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THE FEDERAL CIRCUIT CHANGES THE TEST FOR DESIGN PATENT INFRINGEMENT

The Federal Circuit has changed the test for design patent infringement.

Last week, a design patent holder had to satisfy two tests to successfully establish a claim for design patent infringement, namely the “ordinary observer” test and the “point of novelty” test, with the ordinary observer test requiring that the accused design actually look like the claimed design, and the point of novelty test requiring that the “point(s) of novelty” in the claimed design—those design features not found in the prior art—be present in the accused design. Not surprisingly, recent design patent infringement opinions have mostly focused on the relatively more onerous (for litigants and courts!) point of novelty test.

However, in a unanimous *en banc* opinion handed down this week, the Federal Circuit rejected the point of novelty test, holding that the ordinary observer test should be the **sole test** for determining whether a design patent has been infringed. *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 06-1562 (Fed. Cir. Sept. 22, 2008).

Further, the Federal Circuit refined the ordinary observer test, which refinement was clearly informed by the wreckage of the point of novelty test. Yes, the ordinary observer test is now the sole test for determining design patent infringement, but the test is no longer limited to a comparison of the claimed and accused designs, as it typically was rightly or wrongly. Instead, in instances where the claimed and accused designs are not plainly dissimilar, a comparison of the claimed and accused designs **with the prior art** is now required under the ordinary observer test. Moreover, the burden of introducing comparison prior art is imposed on the accused infringer, and the hypothetical ordinary observer is tasked with making the comparison of the claimed and accused designs with the prior art.

Finally, although the Federal Circuit noted that the issuance of a detailed verbal description of a claimed design by a district court is not reversible error, it nonetheless encouraged district courts to refrain from attempting to provide such a detailed verbal description when construing the claim in a design patent, indicating that a reliance on the illustrations in the design patent is the preferred course.

Notwithstanding this much needed attention to design patent law by the Federal Circuit, open issues (as always) remain, including who exactly is the ordinary observer making the comparison of the claimed and accused designs with the prior art, or at least what does the ordinary observer know, particularly in light of the court’s apparent characterization of the ordinary observer as a person “conversant with the prior art” or possibly a “purchaser familiar with the prior art,” and the court’s seeming reliance on expert testimony in *Egyptian Goddess*. Other open issues include the mechanics of the comparison of the claimed and accused designs with the prior art, and specifics as to the patentee’s burden to demonstrate infringement by a preponderance of the evidence, especially since the burden to introduce comparison prior art is now imposed on the accused infringer.

It appears as if the rejection of the point of novelty test should be, on the whole, beneficial to design patent *holders*, rather than design patent *design around-ers*. Appearances can be deceiving: the patentee in *Egyptian Goddess* still lost. Time will tell, as the Federal Circuit readily acknowledged this week: “we leave it to future cases to further develop the application of this standard.”

Haynes and Boone, LLP's intellectual property attorneys are well versed in all aspects of design patent law, including securing domestic and foreign design protection, clearing designs to minimize the risk of litigation, enforcing design patents, and defending against claims of design patent infringement. If you have any questions regarding design patents or any other aspect of intellectual property law, please contact any of the attorneys listed below.

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