

## "Ordinary Observer" Test Determines Design Patent Infringement

October 6, 2008

In a unanimous en banc ruling, the U.S. Court of Appeals for the Federal Circuit rejected use of the "point of novelty" test in design patent cases. *Egyptian Goddess, Inc. v. Swisa Inc.*, No. 2006-1562 (Fed. Cir. Sept. 22, 2008). The Federal Circuit held that the "ordinary observer" test should be the sole test of infringement for design patents. As a result, design patents have effectively been strengthened.

The Federal Circuit also ruled that:

- The accused infringer bears the burden of production of prior art if it elects to rely on the comparison of prior art as a defense.
- The level of detail used in claim construction for design patent cases is within a court's discretion. A detailed verbal description of the design is not reversible error, nor is a detailed verbal description required.

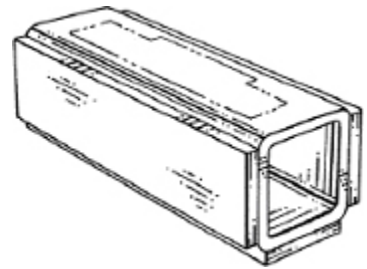
For more than 23 years, the test for design patent infringement was governed by an 1871 Supreme Court decision, which established the "ordinary observer" test, and a 1984 Federal Circuit decision, which established the additional "point of novelty" test.

The "ordinary observer" test states that a design infringes if, in the eye of an ordinary observer, the two designs are substantially similar to each other. *Gorham Co. v. White*, 81 U.S. 511, 528 (1871).

The "point of novelty" test was used with the "ordinary observer" test, which requires an infringing design to "appropriate the novelty of the claimed design." See *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984). The use of the "point of novelty" test, however, was difficult to apply when a claimed design has multiple points of novelty or where several prior art references are used.

The Federal Circuit's ruling in *Egyptian Goddess*, the Court's first en banc hearing for a design patent case, addressed the issues associated with the "point of novelty" test. The Federal Circuit ultimately held that this test is a version of the ordinary observer test. Specifically, "the comparison of designs, including the examination of any novel features, must be conducted as art of the ordinary observer test, not as a separate test focusing on particular points of novelty that are designated only in the course of litigation."

In the case, Egyptian Goddess, Inc. ("EGI") filed an infringement suit against Swisa, Inc. and Dror Swisa (collectively, "Swisa") in the District Court for the Northern District of Texas, alleging infringement of its U.S. Design Patent No. 467,389 ('389 patent) for a nail buffer. The district court issued a claim construction of the '389 patent, describing the design as "a hollow tubular frame of generally square cross section...and with rectangular abrasive pads...affixed to three sides of the frame." (See figure to right.)



**'389 Patent**

Swisa moved for summary judgment of noninfringement, which the district court granted. On appeal, a Federal Circuit panel affirmed that there was no material issue of fact as to whether the accused buffer "appropriates the points of novelty of the claimed design." The Federal Circuit granted a rehearing, en banc, to address the use of the "point of novelty" test for infringement of a design patent.

Although EGI persuaded the Court to eliminate the "point of novelty" test, the Court affirmed the finding of noninfringement for Swisa. The issue was whether an ordinary observer familiar with the prior art would be deceived into thinking that the Swisa nail buffer is the same as the '389 patent. The Federal Circuit stated that to an ordinary observer, taking into consideration the prior art, would not believe a four-sided shape with buffer pads on all four sides (the Swisa nail buffer) is the same as a four-sided shape with buffer pads on three of the four sides ('389 patent).

Although the district court applied the "point of novelty" test, and the Federal Circuit considered prior art and the "ordinary observer" test, they both reached the same conclusion -- no infringement. In so holding, the Federal Circuit used the language from *Gorham*, stating, "we hold that the accused design could not reasonably be viewed as so similar to the claimed design that a purchaser familiar with the prior art would be deceived between the claimed and accused designs, 'inducing him to purchase one supposing it to be the other.'"

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