

DESIGN PATENT PERSPECTIVE: The Ordinary Observer Test PART 1



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After 169 years, a clear and comprehensive test for design patent infringement remains stubbornly elusive. Why is that? The inherent subjectivity of comparing two designs is no doubt a primary culprit, but other areas of intellectual property law such as trademarks are subjective and have developed workable comparative tests. So what is it about design patent law that is troublesome, and can the problem be solved? Let's first take a historical look at

the development of the infringement test at the Supreme Court level.

The original design patent statute was passed in 1842. The statute required that a design be "new and original" or "new and useful" and did not describe the standard for infringement.¹ For the first twenty years very few cases were brought, none made it to the Supreme Court, and the statute was described as "almost wholly a dead letter."²

Due to lack of enforcement, "infringements of design patents [became] almost universal," and "[n]o sooner did a pattern, devised and introduced at great expense, become popular in the market, than it was copied by other manufacturers...."³ It was against this dismaying backdrop that the leading American silversmith of the day, the Gorham Manufacturing Company, "resolved to see whether the law which had promised them protection was adequate to furnish them relief against this great and serious mischief."⁴

Gorham made its stand against George C. White, and sued for infringement of Gorham's well-known Cottage Pattern for fork and spoon handles. The lower court found no infringement based on a three-part rationale. First, a design patent protected the means, i.e., the constituent design elements, of producing a certain appearance and not the overall appearance itself. Second, the comparison was made not through the eyes of an ordinary observer, but rather by one versed in the trade when examining the articles intelligently side by side. Third, although the Gorham design and the White design of 1867 were very much alike in outline, they differed markedly in ornamentation.⁵

Gorham appealed. The Supreme Court reversed and disagreed on all three points. The Court first declared that a design patent protected the *overall design appearance* and not merely the elements that created it. Drawing heavily upon English cases, the Court stated "it is the appearance itself ... no matter by what agency caused ... which the law deems worthy of recompense."⁶ And although differences in lines and configuration are to be considered, "the

controlling consideration is the resultant effect."⁷

Second, the Court held infringement was determined by an *ordinary observer* and not by an expert, holding "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."⁸ Third, the Court held that the patented and accused designs were alike in outline and ornamentation, and that "of these, the outline or configuration is most impressive to the eye."⁹

Unfortunately, missing from the Court's opinion was an important matter, the omission of which would plant the first of two seeds of trouble that would sprout many years later. The Court never expressly discussed the effect of prior art designs on the comparative analysis. Subtle hints did exist, as the Court stated the outline and ornamentation of the patented and accused designs were "alike" and made up "whatever is distinctive in appearance"¹⁰ (with the term "distinctive" necessarily being a comparative term in light of the prior art).

Another subtle hint to the prior art was in the prior history to the opinion, which stated "the 'cottage pattern' became extremely popular; the most successful plain pattern, indeed, that had been in the market for many years." This statement doesn't tell us much, but it gains meaning in the historical context "[t]his trial [*Gorham v. White*] took place during a period when silverware was in the midst of the great Victorian flowering of exotic designs embellished with clusters of grapes, scrolls and greek columns By contrast, Gorham's Cottage pattern was unexpectedly plain."¹¹ When the ornamental patterns of Gorham's and White's designs are compared, they do differ "markedly" as noted by the lower court. But it may be that in addition to the similarity in outline, the similar "plainness" of the patented and accused designs helped convince the Supreme Court that the difference in ornamentation was not significant enough to avoid infringement. We will never know for sure because the Court did not discuss the prior art.

The second seed of future trouble for the infringement test was planted by the peculiar fact pattern of the Supreme Court's second major design patent case, *Smith*

*v. Whitman Saddle Co.*¹² In this case, the Supreme Court held a design patent for a saddle invalid because it merely combined the front and back half of two well known prior art saddles “in the way and manner ordinarily done.”¹³ The Court reinforced its holding of non-infringement by observing that only a single design element in the patent was novel (the sharp drop of the pommel at the rear), and that even if the sharp pommel drop made the design patentable, there was no infringement because the accused design did not share this point of novelty.

The peculiar fact pattern of *Smith v. Whitman Saddle* turned out to be unfortunate. Since the patented design had only a single point of novelty over the prior art, and this single point of novelty was missing from the accused design, the determination of infringement appeared seductively simple: If the patented and accused designs passed the ordinary observer test, then infringement could be determined by identifying the point of novelty in the patented design and determining whether it also existed in the accused design. If not, there

was no infringement. But this attractive analysis was a trap because it worked consistently and predictably only if there was a single point of novelty over the prior art. When the patented design had multiple points of novelty over multiple pieces of prior art, as is usually the case, the comparative analysis broke down and proved unworkable - as the Federal Circuit would come to realize many years later.

Fortunately, early circuit court cases did not take the bait and establish a separate “point of novelty” test. Rather, following *Whitman Saddle*, the circuit courts took up the task of fleshing out the ordinary observer test. Early cases established that the test was to be conducted in light of the prior art and also provided a practical method that often could be used to determine whether infringement existed. In next month’s column, we will explore these early circuit court cases in more detail, discuss the reasons behind the rise and fall of the “point of novelty” test at the Federal Circuit level, and conclude with the present state and probable future of the ordinary observer test.

ENDNOTES

1. The Patent Act of August 29, 1842, 5 Stat at Large, 543.
2. *An Important Decision Relating to the Future of the Fine Arts*, Extract from the New York Times, Nov. 30, 1872.
3. *Id.*
4. *Id.*
5. *Gorham Mfg. Co. v. White*, 10 F. Cas. 827 (C.C.S.D.N.Y. 1870). The accused designs were manufactured and sold by George C. White and patented by Leroy S. White.
6. *Gorham Co. v. White*, 81 U.S. 511, 525 (1872).
7. *Id.* at 526.
8. *Id.* at 528.
9. *Id.* at 529.
10. *Id.* at 528, 529.
11. Cooper C. Woodring, *How a Spoon Revolutionized Design Protection in America, One Man’s Crusade*, Innovation, Summer 2010, pages 57, 58 (quote based on comments made by silver expert Charles Spencer Curb).
12. 148 U.S. 674 (1893).
13. *Id.* at 681.