

## Intellectual Property - USA

### *En Banc* Federal Circuit Clarifies Design Patent Law Test

Contributed by [Kenyon & Kenyon LLP](#)

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On September 22 2008 the Federal Circuit issued a unanimous *en banc* opinion in *Egyptian Goddess Inc v Swisa Inc*,<sup>(1)</sup> reworking the test for design patent infringement. The court affirmed the District Court for the Northern District of Texas's decision granting summary judgment to the accused infringer. The court rejected the 'point of novelty' and 'non-trivial advance' tests, instead holding that the 'ordinary observer' test should be the "sole test for determining whether a design patent has been infringed".

The ordinary observer test, which was originally set forth in 1871 in *Gorham Co v White*,<sup>(2)</sup> requires that substantial similarity between the patented design and the accused design be adjudged from the perspective of an ordinary observer familiar with the art. Prior art will be helpful in highlighting differences between the patented and accused designs, but the accused infringer will have the burden of producing such prior art designs.

In rejecting the point of novelty and non-trivial advance tests, the court pointed to their difficulty of application, particularly where (i) designs involve several novel features or multiple prior art references, and (ii) the outcome depends on the points of novelty enumerated during litigation. Where applicable, the court will still look to smaller points of similarity, thereby incorporating the point of novelty test into the ordinary observer test.

In this case, which involved nail buffers, the patented design holder could not meet its burden of showing by a preponderance of evidence that an ordinary observer, in view of the prior art, would find the accused and patented designs to be the same. The court elaborated that infringement would not be found under the ordinary observer test unless the accused design embodied the patented design "or any colourable imitation thereof". It also noted that when prior art exists that is similar to the patented design and where the patented and accused designs are also similar, as in the case at issue, the ordinary observer may focus on differences "which might not be noticeable in the abstract".

Therefore, design patent owners should be aware that similar prior art designs may be used to narrow the ordinary observer's focus. The decision should help to clarify design patent law jurisprudence.

For further information on this topic please contact [Michelle Mancino Marsh](#) at Kenyon & Kenyon LLP by telephone (+1 212 425 7200) or by fax (+1 212 425 5288) or by email ([mmarsh@kenyon.com](mailto:mmarsh@kenyon.com)).

#### Endnotes

(1) F3d (Fed Cir 2008).

(2) 81 US 511.

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