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Egyptian Goddess Case – Design Patent Infringement

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AIPLA IP Practice in Japan Committee

Overview of Design Patent Infringement

- *Gorham Co. v. White*, 81 U.S. 511 (U.S. 1871)
  - Are designs substantially similar in eye of "ordinary observer" giving attention of a purchaser
  - Substantially similar if resemblance would deceive ordinary observer

Ordinary Observer

- Purchaser of things of similar design or one interested in the subject
- Has reasonable familiarity with such objects, and is capable of forming reasonable judgment whether it presents similarity with or distinctiveness from those which have preceded it. *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F. 2nd 428, 429 (6th Cir. 1933)

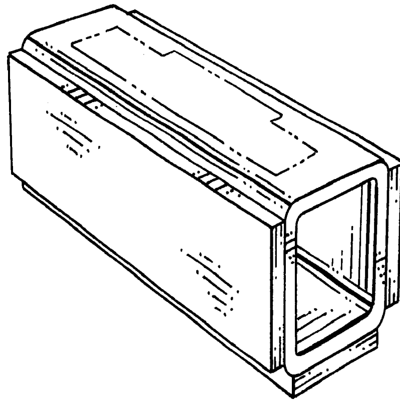
Point of Novelty Test

- Accused design “must also contain substantially the same points of novelty” as the design patent.
- Points of novelty = the differences between the prior art and the claimed design.

Egyptian Goddess, Inc. v. Swisa, Inc.

No. 2006-1562, slip op. (Fed. Cir. Aug. 21, 2007

- Design of Nail Buffer
- Alleged point of novelty to be combination of open and hollow body, a square cross-section, raised rectangular pads, and exposed corners



D‘389 PATENT

ACCUSED PRODUCT

- Closest prior had triangular cross-section
- Court found combination of open and hollow body, raised rectangular pads and exposed corners to be known in art
- Square cross-section was shown in another reference
- Court found square cross-section to be “trivial advance” and not a point of novelty (split decision)

Petition for Rehearing En Banc Granted

- 1. Should the “point of novelty” be a test for infringement of a design patent?
- 2. If so, (a) should the court adopt the non-trivial advance test adopted by the panel majority in this case;
- (b) should the point of novelty test be part of the patentee’s burden on infringement or should it be an available defense;

- (c) should a design patentee, in defining a point of novelty, be permitted to divide closely related or, ornamentally integrated features of the patented design to match features contained in an accused design;
- (d) should it be permissible to find more than one "point of novelty" in a patented design; and
- (e) should the overall appearance of a design be permitted to be a point of novelty? See Lawman Armor Corp. v. Winner Int'l, LLC, 449 F. 3rd 1190 (Fed. Cir.

Questions for Rehearing

- 3. Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? See *Elmer v. ICC Fabricating, Inc.*, 67 F. 3d 1571, 1577 (Fed. Cir. 1995)

AIPLA Amicus Brief

- THE "POINT OF NOVELTY" SHOULD BE ABROGATED AS A SEPARATE AND DISTINCT TEST FOR INFRINGEMENT
  - A. The Supreme Court's "Ordinary Observer" Test Fully Accommodates the Concerns the Point of Novelty Test Was Intended to Address
  - B. As a Separate Test for Infringement, The Point of Novelty Test Is Unworkable

- CLAIM CONSTRUCTION APPLIES TO DESIGN PATENTS AND MUST BE FOCUSED ON THE ORDINARY OBERVER'S PERCEPTION OF THE DRAWINGS
  - A. Unlike Utility Patents, The Claims Of Design Patents Are The Drawings
  - B. *Gorham* Makes Clear That The Ordinary Observer's Perception Of The Drawings Should Control Claim Construction
  - C. The USPTO Has Long Recognized That Drawings Are The Best Method For Defining Property Grants For Designs

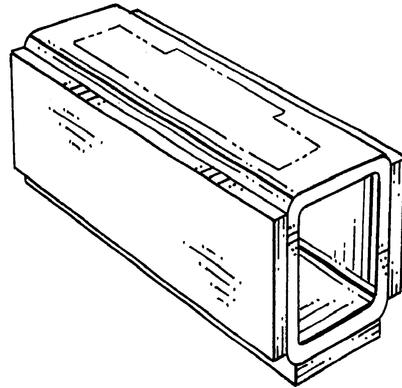
En Banc CAFC Decision

- Unanimous Decision on September 22, 2008
- …[W]e hold that the "point of novelty" test should no longer be used in the analysis of a claim of design patent infringement.
- …[W]e hold that the "ordinary observer" test should be the sole test for determining whether a design patent has been infringed.

Claim Construction in Design Cases

- "We …. leave the question of verbal characterization of the claimed designs to the discretion of trial judges, with the proviso that as a general matter, those courts should not treat the process of claim construction as requiring a detailed verbal description of the claimed design, as would typically be true in the case of utility patents."

Infringement Analysis



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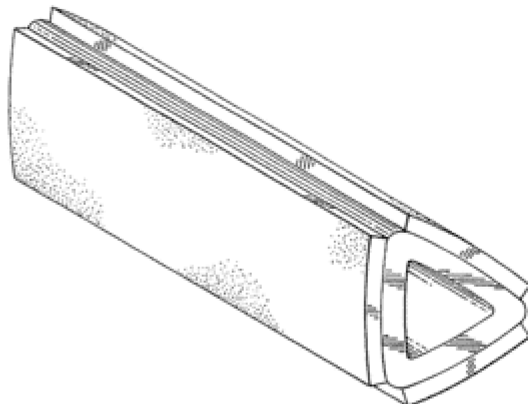

Nailco Prior Art Patent

Falley Buffer Block

CAFC Affirmed Noninfringement

- Relied on Declaration from Summary Judgment proceeding
- Ignored Statements in Declaration of Patentee’s Expert
- Mischaracterized Declaration
- Found no infringement based on new test

… oh, yes of course – it's been my pleasure …

…and thank you very much.