

## DESIGN PATENT INFRINGEMENT AS UNFAIR COMPETITION

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### ABSTRACT

*The rule for determining design patent infringement requires an assessment of substantial similarity through the eyes of an ordinary observer—similarity sufficient to induce the observer to purchase the infringing design supposing it to be the patented design. That test, which originates in the Supreme Court’s 1871 Gorham Manufacturing Co. v. White decision, is an anomaly. It is a patent infringement test framed in language that would be more at home in a trademark infringement or unfair competition case. Yet the Federal Circuit has insisted that design patent infringement is unlike trademark infringement or unfair competition, dismissing any kinship as superficial. In this Article, I first show that the connection between design patent infringement and unfair competition is much deeper than previously recognized. The Gorham case record and associated historical sources help support this assertion. I then urge the Federal Circuit to explore what lessons modern trademark and unfair competition law might provide for design patent infringement law. I survey the law that has grown up around the confusion factors analysis that is used for most modern Lanham Act trademark and unfair competition claims, and I show how that law can be mined for subsidiary rules that would inform the design patent infringement analysis. I conclude that by declining to consult the jurisprudence of trademark infringement and unfair competition claims, the Federal*

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*Circuit is depriving itself of a repository of lessons—positive and negative—developed by courts over many decades, lessons that could bring some needed depth to the design patent infringement analysis.*

TABLE OF CONTENTS

INTRODUCTION . . . . .	1158
I. THE HISTORICAL CASE FOR DESIGN PATENT INFRINGEMENT AS UNFAIR COMPETITION. . . . .	1163
A. Gorham’s <i>Underappreciated Unfair Competition     Rhetoric</i> . . . . .	1163
B. <i>Unfair Competition Evidence in Gorham</i> . . . . .	1171
II. THE MODERN LEGAL LANDSCAPE: DESIGN PATENT INFRINGEMENT AND UNFAIR COMPETITION . . . . .	1177
A. <i>Elements of the Modern Design Patent Infringement     Analysis</i> . . . . .	1177
B. <i>The Modern Legal Landscape of Unfair Competition     Law</i> . . . . .	1178
III. DEVELOPING UNFAIR COMPETITION SUBTESTS FOR ANALYZING DESIGN PATENT INFRINGEMENT . . . . .	1180
A. <i>Refining the Substantial Similarity Inquiry</i> . . . . .	1182
1. <i>Side-by-Side Similarity</i> . . . . .	1182
2. <i>Post-Sale Similarity</i> . . . . .	1186
B. <i>“Attention” and Consumer Sophistication</i> . . . . .	1192
C. <i>Competitive Proximity: The Section 171 Article of     Manufacture and the SurgiSil Problem</i> . . . . .	1194
D. <i>Copying, Intent, and the Relevance of the Alleged     Infringer’s Labeling</i> . . . . .	1199
E. <i>Design Strength</i> . . . . .	1206
F. <i>Confusion Surveys in Design Patent Infringement     Cases</i> . . . . .	1208
CONCLUSION . . . . .	1212

## INTRODUCTION

From its inception, American design patent law<sup>1</sup> has operated as a legal transplant project.<sup>2</sup> Utility patent law has been the chief donor. The patent statute mandates that where no design patent-specific provision exists, utility patent provisions govern.<sup>3</sup> Pursuant to this authority, the Federal Circuit<sup>4</sup> and predecessor courts have spent decades attempting to incorporate utility patent rules into design patent law—sometimes seamlessly,<sup>5</sup> and sometimes only with significant adaptations.<sup>6</sup> Litigation over the court’s fidelity to the concept and practice of transplanting utility patent rules into design patent law continues today in the court’s highest profile cases.<sup>7</sup>

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1. A design patent protects the visual impression of an article—its shape, surface ornamentation, or both. *See* 35 U.S.C. § 171(a) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor.”); *In re Schnell*, 46 F.2d 203, 209 (C.C.P.A. 1931) (construing “design” to encompass shape, surface ornamentation, and combinations). In contrast, the more familiar utility patent law protects inventions. *See* 35 U.S.C. § 101 (laying out the categories of eligible subject matter).

2. For a discussion on legal transplants in intellectual property law more broadly, see generally Mark Bartholomew & John Tehranian, *Historical Kinship & Categorical Mischief: The Use and Misuse of Doctrinal Borrowing in Intellectual Property Law*, 109 IOWA L. REV. 51, 68 (2023) (focusing on borrowing between utility patent law and copyright law). On the history of design patent law’s relationship with utility patent law, see Jason John Du Mont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837, 855-73 (2013) (showing that early proposals derived from British design protection law, but these gave way to a proposal featuring a few design-specific rules, with the rest to be borrowed from utility patent law).

3. *See* 35 U.S.C. § 171(b) (“The provisions ... relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”). The statute “otherwise provides” only a small number of design-specific provisions. *See* 35 U.S.C. §§ 171-173 (setting out some protectability requirements, a right of priority, and the rule governing design patent term); 35 U.S.C. § 289 (establishing a special disgorgement remedy for design patent infringement).

4. The Federal Circuit takes appellate jurisdiction over all cases arising under the patent laws, including the design patent provisions. 28 U.S.C. § 1295(a)(1).

5. *See, e.g.*, *Junker v. Med. Components, Inc.*, 25 F.4th 1027, 1032 (Fed. Cir. 2022) (determining whether sales activity concerning a design constituted an on-sale bar to patentability by applying utility patent case law).

6. *See, e.g.*, *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (ruling that the canons of construction governing utility patent claims do not apply with full force to design patents).

7. *See, e.g.*, *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 102 F.4th 1280, 1295 (Fed. Cir. 2024) (en banc) (ruling that design patent obviousness determinations should be based on the factors developed for utility patent obviousness determinations in *Graham v. John*

This Article focuses attention on a different exercise in transplantation that is even more controversial in contemporary design patent litigation: incorporating trademark and unfair competition rules on consumer confusion<sup>8</sup> into design patent law—particularly, into the jurisprudence of design patent infringement.<sup>9</sup> As this Article shows, transplantation of this sort traces to the first Supreme Court decision addressing substantive design patent law, *Gorham Manufacturing Co. v. White*.<sup>10</sup> Today, *Gorham* remains the touchstone for the design patent infringement analysis, and the Court’s decision to assess design patent infringement from the perspective of the “ordinary observer” is one of the defining features of the American design patent system.<sup>11</sup> Indeed, *Gorham* casts a shadow over several other crucial design patent doctrines, including assessments of patentability over the prior art<sup>12</sup> and the analysis of definiteness and adequacy of disclosure in the design patent document.<sup>13</sup>

Yet despite the acknowledged centrality of *Gorham*, modern Federal Circuit cases have usually denied any kinship between design patent infringement law and unfair competition rules. This is not only a deep conceptual problem, but also one with significant

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*Deere Co. of Kansas City*, 383 U.S. 1 (1966)).

8. See GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY 551-52 (6th ed. 2022) (explaining that likelihood of confusion is the core inquiry in modern trademark infringement and unfair competition claims). Product design trade dress is protectable under trademark and unfair competition regimes, and the confusion rule applicable in word mark cases also applies to product design asserted as trade dress. See GRAEME B. DINWOODIE, MARK D. JANIS & JASON J. DU MONT, TRADE DRESS AND DESIGN LAW 41, 212 (2d ed. 2024).

9. Scholars have left the relationship between design patent infringement and unfair competition rules mostly unexplored. The use of trademark distinctiveness concepts to justify the grant of design patent rights has been proposed in Dennis D. Crouch, *A Trademark Justification for Design Patent Rights* 31 (Univ. Mo. Sch. L. Legal Stud. Rsch. Paper, Paper No. 2010-17, 2010) (arguing that design patents can serve as a proxy for trade dress rights); Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 863 (2010) (referring to doctrinal similarities between trademark and design patent); cf. Sarah Fackrell, *The Counterfeit Sham*, 138 HARV. L. REV. 471, 472, 482-84 (2024) (distinguishing counterfeiting from design patent infringement; asserting that design patent infringement does not require consumer confusion).

10. 81 U.S. (14 Wall.) 511 (1871).

11. See, e.g., *Egyptian Goddess*, 543 F.3d at 670.

12. See *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1235, 1239 (Fed. Cir. 2009).

13. See *In re Maatita*, 900 F.3d 1369, 1372, 1376-77 (Fed. Cir. 2018).

practical implications. It has arisen, for example, in the long-running litigation between Columbia and Seirus over designs for heat-reflective material used in cold-weather apparel.<sup>14</sup> There, the accused infringer Seirus had imprinted its logo on the accused design, and the question was whether the jury could take the logo into account in its design patent infringement determination.<sup>15</sup> In its 2019 decision, the Federal Circuit ruled that while design patent infringement should not be avoidable merely by adding a label to an otherwise infringing design, the fact finder should not be precluded from “*considering* an ornamental logo, its placement, and its appearance as one among other potential differences” between the claimed and accused designs.<sup>16</sup> On remand, the trial court instructed the jury to apply the *Gorham* ordinary observer test and added that the jury need not “find that any purchasers were actually deceived or confused by the appearance of the accused products.”<sup>17</sup> Columbia challenged the instruction, arguing that the trial court should have instructed the jury that consumer confusion was altogether irrelevant to design patent infringement.<sup>18</sup> The Federal Circuit upheld the instruction but acknowledged the concern that juries might be “led astray” and “mistakenly conflate” trademark infringement concepts with those of design patent infringement.<sup>19</sup> According to the Federal Circuit, even though “[a]t a surface level, the ordinary-observer test could be read as evoking concepts of consumer confusion as to source,”<sup>20</sup> the fact that consumers might not be confused about a product’s source would not alone preclude an ordinary observer “from deeming the ... *designs* similar enough to constitute design-patent infringement.”<sup>21</sup> Design patent infringement “does not

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14. See *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 80 F.4th 1363 (Fed. Cir. 2023); *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119 (Fed. Cir. 2019).

15. See *Columbia*, 80 F.4th at 1368, 1371-72, 1383-84 (depicting the claimed and accused designs).

16. *Columbia*, 942 F.3d at 1131.

17. *Columbia*, 80 F.4th at 1383 (quoting the relevant instruction).

18. *Id.*

19. *Id.* at 1384.

20. *Id.*

21. *Id.* at 1383.

consider consumer confusion as to source,” the Federal Circuit averred.<sup>22</sup>

Earlier Federal Circuit cases contain similar categorical pronouncements. In *Unette*, the court stated flatly that a “[l]ikelihood of confusion as to the source of the goods is not a necessary or appropriate factor for determining infringement of a design patent” and that adopting a confusion test for design patent infringement “only serves to blur the otherwise clear line that exists between the test for infringement of a design patent and the ‘likelihood of confusion’ test for infringement of a trademark.”<sup>23</sup> In *Braun*, the court declared that “[d]esign patent infringement does not concern itself with the broad issue of consumer behavior in the marketplace.”<sup>24</sup> And, in *L.A. Gear*, the court stated that “[d]esign patent infringement relates solely to the patented design, and does not require proof of unfair competition in the marketplace.”<sup>25</sup>

In this Article, I reevaluate these claims about the relationship between design patent infringement and unfair competition and offer a new approach. My analysis takes as a given the general proposition that design patent law invariably borrows from other intellectual property regimes. Design patent jurisprudence is (and has always been) underdeveloped. And design patent law was originally conceived to be reliant on borrowing from utility patent law.

Accordingly, my focus here is to address two more controversial questions about doctrinal borrowing for design patent law: first, why should design patent law borrow concepts from trademark and unfair competition law?; and, second, how should it go about doing so?

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22. *Id.*

23. *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986).

24. *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992) (citing *Unette*, 785 F.2d at 1029).

25. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1126 (Fed. Cir. 1993) (citing *Unette*, 785 F.2d at 1029). To be sure, these pronouncements in *Braun* and *L.A. Gear* could be explained away as overstatements. In both opinions, the court was simply attempting to make the modest point that the design infringement analysis requires that the claimed design be compared to the accused design. A comparison between the design patent owner’s commercial product and the accused design is only sometimes probative in design patent infringement cases, even though it would generally be probative in a trademark infringement case. Nonetheless, the pronouncements seem to reflect the court’s general views on the relationship between design patent infringement and unfair competition principles.

In Part I, I show that, as a historical matter, the connection between design patent infringement and unfair competition is deep, notwithstanding the Federal Circuit's pronouncements to the contrary. While the *Gorham* opinion taken alone might seem to gesture only superficially to unfair competition law, the case record and other historical sources paint a much different picture: confronted with a stark choice between utility patent infringement concepts and unfair competition law to formulate the test for design patent infringement, the *Gorham* court chose unfair competition law, albeit without clear attribution, thus leaving courts and commentators to speculate about the depth of the relationship ever since.

In the remainder of the Article, I build on this historical analysis to show why and how design patent law should borrow from modern trademark and unfair competition law. I argue that modern unfair competition law has lessons to offer—positive and negative—that could enrich the jurisprudence of design patent infringement. By stubbornly insisting that unfair competition law has little or nothing to say about how we analyze design patent infringement, the Federal Circuit is missing a crucial opportunity for legal innovation. In Part II, I briefly outline modern principles of Lanham Act unfair competition law, showing that the loosely defined passing-off concepts that characterized unfair competition claims at the time of *Gorham* have given way to consumer confusion as the dominant rubric for most modern Lanham Act unfair competition claims today. In Part III, I engage with the factors analysis that is used to test consumer confusion in Lanham Act cases, analyzing whether and how design patent infringement doctrine should be reconfigured to accommodate those factors. The chief normative conclusion is that courts should draw lessons from doctrinal innovations—and missteps—in modern trademark and unfair competition law to reshape and refine design patent infringement law. Doing so should be seen as a step towards using protection against unfair competition as a coherent, animating rationale for vindicating design patent rights.



## I. THE HISTORICAL CASE FOR DESIGN PATENT INFRINGEMENT AS UNFAIR COMPETITION

In prior work, I and others have noted that some of the rhetoric in the *Gorham* opinion is reminiscent of that found in trademark and unfair competition cases.<sup>26</sup> But the prevailing view in the courts is that the connection between design patent infringement and trademark infringement is only superficial, as the Federal Circuit expressed in *Columbia*.<sup>27</sup> However, as I detail in Part I.A, the *Gorham* case record reveals that the unfair competition roots of the *Gorham* decision in fact run very deep, and other sources that fill out the historical context of the case corroborate that conclusion.

### *A. Gorham's Underappreciated Unfair Competition Rhetoric*

In *Gorham v. White*, Gorham was asserting a patent on a design for forks and spoons, a design Gorham had successfully commercialized as the “Cottage” pattern.<sup>28</sup> Judge Blatchford,<sup>29</sup> presiding at trial, found no infringement.<sup>30</sup> The record contained extensive evidence, nearly all in the form of witness testimony taken by

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26. See Du Mont & Janis, *supra* note 2, at 845-46 (addressing the argument that both deal with product differentiation); Mark A. Lemley & Mark P. McKenna, *Design Patents Aren't Patents (And It's a Good Thing Too)*, 92 GEO. WASH. L. REV. 811, 840-41 (2024).

27. See *supra* notes 14-22 and accompanying text.

28. See 81 U.S. (14 Wall.) 511, 512 (1871); U.S. Patent No. D1,440 (issued July 16, 1861).

29. Blatchford was no stranger to patent cases, having already written nearly fifty opinions in patent cases by the end of 1870, the year when he decided the *Gorham* case. A few years after *Gorham* was decided, he was appointed to the Supreme Court. Arnold M. Paul, *Samuel Blatchford*, in 2 THE JUSTICES OF THE UNITED STATES SUPREME COURT: THEIR LIVES AND MAJOR OPINIONS 679 (Leon Friedman & Fred L. Israel eds., 1969). Regarding his views on patents, see Hon. Samuel Blatchford, Assoc. Just., Sup. Ct., A Century of Patent Law, Address at the Celebration of the Beginning of the Second Century of the American Patent System (Apr. 8, 1891) (lauding the patent system). *But cf.* *Dobson v. Dornan*, 118 U.S. 10, 17 (1886); *Dobson v. Hartford Carpet Co.*, 114 U.S. 439, 447 (1885) (awarding nominal damages for design patent infringement).

30. *Gorham Co. v. White*, 10 F. Cas. 827, 830 (C.C.S.D.N.Y. 1870) (No. 5,627). Blatchford also published his own set of case reporters, and his *Gorham* decision was duly reported there as 7 Blatchf. 513.

deposition.<sup>31</sup> Most of the witnesses were tradesmen, including luminaries such as Charles L. Tiffany.<sup>32</sup>

*Gorham* was the first Supreme Court decision on design patents.<sup>33</sup> It arose at a time of existential crisis for the design patent system.<sup>34</sup> According to one contemporaneous account, prior to the *Gorham* decision, the design patent system was regarded as “almost wholly a dead letter”; design patent infringement had become “almost universal,” and “a serious evil, which seemed to threaten the very existence of American design,” because companies could not justify the large up-front investment required to employ design staffs given the widespread incidence of infringement.<sup>35</sup>

In elaborating its test for infringement, the Court in *Gorham* was writing on an almost entirely blank slate. The original design patent provision merely identified the acts that could constitute infringement without specifying a test.<sup>36</sup> Moreover, although the design patent system had been in place for over thirty years,<sup>37</sup> and the U.S. government had issued over four thousand design patents,<sup>38</sup> the lower courts had said practically nothing about design patents, let alone design patent infringement, prior to the trial decision in *Gorham*. An exception was the first reported U.S. design patent decision, *Root v. Ball*.<sup>39</sup> There, the court relied on a “substantially [ ]

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31. See Transcript of Record, *Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511 (1871) (No. 372) [hereinafter *Supreme Court Record*] (listing nearly forty witnesses).

32. See *id.* None of the designers listed on the *Gorham* design patent testified, nor did the designer of the accused products. See *id.*

33. In *Clark v. Bousfield*, the Court mentioned the design patent provisions but concluded that the subject matter at issue fell under the utility patent provisions. 77 U.S. (10 Wall.) 133, 140 (1869).

34. See *United States Supreme Court: An Important Decision Relating to the Future of the Fine Arts*, N.Y. TIMES, Nov. 30, 1872, at 5 [hereinafter *An Important Decision*].

35. *Id.*

36. See Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842) (conferring on the design patent owner “an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold”). This language remained unchanged in the 1861 Act, which applied in *Gorham*. See Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861); cf. Act of July 4, 1836, ch. 357, § 5, 5 Stat. 117, 119 (1836) (likewise leaving the infringement test for judicial elaboration with regard to utility patents).

37. See *Du Mont & Janis*, *supra* note 2, at 869-73 (describing the passage of the 1842 Act).

38. See U.S. Patent No. D4,000 (issued Apr. 26, 1870).

39. See 20 F. Cas. 1157 (C.C.S.D. Ohio 1846) (No. 12,035).

the same appearance” test, which the court purported to derive from utility patent law.<sup>40</sup>

Judge Blatchford’s trial decision on review in *Gorham* embraced utility patent principles even more definitively.<sup>41</sup> Under those principles, infringement would be analyzed from the perspective of one familiar with the art, so it seemed to follow that design patent infringement ought to be carried out from the perspective of a designer, not a mere ordinary observer.<sup>42</sup> According to Judge Blatchford, the test for design patent infringement should be “whether the two designs can be said to be substantially the same, when examined intelligently, side by side.”<sup>43</sup> “Intelligent” examination called for the perspective of a “person versed in the business of designs in the particular trade in question,” Judge Blatchford insisted.<sup>44</sup> Other considerations also informed his view. An ordinary observer test would be too ambiguous, he asserted.<sup>45</sup> Such a test would be problematic because it would not be symmetrical with the patentability test, which used the perspective of a designer.<sup>46</sup> And, perhaps most tellingly, Judge Blatchford haughtily dismissed the

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40. The court reasoned that in a patent infringement case infringement should be found if the defendant “adopt[s] the same principle” as the plaintiff. *Id.* at 1158. For a mechanical invention, the principle was the “combination of mechanical powers which produce a certain result.” *Id.* By analogy, a design involved ornamentation that produced a particular appearance, so one would infringe a design patent by “adopt[ing] the design so as to produce, substantially, the same appearance.” *Id.*

41. *See Gorham Co. v. White*, 10 F. Cas. 827, 830 (C.C.S.D.N.Y. 1870) (No. 5,627) (“The same principles which govern in determining the question of infringement in respect to a patent for an invention connected with the operation of machinery, must govern in determining the question of infringement in respect to a patent for a design.”). Judge Blatchford did not cite the statute, the legislative history, or *Root v. Ball*, but merely declared that “[t]here must be a uniform test, and that test can only be, as in the case of a patent in respect to machinery, substantial identity,” as viewed by persons versed in the art. *Id.*

42. *See id.* at 829 (“It is impossible to assent to the view, that the test, in regard to a patent for a design, is the eye of an ordinary observer.”).

43. *Id.* at 830.

44. *Id.* (describing the person as one “accustomed to compare such designs one with another, and who sees and examines the articles containing them, side by side”).

45. *See id.* at 829 (“The first question that would arise, if [an ordinary observer] test were to be admitted, would be, as to what is meant by ‘an ordinary observer,’ and how he is to exercise his observation.”).

46. According to Judge Blatchford, just as a design should not be found unpatentable merely because a “casual observer[.]” who failed to give “proper attention” might overlook differences between the design and the prior art, a design should not be found infringing merely because the casual observer would ignore differences between the patented and accused designs. *See id.* at 829-30.

ordinary observer's views as "worthless," in that they were surely "casual, heedless and unintelligent."<sup>47</sup>

The *New York Times* later described Judge Blatchford's decision as the death knell for design patents, claiming that design patents would be "of no value" if Judge Blatchford's eyes-of-the-expert test became the prevailing test.<sup>48</sup> The concern was that it would always be easy for a patentee's competitors to vary some details of the patented design and yet still retain the same overall artistic effect.<sup>49</sup>

The Supreme Court shared this sentiment, reversing and explicitly rejecting Judge Blatchford's test.<sup>50</sup> Writing for a 6-3 Court,<sup>51</sup> Associate Justice William Strong<sup>52</sup> adopted similarly apocalyptic language, asserting that adopting Blatchford's test "would destroy all the protection which the act of Congress intended to give. There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them."<sup>53</sup> Justice Strong explicitly rejected Blatchford's eyes-of-the-expert test,<sup>54</sup> ruling that design patent infringement should instead be assessed from the perspective of the ordinary observer:

We hold ... that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are

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47. *Id.* at 830.

48. *See An Important Decision*, *supra* note 34, at 5.

49. *See id.*

50. *See Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528, 531 (1871). The Court handed down its opinion on November 18, 1872. However, the case arose in the December 1871 term, and it was the practice of reporters at the time to list the term date in the citation.

51. Justices Miller, Field, and Bradley dissented without opinion. *Id.* at 531.

52. Although Strong was an experienced lawyer and had served for over a decade on the Supreme Court of Pennsylvania, he had served only a single term on the U.S. Supreme Court as of the time of *Gorham* (having been appointed by President Grant in February 1870) and had written only two utility patent opinions—and no design patent opinions. *See Mowry v. Whitney*, 81 U.S. (14 Wall.) 620, 639 (1871) (utility patent case involving infringement, validity, and damages issues); *R.R. Co. v. Dubois*, 79 U.S. (12 Wall.) 47, 48, 59 (1870) (upholding a utility patent infringement claim in a case involving issues of claim construction, validity, and assorted equitable claims); *William Strong, 1870-1880*, SUPREME CT. HIST. SOC'Y, <https://supremecourthistory.org/associate-justices/william-strong-1870-1880/> [<https://perma.cc/Z864-HHJE>]. In his ten years on the Court, Strong would not draft another design patent opinion.

53. *Gorham*, 81 U.S. at 527.

54. *See id.*

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.<sup>55</sup>

Ordinary observers, Justice Strong elaborated, were “those who buy and use”; they were “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,” and if such observers were “misled[] and induced to purchase what is not the article they supposed it to be,” then the patentees were injured.<sup>56</sup>

To be sure, the *Gorham* opinion does not announce in explicit terms that it is choosing a trademark/unfair competition rule over a utility patent rule of infringement.<sup>57</sup> But a careful study of the context shows that this is exactly what Justice Strong was doing.

First, Justice Strong’s opinion for the Court went beyond merely reversing Blatchford’s judgment—it stated that the Court “cannot concur” with Blatchford’s approach, and Blatchford’s opinion had explicitly chosen a utility patent rule.<sup>58</sup> Second, the parties’ briefs make plain that both sides saw the case in quite stark terms as a choice between the utility patent infringement rule and a trademark/unfair competition rule. *Gorham*’s brief asserted that design

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55. *Id.* at 528.

56. *Id.*

57. Neither party seems to have argued that the case turned on the statute’s incorporation clause. The Court seems to have assumed that provisions of the 1861 Act, which applied to the *Gorham* patent, “re-enact[ed] in substance the same things apparently” as covered in the 1842 Act, which would have included the incorporation clause. *Id.* at 512 (reporter’s note); see Brief for Appellee at 6, *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871) (No. 168) [hereinafter *White’s Brief*] (“The Act of 1861 did not alter the law from what it previously was, in any respect material to the subject-matter of the patent [in suit].”). In fact, that language did not appear in the 1861 Act, but was reinstated in the 1870 Act, suggesting, perhaps, that its omission was a mistake. Act of July 8, 1870, ch. 230, § 76, 16 Stat. 198, 210 (1870) (“[A]ll the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs.”). In any event, the clause called for the incorporation of “regulations and provisions,” Act of Aug. 29, 1842, ch. 283, § 3, 5 Stat. 543, 544 (1842) (“[A]ll the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.”), and it is reasonable to assume that the parties did not believe that the incorporation clause reached judicially-crafted rules.

58. See *Gorham*, 81 U.S. at 527.

patent infringement should be analogized to trademark infringement (or, presumably, unfair competition).<sup>59</sup> Accordingly, Gorham proposed a test that borrowed concepts of the ordinary purchaser and deception from American and British trademark/unfair competition cases.<sup>60</sup> Under Gorham's proposed standard, "if the defendant's spoons and forks are so close an imitation of plaintiffs' design, that purchasers will mistake the one for the other, it must be for the reason that the configuration and of ornamentation the two are substantially alike."<sup>61</sup> Gorham's brief reasoned that because the beauty of the designs was intended to induce purchasers, purchasers should be the judges of infringement.<sup>62</sup>

By contrast, White's brief expressly called for the utility patent infringement test to carry over to design patent infringement.<sup>63</sup> It also attacked the idea of deriving a test from trademark law, chiefly on the ground that trademark subject matter was not sufficiently similar to design subject matter.<sup>64</sup> As White saw it, a design was more akin to an invention because neither served as indicators of origin.<sup>65</sup> According to this argument, whereas a trademark was a sign placed on an article to indicate "origin or ownership," a design,

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59. See Brief for Appellant at 20-21, *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871) (No. 168) [hereinafter *Gorham's Brief*]. The brief also mentioned copyright but suggested that copyright provided "[a] less complete analogy." See *id.* at 22-23 (mentioning but rejecting an analogy between design patent and copyright).

60. *Id.* at 21; see, e.g., *Walton v. Crowley*, 29 F. Cas. 138, 140 (C.C.S.D.N.Y. 1856) (No. 17,133) ("A tradesman, to bring his privilege of using a particular mark under the protection of equity, is not bound to prove that it has been copied in every particular by another. It is enough for him to show that the representations employed bear such resemblance to his as to be calculated to mislead the public generally who are purchasers of the article, and to make it pass with them for the one sold by him.")

61. *Gorham's Brief*, *supra* note 59, at 19.

62. See *id.* The brief also laid out a public goods argument. See *id.* at 24 (asserting that beauty of design is important in the sale of cutlery, a very small percentage of newly introduced designs succeed, and introducing a new design is expensive (\$3,000 or more, although this seems to include dies and tools that would be needed to manufacture, not just the expense entailed in creating a prototype design)).

63. See *White's Brief*, *supra* note 57, at 5, 7 ("In determining the question of infringement of a patent for a design, the same principles and rules must be applied as are applicable in determining the question of infringement of a patent for a combination in machinery."); see also *id.* at 7-8 (asserting that a patent for a design must be governed by the law of patents, and a designer who invokes the design patent law voluntarily submits to be bound by the patent law).

64. See *id.* at 45.

65. See *id.* at 47.

by contrast “becomes, and is, a part of the article itself, it is incorporated with the article, and is bought and sold and used as a part of the article just as much as if it were a new mechanical combination.”<sup>66</sup> That is, a trademark did not alter the character of a seller’s product, while a design did.<sup>67</sup> This was a dubious argument. Surface ornamentation was a statutorily authorized form of design patent subject matter,<sup>68</sup> and such ornamentation does not necessarily alter the associated product any more profoundly than would affixing a word or logo to the product.

Last, and perhaps most compelling, Justice Strong surely thought that the language he used in the opinion sent a clear signal that the design patent infringement rule had roots in unfair competition law. Earlier in that same term he had written a trademark law opinion, *Canal Co. v. Clark*,<sup>69</sup> in which he explained the test for liability as follows:

[In] all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another.... [T]he custom and advantages to which the enterprise and skill of the first appropriator had given him a just right are abstracted for another’s use, and this is done by deceiving the public, by inducing the public to purchase the goods and manufactures of one person supposing them to be those of another.<sup>70</sup>

Justice Strong lifted the deception/inducement language from his *Canal Co.* opinion and inserted it nearly without change in *Gorham*.<sup>71</sup> Moreover, one of the cases that Justice Strong cited in *Canal*

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66. *Id.*

67. *See id.*

68. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544.

69. 80 U.S. (13 Wall.) 311, 328 (1871) (upholding the denial of trademark protection for the term “Lackawanna” used in connection with coal that had been mined in the Lackawanna region of Pennsylvania).

70. *Id.* at 322-23.

71. *See Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871). Given his use of the *Canal Co.* rhetoric in a design patent case, it is curious that in *Canal Co.* itself, Justice Strong distinguished trademarks from patents and copyrights, asserting that “[p]roperty in a trademark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights, or in patents for inventions,” because trademark rights could be

Co. included the “attention” language that made its way into the *Gorham* standard.<sup>72</sup>

A news report appearing in the *New York Times* dispensed with any pretense of objectivity in describing the decision. *Gorham* “carried on this good fight for art and their rights for six years ... and the decision of the Supreme Court ha[d] at last crowned their courage and endurance with brilliant triumph.”<sup>73</sup> The Court “lent a valuable impulse to the artistic culture of the country,” and “rendered signal and important service to the progress of the fine arts” by construing the design patent law “in such manner as to give practical protection to the designer.”<sup>74</sup> “The value of ... this decision to the artistic progress of the country can scarcely be over-rated,” the story announced.<sup>75</sup>

Florid prose aside, the news story proved prescient as to the importance of *Gorham* to design patent law while also unwittingly reflecting confusion about whether the *Gorham* test had borrowed from patent law.<sup>76</sup> Indeed, a few other post-*Gorham* cases and commentary display confusion about, or perhaps resistance to, the idea that the *Gorham* test differed from the utility patent infringement test. For example, one trial court asserted that “[s]peaking in the general sense, it is doubtless true that the test of infringement, in respect to the claims of a design patent, is the same as in respect to a patent for an art, machine, manufacture, or composition of matter,”<sup>77</sup> although the court proceeded to invoke *Gorham* correctly.<sup>78</sup>

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established in words that were in common use, whereas the patent system required novelty. *Canal Co.*, 80 U.S. at 322. Strong was attempting to explain how “[w]ords in common use” could qualify as a trademark even if they lacked the originality or novelty to qualify for copyrights or patents. *Id.*

72. See *Canal Co.*, 80 U.S. at 322, 323 n.14 (citing, inter alia, *Boardman v. Meriden Britannia Co.*, 35 Conn. 402, 413 (1868)). In *Boardman v. Meriden Britannia Co.*, the Court asserted that “[i]t must appear that the ordinary mass of purchasers, paying that attention which such persons usually give when buying the article in question, would probably be deceived.” 35 Conn. at 413 (quoting *Partridge v. Menck*, 2 Sand. Ch. 622 (N.Y. Ch. 1847)).

73. See *An Important Decision*, supra note 34, at 5.

74. *Id.*

75. *Id.*

76. See *id.* (“Inventors of designs now stand on the same level with inventors of machines.”).

77. *Miller v. Smith*, 5 F. 359, 365 (C.C.D.R.I. 1880).

78. See *id.* (“[I]t is not essential to the identity of the design that it should be the same to



William Robinson's influential commentary carried the confusion even further. Echoing arguments from White's brief, Robinson flatly rejected the trademark analogy, insisting that while the *Gorham* court "seem[ed] to regard a design as subject to very much the same rule as a trade-mark ... in all its essential characteristics it is entirely different."<sup>79</sup> Similar to Judge Blatchford in the trial decision, Robinson saw the ordinary observer rule as overly generous to patentees and therefore "not in harmony with the spirit of the age or of the law which represents it."<sup>80</sup> The rule might be satisfactory for "[s]imple designs" such as silverware patterns, "[b]ut the triumphs of a higher art demand for their discrimination a more experienced and cultured eye," and thus the *Gorham* court should have limited its rule to only those simple designs.<sup>81</sup> After all, Robinson asserted, "[a] design is a work of art, a thing of beauty; and shades of difference, wholly imperceptible to the uneducated eye, may have required for their creation a high degree of inventive skill, and in the opinion of any competent observer may constitute entirely separate designs."<sup>82</sup> Robinson's remarks should be treated as wishful (and perhaps also elitist) thinking; they do not square with the historical record. Yet, they remain relevant, given the now well-engrained judicial habit of foreswearing the connection between design patent infringement law and unfair competition law that *Gorham* forged.

### *B. Unfair Competition Evidence in Gorham*

Having invoked unfair competition rhetoric in announcing the rule for design patent infringement, did *Gorham* in fact apply unfair competition principles in analyzing infringement? The opinion is frustratingly silent, but the case record, viewed in light of historical

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the eye of an expert.").

79. 1 WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* 290 n.1 (1890). According to Robinson, it was "not the primary object of a design, in the eye of the law at least, to distinguish one class of goods, ... from others; for a design is the same invention, to whatever substance it may be applied," and it was the appearance so imparted that was the subject of a design patent. *Id.*

80. *Id.*

81. *Id.*

82. *Id.*

evidence of the contemporary commercial context, furnishes some clues.

At the time of *Gorham*, rights in product designs could be vindicated via an action to prohibit “passing-off,” a type of unfair competition action.<sup>83</sup> Justice Strong’s *Canal Co.* case—from which he borrowed the critical language for use in *Gorham*—is best understood as a passing-off case,<sup>84</sup> even though the Court blended in some trademark rhetoric in the key passage laying out the test for liability.<sup>85</sup> A passing-off claim typically required evidence that the symbol at issue embodied the plaintiff’s goodwill or reputation (and, usually, that it had attained secondary meaning or was even “well-known”)<sup>86</sup> and that the defendant appropriated the symbol with an intent to deceive consumers, taking advantage of the plaintiff’s goodwill or reputation with the goal of diverting trade from the plaintiff.<sup>87</sup> Plaintiffs in passing-off cases could offer an

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83. See Robert G. Bone, *Rights and Remedies in Trademark Law: The Curious Distinction Between Trademark Infringement and Unfair Competition*, 98 TEX. L. REV. 1187, 1192-93 (2020); see also 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 4:3 (5th ed. 2024) (noting that at the time, trademark infringement actions were limited to cases involving “technical trademarks,” which did not include product design).

84. The mark at issue was not a technical trademark; it described the geographic origin of the plaintiff’s goods. See *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 324-25 (1871).

85. See *id.* at 322 (referring to cases “where rights to the exclusive use of a trade-mark are invaded”). It was not unusual for courts to use the rhetoric of unfair competition and trademark infringement interchangeably. See 1 MCCARTHY, *supra* note 83, § 4:4.

86. See, e.g., *R.W. Rogers Co. v. Wm. Rogers Mfg. Co.*, 70 F. 1017, 1018 (2d Cir. 1895) (noting, in a trademark case involving plated tableware, that the plaintiff’s goods were “well-known” and that the defendant had used a similar name “for the purpose of surreptitiously obtaining the advantage of the good reputation” the plaintiff and its predecessors had established); see also *Developments in the Law—Competitive Torts*, 77 HARV. L. REV. 888, 912 (1964) (observing that in cases involving passing off through product simulation, courts in the early twentieth century looked for evidence that the products were “well known,” presaging a debate later in the twentieth century about whether product design trade dress should be subject to a blanket requirement for secondary meaning).

87. Bone, *supra* note 83, at 1193; *Lawrence Mfg. Co. v. Tenn. Mfg. Co.*, 138 U.S. 537, 549 (1891) (“[U]nfair and fraudulent competition against the business of the plaintiff—conducted with the intent, on the part of the defendant, to avail itself of the reputation of the plaintiff to palm off its goods as plaintiff’s—would, in a proper case, constitute ground for relief.”). For some courts, the key question was whether the defendant had made a false representation, not necessarily whether consumers were deceived. See *Amoskeag Mfg. Co. v. Spear & Ripley*, 2 Sand. 599, 607 (N.Y. Super. Ct. 1849). Justice Strong cited *Amoskeag Mfg. Co. v. Spear & Ripley* in his *Canal Co.* opinion. 80 U.S. at 323 n.14 (1871); see also *Borden Ice Cream Co. v. Borden’s Condensed Milk Co.*, 201 F. 510, 513 (7th Cir. 1912) (stating that “whether the public is likely to be deceived as to the maker or seller of the goods ... is not the fundamental

affirmative showing of fraudulent intent, or could argue that intent should be inferred from the circumstances,<sup>88</sup> such as circumstances evidencing intentional copying. Accordingly, one way to assess whether the *Gorham* decision (mostly *sub silentio*) applied unfair competition principles is to ask whether the record contains evidence that would have supported the elements of a passing-off claim.

First, the record revealed abundant evidence of goodwill inhering in Gorham's design. By the time of the *Gorham* litigation, the Gorham firm was America's preeminent silver manufacturer, especially in luxury silver flatware.<sup>89</sup> Gorham silver could be found in the most prominent of American residences, including the White House.<sup>90</sup> Moreover, the particular design covered by the patent at issue in *Gorham*, the "Cottage" pattern, was "one of the most popular patterns that has ever been made," one witness testified, opining that in the two years prior to the lawsuit, more flatware bearing the Cottage design had been sold than "any new design previously introduced."<sup>91</sup> The celebrated jeweler Theodore B. Starr testified that the value of the Cottage pattern was worth "fifty thousand dollars."<sup>92</sup>

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question" in passing-off cases; rather, the question is whether the deception injured the mark owner by diverting sales to the defendant (emphasis added)).

88. JAMES LOVE HOPKINS, *THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION* 257 (2d ed. 1905).

89. See, e.g., William C. Conant, *The Silver Age*, 9 SCRIBNER'S MONTHLY 193, 201 (1874) ("[T]he Gorham Company and the brilliant cluster of artists it includes ... made this a memorable decade to the future historian of art.... [T]here has been hardly a dealer of importance in America who has not depended chiefly on the Gorham Company for first-class silver ware."); see also Supreme Court Record, *supra* note 31, at 68 (testimony of Philo B. Gilbert) (admitting on cross-examination that Gorham's reputation for silver designs was "[t]he best in the country").

90. See, e.g., *Mary Lincoln's Silver Service*, NAT'L MUSEUM AM. HIST., [https://americanhistory.si.edu/collections/object/nmah\\_1359397](https://americanhistory.si.edu/collections/object/nmah_1359397) [<https://perma.cc/5QZT-GSCY>] (picturing silver service dating back to the early 1860s in the collection of the National Museum of American History, Smithsonian Institution).

91. Supreme Court Record, *supra* note 31, at 42 (testimony of James A. Hayden). Another witness called it "the most successful plain pattern that has ever been made." *Id.* at 36 (testimony of Joseph T. Bailey).

92. *Id.* at 18 (testimony of Theodore B. Starr); see *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 512 n.3 (1871) (reporter's notes referring to this testimony). Moreover, Gorham may have been seeking to extract returns from the Cottage pattern while its popularity lasted, as consumer tastes were already beginning to turn away from neoclassical designs toward the more intricately ornamented patterns that came into vogue in the Victorian era. See CHARLES

Design was the key contributor to product value in the silverware business.<sup>93</sup> The sale of silverware “depends entirely on the beauty and fitness of the design,” said Gorham’s witnesses;<sup>94</sup> the design was the most important element in the sale of flatware (other than the skill of the salesman).<sup>95</sup> Moreover, the up-front investments in producing new designs were considerable.<sup>96</sup> It was expensive to employ designers and to create the dies needed to produce new designs,<sup>97</sup> and investing in new designs was risky; as few as one in forty or fifty designs succeeded to the extent that the Cottage design had, according to the testimony.<sup>98</sup>

Second, there was arguably strong evidence of intentional copying of designs to support an inference of fraudulent intent. Gorham’s brief to the Supreme Court argued that the alleged infringer had copied the Cottage pattern,<sup>99</sup> and Gorham presented extensive witness testimony to substantiate this allegation.<sup>100</sup> The Court took

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H. CARPENTER, JR., *GORHAM SILVER 1831-1981*, at 3-4 (1982).

93. Gorham owned a substantial design patent portfolio on silverware designs by the time *Gorham Co. v. White* was litigated. See generally Sarah E. Fensom, *Gorham Silver: The Shining*, ART & ANTIQUES, <https://www.artandantiquesmag.com/gorham-silver/> [https://perma.cc/QMT2-5T9M].

94. Supreme Court Record, *supra* note 31, at 10 (testimony of Edward C. Moore); see also *id.* at 35 (testimony of Joseph T. Bailey) (stating that the sale depends on the pattern); *id.* at 21 (testimony of Edward T. Haughwout) (“[T]he character of designs [is] a very important matter in the selling of goods.”).

95. *Id.* at 18-19 (testimony of Theodore B. Starr).

96. Gorham had pioneered the use of steam-driven drop presses to mechanize the production of silver flatware on a large scale. Gorham employed a corps of designers to carve new designs into steel dies, and the dies were fitted into the presses, which stamped the patterns onto products. See CARPENTER, *supra* note 92, at 13, 38-39.

97. Supreme Court Record, *supra* note 31, at 28 (testimony of Alfred Brabrook) (stating that the value of a successful design is that it avoids the necessity of “getting up a new pattern,” which entails “great expense”); *id.* at 12 (testimony of Charles T. Cook) (stating that the expense in producing saleable silverware lies in “employing skillful designers, who make a number of elegant designs” and the expense of tooling to manufacture a new design could amount to several hundred dollars for each new design).

98. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 512 n.3 (1871) (reporter’s notes); Gorham’s Brief, *supra* note 59, at 24 (summarizing these points and the supporting testimony).

99. Gorham’s Brief, *supra* note 59, at 12 (asserting that even though the designs are not identical, they are “calculated to deceive the unwary, or persons moderately skilled in the article, and to injure the sale of the plaintiff’s goods” (quoting *Crawshay v. Thompson* (1842) 134 Eng. Rep. 146, 149; 4 Man. & G. 357, 363)).

100. Witnesses testified that the Rogers & Bros. product was intended to imitate the patented Cottage design, Supreme Court Record, *supra* note 31, at 36 (testimony of Joseph

note. Justice Strong's opinion reported that according to some witnesses, "the White designs were intended to imitate" Gorham's patented design,<sup>101</sup> leading to the conclusion that the respective designs "would pass for the same thing" and were "so much alike that even persons in the trade would be in danger of being deceived."<sup>102</sup> The Court credited Gorham's evidence that "seven out of ten customers who buy silverware would consider [the parties' respective designs] the same."<sup>103</sup> Even if the defendant's product was not literally "struck from the same die" as plaintiff's, the defendant's product was sufficiently similar in "configuration," "general aspect," or "general appearance and effect" to trigger liability because it would deceive the market.<sup>104</sup>

The copying allegations tied into a broader problem in the silverware industry. The allegedly infringing products were not solid silver—they were electroplated.<sup>105</sup> The products were made by Rogers & Bros., the nation's largest manufacturer of plated flatware.<sup>106</sup> According to two leading historians, the practice of copying

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T. Bailey, that it was "calculated to deceive any one but an expert," *id.* at 14 (testimony of Egbert W. Sperry), and that it was copied from the patented design and then altered slightly to make it look "less like the Cottage pattern," *id.* at 32 (testimony of James H. Whitehouse). One witness claimed that someone from Rogers & Bros. had tried to buy a Gorham piece from him for the evident purpose of copying it. *Id.* at 39 (testimony of Henry D. Morse). It is not clear from the record whether that Gorham product was the Cottage pattern.

101. *Gorham*, 81 U.S. at 530.

102. *Id.* at 531.

103. *Id.* at 530.

104. *Id.* at 531; *see also id.* at 530-31 (asserting that even the defendant's witnesses could identify only "minor differences in the ornamentation," not sufficiently significant visually to attract the notice of "ordinary purchasers, or even persons in the trade"). Even Judge Blatchford in the case below had acknowledged that the testimony in the record established that the accused designs "were intended to appear, to be the same [as the patented design] to an ordinary purchaser, and will so appear to him." *Gorham Co. v. White*, 10 F. Cas. 827, 830 (C.C.S.D.N.Y. 1870) (No. 5,627).

105. Electroplating is a process that involves passing an electric current through a liquid bath containing dissolved metal ions, causing them to form a metal coating on a substrate. FREDERICK A. LOWENHEIM, *ELECTROPLATING: FUNDAMENTALS OF SURFACE FINISHING* 5-7 (Jeremy Robinson & Ruth Weine eds., 1978).

106. *See* Supreme Court Record, *supra* note 31, at 14 (testimony of Egbert W. Sperry). The nominal defendant, George C. White, was a sales agent for Rogers & Bros. *Id.* at 5 (testimony of George C. White). The Rogers brothers had been selling silver-plated tableware since the 1840s. DOROTHY T. RAINWATER & DONNA FELGER, *AMERICAN SILVERPLATE* 22 (rev. 3d ed. 2000); *see also* DOROTHY RAINWATER & JUDY REDFIELD, *ENCYCLOPEDIA OF AMERICAN SILVER MANUFACTURERS* 273 (4th ed. 1998) (describing the many Rogers partnerships that formed, dissolved, and recombined during the mid-1800s).

designs from the solid silver manufacturers became widespread among platers.<sup>107</sup>

According to Gorham, these copying practices were seriously undermining sales of solid silver goods.<sup>108</sup> Indeed, Gorham alleged that the copying by Rogers & Bros. had resulted in a substantial diversion of sales of the Cottage pattern.<sup>109</sup>

Gorham also sought to prove reputational injury through the rhetoric of disparagement. A Gorham witness testified that an unauthorized imitation of solid silver goods in plate “disparages” the trade, causing the market to “look upon the pattern as of little value, considering the deception which can easily be practiced on unsuspecting parties.”<sup>110</sup> However, the Court’s opinion did not explicitly take up the this argument.

In sum, a synthesis of the *Gorham* record and additional historical sources help fill out the relatively terse language of the Court’s opinion. The record contains an abundance of evidence that would

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107. RAINWATER & FELGER, *supra* note 106, at 450 (“There was much copying and near-copying of designs, especially the copying of favorite sterling patterns in silverplate.”).

108. Charles L. Tiffany testified that imitation of a luxury silver flatware pattern in plate would “very seriously injure” sales of the silver pattern or perhaps even “render the silver pattern entirely worthless.” Supreme Court Record, *supra* note 31, at 44 (testimony of Charles L. Tiffany); *see also id.* at 37 (testimony of Henry D. Morse, Tiffany’s associate) (stating that the imitation of a popular silver pattern in plated wares would “nearly, if not entirely, ruin the sale of the silver goods”); *id.* at 35 (testimony of Joseph T. Bailey, Philadelphia jeweler) (stating that if a pattern was available in plated silverware, it would “seriously affect the sale of the silver goods of the same pattern”). Platers could sell at relatively low prices because a plating operation required only minimal capital investment. RAINWATER & FELGER, *supra* note 106, at 35-36. Even some of the defendant’s witnesses conceded that sales of plated goods could erode the sales of sold silver goods in the same pattern over time. Supreme Court Record, *supra* note 31, at 60 (testimony of Francis W. Cooper); *see also id.* at 68 (cross-examination of Philo B. Gilbert).

109. Gorham’s Brief, *supra* note 59, at 25 (arguing that this case was one of “peculiar hardship” because the defendants were making their design in plate and diverting sales from plaintiff’s silver product). A Gorham sales agent testified that his customers (flatware retailers) complained that the Cottage pattern had been “copied in plate” such that “[i]t’s no use for me to keep this pattern in silver [when] I can buy it so much cheaper in plate.” Supreme Court Record, *supra* note 31, at 26 (testimony of George B. Tobey stating that the customers observed that “it is a shame” that Gorham could not get the benefit of its efforts in designing the Cottage pattern because of the copying).

110. Supreme Court Record, *supra* note 31, at 19 (testimony of Theodore B. Starr). Platers could hold down their raw materials costs by minimizing the thickness of the silver coating they applied to their products, which compromised product quality, but not in a way that consumers could detect at the time of purchase. *See generally* LOWENHEIM, *supra* note 105, at 188.

have supported a passing-off claim, and there are some indications that the Court engaged with that evidence.<sup>111</sup>

## II. THE MODERN LEGAL LANDSCAPE: DESIGN PATENT INFRINGEMENT AND UNFAIR COMPETITION

I now pivot to the modern jurisprudence. In this Part, as a first step towards asking how unfair competition law could inform design patent infringement law today, I give a brief account of the place of *Gorham* in the modern design patent infringement analysis, and I summarize how unfair competition law has developed since the time of *Gorham*.

### A. *Elements of the Modern Design Patent Infringement Analysis*

The *Gorham* ordinary observer test remains the core inquiry in modern design patent infringement law,<sup>112</sup> although it is now embedded as part of an infringement test that is more formalized than it was at the time of *Gorham*. The first step is to construe the design patent claims, although this may simply entail reviewing the drawings.<sup>113</sup> As part of this threshold exercise, the court may also “usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim.”<sup>114</sup> Included among these issues are, inter alia, “assessing and describing the effect of any

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111. To be fair, the Court’s rhetoric also mixes in some stray utility patent concepts. *See, e.g., Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 530 (1871) (asking rhetorically whether the accused design “work[s] the same result in the same way, and is ... therefore, a colorable evasion of the prior patent, amounting at most to a mere equivalent?”); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 344 (1854) (using similar language in connection with a utility patent infringement test currently denominated infringement under the doctrine of equivalents).

112. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (rejecting the “point of novelty” test and holding, “in accordance with *Gorham* and subsequent decisions ... that the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed”). This is so even though utility patent infringement rules now operate within a formal structure that was not explicit at the time of *Gorham*. In particular, the courts have (1) segregated claim construction as a threshold step, (2) recognized separate claims of literal infringement and infringement under the doctrine of equivalents, and (3) employed an all-elements test for both types of infringement claims. *See generally* PATENT LAW: AN OPEN-SOURCE CASEBOOK 621-22, 654 (Mark Janis & Ted Sichelman eds., 2023).

113. *See Egyptian Goddess*, 543 F.3d at 679-80 (discouraging the practice of translating design patent drawings into words as part of a claim construction exercise).

114. *Id.* at 680.

representations that may have been made in the course of the prosecution history” and “distinguishing between those features of the claimed design that are ornamental and those that are purely functional.”<sup>115</sup> More recent case law indicates that identifying the article of manufacture with which the design is associated appears to be another threshold step.<sup>116</sup>

Once past these threshold matters, the court compares the patented and accused designs. Here, the modern cases permit the court to conclude that the patented and accused designs are “plainly dissimilar” such that no detailed *Gorham* ordinary observer analysis need be done.<sup>117</sup> If the court does reach the ordinary observer analysis, the modern approach permits the accused infringer to offer “comparison prior art,” in recognition of the current view that in some cases “resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art.”<sup>118</sup> Still, when these complexities are pared away, the *Gorham* ordinary observer test remains at the heart of the analysis.

### *B. The Modern Legal Landscape of Unfair Competition Law*

The legal landscape of unfair competition law has changed dramatically since the time of *Gorham*. First, when *Gorham* was decided, unfair competition law was the dominant framework, and trademark law was conventionally understood as a limited subset of unfair competition law.<sup>119</sup> By contrast, in modern U.S. practice, trademark law has expanded to the point of largely merging with unfair competition law.<sup>120</sup> Even by the time of the Lanham Act of 1946, Congress took the view that there was “no essential difference between trade-mark infringement and what is loosely called unfair

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115. *Id.*

116. *See infra* Part III.C.

117. *Egyptian Goddess*, 543 F.3d at 678.

118. *Id.*

119. *See* Mark P. McKenna, *Property and Equity in Trademark Law*, 23 MARQ. INTELL. PROP. L. REV. 117, 122 (2019).

120. *See, e.g., id.* at 118, 135 (describing this “assimilation” and analyzing its consequences).



competition.”<sup>121</sup> Today, federal unfair competition claims are vindicated through section 43(a) of the Lanham Act,<sup>122</sup> which has been characterized as a partial implementation of the pre-*Erie* federal common law of unfair competition.<sup>123</sup> A typical section 43(a) unfair competition claim closely tracks the elements of a trademark infringement claim, except that it involves unregistered rights.<sup>124</sup>

Second, at the time of *Gorham*, passing-off was a typical rubric for framing an unfair competition or trademark infringement claim,<sup>125</sup> whereas today, the dominant framework is the likelihood of consumer confusion. Some consider the latter a synonym of the former.<sup>126</sup>

Third, notions of likely confusion, whether deployed in a trademark infringement or section 43(a) unfair competition claim, have themselves evolved considerably in several ways that are relevant for this project. For starters, modern enunciations of confusion are not limited to source confusion.<sup>127</sup> The text of section 43(a), as revised in 1989, reflects this shift: a section 43(a) unfair competition claim may arise when the defendant’s activity “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association” of the defendant with the plaintiff.<sup>128</sup> The

121. S. REP. NO. 79-1333, at 4 (1946).

122. 15 U.S.C. § 1125(a).

123. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 29 (2003) (citing 4 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION, § 27:7 (4th ed. 2002)).

124. DINWOODIE & JANIS, *supra* note 8, at 34 n.6; 4 MCCARTHY, *supra* note 83, § 27:13 (outlining the elements of a typical claim under section 43(a) for infringement of unregistered marks).

125. See *supra* note 83 and accompanying text.

126. See, e.g., 3 MCCARTHY, *supra* note 83, § 25:2 (acknowledging, however, that passing-off claims seemed more concerned with the defendant’s intent to cause confusion rather than consumers’ probable perceptions). Other claims that might be understood as springing from common law unfair competition principles have been separately codified, among them anti-dilution and counterfeiting claims. DINWOODIE & JANIS, *supra* note 8, at 695-728 (discussing anti-dilution claims); *id.* at 1057-62 (discussing anti-counterfeiting claims).

127. See, e.g., *Int’l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153, 162 (2d Cir. 2016) (“[O]ur case law demonstrates that consumer confusion is plainly not limited to source confusion.”); *Team Tires Plus, Ltd. v. Tires Plus, Inc.*, 394 F.3d 831, 835 (10th Cir. 2005) (“[T]he relevant confusion under trademark law is not limited to confusion of consumers as to the source of the goods, but also includes confusion as to sponsorship or affiliation.”); cf. Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 427 (2010) (arguing that confusion as to sponsorship or affiliation should be relegated to the law of false advertising).

128. 15 U.S.C. § 1125(a).

Federal Circuit's discussion in *Columbia*, juxtaposing design patent infringement against source confusion,<sup>129</sup> is wrong to the extent that it fails to account for the full scope of modern confusion analysis.

Modern courts generally analyze the likelihood of confusion by applying a multi-factor test.<sup>130</sup> Courts developed those tests over time, starting in earnest a few decades after *Gorham* and continuing well into the twentieth century.<sup>131</sup> The multi-factor tests originated from trademark infringement actions but today are also applied in section 43(a) unfair competition actions involving unregistered marks.<sup>132</sup> Thus, if, as I suggest, modern unfair competition law has something to say to design patent law, one obvious way for the conversation to proceed is through the language of the multi-factor test.<sup>133</sup> I take up that task in Part III.

### III. DEVELOPING UNFAIR COMPETITION SUBTESTS FOR ANALYZING DESIGN PATENT INFRINGEMENT

In this Part, I analyze how contemporary unfair competition law might inform design patent infringement law. I do so by examining

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129. See *supra* notes 19-22 and accompanying text.

130. DINWOODIE & JANIS, *supra* note 8, at 583-85 (table listing multi-factor tests circuit by circuit).

131. Robert G. Bone, *Taking the Confusion out of "Likelihood of Confusion": Toward a More Sensible Approach to Trademark Infringement*, 106 NW. U. L. REV. 1307, 1316-34 (2012) (tracing the history of tests through the courts).

132. See, e.g., *New W. Corp. v. NYM Co. Cal., Inc.*, 595 F.2d 1194, 1201 (9th Cir. 1979).

133. It has been suggested that *Gorham* establishes "a test of visual similarity, not a test of actual or likely consumer confusion." Fackrell, *supra* note 9, at 482. But that is a false dichotomy. The *Gorham* test, in fact, is a bit of both. Even if we were to ignore the *Gorham* case record and historical context, the language of the *Gorham* test tells us as much. It speaks of substantial similarity, but it adds that the similarity must rise to a level that would induce an ordinary observer to purchase the alleged infringing design supposing it to be the patented design. See *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871). The factors tests for likely confusion, and the subsidiary rules that have sprung from those tests, are relevant for design patent purposes to the extent that they inform whether the similarity between patented and accused designs would indeed be sufficient to induce a mistaken purchase. To put it another way, in design patent infringement, evidence of likely confusion could be useful to serve the ultimate purpose of showing the requisite degree of similarity. The rules for testing confusion evidence thus ought to be plumbed for lessons that might inform the law of design patent infringement. The fact that those rules serve an arguably different purpose in trademark law (namely, to show likely confusion) merely counsels for caution in this exercise. It does not establish that the law of trademark infringement must be discarded as irrelevant in addressing design patent infringement.

individual factors from the likelihood-of-confusion factors test—and the jurisprudence that has accumulated around those factors—and identifying lessons, both positive and negative, that design patent law might take away.

I am approaching the analysis at the level of individual confusion factors because I do not favor urging the Federal Circuit simply to transplant the multi-factor test *in toto* into design patent infringement law. That approach is too blunt. It would give too little credence to the long-running debate about the difficulty of administering the multi-factor test as a whole<sup>134</sup> and to the deeper normative debate over restructuring the test entirely.<sup>135</sup> It also might incorrectly imply that courts treat the test as a “rote checklist” or that considering each factor is mandatory, when in fact there are many

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134. For just one of many such arguments, see Robert G. Bone, *Notice Failure and Defenses in Trademark Law*, 96 B.U. L. REV. 1245, 1255 (2016) (criticizing the vagueness of the likelihood-of-confusion test). The debate over whether the confusion test is amenable to summary resolution also hints at difficulties in administrability. *See, e.g.*, *All. for Good Gov't v. Coal. for Better Gov't*, 901 F.3d 498, 513 (5th Cir. 2018) (upholding a grant of summary judgment of infringement and commenting that summary judgment was permissible even though not every confusion factor pointed in favor of the mark owner). *But cf.* *Rearden LLC v. Rearden Com., Inc.*, 683 F.3d 1190, 1210 (9th Cir. 2012) (stating that summary judgment on likelihood of confusion grounds is “disfavored”).

135. *See, e.g.*, Bone, *supra* note 131, at 1378 (suggesting the disaggregation of moral and economic justifications underlying the test, and further subdividing the economic analysis between the probability of confusion and the cognizable harm from confusion).

judicial statements to the contrary<sup>136</sup> along with empirical studies confirming that the factors are not all coequal in practice.<sup>137</sup>

### A. *Refining the Substantial Similarity Inquiry*

One of the most important lessons that design patent law could take from trademark infringement jurisprudence is that the crucial inquiry into substantial similarity ought not be a mechanical exercise but rather should incorporate contextual considerations that would illuminate how a hypothetical ordinary observer would encounter the patented and accused designs. Two related doctrinal issues from trademark law illustrate the point: whether the similarity analysis should be confined to a side-by-side comparison of the protected and accused subject matter, and whether the similarity analysis (and, indeed, the entirety of the liability analysis) should be confined to the point of purchase.

#### 1. *Side-by-Side Similarity*

To start a utility patent infringement analysis, one creates a claim chart laying out the protected subject matter (represented by

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136. See, e.g., *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1145, 1149 (9th Cir. 2011) (noting that the factors are “intended as an adaptable proxy for consumer confusion, not a rote checklist” and that in determining likely confusion, “we adhere to two long stated principles: the ... factors ... are non-exhaustive, and ... should be applied flexibly”); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 154 (4th Cir. 2012) (“This judicially created list of factors is not intended to be exhaustive or mandatory.”). Courts have asserted that they can dispense with the factors test altogether if the court thinks it plain that no consumer will be confused. See *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 509 F.3d 380, 383 (7th Cir. 2007). Likewise, some courts favor forgoing the confusion test altogether in cases of nominative fair use or expressive use. See, e.g., *Playboy Enters. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002) (applying the nominative fair use test instead of the confusion test); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (applying the expressive use test instead of the confusion test); *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1587-89 (2023) (specifying circumstances in which *Rogers* may be invoked); see also Agreement on Trade-Related Aspects of Intellectual Property Rights art. 16, ¶ 1, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299 (“In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.”).

137. See, e.g., Daryl Lim, *Trademark Confusion Revealed: An Empirical Analysis*, 71 AM. U. L. REV. 1285, 1291, 1321-22 (2022); Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1581-82 (2006).

the words of a patent claim) side-by-side with a description or visual representation of the accused subject matter.<sup>138</sup> Local court rules may even require the parties to submit claim charts.<sup>139</sup> Creating such charts is second nature to patent lawyers.

However, if *Gorham's* unfair competition orientation is taken seriously, this simple and fundamental utility patent practice should not necessarily carry over to design patent law. In early design patent cases applying *Gorham*, some courts appeared to recognize this, ruling that “side by side comparison in court” of the patented and accused designs “is not a proper test” of design patent infringement.<sup>140</sup> For some judges, this rule flowed naturally from *Gorham*<sup>141</sup>: the ordinary observer test contemplated an assessment of “the pictured effect on the mind from a general view, rather than details revealed by a minute test.”<sup>142</sup> The rule might also spring from the fact that in some cases, the hypothetical ordinary observer would never encounter the patented and accused designs side-by-side.<sup>143</sup>

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138. ROGER E. SCHECHTER & JOHN R. THOMAS, PRINCIPLES OF PATENT LAW 338 (3d ed. 2019).

139. See, e.g., N.D. CAL. PAT. LOC. R. 3-1(c) (claim chart requirement for the patentee).

140. *Coca-Cola Co. v. Whistle Co. of Am.*, 20 F.2d 955, 956 (D. Del. 1927) (citing *Friedberger-Aaron Mfg. Co. v. Chapin*, 151 F. 264 (C.C.E.D. Pa. 1907)). In *Friedberger-Aaron Mfg. Co. v. Chapin*, the court ruled that “[i]t is very easy to distinguish between the two designs when brought together, but they are so near alike in appearance that the ordinary observer, giving such attention as a purchaser usually gives, would undoubtedly be deceived by the resemblance of the defendant’s design to that of the complainant’s.” 151 F. at 265; see also *Ashley v. Weeks-Numan Co.*, 220 F. 899, 902 (2d Cir. 1915) (“It [was] not a proper test to place the two inkstands side by side, to determine whether or not there are certain differences.”).

141. Indeed, *Gorham* argued that “[i]t would be a mistake to suppose that the resemblance [between the patented and accused designs] must be such as to deceive persons who should see the two marks placed side by side” because the rule, so restricted, “would be of no practical use.” *Gorham's* Brief, *supra* note 59, at 21.

142. *Sanson Hosiery Mills, Inc. v. S.H. Kress & Co.*, 109 F. Supp. 383, 384 (M.D.N.C. 1952). One modern decision seems to take this reasoning one step further, equating side-by-side comparisons to exercises in improperly dissecting the design. *Child Craft Indus., Inc. v. Simmons Juv. Prods. Co.*, 990 F. Supp. 638, 642 (S.D. Ind. 1998) (“Substantial similarity does not require a side-by-side dissection of the two designs. Rather, the design must be considered as a whole.” (citation omitted)). See *supra* Part II for additional discussion of the anti-dissection principle.

143. *Sanson*, 109 F. Supp. at 384 (“The imitation may be on display when the patented article is not present. In such a situation, one seeking [an article bearing the patented design] would readily accept the imitation.”).

The Federal Circuit has not entertained these subtleties. Federal Circuit opinions take it as a given that a design patent infringement analysis should be conducted by comparing the patented and accused designs side-by-side.<sup>144</sup> Undoubtedly, the court has carried over this practice from utility patent law without considering the implications of *Gorham*.

The result is unnecessary confusion about a simple but fundamental aspect of the design patent infringement analysis. As one trial court summarized it, the design patent case law “is not entirely consistent as to whether side-by-side comparison of the patented and allegedly infringing products is appropriate.”<sup>145</sup> At least for cases in which the hypothetical ordinary observer would not have the “opportunity to conduct a detailed comparative analysis” of the patented and accused designs, a side-by-side comparison undertaken by the court might not be probative.<sup>146</sup>

The Federal Circuit should revisit its statements on this point and could draw on the modern law of trade dress infringement in doing so (in addition to the early design patent cases noted above). The law of trade dress infringement rejects the assumption that a side-by-side comparison is mandatory, or even necessarily probative, when analyzing for liability under a likelihood-of-confusion factors test.<sup>147</sup> This is because a side-by-side comparison might not reflect

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144. See *Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1304 (Fed. Cir. 2010) (“The proper comparison requires a side-by-side view of the drawings of the [claimed] design and the accused products.”); *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1327 (Fed. Cir. 2007) (approving of the lower court’s “detailed side-by-side comparison between the patented design and the accused design”). The proper locus of comparison is the patented design as depicted in the patent document, not the patentee’s commercial embodiment. See *Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337, 1341 (Fed. Cir. 2020) (citing *Payless Shoesource, Inc. v. Reebok Int'l, Ltd.*, 998 F.2d 985, 990 (Fed. Cir. 1993) (“Proper application of the *Gorham* test requires that an accused design be compared to the claimed design, not to a commercial embodiment.”)). Courts also say that they are analyzing designs side-by-side when applying the rules of prior art. See *Spigen Korea Co. v. Ultraproof, Inc.*, 955 F.3d 1379, 1384 (Fed. Cir. 2020) (conducting a side-by-side comparison between claimed design and alleged primary reference for obviousness); *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314 (Fed. Cir. 2013) (instructing the lower court that, on remand, it “should do a side-by-side comparison of the [patented and prior art] designs to determine if they create the same visual impression” as part of the obviousness analysis).

145. *Hutzler Mfg. Co. v. Bradshaw Int'l, Inc.*, No. 11 Civ. 7211, 2012 WL 3031150, at \*10 (S.D.N.Y. July 25, 2012).

146. *Id.*

147. Under that test, similarity of the marks is only one of several factors that may be

the way in which the parties' respective trade dress marks are actually displayed in their purchasing context.<sup>148</sup> If consumers would never encounter the parties' products simultaneously, then a proper similarity comparison would analyze whether visual differences "are likely to be memorable enough to dispel confusion on serial viewing."<sup>149</sup> These courts interpret the Lanham Act as requiring a contextual analysis, focusing on similarity in real world marketing conditions.<sup>150</sup>

This proposed change in the Federal Circuit's approach to design patent infringement—while seemingly slight—could prove important in some cases.<sup>151</sup> At a minimum, the court should require the

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relevant to likelihood of confusion. *Cf.* Beebe, *supra* note 137, at 1623 (concluding that a finding of mark dissimilarity is likely to be dispositive against liability).

148. *See* *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 539 (2d Cir. 2005) (vacating the lower court's denial of a motion for preliminary injunctive relief and remanding to the lower court, where that court had found that the parties' handbags were dissimilar when viewed side-by-side); *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 117 (2d Cir. 2006) (ruling that the trial court erred by "inappropriately focusing on the similarity of the marks in a side-by-side comparison instead of when viewed sequentially in the context of the marketplace"); *Kemp v. Bumble Bee Seafoods, Inc.*, 398 F.3d 1049, 1054 (8th Cir. 2005) (declaring that it would be "inappropriate to conduct a side-by-side comparison of the elements of two products' trade dress" without taking into account "the market conditions under which likely consumers would see the marks" (citing *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1187 (6th Cir. 1988))); *Libman Co. v. Vining Indus., Inc.*, 69 F.3d 1360, 1362 (7th Cir. 1995) ("[W]here ... the public does not encounter the parties' trademarks together, the existence of minor differences that would clearly distinguish them in a side-by-side comparison does not refute an inference of likely confusion.").

149. *Louis Vuitton Malletier*, 426 F.3d at 538. This is a longstanding principle in unfair competition cases. *See, e.g.*, Bernard C. Steiner, *The Ordinary and the Ultimate Purchaser*, 16 YALE L.J. 112, 121 (1906) (stating that courts generally assume that the relevant purchaser is viewing the defendant's goods and relying on a memory of the appearance of the plaintiff's goods, and observing that "[s]ide by side, there may be hardly a probability of deception and the differences between the articles may be wide, but the incautious purchaser does not see them in that way and must trust to a treacherous memory").

150. *See Louis Vuitton Malletier*, 426 F.3d at 539. For products purchased primarily online, perhaps it is fair to default to side-by-side comparisons if that best simulates the consumer's purchasing experience.

151. *L.A. Gear* shows that refining the current approach could conceivably affect case outcomes. *See* *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993). The case involved trade dress and design patent infringement claims on shoe designs. *Id.* at 1121. There was evidence that the parties' respective shoes were sold in different stores, such that a side-by-side comparison was improper for the trade dress claim, while it was required for the design patent infringement claim. *Id.* at 1132. The court found design patent infringement notwithstanding the requirement for a side-by-side comparison, *id.* at 1126, but it is easy to imagine a court in a given case finding noninfringement based on slight differences that might

parties to make explicit in a given case whether a side-by-side comparison is probative. For example, where the parties' respective products are sold online, defaulting to a side-by-side similarity comparison in design patent cases may be justifiable. Likewise, where the design patent holder does not sell products bearing the patented design, defaulting to a side-by-side comparison between the design patent drawings and the accused product would seem unavoidable. But where the evidence shows that the patentee produces products bearing the patented design, and an ordinary observer would not encounter those products side-by-side with the accused products, the court should not permit simple side-by-side comparisons.

## 2. *Post-Sale Similarity*

Closely related to the question of the probative value of side-by-side similarity is the question of whether the similarity analysis must be confined to the conditions at the point of sale. The Federal Circuit has embraced the idea of similarity away from the point of sale in the design patent infringement analysis. But instead of tying that practice back to *Gorham*, the court has denied a kinship with trademark law in formulating the relevant rules.

In trademark law, courts have developed a doctrine of post-sale confusion, relying on it in some prominent trade dress cases.<sup>152</sup> In a canonical case, the court ruled in favor of Ferrari on a claim that the maker of a "kit-car," a Ferrari replica, had infringed Ferrari's trade dress rights where there was evidence that the presence of the kit-car in the marketplace gave rise to a likelihood of post-sale confusion.<sup>153</sup> Purchasers at the point of sale were not likely to be confused; they knew that they were buying a kit-car at a price much lower than the price of a genuine Ferrari, and they knew (based in part on the defendant's labeling) that the kit-car was not a genuine

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be noticeable in the course of a side-by-side comparison but might not be noticeable in the course of a sequential comparison.

152. See Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2171-74 (2004) (stating that in trade dress cases, post-sale confusion was more frequently invoked than dilution).

153. *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1238, 1244-45 (6th Cir. 1991).



Ferrari product.<sup>154</sup> However, the court concluded that the confusion cause of action was not limited to purchasers acting at the point of sale, and that the survey evidence showed that members of the public, even if they were not purchasers, were likely to be confused upon observing the kit-car after the point of sale.<sup>155</sup>

Design patent infringement law, by contrast, has adopted two formal, per se rules that drive the conclusion that similarity away from the point of sale is probative in infringement determinations. First, the Federal Circuit has ruled that the infringement analysis must account for “the claimed ornamental features of all figures of a design patent.”<sup>156</sup> This is significant because it means that features that are not visible to purchasers at the point of sale must still be accounted for in an ordinary observer analysis if those features appear in the design patent drawings.<sup>157</sup> Second, the Federal Circuit has ruled that “the ‘ordinary observer’ analysis is not limited to those features visible at the point of sale, but instead must encompass all ornamental features visible at any time during normal use of the product.”<sup>158</sup> The “any time during the normal use” rule is borrowed from the Section 171 ornamentality requirement, where the court defined “normal use” to encompass the entire useful life of the article associated with the design, from manufacture to loss or destruction.<sup>159</sup> In adopting these rules for the design patent infringement analysis, the Federal Circuit distinguished design patent from trademark law.<sup>160</sup>

Instead of treating its practice as *sui generis*, the Federal Circuit should connect its rule to the trademark law jurisprudence of post-sale confusion, mining that jurisprudence for lessons both positive and negative. For example, a crucial unresolved debate in

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154. *Id.* at 1244-45.

155. *Id.* at 1245.

156. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1379 (Fed. Cir. 2002).

157. *See id.* (holding that it was erroneous for the lower court to limit the analysis to the features of “a subset of the drawings”).

158. *Id.* at 1381 (“Rather than limiting the assessment of infringement to the point of purchase, the *Gorham* test applies an objective frame of reference, the hypothetical purchasing decision to be made by an ordinary observer, to all ornamental features visible at any time during the normal use of a product.”).

159. *Id.* at 1379-80 (citing *In re Webb*, 916 F.2d 1553, 1557-58 (Fed. Cir. 1990)).

160. *Id.* at 1380 (citing *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986)).

trademark cases on post-sale confusion is whether evidence of likely post-sale confusion among the general public is actionable or whether instead the mark owner's evidence must show likely post-sale confusion among purchasers or at least prospective purchasers.<sup>161</sup> The point is an important one in many trademark cases involving luxury goods.<sup>162</sup>

In design patent law, this nuance is usually assumed away. Even though the *Gorham* standard relies on the ordinary *observer*, courts routinely have assumed that the group of relevant observers is limited to those who are purchasers or potential purchasers. *Gorham* itself includes language on the point,<sup>163</sup> and it is not alone.<sup>164</sup> Yet, under some circumstances, judges have relied on their own perceptions, or those of jurors, as ordinary observer evidence, without any deep inquiry into whether the judges or jurors are purchasers.<sup>165</sup>

This doctrinal nuance has important policy implications for both design patent and trademark law because it ties into broader unresolved questions about the nature of harms that the respective regimes seek to redress. Design patent law has offered no serious account of the nature of the harm that it seeks to redress with infringement remedies,<sup>166</sup> with one rare exception in which a design

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161. See, e.g., *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1249-50 (6th Cir. 1991) (Kennedy, J., dissenting).

162. In *Ferrari*, Judge Kennedy worried (in dissent) that the majority's post-sale confusion analysis permitted liability based on evidence of likely confusion among those who might observe a Ferrari (or Ferrari kit-car) but would not be likely to purchase such a vehicle. See *id.* at 1250.

163. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871) (holding that the test is whether the resemblance would deceive the ordinary observer such as to "induc[e] him to purchase one supposing it to be the other"). The Court also characterized ordinary observers as "those who buy and use," and said that patentees are injured if the "principal purchasers of the articles to which designs have given novel appearances ... are misled, and induced to purchase what is not the article they supposed it to be." *Id.*

164. For example, an early case applying the *Gorham* standard distinguished between "disinterested" and "ordinary" observers, stating that the latter meant "purchasers of the articles in question for the purposes for which they were intended and are purchased." *Dryfoos v. Friedman*, 18 F. 824, 826-27 (C.C.S.D.N.Y. 1884) (finding no infringement).

165. See *infra* Part III.F. This may be reasonable where the goods in question are of a type ordinarily purchased by the general public.

166. This is despite the fact that the Supreme Court decided a prominent case on design patent infringement damages remedies not long ago. See *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 55, 59 (2016) (holding that under the applicable disgorgement-of-profits provision, awardable profits could be based on components of the alleged infringer's product,

patent owner's argument merely hinted of a kinship with trademark-type harm.<sup>167</sup>

By contrast, trademark cases and commentary have made a much more concerted effort to tease out the harms of post-sale confusion.<sup>168</sup> For example, in *General Motors Corp. v. Keystone Automotive Industries, Inc.*, the court asserted that post-sale confusion could harm “the public and the original manufacturer” in the following ways:

(1) the viewing public, as well as subsequent purchasers, may be deceived if expertise is required to distinguish the original from the counterfeit; (2) the purchaser of an original may be harmed if the widespread existence of knockoffs decreases the original's value by making the previously scarce commonplace; (3) consumers desiring high quality products may be harmed if the original manufacturer decreases its investment in quality in order to compete more economically with less expensive knockoffs; (4) the original manufacturer's reputation for quality may be damaged if individuals mistake an inferior counterfeit for the original; (5) the original manufacturer's reputation for rarity may be harmed by the influx of knockoffs onto the market; and (6) the original manufacturer may be harmed if sales decline due to the public's fear that what they are purchasing may not be the original.<sup>169</sup>

Trademark scholars also have weighed in. For example, Bob Bone has observed that post-sale confusion can create harm to prestige

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rather than the entirety of that product); *see also* Mark D. Janis, *How Should Damages Be Calculated for Design Patent Infringement?*, 37 REV. LITIG. 241 (2018) (criticizing the Court's approach and exploring analogs from trademark and copyright remedies provisions); Pamela Samuelson & Mark Gergen, *The Disgorgement Remedy of Design Patent Law*, 108 CALIF. L. REV. 183, 208-09 (2020) (urging the use of causation and apportionment principles derived from general equitable principles of disgorgement).

167. *Apple Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1320 (Fed. Cir. 2012) (on motion for preliminary injunction). One of Apple's arguments to demonstrate irreparable harm was the “erosion of ‘design distinctiveness,’” also referred to in the case as “brand dilution.” *Id.* (quoting the lower court). The lower court was skeptical about whether brand dilution could arise from design patent infringement, and the Federal Circuit did not comment on this theory. *Id.*

168. *But cf.* Kal Raustiala & Christopher Jon Sprigman, Commentary, *Rethinking Post-Sale Confusion*, 108 TRADEMARK REP. 881, 884 (2018) (arguing that courts evade such discussion of harm when they presume it into existence in post-sale confusion cases).

169. 453 F.3d 351, 358 (6th Cir. 2006) (citations omitted).

value, and that is one kind of harm that trademark law might aim to prevent, depending upon one's normative judgment about the proper scope of the trademark right.<sup>170</sup> By contrast, Jeremy Sheff has argued that harm in the form of mere "status confusion" (confusion on the part of observers who are not evidently potential purchasers, who are confused about "who is entitled to the high social status that the brand is supposed to impart") should not be actionable,<sup>171</sup> even if harm to "bystander[s]" (potential purchasers who observe the allegedly infringing mark) should be actionable under specified circumstances.<sup>172</sup> Laura Heymann has added that a comprehensive assessment of harms should take into account the extent to which post-sale confusion might actually benefit some consumers, given that purchases of knock-off luxury goods may afford certain benefits—utilitarian or otherwise—to individual consumers.<sup>173</sup>

Design patent law should draw on these themes explicitly. Parties involved in design patent infringement cases could develop a richer record for infringement determinations by developing evidence that demonstrates how an alleged infringer's activities injure the reputation of the design patent owner's goods for high quality or rarity. At the remedy stage, courts could direct design patent owners to quantify these injuries via a showing of lost sales or otherwise. Courts could also draw on this literature to sharpen their normative assessments of the harm that design patent infringement seeks to remedy—for example, by directly confronting Sheff's point about whether injury to status should be actionable<sup>174</sup> or by evaluating Heymann's assertion that consumers might benefit from knock-offs.<sup>175</sup>

Moreover, a normative debate around the harms arising from post-sale observation of designs might prove less contentious in

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170. See Bone, *supra* note 152, at 2173-74.

171. Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769, 792 (2012).

172. *Id.* at 784-85 (arguing that bystander confusion might warrant a remedy if courts held mark owners to their proofs on certain confusion factors that are likely to be particularly important in post-sale confusion, such as the consumer sophistication factor).

173. See Laura A. Heymann, *Trademark Law and Consumer Constraints*, 64 ARIZ. L. REV. 339, 377-80 (2022).

174. See Sheff, *supra* note 171, at 832.

175. See Heymann, *supra* note 173, at 378-79.

design patent law than in trademark law. Post-sale confusion doctrine in trademark law is sometimes maligned as an expansionist strategy that aims to move trademark rights closer to rights in gross,<sup>176</sup> but it is not clear that those objections should carry over to design patent law. Design patent rights are already rights in gross. Moreover, incorporating principles from trademark law's post-sale confusion doctrine into design patent infringement law might result in narrowing of rights in a given case.<sup>177</sup>

*Gorham* itself is a good illustration of several of these points.<sup>178</sup> The record and opinion in *Gorham* include gestures to several of the types of harms enumerated in *General Motors*. For example, *Gorham* secured testimony that the presence of plated goods on the market “disparage[d] the sale” and caused “the trade [to] look upon the pattern as of little value” (*General Motors* factor #4)<sup>179</sup> and diverted sales to the alleged infringer (perhaps evidence of *General Motors* factor #6).<sup>180</sup> White argued that it should be inadequate (as a matter of law, apparently) for *Gorham* to show damage to *Gorham*'s reputation for rarity and a decline in the value of the design due to it becoming commonplace (*General Motors* factors #2, #5).<sup>181</sup>

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176. See, e.g., Mark A. Lemley & Mark P. McKenna, *Owning Mark(et)s*, 109 MICH. L. REV. 137, 156-57 (2010).

177. For example, in *Contessa*, involving a design for a serving tray for shrimp, the Federal Circuit reversed a grant of summary judgment of infringement where the district court's infringement analysis had evidently ignored one of the design patent drawings showing the underside of the tray—an aspect of the design that would have been obscured at the point of purchase but visible post-sale when the tray was unpackaged for use. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1381 (Fed. Cir. 2002).

178. For a more modern example, see *Payless Shoesource, Inc. v. Reebok Int'l Ltd.*, 998 F.2d 985, 989-91 (Fed. Cir. 1993) (ruling that the lower court committed clear error in its trade dress infringement analysis by failing to consider post-sale confusion, and that the lower court erred in its design patent infringement analysis for other reasons).

179. Supreme Court Record, *supra* note 31, at 19 (testimony of Theodore B. Starr); see *Gen. Motors Corp. v. Keystone Auto. Indus., Inc.*, 453 F.3d 351, 354 (6th Cir. 2006).

180. *Gorham Co. v. White*, 81 U.S. (14 Wall) 511, 515 (1871); see *Gen. Motors Corp.*, 453 F.3d at 354.

181. White's Brief, *supra* note 57, at 48 (asserting that *Gorham*'s infringement argument is inadequate because it amounts merely to the complaint that defendant's sales of plated goods will cause *Gorham*'s design to become so “common” that consumers will decline to buy *Gorham*'s solid silver design); see *Gen. Motors Corp.*, 453 F.3d at 354. White would have lost on this point today, at least if the issue had been argued as a trade dress matter under the modern Lanham Act. Even apart from the post-sale confusion doctrine, White would have confronted the Lanham Act's anti-dilution provision. 15 U.S.C. § 1125(c)(1). Given the subject matter, *Gorham* surely would also have invoked the concept of dilution by tarnishment. See

And the Court in *Gorham* analogized to counterfeiting, invoking concepts similar to those in *General Motors* factor #1.<sup>182</sup>

In addition, White argued that any purchaser paying fifty cents for a spoon knows that it must be a plated spoon, not a silver spoon, which would ordinarily sell for four dollars.<sup>183</sup> This is a common issue in post-sale confusion cases, invoking questions about whether relevant purchasers (or potential purchasers) would be sufficiently sophisticated to recognize that White's low-cost plated tableware could not be a luxury Gorham solid silver product. I turn to considerations of consumer attention and sophistication next.

### B. "Attention" and Consumer Sophistication

The *Gorham* ordinary observer test includes a qualifier: the observer's perceptions must be those formed when the observer gives "such attention as a purchaser usually gives."<sup>184</sup> Perceptions formed after a "critical examination," or after differences between the patented and accused designs have been pointed out to the observer, would be presumptively irrelevant; those conditions do not reflect the attention that a purchaser "usually gives."<sup>185</sup>

In isolated design patent cases, the *Gorham* attention language has come into issue. In *Braun*, involving designs for handheld blenders, the Federal Circuit determined that a reasonable jury could have relied on testimony that consumers typically purchase such blenders "on an 'impulse' and as a result they may not differentiate" between the patented and accused designs.<sup>186</sup> In other cases,

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*id.*

182. *Gorham*, 81 U.S. at 527-28 (remarking that even a "counterfeit bank note" might not be identical to the "true" one when examined from the perspective of an "experienced artist"); see *Gen. Motors Corp.*, 453 F.3d at 354; see also *United States v. Aylward*, 24 F. Cas. 907, 907 (D. Conn. 1853) (No. 14,482) (relying on an "ordinary observer" test when considering a criminal action involving money counterfeiting). The Court was not using the term "counterfeit" in the sense of modern trademark law, of course.

183. White's Brief, *supra* note 57, at 49.

184. *Gorham*, 81 U.S. (14 Wall.) at 528.

185. *Id.* at 528-30; see *Hutzler Mfg. Co. v. Bradshaw Int'l, Inc.*, No. 11 Civ. 7211, 2012 WL 3031150, at \*7 (S.D.N.Y. July 25, 2012) ("*Gorham* makes clear that 'such attention as a purchaser usually gives' does not include the attention that a purchaser would give the products ... after being told that there may be differences between them." (quoting *Gorham*, 81 U.S. (13 Wall.) at 529-30)).

186. *Braun Inc. v. Dynamics Corp. Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992) (footnote

courts have posited that observers are likely to be more attentive when purchasing expensive goods,<sup>187</sup> or largely inattentive in other circumstances.<sup>188</sup> Judge Learned Hand characterized a purchaser of ink wells as one “whose attention cannot be supposed to have a photographic accuracy,” although his determination of infringement was reversed on appeal.<sup>189</sup>

At minimum, the Federal Circuit should acknowledge that *Gorham*’s attention language provides a direct link to trademark infringement law, and that trademark law commentary could inform the design patent inquiry.<sup>190</sup> In the likelihood-of-confusion calculus, purchaser care (or purchaser sophistication) is a factor in typical multi-factor tests.<sup>191</sup> While the cases have made relatively little headway in refining the concept, insights from trademark scholarship could prove useful in evaluating design patent infringement claims.

For example, Lee, Christensen, and DeRosia developed a model of consumer sophistication drawing on consumer psychology literature and applied the model to reevaluate judicial pronouncements about the consumer sophistication factor in trademark infringement cases.<sup>192</sup> As the authors summarized it, the case law presumes that “consumer care or sophistication correlates positively with price, length and complexity of the purchase transaction; infrequency of purchase; education, age, gender, and income;” and, in some instances, status as a specialist.<sup>193</sup>

In post-sale confusion matters, consumer (or observer) sophistication and attentiveness may be especially important to the liability

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omitted).

187. See *Cardiac Pacemakers, Inc. v. Coratomic, Inc.*, 535 F. Supp. 280, 286 (D. Minn. 1982) (referring to expensive products sold to specialist physicians).

188. See *Superior Merch. Co. v. M.G.I. Wholesale, Inc.*, Nos. Civ.A. 98-3174, Civ.A. 99-3492, 2000 WL 322779, at \*11 (E.D. La. Mar. 27, 2000) (taking into account “the amount of attention that is likely to be given during an impulse purchase” of beads shaped like female breasts).

189. *Ashley v. Samuel C. Tatum Co.*, 181 F. 840, 842 (C.C.S.D.N.Y. 1910), *rev’d*, 186 F. 339 (2d Cir. 1911).

190. Ironically, *Braun* includes an especially forceful denial that the regimes are linked. See 975 F.2d at 820.

191. See DINWOODIE & JANIS, *supra* note 8, at 618-20.

192. See Thomas R. Lee, Glenn L. Christensen, & Eric D. DeRosia, *Trademarks, Consumer Psychology, and the Sophisticated Consumer*, 57 EMORY L.J. 575 (2008).

193. *Id.* at 580-81 (footnotes omitted).

determination. Raustiala and Sprigman have argued that a plaintiff mark owner alleging post-sale confusion should be required to show that the post-sale observer's recognition of similarity between the marks at issue is "salient" (meaning "important or relevant enough to the observer for it to rise to an observation of which the observer is conscious")<sup>194</sup> and that the observer is "familiar enough with the plaintiff's brand to spot the similarities, and yet ... not familiar enough or otherwise not likely to perceive differences that would apprise them that the defendant's product does not in fact originate with plaintiff."<sup>195</sup>

The Federal Circuit should signal that evidence on consumer sophistication and attentiveness should be considered routinely in design patent infringement cases. Testimony that would support a particularized characterization of the hypothetical ordinary observer, and the attentiveness that such an observer should be expected to give to designs of the type at issue, ought to be the norm in design patent infringement analysis. Nuances such as Raustiala and Sprigman's salience requirement could then be explored.

### *C. Competitive Proximity: The Section 171 Article of Manufacture and the SurgiSil Problem*

As traditionally formulated, trademark rights are not rights in gross but instead are rights tied to specified goods or services.<sup>196</sup> This presented challenges in early trademark and unfair competition cases in which mark owners sought to establish liability against alleged infringers who used similar or even identical marks on products or services that were closely related to, albeit not identical with, those of the mark owner.<sup>197</sup> Courts also often invoked the maxim that there could be no unfair competition without competition, where the concept of competition seemed to be limited to

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194. Raustiala & Sprigman, *supra* note 168, at 888.

195. *Id.* at 890.

196. *See, e.g.*, *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 414 (1916) (stating that a trademark is a property right, but only insofar as the mark is used "in connection with an existing business").

197. *See, e.g.*, *Borden Ice Cream Co. v. Borden's Condensed Milk Co.*, 201 F. 510, 513 (7th Cir. 1912) (ruling that Borden for milk was not infringed by Borden for ice cream).



head-to-head competition in the same markets involving the same products or services.<sup>198</sup>

As noted, courts eventually began finding liability where the goods or service of the respective parties were merely “related,” and this, in turn, led to the development of a multi-factor analysis that ultimately came to be accepted as governing in all trademark infringement cases, not just those involving allegedly related goods.<sup>199</sup> The requirement for direct competition between the alleged infringer and the mark owner that characterized early trademark infringement cases has been eased.<sup>200</sup> Under the current test, the degree of similarity between the mark owner’s and alleged infringer’s goods or services (sometimes called competitive proximity) is a factor in the multi-factor analysis.<sup>201</sup> At least one empirical study concluded that competitive proximity is one of the most frequently-invoked factors in likelihood-of-confusion opinions (along with actual confusion and similarity of marks).<sup>202</sup> There are also other manifestations of this shift. For example, evidence that the alleged infringer’s activities diverted sales away from the mark owner is no longer a prerequisite for showing injury in a trademark infringement or unfair competition case.<sup>203</sup>

The currently applicable legal framework for design patents is much different. A design patent is granted for an ornamental design “for an article of manufacture.”<sup>204</sup> Design patent practice prescribes that a design patent application “designate the particular article” of manufacture in the title, and that it specify the name of the article in the required pro forma claim.<sup>205</sup> These requirements have taken on added gravity as a potential limitation on design patent scope

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198. *Id.* at 514 (asserting that “‘unfair competition’ presupposes competition of some sort”).

199. *See* Bone, *supra* note 131, at 1316-34.

200. HARRY D. NIMS, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS*, at iii (3d ed. 1936) (applauding this change and suggesting that it occurred primarily during the 1920s).

201. *See* DINWOODIE & JANIS, *supra* note 8, at 623-24 (describing shifts in the law surrounding this factor).

202. Lim, *supra* note 137, at 1338; *cf.* Beebe, *supra* note 137, at 1632 (proximity is only important “at the extremes, when it weighs strongly in favor of one party or the other”).

203. *See, e.g.*, 5 MCCARTHY, *supra* note 83, § 30:74 (noting that only where a mark owner seeks actual damages must evidence of actual confusion be shown, and that evidence of diversion of sales is one means of showing actual confusion).

204. 35 U.S.C. § 171(a).

205. 37 C.F.R. § 1.153(a) (2011).

after the Federal Circuit's *Curver* and *SurgiSil* decisions. In *Curver Luxembourg, SARL v. Home Expressions Inc.*, the court held that a narrowing amendment to language of the article of manufacture in the title and claim could limit the scope of the design patent rights.<sup>206</sup> In *In re SurgiSil, L.L.P.*, the court ruled that where a design patent application specified in the title and claim (and drawings) that the design was for a lip implant, the claimed design was not anticipated by prior art disclosing an art tool.<sup>207</sup> According to the court, "[a] design claim is limited to the article of manufacture identified in the claim," such that the Board's anticipation finding was premised on a legally erroneous interpretation of the design claim's scope.<sup>208</sup> The claim, the court said, "is limited to lip implants and does not cover other articles of manufacture."<sup>209</sup>

The implications of *SurgiSil* for the infringement analysis remain to be worked out.<sup>210</sup> The design patent anticipation analysis, like the infringement analysis, relies on an ordinary observer test,<sup>211</sup> and both logically would be preceded by claim construction. Although the court in *SurgiSil* purported to resolve the case as a matter of law based on claim construction, it was necessarily concluding that based on its claim construction, the ordinary observer test could not, as a matter of law, have been satisfied.<sup>212</sup> That is, the court was necessarily concluding that no ordinary observer could have found the claimed design for a lip implant to be substantially similar to the prior art design for an art pencil.<sup>213</sup> Based on the court's reasoning, the claimed design for a lip implant likewise would not be infringed if the design for an art pencil were produced without the design patent owner's authority during the term of the design patent on the lip implant.

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206. 938 F.3d 1334, 1340 (Fed. Cir. 2019) (ruling that this limitation applied where the article was not depicted in the drawings).

207. 14 F.4th 1380, 1382 (Fed. Cir. 2021).

208. *Id.*

209. *Id.*

210. The Federal Circuit already has taken one step. *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 80 F.4th 1363, 1379 (Fed. Cir. 2023) (ruling that when a design patent is used as comparison prior art in the infringement analysis, "the prior-art design must be applied to the article of manufacture identified in the [design patent] claim").

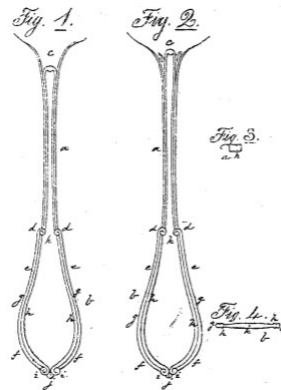
211. *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009).

212. *See* 14 F.4th at 1382.

213. *See id.*

That may all be well and good for lip implants and art pencils, but in other instances, the differences between the respective articles may not be so stark. Consider, for example, the Gorham D1,440 patent at issue in *Gorham v. White*.<sup>214</sup> The D1,440 design patent document describes the patented design as a design “for the handles of [t]able spoons and [f]orks,” and refers only to forks and spoons in describing the drawings.<sup>215</sup> The drawings themselves include a widened portion consistent with a fork or spoon, but probably not consistent with other utensils.<sup>216</sup>

Figure 1. J. Gorham, G. Thurber & L. Dexter, Jr., Spoon and Fork Handle, U.S. Patent No. D1,440, Issued July 16, 1861.<sup>217</sup>



214. See 81 U.S. (14 Wall.) 511, 512 (1871).

215. U.S. Patent No. D1,440, at [2] (issued July 16, 1861). At the time, no pro forma claim was required, so passages from the description, coupled with the drawings, may be understood as defining the claimed subject matter. See Jason Du Mont & Mark D. Janis, *Disclosing Designs*, 69 VAND. L. REV. 1631, 1639, 1648 (2016) (discussing when the Patent Office began recommending the use of a single pro forma claim).

216. ‘440 Patent. The drawings do not depict the tines of the fork or the bowl of the spoon, undoubtedly because the applicant considered the claimed design not to be limited to those details—a strategy that would be effectuated today through partial claiming using broken lines in the drawings to indicate features that are not part of the claimed design. See MPEP § 1503.02 (9th ed. Rev. 7, Feb. 2023).

217. ‘440 Patent.

Thus, based on the reasoning in *SurgiSil*, an argument could be made that the D1,440 patent would not even cover an identical copy of the handle depicted in the D1,440, produced as a handle for, say, a knife.<sup>218</sup> That argument takes the *SurgiSil* rhetoric to its extreme: a design claim “does not cover other articles of manufacture,” so therefore it must not cover *anything* beyond the *identical* article identified in the design patent document.<sup>219</sup>

The *Gorham* court surely would have considered such an outcome absurd. *Gorham* rejected the “eye[s] of [the] expert” test to avoid the use of just these sorts of technicalities to hamstring design patent scope.<sup>220</sup> *Gorham* adopted the ordinary observer test knowing full well that it was defining design patent scope by reference to the vagaries of public perception rather than strictly by the four corners of the patent document.<sup>221</sup> The Court was trading away some degree of notice in favor of achieving a reasonable scope of protection for design patent owners.<sup>222</sup>

Viewed through the lens of unfair competition law, a rule that would confine design patent scope to the identical article identified in the design patent document would look antique—over a century out of date. As noted, unfair competition law long ago accepted that consumers encountering a producer’s mark on one type of goods might expect that the producer might also market related goods under the same mark, and that it was reasonable to suppose that a producer’s goodwill might, in a given case, extend beyond the identical goods produced.<sup>223</sup>

The Federal Circuit should refine its pronouncements on the effect of the article of manufacture on design patent scope.<sup>224</sup> At a

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218. See 14 F.4th at 1382.

219. *Id.* This is a serious constraint on design patent scope in an age when consumers who find a car chassis design appealing might look to purchase a toy car bearing the design, or a digital car bearing the design.

220. See *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 527-28 (1871).

221. See *id.* at 528.

222. See *id.*

223. To be sure, some elements of this phenomenon—such as the practice of trademark merchandising—remain controversial among scholars. See, e.g., Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 478 (2005).

224. If the court maintains the status quo, patent lawyers will be under pressure to invent clever drafting techniques that allow the article of manufacture to be construed expansively. Perhaps we will see Markush claims for design patents. See *Multilayer Stretch Cling Film*

minimum, it should apply a gloss to *SurgiSil* indicating that design patent scope (for both validity and infringement purposes) is not confined as a matter of law to the identical article of manufacture identified in the design patent document. The court should acknowledge that, as with trademark rights, the extent to which a design patent covers designs on other articles depends on the ordinary observer's perceptions—a matter for the fact-finder<sup>225</sup>—and, in line with those perceptions, incorporating a notion of the degree of relatedness of the goods may be appropriate as part of the infringement calculus. The Federal Circuit should not leave courts adrift to resolve relatedness of goods issues by resorting to first principles, and it certainly should not leave the door open for a construction of *SurgiSil* that would forbid even an inquiry into whether the alleged infringer's goods are sufficiently similar to those identified in the design patent document.<sup>226</sup> The Federal Circuit could also reinforce its existing statements explaining that design patent infringement does not require head-to-head competition between the design patent owner and the alleged infringer.<sup>227</sup>

#### *D. Copying, Intent, and the Relevance of the Alleged Infringer's Labeling*

The role of the alleged infringer's intent in the modern design patent infringement analysis is something of a mystery. On the one

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Holdings, Inc. v. Berry Plastics Corp., 831 F.3d 1350, 1357-58 (Fed. Cir. 2016) (explaining the concept of Markush claims in chemical practice). In turn, we will see more disputes over indefiniteness. See 35 U.S.C. § 112(b).

225. Unidynamics Corp. v. Automatic Prods. Int'l, Ltd., 157 F.3d 1311, 1323 (Fed. Cir. 1998).

226. The remedy that should be awarded for infringement in such cases is a separate question, requiring a separate inquiry into what should be counted as the alleged infringer's article of manufacture, if the design patent owner seeks disgorgement of profits under 35 U.S.C. § 289. *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 59 (2016) (stating that the first step of the disgorgement analysis is to “identify the ‘article of manufacture’ to which the infringed design has been applied”).

227. In design patent law, this is because there is no requirement that the design patent owner put the patented design into use at all. *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986) (“The holder of a valid design patent need not have progressed to the manufacture and distribution of a ‘purchasable’ product for its design patent to be infringed by another’s product.”). In this respect, design patent differs from trademark.

hand, utility patent infringement is a strict liability tort,<sup>228</sup> and design patent infringement cases conform to this rule; there is no modern design patent infringement case suggesting that the design patent owner must prove that the alleged infringer intended to copy the patented design.<sup>229</sup> On the other hand, the very nature of the design patent right suggests that it would be rare for anyone to create a design that is substantially similar to a patented design without having had access to the patented design.<sup>230</sup>

In the modern trademark infringement analysis, the role of intent evidence is marginally better defined, although it is still controversial.<sup>231</sup> Intent is one element in modern likelihood-of-confusion multi-factor tests; it is not a threshold requirement.<sup>232</sup> In practice, intent appears to operate as a one-way ratchet: a finding that the alleged infringer had the requisite intent “is of decisive importance” and “creates ... a nearly un-rebuttable presumption of a likelihood of confusion,” according to Barton Beebe,<sup>233</sup> but a finding that the alleged infringer acted in good faith (or lacked the relevant intent) is usually said to be no defense to infringement<sup>234</sup> unless combined with other facts.<sup>235</sup>

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228. See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 35 (1997).

229. However, evidence of copying might lead to a finding that infringement is willful, entitling the design patent owner to seek enhanced damages. *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 579 U.S. 93, 103-04 (2016) (setting out the willfulness standard for the award of enhanced damages in utility patent cases); see *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1290 (Fed. Cir. 2002) (discussing the distinction between an award of disgorgement of profits for design patent infringement under § 289, for which no enhancement is permitted, and an award of damages under § 284, for which enhancement may be sought when infringement is willful).

230. Modern design patent infringement analysis thus may share some common ground with copyright infringement analysis, even though the respective tests are not alike in formal terms.

231. See, e.g., Blake Tierney, *Missing the Mark: The Misplaced Reliance on Intent in Modern Trademark Law*, 19 TEX. INTELL. PROP. L.J. 229 (2011).

232. See DINWOODIE & JANIS, *supra* note 8, at 616-18. By contrast, passing-off actions at the time of *Gorham* often treated evidence of fraud or false representation as a required element. See *supra* note 87 and accompanying text.

233. Beebe, *supra* note 137, at 1622, 1628. Moreover, some cases permit bad intent to be inferred from evidence of mark similarity combined with evidence that the alleged infringer knew of the mark owner's mark. See 3 MCCARTHY, *supra* note 83, § 23:115 (collecting authority).

234. 3 MCCARTHY, *supra* note 83, at § 23:107; see also *Taubman Co. v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003) (characterizing trademark infringement as a matter of strict liability).

235. See DINWOODIE & JANIS, *supra* note 8, at 793-846 (discussing fair use defenses).

In addition, in applying the likelihood-of-confusion test, especially in cases involving product configuration trade dress, some courts distinguish between intent to copy and intent to trade off goodwill, specifying that only the latter should be treated as triggering an inference of likely confusion.<sup>236</sup> For example, in *Groeneveld Transport Efficiency, Inc. v. Lubecore International, Inc.*, a Sixth Circuit panel declared that an argument that intentional copying of trade dress creates a presumption of confusion “indicates a fundamental misapprehension of the purposes of trademark law.”<sup>237</sup> According to the court, trademark law is intended to “promote informational integrity in the marketplace,” not to “prohibit copying as such; that is the province of copyrights and patents.”<sup>238</sup>

If design patent infringement is understood as having roots in unfair competition law, this ought to prompt courts to take a closer look at the role of intent evidence in determining design patent infringement, accounting for the distinction between intent to copy and intent to trade off goodwill. In particular, the context in which the alleged infringer presents its design might well indicate whether the alleged infringer intended to capture the design patent owner’s goodwill as embodied in the design. One important element of this contextual evidence is proof of the labeling that the alleged infringer used in connection with the design.

The point has often been argued in design patent infringement cases, without being tethered to notions of unfair competition. In *Gorham*, the alleged infringer pointed out that its spoons were stamped with the mark “Rogers & Brother,” and argued that this was evidence showing that the alleged infringer was not attempting to deceive purchasers.<sup>239</sup> The Court did not address this argument.

But in *Redway v. Ohio Stove Co.*, an early design patent case applying *Gorham*, the court ruled that the defendant’s use of “its

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236. *But cf.* Alfred C. Yen, *Intent and Trademark Infringement*, 57 ARIZ. L. REV. 713, 742-43 (2015) (criticizing the tendency of some courts to treat intent evidence as relevant to determining the alleged infringer’s fault rather than considering whether the evidence triggers an inference that consumers are likely to be confused).

237. 730 F.3d 494, 511 (6th Cir. 2013); *see also* Versa Prods. Co. v. Bifold Co., 50 F.3d 189, 208 (3d Cir. 1995) (ruling that in product configuration trade dress cases, intent should weigh “in favor of a finding of likelihood of confusion” only when intent to confuse is shown “by clear and convincing evidence” and the defendant’s labeling is “affirmatively misleading”).

238. *Groeneveld*, 730 F.3d at 511-12 (emphasis omitted).

239. White’s Brief, *supra* note 57, at 48.

own name and the name of its own stove, conspicuously displayed, in connection with the design,” was not sufficient to avoid infringement.<sup>240</sup> The *Redway* court said that the rule for design patent cases was the same as that for trademark cases, and that trademark law provided that “the addition of the infringer’s name to a trade-mark, in the place of the owner’s, does not render the unauthorized use of it any less an infringement.”<sup>241</sup>

That characterization of trademark law is insufficiently nuanced to capture the modern jurisprudence. To be sure, modern trademark cases say that an alleged infringer does not get “an absolute affirmative defense to every trademark infringement claim” by merely adding its label to allegedly infringing trade dress,<sup>242</sup> and the McCarthy treatise asserts that the majority rule is that an alleged infringer’s labeling “does not avoid what would otherwise be an infringing trade dress.”<sup>243</sup> On the other hand, McCarthy also concedes that an alleged infringer may avoid trade dress infringement liability by adding labeling that is sufficiently conspicuous, and cites numerous cases that come out this way.<sup>244</sup> Some of these cases emphasize that where purchasers are discerning or knowledgeable about the products in question, prominent labeling is an “important factor[.]” in preventing a likelihood of confusion.<sup>245</sup>

In modern design patent cases, the Federal Circuit has exhibited little consistency in its approach to the relevance of defendant’s labeling, and the court has shown no inclination to consider

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240. 38 F. 582, 584 (C.C.S.D. Ohio 1889).

241. *Id.* (citing *Menendez v. Holt*, 128 U.S. 514 (1888) (asserting that the defendant’s labeling aggravated the unfair competition)).

242. *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246, 259 (5th Cir. 1997) (concluding that the added label was not sufficient to resist a finding of likelihood of success on infringement in a preliminary injunction motion).

243. 3 MCCARTHY, *supra* note 83, § 23:53.

244. *Id.* at n.12 (citing authorities).

245. *See, e.g., Yellowfin Yachts, Inc. v. Barker Boatworks, LLC*, 898 F.3d 1279, 1289 (11th Cir. 2018) (stating that the strength of the plaintiff’s trade dress is an “important factor[.]” in case involving fishing boat trade dress); *Groeneveld Transp. Efficiency, Inc. v. Lubecore Int’l, Inc.*, 730 F.3d 494, 510 (6th Cir. 2013) (involving trade dress for expensive lubrication pumps marketed to knowledgeable buyers); *see also Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1446 (Fed. Cir. 1984) (stating that “conspicuous[.]” display of defendant’s word mark on expensive microwaves dissipated confusion, while conceding that the effect of a label might depend on the “prominence of the label and the type of” goods involved). *Litton* also involved an allegation of design patent infringement, which the court disposed of by using the now-discredited “point of novelty” test. 728 F.2d at 1444.



parallels with trademark law. *L.A. Gear* is a leading example, involving design patent and trade dress claims on shoe designs.<sup>246</sup> The alleged infringer admitted copying the shoe designs.<sup>247</sup> In its design patent infringement analysis, the Federal Circuit remarked that design patent law does not require a showing of unfair competition and does not allow “avoidance of infringement by labelling.”<sup>248</sup> But in its trade dress infringement analysis, the court determined that the “conspicuous and permanent placement” of the labeling was one among other factors that made confusion unlikely, notwithstanding the copying.<sup>249</sup> In *OddzOn Products, Inc. v. Just Toys, Inc.*, the court ignored the defendant’s labeling in analyzing design patent infringement (albeit en route to upholding a determination of noninfringement), but placed weight on the defendant’s labeling when analyzing likelihood of confusion in the companion trade dress claim.<sup>250</sup>

More recently, in its 2019 decision in *Columbia*, the Federal Circuit reiterated the remark from *L.A. Gear* that a would-be design patent infringer “should not escape liability for design patent infringement if a design is copied but labeled with its name.”<sup>251</sup> But this should not be understood as a per se rule, the court in *Columbia* seemed to indicate:

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246. Trade dress was claimed in the overall appearance of the shoes, including color. The design patent likewise covered the appearance of the exterior of the shoe, albeit not limited as to color. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1121 (Fed. Cir. 1993).

247. *Id.* at 1125. The alleged infringer asserted that copying was “prevalent in the fashion industry” and that, in any event, the design patent and trade dress rights were invalid for various reasons. *Id.* at 1126-27, 1129.

248. *Id.* at 1126 (citing *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986)). The court did say it was acceptable for the lower court to have compared the design patentee’s actual product with the alleged infringer’s accused product, where there appeared to be no difference between the design patent drawing and the actual embodiment of the patentee’s shoe. *Id.* at 1125-26. The fact that the district court “analyzed likelihood of confusion” in carrying out this comparison did not give rise to a “methodological error” in the design patent infringement analysis. *Id.* at 1126.

249. *Id.* at 1134. As for the other factors, the Federal Circuit concluded that purchasers of fashion athletic shoes were sophisticated (disagreeing with the district court on this point) and that the fact that plaintiff’s and defendant’s products were sold through different channels of trade, and therefore would not be seen side-by-side, diminished the likelihood of confusion. *Id.* Judge Mayer dissented, accusing the majority of reweighing the evidence. *Id.* at 1135 (Mayer, J., concurring in part and dissenting in part).

250. 122 F.3d 1396, 1408 (Fed. Cir. 1997).

251. *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119, 1131 (Fed. Cir. 2019).

*L.A. Gear* does not prohibit the fact finder from *considering* an ornamental logo, its placement, and its appearance as one among other potential differences between a patented design and an accused one. Indeed, the fact finder is tasked with determining whether an ordinary observer would find the “effect of the whole design substantially the same.” [*Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 530 (1871)]. It would be inconsistent with this mandate to ignore elements of the accused design entirely, simply because those elements included the name of the defendant.<sup>252</sup>

This ruling could be understood as endorsing the sort of case-by-case, contextual approach that unfair competition law favors. If so, the court should have taken the opportunity to say so explicitly. It could have pointed out that the alleged infringer’s labeling is one piece of contextual evidence whose relevance makes sense if the objective is to determine whether the defendant was engaged in behavior resembling passing-off. It could have proceeded to explain that in trademark cases, when courts assess the weight to be given to the alleged infringer’s labeling, that assessment is regularly tied to the level of sophistication of the relevant purchasers.<sup>253</sup> And it could have explained that when there is evidence of copying, unfair competition principles likewise counsel in favor of weighing that evidence as part of a coherent contextual analysis. Indeed, the court could have said that a chief lesson of *L.A. Gear* (and now *Columbia*) is that the *Gorham* ordinary observer standard is not an exercise in mere visual comparison divorced entirely from the surrounding circumstances.<sup>254</sup> Instead, it is necessarily a holistic exercise that takes account of contextual evidence—including non-visual evidence such as evidence of copying or evidence of an alleged infringer’s intent to trade off a design patent owner’s goodwill.<sup>255</sup>

Instead, when it revisited the issue in its 2023 *Columbia* decision, the court leaned even more heavily on its perceived distinction between design patent infringement and source confusion to justify

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252. *Id.*

253. *See, e.g., L.A. Gear*, 988 F.2d at 1134.

254. *See id.* at 1124-25.

255. *See id.* at 1124, 1132; *cf. White’s Brief, supra* note 57, at 25 (asserting that the intent of the allegedly infringing designer should not be relevant to the infringement inquiry).

the ruling that the presence of a logo on the defendant's product was always relevant in a confusion case but only sometimes relevant in a design patent infringement case.<sup>256</sup> The court missed an important opportunity to enrich the design patent infringement jurisprudence by extracting lessons from the trademark jurisprudence, even if it may have reached a reasonable result.

To put a finer point on it, in a trademark infringement or passing-off claim, evidence of an intent to divert sales or otherwise trade off a mark owner's goodwill is directly relevant as a factor in likely confusion,<sup>257</sup> and evidence of intentional copying is indirectly relevant to the extent that it allows an inference of intent to trade off goodwill.<sup>258</sup> In a design patent infringement claim, evidence of intentional copying is directly relevant to the extent that it triggers an inference of visual similarity, and evidence of an intent to divert sales or trade off goodwill should also be relevant to show that the visual similarity was substantial enough that it could induce a purchaser to purchase the alleged infringer's product rather than the design patent owner's. It is this last assertion—the relevance of intent to trade off goodwill in a design patent infringement case—that the courts have not sufficiently explored. And courts may be disinclined to explore it given the Federal Circuit's insistence that design patent infringement has no connection to source confusion.

My appeal to incorporate contextual evidence (such as evidence of intent to trade off goodwill) into the calculus of design patent infringement has even more fundamental implications: it provokes a background question about the nature of the design patent right. It is not a form of strict liability anti-replication protection in the nature of the utility patent right—*Gorham's* rejection of a utility patent infringement test tells us as much. Nor is it a form of anti-copying protection on all fours with copyright because a showing of copying is not mandatory, even though it may be relevant. It is a form of protection against visual similarity, but fidelity to *Gorham* suggests that evidence of efforts to disrupt the informational integrity of the marketplace should be accepted as probative when those efforts trigger inferences about the degree of visual similarity.

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256. See 80 F.4th at 1382-83; see also *supra* note 14 and accompanying text.

257. See *supra* notes 86-87 and accompanying text.

258. See *supra* note 88 and accompanying text.

*E. Design Strength*

In a conventional likelihood-of-confusion factors analysis, mark strength (or sometimes mark “fame”) is included as a factor.<sup>259</sup> The premise is that when the owner’s mark is stronger, the alleged infringer’s activity is more likely to confuse consumers, although Beebe and Hemphill have argued that the relationship between strength and confusion is considerably more nuanced.<sup>260</sup>

Courts speak of two categories of strength: inherent (or “conceptual”) strength and acquired (or “market”) strength.<sup>261</sup> Both types of strength may be considered in any given case, but there is some empirical evidence that when proof regarding the respective types conflicts, market strength tends to receive greater weight.<sup>262</sup>

By including mark strength as a factor in the infringement determination, trademark law posits a relationship between the rules of validity and those of enforceable scope. The inquiry into conceptual strength calls for the court to re-ask whether the mark is distinctive, although the conceptual strength inquiry considers the *degree* of distinctiveness, not just the existence or non-existence of it.<sup>263</sup> Similarly, the market strength analysis considers evidence of the mark’s secondary meaning, a required element of the validity analysis for some categories of marks, although the infringement inquiry assesses market strength as of the time of the infringement (not the time when registration is sought) and focuses on the extent of secondary meaning.<sup>264</sup>

Modern design patent infringement law already includes a loose analog to conceptual strength. *Egyptian Goddess* permits the alleged infringer to introduce comparison prior art into the infringement

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259. See DINWOODIE & JANIS, *supra* note 8, at 615-16.

260. See Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More than the Weak?*, 92 N.Y.U. L. REV. 1339, 1341 (2017).

261. See *JL Beverage Co. v. Jim Beam Brands Co.*, 828 F.3d 1098, 1106-07 (9th Cir. 2016) (noting the categories); *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 147-49 (2d Cir. 2003) (explaining the rationales for the categories).

262. See Beebe, *supra* note 137, at 1633-40.

263. See DINWOODIE & JANIS, *supra* note 8, at 615 n.2.

264. See *Water Pik, Inc. v. Med-Systems, Inc.*, 726 F.3d 1136, 1154 (10th Cir. 2013) (“The difference between [market] strength and secondary meaning is that the former is a range, while the latter is a threshold: a mark may enjoy anything from a high degree of [market] strength to a low degree, but either it has secondary meaning or it does not.”).

determination, allowing for a three-way comparison between the claimed design, the accused design, and the comparison prior art.<sup>265</sup> In a crowded field of design (one with abundant potential comparison prior art), the effect might be to curtail the effective scope of the claimed design, if the accused design is visually closer to the comparison prior art than to the claimed design, or if it magnifies otherwise subtle visual differences between the claimed and accused designs. Analogously, evidence of an abundance of third-party usages is likely to undermine the conceptual strength of a mark. However, in a given case, the comparison prior art might have the effect of highlighting *similarities* between the claimed and accused designs, so the analogy is not reliable.

Commercial strength presents some different considerations for design patents. There is no requirement for design patent subject matter to be put into use, so it would be inappropriate to adopt a rule that allowed evidence of a *lack* of commercial strength to cut against design patent infringement. However, where a design patent owner has commercialized the claimed design, the Federal Circuit should develop a rule for accepting evidence of commercial strength as probative on infringement.

In trademark infringement law, courts have accepted direct evidence of commercial strength (usually survey evidence) and a range of types of circumstantial evidence, such as sales evidence, evidence of the extent of advertising expenditures, and third-party references to the mark (for example, in the media).<sup>266</sup> That evidence, subject to some qualifications discussed below, could be useful in refining the analysis of how a hypothetical ordinary observer presented with the patented and accused designs would make purchase decisions, and courts should be authorized to consider it.

Circumstantial evidence of the foregoing type is already familiar in design patent law. Evidence of commercial success can be used to rebut an assertion that a claimed design is unpatentable for obviousness if there is a demonstrated nexus between the evidence and the “design patent claim’s unique characteristics.”<sup>267</sup> The nexus

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265. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677-79 (Fed. Cir. 2008).

266. Timothy Denny Greene & Jeff Wilkerson, *Understanding Trademark Strength*, 16 STAN. TECH. L. REV. 535, 555-56 (2013).

267. *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1279 (Fed. Cir. 2021).

requirement reflects a concern that the commercial success may be attributable to causes other than the merits of the invention.<sup>268</sup> Where evidence of commercial strength is used for design patent infringement, it may make sense to impose a type of nexus requirement, but the purpose of such a requirement would be merely to ensure that the design patent owner's commercial product embodies the patented design. The Federal Circuit already has some experience with such determinations in cases where it approves of the use of the design patent owner's commercial product as a surrogate for the claimed design in comparing the claimed and allegedly infringing designs.

Trademark scholarship offers some potential further refinements that should be considered in analyzing design patent infringement. Beebe and Hemphill have pointed out that increased strength should not invariably correlate to a broader scope of rights, because for some marks, their very muscularity may indicate that consumers are less likely to be confused—more likely to notice small differences between the asserted and allegedly infringing marks.<sup>269</sup> In addition, Fromer has argued that courts should adopt a sliding scale for evaluated commercial strength evidence in trademark infringement cases, where larger, better-resourced businesses are assumed to supply a larger market and therefore are subjected to a heavier burden to show that their commercial strength evidence has actually been effective in establishing consumer awareness of the mark at issue.<sup>270</sup> Courts should be open to exploring this argument in design patent infringement if we are to take seriously the unfair competition lineage of the design patent infringement test.

#### *F. Confusion Surveys in Design Patent Infringement Cases*

Should design patent infringement analysis be understood as an *empirical* inquiry into consumer perceptions, a longstanding article of faith in the law of trademark infringement?<sup>271</sup> In trademark

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268. *See id.* at 1278.

269. Beebe & Hemphill, *supra* note 260, at 1367-70 (suggesting a possible “inverted U” correlation between strength and likely confusion).

270. Jeanne C. Fromer, *Against Secondary Meaning*, 98 NOTRE DAME L. REV. 211, 261 (2022) (remarking that courts may be doing this *sub silentio* already).

271. *But cf.* Graeme B. Dinwoodie, *Trade Mark Law as a Normative Project*, 2023 SING. J.

infringement cases, actual confusion is one factor in the confusion analysis,<sup>272</sup> and it is generally proven by survey evidence or direct (anecdotal) evidence, usually presented through expert testimony.<sup>273</sup> According to conventional wisdom, survey evidence has weighed heavily in trademark infringement determinations, although its value remains a matter of scholarly debate.<sup>274</sup>

Some steps have been taken to bring survey evidence to bear in design patent infringement cases. Mauro and Morley have constructed an “empirical ordinary observer test” which seeks to mitigate “large-scale variability” in design patent anticipation and infringement inquiries.<sup>275</sup> They performed an experiment to validate the test using the subject matter of the *Gorham* case.<sup>276</sup>

The Federal Circuit has given survey evidence a mixed reception in design patent cases. It has expressed a willingness to permit consideration of actual confusion evidence while showing no

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LEGAL STUD. 305, 306 (arguing that trademark law should pull back from its emphasis on empirical assessments of consumer association and more directly address normative concerns).

272. See DINWOODIE & JANIS, *supra* note 8, at 620-23 (discussing the actual confusion factor).

273. See Shari Seidman Diamond & David J. Franklyn, *Trademark Surveys: An Undulating Path*, 92 TEX. L. REV. 2029, 2036, 2063-64 (2014); DINWOODIE & JANIS, *supra* note 8, at 620 n.3.

274. Compare Diamond & Franklyn, *supra* note 273, at 2066-67 (concluding that surveys are “valuable tools in trademark litigation, even when they are not deployed in trial”), and Dan Sarel & Howard Marmorstein, *The Effect of Consumer Surveys and Actual Confusion Evidence in Trademark Litigation: An Empirical Assessment*, 99 TRADEMARK REP. 1416, 1433 (2009) (concluding that the use of survey evidence increased success rates), with Robert C. Bird & Joel H. Steckel, *The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts*, 14 U. PA. J. BUS. L. 1013, 1017 (2012) (concluding that surveys play a limited role in litigated cases), and Beebe, *supra* note 137, at 1640-42 (questioning the significance of surveys), and 3 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 9:83 (2024) (stating that survey evidence that attempts to measure marketplace reaction is generally not considered probative in copyright cases).

275. Charles L. Mauro & Christopher Morley, *Why the Future of Design Patent Protections Will Rely on Modern Neuroscience, Not Constitutional and Legal Reversionism*, 36 BERKELEY TECH. L.J. 277, 278, 281, 284-87 (2021); see also Mark Bartholomew, Zhihao Zhang, Ming Hsu, Andrew Kayser & Femke van Horen, *A New Addition to the Trademark Litigator’s Tool Kit: A Neuroscientific Index of Mark Similarity*, 113 TRADEMARK REP. 789 (2023) (reporting on an experiment to develop a neural index of visual similarity).

276. Charles L. Mauro, Chris Morley & Paul W. Thurman, *Development and Initial Validation of an Empirical Ordinary Observer Test for Design Patent Infringement*, SSRN (June 5, 2020), <https://ssrn.com/abstract=3620088> [<https://perma.cc/3TN3-N8DR>].

appetite for making the use of such evidence mandatory.<sup>277</sup> In *Braun*, the Federal Circuit adopted the view that the “desirability ... or necessity” for presenting survey evidence in a design patent infringement case should be left for case-by-case adjudication.<sup>278</sup> The court attempted to explain why this approach was consistent with *Gorham*, asserting that while *Gorham* relied in part on “empirical and testimonial evidence” as to the ordinary observer’s perceptions, “[n]othing in *Gorham* suggests that, in finding design patent infringement, a trier of fact may not as a matter of law rely exclusively or primarily on a visual comparison of the patented design, as well as the device that embodies the design, and the accused device’s design.”<sup>279</sup> This made sense, according to the Federal Circuit, because the jury itself could be considered a panel of ordinary observers, and therefore would not necessarily need to rely on “empirical evidence as to whether ordinary observers would be deceived by an accused device’s design.”<sup>280</sup>

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277. See, e.g., *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406-07 (Fed. Cir. 1997) (showing that actual confusion evidence was clearly relevant to substantial similarity, but exclusion of that evidence was harmless error); *Hupp v. Siroflex Am., Inc.*, 122 F.3d 1456, 1464-65 (Fed. Cir. 1997) (appearing to accept the relevance of confusion evidence, while upholding a jury verdict that there was no substantial similarity in spite of the confusion evidence).

278. *Braun Inc. v. Dynamics Corp. America*, 975 F.2d 815, 821 (Fed. Cir. 1992) (“The desirability of or necessity for presentation of [survey] evidence might vary depending on the circumstances of a particular case.”). Whether the court was speaking exclusively about survey evidence of actual confusion, or making a broader point, is not clear. The court was responding to the alleged infringer’s argument that a jury verdict on design patent infringement could not stand when it based its decision solely on viewing the patented and accused designs without additional evidence “such as a statistical survey or other empirical data.” *Id.*; see also Krista E. Holt, Michael K. Milani & John E. Mallonee, *What Patent Lawyers Can Learn from Trademark Law: The New Use of Surveys in Patent Litigation*, INTELL. PROP. NEWSL., Spring 2006, at 1, 14 (2006) (“Surveys have also been used fairly often in design patent cases, which tend to resemble Lanham Act cases with respect to determining the importance of customer perception of the uniqueness and associations of an otherwise nonfunctional property.”).

279. *Braun*, 975 F.2d at 821.

280. *Id.*; see also *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1287 (Fed. Cir. 2002) (stating that a sample of the accused lamp was in evidence and it alone provided substantial evidence of whether an ordinary observer would believe the patented lamp and the Catalina lamp to be substantially the same). To similar effect is a line of cases ruling that expert testimony “cannot create a material issue of fact, where [a] visual comparison reveals that the alleged infringing [design] is not substantially similar to the [patented] design.” *Harel v. K.K. Int’l Trading Corp.*, 994 F. Supp. 2d 276, 284 (E.D.N.Y. 2014); see also *Wallace v. Ideavillage Prods. Corp.*, 640 F. App’x 970, 972 (Fed. Cir. 2016) (comparing the



Some lower courts have sought to refine the approach laid out in *Braun* by ruling that empirical (or expert) evidence might be useful in cases involving designs for products that the general public would not ordinarily encounter.<sup>281</sup> Still, even when acknowledging that evidence of actual consumer confusion may be relevant to design patent infringement determinations, judges have continued to insist on retaining authority to resolve design patent infringement on motions for summary judgment, which may mean that the judge steps into the shoes of the ordinary observer and resolves a case based primarily on his or her own visual comparison.<sup>282</sup> *Egyptian Goddess* already provides judges with a relevant tool by allowing

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patent drawings for a body washing brush to the photographs of an accused product set forth in plaintiff's expert report and "agree[ing] with the district court that no reasonable fact-finder would find them to be substantially the same under ... the ordinary observer test"); *cf.* *Chef'n Corp. v. Trudeau Corp.*, No. C08-01135 MJP, 2009 WL 1564229, at \*2 (W.D. Wash. June 4, 2009) (refusing to admit expert declarations on the ground that expert opinions on ordinary observers' perceptions would not assist the trier of fact, and that "the declarations lack a sufficient factual basis because there is no evidence that the opinions are based on consumer surveys or interviews").

281. *See* *Channell Com. Corp. v. Broadband Prods., Inc.*, No. EDCV 07-1228, 2008 WL 3245199, at \*5 (C.D. Cal. Aug. 6, 2008) (observing that empirical or expert evidence might be useful where the designs at issue did not involve designs for consumer products available for retail sale, and the parties had agreed that the relevant ordinary observer was a field technician).

282. *See, e.g.*, *Child Craft Indus., Inc. v. Simmons Juv. Prods. Co.*, 990 F. Supp. 638, 643 (S.D. Ind. 1998). The court expressed a willingness to consider anecdotal evidence of consumer confusion notwithstanding statements in *Braun* but faulted the patentee for relying on a limited number of "not very compelling" incidents of actual confusion among consumers, and for presenting "no evidence involving broad, neutral customer surveys or any other, more reliable, independently-gathered evidence of customer confusion." *Id.* at 643-44. The court said that when "the designs themselves are before the [c]ourt to compare," the court would make its own visual comparison, and evidence of actual confusion "would not raise a triable issue of fact." *Id.* at 644; *see also* *Moen Inc. v. Foremost Int'l Trading, Inc.*, 38 F. Supp. 2d 680, 683 (N.D. Ill. 1999) (granting summary judgment for plaintiff on design patent infringement despite lack of empirical evidence showing that ordinary observers were deceived by defendant's product). *But cf.* *Amini Innovation Corp. v. Anthony California, Inc.*, 211 F. App'x 938, 941 n.2 (Fed. Cir. 2007) (non-precedential) ("[T]he un rebutted testimony of actual confusion may be evidence from which a jury might reasonably conclude that an accused product meets the ordinary observer test."). For a notable older decision on the issue, see *Jennings v. Kibbe*, 10 F. 669, 671 (C.C.S.D.N.Y. 1882) (ruling that where neither party offered witness testimony to establish the perceptions of the ordinary observer, the judge could resolve the case based on his own observations, at least where the design was of "simple character"). Ironically, Judge Blatchford, the trial judge in the *Gorham* case and the proponent of the "eyes of the expert" standard, presided, and found infringement in a one-sentence analysis. *Id.*

judges to terminate the analysis upon concluding that the patented and accused designs are plainly dissimilar.<sup>283</sup>

The Federal Circuit has been wise to approach confusion survey evidence cautiously in design patent cases.<sup>284</sup> But a deeper and more deliberate analysis of the probative value of surveys in design patent infringement analyses might provide some new insights into what exactly design patent infringement analysis is striving to measure. For example, it might force the design patentee to articulate more precisely how the existence of source confusion might raise an inference of substantial visual similarity in a given case. It might also force the parties to provide greater particularity to their definitions of the relevant ordinary observer. On the other hand, it undoubtedly would add cost and complexity to design patent litigation.

#### CONCLUSION

Design patent law has always been puzzlingly heterogeneous, but that could turn out to be a beautiful thing, and the Federal Circuit should strive to embrace it. The Federal Circuit should recognize that, as a historical matter, the foundational *Gorham* case endorses an unfair competition approach to assessing design patent infringement. Rather than dismissing design patent infringement's kinship with unfair competition with the simple canard that design patent infringement does not concern itself with source confusion, the Federal Circuit should view unfair competition jurisprudence as a rich potential source of subtests for adjudicating design patent infringement. To demonstrate the benefits of taking that view, I have surveyed the law that has developed around the application of individual factors of the confusion tests and have shown how

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283. See *supra* note 117 and accompanying text.

284. Indeed, the Federal Circuit might consider pointing to the mixed views about the utility of surveys in trademark infringement cases as another justification for its cautious approach. The debate about the relevance of confusion evidence has also arisen in the law of copyright infringement. The conventional view is that although copyright infringement law includes a "substantial similarity" inquiry, 3 PATRY, *supra* note 274, § 9:64, the case law "does not define 'substantial similarity' by reference to likelihood of consumer confusion," but rather by the reaction of the fact-finder. *Id.* § 9:83.

2025] DESIGN PATENT INFRINGEMENT AS UNFAIR COMPETITION 1213

selected aspects of that law could inform the law of design patent infringement.