

***Egyptian Goddess*: Filing Down the Design Patent Infringement Test to Ensure a Picture Is Worth a Thousand Words**

By John M. Halan

It has been known for centuries that a picture is worth a thousand words. That is precisely what the Federal Circuit decided recently en banc in *Egyptian Goddess Inc. v. Swisa, Inc.* 543 F.3d 665 (Fed. Cir. 2008), a case involving a design patent on nail buffers. By focusing on the drawings of a design patent to determine infringement, the Federal Circuit erased over two decades of law which had attempted to convert utility patent infringement principles to design patents.

Utility patents – the most common type of patents – are obtained to protect useful products, processes, or compositions of matter. Design patents are obtained to protect the ornamental design – the appearance – of an article of manufacture. For centuries, the scope of utility patents has been defined by written claims which can be construed and applied. Because design patents protect an ornamental design, an appropriate test for infringement has been elusive. While design patent law was the subject of three Supreme Court decisions in the 19th century, the topic has not been taken up by the Supreme Court since. One of those early decisions, *Gorham v. White*, 81 U.S. 511 (1872), set forth the test that has governed design patent infringement for over 100 years:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Unlike utility patents that have a verbal description of the patent monopoly, the above test proved difficult to apply in practice. This difficulty in application and the continual assertions of improperly broad design patent infringement claims led the Federal Circuit to add a second test to design patent infringement and to require detailed verbal descriptions.

Beginning with *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), the federal circuit added a second test required for infringement. In addition to the *Gorham* “ordinary observer” test — whether the patented and accused designs are substantially the same in the eyes of an ordinary observer – the federal circuit added a second “point of novelty” test — whether the accused device includes the points of novelty of the patented design as established by an analysis of the prior art. A patentee has been required to prove both tests to establish infringement. See, e.g., *Bern-*

hardt, LLC v. Collezione Europa USA, Inc., 386 F.3d 1371, 1378 (Fed. Cir. 2004).

The point of novelty test, in its simplest form, evaluates whether the accused design misappropriated what made the design patentable. This is, in essence, a utility patent concept borne out of claim drafting and patent prosecution amendments.

In the *Egyptian Goddess* nail buffer case, the federal circuit filed down the design patent infringement test and reversed the attempts to apply utility patent concepts to design patents.

First, the *Egyptian Goddess* court held that while claim construction in a design patent case is required, “this court has not required that the trial court attempt to provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents.” *Egyptian Goddess*, 543 F.3d at 679. Instead the court “recognized that design patents ‘typically are claimed as shown in the drawings,’ and that claim construction ‘is adapted accordingly.’” *Id.* (citation omitted). The court also “recognize[d] the risks entailed in such a description, such as the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.” *Id.* at 680. “Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.” *Id.* at 679. In other words, the fact finder in a design patent case is to focus on the design as a whole as shown in the patent – the ornamental design.

Second, despite 25 years of jurisprudence, the federal circuit held “that the ‘point of novelty’ test should no longer be used in the analysis of a claim of design patent infringement.” *Id.* at 678. The rationale underlying the “point of novelty” test, however, was maintained. The federal circuit modified the ordinary observer test to ensure that the prior art was considered in determining the scope and infringement of a design patent. While consideration of the prior art was the original rationale for adding the point of novelty test, the test as applied over the years had evolved beyond the original rationale.

The *Egyptian Goddess* decision recognized that the “point of novelty” test was unnecessary because prior art can be

considered as part of the “ordinary observer” test. More specifically, when “the claimed design and the accused design [are] sufficiently distinct ... it will be clear without more that the patentee has not met its burden of proving the two designs would appear ‘substantially the same’ to the ordinary observer” *Id.* at 678. However, the Court held that “[w]hen the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer will consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art.... Where there are many examples of similar prior designs, ... differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.” *Id.*

The Court rationalized that such “ordinary observer” reliance on the prior art is more in keeping with the underlying purposes of design patents. “[A] test that asks how an ordinary observer with knowledge of the prior art designs would view the differences between the claimed and accused designs is likely to produce results more in line with the purposes of design patent and protection.” *Id.* at 677.

Again, a picture is worth a thousand words. Now, the test for design patent infringement allows a picture to be valuable intellectual property as well. The probable results of *Egyptian Goddess* will be several. First, it is likely that more design patents will be sought to further buttress corporate intellectual property portfolios. Second, it is likely that more design patent enforcement actions will be filed. Third, it is likely that the number of trial court decisions finding design patent infringement will increase. ♪

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Practice Tips from the USPTO

By R. Scott Keller and Anna M. Budde

The Intellectual Property Law Section offered “Basic Trademark and Patent Practice for Paralegals and Lawyers” October 6 and 7, 2008 in Grand Rapids and Troy. Although primarily intended to aid new lawyers, paralegals, and administrative assistants, the speakers from the US Patent and Trademark Office provided information and practice tips that may be of more general interest.

Mr. Kery Fries, a senior legal advisor in the Office of Patent Legal Administration, offered these patent practice tips.

USPTO forms. If you alter the language of a USPTO form, remove the language that identifies the form as a USPTO form. (Forms are found at www.uspto.gov/web/forms/index.html.)

Signatures and Powers. The Office suggests you not use a combined declaration and power of attorney form when the client is actually the assignee of rights in the invention. The PTO forms are PTO/SB/80 (general power of attorney for all owned applications, copy to be filed in each specific application), PTO/SB/81 (power of attorney in specific application); and PTO/SB/90 (Statement Under 37 CFR § 3.73(b) in a specific application), which must include the reel and frame of the recorded assignment or be accompanied by a copy of the assignment being submitted or that was submitted for recordation.

For S-signatures, the practitioner—not an assistant—must type in the signature per the Code of Professional Responsibility; make sure to enclose it in *forward slashes*. Samples of acceptable signatures may be found at http://www.uspto.gov/web/offices/pac/dapp/opla/preognoticelsigexamples_alt_text.pdf. The Office may ask for confirmation or evidence of authenticity if doubt is raised by, for example, one practitioner using different electronic signatures in the application or if the signature and typed name do not clearly identify the person.

The Office no longer requires at least 30-days between approval to withdraw from representation and expiration of a time period for a response, but now requires the practitioner to certify that the client was given reasonable notice of the practitioner’s intent to withdraw prior to the expiration date, notified of the response due and time frame for responding, and given all papers and property to which the client was entitled.

Application Data Sheet. In a supplemental application data sheet, new information should be underlined and deleted information should be struck through.

Published Applications. As a result of the application publication requirement, a substitute specification is required if changes are made to the specification other than changes to the title, abstract, claim, or addition of a benefit claim. The assignment information must be in the transmittal letter or in an application data sheet for it to be printed on the published application. Request corrections before data is exported for publication. A request for cor-

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