

U.S. DESIGN PATENTS STRENGTHENED BY RECENT FEDERAL CIRCUIT RULING

On September 22, the Court of Appeals for the Federal Circuit issued its much anticipated *en banc* decision in the case of *Egyptian Goddess, Inc. v. Swisa, Inc. et al.*, significantly strengthening the U.S. design patent system. While the decision affirmed a finding of non-infringement, the Court dramatically redefined the test for design patent infringement. In doing so, the Court threw out the "point of novelty" as a separate and distinct part of the test for infringement and returned the focus of the analysis to whether the accused design is "substantially the same as" or a "colorable imitation" of the patented design.

Background

A design patent is granted by the U.S. Patent & Trademark Office to protect the ornamental appearance of an article of manufacture. Unlike a utility patent that protects how a product works, a design patent protects how a product looks.

Prior to this decision, design patent infringement analysis had devolved into an element-by-element, verbal analysis of the "novel features" of the patented design, often ending in a finding of non-infringement. Rather than interpreting only the drawing which was the original intent of a design patent, District Courts were requiring patent holders to verbally describe the uniqueness of the design.

Why is this important?

This decision is a welcome development for consumer product companies who struggle to keep knock-offs out of the market, allowing them to assert their patents with greater confidence. In addition to simplifying the test for infringement, the decision shifts the burden of comparing the patented design to the prior art onto the accused infringer. Further, the Fed. Cir. clearly cautioned against a detailed written description of the design patent drawings because it can lead to placing undue emphasis on particular design features, rather than on the design as a whole. This decision should reduce the cost of design patent litigation for the patent holder and could make a finding of design patent infringement on summary judgment more likely.

Sterne Kessler is a leader in the procurement and enforcement of design patents. If you would like to know more about the *Egyptian Goddess* decision or how we can put our knowledge in this area to work for you, please contact Tracy-Gene G. Durkin, Esquire at tdurkin@skgf.com or David K.S. Cornwell, Esquire at davidc@skgf.com. Both can be reached at 202-371-2600.