Federal Circuit Abandons "Point of Novelty" Test for Determining Design Patent Infringement

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In *Egyptian Goddess, Inc. v. Swisa Inc*., No. 2006-1562 (Fed. Cir. Sept. 22, 2008), the Federal Circuit abandoned the confusing "point of novelty" test in favor of the longstanding "ordinary observer" test. This decision makes clear that the only test for infringement of a design patent is the "ordinary observer" test set forth by the Supreme Court in 1871.

Last year, the Federal Circuit had agreed to re-hear the case en banc to clarify its myriad confusing (and admittedly conflicting) standards for proving infringement of a design patent, especially with respect to the test that has come to be known as the "point-of-novelty" test. That test has been described as follows:

> "For 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."

After considering the briefs of the parties and 15 amici, and oral argument including four amici, the Federal Circuit abandoned the point of novelty test altogether, thus eliminating the need for the design patent owner to identify any point of novelty in its design patent(s) over the relevant prior art.

Instead, the Federal Circuit re-confirmed the proper test for infringement is the "ordinary observer" test, first suggested by the Supreme Court's Gorham decision in 1871, whereby "[I]f, 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." This now is the **only** test for design patent infringement. Under this test, "infringement will not be found unless the accused article 'embod[ies] the patented design or any colorable imitation thereof.'"

In addition to determining the proper test for design patent infringement, the Federal Circuit discussed the separate question of whether a Markman claim construction should be provided in a design patent case where the claim is to an ornamental design, as described in the drawings. The Federal Circuit noted the district court has broad discretion as to the "level of detail to be used in describing the claimed design," but recommended the district court not construe a design patent claim. The court noted, absent a showing of prejudice, a relative detailed verbal description claim construction will not be reversible error; however, the court went on to state, "[g]iven the recognized difficulties entailed in trying to describe a design in words, 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." In the end, however, the district court has the discretion to construe a design patent claim.

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