

Egyptian Goddess Exposed!

But Not In the Buff(er)...

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I. Introduction

The U.S. Court of Appeals for the Federal Circuit in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) has provided some long-needed relief for design patent owners.

Design patents were increasingly difficult to enforce in light of recent court decisions involving the legal issues of *Markman* claim construction, the ordinary observer test, the point of novelty test, and functionality, to name a few.² In *Egyptian Goddess* the Federal Circuit went a long way towards resolving two of those

issues: *Markman* claim construction, and the point of novelty test, by greatly limiting the former and abolishing the latter.

This article will review the pre- and post-*Egyptian Goddess* law regarding these two issues, ending with a critique of how the Federal Circuit applied its new law to the facts of *Egyptian Goddess* which, unfortunately, left something to be desired.³

II. The Old Law of Design Patent Infringement

Prior to *Egyptian Goddess*, analysis of design patent infringement was divided

2 See Perry J. Saidman, *The Crisis in the Law of Designs*, 89 J. PAT. & TRADEMARK OFF. SOC'Y 301 (April 2007).

3 The author requests the reader's indulgence as he cites and refers to several of his previous papers that discuss various relevant issues in more depth than will be done in this paper, to avoid unnecessary repetition.

into 3 steps.⁴ First, the meaning and scope of the design patent claim was construed by the court as a matter of law according to *Markman*.⁵ Second, the *Gorham* ordinary observer test⁶ was applied to determine whether the patented and accused designs were substantially the same in the eyes of an ordinary observer. Finally, the *Litton* point of novelty test⁷ was applied to determine whether the accused design appropriated the point of novelty of the patented design that distinguished it from the prior art. Only if the *Markman*-construed claim satisfied both the *Gorham* ordinary observer test and the *Litton* point of novelty test could infringement be found.

A. *Gorham*

The venerable 1871 Supreme Court decision *Gorham Mfg. Co. v. White* set forth the time-honored test for design patent infringement:

We hold therefore, 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.

This ordinary observer test is cited in every modern design patent infringement decision.

The significance of *Gorham*, and the main issue decided in that case, was that the Court determined that substantial sameness was to be viewed through the eye of an ordinary observer rather than through the eye of an expert or one versed in the trade:

The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer. The learned judge thought there could be no infringement unless there was 'substantial identity' 'in view of the observation of a person versed in designs in the particular trade in question — of a person engaged in the manufacture or sale of articles containing such designs — of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side.' There must, he thought, be a comparison of the features which make up the two designs. With this we cannot concur. Such a test would destroy all the protection which the act of Congress intended to give. *Gorham*, 81 U.S. at 527.

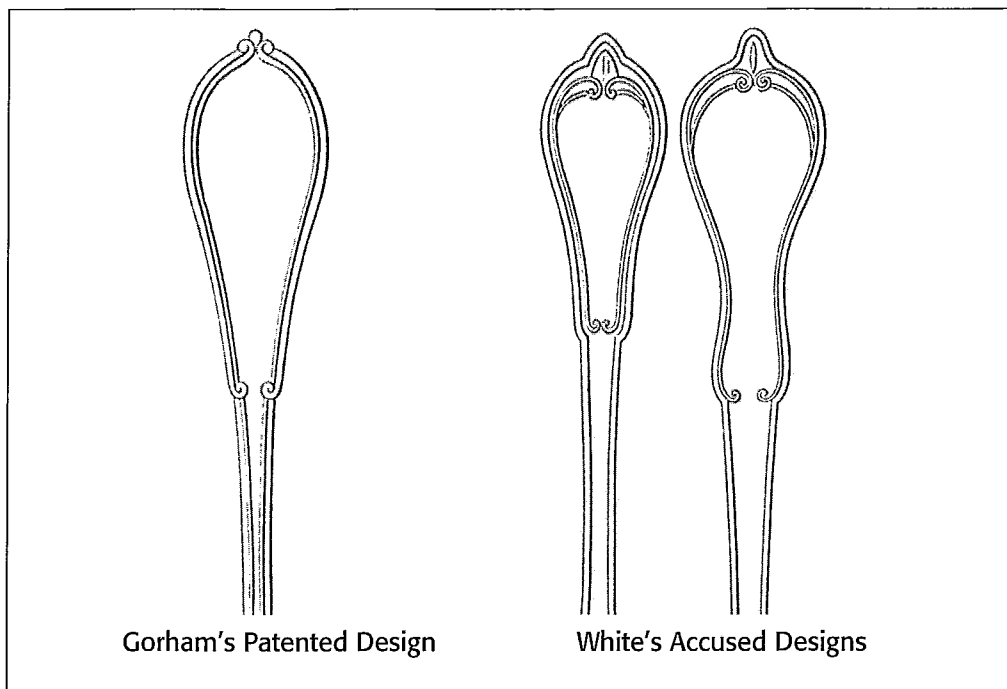
In finding infringement of *Gorham*'s design patent by two of *White*'s designs that contained differences that were readily noticeable by a person versed in the trade, the Supreme Court gave design patent owners reason to believe that their design patents would be given reasonably broad scope.

4 See, e.g., *Contessa Food Products Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002).

5 *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

6 *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871).

7 *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984).



B. Litton

In *Litton*, *supra* n.7, involving the design of microwave ovens, the Federal Circuit for the first time specifically laid down the “point of novelty” test. No previous court had used those precise words. As stated in *Litton*:

For a design patent to be infringed, however, 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 Wittnauer Watch Co.*, 388 F.Supp. 1257, 1263, 185 USPQ 123, 128 (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. This “point of novelty” approach applies only to a determination of infringement. *Litton*, 728 F.2d at 1444.

The ordinary observer test was the more subjective of the two-part test, while the point of novelty test was more objective. In applying the point of novelty test, litigants compared the claimed design to the prior art to thereby ascertain the claimed design’s point of novelty, and then determined whether the point of novelty was present in the accused design.

The point of novelty test was fraught with problems⁸, not the least of which was that there was no guidance on how it was

⁸ See Perry J. Saidman, *What is the Point of the Point of Novelty Test for Design Patent Infringement? Nail Buffers and Saddles: An Analysis Fit for an Egyptian Goddess*, 90 J. PAT. & TRADEMARK OFF. SOC’Y 401 (June 2008).

to be applied. Design patentees took one approach, which ensured that their carefully crafted point of novelty was literally present in the accused design, while accused infringers naturally took the opposite approach which ensured that their just as carefully crafted point of novelty was not present in the accused design. Indeed, until *Markman*, the point of novelty test offered the most attractive way for an accused infringer to escape liability in that it was generally understood that the *Gorham* ordinary observer test, being rather subjective, could go either way in most cases.

C. *Markman*

The *Markman* requirement that a patent's claim be construed as a matter of law prior to determining infringement, first applied to design patents by the Federal Circuit in *Elmer v. ICC Fabricating, Inc.*,⁹ has been roundly criticized for several years.¹⁰ The major objection was that often the courts in construing a design patent claim attempted to verbalize, or put into words, the claimed design as shown in the drawings.¹¹ While this sounds somewhat reasonable, the tendency of the courts was to over-verbalize the claimed design, resulting in a literal picture claim of everything shown in the design patent's drawings.

Then, the verbalized design was given to the finder of fact, the jury in many

cases, to apply the *Gorham* ordinary observer and *Litton* point of novelty tests. The main difficulty was that the *Gorham* test mandated a comparison of the claimed design as shown in the drawings with the accused design, and the verbalized design patent claim diverted the jury's attention from what the design actually looked like. The net effect was that the trier of fact wound up comparing the verbalization of the drawings with the accused design, and in many cases, inevitably found that several verbalized design features were not present in the accused design, much more often than not resulting in a holding of non-infringement. In so doing, the trier of fact would inadvertently pre-empt application of *Gorham's* "substantially the same" infringement test, which inherently embodied the doctrine of equivalents for designs,¹² substituting an essentially literal infringement test.

Moreover, after its detailed verbalization of the design patent claim, a court would frequently grant a motion for summary judgment of non-infringement,¹³ and the case would never reach the jury to enable it to determine if the two designs were substantially the same or if the accused design had the point of novelty of the patented design. If the case did reach the jury, it did so under the court's jury instructions containing its hyper-verbalization of the design, tying the hands of

9 67 F.3d 1571, 1577 (Fed. Cir. 1995).

10 See Perry J. Saidman and Allison Singh, *The Death of Gorham Co. v. White: Killing It Softly with Markman*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 792 (October 2004).

11 See Saidman, *supra* note 2, at 323-27 (discussing the devastating trend of *Markman* claim construction of design patents by comparing as an example the outcomes of a pre-*Markman* case, *Braun, Inc. v. Dynamics Corp. of Amer.*, 975 F.2d 815 (Fed. Cir. 1992), where infringement analysis focused on overall design and infringement was found despite differences in appearance, to a post-*Markman* case, *OddzOn Products Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997), where infringement analysis focused on verbalization of the design and relatively minor details rather than the overall design, and the court found no infringement).

12 See *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186 (Fed. Cir. 1988).

13 See *Design Patents: Claim Construction Rules Lead to Summary Judgment of Non-Infringement*, at <http://www.patentlyo.com/patent/2008/01/design-patents.html?cid=98131392#comment-98131392>.

the jury in many cases to an overly narrow verbalized design patent claim.

Design patent claim construction under *Markman* soon became the easiest way for infringers to avoid liability; the point of novelty test became a second tier defense. The net effect of this double-barreled attack was that after 1995 very few design patents were found infringed.

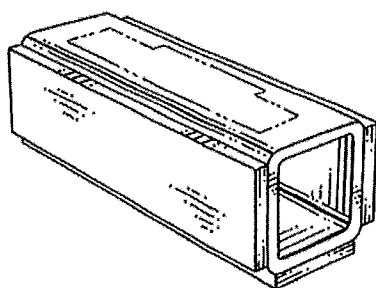
III. The New Law of Design Patent Infringement – *Egyptian Goddess*

A. Background of the Case

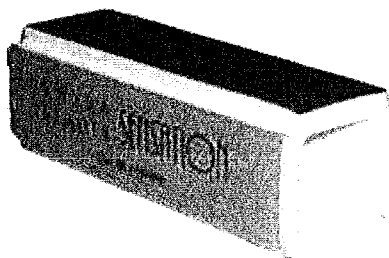
Rumblings about the point of novelty test began in the Federal Circuit's 2006 decision of *Lawman Armor Corp. v. Winner Int'l*,

L.L.C., 437 F.3d 1383 (Fed. Cir. 2006), which attracted a spate of amicus briefs in support of a petition for rehearing, which was unsuccessful. As noted in *The Crisis in the Law of Designs*¹⁴, the central holding of *Lawman* was that the point of novelty could not be a combination of old design features¹⁵, although the court's "clarification" in response to the petition for rehearing left this holding more than a little muddled¹⁶. As aptly noted by Judge Newman in her dissent to the denial of the petition on rehearing *en banc*, the law of design patent infringement as it pertained to the point of novelty test was left in a state of limbo.¹⁷

Fast forward to August, 2007 when the Federal Circuit handed down its original decision in *Egyptian Goddess, Inc. v. Swisa*,



EG's Patented Design



Swisa's Accused Design

¹⁴ Saidman, *supra*, note 2, at 315.

¹⁵ See *Lawman Armor Corp. v. Winner Int'l, L.L.C.*, 437 F.3d 1383, 1385 (Fed. Cir. 2006) ("What Lawman's contention comes down to is that the [patent in suit] contains a ninth "point of novelty," namely, the combination in a single design of the eight non-novel "points of novelty" it embodies. This argument is inconsistent with, and would seriously undermine, the rationale of the 'points of novelty' test.")

¹⁶ See *Lawman Armor Corp. v. Winner Int'l, L.L.C.*, 449 F.3d 1190 (Fed. Cir. 2006). ("In our decision, we did not intend to cast any doubt upon our prior decisions indicating that in appropriate circumstances a combination of design elements itself may constitute a 'point of novelty'. Such 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.")

¹⁷ See *id.* at 1192, 1194 ("I am concerned lest the design patent law be placed in unpredictable limbo, for many if not most design patents are novel combinations of known design elements, and design patents are examined and granted on this rationale.")

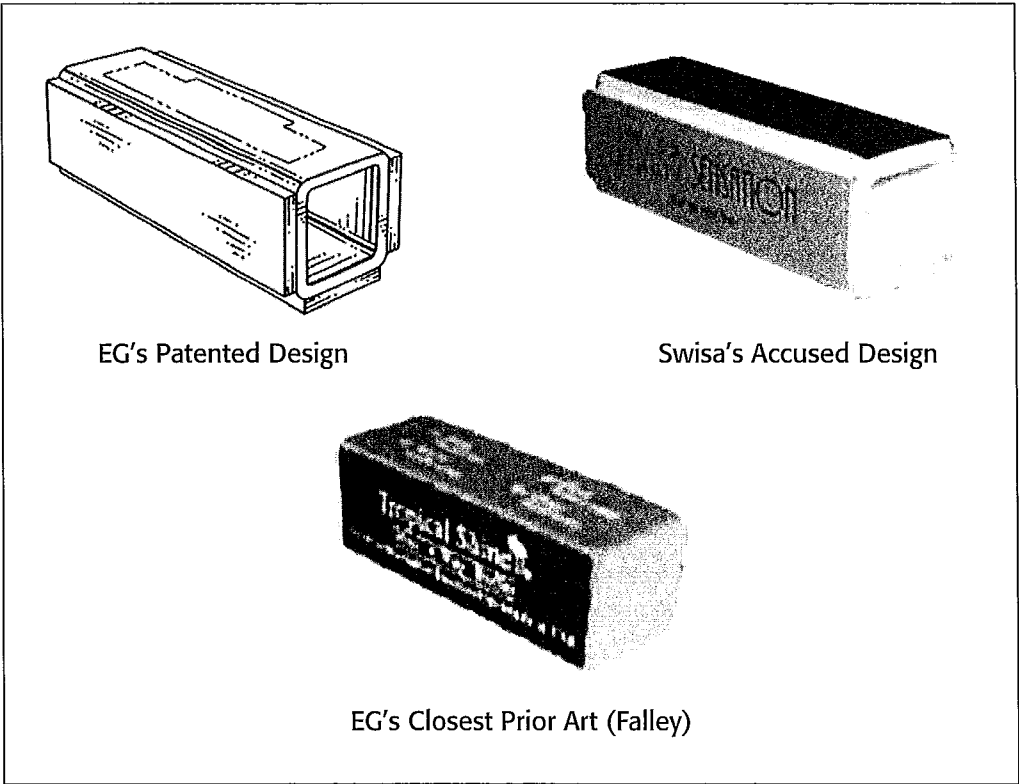
Inc., 498 F.3d 1354 (Fed. Cir. 2007), a case about the design of nail buffers.

Egyptian Goddess (“EG”) chose the Falley block, a solid, square buffer block, as its closest prior art. So, as is typical with patentees, EG submitted a point of novelty that not only distinguished its claimed design over the Falley block, but, to no one’s surprise, also read on the accused Swisa design: (1) an open and hollow body, (2) square cross-section, (3) raised rectangular pads, and (4) exposed corners. *Egyptian Goddess*, 498 F.3d at 1358.

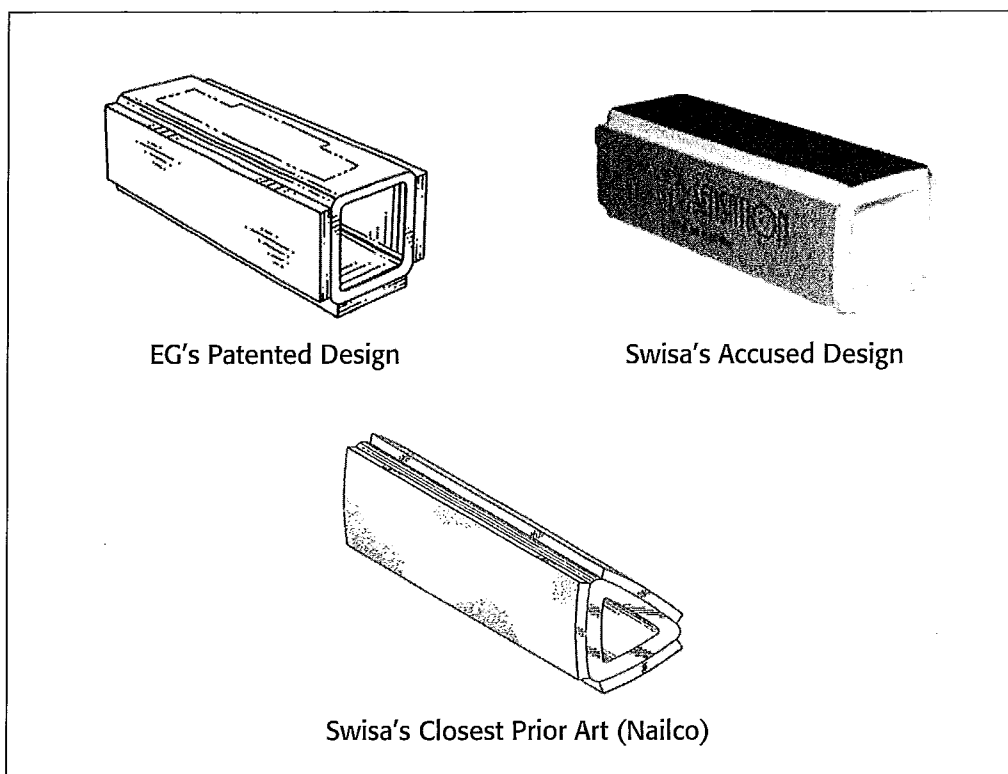
As is typical with accused infringers, Swisa had a different view of the closest prior art, choosing the triangular Nailco

buffer, and argued that everything in EG’s point of novelty was found in the Nailco prior art but for the square cross-section which EG had admitted was old.

The Federal Circuit first said that square buffers are old, essentially agreeing with Swisa, and then, out of the clear blue sky, held that EG’s point of novelty was a trivial advance over the prior art,¹⁸ and thus not sufficient to even be a point of novelty. No court had ever before mentioned the words “non-trivial advance” when discussing the point of novelty test. The court set forth no guidelines as to what was trivial or non-trivial. Then the court devised its own



¹⁸ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1358 (Fed. Cir. 2007) (“In light of the prior art, no reasonable juror could conclude that EG’s asserted point of novelty constituted a non-trivial advance over the prior art.”)



point of novelty: "only if the point of novelty includes the absence of a pad on the 4th side could it be non-trivial." *Egyptian Goddess*, 498 F.3d at 1358.

The court concluded, "Since the parties agree that the Swisa buffers do not contain a fourth side without a raised pad, summary judgment of noninfringement was properly granted." *Egyptian Goddess*, 498 F.3d at 1358-59.

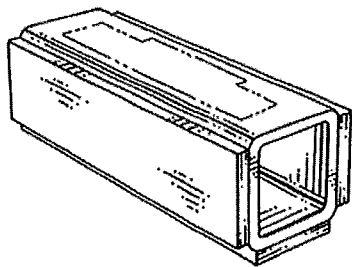
Shown on the next page are the patented design, the accused design, and both parties' closest pieces of prior art. One might ask oneself, from a visual standpoint, which is closer to which?

EG filed a petition for rehearing and rehearing en banc. Upset that the court had made it even easier for an accused infringer to avoid liability by alleging

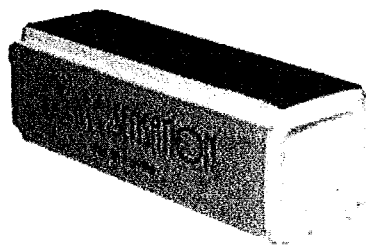
that the proffered point of novelty was trivial, the design patent bar responded with several amicus briefs in support of EG's petition.

Several months later, to everyone's surprise and delight (save Swisa), the Federal Circuit, for the first time in its history, granted an *en banc* rehearing in a design patent case, vacating its earlier *Egyptian Goddess* decision. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 256 F. Appx. 357 (Fed. Cir. 2007). The Federal Circuit posed three questions for the parties to brief, but the second question had 5 parts, so it really presented 7 questions altogether:

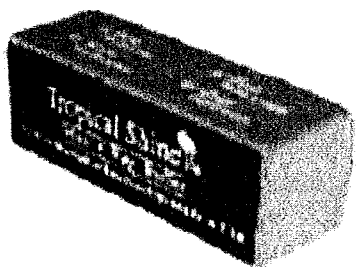
1. Should "Point of Novelty" be a test for design patent infringement?
2. If so:



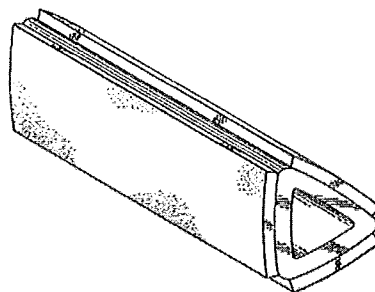
Patented Design



Accused Design



EG's Closest Prior Art (Falley)



Swisa's Closest Prior Art (Nailco)

- A. Should the Court adopt a non-trivial advance test?
- B. Should it be the patentee's burden or an affirmative 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?

- E. Should the overall appearance of a design be permitted to be a point of novelty?

3. Should claim construction apply to design patents, and if so, what role should that construction play in the infringement analysis? *Egyptian Goddess*, 256 F. Appx. at 357-58.

As it turns out, only the first and third questions really mattered, since the court essentially mooted the 5-part second question by answering no to the first question.

The first and third questions were somewhat remarkable because neither had been raised by the parties during litigation. They were overarching issues going to the heart of design patent

infringement. To this author's knowledge, no court had ever before questioned whether the point of novelty was a proper test for design patent infringement. And although the issue of *Markman* claim construction had been simmering, it was not at play in *Egyptian Goddess* since both parties had stipulated to the lower court's claim construction.¹⁹ But interestingly, the Federal Circuit's original *Egyptian Goddess* decision, after citing the lower court's incredibly narrow claim construction with approval, promptly went on to decide the merits of the case without ever referring to that claim construction.²⁰

The Court's en banc order attracted a plethora of briefs from *amici curiae*.²¹

B. Major Holdings of *Egyptian Goddess*

1. *Markman* Claim Construction

Regarding district court judges' proclivity to verbalize design patent claims, the Federal Circuit put the practice to rest, stating quite clearly:

Given 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. *Egyptian Goddess*, 543 F.3d at 679.

While stopping short of prohibiting design patent claim verbalization, the court was clearly discouraging the practice. However, the court also said it would not be reversible error to do so. *Id.*

This is unquestionably a major step forward in leveling the field for design patentees. Courts are unlikely to spend their limited resources verbalizing design patent claims in view of the Federal Circuit's guidance away from that practice in *Egyptian Goddess*. This leaves the trier of fact to make a classic visual comparison of the claimed design, as shown in the design patent drawings, with the accused design, without being unfairly biased by an overly narrow, literal claim interpretation. Since no design patent is ever literally infringed,²² *Gorham's* doctrine of equivalents is once again in full play in assessing design patent infringement.

While discouraging verbalization of design patent claims, the court did suggest that during *Markman* claim construction, there were certain things that a court could do that might be helpful to the trier of fact, including:

1. Pointing out various features of the claimed design as they relate to the accused design and the prior art;
2. describing the role that conventions play in design patent drafting;

¹⁹ *Egyptian Goddess*, 498 F.3d at 1356.

²⁰ *Id.* at 1358.

²¹ Sixteen *amicus curiae* briefs were submitted, by: The American Intellectual Property Law Association; Apple Inc.; The Bar Association of the District of Columbia-Patent; The Curiae Fédération Internationale Des Conseils in Propriété Industrielle; Daisy Manufacturing Company; Electrolux Home Products, Inc. and Nike, Inc.; Elite Group, Inc. and Sensio, Inc.; The Federal Circuit Bar Association; Ford Global Technologies, LLC; The Houston Intellectual Property Law Association; The Industrial Designers Society of America; The Intellectual Property Law Association of Chicago; The Intellectual Property Owners Association; LKQ Corporation, et al.; Monster Cable Products, Inc.; and Professor William T. Fryer, III.

²² At least, those rare cases of literal infringement would presumably be settled rather quickly.

3. describing the effect of the prosecution history of the patented design; and
4. distinguishing between those features of the claimed design that are ornamental and those that are purely functional. *Egyptian Goddess*, 543 F.3d at 680.

The author disagrees with the latter suggestion that the court needs to delineate between functional and non-functional elements before applying the *Gorham* test.²³ There is no need to distinguish between functional and non-functional elements before applying the *Gorham* test because the entire claimed design has been deemed ornamental under 35 U.S.C. § 171 by the PTO granting the patent in the first place. The presence or absence of so-called functional features doesn't matter because the *Gorham* test is performed on the claimed design as a whole, and not on selected elements thereof. If an accused infringer believes that the entire claimed design is impermissibly functional, i.e., if there are no other designs that can perform substantially the same function, then the design patent will be subject to a properly pled invalidity defense.

2. Point of Novelty

The Federal Circuit in its en banc *Egyptian Goddess* decision abolished the point of novelty test as a component of design patent infringement analysis. It is no longer a requirement that the patentee prove that the point of novelty of the

patented design be found in the accused design. This is, perhaps, the most significant holding of the case, especially for patentees.

More particularly, the Federal Circuit held:

the "point of novelty" test should no longer be used in the analysis of a claim of design patent infringement, and

the "ordinary observer" test should be the sole test for determining whether a design patent has been infringed. *Egyptian Goddess*, 543 F.3d at 678.

However, in so stating, the court in fact did tweak the *Gorham* ordinary observer test. The original *Gorham* holding had nothing whatsoever to do with the prior art; the decision was all about deciding through whose eyes substantial similarity was to be viewed, an expert's, or an ordinary observer's.²⁴ And the Court in *Gorham* decided that it would be through the eyes of an ordinary observer. The prior art was never mentioned, and was not a part of that case.

How did the Federal Circuit tweak *Gorham*, and what is the new test? Although there is no strikingly clear singular statement in *Egyptian Goddess* setting forth the new test, the Federal Circuit reinterpreted *Litton* and older cases²⁵ as applying a "version of the ordinary observer test in which the ordinary observer is deemed to view the differences between the patent-

²³ See Perry J. Saidman, *The Dysfunctional Read Test: Missing the Mark(man) Regarding the Test for Design Patent Infringement*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 533 (July 2008).

²⁴ See discussion at IIA, *supra*.

²⁵ See, e.g., *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944); *Horwitt v. Longines Wittnauer Watch Co.*, 388 F. Supp. 1257, 1263, 185 U.S.P.Q. 123, 128 (S.D.N.Y. 1975).

ed design and the accused product in the context of the prior art". *Egyptian Goddess*, 543 F.3d at 676.

So, the tweak is this: *Gorham's* "ordinary" observer now takes into account the prior art in determining substantial sameness.

The court also imposed a requirement that the alleged infringer has the burden of production of this prior art:

If the accused infringer elects to rely on the comparison prior art as part of its defense against the claim of infringement, the burden of production of that prior art is on the accused infringer...but the ultimate burden of proof to demonstrate infringement falls on the patentee. *Egyptian Goddess*, 543 F.3d at 676.

a. Is the New Test Consistent with Gorham?

In its en banc *Egyptian Goddess* decision, the Federal Circuit cited *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*²⁶ with approval. *Egyptian Goddess*, 543 F.3d at 674-76. In *Applied Arts*, the court recognized the tension between the ordinary observer test and case law that required the accused design "present the appearance which distinguishes the design claimed in the patent from the prior art" in order to infringe. *Applied Arts*, 67 F.2d at 429.

The court queried:

What does the ordinary observer, at least in the common acceptance of that phrase, know of the prior art? If the two tests are to be reconciled, some

qualification must be recognized as applied to the ordinary observer. *Applied Arts*, 67 F.2d at 429-30.

The court then answered:

[T]he average observer [is] not one who has never seen an ash tray or a cigar lighter [the designs at issue in the case], 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. *Applied Arts*, 67 F.2d at 430.

Thus, according to *Applied Arts*, the ordinary observer is "a purchaser of things of similar design." *Applied Arts*, 67 F.2d at 429.

The *Egyptian Goddess* holding essentially elevated *Gorham's* ordinary observer to one who views the patented design and accused design within the context of, and presumably having familiarity with, the prior art. In other words, the *Egyptian Goddess* ordinary observer is just like the *Applied Arts* ordinary observer, i.e., someone versed in the trade.

However, it is beyond question that the Supreme Court in *Gorham* explicitly rejected the lower court's finding that substantial sameness was to be judged through the eye of a person versed in designs in the particular trade in question, or of a person engaged in the sale of articles containing such designs.²⁷ In finding that the eye was to be that of an "ordinary"

²⁶ 67 F.2d 428 (6th Cir. 1933).

²⁷ See *Gorham*, 81 U.S. at 528.

observer, the Court *lowered* the level of scrutiny of the person charged with determining substantial sameness. The Court concluded that to view substantial sameness through the eye of an expert or of someone versed in the trade would deny the protection that Congress sought to provide, because every expert or person versed in the trade would be able to visually discern differences between the patented design and accused design. This is clearly manifested in the Supreme Court's holding in *Gorham* where, despite readily noticeable differences in the two silverware handles, easily observed by persons versed in the trade such as witnesses from Tiffany's, infringement was found, because the visual acuity standard was lower — the standard made sure that colorable imitations would not be permitted to escape liability:

There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them. *Gorham*, 81 U.S. at 527.

Applied Arts elevated the standard by saying that the so-called "ordinary" observer was a person versed in the trade, a person familiar with the prior art. This returned the law at that time to pre-*Gorham* standards. One rationale for the *Applied Arts* court going in that direction was perhaps

because it was struggling with how to take into account the prior art so that the design patent would not encompass the prior art, a perfectly reasonable objective. This is similar to what the Supreme Court did in *Whitman Saddle* (discussed *infra*, not cited in *Applied Arts*), and exactly why the point of novelty test, although flawed, eventually emerged: to prevent the *Gorham* test from allowing the design patentee to extend his scope of coverage to include the prior art or to include a design that is deemed obvious in view of the prior art.²⁸ So, *Applied Arts* is understandable, but seems to fly in the face of *Gorham* in the same manner as the Federal Circuit's *en banc Egyptian Goddess* decision.

Perhaps the clearest way for *Egyptian Goddess* to get to the Supreme Court, if EG wishes to go there, is to argue that *Egyptian Goddess* took the ordinary meaning out of "ordinary observer". The post-*Egyptian Goddess* observer is no longer ordinary.²⁹ The observer is now one versed in the trade, familiar with the prior art designs. Not only does this contradict the fundamental rationale of *Gorham*, it doesn't make any real world sense because most consumers, shopping for example in a big box retail store buying a pair of sneakers, have absolutely no idea of the prior art, and couldn't care less. They might nevertheless mistake the Wal-Mart knock-off for Nike's patented "Shox" design.³⁰ This new ordinary observer will perhaps result in fewer

²⁸ The *Egyptian Goddess* decision on re-hearing dealt with this issue in 2 sentences, without elaboration: "One function that has been served by the point of novelty test, according to Swisa and its supporting amici, is 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. Again, however, we believe that the preferable way to achieve that purpose is to do so directly, by relying on the ordinary observer test, conducted in light of the prior art." *Egyptian Goddess*, 543 F.3d at 678.

²⁹ See *Arminak & Assoc's v. Saint-Gobain Calmar, Inc.*, 424 F. Supp. 2d 1188 (C.D. Cal. 2006), *aff'd*, 501 F.3d 1314 (Fed. Cir. 2007), *cert. denied*, 128 S. Ct. 2906 (2008) (elevating the ordinary observer to a corporate buyer to the exclusion of the ultimate retail purchaser).

³⁰ See *Nike, Inc. v. Wal-Mart Stores, Inc.*, No. 1:08-cv-05840 (N.D. Ill. Oct. 13, 2008).

patent case *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893), which many believed to be the origin of the point of novelty test. Whitman got a design patent on a saddle.

The Supreme Court in *Whitman Saddle* said that the back half of the saddle (D), the so-called Jenifer cantle, was old, and the front half of the saddle (B), the so-called Granger saddle, was old, and that the sharp drop at the rear of the pommel (b-c) was what was new and material, since Whitman's patent would not have issued without it. *Whitman Saddle*, 148 U.S. at 682.

The Court concluded that since the defendant's saddle did not have that sharp pommel drop, it did not infringe. *Id.* Just reading the decision, the words of the Supreme Court sound eminently reasonable, and also sound a lot like the point of novelty test.

But the Federal Circuit in *Egyptian Goddess* said that *Whitman Saddle* was not about the point of novelty. *Egyptian Goddess*, 543 F.3d at 672. They said that the point of novelty test was a relatively recent incarnation, circa 1984 in the *Litton* case, and the point the Supreme Court was making in *Whitman Saddle* was that, viewed in light of the similarities between the prior art and the 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. *Id.*

More about *Whitman Saddle* below.

C. Application of the New Gorham Test – Guidelines

In its en banc *Egyptian Goddess* decision, the Federal Circuit gave no explicit instructions for applying the new *Gorham* test, but it did discuss several helpful guidelines.³³

Following are several of the most interesting guidelines.

1. The 3-Way Visual Comparison

When the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer. *Egyptian Goddess*, 543 F.3d at 676.

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.* at 677.

These guidelines, in calling for a comparison between the patented design, the accused design, and the prior art, sound somewhat like the 3-way visual test that was advocated in several amicus briefs, including that of Apple Inc., namely:

When the claimed design or accused design is closer to the prior art than to

³³ The court did not set its discussion out as "guidelines" and its discussion is arguably only *dicta*, but it is generally well reasoned and instructive for various situations likely to be encountered.

each other, it is more likely that not that the claimed and accused designs are not substantially the same; and when the claimed design is closer to the accused design than either is to the prior art, it is more likely than not that the claimed and accused designs are substantially the same.³⁴

Almost needless to say, one must visually observe the patented design, the accused design, and the prior art, in order to make this judgment.

There are several examples in prior cases going back many decades that have essentially employed this 3-way visual test.³⁵

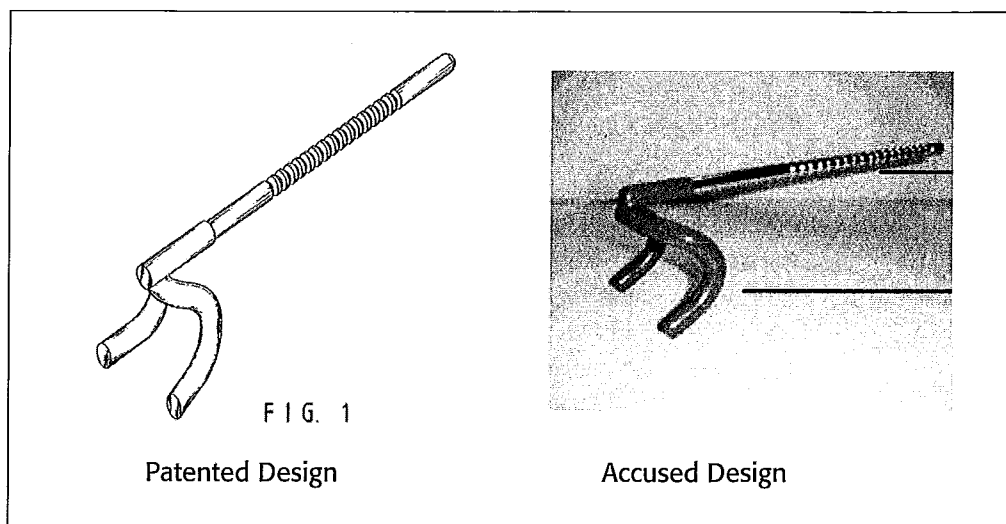
It seems that the 3-way visual test would be an ideal one for decision by a jury, ostensibly a group of ordinary observers.³⁶

2. How to Deal with a Combination of Old Design Features

If the claimed design consists of a combination of old features that creates an appearance deceptively similar to the accused design, even to an observer familiar with similar prior art designs, a finding of infringement would be justified. *Egyptian Goddess*, 543 F.3d at 677.

This guideline deals directly with the *Lawman* decision.³⁷ The patented and accused designs are reproduced below.

In finding non-infringement, the court said that Lawman's point of novelty impermissibly consisted of a combination of 8 old features. *Lawman*, 437 F.3d at



³⁴ Brief for Apple Inc. as *Amici Curiae* Supporting Neither Party, *Egyptian Goddess, Inc. v. Swisa, Inc.*, 256 Fed. Appx. 357 (Fed. Cir. 2008) (No. 2006-1562).

³⁵ See Saidman, *supra* note 8, at 412-15.

³⁶ See, e.g., *Braun*, 975 F.2d at 821 ("[I]n *Gorham*, the Supreme Court did not state, or suggest, that a panel of jurors was anything other than a panel of ordinary observers capable of making a factual determination as to whether they would be deceived by an accused device's design similarity to a patented design.").

³⁷ *Lawman Armor Corp. v. Winner Int'l, L.L.C.*, 437 F.3d 1383 (Fed. Cir. 2006).

1385.³⁸ Some of the prior art used by the court to establish that these 8 features were old included the following (below).

Presumably, if this case were decided under the post-*Egyptian Goddess* regimen using this guideline, it would go the other way, because it is fairly clear that this combination of old features in the patented design creates an appearance quite similar to the accused design. So, that's good news for patentees, and puts to rest the ridiculous conclusion of the *Lawman* case that a combination of old features cannot be infringed.

3. The Prior Art is Not Always Needed

In some instances, the claimed design and the accused design will be sufficiently distinct that it will be

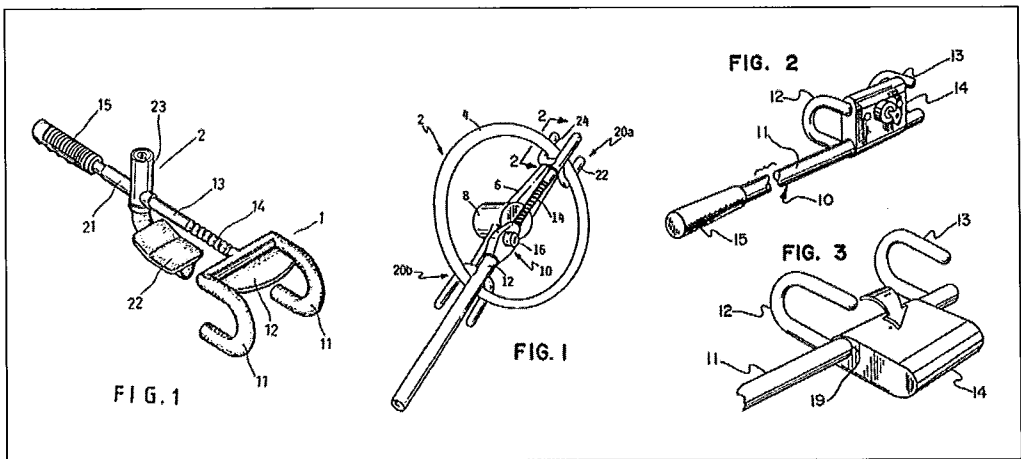
clear without more that the patentee has not met its burden of proving the two designs would appear "substantially the same" to the ordinary observer. *Egyptian Goddess*, 543 F.3d at 678.

This guideline essentially says that if the patented and accused designs are not *prima facie* substantially the same, you don't need to look at the prior art at all.

*Read Corp. v. Portec, Inc.*³⁹ is perhaps a good example of where the patented and accused designs are sufficiently distinct so that it is clear without examining the prior art that there cannot be infringement.

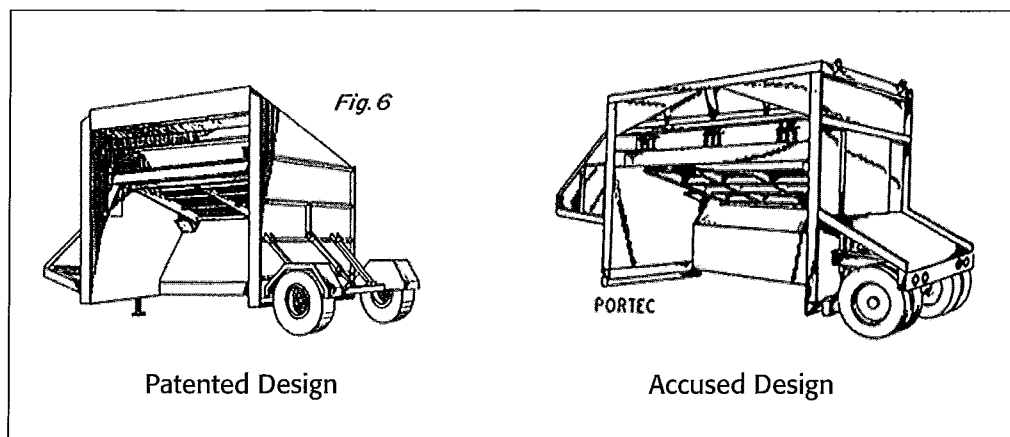
The overall designs in *Read* might well be judged sufficiently distinct, regardless of what the prior art teaches (next page).

This guideline also ameliorates the concern expressed by some commentators



³⁸ Lawman's eight points of novelty were: (1) a sliding arm of a steering wheel locking device that includes a shaft with 2 hooks attached at approximately one end of the shaft; (2) the hooks are curved, have the same profile, are symmetrical to one another, and are generally shaped like the letter "C"; (3) the open ends of the hooks face outward from the shaft; (4) the shaft attaches to the hooks at or about the top portions of the hooks, approximately midway between the two hooks; (5) the shaft includes a pattern of ridges; (6) the increases in diameter at the end of the shaft attached to the hooks, with the diameter increasing at a point just prior to the point of attachment of the hooks to the shaft; (7) the shaft is generally circular at the point where it attaches to the hooks; and (8) the hooks are approximately 20-25% of the length of the shaft. *Lawman Armor Corp. v. Winner Int'l L.L.C.*, 2005 WL 354103 (E.D. Pa. 2005).

³⁹ 970 F.2d 816 (Fed. Cir. 1992).



that the 3-way visual test is flawed in that a "pioneering design", i.e., one which is bereft of relevant, visually close prior art (e.g., the first cellular flip phone) would be given unduly broad scope and therefore would be infringed by a later cellular flip phone that really didn't look like it. In such a case, the owner of the first flip phone design patent, in designing such a stark departure from the prior art, might attempt to wield its design patent as a utility patent, rather than being limited generally to the design as shown in the patent drawings. This approach has not worked before and has been well recognized by the courts as impermissible.⁴⁰

Thus, in our hypothetical, even though the first flip phone design patent would likely be closer to a later flip phone accused design than it would be to the closest prior art (perhaps one of those old "brick" mobile phones), the 3-way visual test and prior art would not be employed under this guideline since the

claimed design and accused design are sufficiently distinct.

4. The Patented and Accused Designs are Plainly Similar

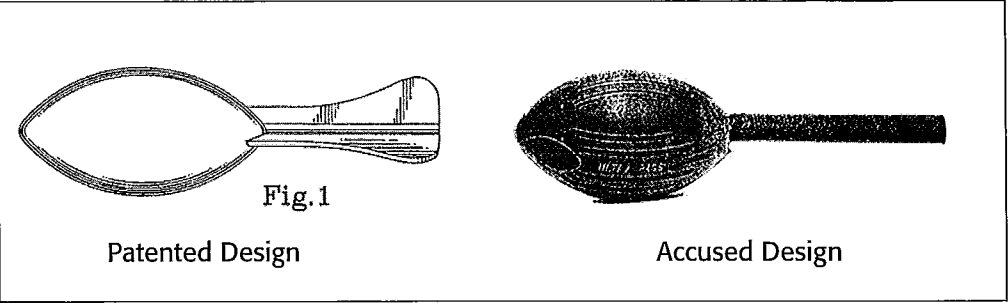
[W]hen the claimed and accused designs are not plainly dissimilar, resolution of the question...will benefit from a comparison of the claimed and accused designs with the prior art. *Egyptian Goddess*, 543 F.3d at 678.

Relevant to this guideline is *OddzOn Products, Inc. v. Just Toys, Inc.*⁴¹, which found no infringement. The claimed and accused designs are not plainly dissimilar (top of next page).

When one examines the prior art (bottom of next page), it is seen to be vastly different from both the patented and accused designs. Thus, taking into account the guideline that suggests the 3-way visual test⁴², there can be little

⁴⁰ See, e.g., *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988) ("But a design patent is not a substitute for a utility patent. A device that copies the utilitarian or functional features of a patented design is not an infringement unless the ornamental aspects are also copied, such that the overall resemblance is such as to deceive.").

⁴¹ 122 F.3d 1396 (Fed. Cir. 1997).



argument that the finding under the new law would now be one of infringement.

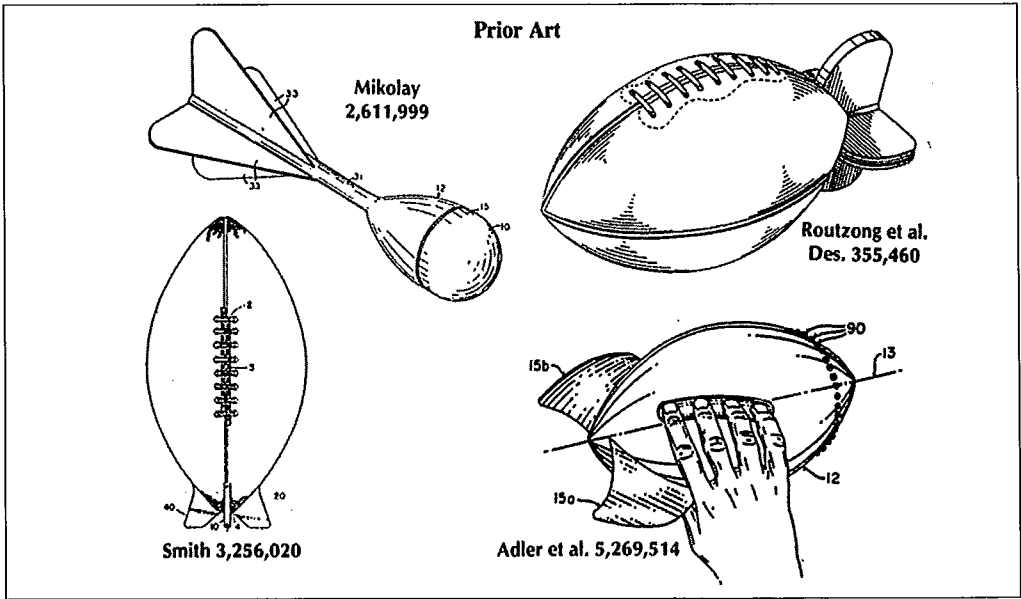
the hypothetical ordinary observer who is conversant with the prior art. *Egyptian Goddess*, 543 F.3d at 678 (emphasis added).

5. The Prior Art is Crowded

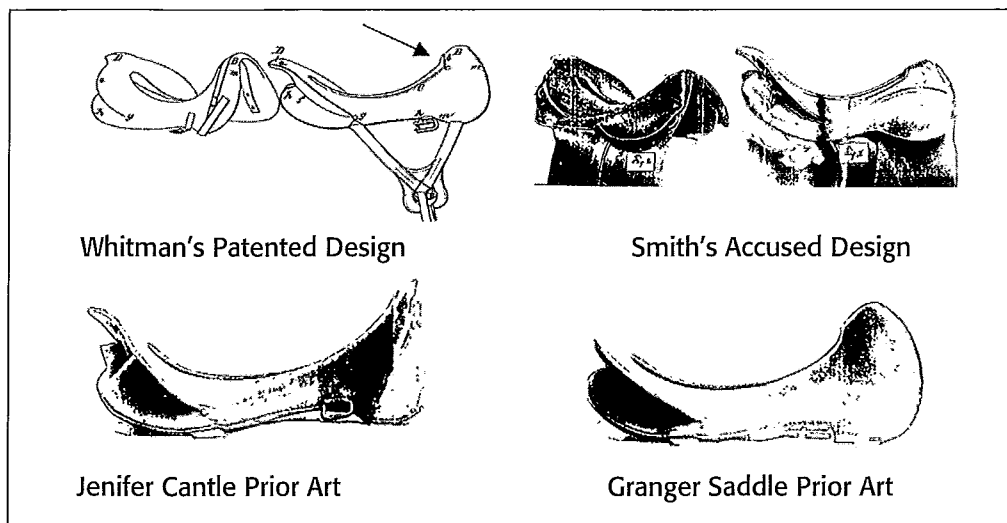
This guideline invoked *Whitman Saddle*:

Where there are many examples of similar prior art designs, as in a case such as *Whitman Saddle*, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to

The author’s major problem with this guideline is that the court made its pronouncements about *Whitman Saddle* presumably without having seen the accused design or the prior art. The only design readily accessible from reading the opinion of this 1893 case is the patented



42 See section III.C.1, *supra*.



design. The accused design and prior art were buried in the parties' briefs, never published as part of the opinion. Thus, the Federal Circuit was likely evaluating *Whitman Saddle* based on the Supreme Court's verbal descriptions of the accused and prior art designs.⁴³

How are "differences ... noticeable", even "in the abstract", if you don't look at the designs?

The *Whitman Saddle* case is much better understood by looking at the accused design and closest prior art⁴⁴ (above).

Upon seeing the accused design and the prior art, it becomes apparent that overall, the patented design and accused design are very, very close visually; closer to each other than either was to the closest prior art.⁴⁵ So, under the 3-way visual test, infringement would be found, since the design feature relied upon by the Supreme Court (the pommel drop,

see arrow) was such a relatively minor visual feature.

In *Egyptian Goddess*, the Federal Circuit explained *Whitman Saddle* as follows:

...viewed in light of the similarities between the prior art and the 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. *Egyptian Goddess*, 543 F.3d at 673-74 (emphasis added).

Since the Federal Circuit presumably did not have illustrations of the prior art or accused designs to look at, how could it make such a statement about how they "appear"?

Looking at the claimed design, the accused design, and the prior art, the

⁴³ This belies the Federal Circuit's own recognition of the inadequacy of describing a design in words in the *Markman* portion of its opinion. *Egyptian Goddess*, 543 F.3d at 679.

⁴⁴ In *What is the Point of the Point of Novelty Test for Design Patent Infringement?*, Saidman, *supra* note 8, it is explained that old Supreme Court records revealed in the parties' original briefs a plethora of illustrations & photos of the accused design and prior art.

⁴⁵ See Saidman, *supra* note 8.

pommel drop is neither noticeable in the abstract, nor in view of the prior art. The striking thing is how close the accused and claimed designs are to each other, even in the context of the prior art, thereby suggesting that under the 3-way visual test, a holding of infringement would be appropriate today.⁴⁶

Thus, while it makes sense that in a crowded field of relevant prior art that small differences between the accused and patented designs might take on greater significance, such a principle does not flow from *Whitman Saddle*.

6. Novel Features Can be Relevant

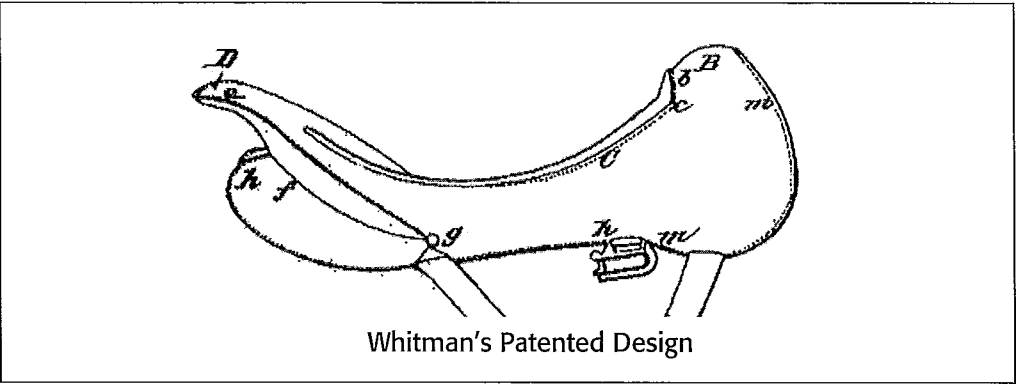
[E]xamining the novel features of the claimed design can be an important component of the comparison of the claimed design with the accused design and the prior art. But the comparison of the designs, including the examination of any novel features, must be conducted as part of the ordinary observer test, not as part of a separate test focusing on

particular points of novelty that are designated only in the course of litigation. *Egyptian Goddess*, 543 F.3d at 678.

Returning to the *Whitman Saddle* case, the novel features were: the Jenifer cantle (D); the Granger saddle (B); and the pommel drop (b-c) (below).

Today, *Whitman Saddle* would assert that its patent is valid because the design comprises a novel and nonobvious combination;⁴⁷ it is infringed because Smith’s saddle looks substantially the same as the patented design; and the pommel drop is an insignificant feature – much less visible even than a missing pad on the 4th side of a nail buffer.

The following discussion should make it clear that the big problem is analyzing design patent cases just with words. All words are given equal weight. The words do not themselves convey the visual impact of the various design features, nor their relationship to the overall design. If you simply read the words of the Supreme Court in the *Whitman* case, as



46 In the author’s paper, Saidman, *supra* note 8, this conclusion, seemingly at odds with the Supreme Court’s finding in *Whitman*, is reconciled in some detail.

47 See *id.* (discussing the novelty of Whitman’s combination of prior art saddle elements).

did the Federal Circuit, they make total sense. The list of novel features would be:

1. Jenifer cantle
2. Granger saddle
3. Pommel drop

Equal importance is give to all novel features in words.

If those words are made proportional in size to their visual impact, this is what would result.

1. Jenifer cantle
2. Granger saddle
3. Pommel drop

This is how design patent decisions ought to be written, unless they also publish the designs in question. Again, you must *see* the designs in question in order to correctly analyze the case.

IV. The New Law Does Not Apply to Nail Buffers

With *Egyptian Goddess*, the Federal Circuit had a golden opportunity not only to right design patent infringement analysis, but also to demonstrably and clearly apply its new law to the facts. It arguably failed on the latter count.

In affirming the summary judgment of non-infringement, the court held:

No reasonable fact-finder could find that [EG] met its burden of showing...that an ordinary observer, taking into account the prior art, would believe the accused design to be the same as the patented design. *Egyptian Goddess*, 543 F.3d at 683.

The author disagrees with this part of the *en banc Egyptian Goddess* decision.

The court stated:

The question before this court under the standard we have set forth above is whether an ordinary observer, familiar with the prior art Falley and Nailco designs, would be deceived into believing the Swisa buffer is the same as the patented buffer. *Id.* at 681.

In deciding this question, the court examined experts' declarations submitted by EG and Swisa in the district court in respective opposition and support of the motion for summary judgment. But these declarations were drafted under the old law. Since the Federal Circuit changed the law, it arguably would have been more fair to remand the case so the lower court could receive new submissions from the parties based on the new law.

Assuming *arguendo* that it was proper for the Federal Circuit to evaluate the sufficiency of the old declarations under the new law, another problem is how they evaluated them. First, the court evaluated a declaration submitted by Ms. Eaton on behalf of EG:

The problem with Ms. Eaton's declaration is that she characterized the accused and patented designs as similar because they both have square cross sections and "multiple" raised buffer pads, without directly acknowledging that the patented design has three pads while the accused design has four, one on each side. *Egyptian Goddess*, 543 F.3d at 682.

However, in reviewing the Eaton declaration, she said in paragraph 7:

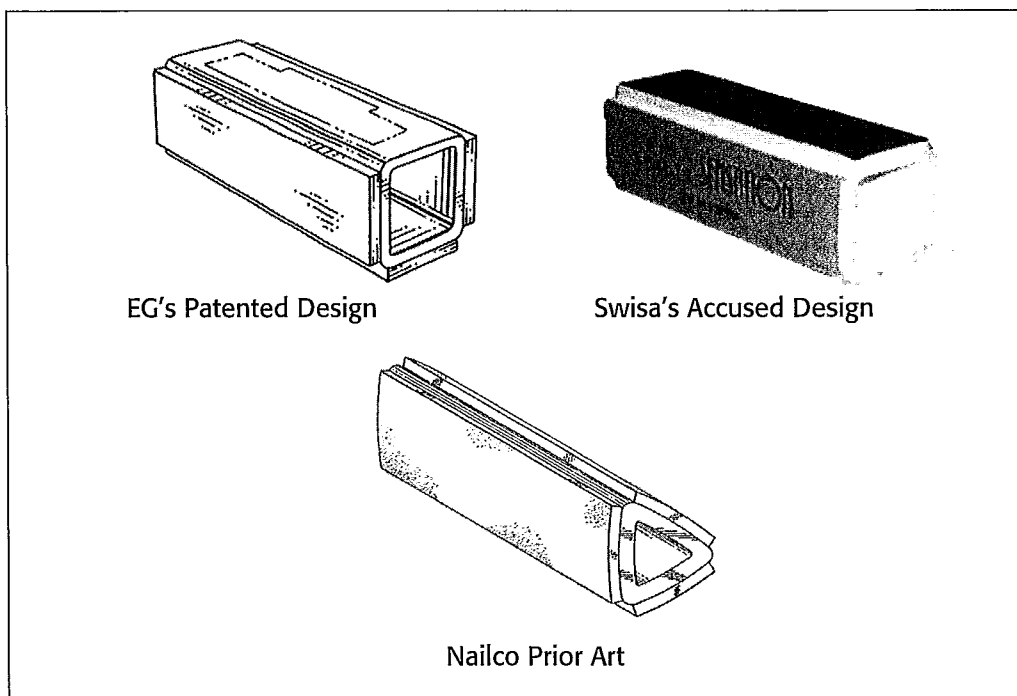
I understand that the accused nail buffer has one more buffer pad than the patented design.⁴⁸

Thus, the Federal Circuit was incorrect. Then the court said:

She also failed to address the fact that the design of the Nailco patent is identical to the accused device except that the Nailco design has three sides rather than four. *Id.*

Identical? Really? The words of Judge Moore at the *Egyptian Goddess* oral argument on June 2, 2008 come to mind. After Swisa argued for the umpteenth time that they didn't infringe because of the triangular buffer, Judge Moore said: "Even my five-year old knows the difference between a triangle and a square.... How could anybody be confused by the triangle versus the square, it's such a significant difference between the prior art?"⁴⁹

Saying that the accused design was identical to the Nailco buffer but for having three sides as opposed to four is like saying a triangle is identical to a square



⁴⁸ Brief of Plaintiff in Response to Defendant's Motion for Summary Judgment, Eaton Declaration, *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 3:03-CV-0594-N (E.D. Tex. May 5, 2005).

⁴⁹ Transcript of en banc rehearing, *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 3:03-CV-0594-N (Fed. Cir. June 2, 2005).

except one has three sides and the other has four sides.

Next, the Federal Circuit said:

Thus, she could as easily have said that the Nailco buffer design 'is like the accused design because both designs have a hollow tube, have multiple rectangular sides with raised rectangular pads mounted on each side that do not cover the corners of the tube,' in which case the Nailco prior art buffer would be seen to closely resemble the accused design. *Egyptian Goddess*, 543 F.3d at 682.

This is a strange statement. It misquotes Ms. Eaton, who emphasized the *square* hollow tube, not just a hollow tube:

In my opinion, the substantially similar appearance in overall design results from both designs having a *hollow tube, square in cross section* and rectangular in length, with multiple raised rectangular pads mounted on the sides, and that do not cover the corners of the tube.⁵⁰

And, no matter what Ms. Eaton or anyone else says in words, even a 5-year old can *see* that the Nailco prior art buffer does not closely resemble the accused design. One is a triangle, the other is a square. The court set up a straw statement, seemingly based on the old point of novelty test, and then knocked it down.

Next, the Federal Circuit, in its very first opportunity to apply its own new law, said:

Nothing 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.*

Well, what did Ms. Eaton say, exactly?

In my opinion an ordinary observer and purchaser of nail buffers would consider that *the patented design and the accused nail buffer have a substantially similar appearance in overall design, particularly in light of other [prior art] nail buffers*, such as a solid block buffer and the hollow *triangular* Nailco buffer.⁵¹

Even under the new law, Ms. Eaton arguably made the comparison suggested by the court's new guidelines: the patented design, the accused design, and the prior art. What more can you ask for?

In addition, you don't really need a declaration to explain that the accused design is square, and the Nailco prior art is triangular. There's nothing really to explain; just look at them.

Finally, last and least, the Federal Circuit said:

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. *Id.*

⁵⁰ Eaton Declaration, *supra* note 48 (emphasis added).

⁵¹ Eaton Declaration, *supra* note 48 (emphasis added).

However, recalling the court's guideline from the EG decision:

...examining the novel features of the claimed design can be an important component of the comparison of the claimed design with the accused design and the prior art. *Id.* at 678.

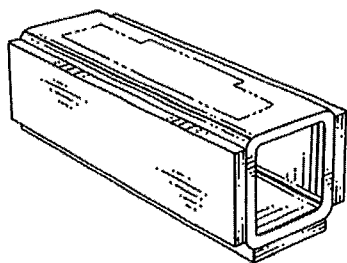
If we are indeed allowed to examine novel features as an important component of the new ordinary observer analysis, there is no prior art that shows a 4-sided hollow buffer with pads. Since it wasn't novel to have only 3 pads (*see* Nailco), and it wasn't novel to have 4 pads (*see* Falley), the dominant visual novelty compared to the prior art was a 4-sided square hollow buffer which was not in the prior art but was present in the accused design. A triangular hollow buffer simply doesn't look like the patented design. Although the

patented design is clearly obvious in view of the Nailco prior art in a utility patent sense, the Nailco prior art simply doesn't look like it in a design patent sense. It appears that the Federal Circuit just hasn't quite got the distinction between utility and design patents.

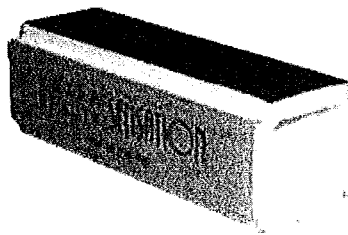
V. Another Way to **Look at** the Facts in *Egyptian Goddess*

If the Federal Circuit's guidelines are to mean anything, they must mean that the Nailco buffer and the patented design were deemed closer to each other than either is to the accused design, thereby precluding a finding of infringement.

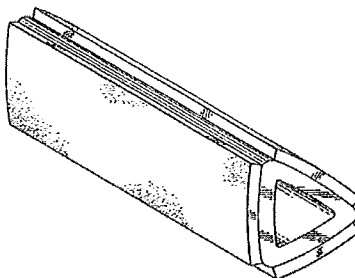
However, the Nailco prior art buffer was cited by the PTO Examiner during prosecution of the patented design, and the Examiner did not reject the claim. That is, the patented design was deemed



EG's Patented Design



Swisa's Accused Design



Nailco Prior Art

by the PTO to be nonobvious over the Nailco prior art. Let's examine this more closely.

The test for whether a prior art reference establishes a *prima facie* case of obviousness for a design is whether the reference has design characteristics which are "basically the same" as the claimed design. See *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982).⁵² If it is "basically the same", the prior art is called a *Rosen* reference.

Since the Nailco patent was in front of the Examiner, and the patented design was allowed, clearly the Nailco buffer was deemed not to be "basically the same" as the claimed design to a designer of ordinary skill, who has a relatively high level of visual acuity.

Suppose the accused infringer Swisa had applied for a design patent on its design; the Egyptian Goddess patented design would then be prior art to the Swisa application (below).

The question would then be whether the EG prior art buffer establishes a *prima facie* case of obviousness, i.e., is the EG buffer a *Rosen* reference?

In such a hypothetical, it is clear to anyone who practices design patent law that the EG prior art would easily be deemed a

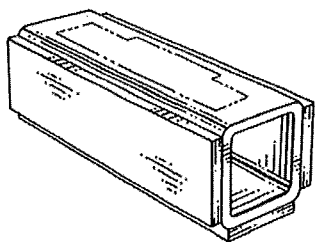
Rosen reference, i.e., an examiner would cite it as being "basically the same" as the claimed design (the Swisa buffer) and reject the latter under 35 U.S.C. § 103.

Recall the *Gorham* test that asks whether the two designs are "substantially the same". Given the lower visual acuity of an ordinary observer under the test for infringement, compared to the higher visual acuity of a designer skilled in the art under the test for non-obviousness, and given that the two designs are "basically the same", can there be any question but that the Swisa design and Egyptian Goddess design are "substantially the same" under *Gorham*?

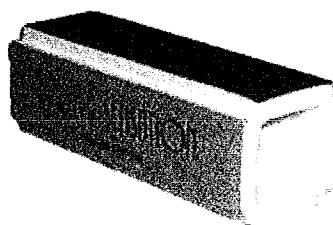
That is, if Egyptian's buffer and Swisa's buffer are "basically the same" to a skilled designer, they must be "substantially the same" to an ordinary observer. Thus, infringement is also made out by this alternate, albeit hypothetical, analysis.

VI. Conclusion

It is unquestioned that the Federal Circuit, in abolishing the point of novelty test and relegating claim verbalization to a far back seat, has deprived alleged infringers of their two major weapons in avoiding



Hypothetical Prior Art (EG)



Hypothetical Claimed Design (Swisa)

⁵² "[O]ne must first find a single prior art reference, 'a something in existence, the design characteristics of which are *basically the same* as the claimed design.'" (Emphasis added).

infringement. Thus, the EG decision is a significant boost to design patentees. It is a welcome change to counteract what was a longstanding tendency to reduce design patent protection to a hollow and useless thing. See Saidman, *supra* note 2.

Exactly how the new *Gorham* test, taking into account the prior art, will be applied will obviously be left to the development of case law. Since the court stopped short of abolishing verbalization of design patent claims under *Markman*, accused infringers seeking to avoid liability will likely push the district court to adopt some sort of verbalized claim construction that will narrow the scope of the design patent, and patentee/plaintiffs will likely argue that the claimed design is defined by the drawings of the design patent, period.⁵³

When it comes to the point of novelty, although abolishing it as a test, the Federal Circuit left open the relevance of the prior art in ascertaining the novel elements of the claimed design in determining substantial sameness under *Gorham*, putting the burden of production on the accused infringer to come forth with such relevant prior art. Thus, it is likely that accused infringers will make point-of-novelty-like arguments in attempting to avoid infringement, while patentees will at least be relieved of the burden of proving what the novel elements are, and that they are found in the accused design.

However open the Federal Circuit left the door to those arguments, there is also

little question that *Egyptian Goddess* represents a sea change in the law, with the focus returning to comparing the patented design, the accused design, and the prior art *as a whole*. This focus should reduce design patent cases being subject to disposition on a motion for summary judgment, leaving the merits of the factual dispute in the able hands of the jury who are well equipped, as a group of ordinary observers, to determine substantial sameness. See Braun, *supra* note 11.

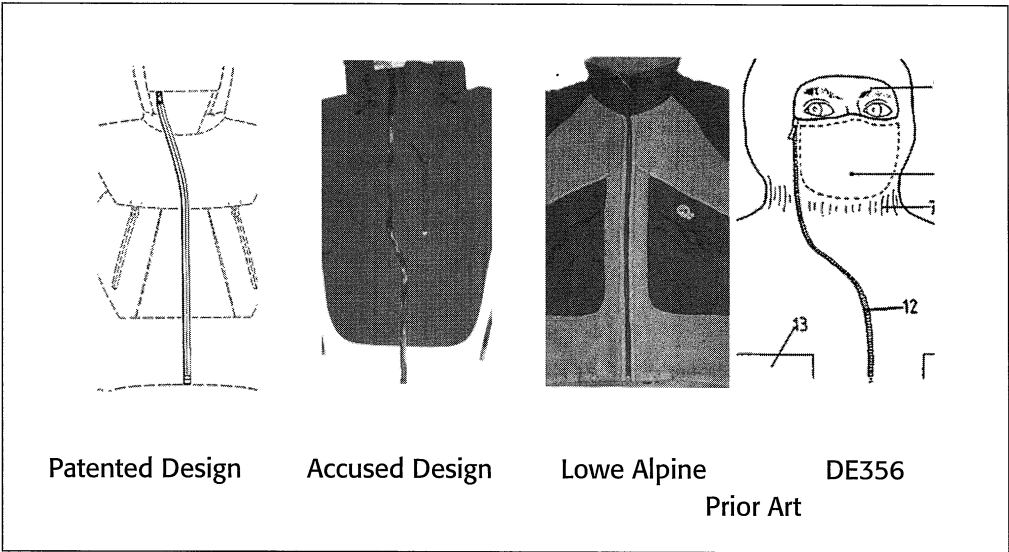
At the same time, the Federal Circuit's first attempt in applying their new law, to the facts of the *Egyptian Goddess* case, does not bode well.⁵⁴ The Federal Circuit's ultimate holding seems to lack full appreciation that a design patent case is all about the appearance of the designs. With the Federal Circuit's convoluted reasoning in its affirmation of the district court's finding of non-infringement on summary judgment, it has provided somewhat of a weapon in the hands of the accused infringer.

As of this writing, only one district court has applied the new *Egyptian Goddess* law to the facts in a design patent infringement case, and the results are encouraging. In *Arc'Teryx Equipment, Inc. v. Westcomb Outerwear, Inc.*⁵⁵, a case involving the design of a zipper, the court granted the defendant's motion for summary judgment of non-infringement. The patented design, the accused design and the closest prior art are illustrated below on next page.

53 See, e.g., *Black & Decker, Inc. v. Pro-Tech Power, Inc.*, 47 U.S.P.Q.2d 1843, 1845 (E.D. Va. 1998); *ADC Telecomm. V. Panduit Corp.*, 200 F. Supp. 2d 1022, 1032-33 (D. Minn. 2002); *Caponey v. ADA Enterprises, Inc.*, 511 F. Supp. 2d 618, 624 (D. S.C. 2007); *Colgate-Palmolive Co. v. Ranir*, 2007 WL 2225888, at *4 (D. Del. 2007).

54 It is curious indeed that the *Egyptian Goddess en banc* decision was unanimous; not a single one of the 12 participating judges disagreed with the finding of non-infringement, despite several reservations expressed at oral argument, and despite the fact that the author has been unable find a single design patent practitioner who supports the non-infringement holding (save, of course, Swisa).

55 2008 WL 4838141 (D. Utah 2008).



Relying on *Egyptian Goddess*, the court declined to proffer a detailed verbalization of the claimed design. It went on, however, to describe and compare the patented and accused designs in some detail, continually referring to what an ordinary observer would notice.⁵⁶ For example, the court said:

Within this general description of the two zippers, there a [sic] several differences worth noting. First, an ordinary observer would be left with the impression that the 715 patent contains only two sections – a straight section and a diagonal section. An ordinary observer of Defendant’s Mirage Jacket, on the other hand, would be left with the impression that the jacket contains three sections – a straight section, a diagonal section, and a second straight section. *Arc’Teryx*, 2008 WL 4838141 at *3.

It then compared the patented and accused designs to the prior art Lowe’s Alpine jacket and the prior art DE 356 patent, and in finding no infringement concluded with the following analysis:

The 715 patent is much closer to the Lowe Alpine Black Ice Jacket in that they both contain one straight and one diagonal section. Defendant’s Mirage Jacket, on the other hand, is similar to the DE 356 patent in that both designs contain a straight section, curving into a diagonal section, which curves into a second straight section. *Id.*

Thus, the court employed the 3-way visual test: both the patented design and the accused design were closer to the prior art than to each other, resulting in a holding on summary judgment of non-infringement. Based on the visual evidence above, it is hard to find fault with the court’s analysis.

⁵⁶ “The parties agree that the ‘ordinary observer’ in this situation is an outdoor clothing customer who is more discerning than [sic] an average retail shopper.” *Id.* at *2.

As demonstrated by *Arc'Teryx*, the 3-way visual test, that forces the fact-finder to focus what the claimed design, accused design and prior art actually look like, will likely become the "go to" test that embodies the *Egyptian Goddess* mandate that the *Gorham* test must take into account the prior art.

What about Supreme Court review of the *Egyptian Goddess* decision? It seems offhand that the Federal Circuit left nothing to appeal by essentially splitting the baby: satisfying EG by doing away with the point of novelty test and Markman claim verbalization, but finding in favor of Swisa on non-infringement. So, Swisa is clearly left with nothing to appeal since they presumably are quite happy with the outcome. The one thing for EG to appeal is the Federal Circuit's application of the new law to their facts, something that the Supreme Court is not likely to find worthy of review.

As of this writing, EG filed a petition for rehearing *en banc* of the Federal Circuit's *en banc* EG decision, a petition that was denied.⁵⁷ The ensuing petition for certiorari will need to raise more than the erroneous application of the new law to the *Egyptian Goddess* facts to garner the

attention of the Supreme Court. In the author's view, the most likely path to the Supreme Court is to argue that *Egyptian Goddess* is an unwarranted dilution of the *Gorham* ordinary observer test in that it obliterates the import of the Court's venerable 1871 decision that determined that the one determining substantial sameness is an "ordinary" observer, and not a person versed in the trade having familiarity with the prior art.⁵⁸ Supreme Court review is still unlikely.

We will thus probably be left with case-by-case development of the new EG test for design patent infringement in view of the Federal Circuit's *en banc* decision. Will *Egyptian Goddess* usher in a new era of design patent jurisprudence, giving life and meaning to the essence of the Supreme Court's 137-year old *Gorham* case that design patents clearly have broad scope?⁵⁹ Or will the courts wander in the wilderness for another 137 years, seeking the holy grail of design protection, thereby relegating design patent law to a state of perpetual limbo?⁶⁰

It is a great time to be an ordinary observer of developing design patent jurisprudence.

57 *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008), *rehear'g en banc denied* (Nov. 4, 2008).

58 See discussion of the "ordinary observer" at section III.B.2.a, *supra*.

59 See discussion of *Gorham* at section II.A, *supra*.

60 See Perry J. Saidman & Theresa Esquerro, *A Manifesto on Industrial Design Protection: Resurrecting the Design Registration League*, 55 J. COPYRIGHT SOC'Y 423 (Winter-Spring 2008). In response to the issues detailed in the Crisis paper, the author advocated that the United States should adopt a design registration system akin to the European Community Design law. It is likely that cries for such a *sui generis* registration law in the U.S. will be heard anew should the EG decision not eventually result in a substantial strengthening of design patent protection.