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"ORDINARY OBSERVER" TEST IS THE ONLY TEST FOR ANALYZING DESIGN PATENT VALIDITY

Last year the Court of Appeals for the Federal Circuit in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) held that the "point of novelty" test was no longer valid in determining design patent infringement. Rather, the "ordinary observer" test from U.S. Supreme Court's decision in *Gorham Co. v. White*, 81 U.S. 511 (1871), is the sole and controlling test for determining whether a design patent has been infringed. The Court in *Egyptian*, however, left unanswered whether the "ordinary observer" test would be applied in design patent validity analyses. On December 17, 2009, the Federal Circuit in *Int'l Seaway Trading Corp. v. Walgreens Corp.*, No. 2009-1237 (Fed. Cir. Dec. 17, 2009) affirmatively answered this question: "the ordinary observer test must logically be the sole test for anticipation as well."

Practical Implications

- Invalidity may be used more frequently as a challenge to design patent infringement.
- How to uniformly apply the "ordinary observer" test in an invalidity analysis must still be determined.
- It is expected that the United States Patent and Trademark Office will be applying the "ordinary observer" test when examining design patent applications. Accordingly, we expect that examination procedures for design patent applications will be an evolving process.

A copy of the Court's full opinion can be found at <http://www.ca9c.uscourts.gov/opinions/09-1237.pdf>.

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