

## Egyptian Goddess v. Swisa: Design Patent “Point of Novelty” Infringement Test Rejected in Favor of “Ordinary Observer” Test

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The Supreme Court in *Gorham Co. v. White*, 81 U.S. 511, 528 (1871) first articulated the “ordinary observer” test in design patent infringement cases as “if, in the eye of the 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.”

However, the Federal Circuit generated a second compulsory test for analyzing design patent infringement cases known as the “point of novelty” test in 1984. In *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 144 (Fed. Cir. 1984), the Federal Circuit held that “[f]or a design patent to be infringed . . . no matter how similar two items look, ‘the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.’ That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art.”

Egyptian Goddess brought suit in the U.S. District Court for the Northern District of Texas claiming that Swisa had infringed their patent claiming a design for a fingernail buffer, consisting of a rectangular, hollow tube having a generally square cross-section and featured buffer surfaces only three of its four sides. Swisa’s fingernail buffer consisted of a rectangular, hollow tube having a square cross-section, but it featured buffer surfaces on all four of its sides. The district court granted the motion for summary judgment of noninfringement for Swisa and indicated that the plaintiff in a design patent case must prove that the accused device is “substantially similar” to the claimed design under what is referred to as the “ordinary observer” test and that the accused device contains “substantially the same points of novelty that distinguished the patented design from the prior art” (*Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354).

Egyptian Goddess appealed and a three judge panel on the Court of Appeals for the Federal Circuit affirmed, continuing to apply the "point of novelty" test. The court granted *en banc* re-hearing to address whether the "point of novelty" test should continue to be used as a test for design patent infringement and, if so, how the test should be applied.

In a unanimous decision, the *en banc* Court of Appeals for the Federal Circuit held that the “point of novelty” test is inconsistent with precedent, and it unnecessary to protect against unduly broad assertions of design patent rights (*Egyptian Goddess, Inc. v. Swisa, Inc.*, 2008 WL

4290856 C.A.Fed. (Tex.)). The court only applied the “ordinary observer” test first set forth in *Gorham Co. v. White*, consequently rejecting the “point of novelty” test. The judges agreed that the “ordinary observer” test is the exclusive test for determining design patent infringement. The court noted that the best way to emphasize the similarities and differences between two designs is to view the designs in light of the prior art from the perspective of an ordinary observer. The point of novelty test presents a problem when a design patent contains several points of novelty, namely that any one point of novelty that a court chooses to focus on may determine the outcome of the case, which is avoided by using strictly the ordinary observer test.

Using the ordinary observer test, the court decided no reasonable fact-finder could find that Egyptian Goddess, Inc. met its burden of showing, by a preponderance of the evidence, that an ordinary observer, taking into account the prior art, would believe the accused design to be the same as the patented design. The court affirmed the conclusion of the district court.

Sources:

Egyptian Goddess, Inc. v. Swisa, Inc., No. 2006-1562, 2008 WL 4290856 (Fed. Cir. Sept. 22, 2008).

Egyptian Goddess, Inc. v. Swisa, Inc., Order No. 2006-1563 (Fed. Cir. Nov. 26, 2007), available at <http://www.fryer.com/EgyptianGoddessCaseFedCirOrderEnBancReview06-1562o.pdf>

For further information:

Dennis Crouch, *En Banc Federal Circuit Revives Design Patent Law*, Patently-O, <http://www.patentlyo.com/patent/2008/09/en-banc-federal.html> (last visited Oct. 6, 2008).

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