

Design patents, long a bit player on the intellectual property stage, have seemingly entered a new era of respect, valuation and desirability. The legal press is abuzz with articles touting the amazing comeback made by design patents. Utility patents are by far the more common type of patent. These are patents in the classic sense that protect inventions for new and useful advances in technology. A design patent, on the other hand, completely excludes from its scope of protection any design that is dictated by its function and instead protects solely the ornamental appearance of an article of manufacture. This ornamental appearance can include surface ornamentation, the overall design of a product or merely a certain portion of a product.

Design patents often overlap with protection afforded by copyrights and trade dress, in terms of subject matter. However all three of these forms of IP have different standards for protection, terms and many other aspects that differ across the board. To demonstrate the breadth of scope of design patents, one can obtain a design patent for "fabric". The design patent will cover any original work of art that can take the form of a piece of fabric (whether it is ever intended to be made or sold as such is irrelevant). The design patent and the copyright are protecting the very same creation, a two dimensional work of art, but design patent law uses the fiction that what you really have is a new design for an article of manufacture (e.g. fabric, carpet, tile, or sometimes what is merely described in the design patent as a "sheet") while copyright law protects the artwork per se.

Design patents have historically been unfairly maligned. The reasons that have been given for the impracticality of pursuing a design patent have not been based on reality, but have nonetheless taken root – until recently. Some of the reasons that have been given are that i) they take too long (however, an applicant can use an expedited process to seek a design patent at a cost of only \$900 and expect to receive the patent in about 5 months), ii) they are difficult to get (and yet 90% of all applications filed between 2008 and 2011 were allowed), and iii) they are very difficult to enforce successfully in court - that one may have had some truth to it in the past, but at least the perception, if not the truth, is that they are now powerful weapons against copying in many industries from high tech to footwear.

Two events, both stemming from lawsuits - one being an appellate decision that changed the law and the other a high-profile jury verdict in a trial between Apple and Samsung, have played a significant role in resurrecting the design patent from its grave.

Until 2008, the test for infringement of a design patent consisted of two parts. The first part, the "ordinary observer" test, asked whether an ordinary observer, giving such attention as a purchaser usually gives, would be induced to purchase the accused design thinking it to be the patented design. The second part of the test, the "point of novelty" test, asked whether the accused design appropriates the novelty in the design patented that distinguishes it from the "prior art" which encompasses all designs already in the public domain. The point of novelty test had proved extremely difficult to apply and was easily manipulated to the advantage of both patentees and accused infringers in litigation.

In 2008, the Federal Circuit Court of Appeals issued a game changing decision in *Egyptian Goddess, Inc. v. Swisa et al.* 543 F.3d 665 (September 22, 2008). Egyptian Goddess is a Texas-

based company that sells nail, body, and skin care products. On December 17, 2002, the USPTO granted Egyptian Goddess patent number D467,389, which claims "the ornamental design for a nail buffer." The patented nail buffer is rectangular and has nail-buffing surfaces on three of its four sides. Shortly after receiving its patent, Egyptian Goddess sued Swisa Inc. in the Northern District of Texas for infringement by Swisa's own four-sided rectangular nail buffer. After construing the patent's claim, and then comparing the construed claim to the defendants' product, the U.S. District Court for the Northern District of Texas granted summary judgment for Swisa. The District Court found that the defendants' buffer did not incorporate the one point of novelty that Egyptian Goddess' design had over the prior art: Swisa's nail buffer had buffer pads on all four sides of its product instead of just three.

On appeal, the Federal Circuit streamlined design patent infringement analysis by disposing of the point of novelty test in favor of the ordinary observer test. Shortly after this decision, in *Int'l Seaway Trading Corp. v Walgreens Corp.*, 589 F.3d 1233 (Fed. Cir. 2009), the Federal Circuit went a step further and held that the ordinary observer test is the sole test for design patent validity (the flip side of infringement, which asks whether an article is patentable over prior art).

Patentees now only have to demonstrate that, to an ordinary customer familiar with the prior art, the overall appearance of the accused device is substantially the same as the overall appearance of the design patent (note that the comparison is to the patent, not the device itself).

In theory at least, infringement will be easier to prove because a patentee does not have to struggle with defining the point of novelty and showing that the defendant has in fact appropriated this point of novelty. The *Egyptian Goddess* decision further eases the burden on the patentee because the Federal Circuit gave the accused infringer the burden of comparing the patented design to prior art – reliance on prior art is now a part of the accused infringer's defense.

In the 2012 Apple v Samsung trial, described as perhaps the highest profile patent trial of all time, the jury's finding that the thin, rectangular, rounded-corners design of various Samsung Galaxy devices infringed an Apple design patent is a stunning example of the potential power and scope of design-patent protection and has planted the seeds for a resurgence in design patent applications.

The coverage of the more than \$1 billion verdict, coupled with the clamor over Apple having a "monopoly over rectangles with rounded corners," has placed design patents center-stage. Companies that previously discounted design patent protection are likely to reassess their view. The success of Apple's comprehensive IP strategy, demonstrated by the verdict against Samsung which involved awards based on trade dress, utility patents, and (mostly) design patents is inspiration for others to adopt a similar approach to protecting the IP in their products.