



Standard for Design Patent Infringement Changed

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U.S. Design patents cover new, original and ornamental designs for articles of manufacture. For example, design patents are often used to protect ornamental furniture designs. Unlike utility patents, which cover functional features of new and useful processes, machines, manufactures and compositions of matter, design patents cover only ornamental features of articles of manufacture. Like a utility patent, a design patent gives its owner the exclusive right to make, use, offer to sell, sell and import the patented invention in the United States during the term of the patent. The term of a design patent is fourteen (14) years.

Since 1984, the test for design patent infringement has consisted of two parts. Under the first part, the ordinary observer test, “if 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.” You will probably need to read that one twice. In other words, would a purchaser buy product B, mistakenly believing it was product A because of the similarity in appearance? Under the second part, the point of novelty test, the similarity in the two designs must be attributed to the novelty that distinguishes the patented device from the prior art. Until last Monday, both parts had to be satisfied for design patent infringement to be found.

On Monday, September 22, 2008, however, the U.S. Court of Appeals for the Federal Circuit (the “CAFC”) held that both the ordinary observer test and the point of novelty test are no longer needed. In *Egyptian Goddess, Inc. v. Swisa*, 2006-1562 (Fed. Cir. Sept. 22, 2008), the CAFC unanimously held that the point of novelty test is no longer to be used as a separate test. Instead, according to the court, “a version of the ordinary observer test in which the ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art” is to be used. Despite the elimination of the point of novelty test as a separate test, the distinction between the patented design and the prior art is still relevant. The court held: “[T]he comparison of the designs, including the examination of any novel features, must be conducted as part of the ordinary observer test, not as part of a separate test focusing on particular points of novelty that are designated only in the course of litigation.”

Thus, the CAFC in *Egyptian Goddess* basically integrated the two tests into a single test. Whether this effectively makes it easier to prove design patent infringement is yet to be seen. [Click here to](#)

[download a PDF](#) of the *Egyptian Goddess* case.

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