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The New Rules for Design Patent Infringement After *Egyptian Goddess*

**Frederick Linton Medlin
Lin Medlin Law, P.C.
9715 Redondo Drive
Dallas, Texas 75218**

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Table of Contents

	Page
INTRODUCTION.....	1
PRIOR TO EGYPTIAN GODDESS, AN ACCUSED DESIGN HAD TO INFRINGE UNDER BOTH OF TWO DIFFERENT TESTS.....	1
The different nature of design patents requires a different infringement analysis from that used for utility patents with written claims limitations.....	1
The ordinary observer test asks whether the accused and claimed designs produce the same effect on the eye of the non-expert purchaser of the accused device.....	1
The point of novelty test required that the accused design appropriate the novelty in the claimed design that distinguished it from the prior art.....	3
The application of the doctrine of equivalents in utility patent law provides an analogy to how the two prior infringement tests in design patent law worked together.....	4
THE FACTS AND HISTORY OF THE EGYPTIAN GODDESS CASE ILLUSTRATE HOW THE POINT OF NOVELTY TEST WORKED.....	4
The district court granted summary judgment based on the point of novelty test as it existed at the time.....	5
The designs at issue were simple, with small differences over prior art.....	5
The district court held that the Swisa Buffer could not infringe because it lacked the D’389’s only possible point of novelty, a fourth side without a raised pad.....	7
Swisa moved for summary judgment on three separate grounds.....	7
The district court ruled there could be no infringement under the point of novelty test.....	7
The Federal Circuit panel in Egyptian Goddess introduced the “non-trivial advance test.”.....	8
The panel majority ruled that a combination point of novelty had to be a non-trivial advance over the prior art.....	8
For the non-trivial advance test, the panel majority cited Smith v. Whitman Saddle.....	9

THE ARGUMENTS BEFORE THE EN BANC FEDERAL CIRCUIT.....	9
The en banc court ordered the parties to brief a series of questions.....	9
Egyptian Goddess and amici supporting it proposed two different versions of the ordinary observer test that they argued would render the point of novelty test unnecessary	10
The pure “3-way test.”.....	11
The ordinary observer test informed by the prior art, or the “contextual ordinary observer test.”.....	11
Swisa argued that both precedent and policy required retaining the point of novelty test.	11
Swisa claimed that <i>Smith v. Whitman Saddle</i> required the point of novelty test.	11
Swisa asserted that the point of novelty test was required to prevent findings of infringement where the accused design was only practicing the prior art.	12
Swisa also argued that the pure “3-way test” was unworkable.....	12
THE EGYPTIAN GODDESS COURT RULED THAT THE POINT OF NOVELTY TEST WAS A RECENT INVENTION THAT WAS INCONSISTENT WITH GORHAM, AND ELIMINATED IT.....	13
The Court asserted that <i>Litton</i> did not draw upon <i>Whitman Saddle</i> for the point of novelty test, and that the test arose from later misinterpretations of <i>Litton</i>	13
The Egyptian Goddess court found that limiting the infringement analysis to the ordinary observer test informed by the prior art was consistent with pre- <i>Litton</i> case law, including <i>Whitman Saddle</i>	14
The Applied Arts court explained that the ordinary observer must have a reasonable familiarity with the prior art.....	15
The Egyptian Goddess court explained that the two tests in <i>Litton</i> were really the one test found in <i>Applied Arts</i> and the other prior cases.....	16
Properly read, <i>Litton</i> apparently did not apply a separate point of novelty test....	16
The contextual ordinary observer test served the purpose of focusing attention on the difference between the prior art and the claimed design equally as well as the point of novelty test.....	16
Examining the novel features of a claimed design could still be important, but only as part of the ordinary observer test.....	16

Little, if anything, survives from the case law applying the point of novelty test.....	17
THE COURT AFFIRMED BECAUSE THE SWISA BUFFER COULD NOT INFRINGE UNDER THE ORDINARY OBSERVER TEST AS INFORMED BY THE PRIOR ART	
The Court held that no reasonable fact-finder could find that Egyptian Goddess had met its evidentiary burden.....	18
The en banc court harmonized its conclusion with those of the district court and panel majority.....	20
Egyptian Goddess moved for rehearing and now has petitioned for writ of certiorari.....	20
It is not yet certain by what name the ordinary observer test as informed by the prior art will be known.....	21
THE EN BANC COURT ALSO DETERMINED WHAT ROLE CLAIM CONSTRUCTION SHOULD PLAY IN THE INFRINGEMENT ANALYSIS IN DESIGN PATENT CASES.	
.....	21
District courts should ordinarily not try to provide a detailed description of the patent design, but this is in the court’s discretion.....	22
As part of claim construction the court “can” or “must” identify the non-functional aspects of the design.....	22
CONCLUSION	24

I. INTRODUCTION

The en banc Federal Circuit dramatically altered design patent law in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc). It scrapped the point of novelty test and “clarified” the ordinary observer test. The court also explained the proper application of claim construction in design patent law, ruling that ordinarily it would be preferable for district courts not to try to create lengthy verbal descriptions of designs. Additionally, the opinion seemed to say that identification of functional features of a patented design was a part of claim construction, with the implication that the ordinary observer must be deceived by a similarity in ornamental features.

II. PRIOR TO *EGYPTIAN GODDESS*, AN ACCUSED DESIGN HAD TO INFRINGE UNDER BOTH OF TWO DIFFERENT TESTS.

A. **The different nature of design patents requires a different infringement analysis from that used for utility patents with written claims limitations.**

Design patents have their own statutory basis, which provides that “[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent thereof, subject to the conditions and requirements of this title.” 35 U.S.C. § 171. Design patents thus protect the ornamental, rather than functional, aspects of a product’s design. This different purpose means that design patents, although they are subject to the same “conditions and requirements” as utility patents, have a profoundly different nature. Ornamental aspects simply cannot be conveyed adequately in words, so that design patents do not have the kind of claims that utility patents do, with written claims limitations. Instead, they have a single claim, consisting of drawings for the design. As a result, the infringement analysis must differ from that employed for utility patents.

Before *Egyptian Goddess* this infringement analysis consisted of two separate analyses, the ordinary observer test and the point of novelty test, which asked different questions and served different goals. An accused design had to infringe under both tests for there to be liability.

B. **The ordinary observer test asks whether the accused and claimed designs produce the same effect on the eye of the non-expert purchaser of the accused device.**

The ordinary observer test dates back to *Gorham v. White*, 81 U.S. 511 (1871). *Gorham* provided that an accused design infringes a claimed design if an ordinary observer, giving the usual attention of a purchaser, would be deceived into buying the accused design thinking he or she was buying the patented design.

We hold . . . that 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.

Gorham, 81 U.S. at 528. Thus the traditional ordinary observer test asks whether a purchaser could make this mistake because the accused design produced substantially the same effect on the eye as the claimed design. “[S]ameness of effect upon the eye, is the main test of substantial identity of design” *Id.* at 527. The *Gorham* test is **not** about the consumer mistaking the source of the accused design as being the same as that of a product covered by the patented design, but rather about an ordinary observer mistaking the accused design for the patented design. *Unette Corp. v. Unit Pack Co., Inc.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986) (“Likelihood of confusion as to the source of the goods is not a necessary or appropriate factor for determining infringement of a design patent.”).

The *Gorham* Court expressly stated that the ordinary observer was **not** an expert, because if the test involved producing the same effect on an expert’s eyes, there would be no protection under the statute for any design. According to the *Gorham* Court, “human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them.” 81 U.S. at 527. Therefore experts were “not the persons to be deceived” under the test. *Id.*

Instead, the ordinary observer is someone who exercises the customary care given by a purchaser of the accused product. “The measure of infringement of a design patent is deception of the ordinary observer, when such person gives the design the attention usually given by a purchaser of the item bearing the design.” *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998). The opinion in *Goodyear* is instructive. Goodyear Tire and Rubber Company (“Goodyear”) claimed that a certain tread design infringed one of its design patents. The district court found no infringement, and Goodyear appealed. One of Goodyear’s complaints on appeal was that the district court had erred in construing the word “tire” as meaning a truck tire. Goodyear argued that by this construction the court erroneously selected a purchaser of “truck tires” as the ordinary observer. The Federal Circuit agreed that the patent itself was not limited to truck tires, but “deception concerning the patented design is determined from the viewpoint of the person who is the ordinary purchaser of the article charged to be an infringement.” 162 F.3d at 1117. There was no error in the district court’s reasoning, because what was relevant was the actual use of the accused infringing tread:

The focus is on the actual product that is presented for purchase, and the ordinary purchaser of that product. The accused tire, the Hercules Power Trac, is a truck tire. The district court correctly invoked the ordinary trucker or fleet operator who purchases truck tires, as the person from whose viewpoint deceptive similarity to ‘080 design is determined.

162 F.3d at 1117 (emphasis added). “[O]ne necessary conclusion from *Goodyear* is that if the accused tire had been a passenger car or some other tire, the attributes of the ‘ordinary observer’ would also have changed, and a different infringement conclusion may have resulted.” *Minka*

Lighting, Inc. v. Craftmade International, Inc., 2001 WL 1012685, at *11 (N.D. Tex.). Consistent with *Goodyear*, the Federal Circuit determined that, where the design patent owner did not sell its patented trigger sprayer devices directly to retail customers, the ordinary observer was the industrial buyer for companies that bought stand-alone trigger sprayer devices, rather than the retail purchasers of the finished product of which the shrouds were components. *Arminak and Associates, Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1323 (Fed. Cir. 2007). The appropriate hypothetical ordinary observer is “a person who is either a purchaser of, or sufficiently interested in, the item that displays the patented designs and who has the capability of making *a reasonably discerning decision* when observing the accused item’s design” as to whether it is substantially the same as the patented design. *Id.* (emphasis added).

C. The point of novelty test required that the accused design appropriate the novelty in the claimed design that distinguished it from the prior art.

Prior to *Egyptian Goddess*, courts considered a classic articulation of the point of novelty test to be that set out by a panel of the then relatively new Federal Circuit in 1984:

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.” *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944); *Horwitt v. Longines Wittnaure Watch Co.*, 388 F. Supp. 1257 (S.D.N.Y. 1975). 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.

Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984). The purpose of this test was to focus on the difference between the claimed design and the prior art.

Although a point of novelty could be a single novel feature, it also could be a combination of features already present in the prior art, as was the case in *Litton*. If a claimed design contained a particular combination of elements, and a very close piece of prior art contained a subset of those elements, only the elements not in the subset combination could comprise the point of novelty. For example, in *Sun Hill Indus. v. Easter Unlimited*, 48 F.3d 1193, 1198 (Fed. Cir. 1995), the only differences between the claimed design for a certain leaf bag and the nearest prior art bags were contrasting jack-o-lantern faces, the bottom closure, the specific feature of the jack-o-lantern faces, and the shiny surface. “The point of novelty therefore consist[ed] *at most* of these four features.” *Id.* (emphasis added). Such a formulation led immediately to the question of what comprised the point of novelty when there were several pieces of prior art that were equally close to the claimed design. The combination point of novelty would then consist of different elements depending on the particular piece of prior art to which one compared the claimed design. Critics of the point of novelty test would portray this as a fatal flaw in whole concept of the point of novelty test.

D. The application of the doctrine of equivalents in utility patent law provides an analogy to how the two prior infringement tests in design patent law worked together.

The traditional ordinary observer test, standing by itself, was like a “substantial similarity” analysis under the doctrine of equivalents in utility patent law. In utility patent law, the doctrine of equivalents is checked by the individual claims limitations of the patent. Again, design patents have no such individual claims limitations. The point of novelty test, however, constrained the application of the doctrine of equivalents in design patent law in the same way that the claims of a utility patent limit an application of the doctrine of equivalents.

The Federal Circuit had expressly held the doctrine of equivalents could only be applied in design patent cases when the accused product included features equivalent to the novel features of the claimed design. A patentee could not invoke the doctrine of equivalents to evade scrutiny of the point of novelty, because to do so would “eviscerate the purpose of the ‘point of novelty’ approach, which is to focus on those aspects of a design which render the design different from prior art designs.” *Sun Hill, supra*, 48 F.3d at 1199 (Fed. Cir. 1995). Just as case law so limited the application of the doctrine of equivalents in design patent law, the presence of the point of novelty test also limited the equivalence analysis that was necessarily present even in a literal infringement analysis, because of the nature of the ordinary observer test.

A loose end left after the *Egyptian Goddess* decision is for the Federal Circuit to determine what role the doctrine of equivalents should play in design patent law after the demise of the point of novelty test. As the ordinary observer test itself contains an equivalence analysis, there should be no separate application of the doctrine of equivalents, which would now be unconstrained by the point of novelty test.

The reasoning of *Egyptian Goddess* indicates that the equivalence analysis inherent in the ordinary observer test, which previously had been limited by the point of novelty test, is now limited by the fact that the ordinary observer compares the claimed and accused designs in light of the prior art, as discussed more fully below.

III. THE FACTS AND HISTORY OF THE *EGYPTIAN GODDESS* CASE ILLUSTRATE HOW THE POINT OF NOVELTY TEST WORKED.

The Federal Circuit had never taken a design patent case for en banc review prior to *Egyptian Goddess*. It explained that it had granted a rehearing en banc in that case “to address the appropriate legal standard to be used in assessing claims of design patent infringement.” 543 F.3d at 668. Some understanding of the background of the case provides both a view of prior law and insight into the nature of the holding.

READERS WHO WISH LESS BACKGROUND MAY TO SKIP THIS SECTION AND GO DIRECTLY TO SECTION IV, WHICH SETS OUT THE ARGUMENTS BEFORE THE EN BANC COURT.

A. The district court granted summary judgment based on the point of novelty test as it existed at the time.

1. The designs at issue were simple, with small differences over prior art.

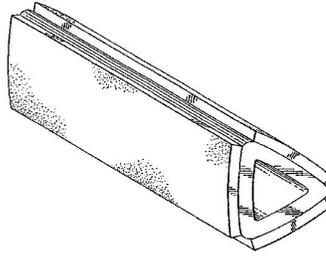
In 1987 a designer and entrepreneur named Michael Falley created what he called a “4-way buffer block” meant to be used in a four step fingernail buffing process in which the fingernail was buffed with increasingly finer abrasive surfaces to achieve a high polish. On the four long sides of a rectangular foam block he mounted four different abrasive surfaces. The foam in the underlying block absorbed the heat generated by the fingernail buffing process. The abrasive surfaces did not meet at the edges of the block, but rather stopped short of them, leaving the foam edge exposed. Falley advertised this as a “cuticle protection edge,” because if the abrasive surfaces had met the resultant sharp edge would present a danger to the cuticles during the buffing process.



The Falley Buffer Block

Falley’s company, Realys, Inc., also made a “3-way buffer” block, intended for a three step process, that lacked an abrasive surface on one of the four long sides. Falley’s 4-way and 3-way buffer blocks made by Realys, Inc. were widely available, and numerous foreign and domestic manufacturers made imitations of both.

In 1998, Nailco, Inc. asked Michael Falley to make a three-sided hollow buffer for a 3-way buffing process. This buffer had a three-sided hollow tube rather than a foam block. As foam was still needed to absorb the heat from the buffing process, the abrasive surfaces rested on foam pads that in turn rested on the underlying plastic tube. There was still a need for a cuticle protection edge, which, because of the raised pads, produced a gap at each long edge of the buffer. In August, 1998, Anne Letherby and Lawrence Gaynor, who was Nailco’s owner, applied for what became United States Design Patent D416, 648 (the “Nailco Patent”). They also obtained a utility patent on the design, United States Patent No. 5,899,210.



Drawing from the Nailco Patent

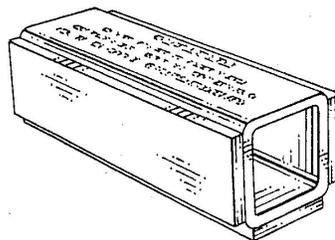
Michael Falley’s company, Reals, Inc., manufactured Nailco Buffers which looked like the above drawing from the Nailco Patent. Some of these buffers were meant for resale by Nailco, Inc. to Egyptian Goddess, Inc, (“Egyptian Goddess”).

At a Fort Worth trade show in the summer of 2001, Falley met Dror Swisa. Falley proposed to make for him a hollow, 4-way buffer. The new buffer would have every feature of the Nailco Buffer, but would add *a fourth side with a pad*, resulting in square ends like the original Falley Buffer Block. Falley began manufacturing such a buffer for Swisa, Inc, (the “Swisa Buffer”).



The Swisa Buffer

In October, 2001, the owner of Egyptian Goddess, Inc., Adi Torkiya, who was selling Nailco Buffers, applied for a design patent for a 3-way buffer that had every feature of the Nailco design, but added a fourth side *without an abrasive pad*, resulting in square ends like the Falley Buffer Block. He was issued United States Patent No. D467,389 (the “D’389” Patent”).



Drawing from the D’389 Patent

2. The district court held that the Swisa Buffer could not infringe because it lacked the D'389's only possible point of novelty, a fourth side without a raised pad.

a. Swisa moved for summary judgment on three separate grounds.

In 2003, after the D'389 Patent was granted, Torkiya assigned it to his company Egyptian Goddess, and that company sued Dror Swisa and Swisa, Inc., (collectively "Swisa"), claiming that the Swisa 4-way hollow buffer infringed. Swisa moved for summary judgment, arguing that there could be no infringement under either the ordinary observer test or the point of novelty test. The ordinary observer was someone who bought 4-way buffers and had a reasonable familiarity with them, and such an observer would not mistake a 4-way buffer like the Swisa Buffer for a 3-way buffer, but would notice that the buffer had four pads rather than three. Swisa also argued that there was only one possible point of novelty in the D'389 patent, the addition of a fourth side without an abrasive pad, and because that feature was lacking in the Swisa Buffer, there could be no infringement. Swisa further argued that the D'389 was invalid under 35 U.S.C. § 108 as obvious over the Nailco Patent.¹

b. The district court ruled there could be no infringement under the point of novelty test.

The district court considered only whether there could be infringement under the point of novelty test. Egyptian Goddess argued that its point of novelty was not the addition of a fourth side without a pad, but rather the combination of four prior art elements: (1) open and hollow body, (2) square cross section, (3) raised rectangular pads, and (4) exposed corners. Swisa countered that the point of novelty could not be such a combination, because every element was already combined in the Nailco design except for the square cross section. The District Court accepted Swisa's argument, and granted summary judgment of non-infringement under the point of novelty test.

¹ Such a finding of invalidity required that there be first a design reference in the prior art, the design characteristics of which were basically the same as the claimed design. *In re Borden*, 90 F.3d 1570, 1574-1575 (Fed. Cir. 1996). In order for secondary references to be considered, there had to be some suggestion from the prior art to modify the basic design with features from the secondary references. Put differently, the teaching of prior art designs might be combined only when the designs were so related that the appearance of ornamental features in one would suggest the application of those features in the other. *Id.* Swisa argued that the basic reference for the D'389 design was the Nailco Patent, and the Falley Buffer Block was the secondary reference. Swisa contended that any designer of a multi-step buffer that was to be a variant on the Nailco Buffer would naturally look first to the original 4-way and 3-way buffer blocks that Realys, Inc. had been marketing since 1987, and which were widely copied. All that Torkiya had done in designing the D'389 design was to return the Nailco design to the square-ended configuration of the Falley Buffer Block.

“[The Nailco Patent] discloses a nail buffer with an open and hollow body, raised rectangular pads, and open corners . . . ***EGI cannot claim the combination of those three elements in the D’389 Patent as novel when they were already combined in the Nailco Patent.*** The only point of novelty in the D’389 Patent over the Nailco Patent is the addition of the fourth side without a pad, thereby transforming the equilateral triangular cross-section into a square.” (emphasis added).

Egyptian Goddess, Inc. v. Swisa, Inc., 2005 WL 5873510, at *2 (N.D. Tex., Dec. 14, 2005) (emphasis added).

B. The Federal Circuit panel in *Egyptian Goddess* introduced the “non-trivial advance test.”

1. The panel majority ruled that a combination point of novelty had to be a non-trivial advance over the prior art.

On its appeal to the Federal Circuit, *Egyptian Goddess* continued to claim that its point of novelty was not the addition of a fourth side without an abrasive, but rather the same combination of four prior art elements: (1) open and hollow body, (2) square cross section, (3) raised rectangular pads, and (4) exposed corners. *Swisa* for its part again argued that a combination point of novelty at most consists of the difference between the claimed design and the nearest prior art, and since the *Nailco Patent* already combined the open and hollow frame, the raised pads, and the exposed corners, none of these elements could be part of *Egyptian Goddess*’ combination point of novelty. *Swisa* also argued, in both its brief and oral argument to the panel, that the court could affirm the summary judgment on the grounds that there could be no infringement under the ordinary observer test, or that the *D’389 Patent* was invalid as obvious over the *Nailco Patent*.

In a split decision, the majority of the Federal Circuit panel affirmed. In doing so, the panel majority introduced the short-lived “non-trivial advance test.” It ruled that “[f]or a combination of individually known design elements to constitute a point of novelty, the combination must be a non-trivial advance over the prior art.” *Egyptian Goddess v. Swisa*, 498 F.3d 1354, 1357 (Fed. Cir. 2007), *rehearing en banc granted, opinion vacated*, 256 Fed. Appx. 357 (Fed. Cir. 2007). Writing for the panel majority, Judge Moore noted that “nail buffers having square cross-sections were widely known in the prior art.” 498 F.3d at 1358. “In light of the prior art, no reasonable juror could conclude that [*Egyptian Goddess*]’ asserted point of novelty constituted a non-trivial advance over the prior art.” *Id.* Thus, according to the panel majority, the “district court correctly determined that only if the point of novelty included a fourth side without a raised pad could it even arguably be a non-trivial advance over the prior art.” *Id.* The *Swisa* buffers had raised, abrasive pads on all four sides, and therefore summary judgment of non-infringement had properly been granted. 498 F.3d at 1358-1359.

In reality, the district court had not determined that only if the asserted combination point of novelty included a fourth side without a pad could it even arguably be a non-trivial advance. This standard was brand new in the panel's majority decision, and there was no reason that the district court would have thought in such terms. Rather the district court, applying the law as it had existed at the time of its decision, had simply found that the addition of a fourth side without a pad was the only possible point of novelty because all of the other elements in the claimed combination point of novelty were already present in combination in the prior art Nailco Patent.

2. For the non-trivial advance test, the panel majority cited *Smith v. Whitman Saddle*.

As authority for the non-trivial advance test, Judge Moore, writing for the panel majority, cited *Smith v. Whitman Saddle*, 48 U.S. 674, 682 (1893). Prior to the en banc decision in *Egyptian Goddess*, some believed that *Whitman Saddle* had been the origin of the point of novelty test. In relying on *Whitman Saddle* for the non-trivial advance test, Judge Moore was apparently reading that case as saying that in order for there to be infringement, the accused design had to appropriate an inventive aspect of the claimed design, and that an obvious combination of features from two different prior art designs could not constitute that inventive aspect.

IV. THE ARGUMENTS BEFORE THE EN BANC FEDERAL CIRCUIT.

The Federal Circuit granted a rehearing en banc and vacated the panel decision.

A. The en banc court ordered the parties to brief a series of questions.

The first question on which the en banc court wanted briefing and argument was whether the point of novelty test should even be a test for infringement of design patents. The court then asked a series of questions going to how the point of novelty test should work if it were retained. For example, should the court adopt the non-trivial advance test adopted by the panel in the case? Should a design patentee, in defining a point of novelty, be permitted to divide closely related or ornamentally integrated features of the claimed design to match features contained in the accused design? Should it be permissible to find more than one point of novelty in a patented

design? The en banc court also asked whether the overall appearance of a design be permitted to be a point of novelty?²

Finally, the en banc court asked the parties to brief whether claim construction should apply to design patents, and, if so, what role claim construction should play in the infringement analysis. Neither party had challenged the detailed written description that the district court, as part of claim construction, had set out on its own initiative, although Swisa had argued to the panel that the district court had erred in ruling as part of claim construction that no individual features of the accused design were functional. Swisa's Appellee's Brief at 2006 WL 3884279, at *36-49.

B. Egyptian Goddess and amici supporting it proposed two different versions of the ordinary observer test that they argued would render the point of novelty test unnecessary.

The importance of the en banc court's question as to whether it should retain the point of novelty test led to twenty seven amici filing a total of sixteen amicus briefs. In general, entities that owned portfolios of patents, and associations that represented them, wanted the point of novelty test eliminated, and wrote amicus briefs supporting Egyptian Goddess. Egyptian Goddess and its amici argued that the point of novelty test was unworkable, and that the ordinary observer test could be performed in such a way as to render the point of novelty test unnecessary.

² This question had been at the heart of a case that would seem to have narrowly missed becoming the Federal Circuit's en banc examination of the point of novelty, *Lawman Armor Corp. v. Winner International, LLC*, 437 F.3d 1383 (Fed. Cir. 2006). The appellant in *Lawman* claimed that the entire combination of elements in its design was its point of novelty. The Federal Circuit panel stated that to accept the whole combination as a point of novelty, without examining how the combination differed from prior combinations, would virtually eliminate the significance of the point of novelty test. The panel observed that "[i]f the combination of old elements shown in the prior art is itself sufficient to constitute a 'point of novelty' of a new design, it would be a rare design that would not have a point of novelty." *Lawman*, 437 F.3d at 1385-1386. This language created a furor, as some understood it to mean that a combination of old elements simply could not be a point of novelty. Later the same panel, however, in its opinion denying a petition for panel rehearing, clarified that it "did not intend to cast any doubt upon [the court's] prior decisions indicating that in appropriate circumstances a combination of design elements itself may constitute a 'point of novelty.'" *Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190, 1192 (Fed. Cir. 2006). But "[s]uch a combination is a different concept than the overall appearance of a design which, as indicated, our cases have recognized cannot be a point of novelty." *Id.* The Federal Circuit then refused a petition for rehearing en banc. *Lawman Armor Corp. v. Winner Int'l, LLC*, 437 F.3d 1392 (Fed. Cir. 2006). A dissenting opinion in which three judges joined stated that the panel's position that the overall appearance of a design could not itself be a point of novelty conflicted with many cases in the court's precedent, including *Litton*, and that the Federal Circuit should rehear *Lawman* en banc.

Two versions of the ordinary observer test were proposed, although the conceptual distinction between them was often blurred.

1. The pure “3-way test.”

Under the pure “3-way test,” the fact finder, putting himself in the place of the ordinary observer, would compare the accused design to both the claimed design and the prior art, and if the accused design seemed closer to the claimed design than to the prior art, then it infringed. If the accused design seemed closer to the prior art, it did not infringe.

2. The ordinary observer test informed by the prior art, or the “contextual ordinary observer test.”

In this test, the fact finder would compare the accused and claimed designs in the context of the prior art, or put differently, the ordinary observer would be someone familiar with the prior art. This was not really a new version of the ordinary observer test. Swisa itself, in its argument to the panel that it could affirm the summary judgment below on the alternate ground that there was no infringement as a matter of law under the ordinary observer test, argued that the ordinary observer is “one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it.” *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933) (argued in Swisa’s Appellee’s Brief at 2006 WL 3884279, at *25).

C. Swisa argued that both precedent and policy required retaining the point of novelty test.

1. Swisa claimed that *Smith v. Whitman Saddle* required the point of novelty test.

Swisa asserted that the Supreme Court had adopted the essence of the point of novelty test back in 1893 in *Smith v. Whitman Saddle*, *supra*. Swisa argued that *Whitman Saddle* had set out a two step process in which first the inventive element in the claimed design was determined, and then it was determined whether that inventive aspect was present in the accused design. According to Swisa, the *Litton* point of novelty test was just a recent articulation of this two step process.

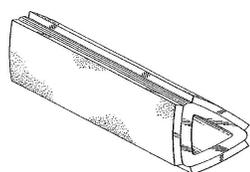
Swisa further argued that even if the Federal Circuit were not bound to retain the point of novelty by *Whitman Saddle*, there was insufficient reason to overturn the Federal Circuit’s own precedent employing the point of novelty test, which stretched back to *Litton*.

2. Swisa asserted that the point of novelty test was required to prevent findings of infringement where the accused design was only practicing the prior art.

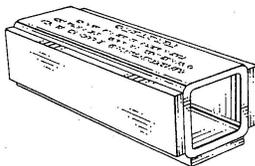
Even if precedent did not require the point of novelty test, Swisa urged the court to retain it on the grounds that the ordinary observer test, standing by itself, risked leading to findings of infringement where the accused design was only practicing the prior art. An accused design might produce the same effect on the eye of an ordinary observer because it had taken from the patented design the inventive aspects separated the patented design from the prior art. But the two designs could also look confusingly similar simply because both shared elements that were already present in the prior art. The *Gorham* Court’s admonition that the ordinary observer was not an expert exacerbated this problem, because the less expertise the ordinary observer possessed, the greater the risk of a finding of infringement when the accused design was merely practicing the prior art.

3. Swisa also argued that the pure “3-way test” was unworkable.

Swisa argued that the buffers at issue showed why the pure “three way test” would lead to improper findings of infringement.



Nearest prior art



Claimed Design



Accused Design

The accused design, the Swisa Buffer, looked closer to the claimed design, the D’389 than it did to the nearest prior art, the Nailco Buffer, even though a properly defined ordinary observer familiar with the prior art and “giving such attention as a purchaser usually gives” would not buy a 4-way buffer such as the Swisa Buffer, mistaking it for a 3-way buffer.

Even if one compared the accused design to both the Falley Buffer Block and Nailco Patent on the one hand, and the D’389 on the other, the Swisa Buffer would still look closer to the D’389 than to any of the other buffers. Thus, the pure “3-way test” led to an incorrect result.

V. **THE *EGYPTIAN GODDESS* COURT RULED THAT THE POINT OF NOVELTY TEST WAS A RECENT INVENTION THAT WAS INCONSISTENT WITH *GORHAM*, AND ELIMINATED IT.**

A. **The Court asserted that *Litton* did not draw upon *Whitman Saddle* for the point of novelty test, and that the test arose from later misinterpretations of *Litton*.**

The en banc court rejected the idea that courts had employed a separate point of novelty test prior to *Litton* or even in *Litton* itself. Rather, according to the court, it was in a “series of cases tracing their origins to *Litton*” that the Federal Circuit had held that proof of similarity under the ordinary observer test was not enough to establish design patent infringement. 543 F. 3d at 670.

Litton itself is, to say the least, ambiguous on this point. The *Litton* court had explained that the accused design had to appropriate novel aspects of the claimed design, and this meant that the similarity of the designs had to be based on their having in common the “novelty” which distinguished the claimed design from the prior art:

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.” *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944); *Horwitt v. Longines Wittnaure Watch Co.*, 388 F. Supp. 1257 (S.D.N.Y. 1975). 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.

Litton, 728 F.2d at 1444 (emphasis added).

In the *Sears, Roebuck* case on which the *Litton* court relied, the Eighth Circuit had spoken of “the test” for design patent infringement as being whether the appearance of the two designs was substantially the same. But the application of this test involved two considerations. First, the identity of appearance or sameness of effect as a whole upon the eye of an ordinary purchaser must be such as to deceive him, which is the *Gorham* test. Second, **“to infringe, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.”** 140 F.2d at 395 (emphasis added). For these two considerations, the *Sears* court had cited both *Gorham* and *Whitman Saddle*. Therefore, prior to *Egyptian Goddess*, it had seemed to some that *Litton* was setting out a separate test that was traceable directly back to *Whitman Saddle*.

The unanimous *Egyptian Goddess* court stated, however, that a “close reading of *Whitman Saddle* and subsequent authorities” indicated that the Supreme Court had not adopted a separate point of novelty test, and that in fact such a “second and free-standing requirement for

proof of design patent infringement” was inconsistent with the ordinary observer test laid down in *Gorham* and was not needed. 543 F.3d at 672.

B. The *Egyptian Goddess* court found that limiting the infringement analysis to the ordinary observer test informed by the prior art was consistent with pre-*Litton* case law, including *Whitman Saddle*.

The *Egyptian Goddess* court explained that “nothing” in the *Whitman Saddle* opinion “suggested” that the court was fashioning a separate point of novelty test for infringement. 543 F.3d at 673. According to the *Egyptian Goddess* court, the point that the *Whitman Saddle* Court “was making was that, viewed in light of the similarities between the prior art and patented design, the accused design did not contain the single feature that would have made it appear distinctively similar to the patented design rather than like the numerous prior art designs.” 543 F.3d at 673-674. The *Egyptian Goddess* court went on to explain that *Gorham* had been interpreted as employing an ordinary observer familiar with the prior art so that the fact finder would be able to determine if the accused design appropriated the inventive aspect of the claimed design.

Subsequent cases applied that principle, interpreting the ordinary observer test of *Gorham* to require that the perspective of the ordinary observer be informed by a comparison of the patented design and the accused design in light of the prior art, ***so as to enable the fact-finder to determine whether the accused design had appropriated the inventiveness of the patented design.***

543 F.3d at 674 (emphasis added). Thus the *Egyptian Goddess* court was apparently saying, at least in that part of its opinion, that the purpose of the contextual ordinary observer test was to determine whether the accused design had taken the inventive element in the patented design.

The *Egyptian Goddess* court examined cases between *Whitman Saddle* and *Litton*, and found them supportive of an ordinary observer test informed by the prior art, with such a test rendering unnecessary the point of novelty test as a means of determining whether the accused design had appropriated the inventiveness of the patented design. For example, the en banc court found significant *Zidell v. Dexter*, 262 F.145 (9th Cir. 1920). The court in *Zidell* wrote that it was “deducible” from *Whitman Saddle* that when a patented design consisted only of old elements brought together with slight modifications of form, the patent’s “invention” consisted only in those modifications. 262 F. at 146. Thus, an accused design that used the same elements with its own variations of form did not infringe, if the ordinary observer could distinguish this design. *Id.* The *Egyptian Goddess* court focused on the fact that in *Zidell*, the court had emphasized the importance of similar prior art designs to the determination of infringement under the ordinary observer test. 543 F.3d at 674. Prior to the conception of the patented garment design in *Zidell*, many similar garments had been in use and on sale, with variations in design that were “so slight as to leave to the ordinary observer the impression of a very general resemblance” 543 F.3d at 673, quoting *Zidell*, 262 F. at 147. The *Zidell* court said it had to assume that to women, who were in the main the purchasers of this class of garment, “these various coincident forms of

garments were known,” and whether such purchasers would be deceived into mistaking the accused products for garments of the patented design “would necessarily depend largely upon that general knowledge.” *Id.*

C. The *Applied Arts* court explained that the ordinary observer must have a reasonable familiarity with the prior art.

The en banc court also discussed a case that had been central to the arguments of those who wished to see the point of novelty test eliminated, *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428 (6th Cir. 1933). The *Applied Arts* court recognized that a design patent was not infringed by anything which did not “present the appearance which distinguishes the design claimed in the patent from the prior art,” and for this proposition cited several cases, but without mentioning *Whitman Saddle*. 67 F.2d at 429. The *Applied Arts* court went on to note a tension. The *Gorham* Court had said that “sameness of effect upon the eye” of the ordinary, non-expert observer was “the main test of substantial identity of design.” But it was “clearly the rule that similitude of appearance” was to be judged by “the scope of the patent in relation to the prior art.” *Id.* A question “at once” presented itself: were “these tests of identity in conflict?” *Id.* For what did “the ordinary observer, at least in the common acceptance of that phrase, know of the prior art?” 67 F.2d at 429-30.

The *Applied Arts* court tried to “reconcile” the two tests by defining the ordinary observer as one who had a “reasonable familiarity” with the prior art.

If the two tests are to be reconciled, some qualification must be recognized as applied to the ordinary observer. A careful analysis of *Gorham v. White*, and other adjudicated cases supplies the answer. The ordinary observer is not any observer, but one who, with less than the trained faculties of the expert, is ‘a purchaser of things of similar design,’ or ‘one interested in the subject.’ . . . ***So is the average observer not one who has never seen an ash tray or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment*** when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it.

67 F.2d at 430 (emphasis added). Using this definition of the ordinary observer, the *Applied Arts* court found that while there was “some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration [was] no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art.” *Applied Arts*, 67 F.2d at 430.

The *Egyptian Goddess* court embraced this “reconciliation” of the “two tests” employed by the *Applied Arts* court, and even went so far as to convey that prior to the *Litton* case, over 50 years after *Applied Arts*, there had never even been two different tests to be reconciled.

D. The *Egyptian Goddess* court explained that the two tests in *Litton* were really the one test found in *Applied Arts* and the other prior cases.

1. Properly read, *Litton* apparently did not apply a separate point of novelty test.

The *Egyptian Goddess* court stated that *Litton* and the predecessor cases on which it relied were “more properly read as applying 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.” 543 F.3d. at 676 (emphasis added). The en banc court believed that when the ordinary observer viewed the differences between the claimed and accused designs in light of the prior art, his or her attention would be drawn to those aspects of the claimed design that differed from the prior art. When a patented design was close to the prior art, small differences were likely to be important to the hypothetical ordinary observer. According to the en banc court, it was for this reason that the Supreme Court in *Whitman Saddle* had focused on the one feature of the claimed design that departed from the prior art, the sharp drop at the rear of the pommel. To an observer familiar with the prior art, this sharp drop would be important to the overall appearance of the design and would “serve to distinguish the accused design, which did not possess that feature, from the claimed design.” *Id.*

2. The contextual ordinary observer test served the purpose of focusing attention on the difference between the prior art and the claimed design equally as well as the point of novelty test.

The en banc court noted that the Federal Circuit had characterized the purpose of the point of novelty test as having been to focus on those aspects of a design which rendered it different from prior art designs. 543 F.3d at 677. But that purpose, said the *Egyptian Goddess* court, could be equally well served by applying the ordinary observer test though the eyes of an observer familiar with the prior art. “If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing.” *Id.* But, unlike the point of novelty test, this version of the ordinary observer test did not “present the risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature” simply because that feature could be characterized as a point of novelty. *Id.*

3. Examining the novel features of a claimed design could still be important, but only as part of the ordinary observer test.

The court noted that Swisa and its supporting amici had argued that one function of the point of novelty test had been “to cabin unduly broad assertions of design patent scope by ensuring that a design that merely embodies or is substantially similar to prior art designs is not found to infringe.” 543 F.3d at 678. But the better way to do this was though the ordinary

observer test, conducted in light of the prior art. This did not mean that differences between the claimed design and the prior art were irrelevant.

[E]xamining the novel features of the claimed design can be an important component of the comparison between the claimed design with the accused design. But the 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.

543 F.3d at 678. The en banc court recognized that sometimes the claimed and accused designs would be sufficiently distinct that it would be clear “without more” that the patentee had not met its burden of proving the two designs would appear substantially the same to the ordinary observer. In other cases, where the two designs were “not plainly dissimilar,” the consideration would benefit from comparing the claimed and accused designs with the prior art. Where there were many examples of prior art designs that are similar to the claimed and accused designs -- as in *Whitman Saddle* -- “differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.” *Id.*

E. Little, if anything, survives from the case law applying the point of novelty test.

The court was undoubtedly correct in affirming that the ordinary observer should have some familiarity with the prior art, and conduct the test in the context of the prior art. Neither party had argued that the proper approach to the ordinary observer test employed an observer unaware of the prior art. The version of the test the court selected was also preferable to the pure 3-way test, a dangerously simplistic exercise which could easily lead to findings of infringement where the actual customary purchasers of the accused design would not mistake it for the patented design. Yet the court’s embrace of the ordinary observer test informed by the prior art did not require abandonment of the point of novelty test. It remains to be seen whether this clarified ordinary observer test can adequately serve the goal formerly served by the point of novelty test: that of requiring that an accused design appropriate the inventiveness of the claimed design before there can be a finding of infringement.

In part because the *Egyptian Goddess* court did not expressly overrule *Litton* but purported to only properly interpret it, there is a temptation to speculate as to what extent the principles of *Litton* and other point of novelty cases survive. Cases such as *Whitman Saddle* and *Litton*, if they were all along applying the contextual ordinary observer test rather than any two test system, arguably survive to the extent that they can inform the proper application of the ordinary observer test. It is more questionable as to whether anything survives of the many cases that followed *Litton* and supposedly incorrectly read into that case a separate point of novelty test that was never there. These cases include, among others, the list of cases that were “abrogated” by the en banc court: *Lawman Armor Corp. v. Winner Int’l, LLC*, 437 F.3d 1383, 1386 (Fed. Cir.

2006) (rejecting point of novelty that consisted of overall design because it would virtually eliminate the point of novelty test); *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1383 (Fed. Cir. 2004) (“the parties and the district court have recognized” that the point of novelty test “is distinct from” the ordinary observer test); *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002) (it is legal error to merge the ordinary observer test and point of novelty test, for example by making the point of novelty the overall design); *Unidynamics Corp. v. Automatic Prods. Int’l, Inc.*, 157 F.3d 1311, 1323-24 (Fed. Cir. 1998) (“merger of the point of novelty test and the ordinary observer test is legal error”); *Sun Hill Indus. Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193 (Fed. Cir. 1995) (“The trial court’s choice of the overall design as the point of novelty, and its consequent collapsing of the point of novelty test into the substantial similarity test, constitute legal error.”); *Oakley, Inc. v. Int’l Tropic-Cal., Inc.*, 923 F.2d 167, 169 (Fed.Cir. 1991); and *Avia Group Int’l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988).

As discussed above, the *Egyptian Goddess* court seemingly believed that the ordinary observer viewing the claimed and accused designs in the light of the prior art would serve the same function as a test that specifically asked whether the accused design appropriated the inventive elements of the claimed design. These are very different approaches however. It is not necessarily the case that designs which look substantially similar to the ordinary observer who is familiar with prior art do so because of novel elements that the claimed and accused designs have in common. This is particularly true given the fact that the observer cannot be an expert. It is not yet clear where on the scale between the prohibited expert at one end and the prohibited observer working in a vacuum at the other end the ordinary observer should fall, but the farther the observer is from being an expert, the more likely the observer is to find infringement based on a similarity of shared prior art features. It was a strength of the point of novelty test that it contained no prohibition against the fact finder bringing to the issue the full knowledge of an expert.

The contextual ordinary observer test will presumably serve the goal of preventing infringement where the accused design is only practicing the prior art at least to some extent. But because the means by which the goal is to be served differ dramatically from the means employed in the point of novelty test, it is doubtful that anything significant of that case law, which illustrated the prior means, will bear on cases employing instead the contextual ordinary observer test.

VI. THE COURT AFFIRMED BECAUSE THE SWISA BUFFER COULD NOT INFRINGE UNDER THE ORDINARY OBSERVER TEST AS INFORMED BY THE PRIOR ART.

A. The Court held that no reasonable fact-finder could find that Egyptian Goddess had met its evidentiary burden.

The en banc court, having determined that the proper infringement analysis consisted of the single test where the ordinary observer viewed the claimed and accused designs in light of

the prior art, affirmed the summary judgment under that test. “[A]n ordinary observer, familiar with the prior art Falley and Nailco designs,” would not “be deceived into believing the Swisa buffer is the same as the patented buffer.”

The evidence that Swisa had advanced in its arguments in briefing to the panel demonstrated that Swisa could not infringe under an ordinary observer test where the ordinary observer was reasonably familiar with the prior art, or a customary purchaser of 4-way buffers. Advertising for 3-way and 4-way buffers stressed whether the buffers were “3-way” or “4-way.” Indeed, Egyptian Goddess’ own advertising for the buffer it sold based on the D’389 design was completely centered on the fact that the buffer was intended for a three-way process. Similarly, Swisa’s advertising for its buffer was completely centered on the fact that the buffer was for a four-step process. Swisa’s Appellee’s Brief, 2008 WL 3884279, at *27-30. Swisa further argued that the testimony of Egyptian Goddess’ expert, Kathleen Eaton, that “customers do not know the difference between or express a preference for three-way or four-way nail buffers” failed to raise an issue of fact, because it was so unreasonable and contrary to undisputed facts. *Id.* at *33-35. Moreover, even if customers did not have such preferences, purchasers still would recognize the readily-observable difference between a buffer with three abrasive pads and one with four. *Id.* at *35-36.

Rather than adopt Swisa’s particular criticisms of Eaton’s declaration, the en banc court focused on other problems with it in comparison with the declaration of Steve Falley, Swisa’s expert.³ Steve Falley’s declaration “addressed the differences among the prior art designs, the accused design, and patented design” 543 F.3d at 681. He explained why the difference between a buffer with abrasive on three sides, a 3-way buffer, and one with abrasive on four sides, a 4-way buffer, would be immediately apparent to any consumer used to buying nail buffers. 543 F.3d at 682. By contrast, the court said, Eaton’s declaration failed to even directly acknowledge that the patented design had three pads while the accused design had four, and it failed to address the fact that the design of the Nailco patent was identical to the patented design except that the Nailco design had three sides rather than four. 543 F.3d at 682. A ghost of the pure 3-way test for which Egyptian Goddess had unsuccessfully argued put in an appearance as the court observed that “[n]othing about Ms. Eaton’s declaration explains why an ordinary observer would regard the accused design as being closer to the claimed design than to the Nailco prior art patent.” *Id.* “In fact, Ms. Eaton’s reference to the prior art buffers [was] limited to the single, and conclusory, comment that an ordinary observer and purchaser of nail buffers would consider the patented design and the accused buffer to be substantially similar, ‘particularly in light of other nail buffers, such as a solid block buffer and the hollow triangular Nailco buffer.’” *Id.*

³ Swisa’s original expert in the case had been Michael Falley himself, the inventor of the three-way and four-way buffer blocks and designer of the Swisa Buffer. He died in 2004 during the course of the litigation, and was replaced by his brother, Steve Falley, who had been the Production Manager and Sales Manager for Realys, Inc.

The en banc court concluded that “[i]n light of the similarity of the prior art buffers to the accused buffer . . . no reasonable fact-finder could find that EGI 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.” 543 F.3d at 682.

B. The en banc court harmonized its conclusion with those of the district court and panel majority.

The en banc court stated that it was reaching the same conclusion that the district court had reached, and for many of the same reasons. It further stated that although it was using the “ordinary observer test as informed by the prior art,” rather than the point of novelty test, its analysis “largely” tracked that of the district court. According to it, the district court, after “analyzing the Nailco patent and the claimed design as they related to the accused design,” had concluded that in the context of nail buffers a fourth side without a pad was not “substantially the same as a fourth side with a pad.” 543 F.3d at 682. Although the district court’s focus was on an individual feature, the en banc court was satisfied that the feature was important to the whole design when viewed in light of the prior art:

While the district court focused on the differences in the particular feature at issue rather than the effect of those differences on the appearance of the design as a whole, we are satisfied that the difference on which the district court focused is important, viewed in the context of the prior art.

543 F.3d at 682-683. The en banc court also noted that its analysis under the ordinary observer test was “parallel” to that of the panel, which had focused on viewing the difference between the claimed and accused designs in light of the prior art, as had the en banc court. The panel majority’s observation that the difference between the accused design and the patented design could not be considered minor when considering the prior art in the nail buffer field “capture[d] the essence of the rationale” of the en banc court’s decision, even though the panel had employed a different analytical approach. 543 F.3d at 683.

C. Egyptian Goddess moved for rehearing and now has petitioned for writ of certiorari.

Undeterred by the unanimous nature of the en banc ruling, Egyptian Goddess filed a motion for further en banc rehearing. Egyptian Goddess’ Petition for Rehearing en Banc, 2008 WL 4651575. Egyptian Goddess argued that the en banc court had misapplied the *Gorham* test, because it took individual features from prior art designs into account rather than just comparing overall designs. Egyptian Goddess further complained that the court should not have affirmed the summary judgment when infringement was not shown under the “practical test,” that is, the pure three-way test. Egyptian Goddess was essentially arguing that the pure three-way test was the only proper test, because by comparing the accused and claimed designs only to overall designs in the prior art, without taking into account individual features in those prior art designs,

one would be in effect performing the pure three-way test rather than the ordinary observer test informed by the prior art test.

The petition for a second rehearing en banc was denied. *Egyptian Goddess* then filed a petition for writ of certiorari, asking the Supreme Court to “correct the Federal Circuit’s erroneous interpretation of the *Gorham v. White* ‘ordinary observer’” test. *Egyptian Goddess’s* Petition for Writ of Certiorari at p. 6. The Petition again argued that the Federal Circuit “erred by failing to hold that when the patented and accused designs are compared in light of the prior art designs, the comparison is to be conducted by viewing the visual effect of each design as a whole.” *Id.* Yet, in fact, the en banc court was mandating that designs be looked at as a whole, although that did not mean that individual features could not be significant. Again, the en banc court, while reconciling its opinion with that of the district court, noted that “[w]hile the district court focused on the differences in the particular feature at issue *rather than the effect of those differences on the appearance of the design as a whole*, we are satisfied that the difference on which the district court functioned is important” 543 F.3d at 683.

D. It is not yet certain by what name the ordinary observer test as informed by the prior art will be known.

The most likely name for the post-*Egyptian Goddess* ordinary observer test is simply the “ordinary observer test.” Key to the reasoning of the decision was the premise that the en banc court was not altering the test, but only clarifying what it was.

Were it necessary to distinguish the post-*Egyptian Goddess* test from the pre-*Egyptian Goddess* test, possible names that are shorter than “the ordinary observer test as informed by the prior art” include the “contextual ordinary observer test.” This name is drawn from the court’s observation that it thought that *Litton* and the predecessor cases on which *Litton* relied were “more properly read as applying 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.” 543 F.3d at 676. Another possibility is the “familiar ordinary observer test,” drawn from the court’s reference to “the ordinary observer test through the eyes of an observer familiar with the prior art.” 543 F.3d at 677. Yet another possibility is the “knowledgeable ordinary observer test,” drawn from the court’s statement that “a test that asks how an ordinary observer with knowledge of the prior art designs would view the differences between the claimed and accused designs is likely to produce results more in line with the purposes of design patent protection.” 543 F.3d at 677.

VII. THE EN BANC COURT ALSO DETERMINED WHAT ROLE CLAIM CONSTRUCTION SHOULD PLAY IN THE INFRINGEMENT ANALYSIS IN DESIGN PATENT CASES.

A. District courts should ordinarily not try to provide a detailed description of the patent design, but this is in the court’s discretion.

The last of the questions the en banc court had asked the parties and amici to brief was whether claim construction should apply to design patents, and, if so, what role it should play in the infringement analysis. The court had previously held that district courts had a duty to conduct claim construction in design patent cases, but had not prescribed any particular form that the claim construction should take. Because design patents were typically claimed as shown in drawings, the Federal Circuit had not required that district courts try to provide a detailed claim construction. 543 F.3d at 679. The *Egyptian Goddess* court noted that the Supreme Court had recognized that a design was better represented by an illustration than it could be by any description, and a description would probably not be intelligible without an illustration. 543 F.3d at 679, citing *Dobson v. Dorman*, 118 U.S. 10, 14 (1886). The court decided that the “preferable” course ordinarily would be for a district court not to try to construe a design patent claim by providing a detailed verbal description of the claimed design. But the court found it important to emphasize that a district court’s decision regarding the level of detail to be used in describing the claimed design was a matter within the court’s discretion, and absent a showing of prejudice, the court’s decision to issue a relatively detailed claim construction would not be reversible error. 543 F.3d at 679-680.

B. As part of claim construction the court “can” or “must” identify the non-functional aspects of the design.

A single sentence in the en banc opinion may have profound ramifications for the functionality doctrine as applied to individual elements of design patents. By its use of a quotation from an earlier decision, the en banc court strongly suggested that as a part of claim construction a district court *must* identify the patented design’s non-functional aspects.

[A] trial court can “usefully guide” the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those include such matters as . . . distinguishing between those features of the claimed design that are ornamental and those that are purely functional, *see Oddzon Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“Where a design contains both functional and non-functional elements, the scope of the claim *must* be construed in order to identify the non-functional aspects of the design as shown in the patent.”).

543 F.3d at 680 (emphasis added). This citation to *Oddzon* and the quotation from *Oddzon* in the parenthetical seem to answer two questions that had previously been raised as to the role of the functionality doctrine in the infringement analysis as applied to individual design aspects.

There had been uncertainty as to whether individual functional elements should be excluded from the ordinary observer test comparison in the infringement analysis. The court in *Oddzon* had stated that if a claimed design contained both functional and ornamental features, the plaintiff had to show that the perceived similarity between the two designs under the ordinary

observer test was based on the ornamental features of the claimed design. 122 F.3d at 1405. It was in order to exclude functional features from the comparison that the court had to identify what features were functional and which were ornamental as part of claim construction. Thus the quotation by the *Egyptian Goddess* court from *Oddzon* that “the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent” would seem to indicate that, as in *Oddzon*, the ordinary observer test required that the observer be deceived by a similarity in ornamental, rather than functional features.

The *Oddzon* quotation in the en banc opinion would also seem to demolish the arguments of those who had argued that identification of functional elements or features in a design was a task for the fact finder, just as was determination of whether an overall design was functional. Despite the clear language of *Oddzon*, this mistaken notion had been embraced by some courts. See, e.g., *Sofpool LLC v. Intex Recreation Corp.*, 2007 WL 4522331, at *2 (E.D. Tex. Dec. 19, 2007) (“The determination of whether an aspect of a patented design is functional or ornamental is a question of fact.”); *ADC Communications Inc. v. Panduit Corp.*, 200 F.Supp. 1022, 1035 (D.Minn. 2002) (“Whether the features of a design are functional or ornamental is an issue of fact.”). Design patent defendants should benefit from this apparent recognition by the *Egyptian Goddess* court that identification of functional aspects of a design is a rightful part of claim construction, and the implication that such functional elements should be deleted from the comparison between the accused and claimed designs in the infringement analysis. This subject is more fully explored in an article by the author: Frederick L. Medlin, *Functionality of Individual Features in Design Patents: A New Role After Egyptian Goddess*, 77 BNA'S PATENT, TRADEMARK & COPYRIGHT JOURNAL 139 (December 5, 2008). A reprint of the article is attached as Appendix A.

A fervent rebuttal to this article shows the alarm that the prospect of an invigorated doctrine of functionality of individual features apparently engenders in those seeking broader scope for design patents. Perry J. Saidman, *Functionality and the Test for Design Patent Infringement: Rarely the Twain Should Meet*, 77 BNA'S PATENT TRADEMARK & COPYRIGHT JOURNAL 201 (Dec. 19, 2008). Saidman accuses this author of a “valiant attempt to morph functionality into a full-blown infringement defense.” *Id.* at p. 201. He wants to “debunk the notion that a court needs to delineate between so-called functional and non-functional design elements during *Markman* claim construction” prior to the fact finder applying the ordinary observer test, and he “**disagrees with the dicta in *Egyptian Goddess* that suggests otherwise.**” *Id.* (emphasis added). According to Saidman, the *Egyptian Goddess* en banc decision had nothing to do with the merits of functionality,” so that “its pronouncement regarding the alleged functional/ornamental dichotomy” is dicta. *Id.* Similarly, Saidman asserts that the *Egyptian Goddess* court’s indication there might be any need to delineate between functional and ornamental design features prior to the infringement analysis “is off the mark,” but “in all fairness this question was not at issue in the *Egyptian Goddess* case.” *Id.* at p. 207.

Except that whether identification of functional features should be a part of claim construction **was** at issue, to the extent that any aspect of claim construction was “at issue”. The

en banc court had expressly asked for briefing on what role claim construction should play in the infringement analysis, and Swisa had argued that claim construction should include identification of functional features (Swisa's En Banc Appellee's Brief, 2008 WL 890914 at *45), and, on behalf of Apple, Inc., Saidman himself had argued that functionality was purely a validity issue (Amicus Brief for Apple Inc. at p. 12, n. 14, 2008 WL 699183 at *14, n. 14) ("Functionality is a validity issue, not an infringement issue"). Moreover, neither party below had argued that the district court should or should not provide detailed written descriptions in the claim construction process, or criticized the description the court provided. The *only* quarrel the parties had on appeal concerning claim construction was Swisa's argument to the panel that the district court had erred in not finding that individual elements of the accused design were functional. Thus the en banc court's statement that trial courts could "usefully guide fact finders by distinguishing between features that are ornamental and those that are purely functional" is no more dicta than anything else the en banc court said on the subject of claim construction. It seems highly unlikely that the en banc court meant for district courts or practitioners to dismiss as "dicta" or unconsidered its guidance on a topic that it had sua sponte decided to consider, had asked for and received briefing on, and had pronounced upon in the course of rewriting design patent law.

VIII. CONCLUSION

Egyptian Goddess is one of the most important cases in the history of design patent law. According to the reasoning of the unanimous en banc Federal Circuit, the infringement analysis for design patents had gone astray through numerous decisions that had apparently misinterpreted *Litton*. *Egyptian Goddess*, according to its authoritative view of the case law, returns the law to the correct analysis, employing a single infringement test involving a comparison of the accused design and the claimed design in the context of the prior art. Much remains to be worked out as to the details of the application of this test; the *Egyptian Goddess* court itself noted that, with regard to the details concerning the burden of proof and burden of production as to prior art, it was leaving it "to future cases to further develop the application of the standard." 543 F.3d at 679. Similarly, future cases must clarify where the ordinary observer lies on the continuum between, at one end, an expert, and, at the other end, someone completely unaware of the prior art.

The *Egyptian Goddess* case constituted a substantial victory for design patent plaintiffs. Moving for summary judgment under the point of novelty test had become a popular avenue for design patent defendants to escape from the uncertainties of jury trials. District courts granted many such summary judgments, and design patent plaintiffs in general must be said to have had stronger cases the day *Egyptian Goddess* was handed down than they had possessed the day before.

For design patent defendants, the only potential good that came out of *Egyptian Goddess* was the indication in the decision that determination of functionality as to individual features or aspects of designs was properly a matter of claim construction for the courts, and the implication that individual features that were functional should be deleted from the comparison under the ordinary observer test.

Whether it existed for 115 years or less than 24, the point of novelty test is no more. A new era of design patent law has begun.