

Comparison Prior Art: Essential Context or Unnecessary Complexity?



Our Speakers



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What is Comparison Prior Art and What is its Purpose?

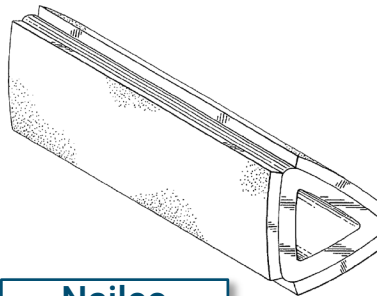
- Comparison prior art provides the “frame of reference” through which the ordinary observer compares the patented design with the accused design in an infringement analysis
- Helps calibrate how much differences count in the infringement analysis:
 - Crowded field → many similar prior designs → patented design may be close to prior art
 - Relatively small differences may be magnified and more significant in defeating infringement
 - Sparse field → patented design may be very different from prior art
 - Relatively small differences may carry less weight, so infringement may be more likely
 - Cuts both ways: if accused design copies a feature that departs conspicuously from prior art, may support infringement

Concept comes from Egyptian Goddess

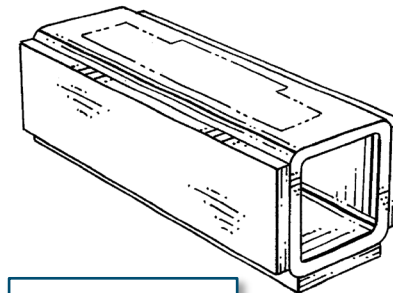
- *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc)
 - Rejected point of novelty test → sole test for infringement is ordinary observer test
 - Applied in view of prior art designs so the ordinary observer can be given a “frame of reference” in answering the question of whether one thing is like another
 - Comparison prior art can help “highlight the distinctions [and similarities] between the claimed design and the accused design.” *Id.* at 677.



Falley
Prior Art



Nailco
Prior Art



D467389

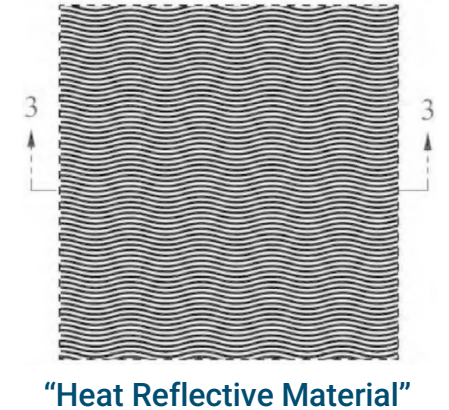


Accused
Product

- But *Egyptian Goddess* did not weigh in on the proper scope of comparison prior art that may be used in an infringement analysis ...

What Qualifies as Comparison Prior Art?

- *Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc.*, 80 F.4th 1363 (Fed. Cir. 2023)
 - Comparison prior art must be applied to the same article of manufacture identified in the design patent's claim.
 - Not enough that the comparison prior art looks similar. Must also consider the function of article of manufacture. Here: what qualified as “heat reflective material.”
 - Suggested the district court construe the term.
 - While not providing its own definition, Federal Circuit suggested that the district court might consider accused products marketing material.
 - Did not say from whose perspective you should construe the term i.e., person of ordinary skill in the heat reflective material art, an ordinary observer purchasing heat reflective material, etc.



Suitcase or Suitcase Handle or Handle?



Thank you.

