

## Service

## Intellectual Property

## Design Patent Infringement Standards Drastically Change

On September 22, 2008, the Federal Circuit Court of Appeals issued its en banc decision in *Egyptian Goddess, Inc. et al. v. Swisa, Inc.* (2006-1562). The decision, authored by Judge Bryson, rewrites the standard for determining infringement of a design patent by eliminating the so-called "point of novelty" test. The Court concluded that the "point of novelty" test should "no longer be used in the analysis of a claim of design patent infringement."

Prior to the *Egyptian Goddess* decision, the Federal Circuit had required plaintiffs alleging infringement of a design patent to prove *both* (1) that the accused device was "substantially similar" to the claimed design under what is referred to as the "ordinary observer" test, and (2) that the accused device contained "substantially the same points of novelty that distinguished the patented design from the prior art." This second component of the infringement analysis, commonly referred to as the "points of novelty" test, allowed defendants in design patent matters to force plaintiffs to identify, in words, the aspect of the patented design that was "new or novel" - i.e., not found in the prior art. However, with this decision, the singular test in determining infringement of a design patent is now "whether an ordinary observer, taking into account the prior art, would believe the accused design to be the same as the patented design."

In addition to eliminating the "point of novelty" test as part of the plaintiff's burden, the Court also cleared the air of whether a detailed claim construction is required in a design patent matter. "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." The lower court may, in its discretion, reduce the design patent claim to a verbal or written pronouncement of scope where appropriate to advise the jury of what the

patentee has specifically disclaimed or where features have a purely utilitarian (as opposed to ornamental) purpose.

In short, the "point of novelty test" has been shifted from the plaintiff's burden in proving design patent infringement to the defendant's burden in refuting infringement or attacking validity of the design patent itself. The immediate impact of this decision is that design patent plaintiffs will have a much easier time of meeting their initial burden of proof for their infringement allegations and a much easier path to trial. Design patent defendants, on the other hand, will shoulder the entire burden of identifying, evaluating and utilizing prior art in fending off design patent infringement claims. Also, without any obligation to provide a written claim construction opinion, the cost of prosecuting a design patent case has been significantly lessened.

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