

**November 20, 2008**

## **Centuries-Old Design Patent Infringement Test Rectified**

**By Jerry Helget**

In a unanimous *en banc* patent decision, the Federal Circuit in *Egyptian Goddess, Inc. v. Swisa, Inc.* recently put the test for design patent infringement back on track with the U.S. Supreme Court's 1871 decision in *Gorham v. White*, adopting the "ordinary observer" test as the sole factor for determining design patent infringement. This decision has brought a lot of excitement and enthusiasm to design patent holders, and patent prosecutors and litigators who anticipate that *Egyptian Goddess* will bring more favorable outcomes and certainty to design patent law.

Since the mid-1980s, the Federal Circuit has used, and required district courts to use, the "point of novelty" test, which required that an accused infringing device must appropriate the novelty in the patented device that distinguished it from the prior art. This test was often supplemented with what is known as the "non-trivial advance over the prior art" test when the design included a combination of individually known design elements that constituted a "point of novelty."

Under *Egyptian Goddess*, where the patent and accused design are not "plainly dissimilar," courts are to apply the "ordinary observer" test in light of the prior art test. Unlike cases decided over the past 30 years, courts must now look for "sameness" between the patent and infringing product to determine if infringement exists (ie. "sameness of appearance, and mere difference of lines in the design patent drawings... or slight variances in configurations... will not destroy substantial identity of design.") The test is whether to an ordinary observer, not an expert, there is a "sameness of effect upon the eye." If the resemblance is such as to deceive an observer and essentially lead to the purchase of one device supposing it was the other, design patent infringement exists.

In the olden days, design patents were thought to have no scope. As we watch district courts apply the old, formerly cast away and now revitalized "ordinary observer" test, design patents may very well be found to have scope beyond what is merely in design patent drawings.