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THE FINAL IMPRESSION COUNTS - SEEKING COMMON GROUND IN DESIGN PATENT INFRINGEMENT

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Visual images act as powerful product differentiators. The visual appearance of products has become an asset of considerable economic value and litigation surrounding it is increasingly common.

1. COMPARING THE SIMILARITY OF VISUAL ELEMENTS

Design patent infringement litigation raises the complex issue of assessing the degree of similarity in the appearance of two products. Some fundamental questions relating to the analysis remain unresolved.

Design patents involve visual images. When assessing similarity in an infringement proceeding, visually perceived images are necessarily “translated” into verbal expression. “When properly done, this verbal description should evoke the visual image of the design.”¹ But finding the appropriate description to merely evoke the visual image without placing undue weight on individual features presents great difficulty. A design’s individual elements are not equally significant. Details that the ordinary observer might pay attention to may be overlooked by the trier of fact, or alternatively, features which in the overall analysis would hardly be noticed by the purchaser, risk being overly emphasized.²

The relative weight of individual elements is closely related to the proper lens to be applied to the analysis. Should the observer “zoom in” identifying each element of the design and then compare the similarities and differences of each element individually, or should the observer “zoom out” to form a holistic view of the designs as a whole and then determine similarity. The choice of lens has strategic implications. Patent holders tend to advocate a “design as a whole” approach. Alleged infringers typically advocate

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¹ Concept Innovation v. CFM Corp., No. 04 C 3345, 2004 WL 2812109, p.3
² These concerns are not limited to design patents. Similarity comparisons of visual elements in copyright and trademark law are subject to the same problems. Rebecca Tushnet, Looking at the Lanham Act: Images in Trademark and Advertising Law, 48 HOUS. L. REV. 861, 886–87 (2011); see also Rebecca Tushnet, Worth a Thousand Words: The Images of Copyright Law, 125 HARV. L. REV. 683 (2012).
an elemental analysis, seeking to elevate minor details to the status of similarity-destroying differences.\(^3\)

A further complication relates to the scope of protection. It is a fundamental rule that in comparing a design, only the design’s protectable elements are to be considered and any non-protectable design features are to be disregarded. On the other hand, the law also mandates that competing designs be compared in their entirety. The latter rule inherently conflicts with the former. Under a “design as a whole” view, non-protectable non-novel and functional aspects would have to be included when determining similarity, thus unjustifiedly broadening the scope of protection beyond the scope to which the patentee is entitled. Conversely, if these aspects are to be excluded, the fact finder is faced with a truncated version that bears no resemblance to the protected design.

Finally, a certain amount of subjectivity is inevitable in comparing designs. Individuals form unique, subjective reactions to visual images. They process the information gathered by the eye in different ways compared to each other and, sometimes, to the objective physical appearance of the object.\(^4\) Therefore one individual’s impression of an object may differ from that of another individual. When performing a comparison, two articles may appear substantially similar to one observer, but not to another.\(^5\) The results of this type of comparison therefore tend to be imprecise.\(^6\)

Because these questions remain unresolved, the procedure to be followed in an infringement analysis lacks clear guiding principles. This renders the analysis unnecessarily vulnerable to subjective treatment by courts and fact finders, as well as to strategic positioning by litigants. Outcome predictability is low.\(^7\) At an international level, there is no agreement on how infringement should be analyzed. Even though a design is the same regardless of jurisdiction, outcomes of proceedings may vary from country to country.

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\(^3\) Concerns have been expressed that an analysis that considers the design as a whole tends to favor rightsholders over competitors. “Favoring visual comparison over written descriptions will be likely to favor design patent owners over accused infringers. Rebecca Tushnet, The Eye Alone is the Judge: Images and Design Patents, 19 J. Intell. Prop.L. 409, 417 (2012). This position is supported by the fact that holistic analysis paints with a broader brush and minor differences do not play a role. Conversely, it has been stated that an element-by-element analysis often ends up favoring the accused product, because of its greater focus on details and tends to be more pro-competitive. This should not be a true concern. Unlike a utility patent, the design’s contribution rewarded with a patent right, is the appearance to the eye. Similarity should also be judged by the eye, rather than by detailed technical analysis. It must be assumed that competitive concerns have been taken into consideration in formulating this policy. See Gorham v. White, 81 U.S. 511, 528 (1871).


\(^5\) See Procter & Gamble v Reckitt Benckiser (UK) 2007 EWCA Civ 936. Every field of IP law is struggling with this problem.

\(^6\) See Procter & Gamble v Reckitt Benckiser (UK) 2007 EWCA Civ 936.

\(^7\) See also note 3, *supra*. 
The following will discuss how these issues are addressed under the design laws of China, the US and the European Union. Specifically, we will explore these jurisdictions’ approaches to the analytical difficulties presented by non-protectable design features - prior art and functionality – and will seek to identify methods which appear effective in mitigating the problems listed above.

2. SIMILARITY ANALYSIS UNDER CHINA LAW

The Patent Law of the Republic of China,\(^8\) provides that the owner of a design patent may prevent third parties from making, offering for sale, selling or importing a product that incorporates, the patented design, for purposes of production or business, without the consent of the right holder. This absence, in early years, of more precise standards for determining whether a product is identical or similar to a patented design, has resulted in inconsistent and arbitrary court decisions and has prevented the development of clear standards for infringement determination. Early cases merely responded to the needs of a market economy in its infancy that relied heavily on copying and counterfeiting foreign intellectual property, by adopting a rather basic “element-to-element” comparison approach to infringement determination. The fact that the Chinese legal system does not recognize judicial precedents as binding, except for the Supreme People’s Court’s official interpretations of the law,\(^9\) further aggravated the lack of consistency in decisions. Only with the official interpretation issued by the Supreme People’s Court on December 28, 2009\(^10\) ("the 2009 Interpretation"), has the standard of overall visual similarity been introduced and codified. Clearer guidelines regarding these standards have been provided to the People’s Courts.

2.1 Early infringement determination standard

The jurisprudence of the early years following enactment of the 2001 amendment to the patent law tended to follow an element-by-element approach to design similarity.

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9 For purposes of clarification: China is not a “judicial-precedent” type of legal system. In order to reduce courts’ interpretative discretion and therefore judicial inconsistency, the Supreme People’s Court issues interpretations such as the ones discussed herein. These Interpretations are equivalent to law and are binding upon all civil judges. This is the typical judicial tool used in China to form court binding interpretative provisions of a general law.

10 Judicial Interpretation of the Supreme People’s Court on Several Issues Concerning the Application of Law in the Trial of Patent Dispute Cases Fa Si [2009] No. 21, which came into effect from January 1, 2010.
This traditional view, embodied in the 2001 Opinions of the Beijing Higher Court\(^\text{11}\), was then confirmed by the 2009 judgment of the Shijiazhuang Higher Court in the FIAT Panda case\(^\text{12}\). In that case, the Court held that in comparing designs, the existence of a single different design feature or the absence thereof is sufficient to deny similarity, even though the two designs may look similar based on an overall and comprehensive observation.

In this decision the Court considered that the front view of a vehicle is most significant and that a change to the front grille would eliminate the similarity of the two vehicles in that the grille was an essential element to the FIAT Panda design. The court however neglected other relevant features on the design patent’s side and rear views and the originality of the side view of the FIAT Panda and its side roofline compared to the prior art. The fact that the court was not obliged by any provision to confirm its determination of which features were essential or non-essential, by referring to the overall visual effect of the designs under comparison, left the judges with unlimited discretion as to the determination of the scope of protection of the design patent. This comparison standard resulted in a finding of non-infringement as a result of defendant merely adding or slightly reshaping features in order to differentiate their design from patented design, despite the fact that the overall visual impression of the two designs was one of similarity.

### 2.2 Introduction of the “overall visual effect” standard

In 2009, the Supreme Court issued a new interpretation.\(^\text{13}\) Its articles 10 and 11, list more specific governing criteria to be used by all People’s Courts in determining design patent infringement.

The Interpretation makes clear that infringement must be assessed using the level of knowledge and understanding of the average consumer of the claimed design. When making this determination, a court must take into account the overall visual impression formed by the design features, which are within the design patent’s scope of protection. Identity/similarity between the claimed and the accused designs is assessed based on the designs’ overall visual effect. Greater weight is given to elements, which are more readily visible to the observer when the product is in use, and to those which differ from the previously known range of shapes typical for the respective element. Technical features necessary for the functionality of the product or for the product’s material and internal construction are given no consideration.

Once this analysis is completed, the court must compare the overall visual effect of the claimed design with that of the accused product. This phase evaluates the impact of

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\(^{11}\) Opinions on Several Issues Relating to Patent Infringement Establishment (Jing Gao Fa Fa [2001]No. 229).

\(^{12}\) FIAT AUTO S.P.A. v. Great Wall Motors (2008), Ji Min San Zhong Zi No. 84, judgment was made on December 29, 2008 by Hebei High Court.

\(^{13}\) Judicial Interpretation of the Supreme People’s Court on Several Issues Concerning the Application of Law in the Trial of Patent Dispute Cases Fa Si [2009] No. 21, which came into effect from January 1, 2010.
design differences on the overall visual effect of both designs under comparison, including design features which are present in the patented design, but are different or absent from the infringing design. If there are no differences between the overall visual effects of the patented and the accused designs, the court shall find the designs to be identical. Conversely, where no substantial differences between the two overall visual effects exist, the court shall find the designs to be similar, in other words, minor design differences will not affect the impression of overall visual similarity of the designs under comparison. In both instances infringement will be found.

In drafting its 2009 Interpretation the Supreme People’s Court’s had been influenced not only by the experience of other countries, but also by recent court judgments in China. In particular, a precursor of the December 2009 Interpretation’s Article 11, was the decision of the No. 1 Beijing Intermediate Court in the Neoplan v. Zonda case, involving the outer design of a bus. In its judgment of January 14, 2009, the court noted that:

“[...] both designs are characterized by wedge-shaped upper and lower windshields, [...] The above-mentioned design features basically constitute the overall exterior design of the bus. Although there are differences between the two, (...), these are partial and minor and do not obviously affect the overall view of the bus. The accused infringing product and the patented design are almost identical based on overall observation [...].”

The court then concluded that the presence of differences in the design does not necessarily take away the overall effect of similarity evoked by the comparison. As long as the overall visual effect remains similar, the existence of differences alone will not avoid infringement. Similarly, the essentiality of design features must also be determined based on the design’s overall visual effect.

The *Neoplan* decision and article 11 of the 2009 Interpretation enacted following it, have brought about a rather radical change of direction compared to prior case law. Article 11 officially broadened the scope of protection of design patents and the likelihood of successful enforcement against attempts to avoid liability by merely changing or adding design features to a product. It also provided a more objective confirmation test to limit the discretion of civil judges when determining a design’s essential and non-essential features. This norm abandoned the older “element-to-element” comparison standard in favor of the overall impression of similarity in the eyes of a normal user. In particular, judges are required to conduct comparisons based on a comprehensive examination of the products and determine the overall visual effect of the protected design by selecting its essential features. Such features are defined as design features that are novel and different from the typical range of shapes or patterns known for that type of product. In this way the norm stretched the prior boundaries to enlarge the scope of protection of design patents. At the same time, given the need to protect only the design’s aesthetic value, the Interpretation mandates that judges eliminate from consideration those features that are not novel, technically necessitated or too small to be relevant.

In practice, the approach prescribed by article 11 does not resolve the inherent tension between the risk of overstretching a design’s scope of protection by emphasizing the overall comprehensive design evaluation, and that of over-emphasizing the visual effect of single parts, which would lead judges to the old element-to-element examination standard. Some decisions following the Supreme Court’s 2009 Interpretation took the opportunity to correct the risks resulting from an incorrect application of the comprehensive examination and overall visual effects principles.

### 2.3 Further elaboration by the Supreme People’s Court after 2009

Soon after the 2009 Interpretation entered into force, the Supreme Court had the opportunity to refine the concepts embodied in its article 11. In 2010, in *Honda v. Patent Reexamination Board*[^1] in another case involving a vehicle, the Supreme Court further defined how the essential features and scope of protection of a design patent are to be determined. The *Honda* Court attempted to strike a balance between the holistic assessment based on the test of comprehensive observation of the designs with the need to set aside non-protectable elements, such as non-novel or technically necessitated features. The Supreme Court opined that in car designs which share or appear to share a common configuration as a whole (including non-novel and technically necessitated shapes), the overall configuration of the vehicle shape will have a limited visual effect and impact in the eye of an ordinary observer. Instead, distinctions in sectional design features, such as the design of headlights, lateral view, and rear view, are likely to have a notable visual effect on the design of the car as a whole.

whole. Relying on this reasoning, the Court ruled that the existence of differences in specific design features, such as headlamps and side door windows, would lead ordinary consumers to distinguish the patented design from prior designs.\(^{16}\)

This decision clearly confirms the tenet of article 11 of the 2009 Interpretation, requiring a judge to discount features which are not novel or technically needed from the overall visual effect. Unlike the *FIAT Panda* case, the *Honda* decision does not conclude that differences on single design features are sufficient to avoid similarity. It just asks the judge to zoom-in first on certain relevant features (novel features) and then to consider their visual effect comprehensively with respect to the rest of the vehicle. In sum, the Court seems to be seeking a balance between the need to emphasize the predominant essential features (zoom-in) and the need avoid a comparison based on a truncated design, an approach that would risk sliding back into an “element-to-element” comparison. Instead, after having identified the overall visual of the essential features, the Court will have to go back and confirm this effect in light of the overall and comprehensive view of the entire design. This decision appears restrictive, in that it reduces the judge’s freedom to select what features are essential or not. However, it does not seem to restrict the legal value of the comprehensive examination of the whole vehicle including non-novel parts (standard shapes for each type of vehicle). In practical terms, even if the shape of sub-components such as headlights are modified, this may still not be sufficient to remove the similarity of the remainder of the front’s visual effect and therefore create no different visual effect in a comprehensive examination of the whole design. This approach responds to the local Chinese automotive industry’s tendency to copy individual parts of a foreign design patent and combine them with more common existing designs.

Following the *Honda* decision, the Supreme People’s Court intervened again on the issue of how essential features are to be identified. In particular, the court confirmed the principle that the overall visual effect of a design patent is determined by its essential features, as stated also in *Honda* and previously in article 11 of the 2009 Interpretation. The Supreme Court ruled that addition of new decorative features to the accused design shall not automatically overcome the effect of visual similarity, as long as the infringing product design contains all the essential features of the patent. In the 2011 *Jun Hao Company vs. Jia Yi Furniture Factory* decision\(^{17}\), the Supreme People’s Court stated that:

“(...) the design characteristic in design patent which is different from existing design has significant influence on the overall visual effect. In cases in which the accused design uses the design characteristic of the patented design, simple

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\(^{16}\) Even though this decision arises in an invalidation context, similar parameters for evaluation apply for purposes of infringement, making this decision relevant for the present discussion.

\(^{17}\) Zhongshan City Junhao Furniture Co., Ltd. v. Zhongshan City South District Jiayi Craft Furniture Factory (2011) Min Shen Zi No. 1406, judgment was made by Supreme People’s Court in China on November 22, 2011.
replacement of decorative pattern will not influence the similarity between the two in visual effect (...)."

The 2014 Draft Interpretation of the Supreme People’s Court

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In July 2014 The Supreme People’s Court issued for public comment a new draft “Interpretation on Several Issues about the Application of the Law to the Trial of Patent Infringement Disputes II” (“2014 Draft Interpretation” or “Draft”)\textsuperscript{19}. This is the Supreme People’s Court’s second interpretation of the Patent Law, since its latest legislative amendment in 2009. This latest Draft follows the proposed amendments to the Patent Law issued by the State Council in August 2012 and more importantly, the “Guidelines for Determination of Patent Infringement” issued in September 2013 by the Beijing Higher Court (“Opinions”).

The 2014 Draft Interpretation is not binding at present. It may be either passed with further amendments or abandoned. Nonetheless, the document is interesting in that it provides an insight into the Supreme Court’s doctrinal thinking and portends the changes be made to design patent protection norms in China. The 2014 Draft Interpretation seems to substantially increase the burden of proof of patentees with respect to determination of infringement, especially when compared with the more relaxed and patentee-friendly standards of the case law analyzed in the preceding paragraphs. On the other hand, clearer interpretations of relevant norms on infringement determination may help consistency and in turn clarity as to what can be really protected by way of a design patent. Less judicial uncertainty will ultimately benefit holders of novel and truly original design patents and will have long term adverse effects only on the large number of junk patents registered as designs in China.\textsuperscript{20}

2. 4.1. Infringement analysis

Article 17.2 of the Draft provides that where an allegedly infringing product does not reproduce all the features which distinguish the patented product from prior design, the court may presume that the designs are not similar, and therefore not infringing. On the other hand, there will be a presumption of similarity when all the distinguishing features of the design patent are reproduced in the accused design. This elementally-focused norm seems to extend the literal infringement theory applicable to invention patents to design patents. It likely arises out of the Supreme People’s Court’s desire for practical rules to facilitate judges’ decision-making when assessing infringement in light of article 11 of the 2009 Interpretation.

On the one hand, it is therefore the intention is laudable in that it aims at reducing the discretionary space of judges in choosing a clearer identity/similarity determination standard. On the other hand, Article 17.2 seems to distance itself not only from article 11 of the 2009 Interpretation but also from the holding of the Honda decision.

\textsuperscript{19} Judicial Interpretation of the Supreme People’s Court on Several Issues Concerning the Application of Law in the Trial of Patent Dispute Cases II (Draft for comments).

\textsuperscript{20} Registration of design patents in China does not require examination, with the result that a large number of patents of questionable validity are on the books.
current formulation, article 17.2, could be understood as a derogation of the general principle of comprehensive comparison of the overall visual effect of the designs. Article 17.2 seems in fact to exempt the judge from confirming the essential features identified in the course of the first examination of the patented design (scope of protection) by a comprehensive determination of the overall visual effect of the design patent as provided in the 2009 Interpretation and later in Honda. It is here that the major risk of erroneous and subjective determinations by the civil judge lies and of a return to the “element-to-element” standard of the FIAT Panda case. However, this norm must be read in light of Honda and Jun Hao and is thus limited to those added features with a mere decorative effect. Although the norm seems to emphasize the importance of individual features, the first paragraph of the same article restates the general principle that infringement must be established based on the overall visual effect of the compared designs.

In practical terms, determining the essentiality of a design feature is not a mere abstract operation, but the result of visual cognition of the product as a whole, in light of the prior art. The essentiality of a feature in a design can only be measured and confirmed by looking at the product’s design in its entirety. Departure from the design as a whole would lead back to an “element-to-element” analysis and to arbitrary restrictions of the patent’s scope of protection. How can a judge confirm the essentiality of a feature if not by comparing the visual effect that its presence or absence of modification has on the overall visual effect of the design? Art. 17.2 should be drafted in such a way as to make clear that such presumptions cannot derogate the general rule of overall visual effect.

In conclusion, the wording of article 17.2 is ambiguous and gives judges decisional discretion, which appears not to be limited by the need to confirm the overall visual effect of the selected essential features by comprehensive observation of the design and the infringing product as a whole. For this reason, it may be that this norm is actually unnecessary, especially in light of the guidance already provided to civil judges by article 11 of the 2009 Interpretation and by the consolidated jurisprudence of the same court.

2. 4.2. Prior art and normal user

Article 17.3 stipulates that the “common user” for purposes of similarity evaluation is the “direct purchaser of the accused infringing product.” For instance, in relation to design of a whole vehicle, the consumer is the buyer and not a road bystander. For vehicle spare parts, the common consumer is intended to be the vehicle owner and not the mechanic. Such provision is in line with the law and the prior jurisprudential elaborations.

However, Draft article 17.4 provides that, when determining the knowledge and cognitive ability of the common consumer, the court shall consider the degree of freedom of the designer in creating the specific product design. In particular, the norm
provides that, when viewing the design through the lens of the knowledge and cognitive ability of the common user, the judge must consider the designer’s degree of freedom to create the specific product design, in terms of both novelty and functionality. The Draft Interpretation seems to leave it to the common user to define the boundaries of a designer’s freedom. The risk of such formulation is that the wording of the Draft may be interpreted to imply that the common consumer shall have a high degree of design knowledge that would turn him into the person skilled in the art, i.e. the designer himself. The only boundary that can be interposed to avoid such degeneration of the common user into the person skilled in the art, is to require the common user to be generally knowledgeable of the prior art context. Article 17.5 provides that if the designer has much design freedom it will not be easy for the common user to notice small differences between designs and vice-versa. This can be read to imply that the Court is asking the judge to provide the common user with basic knowledge of the prior art context as a frame of reference for the degree of creative freedom of the designer.

A better and more detailed formulation of the prior art principle as the basis for determining the common user’s cognitive capability is provided by articles 77.4 of the 2013 Opinions of the Beijing Higher Court. According to this norm, when defining the common user’s degree of knowledge and cognitive capability, the judge must take into consideration the development of the product design processes prior to the design patent’s filing date. This norm makes therefore direct reference to the prior art context as the frame upon which to build the notion of designer’s freedom from the point of view of the common user.

In spite of its unclear formulation, article 17 of the Draft Interpretation seems to align with established case law and with other foreign standards.

3. SIMILARITY ANALYSIS UNDER US LAW

In US law, design patents fall under the general Patent Act, which governs both utility and design patents. Certain particularities of US law and procedure tend to sharpen the tension between the elemental and the holistic method in analyzing design patent infringement. These particularities include the fact that US design patent law is governed by the general principles and procedures of utility patent law, and as a result emphasizes formal claims construction which mandates verbalization of each element

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21 Article 77.4 of the Guidelines for the judgment of Patent Infringements promulgated on September 4, 2013 by the Beijing higher Court provides that: “[...] When specifically defining the knowledge and cognitive ability of ordinary customers of a design patented product, it shall be connected with the specific design patented product, and the design development process of the product before the application for the design patent shall be taken into consideration”

22 US Patent Act, 35 USC § 1-376

23 35 USC § 171. The Act also covers plant patents.

Inevitably, this will channel the similarity evaluation into an element-by-element analysis. Furthermore, in the US, a jury, rather than a judge usually performs the comparison between the claimed and the accused design. This fact enhances the need to verbally describe the features, compared to a situation where the judge acts as trier of fact. The following will discuss how the infringement analysis is handled by US courts, focusing specifically on the issues of prior art and functionality.

3.1. Assessment of Prior art: the Egyptian Goddess Case

US design patent law subscribes, at least in theory, to a holistic approach to the infringement analysis. As early as 1871, the US Supreme Court held in *Gorham v White*, that similarity must be evaluated from the perspective of the ordinary observer based on the overall impression of the design as a whole, rather than based on comparison a design’s individual features. With time however, courts added a second step to the analysis, the “point of novelty” which holds that the accused design only infringes when it appropriates the novelty that distinguishes it from the prior art and such distinguishing novel features further constitute a non-trivial advance over the prior art. The “point of novelty” approach required identification and examination of the patented design’s innovative aspects individually, with a focus on the degree to which the patented design departed from the prior art. Courts followed this approach for years, while paying lip service to the *Gorham* rule, despite admonitions against a narrow focus on individual features.

In 2008, the Federal Circuit abrogated the point of novelty rule in its *Egyptian Goddess* decision and reinstated the *Gorham* ordinary observer test as “the sole test for determining whether a design patent has been infringed.” The *Egyptian Goddess* decision folded the two steps of the “point of novelty” analysis into a single ordinary observer test, consistent with *Gorham*, so that “the eye alone is the judge of the identity

26 Perry J. Saidman, Allison Singh, The Death of Gorham Co. v. White: Killing It Softly with Markman, (for the argument that *Markman* should not apply to design patent cases)
27 “[i]f, in the eye of an ordinary observer, 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.” *Gorham* v. *White*, 81 U.S. 511, 528 (1871); see also *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239–41 (Fed. Cir. 2009); *Egyptian Goddess Inc. v. Swisa Inc.*, 543 F.3d 665, 671 (Fed. Cir. 2008) (en banc); *Amini Innovation Corp. v. Anthony Cal*, 439 F.3d 1365, 1371 (Fed. Cir. 2006).
30 *Lawman Armor v Winner*, 449 F.3d 1190 (Fed. Cir. 2006).
32 *Amini Innovation v Anthony*, 439 F.3d 1365 (Fed. Cir. 2006); *Durling v. Spectrum Furniture Co.*, 101 F.3d 100 (Fed. Cir. 1996).
33 *Egyptian Goddess*, 543 F.3d at 678.
of two things”. This change required the ordinary observer to be elevated to having the knowledge and competence to distinguish between the patented design and its prior art predecessors.

Prior art forms a helpful frame of reference for the ordinary observer when comparing the protected design and accused device. Aspects that may not be noticeable in the abstract can gain or lose significance, depending on the prior art context. A design’s prior art background thus provides a context that can focus the ordinary observer’s attention on those aspects of the accused design that differ from the prior art. The prior art context also provides a frame of reference regarding a designer’s creative freedom and the space available in which to maneuver and differentiate its design from existing designs. In a crowded field, with the patented design close to the prior art, creative room is limited. Differences, which at first sight appear to be minor, may assume greater importance. If the accused design includes a particular feature present in the patented design that departs conspicuously from the prior art, the accused design is more likely found to be infringing. At the same time, however, Egyptian Goddess mandates that the ordinary observer not lose sight of the design as a whole. This analysis thus uses a broader brushstroke in evaluating similarity than the “point of novelty” and better parallels the manner in which the ordinary observer views the article. The anomalous result of finding infringement where a design embodies a single piece of prior art can be more easily avoided. Still, a certain amount of “zooming in” on particular elements of a design seems inevitable, be it only in the guise of directing the analysis to relevant elements or the focal points of comparison. This tension is illustrated by the following case.

34 Gorham v White, 81 U.S at 526 (quoting Holdsworth v. McCrea, 2 A.C., (H.L.), 388 (U.K.)).
35 The evaluation of similarity must be carried out through the eyes of the ordinary observer, “giving such attention as a purchaser usually gives, to the overall visual impression of the design as a whole”. Gorham Mfg. Co. v. White, 81 U.S. 511, (1871); Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed. Cir. 1996); see also 1-23 Chisum on Patents § 23.05.
36 The standard is whether the ordinary observer would consider two designs to be substantially the same based on the scope of the patent in relation to the prior art. 1-23 Chisum on Patents § 23.05. In cases where there is plain dissimilarity, the absence of infringement is clear and there is no need to look at prior art. Minka Lighting v. Maxim Lighting, 2009 WL 691594 (N.D. Tex. Mar. 16, 2009).
37 “Where there are many examples of similar prior art designs, as in a case such as Whitman Saddle, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.” 1-23 Chisum on Patents § 23.05, citing Amini Innovation Corp. v. Anthony Cal, 439 F.3d 13171 (Fed.Cir.2006).
38 Wing Shing, 665 F.Supp.2d at 361.
39 Prior art will thus prevent non-expert observers from aggregating too many aspects of the design. See Tushnet, supra note 3, p. 419-420.
40 Egyptian Goddess, 543 F.3d at 677.
41 Id.
42 The Egyptian Goddess standard is engineered so as to avoid the anomalous result where a design that simply embodies a piece of prior art is found to infringe.
In *Wing Shing v. Sunbeam Products*, the court considered the focal points of comparison of the coffee maker at issue to be its top and base. An examination of the prior art found minor differences between the protected and the accused design, except for the base. The court perceived the base as “the most prominent observable difference”, a most salient departure from prior art and the court analyzed it as follows:

“because the [accused design] and the [patented design] differ at the very feature that primarily distinguishes the patented design from the prior art, no ordinary observer familiar with the Accel [prior art] would be deceived into believing that [the patented and accused design] are the same. Indeed, since it is difficult to tell the [accused design] and the Accel prior art apart without focusing on their bases, it would be unreasonable to conclude that any observer capable of distinguishing those two machines would confuse the [patented and accused design] which also have different bases.”

Had the defendant copied the base, there would have been a clear inference of infringement, because, with regard to that specific feature, the accused design is more likely to be viewed as deceptively similar to the patented design. But in this case, the defendant created its own unique base.

As conducted, this analysis directed the focus on a specified element of the design, that sharply distinguished, against the context of the prior art, the accused design from the claimed design. This approach is proper under *Egyptian Goddess* and most likely complies with the Gorham standard, as the ordinary observer is allowed to consider the designs as a whole, albeit guided by the court in identifying the salient element of the design.

Then again, the question remains whether the court’s guidance places undue weight on specific elements. Is it possible that the ordinary observer, endowed with knowledge of prior art and the ability to differentiate between designs, would be capable of making this determination unaided?

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43 *Wing Shing v. Sunbeam*, 665 F. Supp. 2d 357 (S.D.N.Y. 2009) aff’d, 374 F. App’x 956 (Fed. Cir. 2010). Involved proceedings at a summary judgment level, in which Judge Holwell, granting summary judgment of non-infringement because of differences between the patented design and the accused products, wrote a frequently-cited post *Egyptian Goddess* opinion on how to undertake the comparison.


45 *Egyptian Goddess*, 543 F.3d at 680.
3.2. **Assessment of Functionality**

The second thorny aspect of the design patent similarity analysis is the handling of functional features. This aspect pointedly brings out the tension between a holistic assessment of confusing similarity and elemental evaluation and comparison.\(^\text{46}\)

It is generally accepted, that protection of design patents extends to a design’s ornamental elements, but not to its functional elements, which are deemed to be beyond the scope of protection.\(^\text{47}\) Assessment of similarity must be based on the design’s protected scope. Consequently, the comparison must be limited to a design’s ornamental aspects only, and not take into account its functional aspects.\(^\text{48}\) In other words, functional elements do not factor into the analysis.\(^\text{49}\) This requires identification of any elements dictated by function, a task performed as part of the court’s claims construction.\(^\text{50}\) Once the functional elements are identified, they are ignored or “factored out” for purposes of the ensuing comparison. Only the design’s non-functional, ornamental elements remain to be compared.\(^\text{51}\)

Given the very general terms of the functionality definition,\(^\text{52}\) the determination whether an element is functional is fraught with difficulty. Generally deemed to be

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\(^{46}\) Tushnet, *supra* note 3, p. 420  
\(^{47}\) OddzOn Products, Inc. v. Just Toys, Inc. 122 F.3d 1396 (Fed. Cir. 1997); Richardson v Stanley Works, 543 F.3d 1288 (Fed. Cir. 2010).  
\(^{48}\) The similarity analysis is to be evaluated based on the scope of the patent. 1-23 Chisum on Patents § 23.05  
\(^{49}\) Dissection and holistic assessment are “fundamentally contradictory, since analytic dissection interferes with gestalt evaluation.” Tushnet, *supra* note 3 p. 419.  
\(^{50}\) In US patent infringement cases, claims construction, in the course of which the individual claims are identified and analyzed, precedes the actual infringement action. Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996).  
\(^{51}\) E.g. OddzOn Products v. Just Toys, 122 F.3d 1396 (Fed. Cir. 1997). The more numerous the functional elements of the design, the more narrow the construction of the claim.  
\(^{52}\) “An aspect of a design is considered functional if it is essential to the use or purpose of the article embodying the design or if the aspect affects the cost or quality of that article. However, the existence of alternative designs, i.e. the fact that the functional aspect can be accomplished in ways other than by the patented design will defeat a finding of functionality”, so that the trapezoidal shape and “finger-friendly”
beyond the ken of the ordinary observer, it is usually performed by the court. The analysis is subject to the admonition that it should not convert the overall infringement test to an element-by-element comparison, as the overall appearance of the design is supposed to control the similarity determination. Still, it remains questionable how this process complies with the mandates of Gorham and Egyptian Goddess, as the comparison considers a truncated version of the design, rather than the design the purchaser would encounter.

A case in point is the tossing ball design claimed by the plaintiff in OddzOn v. Just Toys. The patented design involved a smooth-surface, football-shaped ball, with a slender tailshaft and three fin structure, projecting from its rear, that gave the ball a rocket-like appearance. The accused device consisted of a ridge-surfaced football-shaped ball, which also displayed a tail and fin structure. The tail and fin structure was intended to add speed and stability, in the same manner as tails and fins found on darts or rockets. Plaintiff OddzOn had the burden of establishing that not the design’s functional features, but its ornamental aspects, accounted for the similarity perceived and that the similarity was such that an ordinary person would be deceived by reason of the common ornamental features.

As customary in cases where the claimed patent consists of both ornamental and functional features, the court proceeded by way of a two step analysis: construing the claim to identify functional features and then comparing the patented design to the accused device. In the first step, the court found the tail and fin structure to be functional. The court approached the second step by limiting the scope of the patent to the overall visual impression of the ornamental aspects, i.e. considering the ball alone, rather than the broader general design of a rocket-like tossing ball. Not surprisingly, the court concluded that the ornamental features in the patented design and the accused device differed, and that no basis for infringement existed.

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53 Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563 (Fed. Cir. 1996); Richardson v Stanley Works, 543 F3d 1288 (Fed Cir 2010).
54 The deception that arises is a result of similarities in the overall design and not of similarities in ornamental features considered in isolation. Luv ‘n Care v Mayborn USA, 898 F Supp 2d 634 (SDNY 2012). Thus, even though functionality has been factored out, the overall appearance of the design controls the similarity determination. Accordingly, when courts evaluate design infringement claims they look to similarities in overall design, “not similarities of ornamental features in isolation.” Amini Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1372 (Fed. Cir. 2006). "In evaluating a claim of design infringement, a trier of fact must consider the ornamental aspects of the design as a whole and not merely isolated portions of the patented design." Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1189 (Fed. Cir. 1988).
56 Id.
57 Id.
58 The court rejected the patentee’s contention that the overall similarity of the “rocket-like” appearance is sufficient to show infringement. “We agree with the district court’s claim construction, which properly limits the scope of the patent to its overall ornamental visual impression, rather than to the broader general design concept of a rocket-like tossing ball.” OddzOn Products, 122 F.3d at 1405.
The difficulty with this analysis is that, particularly in instances where a design’s functional aspects are readily separable from its ornamental ones, the trier of fact essentially compares the truncated versions of the claimed and accused design. The analysis thus becomes much more literal in nature than intended by Gorham.59 It is quite conceivable that, not being instructed to factor out the tail and fin structure, an ordinary observer might have reached a different finding. The effect of the court’s focus on the ball alone was to enhance the significance of the ball’s surface decoration, when compared to the overall design, thus giving a distorted view to the product.

Furthermore, because the analysis of functional elements has remained unaffected by the holding in Egyptian Goddess, courts continue to practice it.60 While a few courts have tried to take a more holistic view of the comparison, 61 the prevailing view remains that the OddzOn method is to be followed. This approach however, is not satisfactory either, as the patentee should not benefit from a scope of protection exceeding that normally allowable by the patent office.

The case of Richardson v Stanley Works 62 further illustrates this dilemma. 63 In Richardson, the claimed design, the Fubar, multifunctional tool, consisted of the unique

OddzOn “Vortex” tossing ball

Just Toys “Ultra Pass” balls

The case of Richardson v Stanley Works 62 further illustrates this dilemma. 63 In Richardson, the claimed design, the Fubar, multifunctional tool, consisted of the unique

59 Saidman, Singh, supra note 26, p. 10.
60 E.g. Mobile Hi-Tech Wheels v. CIA Wheel Group, Mobile Hi-Tech Wheels v. CIA Wheel Group, 514 F. Supp. 2d 1172 (C.D. Cal. 2007), In comparing the ornamental aspects of a wheelrim, the court instructed the jury to ignore the design’s functional aspect: “I am telling you that in comparing the plaintiff’s patent to the defendant’s wheel, Exhibit 24, you’re not to consider the back plate. In other words, the back plate is not for you to consider. You’re just to consider the other aspects of the patent as compared to the product.” (But note, that a separate issue in the case related to the extent of whether the dotted lines were part of the protected scope; an issue which may also have influenced the phrasing of the jury instructions).
61 LA Gear v Thom McAnn, 988 F.2d 1124 (Fed. Cir. 1993); Good Sportsman Mktg. v Li & Fung, E.D. Tex 2010).
62 Richardson v Stanley Works, 543 F.3d 1288 (Fed. Cir. 2010).
configuration of several functional components, a hammer with a stud climbing tool and a crowbar. All of these elements were found to be purely functional.64 Even though they made up essentially the entire visual appearance of the design, the Federal Circuit found that the District Court had properly “factored out the functional aspects of Richardson’s design as part of its claim construction.” The court indulged in the fiction that evaluating the similarity of the ornamental features alone is equivalent to evaluating the design as a whole.65 The fact is however, that once the functional elements have been factored out, the appearance of the claimed design may differ quite considerably, as it did in Richardson. Gaps are left where functional elements would have been located and produce an effect likened to “a jigsaw puzzle with pieces missing.” 66

As a result, comparing the similarity of the claimed and the accused device would be extraordinarily difficult and is likely to distort the analysis. Discounting a dissimilar “functional” element, increases the claimed design’s scope of protection and tends to lead to a finding of similarity, when in fact inspection of the design as a whole would yield a conclusion of dissimilarity. Conversely, discounting a similar “functional” element, reduces the claimed design’s scope of protection and may lead to an incorrect finding of dissimilarity.67

In summary, the manner in which functionality is currently handled by US courts lacks doctrinal foundation and is inconsistent with the Supreme Court’s mandate in Gorham.

4. SIMILARITY ANALYSIS UNDER EU DESIGN LAW

The design law of the European Union came to the scene relatively recently. Developed the late 1990s, the EU design law system,68 with the benefit of hindsight, has sought to avoid the problems that plagued older design laws in the EU member states and elsewhere. Many consider it to be the most advanced design law.

63 Configuration of the elements might have been argued here, but apparently was not. “The appearance may be the result of peculiarity in configuration or of ornament alone, or of both conjointly.” Gorham v White, 81 U.S. at 525.
64 Richardson v. Stanley Works, 543 F.3d at 1294
65 In evaluating infringement, we determine whether the deception that arises is the result of he similarities in the overall design, not of the similarities in ornamental features in isolation” Richardson at F.3d 1295; see Robert Oake, Rethinking Design Patent Infringement Law, http://www.designpatentschool.com/page7/assets/Rethinking%20Design%20Patent%20Infringement%20Law%202010.pdf, p. 32.
67 See Dumont, Janis, supra note 67, p. 91
The structure of the infringement analysis in EU law differs considerably from that in the US and China. Infringement is measured by whether the allegedly infringing product does or does not “produce on the informed user a different overall impression” from the protected design, in other words, a later design infringes if it does not create a different overall impression from an earlier design right.\(^{69}\)

The differences between a protected design and an accused article are assessed by the “informed user.” This is “a user who has experience of other similar articles will be reasonably discriminatory—able to appreciate enough detail to decide whether ... an alleged infringement produces a different overall impression.”\(^ {70}\) As summarized by the *Samsung v. Apple* court, the informed user is precisely that, a user of the product, not a designer, technical expert, manufacturer or seller, but more observant than the average consumer of trademark law. He or she is particularly observant and able to detect differences of importance to the overall impression which the average consumer does not see, and is interested in the products concerned, showing a relatively high degree of attention when he uses them.\(^ {71}\)

In contrast with the US approach, EU law has folded the assessment of both the prior art and of functionally dictated features into a single process: the evaluation by the informed user of both these aspects. As a result, no factoring out of non-protectable elements occurs.

The process in which the informed user engages is complex. When assessing similarity, the informed user is required to take into consideration “the degree of freedom of the designer in developing his design”.\(^ {72}\) Freedom of design may be restricted by a particularly crowded field with a rich design corpus (prior art). The informed user is deemed to have knowledge of the design corpus, as well as of the design features normally included in the existing designs in the respective sector.\(^ {73}\) Thus a comparison between the claimed and the accused design takes into consideration that a field is crowded and allocates appropriate weight to them: when the field is crowded minor differences may sufficiently differentiate among designs.

Further restrictions on the designer’s freedom may result from the fact that design features are mandated by reason of the product’s function. In such cases, when technical constraints substantially limit the designer’s degree of freedom, competitors’ designs tend to closely resemble the protected design. The informed user must then take into account the degree of the designer’s freedom and possible variations within

\(^{69}\)The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression. Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community Designs, Art. 10(1).

\(^{70}\) Procter & Gamble v Reckitt Benckiser (UK) 2007 EWCA Civ 936.


the product field in question.\textsuperscript{74} It must recognize that the scope of protection of designs where a designer has little freedom will be narrower than for other designs and conversely, when the designer enjoys a high degree of freedom, the design is accorded a greater scope of protection, ensuring a more “robust buffer between the protected design and its rivals.”\textsuperscript{75} The degree of freedom inquiry is strictly a matter of allocating relative weight to design features. In contrast with US design patent law, features are not factored out altogether.\textsuperscript{76}

The UK decision in \textit{Procter & Gamble v. Reckitt Benckiser}\textsuperscript{77} explains how this analysis is to be performed. At issue in the case are spray cans that feature a trigger and a “pistol grip”. The designer’s freedom is somewhat constrained by the fact that the product must be grippable, and that the index finger can pull the trigger. The trigger must furthermore be shaped to fit the finger and leave sufficient space behind it to be pulled. When assessing the product’s overall impression, the informed user has to take those requirements into account and place weight accordingly. In such cases, smaller differences will be enough to create a different overall impression where freedom of design is limited.\textsuperscript{78}

\begin{figure}[h]
\centering
\includegraphics[width=0.5\textwidth]{spray_cans.png}
\caption{Spray cans featuring a trigger and a “pistol grip.”}
\end{figure}

\textsuperscript{74} Träjärn AB v. Renajs Scandinavia AB et al., Boras District Court, Sweden, Docket no T-734-03/T 750-03 (July 24, 2009). Such analysis is what Art. 6(2) (for purposes of validity “In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration”) and Art. 10(2) (for purposes of scope of protection) require. Procter & Gamble v Reckitt Benckiser (UK) 2007 EWCA Civ 936.

\textsuperscript{75} Dumont, Janis \textit{supra}, note 67, pp. 298-299.

\textsuperscript{76} Dumont, Janis \textit{supra}, note 67, p. 297.

\textsuperscript{77} Procter & Gamble v Reckitt Benckiser (UK) 2007 EWCA Civ 936.

\textsuperscript{78} Id.
This process does not require that functional features be factored out. In *Gimex v. The Chill Bag*, which involved the design of bottle bags, the court had determined that many features of the design’s functional considerations impose design constraints, including “(i) reusability of the product, (ii) foldability of the product when empty, (iii) transparency of the product, (iv) capacity to hold a wine bottle with coolant materials and enabling their carriage with the wine bottle upright, therefore having to contain the bottle in an upright position and coolant and having at least one handle to carry it in the hand; (v) low cost.” The court did not hold the entire design invalid pursuant to Art. 8(1), nor did it exclude or otherwise discount the functional features. Instead the court indicated that their functional nature had already been taken into account when considering design freedom. It then proceeded, based on the claimed design as a whole, to make the comparison, noting the features’ functional nature. Because of the presence of numerous functional features, the bottle bags were quite similar, with the effect that the scope of protection was relatively narrow. The accused product was found to infringe.

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80 Id.
81 Id. Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community Designs Article 8(1) provides that “A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.”
82 Even bearing in mind that the scope of protection of the Ice Bag design is relatively narrow, overall the Chill Bag does not produce a different overall impression on an informed user from that created by the Ice Bag. The Chill Bag is an infringement. *Gimex Int’l v The Chill Bag & Ors.*
5. TOWARDS A COMMON APPROACH

So far we have outlined some of the main difficulties encountered in analyzing design patent infringement and the approaches adopted by different jurisdictions. The following will consider these matters from a normative perspective, seeking to distill some commonly acceptable principles and to develop a basis for bridging the discrepancies.

5.1. Guidance Provided by Underlying Policy

The core question that emerges from the foregoing discussion is whether the infringement evaluation should be conducted in a holistic manner, by considering the product as a whole, or an elemental manner, by analyzing its parts separately. The laws discussed above, seem, at least in theory, to mandate a holistic approach, even if this precept is often not necessarily followed in practice. To understand the reason for this preference, it is helpful to start with the policies underlying design protection, specifically, the role of the infringement analysis in implementing these policies.

The law deems the “appearance to the eye” to be a contribution to the public which is “worthy of recompense” by way of IP protection. Economic theory holds that IP protection, including protection of designs, should provide inventors/designers with exclusivity in the market for a limited time, in order to allow them to recoup their investment and make a profit, thereby ensuring ongoing incentive for further innovation.

Such protection is necessary because a designer’s exclusive IP right is undermined by the presence in the market of a competing product that is similar to the protected design. If purchasers were to mistake the competitor’s similar product for the one

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83 Gorham v. White, 81 U.S. at 528.
embracing the protected design, the holder of the design right would be harmed. In that event, IP laws entitle the rightholder to exclude competing producers of confusingly similar goods from the market by way of an infringement action that must determine whether the competing product is impermissibly similar in appearance. The question then arises by what standard “similarity” should be measured.

Consistent with underlying policy, the evaluation should parallel the manner in which the harm occurs, namely the perception of similarity or lack thereof experienced by the purchaser when faced with the article. Design products are purchased for their aesthetic appeal. A product’s attractive or interesting appearance is intended to produce in the purchaser a spontaneous emotional reaction, at an almost visceral level, not unlike viewing a piece of art. As far as the product’s aesthetic features are concerned, purchase decisions are generally made based on this initial reaction and not further justified or rationalized. This suggests that the model for evaluating similarity in an infringement action should follow the perceptual and cognitive process by which the purchaser reacts to the product’s appearance, i.e. the analysis should be guided by the spontaneous reaction to the product’s appearance. Consistent with this logic, the US Supreme Court held “sameness of effect upon the eye to be the main test of substantial identity of design.” If the competing product, seen as a whole, gives rise to a similar reaction as the protected design, and if as a result the purchaser is unable to differentiate between the protected design and a competitor’s design, then the product would likely infringe.

This speaks in favor of a holistic approach to the analysis, of a determination based on the purchaser’s overall impression of the products and would provide a sound policy basis for the EU Regulation’s “overall impression” standard. By the same token, an elemental analysis would appear unsuitable, because it does not replicate a purchaser’s mental process in making the purchase decision. Instead, it risks distorting the analysis, by giving individual design features, whether different or similar, disproportionate

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85 “.. if [the purchasers] are misled and induced to purchase what is not the article they supposed it to be -- if, for example, they are led to purchase [articles] deceived by an apparent resemblance into the belief that they bear the [protected] design, and therefore, are the production of the holders of the ...patent, when in fact they are not -- the patentees are injured and that advantage of a market which the patent was granted to secure is destroyed. Gorham v. White, 81 US at 528.

86 Once the initial “like” reaction has taken place, the aesthetic superiority of a given design over others is accepted in the purchaser’s mind and the purchase decision is not further rationalized as far as the product’s aesthetic features are concerned. For products whose value lies in their appearance, (rather than their functionality,) purchasers tend to make purchase decisions based on observing the product as a whole, rather than dissecting it into fragments of its visual appearance. Therefore, it is not necessary that every aspect of the designs be identical, minor differences are not determining. See Brooks Furniture Mfg. v. Dutailier Int’l, Inc., 393 F.3d 1378, 1383 (Fed.Cir.2005). An expert’s analysis risks directing the analysis to an excessive focus on detail.

87 Gorham v. White, 81 U.S. 511 (1871).

88 Accepting that the process is inherently imprecise. “scope of rights in visual work is inherently imprecise” P&G paraphrased.
weight compared to their overall role in the design as a whole. Competing designs thus risk being found non-infringing due to differences, or infringing based on similarities that would have been irrelevant to a real-world purchaser.

Therefore, strong theoretical arguments can be made in favor of a holistic and against an elemental approach. In reality however, the dichotomy between a holistic and an elemental analytical method may not be as sharp as it appears. Because the judicial process does not countenance determinations based merely on visceral reactions to the appearance of an object, evaluation of individual features becomes a necessity. As a result, in practice the process in most cases is blended: in a properly performed analysis, an evaluation of individual features would precede and inform the overall impression determination.89

Once the basic methodology for this analysis has been established as a matter of principle, a number of questions arise. These include important process-related questions, such as who should perform the evaluation of individual features and the comparison respectively, how to handle new contributions to the design vs. those which are already in the state of the art and features dictated by functional considerations, and finally how the interaction between these methods should be structured, to avoid the pitfalls inherent in an elemental analysis. The following will attempt to answer these questions.

5.2. The notional purchaser

In seeking to emulate the real-world purchaser’s mental process, the jurisdictions examined have delegated to a notional purchaser the task of making the comparison.90 The notional purchaser is described as a particularly observant individual, interested and deeply knowledgeable about the product at issue and other comparable products in the field,91 who shows a relatively high degree of attention to products when he uses them.92

In general, the notional observer in a design context is deemed more observant and knowledgeable than the reasonable consumer in trademark law, but less so than the

90 The notional purchaser is the informed user in the EU, see text accompanying notes 72-73 supra, the common user in China and the ordinary observer in the US, respectively.
92 PepsiCo v. Grupo Promer (C-281/10P) [2012] FSR 5, paragraph 59. In the US, the ordinary observer gives the article such attention as a purchaser usually gives. The analysis is to be carried out by “observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances...”. Gorham v. White, 81 U.S. at 528.
PHOSITA (personal having ordinary skill in the art) in the utility patent context. It is important that the notional purchaser NOT be an expert, as experts would approach the analysis with a greater knowledge of and attention to detail than a notional purchaser. A true expert would not miss even the most minute detail.\textsuperscript{93} In performing the mental process described above, the notional purchaser must avoid extremes, such as on the one hand, observing in detail any minimal differences between the designs, and on the other, merely perceiving the designs as a whole, without analyzing the details.\textsuperscript{94} Within these general parameters there is little disagreement about the notional purchaser’s competencies. The same cannot be said about the tasks which the notional observer is to perform, as will be discussed in the next section.

5.3. How to handle the scope of protection

Possibly the thorniest issue in design infringement analysis is the handling of the scope of protection. Most designs include elements which are not protectable and to which the rightholder’s monopoly does consequently not extend. In the context of assessing the design as a whole, this presents a dilemma. If non-protected features are considered when making the comparison, the scope of protection is increased beyond that to which the right holder is entitled. If, on the other hand, they are excluded, the comparison is based on a truncated version of the design, which bears no resemblance to either the claimed design or the accused product and becomes nothing more than a farce.

As mentioned above, the notional purchaser normally makes a purchase decision based simply on perceiving the article as a whole without conducting an element-by-element analysis of protectable features. A judicial proceeding clearly requires more than a simple conclusion of similar/non-similar. The conclusion must be supported by an analysis which identifies the relevant individual features and assesses their protectability. The difficult question is how the information developed in the course of this analysis is to be used without straying into an elemental analysis.

This difficulty can be overcome by yet another fiction: expanding the notional observer’s sphere of competence to knowledge of non-protectable features. The notional purchaser endowed with such knowledge could be tasked with identifying non-protectable features, evaluating their overall effect, allocating weight based on its findings and performing the comparison. This would mean that evaluation of design

\textsuperscript{93} Gorham v. White, \textit{supra} note 27.

\textsuperscript{94} Under US law the ordinary observer is a person who is either a purchaser of, or sufficiently interested in, the item that displays the patented designs and who has the capability of making a reasonably discerning decision when observing the accused item’s design whether the accused item is substantially the same as the item claimed in the design patent. The ordinary observer should not be an expert as an expert, upon close examination, is bound to find even the most minute differences between two articles, whereas infringement uses a fairly broad brush. 1-23 Chisum on Patents \$ 23.05; see also PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5, paragraph 59; Gorham v. White, \textit{supra} note 27.
elements and comparison could be performed in a single process and no dissection into individual elements would be required.

This approach was adopted by the EU design system. The court is required to don the spectacles of the “informed user”, and factor into its analysis any constraints on the designer’s freedom, in terms of both the design corpus and features which may be dictated by functional considerations. It then allocates the proper weight to these features, e.g. in a crowded field the scope of protection might be narrower, etc. Then, using the information thus developed, a court, still wearing the spectacles of the informed user, performs the comparison.

Other jurisdictions have vacillated. In China the analysis has varied from a more holistic approach in the Neoplan case to the 2014 Interpretation of the Supreme Court which may be read as derogating the principle of comprehensive comparison of the design’s overall visual impression.

US law has divided the competencies so that the notional purchaser is deemed to have knowledge of prior art, but not of functionality. Consideration of prior art is factored into the comparison performed by the ordinary observer: if an accused product is closer to the claimed design than to prior art, it probably infringes, whereas if it bears a stronger similarity to the prior art, it probably does not. The handling of functional features is more complicated. Functional features must be identified by the court, often in a special claims construction proceeding. Any features found to be functional must be “factored out” of the analysis. The actual comparison is usually undertaken by a jury. The court’s determination of functionality must therefore be communicated to a jury with a fair amount of precision, along with appropriate instructions. This approach leads to the distorted results seen in OddzOn and Richardson, where, after factoring out functional elements only a truncated version of the design was left.

95 Procter & Gamble v Reckitt Benckiser [2007] EWCA Civ 936.
96 One lingering question is whether too much is being asked of the notional purchaser. Charging the informed user with both evaluating the effect of design constraints and delegating similarity assessments to it, in effect makes it a quasi-omniscient trier of fact. Does this method yield sufficient accuracy? Still, the system has the advantage of avoiding the distortions inherent in an elemental analysis, simplifying the analysis overall and eliminating the costs and delays involving experts.
98 Egyptian Goddess v. Swisa, 543 F.3d 665 (Fed. Cir. 2008).
100 Richardson v Stanley Works, 543 F3d 1288 (Fed. Cir. 2010).
101 Theoretically, if US law were to be read less literally, it would be possible to approximate a more cohesive methodology, by allocating reduced weight to functional features without actually excluding them altogether from the comparison.
In summary, at one end of the spectrum, the EU has opted for a largely holistic analysis, in which the notional person is tasked with both evaluating and comparing, while at the other, the US approach is divided into separate holistic and elemental segments. Chinese law is placed somewhere in between, adhering in principle to a holistic approach, although in its recent Interpretation the Chinese Supreme Court seems to emphasize the elemental aspect of the analysis. These divergent views may not be easy to reconcile, unless, as discussed in the following section, an effective interaction between the various methodologies can be reached.

5.4. The final step

The last question refers to the overall sequence of the analysis and to how the elemental and holistic segments of the analysis interrelate as part of it. Certain “best practices” can be gleaned from some of the decisions, which structure that analysis so as to give an overarching role to the overall impression. In this spirit, the Samsung Electronics v Apple UK court of appeal reemphasized that, what ultimately matters, is the overall impression, regardless of the nature of the preceding preparatory analysis. In the Samsung v. Apple case, one of the parties complained that various design features at issue had been analyzed in a piecemeal and feature-by-feature fashion. The court of appeal noted this complaint, but discounted it, finding that as long as a court ultimately came to consider the overall impression of the design, a feature-by-feature examination is not fatal to the outcome. In other words, a final step considering the design as a whole may cure possible errors in the preceding analysis.

This final step would consist of a global assessment of the overall impression. Informed by the earlier evaluation of the design’s discrete elements, the court would synthesize the information provided, articulate the overall impression at a high level of generality and then compare the protected design with the accused product.

For instance, in the Magmatic v. PMS Ltd. case, a UK appellate court adopted the evaluation of discrete design features conducted by the lower court, but found it to be insufficient. To correct the piecemeal impression left by the lower court’s analysis, the appellate court added a final step, globally assessing the design’s overall impression. This assessment described the animal shaped childrens’ suitcases at issue, respectively as (1) a “horned animal” with a sleek and stylized design and, from the side, a generally symmetrical appearance with a significant cut away semicircle below the ridge (the claimed design), and (2) “evocative of an insect” with antennae or an animal with floppy ears, influenced by the coloring of the body, which makes one look like a ladybird.

103 “[The] impression created by the CRD is that of a horned animal. It is a sleek and stylised design and, from the side, has a generally symmetrical appearance with a significant cut away semicircle below the ridge.” Magmatic Ltd. and PMS Int’l, [2014] EWCA Civ 181.
accused product).\textsuperscript{104} Put this way, the court’s characterization makes it clear that the overall impression is such that a purchaser would not be deceived into buying one, thinking it is the other.\textsuperscript{105} In other words, the product does not infringe.

The sequence of steps to be performed in evaluating infringement can be distilled from the \textit{Magmatic} decision, as follows:

1. consideration of the design corpus/prior art
2. consideration of the degree of design freedom
3. consideration of the effect on the scope of protection of
   a. differences between the design corpus/prior art and the claimed design (whereby less significance will be attached to those features which form part of the design corpus and correspondingly greater significance to those features which do not);
   b. the degree of design freedom in terms of functional considerations upon the scope of protection (whereby particular importance will be attached to features as to which the designer has great freedom)
4. final global assessment of the overall impression and comparison.

Failing to conduct this final step may be considered an error.\textsuperscript{106}

It is this “crowning” global assessment that allows the court to take a step back for a final look at the design. Its description phrased at a high level of generality constitutes a

\textsuperscript{104} “By contrast the design of the Kiddee Case is softer and more rounded and evocative of an insect with antennae or an animal with floppy ears (here the impression of the shape is influenced by the coloring of the body, which makes one look like a ladybird and the handles on its forehead like antennae.” \textit{Magmatic Ltd. and PMS Int’l}, [2014] EWCA Civ 181.

\textsuperscript{105} See \textit{Gorham v White}, \textit{supra} note. 27.

\textsuperscript{106} While the lower court correctly carried out these steps without giving rise to a basis for criticism. it was faulted for failing to conduct that last, most important step as the analysis is not limited to the considerations listed above. What is required is a global assessment, in which the designs are “considered having regard to the context in which the accused shape occurs, with some features having greater prominence than others.” \textit{Magmatic Ltd. and PMS Int’l}, [2014] EWCA Civ 181.
final verification that no distortions have occurred in the course of the underlying analysis. It validates the initial “appearance to the eye” at a more informed level, taking into consideration the designer’s freedom, prior art and functionality concerns. For instance, a characterization of “a horned animal” vs. “an insect” suggests that the overall impression is clearly different. Similarly, in the Chill Bag case, both the claimed design and the accused product created the overall impression of “an ice bucket bag”, any differences being insignificant. Even if the preparatory analysis is not undertaken in a principled fashion, i.e. if individual elements are evaluated piecemeal or discounted altogether, or if weight is allocated incorrectly, the final step may go a long way in curing, or at least mitigating the effect of these deficiencies.107 Had this last step, for instance, been performed by the OddzOn court, the products might have been characterized as creating the overall impression of a rocket and a different outcome would have obtained.

While this solution sounds simple, it is not without risk. The difficulty lies in finding the correct level of generality in formulating the final step.108 The responsibility in formulating it is great, because, after all, the entire case may hinge on this final assessment. While the description must be concise enough to dispose of the dispute, too concise a characterization may appear subjective. For instance, had the Magmatic court limited its overall impression to a mere cursory statement of “a horned animal” and “an insect” without further justification, this might have been insufficient. Too elaborate a description risks being confusing. Therefore, the final statement must be sufficiently general to distill the underlying findings and test them against the notion

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107 “The height [of the Chill Bag] is essentially the same and the handles are virtually identical. The only differences from the Ice Bag design which are capable of being significant are the absence of the business card slot and the presence of a coaster slot in the base. In my judgment these two differences do not lead to a different overall impression. To an informed user the Chill Bag is clearly an ice bucket bag. When a bottle, ice and water are put inside it will look like a nice bucket with the bottle neck proud of the top and a wider base. I bear in mind the informed user is particularly observant. In this case I believe a side by side comparison is appropriate. The informed user would notice the lack of business card slot but would not regard it as significant given the overall impression created by the design. Equally the presence of the coaster slot in the Chill Bag is not important to the overall impression. It is barely visible. Even if the informed user noticed it at all, and given that they are observant I will assume that they do, it would not strike the user as being visually significant. Gimex v The Chill Bag [2012] EWPCC 31. In another case, “One of the overall effects of the design is the interaction between the strap assembly portion and the base portion of the shoes where the strap is attached to the base. Multiple major design lines and curves converge at that point creating a focal point attracting the eye of the ordinary observer when viewing the overall effect of the design. Another overall effect of the design is the visual theme of rounded curves and ellipses throughout the design, including the strap forming a sort of continuation of the sidewall of the base to create a visually continuous ring encircling the shoe” Crocs v. ITC, 598 F.3d 1294, (Fed. Cir. 2012).

108 “[T]he level of generality to which the court must descend is important. Here for instance, it would be too general to say that the overall impression of the registered design is a “canister fitted with a trigger spray device on the top”. The appropriate level of generality is that which would be taken by the notional informed user. Procter & Gamble v Reckitt Benckiser (UK) 2007 EWCA Civ 936, paragraph 35.
purchaser’s overall impression, without falling into the trap of a detailed elemental analysis.

To conclude, the final step, if undertaken correctly, would help mitigate distortions of an infringement analysis that does not observe the “design as a whole” rule. In this way, the final step would bring the analysis closer to the policies of design protection outlined above and thus have a unifying effect across jurisdictions. From an international perspective, mandating the final overall impression test would be a considerable advance towards harmonizing the infringement analysis, as it would lead to overall greater consistency in methodology and results. Furthermore, this step constitutes an easy-to-adopt measure that does not require major reform. It does not conflict with the laws of the jurisdictions examined, and probably not with the laws of other jurisdictions either.109

6. CONCLUSION

A design looks the same regardless of jurisdiction and applicable law. There is no good reason for the evaluation of similarity of two designs to change with jurisdictions, despite different cultures, legal systems and procedures. The fundamentally different analytical methods currently used in different countries are not grounded in principle and hinder international business.

Substantive legislative reform in the field of design is not imminent. Mandating a final overall impression test the as “final step” would go a long way towards greater overall consistency in results across jurisdictions.

109 The final step may be applicable to other jurisdictions as well. For instance, in Singapore, protection for Registered Designs is provided for under the Registered Designs Act (“RDA”). The two-step test applied by the Singapore courts in Hunter Manufacturing Pte Ltd &. Anor v Soundtex Switchgear and Engineering Pte Ltd consists of (1) assessing the essential or the significant features and having regard to such matters as the statement of novelty, relevant prior art and functions, exclusions etc; and (2) comparing the registered design with the alleged infringement to assess whether visually, the latter has incorporated all the design features which as a result of the first step are considered essential parts of the registration.