

**EGYPTIAN GODDESS V. SWISA: PATENTLY OBVIOUS? RECONCILING THE ORDINARY OBSERVER AND POINT OF NOVELTY TESTS**

I. PROTECTING FANCIFUL ORNAMENTATION..... 111

II. DESIGN PATENTS, INFRINGEMENT TESTS, AND THE MARKMAN ORDER..... 112

    A. *Design Patents* ..... 112

        1. Characteristics of Design Patents ..... 112

        2. Obtaining a Design Patent ..... 113

    B. *Infringement* ..... 114

    C. *The Ordinary Observer Test*..... 114

    D. *The Point of Novelty Test* ..... 115

    E. *The Markman Order* ..... 116

III. *EGYPTIAN GODDESS, INC V. SWISA, INC.*..... 117

    A. *The Facts*..... 117

        1. District Court–N.D. Texas, Dallas ..... 117

        2. Court of Appeals for the Federal Circuit ..... 119

            a. The Majority Opinion ..... 119

            b. The Dissent ..... 119

        3. Petition for Panel Rehearing ..... 120

        4. Rehearing en Banc..... 120

IV. *EGI V. SWISA’S INFLUENCE ON THE FUTURE* ..... 124

    A. *Clarifying the OO Test For Its Use In Future Case Law* ..... 124

        1. Reconciling the Ordinary Observer and the Point of Novelty Tests..... 124

        2. The Spirit of *Gorham’s* Ordinary Observer ..... 125

        3. The Spirit of *Gorham’s* Ordinary Observer Test... 126

        4. The OO Test in Other Areas of Intellectual Property ..... 128

        5. Case by Case in the Future?..... 128

    B. *Revising Claim Construction* ..... 131

        1. A Departure from *Gorham* ..... 131

        2. A Picture is Worth A Thousand Words? ..... 133

    C. *Road to the Supreme Court*..... 137

V. CONCLUSION..... 137

## I. PROTECTING FANCIFUL ORNAMENTATION

*Nehmetawy* - ancient Egyptian goddess  
 - “She Who Recovers the Stolen”  
 - goddess of justice<sup>1</sup>

The Coca-Cola bottle.<sup>2</sup> The Statue of Liberty.<sup>3</sup> The iPhone.<sup>4</sup> Countless design patents are encountered every day, but they are easily overlooked and passed by. Some prosaic, most unexceptional, design patents do not compel much attention. That is, until they are threatened by an infringing competitor. Distinguished from the more familiar utility patent, design patents protect the fanciful ornamentation of thousands of everyday shapes and configurations.<sup>5</sup> For over a hundred years, patentees might win a charge of infringement against an alleged infringer by arguing the broad overall similarities of the products and, more recently, by illustrating the infringer’s appropriation of the patentee’s point of novelty into the infringing design.<sup>6</sup> Accordingly, disparate applications of the infringement tests have left patentees wondering what exactly is required to win an infringement case.<sup>7</sup>

*Egyptian Goddess, Inc. v. Swisa, Inc.*<sup>8</sup> (“EGP”) is the deciding case in which the Court of Appeals for the Federal Circuit (“CAFC”) established the definitive test of infringement in design patents.<sup>9</sup> In re-adopting the 1871 Supreme Court-decided ordinary observer test, the court rejected the “recent vintage”<sup>10</sup> point of novelty test, but kept the test’s inquiry into prior art.<sup>11</sup>

1. See The Egyptian Gods, <http://www.philae.nu/akhet/NetjeruN.html#Nehmetawy> (last visited Dec. 20, 2009).

2. Design for a Bottle or Similar Article, U.S. Patent No. D 48,160 (filed Aug. 18, 1915) (issued Nov. 16, 1915).

3. Design for a Statue, U.S. Patent No. D 11,023 (filed Jan. 2, 1879) (issued Feb. 18, 1879).

4. Electronic Device, U.S. Patent No. D 558,757 (filed Jan. 5, 2007) (issued Jan. 1, 2008).

5. See 35 U.S.C. § 171 (2006).

6. See, e.g., *Gorham Co. v. White*, 81 U.S. 511, 525 (1871); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984).

7. See Thomas B. Lindgren, *The Sanctity of the Design Patent: Illusion or Reality? Twenty Years of Design Patent Litigation Since Compeco v. Day-Brite Lighting, Inc., and Sears, Roebuck & Co. v. Stiffel Co.*, 10 OKLA. CITY U. L. REV. 195, 258-66 (1985).

8. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).

9. *Id.* at 672, 683.

10. *Id.* at 672 (referring to the point of novelty test, which evaluates whether an accused product appropriates the patented product’s point of novelty, as being of “recent vintage”).

11. See *id.* at 678, 683.

Although the court purports to strictly adopt the ordinary observer test, only analysis of future case law will reveal *EGI's* true influence on tomorrow's design patents.<sup>12</sup>

This Note is organized into five parts. Part II introduces the fundamental infringement tests of *Gorham Co. v. White*<sup>13</sup> and *Litton Systems, Inc. v. Whirlpool Corp.*<sup>14</sup> Part III reviews the procedural history of *EGI* and the CAFC's decision on resolving the appropriate analysis for design patent infringement.<sup>15</sup> Part IV examines the court's decision and weighs its implications on future patent prosecution. Part IV also discusses the CAFC's query of claim construction in design patent claims.<sup>16</sup> Part V concludes this Note.

## II. DESIGN PATENTS, INFRINGEMENT TESTS, AND THE MARKMAN ORDER

### A. *Design Patents*

#### 1. Characteristics of Design Patents

A design patent may be granted to whomsoever creates a "new, original, and ornamental design for an article of manufacture,"<sup>17</sup> where the design consists of "the visual ornamental characteristics embodied in, or applied to, such an article,"<sup>18</sup> evident exclusively in its outward appearance. Both design patents and their more commonly known counterparts, utility patents, are afforded separate legal protection;<sup>19</sup> however, design patents differ in that the ornamentation and distinctive appearance of a product is characterized by its inability to exist alone and is "inseparable from the article to which it is

12. *See id.*

13. *Gorham Co. v. White*, 81 U.S. 511 (1871).

14. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984); *see infra* Part II.

15. *See infra* Part III.

16. *See Egyptian Goddess, Inc., v. Swisa, Inc.*, No. 2006-1562, 2007 WL 4179111, at \*1 (Fed. Cir. Nov. 26, 2007); *see infra* Part IV.

17. 35 U.S.C. § 171 (2006).

18. 2 JOHN GLADSTONE MILLS III, DONALD C. REILEY III & ROBERT C. HIGHLEY, *PATENT LAW FUNDAMENTALS* § 8(a) (2d ed. 2004) ("The subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.") [hereinafter *MILLS, REILEY & HIGHLEY*].

19. *See* 35 U.S.C. § 173 (2006) (granting exclusive rights and protection for design patents for fourteen years); 35 U.S.C. § 154 (2006) (granting exclusive rights and protection for utility patents for twenty years); *see generally* 35 U.S.C. § 271 (2006); 35 U.S.C. § 289 (2006).

applied.”<sup>20</sup> Whereas the novelty and originality conditions are satisfied by terms equivalent to those of utility patents,<sup>21</sup> any functionality of a design must merely be incidental to the product’s shape or look.<sup>22</sup>

Design patents share notable similarities with copyrights and trademarks in that each protect aesthetic features.<sup>23</sup> But while copyrights only protect the artistic expression of nonfunctioning articles, design patents are unique in that they protect the visual appearance of a functional product.<sup>24</sup> Further, trademarks are used to prevent confusion amongst consumers, whereas the validity of design patents is not affected by consumer confusion.<sup>25</sup> There is, however, an overlap between the statutes allowing a qualifying claimant to secure protection by a combination of copyright, trademark, and patent,<sup>26</sup> thereby ensuring their work is safeguarded from infringement.

## 2. Obtaining a Design Patent

To apply for a design patent, a designer files a single claim<sup>27</sup> defining the design by means of a black and white drawing, or in rare instances, a colored drawing or photograph disclosure.<sup>28</sup> While a verbal description of the design may supplement the claim, this illustration or photograph is the entire visual depiction reviewed by the United States Patent and Trademark

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20. MANUAL OF PATENT EXAMINING PROCEDURE § 1512 ¶ 15.44 (8th ed., rev. July 2008) (stating that a “utility patent” protects the way an article is used and works . . . while a “design patent” protects the way an article looks); see 35 U.S.C. § 171 (2006); see generally 35 U.S.C. § 101 (2006).

21. See 35 U.S.C. § 103 (2006) (stating that “a patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains”); see also 35 U.S.C. § 102 (2006).

22. See Laurence H. Pretty, *Noninfringement Defenses*, in PATENT LITIGATION, at 1-28 (PLI Patent Litig., Course Handbook, 2007).

23. See, e.g., 17 U.S.C. § 101 (2006); 35 U.S.C. § 171 (2006).

24. See 35 U.S.C. § 171.

25. See, e.g., 15 U.S.C. § 1051 (2006); 35 U.S.C. § 171.

26. See MANUAL OF PATENT EXAMINING PROCEDURE § 1512 ¶ 15.55, ¶ 15.55.01 (8th ed., rev. July 2008).

27. See 37 C.F.R. § 1.152 (2008); 37 C.F.R. § 1.153 (2008); MILLS, REILEY & HIGHLEY, *supra* note 18, § 8(a) (“Designs that are independent and distinct must be filed in separate applications since they cannot be supported by a single claim.”).

28. 37 C.F.R. § 1.84 (2008) (stating that “[t]he Office will accept photographs in . . . design patent applications if photographs are the only practicable medium for illustrating the claimed invention”).

Office, and subsequently, by any judge or juror.<sup>29</sup> What a utility patent filer may assert through verbal descriptions, a design patent filer must convey and describe all declarations of a design claim through stippling, shading, and broken and solid lines.<sup>30</sup>

### B. *Infringement*

The underlying issue in *EGI* is the court's disagreement on the absolute test in the analysis for infringement.<sup>31</sup> The inconsistent and varying criteria prevent parties to a suit from making predictions to the outcome of an infringement challenge.<sup>32</sup>

### C. *The Ordinary Observer Test*

The chief Supreme Court case advocating the "ordinary observer" ("OO") test, *Gorham Co. v. White*, proceeded in 1871 under The Patent Acts of 1842 and 1861.<sup>33</sup> In *Gorham*, it was of issue whether the designs used by the accused defendant were "substantially the same" as those patented by the complainant.<sup>34</sup> The Supreme Court held that "the controlling consideration is the resultant effect," and "a mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration . . . will not change the substantial identity."<sup>35</sup> The OO test, as determined by the Court, was based on the "sameness of effect upon the eye," and this "same general effect" determines the substantial identity of the alleged

29. See MILLS, REILEY & HIGHLEY, *supra* note 18, § 8(a) (stating that the drawing or photograph constitutes the entire visual disclosure of the claim and while feature descriptions are "optional," "as a general rule, a drawing is the design's best description").

30. See 37 C.F.R. § 1.152 (expressing that the claimed design is shown by solid lines and the un-claimed environment is shown by broken lines); see generally MILLS, REILEY & HIGHLEY, *supra* note 18, § 8(a) (stating that structure necessary to show the article where the design is used, but not part of the claimed design, may be represented by broken lines).

31. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008); see generally Lindgren, *supra* note 7, at 258-66 (asserting that there is a split among the circuits as to the appropriate standard to be applied by the district courts on the issue of obviousness—the "ordinary observer" standard versus the "ordinary designer" standard; the CAFC uses the "ordinary designer" standard). In terms of infringement, very rarely will a design patent be held to be infringed by a United States district court; while the Sixth, Ninth, and Tenth Circuits seem to favor design patents, the Second and Seventh Circuits are seemingly favorable to an alleged infringer. *Id.* See also *id.* at n.163.

32. See generally Lindgren, *supra* note 7, at 258-66.

33. *Gorham v. White*, 81 U.S. 511, 512-13 (1871); see, e.g., 35 U.S.C. § 171 (2006) (current codification of "Patent Act of 1842"); see also 12 Stat. 249 (1861) ("Patent Act of 1861").

34. *Gorham*, 81 U.S. at 512-13.

35. *Id.* at 526-28.

infringer in comparison to the patented product.<sup>36</sup> Additionally, the Court established that Congress did not intend to subject the “effect upon the eye” test to expert judgment only, 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.”<sup>37</sup> The Court held that experts are not the class of consumers an infringer would attempt to deceive, so therefore, the standard by which we may determine a design patent infringement is as it would be seen by “men of ordinary intelligence.”<sup>38</sup>

From *Gorham*, the decisive test for infringement is

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.<sup>39</sup>

Upon examination of the whole design, the OO test identifies infringement if the effect of each of the competing designs is substantially the same.<sup>40</sup>

#### D. *The Point of Novelty Test*

Over one hundred years later, the CAFC adopted an additional criterion for a complainant patent holder to prevail in infringement suits.<sup>41</sup> Although it had been previously identified in earlier cases, the “point of novelty” (“PON”) test was first christened as such in *Litton Systems, Inc. v. Whirlpool Corp.*<sup>42</sup> *Litton* directly cited *Gorham’s* OO test, and incorporating the infringement standard from *Sears, Roebuck & Co. v. Talge*,<sup>43</sup> the CAFC interpreted that “the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.”<sup>44</sup> Despite, and regardless of, any findings under the

36. *Id.* at 517, 527.

37. *Id.* at 527.

38. *Id.* at 528.

39. *Id.*

40. *Gorham Co. v. White*, 81 U.S. 511, 530 (1871).

41. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984).

42. *Id.*; see also *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944); *Horwitt v. Longines Wittnauer Watch Co.*, 388 F. Supp. 1257, 1263 (S.D.N.Y. 1975).

43. See *Sears, Roebuck & Co.*, 140 F.2d at 396 (requiring a comparison of the features of the patented design with prior art and with the accused design).

44. *Litton*, 728 F.2d at 1444 (citing *Sears, Roebuck & Co.*, 140 F.2d at 396).

OO test, an analysis must still survey for similarities with “the novelty which distinguishes the patented device from the prior art.”<sup>45</sup> *Litton* acknowledged that while “minor differences . . . shall not prevent a finding of infringement,”<sup>46</sup> the similarities between the patented and challenged design may be based upon a configuration commonly known in prior art.<sup>47</sup> For example, although the disputed microwaves in *Litton* admittedly looked similar “in the eyes of the casual buyer,” the similarity was a common feature implemented by several microwave ovens then currently on the market.<sup>48</sup> *Litton*, therefore, first required a prior determination of the patented product’s PON so that the fact-finder may compare this particular novelty against the alleged infringer’s design.<sup>49</sup>

#### E. *The Markman Order*

By the 1990s, the OO and PON infringement tests had long established their roles in infringement suits. In 1996, a paramount utility patent case appended an additional requirement to the aforementioned tests—the Markman Order.<sup>50</sup> In response to the issue of whether the interpretation of a claim is reserved for the court or subject to jury determination, the Court held in *Markman v. Westview Instruments, Inc.*<sup>51</sup> that “the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.”<sup>52</sup> The holding, which demanded a pre-trial order to predicate the scope of the infringement trial, created what is now known as the Markman Order. The Markman Order removes the task of claim construction previously bestowed upon the jury and grants trial courts the authority to establish how a patent and its claims are to be construed.<sup>53</sup> Although the *Markman* decision was neither

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45. *Id.*

46. *Id.*

47. *Id.* (citing *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933)).

48. *Id.* at 1446.

49. *See id.* at 1444.

50. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) (requiring lower courts to render determinations of design patents by verbalizing the designs); *see also Perry J. Saidman & Allison Singh, The Death of Gorham Co. v. White: Killing It Softly with Markman*, 86 J. PAT. & TRADEMARK OFF. SOC’Y 792, 796-97 (2004) (discussing the effect of *Markman* on design patents) [hereinafter Saidman & Singh].

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

52. *Id.* at 372.

53. DAVID F. HERR, ANNOTATED MANUAL FOR COMPLEX LITIGATION § 33.22 (4th ed. 2009) (discussing the removal of claim construction from the jury and de novo review of claim construction by the Federal Circuit).

about nor spoke upon design patents, the influence of its decision has since impacted several design patent cases.<sup>54</sup>

The concern remains how design patents, which have never had a requirement for the verbal interpretation of a design,<sup>55</sup> may be resolved against this lesser-alluded-to benchmark, which verbalizes the visual appearance of a patentee's drawings.<sup>56</sup>

### III. *EGYPTIAN GODDESS, INC V. SWISA, INC.*

#### A. *The Facts*

##### 1. District Court—N.D. Texas, Dallas

Plaintiff EGI holds design patent D 467,389<sup>57</sup> (“D’389”) for a fingernail buffer designed to hold buffing pads of different abrasiveness.<sup>58</sup> The Markman Order was construed as follows:

A hollow tubular frame of generally square cross section, where the square as sides of length S, the frame has a length of approximately 3S, and the frame has a thickness of approximately  $T=0.1S$ ; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately 1.25T, and the inner corner of the cross section rounded on a 90 degree radius of approximately 0.25T; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.<sup>59</sup>

54. See *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995); see also *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997); *Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, No. 03-1162, 2004 WL 506587 (Fed. Cir. Jan. 16, 2004); *Puritan-Bennett Corp. v. Penox Techs., Inc.*, 297 F. Supp. 2d 1110 (S.D. Ind. 2003); *Tecumseh Prods. Co. v. Briggs & Stratton Corp.*, 295 F. Supp. 2d 902 (E.D. Wis. 2003).

55. See MANUAL OF PATENT EXAMINING PROCEDURE § 1503.01 (8th ed., rev. July 2008); 37 C.F.R. § 1.153 (2008) (stating that “[n]o description, other than a reference to the drawing, is ordinarily required”); see *MILLS, REILEY & HIGHLEY supra* note 18, § 8(a) (stating that a feature description is optional).

56. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 3:03-CV-0594-N, 2005 WL 5873510, at \*1 (N.D. Tex. Dec. 14, 2005); see, e.g., *Elmer*, 67 F.3d at 1577.

57. Nail Buffer, U.S. Patent No. D 467,389 (filed Feb. 13, 2002) (issued Dec. 17, 2002).

58. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 3:03-CV-0594-N, 2005 WL 5873510, at \*1 (N.D. Tex. Dec. 14, 2005).

59. *Id.*; *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 3:03-CV-0594-N, 2005 WL 6225310, at \*2 (N.D. Tex. Mar. 4, 2005).



Swisa's accused product also consists of a similar hollow tube having a square cross-section; however, it features buffers on all four sides.<sup>60</sup> EGI sued for design patent infringement.<sup>61</sup> In summary judgment, the district court held that a plaintiff in a design patent infringement case must prove the infringement under both the OO test and the PON test.<sup>62</sup> The parties disagreed as to the points of novelty in the D'389 patent.<sup>63</sup> EGI identified four design elements and claimed the PON of the patent was the combination of those four elements,<sup>64</sup> while Swisa criticized this impermissible "shopping list approach" to determine the appropriate PON.<sup>65</sup> The district court did not address this approach as it found U.S. Design Patent No. 416,648<sup>66</sup> (Nailco Patent) had already disclosed a nail buffer with an open and hollow body, raised rectangular pads, and open corners.<sup>67</sup> The court declined EGI's attempt to claim the combination of those three elements as novel in the D'389 patent when the combination was already utilized in the Nailco Patent.<sup>68</sup> The only PON, the district court subsequently found, was the addition of the fourth side, turning a triangular-tubed buffer into a rectangular-tubed buffer.<sup>69</sup> The fourth padless side of the buffer was then decidedly not "substantially the same" as a fourth side *with* a pad, since Swisa's product did not include the court-determined PON of the D'389 patent.<sup>70</sup> Peculiarly, the district court stated that EGI's buffer was not like Swisa's buffer, even though EGI's product was the product with the patent and it was EGI that had its product first on the market; the court articulated that the original was not like the copy.<sup>71</sup>

The district court granted Swisa's motion for summary judgment for non-infringement.<sup>72</sup>

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60. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 668-69 (Fed. Cir. 2008).

61. See *Egyptian Goddess*, 2005 WL 5873510, at \*1.

62. *Id.*

63. *Id.* at \*2.

64. *Id.* at \*2 n.4 (claiming the design elements of D'389 were the 1) open and hollow body, 2) square cross section, 3) raised rectangular pads, and 4) exposed corners).

65. *Id.* at \*2 (citing *Bush Indus., Inc. v. O'Sullivan Indus., Inc.*, 772 F. Supp. 1422, 1452-54 (S.D.N.Y. 1991)).

66. Manicure/Pedicure Tool, U.S. Patent No. D 416,648 (filed Aug. 17, 1998) (issued Nov. 16, 1999).

67. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 3:03-CV-0594-N, 2005 WL 5873510, at \*2 (N.D. Tex. Dec. 14, 2005).

68. *Id.*

69. *Id.*

70. *Id.*

71. See *id.*

72. *Id.*

## 2. Court of Appeals for the Federal Circuit

On appeal, the CAFC also required analyses of infringement under the OO test and the PON test.<sup>73</sup> To determine PON, the CAFC relied on its decision in *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*<sup>74</sup> with the initial burden on the patentee to present its contentions as to points of novelty.<sup>75</sup> This PON may be either a single novel design or a combination of elements individually known in prior art, but it must include features of the claimed design that distinguish it from prior art.<sup>76</sup>

### a. The Majority Opinion

The issue in dispute was again the elements that constitute complainant's point, or points, of novelty of the D'389 patent.<sup>77</sup> The CAFC held that because EGI's asserted PON was a combination of four claimed design elements that were individually well-known prior-art designs, the district court did not err in rejecting EGI's overall PON as a "non-trivial advance over the prior art."<sup>78</sup> Had only complainants listed a "fourth side without a raised pad" as its PON, the court would have held it as a "non-trivial advance over the prior art,"<sup>79</sup> unabashedly giving priority to form over substance. Notwithstanding its holding that EGI's design was a non-trivial advance, the court did not invalidate patent D'389.

Summary judgment was affirmed for defendant, Swisa.<sup>80</sup>

### b. The Dissent

Judge Dyk dissented, criticizing the majority's implementation of a new concept that prohibits a combination of elements as a PON unless they constitute a "non-trivial advance

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73. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1356-57 (Fed. Cir. 2007) (citing *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371 (Fed. Cir. 2004)) ("There are two distinct requirements for establishing design patent infringement."); *Id.* (citing *Gorham Co. v. White*, 81 U.S. 511, 528 (1871)) ("[t]he first, called the ordinary observer test . . ."); *Id.* (citing *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984)) ("[t]he second, called the point of novelty test . . .").

74. *See Bernhardt*, 386 F.3d at 1384.

75. *See id.*

76. *See Litton*, 728 F.2d at 1444; *see also Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190, 1192 (Fed. Cir. 2006).

77. *See Egyptian Goddess*, 498 F.3d at 1356-58.

78. *Id.* at 1358.

79. *Id.*

80. *Id.* at 1359.

over the prior art.”<sup>81</sup> The dissent claimed the majority equated the novel phrase, “non-trivial advance” with the long held standard for patents to be “nonobvious.”<sup>82</sup> This wrongfully shifted the burden of proof from the accused to the patentee,<sup>83</sup> requiring the patentee to first prove non-obviousness before the court may examine any infringement. Furthermore, a finding of “non-trivial advances” had never been a requirement to find an asserted combination PON, and thus, Judge Dyk contended that the majority decision ignored the actual question at issue.<sup>84</sup>

The dissent also made a noteworthy observation on the construction of design patents, citing a prior CAFC decision that held “design patents have almost no scope.”<sup>85</sup> Although the dissent addresses this issue in regards to points of novelty,<sup>86</sup> this concept is later central to the rehearing en banc’s consideration of claim construction used in design patents.<sup>87</sup>

### 3. Petition for Panel Rehearing

A petition for panel rehearing and rehearing en banc were filed by Appellant.<sup>88</sup> The petition for panel rehearing was denied; the petition for rehearing en banc was granted.<sup>89</sup> Parties were directed to address whether the PON test should be a valid analysis for infringement, and whether claim construction should apply to design patents.<sup>90</sup>

### 4. Rehearing en Banc

In its rehearing en banc, the CAFC reviewed the OO and PON tests and considered the necessity of their concurrent application in determining design patent infringement.<sup>91</sup>

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81. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1359 (Fed. Cir. 2007) (Dyk, J., dissenting).

82. *Id.*

83. *See* 35 U.S.C. § 282 (2006) (“The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.”).

84. *Egyptian Goddess*, 498 F.3d at 1360 (Dyk, J., dissenting) (citing *Lawman Armor Corp. v. Winner Int’l, LLC*, 437 F.3d 1383, 1385 (Fed. Cir. 2006)) (“Whether there is any suggestion to combine prior art references may be relevant in a validity inquiry to determine obviousness . . . but has no place in the infringement issue in this case.”); *see generally* *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893).

85. *Egyptian Goddess*, 498 F.3d at 1359 (citing *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988)).

86. *See id.*

87. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679-80 (Fed. Cir. 2008).

88. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 256 F. App’x 357 (Fed. Cir. 2007).

89. *See id.*

90. *See id.* at 357-58.

91. *Egyptian Goddess*, 543 F.3d at 671.

Although the court recognized that cases decided after *Litton* have used the tests as “conjunctive,”<sup>92</sup> “the extent to which the point of novelty test has been a separate test has not always been clear in this court’s case law.”<sup>93</sup> In fact, the court contended “the merger of the point of novelty test and the ordinary observer test is legal error.”<sup>94</sup>

Not unexpectedly, EGI encouraged the termination of the PON test, asserting that the OO test is capable of fulfilling the purposes for which the PON test was designed, but with less risk of confusion.<sup>95</sup> Without requiring the fact-finder to identify the points of novelty,<sup>96</sup> a patentee does not risk losing in summary judgment because of a failure to identify a court-approved PON.<sup>97</sup> A patentee may instead charge an accused infringer based on the article’s overall appearance alone,<sup>98</sup> which some have considered a lower burden of proof for plaintiffs.<sup>99</sup> Even without the PON test, according to EGI, an ordinary observer familiar with prior art would “naturally be drawn to the features of the claimed and accused designs that render them distinct from the prior art.”<sup>100</sup>

Swisa, however, argued for the continuation of the PON test, interpreting the holding of *Smith v. Whitman Saddle Co.*<sup>101</sup> as a

92. *Id.*

93. *Id.*; see *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993) (applying both OO and PON tests); see also *Shelcore, Inc. v. Durham Indus., Inc.*, 745 F.2d 621, 628 n.16 (Fed. Cir. 1984) (applying both OO and PON tests).

94. *Egyptian Goddess*, 543 F.3d at 671 (citing *Unidynamics Corp. v. Automatic Prods. Int’l, Ltd.* 157 F.3d 1311, 1324 (Fed. Cir. 1998) (holding that the merging of the OO test and PON test was legal error)); see *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002) (discussing that the courts cannot rely on the claimed overall design as the point of novelty); see also *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir. 1995) (discussing that the collapse of the PON test into the substantial similarity test constitutes legal error).

95. See *Egyptian Goddess*, 543 F.3d at 672.

96. See, e.g., *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1375 (Fed. Cir. 2004) (noting the district court’s finding that “the points of novelty issue was a question for the fact finder”); *Fisher-Price, Inc. v. Safety 1st, Inc.*, 109 F. App’x 387, 394 (Fed. Cir. 2004); *Contessa Food Prods.*, 282 F.3d at 1377; *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1286-87 (Fed. Cir. 2002).

97. See, e.g., *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1358 (Fed. Cir. 2007); see generally *Blankenship v. Barnett Bank*, No. 00-1087, 2000 WL 369672 (Fed. Cir. Apr. 10, 2000); *Lawman Armor Corp. v. Winner Int’l, LLC*, 437 F.3d 1383, 1385-86 (Fed. Cir. 2006); *Colida v. Ericsson, Inc.*, No. 03-1599, 2004 WL 386590 (Fed. Cir. Mar. 2, 2004).

98. See, e.g., *Gorham Co. v. White*, 81 U.S. 511, 530 (1871).

99. See Brief of Nike, Inc. as Amicus Curiae at 1, *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (No. 3:03-CV-0594), 2007 WL 3192566 (claiming overall appearance alone changes the burden to “substantial, rather than clear and convincing”).

100. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 672 (Fed. Cir. 2008).

101. *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893).

standard established by the Supreme Court to be the “second and distinct test for design patent infringement.”<sup>102</sup> Swisa contended that the CAFC was bound by the Supreme Court’s decision in *Whitman Saddle*.<sup>103</sup> In its review of the *Whitman Saddle* decision, the CAFC held that the Supreme Court had not adopted a separate PON test, but rather, the PON test was inconsistent with the objectives of the OO test as established by *Gorham*.<sup>104</sup> It interpreted *Whitman Saddle* merely held that, in light of the similarities between prior art and the patented design, the accused did not possess the unique feature that made it appear any more similar to the patented design than it did the prior art designs.<sup>105</sup> On this basis, the court denied any use of a PON test.<sup>106</sup> Referring to the origins of the PON test, the court then reread *Litton* as also applying the OO test in which the ordinary observer views the differences between the patented design and the accused product in the context of prior art.<sup>107</sup>

An issue of concern to the CAFC was the ease of application of the PON test.<sup>108</sup> While the court conceded that the test is reasonably straightforward in cases where the claimed design is based upon a single PON over prior art, it argued the complications of using the PON test when presented with a complex or combination PON. Furthermore, the problem did not dissipate whether or not it was applied congruently or independently with the OO test.<sup>109</sup>

In products where parties disagree on its PON advance over prior art, such as the D’389 nail buffer, “the outcome of the case can turn on which of the several candidate points of novelty the

102. *Egyptian Goddess*, 543 F.3d at 672.

103. *See id.*; *Whitman Saddle*, 148 U.S. 674.

104. *See Egyptian Goddess*, 543 F.3d at 672 (“[T]he point of novelty test as a second and free-standing requirement for proof of design patent infringement . . . is not needed to protect against unduly broad assertions of design patent rights.”).

105. *See id.* at 673-74; *see also Whitman Saddle*, 148 U.S. 674.

106. *See Egyptian Goddess*, 543 F.3d at 672-74 (“A close reading of *Whitman Saddle* and subsequent authorities indicates that the Supreme Court did not adopt a separate point of novelty test for design patent infringement cases.”); *see also Whitman Saddle*, 148 U.S. 674.

107. *Egyptian Goddess*, 543 F.3d at 676 (“When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And . . . small differences between the accused design and the claimed design are likely to be important to the eye . . .”).

108. *See id.* at 671-77.

109. *See id.* at 671 (“[A]pplying the point of novelty test where multiple features and multiple prior art references are in play has led to disagreement over whether combinations of features, or the overall appearance of a design, can constitute the point of novelty of the claimed design.”).

court or fact-finder focuses on” instead of evaluating the designs as a whole.<sup>110</sup> Moreover, with multiple points of novelty, the court feared that despite an identical appearance, an accused might argue that it did not infringe because it did not copy all points of novelty.<sup>111</sup> The court’s concern that the need to define an article’s PON detracts from the main infringement issue, which led to its ultimate decision to reconsider “the place of the point of novelty test in design patent law generally.”<sup>112</sup>

Numerous amici curiae briefs were filed and many asserted that the proper approach in infringement analysis calls for a three-way visual comparison.<sup>113</sup> Supporters in favor of the elimination of the PON test included some of the United States’ largest corporations (e.g., Apple, Nike, etc.), bar associations (e.g., FCBA, AIPLA, etc.), and trade associations (e.g., IDSA, IPLA, etc.)<sup>114</sup>

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110. *Id.* at 677.

111. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008). With more points of identified novelty, the more opportunities a defendant may have to argue that its design does not infringe. Therefore, an accused might be able to copy many points of novelty and give the overall appearance of being identical to the claimed design, but argue it did not appropriate all of them. *Id.*

112. *Id.* at 671.

113. *See id.* at 672; Brief for Designers Society of America as Amicus Curiae Supporting Plaintiff-Appellant, *Egyptian Goddess*, 543 F.3d 665 (No. 2006-1562), 2008 WL 644362; Brief for Property Law Association of Chicago as Amicus Curiae Supporting Neither Party, *Egyptian Goddess*, 543 F.3d 665 (No. 2006-1562), 2008 WL 545142; Brief for Fédération Internationale Des Conseils En Propriété Industrielle (“FICPI”) as Amicus Curiae Supporting Neither Party (Supporting Reversal), *Egyptian Goddess*, 543 F.3d 665 (No. 2006-1562), 2008 WL 644359; Brief for American Intellectual Property Law Association as Amicus Curiae Supporting Neither Party, *Egyptian Goddess*, 543 F.3d 665 (No. 2006-1562), 2008 WL 644360; Brief for Electrolux Home Products, Inc. & Nike, Inc. as Amici Curiae Supporting Neither Party (Supporting Reversal), *Egyptian Goddess*, 543 F.3d 665 (No. 2006-1562), 2008 WL 644361; Corrected Brief for Apple, Inc. as Amicus Curiae Supporting Neither Party (Supporting Reversal), *Egyptian Goddess*, 543 F.3d 665 (No. 2006-1562), 2008 WL 699183; Corrected Brief for Federal Circuit Bar Association as Amicus Curiae Favoring Reversal and Supporting Neither Party, *Egyptian Goddess*, 543 F.3d 665 (No. 2006-1562), 2008 WL 699181.

114. *See supra* note 113 and accompanying text.

IV. *EGI* V. *SWISA*'S INFLUENCE ON THE FUTUREA. *Clarifying the OO Test For Its Use In Future Case Law*

## 1. Reconciling the Ordinary Observer and the Point of Novelty Tests

In deciding *EGI*, the CAFC specifically adopted the *Gorham* OO test in favor of the *Litton* PON test.<sup>115</sup> Despite this, the PON test has all but disappeared, as parties must still inquire into prior art.

The CAFC's decision to eliminate the PON test was seemingly abrupt, considering the court affirmed judgment for Swisa for *EGI*'s failure to list what the court deemed the correct PON only one year before.<sup>116</sup> In its rehearing en banc decision, the court even goes so far as to declare that "the merger of the point of novelty test and the ordinary observer test is legal error,"<sup>117</sup> citing *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.*<sup>118</sup> Irrespective of this *Sun Hill* case, courts had routinely continued to embrace the tests' confluent use for many years.<sup>119</sup> It is paradoxical to receive the CAFC's characterization of the PON test as "recent vintage"<sup>120</sup> when it was still applied by all courts up to this very decision made in *EGI*.<sup>121</sup>

The issue remains as to what the OO test standing alone signifies and the amount of protection it affords a patentee. The court shows good intentions by reducing PON guesswork for future parties,<sup>122</sup> yet remnants of the PON inquiry clearly remain in the court's revised test; such elements were nonexistent in the standard of *Gorham*.<sup>123</sup> *EGI*'s final amalgamation of an

115. See *Egyptian Goddess*, 543 F.3d at 678.

116. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1358-59 (Fed. Cir. 2007).

117. *Egyptian Goddess*, 543 F.3d at 671 (quoting *Unidynamics Corp. v. Automatic Prods. Int'l Ltd.*, 157 F.3d 1311, 1323-24 (Fed. Cir. 1998)).

118. See *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir. 1995).

119. See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993) (applying both OO and PON tests); see also *Shelcore, Inc. v. Durham Indus., Inc.*, 745 F.2d 621, 628-29 (Fed. Cir. 1984) (applying both OO and PON tests).

120. See *Egyptian Goddess*, 543 F.3d at 672.

121. See generally *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1320-27 (Fed. Cir. 2007) (applying the PON test in 2007); *Lawman Armor Corp. v. Winner Int'l, LLC*, 437 F.3d 1383, 1384 (Fed. Cir. 2006) (applying the PON test in 2006).

122. See *Egyptian Goddess*, 543 F.3d at 677.

123. Compare *id.* at 677, 682 (applying the OO test "as informed by the prior art"), with *Gorham Co. v. White*, 81 U.S. 511, 526-31 (1871).

infringement test still retains ambiguity as it treats points of novelty as fleeting concepts to note and consider as opposed to a measure of concrete embodiments to be found in an accused work.

## 2. The Spirit of *Gorham's* Ordinary Observer

After pages of expert testimony from both parties, the *Gorham* court determined that the test for patent design should be viewed through the eyes of “men generally, of observers of ordinary acuteness, . . . [and] of ordinary intelligence.”<sup>124</sup> The Supreme Court understood an infringer’s intentions to mislead consumers into purchasing an article they believed to be, or made by, another.<sup>125</sup> The advantage of a patent, the court held, is destroyed when the overall appearance of an original work is preserved, save a few lines noticeable only by experts.<sup>126</sup> The court concluded, without assigning explicit qualifications, that an ordinary observer should be one “giving such attention as a purchaser usually gives . . . .”<sup>127</sup> In this manner, judgment against a defendant is not limited to only cases of literal infringement.

It is difficult to argue that *EGI* preserves the spirit of *Gorham's* ordinary observer. By requiring the ordinary observer to take into account prior art, the CAFC applied a different analytical approach to design patent infringement, creating a superior breed of ordinary observer.<sup>128</sup> The essence of a consumer’s passing eye is lost to an informed customer who now has the opportunity to compare prior art and the original design with the accused’s. The issue now is whether *EGI's* observer is, in fact, ordinary.

On the other hand, if the court meant to follow the trends of steadily changing case law, courts must also recognize the newly-adopted standard set forth in *Arminak & Associates, Inc. v. Saint-Gobain Calmar, Inc.*<sup>129</sup> In *Arminak*, the CAFC shifted the

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124. *Gorham*, 81 U.S. at 528.

125. *See id.* at 530 (noting the experts agree that the designs are so nearly identical that ordinary purchasers of silverware would mistake one for the other).

126. *See id.* at 528; *see, e.g., id.* at 526-27 (“[The] sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if sufficient to change the effect upon the eye, will not destroy the substantial identity.”).

127. *Id.* at 528.

128. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677, 682 (Fed. Cir. 2008) (stating that the court must use an ordinary observer “as informed by the prior art”).

129. *See Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314 (Fed. Cir. 2007).



century old *Gorham* ordinary observer reference from retail purchaser to commercial buyer, assuming the ordinary observer will have minimum familiarity with the product in question.<sup>130</sup> Reviewing its decision in *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*,<sup>131</sup> the court re-examined the focus of the OO test, which had refined the previously nondescript purchaser described in *Gorham* to an ordinary purchaser of the product at issue.<sup>132</sup> To the *Arminak* court, a knowledgeable observer was not unique to the *Goodyear* case, citing evidence of such a standard dating as early as 1933.<sup>133</sup>

If the *EGI* court's intentions were to revert to the original *Gorham* test, it is mistranslating the broad spirit of the ordinary observer. However, if it meant to adopt *Arminak's* tighter focus of the OO standard, *EGI* failed to mention any such revisions and clarifications of the modern OO. It is not yet known if tomorrow's OO is one who casually views the design for the first time, or professionally for the hundredth time.

### 3. The Spirit of *Gorham's* Ordinary Observer Test

Although *EGI* claimed its adoption of the OO test to be "in accordance with *Gorham*," the court allowed a comparison of the designs and an examination of any novel features.<sup>134</sup> Conversely however, *Gorham* disagreed with the lower court's opinion that there must "be a comparison of the features which make up the two designs."<sup>135</sup> As long as the general effect is appropriated, a purchaser may be misled, even if he is not afforded an opportunity to inspect the competing designs.<sup>136</sup> In fact, several

130. See *id.* at 1321-24.

131. See *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113 (Fed. Cir. 1998).

132. Compare *Arminak & Assocs.*, 501 F.3d at 1322 ("In the *Goodyear* case . . . we stated that the focus of the ordinary observer test is 'on the actual product that is presented for purchase, and the ordinary purchaser of *that* product.'" (emphasis in original) (citing *Goodyear Tire & Rubber*, 162 F.3d at 1117)), with *Gorham Co. v. White*, 81 U.S. 511, 522-31 (1871).

133. See *Arminak & Assocs.*, 501 F.3d at 1322 ("The ordinary observer is not any observer, but one who, with less than the trained facilities of the expert, is 'a purchaser of things of similar design,' or 'one interested in the subject' . . . one who, though not an expert, has reasonable familiarity with such objects . . ." (citing *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933))); see also *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1451 (Fed. Cir. 1993) (holding that the ordinary purchaser of disputed object was the retail purchaser, not the final consumer); see, e.g., *Spotless Enters., Inc. v. A&E Prods. Group, L.P.*, 294 F. Supp. 2d 322 (E.D.N.Y. 2003); *Puritan-Bennett Corp. v. Penox Techs., Inc.*, No. IP02-0762-C-M/S, 2004 WL 866618 (S.D. Ind. Mar. 2, 2004).

134. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008).

135. *Gorham Co. v. White*, 81 U.S. 511, 527 (1871).

136. See generally *id.* at 526-31.

of plaintiff's experts in *Gorham* notably testified that the designs in question were actually substantially different, although they could only conclude so if presented the products side-by-side.<sup>137</sup> The *Gorham* patent was then protected only because the opportunity to contrast the competing designs was held inadmissible.

Recent court trends, though, have shown a stark contrast from the original *Gorham* decision in allowing the lower courts to conduct a detailed side-by-side comparison between the patented design and the accused design.<sup>138</sup> The *Gorham* standard may arguably be saved from the side-by-side comparison if *Arminak* meant only to apply its interpretation of 35 U.S.C. § 289 to the PON test.<sup>139</sup> However, *EGI* demonstrates that case law concerning the OO has been anything but explicit and definite, resulting in the occasional application of 35 U.S.C. § 289 to the ordinary observer.<sup>140</sup> By mandating a three-way comparison as a test for infringement,<sup>141</sup> *EGI* is not a clean reversion to *Gorham* as it evidently appropriates details that attribute to, and originate from, the PON test.<sup>142</sup>

If the CAFC stands by the test that arises out of *EGI*, it may wish to review its interpretation of *Sun Hill*.<sup>143</sup> In an attempt for efficiency, the trial court in *Sun Hill* conflated the PON with the OO test.<sup>144</sup> The CAFC reversed the lower court's holding, specifically condemning the "collaps[e] of the point of novelty test into the substantial similarity test."<sup>145</sup> At first look, it appears that *EGI*'s infringement standard is remarkably similar to the very method *Sun Hill* characterizes as legal error, and therefore

137. See *id.* at 515 (Newell Mason, a twenty-year veteran jeweler testified that "[t]he patterns are substantially different, but ordinary purchasers, seeing them apart, would mistake one for the other."); see also *id.* at 515-17 (Henry B. Renwick, a sixteen-year expert in the examination of machinery, inventions, and patents testified, "It might deceive me, I think, in going from one store to another, but not if shown me in the same shop where I had just examined one of the Gorham spoons.").

138. See generally *Arminak v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1327 (Fed. Cir. 2007) (stating that there is no authority for defendant's contention that it was improper for the district court to do a detailed side-by-side comparison).

139. See *id.* at 1323; 35 U.S.C. § 289 (2006).

140. *Arminak*, 501 F.3d at 1327 ("Without comparing the patented design with the accused design, there was no way for the district court to determine whether an ordinary observer would find the accused design deceptively similar and whether the accused design appropriated points of novelty.").

141. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008).

142. See *id.* at 672-79.

143. See *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193 (Fed. Cir. 1995).

144. See *id.*

145. *Id.* at 1197.

128 *HOUSTON BUSINESS AND TAX LAW JOURNAL* [Vol. X

was citing case law that did not support its contentions. However, observant patent litigators will note the crucial aspect distinguishing the two cases. Perhaps by not explicitly identifying it as a merged test, the *EGI* standard distinguishes itself from *Sun Hill*.<sup>146</sup> It is yet unsettled how future case law will reconcile these cases.

## 4. The OO Test in Other Areas of Intellectual Property

An assessment of the court's newly suggested OO test cannot be complete without also noting the use of the ordinary observer in other areas of intellectual property. In order to determine substantial similarity for copyright enforcement, courts have frequently utilized an "ordinary observer" test which looks to the 'total concept and feel' of the competing works."<sup>147</sup> Not unlike the *Gorham* standard, the copyright OO test surveys the entire view of a product as compared to another without regard to prior art.<sup>148</sup> While patents and copyrights are arguably two incomparable prongs of intellectual property,<sup>149</sup> it cannot be denied that the *EGI*'s new-old standard is shifted away from other tests that share its name. Future courts should take care to note that *EGI* instills a distinctly different ordinary observer test within the realm of intellectual property. Courts may later want to restore OO uniformity between designs and copyrights.

## 5. Case by Case in the Future?

The existence of various and numerous prior nail buffer configurations distinguishes *EGI* from *Gorham*. While *Gorham* was decided based purely on the ornamental design on a product, *EGI* had to take into account the three-dimensional configurations a nail buffer can encompass.<sup>150</sup> With multiple

146. Compare *Egyptian Goddess*, 543 F.3d at 672-79, with *Sun Hill Indus., Inc.*, 48 F.3d at 1197.

147. Aric S. Jacover & Christopher C. Mackey, *Basic Copyright Enforcement*, in UNDERSTANDING COPYRIGHT 2008 144 (Pat., Copyrights, Trademarks, and Literary Prop. Course Handbook Series, 2008), available at 938 PLI/Pat 133 (Westlaw); see also Mary Jane Augustine & Christopher S. Dunn, *Consequences of Ownership or Licensing of the Project Drawings—If You Pay For It, Do You Own It?* 28 CONSTRUCTION LAW. 35, 38 (2008) (citing *Johnson v. Gordon*, 409 F.3d 12, 18-19 (Mass. 2005) (describing the copyright ordinary observer test as asking whether an "ordinary person of reasonable attentiveness would, upon . . . looking at [the original and copied works], conclude that the defendant unlawfully appropriated the plaintiff's protectable expression")).

148. See *King Features Syndicate v. Fleischer*, 299 F. 533, 535 (2d Cir. 1924) ("A copy is that which ordinary observation would cause to be recognized as having been taken from or the reproduction of another.").

149. See generally 17 U.S.C. § 101 (2006); 35 U.S.C. § 171 (2006).

150. Compare *Gorham Co. v. White*, 81 U.S. 511, 527 (1871), with *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 668 (Fed. Cir. 2008).

prior designs that had shape-shifted over the years,<sup>151</sup> *EGI* had to reconcile the alleged infringer's work against both the original design and previously marketed ones. A triple comparison was the only way to frame the context of the accused work to determine ultimate infringement.<sup>152</sup> If the existence of prior art required a three-way comparison to justly establish infringement, how, then, would the court address a case like *Gorham*, where prior art is based solely on its artistic value?

Likewise, to reconcile *Arminak*, there was the introduction of a secondary buyer who assembled products before reselling to the general public.<sup>153</sup> This allowed the *Arminak* court to question the identity of the OO, as an assembling purchaser is expected to be more knowledgeable than any common customer.<sup>154</sup> Neither *Gorham* nor *EGI* considered the OO to be any other than the final purchaser and therefore, did not have to address *Arminak*'s concerns. The more sophisticated a customer, the less a plaintiff might predict a judgment of infringement,<sup>155</sup> as his skilled eye would allow him to more likely recognize infringement. Therefore, the identity of the ordinary observer—whether common, informed, or expert—can either result in great success or complete ruin for a patentee.

*EGI*'s D'389 design and Swisa's buffer design are observably similar; both are tubular nail buffers with a hollow square cross section and raised buffer pads mounted on the sides.<sup>156</sup> Although case law would suggest a different outcome arising from *EGI*,<sup>157</sup>

151. *Egyptian Goddess*, 543 F.3d at 681 fig. 2.

152. *See id.* at 676-77 ("Particularly in close cases, it can be difficult to answer the question whether one thing is like another without being given a frame of reference. The context in which the claimed and accused designs are compared, i.e., the background prior art, provides such a frame of reference and is therefore often useful in the process of comparison.").

153. *See Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1321 (Fed. Cir. 2007) (citing *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 424 F. Supp. 2d 1188, 1198 (C.D. Cal. 2006) ("The record clearly shows that Calmar never sold any of its patented shrouds directly to retail consumers.")).

154. *Compare Arminak*, 501 F.3d at 1321 ("If the ordinary observer is the contract buyer or industrial purchaser of trigger sprayers, then the undisputed material facts in the record establish that such a purchaser would not find substantial similarity between the patented and accused shrouds, and therefore would not be decided into thinking that *Arminak*'s AA Trigger shroud is one of the patented designs."), *with Gorham*, 81 U.S. at 526-31.

155. *See, e.g., Arminak*, 501 F.3d at 1315 (holding that the OO and purchaser should be the knowledgeable industrial buyer, and holding no infringement as the products were not deceptively similar to design patents); *see generally Gorham*, 81 U.S. at 528 ("It is said an engraver distinguishes impressions made by the same plate.").

156. *See Egyptian Goddess*, 543 F.3d at 681 fig. 2.

157. *See, e.g., S. Dresner & Son v. Doppelt*, 120 F.2d 50, 51 (7th Cir. 1941) ("It is similarity in the peculiar or distinctive appearance which constitutes infringement [of a

the CAFC unyieldingly held a non-infringement judgment for Swisa.<sup>158</sup>

In the end, *EGI* may be less significant to patentees and infringers than previously projected. The claimed reversion to *Gorham's* OO is tainted with several aspects of the PON test, and most cases will likely be held no differently than they would have been prior to the decision of *EGI*.<sup>159</sup> *EGI* essentially suggests the PON test without calling it so; infringement is now found when the accused appropriates *a* novelty as opposed to appropriating *the* novelty.<sup>160</sup> This test still relies on the OO to recognize distinctions between the designs, though they might not be *the* singular distinction protected by patentee.<sup>161</sup> Only simple semantics separate *EGI* from *Litton*.<sup>162</sup>

Ideally, the *EGI* ruling provided plaintiffs a lower standard to prove a case using a broad span of similarity. There are fewer technical points for a fact-finder to review as the reversion to the OO test calls for a general overview of the competing designs, but the CAFC's application of the law showed that proving infringement under the new OO test will not be as transparent as a plaintiff would prefer. Many cases may still turn on technical points of prior art as the revised OO test still involves an examination of features as part the infringement analysis. Although sameness of appearance remains the touchstone of design infringement, novel features are still probative to the determination of infringement. Future patentees would be wise to recognize the differences that distinguish the key design patent cases and such differences, which called for the particular decisions made by the courts. *EGI* won the battle but lost the war, or perhaps it was the other way around. Once again, the court used the ordinary observer test to analyze infringement,

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design patent] rather than identity in the details producing such appearance.”); *North British Rubber Co. v. Racine Rubber Tire Co. of New York*, 271 F. 936, 938 (2nd Cir. 1921) (“[A patented] design must be looked at as a whole.”); *Zidell v. Dexter*, 262 F. 145, 146 (9th Cir. 1920) (holding where invention consists only of bringing together old elements with slight modifications of form, a person using the same elements with his own variations of form does not infringe, if his design is reasonably distinguishable); *Lewy v. Hoffman Beverage Co.*, 27 F. Supp. 533, 534 (S.D.N.Y. 1939) (holding that the infringement of a design patent is not determined by picking apart the elements of the alleged infringing device but is determined by appearance of device in its total aspect in comparison with the patent design).

158. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 683 (Fed. Cir. 2008).

159. See *id.* at 677 (stating that an OO, when comparing the claimed and accused designs in light of the prior art, will attach importance to differences between the claimed design and the prior art depending on the overall effect of those differences on the design).

160. See *id.*

161. See *id.*

162. See *id.*; see *supra* note 147.

but interestingly, it found non-infringement despite the view of many that this test is a lowered standard of finding infringement.<sup>163</sup>

Although the court hoped to resolve dual infringement test issues, *EGI* might only be precedent to patentees who share a similar fact pattern.

## B. *Revising Claim Construction*

### 1. A Departure from *Gorham*

How does one *really* describe a Picasso? A Dali? A Monet? Each disembodied eye, each melting clock, and each stroke of color are attractions on its own, but these pieces of work are more than the sum of its parts.

Perhaps it is best to revise infringement claims by reassessing the beginnings of infringement analysis and claim construction, which is what the so-called “Markman Order” dictates.<sup>164</sup> For utility patents, claims are translated from patent jargon into everyday English.<sup>165</sup> For design patents, where claims are prosecuted with only illustrations and photographs,<sup>166</sup> the Markman Order construction is the first such “verbalization” of the patent,<sup>167</sup> requiring a judge to put into words the visual appearance of the designs as shown in the patent drawings.<sup>168</sup> Originally intended to construe the scope of utility patents, the decision in *Elmer v. ICC Fabricating*<sup>169</sup> later extended the *Markman* decision to also apply to design patents, reinforcing the progressive trend of eliminating *Gorham*’s ordinary observer comparison. A verbal comparison between the original and

163. See, e.g., Brief for Nike, Inc. as Amicus Curiae Submitted with leave of the Court, *Egyptian Goddess*, 543 F.3d 665 (No. 2006-1562), 2007 WL 3192566 at 1 (claiming overall appearance alone changes the burden to “substantial, rather than clear and convincing”).

164. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996).

165. See Kristen Osenga, *Linguistics and Patent Claim Construction*, 38 RUTGERS L.J. 61, 92 (2006); see also ROBERT C. KAHRL, PATENT CLAIM CONSTRUCTION § 1.01 (Aspen Publishers 2001) (describing claim construction as the process by which the courts determine the true meaning of the claims of a patent).

166. See 37 C.F.R. § 1.152 (2008); see also Saidman & Singh, *supra* note 50, at 796 (“There is never language in the design patent claim itself that requires interpretation.”).

167. Craig Zieminski, *A Function for Markman Claim Construction in Design Patents*, 90 J. PAT. & TRADEMARK OFF. SOC’Y 326, 327-28 (2008); *Id.* at 350 (describing claim construction as “translating an illustration into a verbal description and parsing the illustration for those elements whose design is dictated by utilitarian considerations”); see also Saidman & Singh, *supra* note 50, at 793.

168. See Saidman & Singh, *supra* note 50, at 793.

169. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995).

accused designs no longer shares the same origins as the OO infringement test described in *Gorham*. The *Gorham* test involved the visual comparison of the accused design and the patented design.<sup>170</sup> The patented design was set forth by the patent drawings.<sup>171</sup> A genuine *Gorham* test, therefore, should involve the comparison between the accused designs to the patent drawings. Error occurs when claim construction takes away the visual comparison granted by *Gorham* to replace it with a detail-oriented inspection,<sup>172</sup> a method specifically rejected by *Gorham*.<sup>173</sup> The Markman Order then serves no additional purpose and becomes an unnecessary recitation of what the fact-finder already visually perceives.

The Markman Order, as applied to design patents, has also been criticized for ignoring the possibility of equivalents.<sup>174</sup> Reflecting upon two CAFC decisions, practitioners Perry J. Saidman and Allison Singh note their drastically different outcomes, contending the *Markman* decision is responsible for this divergence.<sup>175</sup> The pre-*Markman* decision of *Braun Inc. v. Dynamics Corp. of America*<sup>176</sup> affirmed a jury finding of infringement; in contrast, the post-*Markman* decision of *OddzOn Products, Inc. v. Just Toys, Inc.*<sup>177</sup> affirmed the lower court's finding of non-infringement, despite that in both cases the patented design and the accused design were more similar in appearance to each other than to the prior art.<sup>178</sup> Without allowing the fact-finder to visually compare the designs in the eyes of an ordinary observer, the *Markman* claim construction, as Saidman and Singh lament, reduces an infringement claim to literal infringement analysis, conditional on how the Markman Order is constructed.<sup>179</sup> Applying *Markman* to design patents

170. See *Gorham Co. v. White*, 81 U.S. 511, 527 (1871).

171. See 35 C.F.R. § 1.152 (2008).

172. See *Lewy v. Hoffman Beverage Co.*, 27 F. Supp. 533, 534 (S.D.N.Y. 1939) (“However, in order to determine infringement one does not of course in a design patent case pick apart the elements.”).

173. *Gorham*, 81 U.S. at 527.

174. See Saidman & Singh, *supra* note 50, at 799 (arguing that given the closeness in overall appearance of the accused design and the claimed design and the contrast of either when compared to prior art, a fact-finder would have been able to return a verdict of infringement given the opportunity to visually compare the designs).

175. *Id.*

176. See *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 819 (Fed. Cir. 1992).

177. See *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1407 (Fed. Cir. 1997).

178. See Saidman & Singh, *supra* note 50, at 797-99.

179. *Id.*

then, they maintain, is a misreading of *Gorham*, regardless of whether or how the courts actually apply the *Gorham* test.<sup>180</sup>

## 2. A Picture is Worth A Thousand Words?

Departure from *Gorham* aside, whereas utility patents are guided by the original claims that provide “a specification describing the invention ‘in such full, clear, concise, and exact terms,’”<sup>181</sup> design patentees are supported only by their claim illustrations.<sup>182</sup> Claim drawings might not precisely communicate the line between that which is protected and that which is available for public use;<sup>183</sup> translations can be imprecise.<sup>184</sup> The linguistics of the description, however carefully chosen, may carry an implication that could causally affect the outcome of the case.<sup>185</sup> Is it oval or ovaloid? Diagonal or slanted askew?

“The court must properly interpret the claims, because an improper claim construction may distort the infringement and validity analyses,” and create a biased advantage for one party.<sup>186</sup> If claims are too broadly construed, the patent is “unnecessarily expanded”; if claims are too narrowly construed, the patentee is “denied the exclusivity to which it is entitled”<sup>187</sup> and may be restricted from the actual scope described by the drawings.<sup>188</sup> Both inaccurate types of claim construction may unfairly and unpredictably alter its scope, undermining the incentives behind the patent system.<sup>189</sup>

180. *See id.* at 800.

181. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (citing 35 U.S.C. § 112 (1994)).

182. *See* 37 C.F.R. § 1.153(a) (2008); *see also* 37 C.F.R. § 1.84 (2008).

183. *See* *Zieminski*, *supra* note 167, at 340.

184. *See id.* at 341-42; *see id.* at 347 (“In the related area of copyright idea/expression abstraction, where the court must separate a protected expression from its unprotected idea, Learned Hand once lamented, ‘Nobody has ever been able to fix that boundary, and nobody ever can.’”); *see also id.* (“[T]here is little reason to think that judges are any better equipped to contend with complex scientific or statistical evidence.” (quoting Jennifer Robbennolt, *Evaluating Juries by Comparison to Judges: A Benchmark for Judging?*, 32 FLA. ST. U. L. REV. 469, 488 (2005))).

185. *See generally* RODNEY JULIAN HIRST, *THE PROBLEMS OF PERCEPTION* 114-17 (Routledge 2004).

186. *See* *Amazon.com v. BarnesandNoble.com*, 239 F.3d 1343, 1351 (Fed. Cir. 2001).

187. *Kimberly A. Moore, Are District Judges Equipped to Resolve Patent Cases?*, 12 FED. CIR. B.J. 1, 23 n.103 (2002).

188. *See id.* at 23.

189. *See id.* at 23 n.103.



“The law of claim construction . . . is easily stated but often difficult to apply.”<sup>190</sup> The most precise verbal description does not necessarily convey a better-defined construction of a claim than the drawings themselves.<sup>191</sup>

It is curious that *EGI*—a post-*Markman* claim—acknowledged the potential for harmful error<sup>192</sup> and recognized that claim construction must be adapted “accordingly,”<sup>193</sup> yet still allowed the admission of the *Markman* Order.<sup>194</sup> Despite denying any requisite need to verbalize the design,<sup>195</sup> the court defended claim construction as a process that could be helpful to the ultimate fact-finder.<sup>196</sup> When this may be so was not disclosed by the CAFC.

Recognizing the potential for inaccuracies and errors but still ambivalently constructing design patent claims<sup>197</sup> corrupts the protection warranted by patents.<sup>198</sup> However, abolishing claim construction for design patents is not necessarily the answer. The purpose behind the claim construction exercise is to define and delineate the “metes and bounds” of the patented design.<sup>199</sup> Whereas utility patents are already prosecuted by articulated claims, a design patent, with illustrations and

190. *Eaton Corp. v. ZF Meritor LLC*, No. 03-74844, 2006 WL 3313190, at \*3 (E.D. Mich. Nov. 14, 2006).

191. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (“[A] design is better represented by an illustration ‘than it could be by any description and a description would probably not be intelligible without the illustration.’”) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)); *see also Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, No. 03-1162, 2004 WL 506587, at \*2 (Fed. Cir. Jan. 16, 2004), (“The infringement analysis essentially involves comparing the drawings to an accused device; a verbal description of the drawings does not necessarily aid such a comparison.”).

192. *See Egyptian Goddess*, 543 F.3d at 679-80 (acknowledging the risk of placing undue emphasis on particular features of the design and the risk that a finder will focus on each described feature rather than on the design as a whole).

193. *Id.* at 679 (citing *Arminak v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1319 (Fed. Cir. 2007)).

194. *Id.* at 668.

195. *Id.* at 679 (“[T]his court has not required that the trial court attempt to provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents.”).

196. *Id.* at 680.

197. *See, e.g., Scott A. Turk, The Proper Method for Using Dictionaries to Construe Patent Claims*, 6 CHI.-KENT J. INTELL. PROP. 43, 47 (2006) (noting that claim construction is “vital, since inaccuracy at the first step of infringement analysis could lead to the wrong results in the second step”).

198. *See* 35 U.S.C. § 271 (2008).

199. *See Associated Equip. Corp. v. Authorized Motor Parts Corp.*, 996 F.2d 317 (Fed. Cir. 1993) (“[C]laim construction ‘is necessary to define the metes and bounds of the protection afforded by the claims.’”) (citing *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985)); *see also Gregory J. Gallagher, Recent Development: The Federal Circuit and Claim Construction: Resolving the Conflict Between the Claims and the Written Description*, 4 N.C. J.L. & TECH. 121, 121-24 (2002).

photographs and no focused claim, has no overt scope.<sup>200</sup> This, of course, must be resolved against a prior statement in dicta by the CAFC that “[d]esign patents have almost no scope.”<sup>201</sup> Scopeless, per se, but not without meaning. The breadth of the patent is encompassed within the drawing,<sup>202</sup> and it should be the drawings themselves at the center of claim construction.<sup>203</sup>

It may be valuable, though, to a jury to have the drawings and prosecution history interpreted from the abstract.<sup>204</sup> Given the meaning behind the dotted lines and shading to describe exactly what the patent warrants, a fact-finder need not be distracted by the areas of the drawing that the patentee does not claim.<sup>205</sup> If, on the other hand, no parts of the claim are in dispute, the trial court would not have to waste time and resources trying to construe the most accurate claim.<sup>206</sup>

Ultimately, *EGI* received the same fate as *OddzOn*;<sup>207</sup> while the accused design was more similar in appearance to the patented product than to prior art, the CAFC still held for non-infringement.<sup>208</sup> This may have been decided differently prior to *Markman*.<sup>209</sup> Because of the difficulties of claim construction,

200. See generally *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (discussing the basic differences between utility and design patent cases).

201. *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988); see, e.g., *Minka Lighting, Inc. v. Craftmade Int'l, Inc.*, 93 F. App'x 214, 216 (Fed. Cir. 2004) (“[D]esign patent scope is severely limited . . .”).

202. See *Unidynamics Corp. v. Automatic Prods. Int'l*, 157 F.3d 1311, 1323 (Fed. Cir. 1998) (“[D]esign patents have almost no scope beyond the drawings . . .”); *Saidman & Singh*, *supra* note 50, at 795 (asserting that visual comparison of a patented design with an infringing design can reveal many differences in detail, which suggests that design patents can have substantial scope).

203. See *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1116 (Fed. Cir. 1998) (indicating that because the design drawings define the design patent claim, claim construction should focus on them).

204. See *Minka*, 93 F. App'x at 216 (suggesting that a verbal description may be helpful if the claim drawing contains features that are not part of the patented design).

205. See *id.*

206. See *Saidman & Singh* *supra* note 50, at 801 (stating that the requirement for converting visual images into words wastes enormous court resources); *Fisher-Price, Inc. v. Safety 1st, Inc.*, Nos. 03-1644, 04-1004, 2004 WL 1946482, at \*2 (“There were no disputed claim terms in the ‘755 patent or the D’940 patent. Consequently, there were no *Markman* proceedings as far as those patents were concerned.”); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (noting that the effort the district court expended in formulating its verbal description of the claimed design was not clearly justified); *Dexas Int'l, Ltd v. Tung Yung Int'l, Inc.*, No. 6:07-cv-334, 2008 WL 4831348, at \*6 (E.D. Tex. June 24, 2008) (“[T]here is no basis to adopt a needlessly confusing claim construction.”).

207. *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997).

208. *Egyptian Goddess*, 543 F.3d at 682.

209. See generally *Saidman & Singh*, *supra* note 50 at 797-800 (concluding that the *Markman* claim construction requirement has resulted in questions of design patent infringement being removed from the jury).

courts may want to entertain other available methods of infringement analysis.<sup>210</sup> With the already numerous similarities between utility patents and design patents,<sup>211</sup> it is logical and even practical to suggest implementing claim drafting in design suits. Applications for utility patents are filed when the patentee verbalizes exactly what he regards as the particular features of his invention,<sup>212</sup> and distinguishes the new article from prior art.<sup>213</sup> The addition of prosecution history to assess later claim construction may prove beneficial for design cases so that a design patentee, just like a utility patentee, cannot describe one claim to get his or her patent issued,<sup>214</sup> but a contrary claim when asserting the patent.<sup>215</sup> In the realm of design patents, it would prevent a patentee from being granted a broadened scope of his work.<sup>216</sup> In conjunction with claim construction, it could help to reduce overly broad Markman Orders, as the court would already have a previous verbalization directly from the original claims of the patentee.<sup>217</sup> The result would be a test more in line with the purposes of design patent protection.<sup>218</sup>

Future case law might also do well to consider non-mandatory claim construction, focusing primarily on the patent drawings, but allowing the fact-finder to use the verbalization of features when necessary to clarify or specify the design claim.<sup>219</sup> *Markman* essentially added a pretrial order in which parties disputed the meanings of key terms and phrases,<sup>220</sup> but little

210. *Dexas Int'l*, 2008 WL 4831348, at \*2 (“Claim construction in the context of a design patent involves an ‘additional level of abstraction’ . . . created by the lack of a written description that is present in a utility patent.” (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996))).

211. See U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1502.01 (8th ed., rev. July 2008).

212. See 35 U.S.C. § 112 (2006).

213. See U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1503.01 (8th ed., rev. July 2008).

214. See 35 U.S.C. § 112.

215. See 35 U.S.C. § 305 (2006); see generally MILLS, REILEY & HIGHLEY, *supra* note 18, § 14:34 (illustrating how claims can be broadened or narrowed by altering the language used in the claim).

216. See MILLS, REILEY & HIGHLEY, *supra* note 18, § 14:34.

217. See 35 U.S.C. § 112 (requiring the patentee to provide a written description of his invention).

218. See generally MANUAL OF PATENT EXAMINING PROCEDURE § 1502 (8th ed., rev. July 2008) (giving the definition and features of a design patent).

219. See *Minka Lighting, Inc. v. Craftmade Int'l, Inc.*, No. 01-1162, 2004 WL 506587 at \*2 (Fed. Cir. 2004) (discussing when a verbal description may be helpful in construing a design patent).

220. See *Zieminski*, *supra* note 167, at 327-28; *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

guidance has been given as to how to easily and accurately construe a design claim.<sup>221</sup> Courts have been met with wordy descriptions in translating claim features,<sup>222</sup> suggesting in the end that a patent's drawing views may very well be "its own best description."<sup>223</sup>

### C. Road to the Supreme Court

Denied a second rehearing en banc, hopeful patentees and competitors waited on a petition for writ of certiorari to the Supreme Court. The Supreme Court had not taken a design patent case that addresses the standard for infringement suits within the last century and has not approached the ordinary observer since *Whitman Saddle*.

The Supreme Court denied certiorari in April of 2009.<sup>224</sup>

And so *EGI* updated the modern standard for infringement suits and ultimately presented a significant development in the area of design patents. Patentees may now interpret the court of appeal's decision as reassurance that infringement claims may more easily be won if a fact-finder need only compare the contending designs.

## V. CONCLUSION

In *Egyptian Goddess, Inc. v. Swisa, Inc.*, the Federal Circuit Court of Appeals specifically adopted the "ordinary observer" test as the exclusive design patent infringement analysis, abrogating twenty years of the court's own precedents.<sup>225</sup> It is the revival of the 1871 Supreme Court decision in *Gorham*, and the rejection, for the most part, of the more recent *Litton* point of novelty

221. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) ("[T]he court has not prescribed any particular form that the claim construction must take.").

222. See, e.g., *Bernardo Footwear, L.L.C. v. Fortune Dynamics, Inc.*, No. H-07-0963, 2007 WL 4561476, at \*2 (S.D. Tex. Dec. 24, 2007) (requiring over 300 words to describe a flip-flop styled sandal); *Calphalon Corp. v. Meyer Corp., U.S.*, No. CIV. S-05-971 WBS DAD, 2006 WL 2474286, at \*2 (E.D. Cal. Aug. 25, 2006) (requiring over 300 words to describe a cookware handle); *Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.*, No. 3:06-CV-995-K, 2008 WL 763160, at \*1-2 (N.D. Tex. Mar. 18, 2008) (requiring approximately 800 words to describe an ornamental ceiling fixture); *Sofpool, LLC v. Intex Recreation Corp.*, No. 2:07-CV-097, 2007 WL 4522331, at \*4 (E.D. Tex. Dec. 19, 2007) (requiring nearly 200 words to describe a round swimming pool).

223. See U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1503.01 (8th ed., rev. July 2008) (quoting *In re Freeman*, 23 App. D.C. 226 (D.C. Cir. 1904)).

224. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 129 S.Ct. 1917 (2009).

225. See *Egyptian Goddess*, 543 F.3d at 678.

test.<sup>226</sup> In doing away with the PON test, the court held that the proper inquiry for infringement claims is whether an ordinary observer with knowledge of the prior art could confuse the accused design as substantially similar.<sup>227</sup> Although many consider this reversion back to the ordinary observer test as lowering the bar for finding infringement,<sup>228</sup> it is yet unclear if *EGI* will prove a substantial victory to future patentee plaintiffs. New issues have emerged concerning the unresolved identity of the proper ordinary observer, when and how much claim construction may aid the ordinary observer in analyzing a patent claim, and how much consideration one must give prior art. Patent practitioners and design patent holders alike will anticipate forthcoming decisions and whether they will reveal the perplexing answers facing design patents left muddied by *EGI*. *EGI* is the CAFC's attempt to realign design patent infringement analysis with the Supreme Court precedent of *Gorham*,<sup>229</sup> but design patent claims warrant close attention as case law continues to unfold.

*Sylvia Ngo*

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226. See *id.*; *Gorham Co. v. White*, 81 U.S. 511 (1871); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984).

227. See *Egyptian Goddess*, 543 F.3d at 678.

228. See Brief for Nike, Inc. as Amicus Curiae Submitted with Leave of the Court, *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 135 (Fed. Cir. 2007) (No. 3:03-CV-0594), 2007 WL 3192566.

229. See *Egyptian Goddess*, 543 F.3d at 678.