

ALERT

EN BANC PANEL OF THE FEDERAL CIRCUIT UNANIMOUSLY STREAMLINES THE TEST FOR INFRINGEMENT OF A DESIGN PATENT

Egyptian Goddess v. Swisa (Fed. Cir. 2008, en banc)

On September 22, in an unanimous en banc opinion, the Court of Appeals for the Federal Circuit streamlined the test for infringement of design patents by rejecting the “point of novelty” test as a separate requirement for a finding of infringement. Instead, the court held that the “ordinary observer” test, first announced by the United States Supreme Court in 1871, is the “sole test for determining whether a design patent has been infringed.”

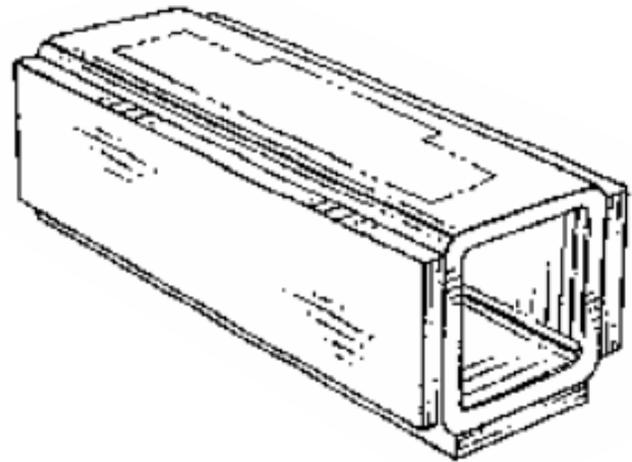
Egyptian Goddess was the owner of a design patent on a nail buffer that was comprised of a hollow, square tube that was rectangular in length with pads mounted on three of the four rectangular faces of the buffer. *Swisa* produced similar buffers with pads on all four rectangular faces.

On summary judgment, the district court held that the *Egyptian Goddess* design patent was not infringed because *Egyptian Goddess* failed to prove that the accused design appropriated the design patent’s point of novelty.

On appeal, a two-to-one panel affirmed, holding that: “For a combination of individually known design elements to constitute a point of novelty, the combination must be a non-trivial advance over the prior art.” The Federal Circuit then granted en banc review and ordered the parties to brief the issue of whether the “point of novelty” test was an appropriate measure of whether a design patent was infringed.

In 1871, the United States Supreme Court stated that the test for design patent infringement is whether the resemblance of the accused design to the claim design would deceive an ordinary observer into purchasing the wrong product. *Gorham Co. v. White*, 81 U.S. 551 (1871).

In 1984, the Federal Circuit Court of Appeals added a requirement that the accused design appropriate the novel points of the claimed design – the so called “point of novelty”



test for design patent infringement. *Litton Systems v. Whirlpool Corp.*, 728 F.2d 1323 (Fed. Cir. 1984). Since that time, both the courts and practitioners have questioned whether the point of novelty test is a “separate test” for infringement or whether it is simply part of the analysis that could go into the “ordinary observer” test. As noted by the court, the “point of novelty” test has proved to be difficult to apply when the design at issue has numerous features which could be possible points of novelty, or where the claimed design combines features found in multiple references.

The en banc court held the “ordinary observer” test can fulfill the purposes for which the “point of novelty” test was designed without the concomitant risk of confusion found in combining multiple references.

Accordingly, the en banc panel held the focus of an infringement inquiry will be to look for substantial similarity between the patented design and the accused design. The similarity is considered from the perspective of an ordinary observer who is familiar with the art. Prior art designs will



generally be useful for highlighting differences between the prior art and the patented design. Nevertheless, even under this more straight forward standard, the Court of Appeals held that “no reasonable fact finder could find that [Egyptian Goddess] met its burden of showing, by a preponderance of the evidence, that an ordinary observer, taking into account the prior art, would believe the accused design to be the same as the patented design.”

In a second pro-patent holder ruling, the court held this test for infringement places the burden of proof on the defense if the accused infringer elects to rely on the comparison of prior art as part of its defense against the claim of infringement. Under such circumstances, the burden of producing prior art is on the accused infringer.

Finally, the court held there is no requirement to provide a detailed written description of the claimed design during the claim construction process. The court noted that the problem with such claim constructions is that a detailed description can distract from the design as a whole. Instead, it may be helpful for a court to point out various features of the claimed design as they relate to the accused design and the prior art, or to explain the role of particular conventions in design patent drafting.

At bottom, the *Egyptian Goddess* decision has both simplified and streamlined the elements a design patent holder must prove to win a design patent infringement lawsuit. Alternatively, this simplification of the infringement test can also be a double-edged sword (as it was to *Egyptian Goddess*) insofar as it may make it more likely that a District Court and the Federal Circuit will feel more comfortable granting judgments of non-infringement on summary judgment.