

### Current Test for Design Patent Infringement:

“[infringement exists if two designs are] *substantially the same through the eyes of an ordinary observer familiar with the prior art.*”

In 2008, the Federal Circuit overhauled the test for design patent infringement in *Egyptian Goddess v. Swisa*. The decision was heralded as broadening "the protection afforded by design patents" because it eliminated the problematic point-of-novelty test for infringement.

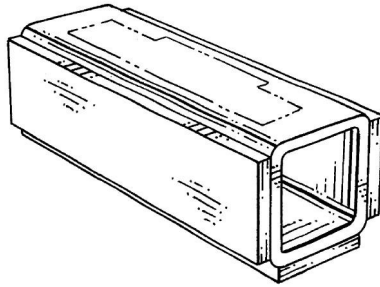
### **The Old Design Patent Infringement Test**

Prior to *Egyptian Goddess*, courts applied a two-pronged test to determine design patent infringement. The first prong—the ordinary observer test—was first articulated by the Supreme Court more than a century ago. This prong was satisfied when "two designs are substantially the same, if the resemblance is such as to deceive an observer, inducing him to purchase one supposing it to be the other." The observer should be "ordinary" and give the patented design and accused design "such attention as a purchaser usually gives." Also, the claimed design and the accused design were to be considered as a whole, not compared element by element.

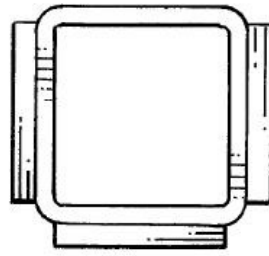
The second prong—the point of novelty test—was met only if the accused design also "appropriate[d] the novelty in the patented device which distinguish[ed] it from the prior art." Therefore, under this prong, a court must identify the novelty in the patented design, the features which distinguish it from the prior art, and determine if the accused design also includes these features. Only if the accused design includes these novel features, may the court grant a ruling of infringement. However, a court may not find infringement if the accused design merely copied aspects of the patented design that were already in the prior art.

### **Federal Circuit Modifies the Test**

In *Egyptian Goddess*, Swisa sold a nail buffer similar to Egyptian Goddess's patented design (U.S. Design Patent No. D467,389). The patented design was directed to a nail buffer having a square cross-section, raised buffer pads on three of its four sides, and exposed corners. Swisa's accused product consists of a rectangular, hollow tube having a square cross-section, raised buffer pads on all four of its sides, and exposed corners.



**Egyptian Goddess' Claimed Design**



**Swisa Nail Buffer**

The U.S. District Court for the Northern District of Texas granted Swisa summary judgment of noninfringement based on the point of novelty test. The court held that the point of novelty of the '389 patent was the unique combination of four design elements: open and hollow body, square cross-sections, raised rectangular pads, and exposed corners. However, these design elements were all shown in the prior art, and therefore, Swisa merely copied aspects of the '389 patent that were already in the prior art.

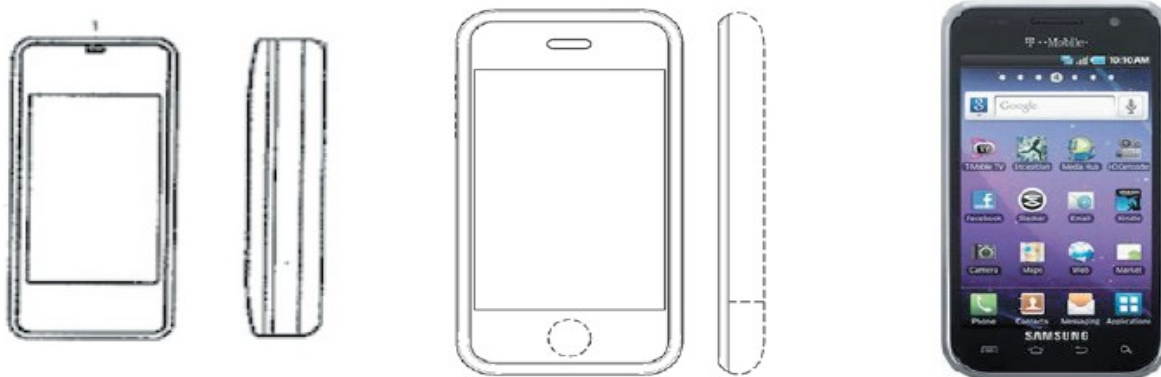
On appeal, the Federal Circuit upheld the district court's ruling of noninfringement, and the patent owner petitioned for a rehearing. Several amicus brief-submitters urged the Federal Circuit to eliminate the point of novelty test, arguing the test complicated a showing of design patent infringement.

In 2008, the en banc court struck down the point of novelty test holding that it was inconsistent with the Supreme Court's holding in *Gorham Co. v. White*. The Federal Circuit held that the ordinary observer test should be the sole test for design patent infringement, but in a modified form. Now, infringement must be determined "in light of the prior art" by "applying the ordinary observer test through the eyes of an observer familiar with the prior art."

### ***Apple v. Samsung***

In 2012, a jury in the Northern District of California returned a verdict of design patent infringement in the much publicized *Apple v. Samsung*. Apple asserted a number of design patents, including one directed to the face of a smartphone. The jury was instructed to use the modified ordinary observer test and told that "[w]hen the claimed design is visually close to prior art designs, small differences between the accused design and the claimed design may be important in analyzing whether the overall appearances of accused and claimed designs are substantially the same."

While there is no written reasoning to analyze from the jury's verdict, a comparison of the prior art, claimed design, and one of the accused Samsung products offers some insight:



### Prior Art Park B. Smith's Claimed Design Samsung's Smartphone

Verdict: US design patents only cover what is shown as solid lines. Dotted lines don't count. The left image is from Apple's US design patent D593087. The right image is of a Samsung Galaxy S 4G. The Samsung image is from the court records in [Apple v Samsung](#). The Samsung phone infringed the Apple patent even though the backs were different because the Apple patent showed the back as a dotted line and was not claimed.

### Takeaway

Following *Egyptian Goddess*, "the ability to enforce design patents has been enhanced." "Design patentees undoubtedly received a significant boost," and will have a "de facto increase in scope of protection." The elimination of the point of novelty test "increases the value of design patents."