jaszi, and Martha Woodmansee eds. 2011) ("[For design patents], standards for both disclosure and protection are more narrowly circumscribed and the primary worth of the patent is to establish successful reduction to practice, as in a simple registration system (similar to copyright). Not coincidentally, plants and designs are often accompanied by photographs, and photographs tend to provide only mimetic evidence; neither explanatory nor ambiguous, they are useful primarily for proving infringement." (footnotes omitted)).

⁶⁷ See Sarah Burstein, Guest Post: Design Patents and Apple v. Samsung, MADISONIAN.NET, Aug. 27, 2012, <http://madisonian.net/2012/08/27/guest-post-design-patents-and-apple-v-samsung-2/> (discussing the relevance of the patent drawings and Apple's design patents on portions of the overall products); Michael Risch, Brief Initial Thoughts on Apple v. Samsung, MADISONIAN.NET, Aug. 25, 2012, <http://madisonian.net/2012/08/25/brief-initial-thoughts-on-apple-v-samsung/> (noting the breadth of the design patent infringement claims in the case).