

05-1253

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

LAWMAN ARMOR CORPORATION,
Plaintiff-Appellant,

v.

WINNER INTERNATIONAL, LLC, and
WINNER HOLDING LLC,
Defendants-Appellees.

Appeal from the United States District Court
for the Eastern District of Pennsylvania
in Case No. 02-CV-4595, Senior Judge Robert F. Kelly

**COMBINED PETITION FOR PANEL REHEARING AND FOR
REHEARING EN BANC OF PLAINTIFF-APPELLANT
LAWMAN ARMOR CORPORATION**

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CERTIFICATE OF INTEREST

Counsel for Appellant, Lawman Armor Corporation, certifies the following:

1. The name of every party represented by us is Lawman Armor Corporation.
2. Appellant listed in the above caption is the real party in interest.
3. There are no parent corporations or publicly held companies that own 10 percent or more of the stock of the party represented by us.
4. The names of all law firms and the partners or associates that appeared for the party now represented by us in the trial court or are expected to appear in this court are:

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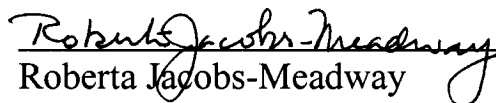
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TABLE OF CONTENTS

	Page
CERTIFICATE OF INTEREST	i
TABLE OF CONTENTS	ii
TABLE OF AUTHORITIES	iii
STATEMENT OF COUNSEL – PETITION FOR REHEARING EN BANC.....	1
POINTS OF FACT OR LAW OVERLOOKED OR MISAPPREHENDED BY THE COURT.....	2
ARGUMENT IN SUPPORT OF A REHEARING AND IN SUPPORT OF REHEARING EN BANC	3
I. The logical yet impossible conclusion of the Court of Appeals for the Federal Circuit’s refusal to permit a combination of elements to be considered a “point of novelty” is that valid design patents can issue and not be capable of being infringed.....	3
II. The <u>Litton</u> case and other Fed. Cir. case law explicitly recognizes that a combination of elements is a point of novelty.....	4
III. The claim of the design element which is shown in solid lines in the drawings should as a matter of law be a “point of novelty” provided it is reviewed with respect to the prior art.....	6
IV. The “point-of-novelty” test contradicts basic patent law tenets set forth by the U.S. Supreme Court and the Court of Appeals for the Federal Circuit.	9
V. Request for Remand.....	15
ADDENDUM: AFFIRMANCE OPINION ISSUED FEBRUARY 22, 2006	
CERTIFICATE OF SERVICE	
CERTIFICATE OF COMPLIANCE	

TABLE OF AUTHORITIES

FEDERAL CASES

<i>Avia Group International, Inc. v. L.A. Gear California, Inc.</i> , 853 F.2d 1557 (Fed. Cir. 1988).....	1, 5, 6
<i>Carella v. Starlight Archery & Pro Line Co.</i> , 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986)	7, 8
<i>Carman Industries Inc. v. Wahl</i> , No. 83-683 slip op. (Fed. Cir. 1983).....	10
<i>Diamond v. Diehr</i> , 450 U.S. 175, 209 U.S.P.Q. 1 (1981)	1, 10, 11, 14
<i>Elmer v. ICC Fabricating, Inc.</i> , 36 U.S.P.Q. 2d 1417 (Fed. Cir. 1995).....	8, 9, 13
<i>Environmental Designs Ltd. V. Union Oil Co. of California</i> , 713 F.2d 693, 218 U.S.P.Q. 865 (Fed. Cir. 1983)	3
<i>Gorham Co. v. White</i> , 81 U.S. 511 (1871).....	5
<i>Graham v. John Deere Co.</i> , 383 U.S. 1, 148 U.S.P.Q. 459 (1966).....	3
<i>In re Gulack</i> , 703 F.2d 1381 (Fed. Cir. 1983)	10
<i>Horwitt v. Longines Wittnauer Watch Co.</i> , 388 F. Supp. 1257, 185 U.S.P.Q. 123 (SDNY 1975)	10
<i>Johnson v. IVAC Corp.</i> , 12 U.S.P.Q. 2d 1382 (Fed. Cir. 1989).....	8
<i>Keystone Retaining Wall System, Inc. v. Westrock, Inc.</i> , 997 F.2d, 1444 (Fed. Cir. 1993).....	1, 7
<i>L.A. Gear v. Thom McCan Shoe Co.</i> , 988 F.2d 1117 (Fed. Cir. 1993)	1, 6
<i>Litton System, Inc. v. Whirlpool Corp.</i> ., 782 F.2d 1423 (Fed. Cir. 1984)	1, 2, 3, 4, 5, 9, 10, 11, 13, 14
<i>In re Mann</i> , 861 F.2d 1581, 8 U.S.P.Q. 2d 2030 (Fed. Cir. 1991).....	8

<i>In re Nalbandian</i> , 661 F.2d 1214, 211 U.S.P.Q. 782 (CCPA 1981).....	3
<i>Scripps Clinic & Research Foundation v. Genentech, Inc.</i> , 927 F.2d 1565, 18 U.S.P.Q. 2d 1001 (Fed. Cir. 1991).....	7
<i>Sears, Roebuck & Co. v. Talge</i> , 140 F.2d 395 (8th Cir. 1944).....	10
<i>Sun Hill Industries, Inc. v. Easter Unlimited, Inc.</i> , 33 U.S.P.Q. 2d 1925 (Fed Cir. 1995).....	6, 7
<i>Warner Jenkinson v. Hilton Davis Chemical</i> , 520 U.S. 17 (1997).....	13, 14
<i>White v. Dunbar</i> , 119 U.S. 47 (1886).....	13
<i>Winner International Corp. v. Wolo Manufacturing Corp.</i> , 15 U.S.P.Q. 2d 1076 (Fed. Cir. 1990).....	6, 7, 13
<i>In re Zahn</i> , 204 U.S.P.Q. 988 (CCPA 1980).....	8, 13

FEDERAL STATUTES

35 U.S.C. Section 101.....	11
35 U.S.C. Section 171.....	3
U.S. Const. art. I, § 8.....	4

UNREPORTED CASES

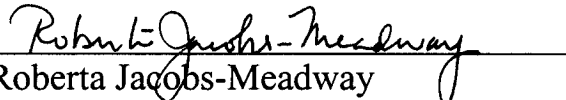
<i>Amini Innovation Corporation v. Anthony California, Inc. and James Chang</i> , Case No. 05-1159, 2006 Westlaw 508698 (Fed. Cir., March 3, 2006).....	7
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**STATEMENT OF COUNSEL – PETITION FOR REHEARING EN
BANC**

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States or the precedents of this court: 1. Litton System, Inc. v. Whirlpool Corp., 782 F.2d 1423 (Fed. Cir. 1984); 2. Avia Group Int’l, Inc. v. L.A. Gear California, Inc., 853 F.2d 1557 (Fed. Cir. 1988); 3. L.A. Gear v. Thom McCan Shoe Co., 988 F.2d 1117 (Fed. Cir. 1993); 4. Keystone Retaining Wall Sys., Inc. v. Westrock, Inc., 997 F.2d, 1444 (Fed. Cir. 1993); 5. Amini Innovation Corporation v. Anthony California, Inc. and James Chang, Case #05-1159 (Fed. Cir., March 3, 2006); 6. Diamond v. Diehr, 450 U.S. 175, 209 USPQ 1 (1981).

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether the “points of novelty” approach as adopted by Litton and its progeny conflicts with a basic patent law tenet set forth by the U.S. Supreme Court and the Court of Appeals for the Federal Circuit that “claims must be considered as a whole”.


Roberta Jacobs-Meadway
Attorney of Record for Plaintiff-Appellant

**POINTS OF FACT OR LAW OVERLOOKED OR
MISAPPREHENDED BY THE COURT**

1. A combination of elements may be considered a “point of novelty” under the “points of novelty” test.

2. Litton System, Inc. v. Whirlpool Corp., 782 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984) specifically recognizes that a combination of elements can be a “point of novelty”.

3. The overall configuration and appearance of the patented design does constitute a “point of novelty” provided it is reviewed with regard to the prior art.

4. The point of novelty approach as adopted by Litton and its progeny conflicts with basic patent law tenets set forth by the U.S. Supreme Court and the Court of Appeals for the Federal Circuit that a patent claim must be considered as a whole.

**ARGUMENT IN SUPPORT OF A REHEARING AND IN SUPPORT
OF REHEARING EN BANC**

At oral argument, counsel for Lawman set forth the points of novelty in the '621 Patent that are neither found directly in the prior art, nor suggested by the prior art. The present Petition for Rehearing focuses not on the specifics, but on the points of law concerning prior art that Lawman respectfully believes must be reconsidered.

- I. The logical yet impossible conclusion of the Court of Appeals for the Federal Circuit’s refusal to permit a combination of elements to be considered a “point of novelty” is that valid design patents can issue and not be capable of being infringed.**

The tests for patentability of designs are the same as for utility patents. See 35 U.S.C. Section 171. In re Nalbandian, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981). Thus, even if a design is made of all old elements, the combination may be patentable. Litton System, Inc. v. Whirlpool Corp., 782 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984), citing at 221 USPQ 109, Environmental Designs Ltd. V. Union Oil Co. of California, 713 F.2d 693, 698, 218 USPQ 865, 87 (Fed. Cir. 1983). See also Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966).

However, if a valid design patent issues which is simply a combination of known prior art elements, it would be impossible to infringe such a design patent if the claimed combination of prior art elements is not considered a

“point of novelty”. In particular, since each element of the combination is known in the art, there can be no “points of novelty”; and according to the decision of this Court in this case of which reconsideration is being requested, with no “points of novelty” there can be no infringement. Such a result runs counter to reason. Indeed, for the Patent Office to issue valid patents incapable of infringement would run afoul of the Constitution Article I, Section 8 which gives Congress the power to grant patents: “To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries...” U.S. Const. art. I, § 8. By holding that design patents which are a combination of old elements as a matter of law cannot be infringed, this Court would be countermanding the “exclusive right” secured by the patent under Article I, Section 8. This result cannot stand.

II. The Litton case and other Fed. Cir. case law explicitly recognizes that a combination of elements is a point of novelty.

One manner of overcoming the problem set forth above is to recognize that the Litton case does in fact explicitly recognize that a combination of elements may and does constitute a point of novelty. In particular, the Litton Court stated:

“The **novelty** of the ‘990 patent **consists... of the combination** on a microwave oven’s exterior of a three-stripe door frame, a door without a handle, and a latch release lever on the control panel.” (emphasis added). 221 USPQ at 110.

The Litton Court did not find or state that there were three “points of novelty”. Rather, they found a single point of novelty which consisted of a combination of elements. *By recognizing that a novel combination of elements relative to the most relevant single piece of prior art is in fact the point of novelty, all valid patents would be capable of being infringed.*

Infringement using this test would require what it presently requires; i.e., a confusingly similar design as set forth in Gorham Co. v. White, 81 U.S. 511 (1871), and appropriation of the point of novelty (the combination of novel elements) of the patented device. Litton at 109 - 110.

It is also noted that the Federal Circuit has previously found a point of novelty in a combination of elements. See, e.g., Avia Group Int’l, Inc. v. L.A. Gear California, Inc., 853 F.2d 1557, 1565 (Fed. Cir. 1988), where the court held that the point of novelty of U.S. Pat. No. Des. 287,301 (shoe upper) was “the **combination** of saddle, eyestay and perforations.” Id. (emphasis added). The court specifically rejected the defendant’s argument that the existence of these individual features in the prior art prevented the

combination of such features from being the patent's claimed novelty. *Id.* at 1564. See also L.A. Gear v. Thom McCan Shoe Co., 988 F.2d 1117 (Fed. Cir. 1993), where the court affirmed a finding that the point of novelty resided in the “overall appearance of the **combination**” of the design patent's major design elements, despite that fact that “all of the elements of the design of the '081 patent were known” and “found in the prior art.” *Id.* at 1124-26 (emphasis added). The court affirmed the district court's conclusion that the novelty resided in the fact that “these particular elements had not previously been combined in a single shoe design.” *Id.* at 1124.

III. The claim of the design element which is shown in solid lines in the drawings should as a matter of law be a “point of novelty” provided it is reviewed with respect to the prior art.

An alternative manner of overcoming the problem set forth above is to recognize that the overall configuration and appearance of the patented design does constitute a “point of novelty” provided it is reviewed with regard to the prior art. This would not overrule prior case law (e.g., Winner International Corp. v. Wolo Manufacturing Corp., 15 USPQ2d 1076 (Fed. Cir. 1990) or Sun Hill Industries, Inc. v. Easter Unlimited, Inc., 33 USPQ2d 1925 (Fed Cir. 1995)) as neither of these cases state that the overall configuration cannot constitute a “point of novelty”. They only state that the

point of novelty must be reviewed with regard to the prior art. Winner at 15 USPQ2d 1077, Sun Hill Industries, Inc. at 33 USPQ2d 1928. In fact, Federal Circuit case law states that it is the overall design which is patented: “A design patent protects the non-functional aspects of an ornamental design as seen as a whole and as shown in the patent.” Keystone Retaining Wall Sys., Inc. v. Westrock, Inc., 997 F.2d, 1444, 1450 (Fed. Cir. 1993). “[I]t is the overall [device] that is patented – not just the details of its ornamentation...” Amini Innovation Corporation v. Anthony California, Inc. and James Chang, Case No. 05-1159, 2006 Westlaw 508698 (Fed. Cir., March 3, 2006). Thus, to hold that the overall configuration cannot constitute a point of novelty would conflict with Federal Circuit case law. In addition, to hold that the overall configuration cannot constitute a point of novelty would be logically self-contradictory, for what makes something novel? The only requirement for novelty is that it is new relative to any piece of prior art; i.e., all elements are not found in a single piece of prior art. Invalidity based on lack of novelty (often called "anticipation") requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991); Carella v. Starlight Archery & Pro

Line Co., 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir. 1986). Since the claim of a design patent is defined by the elements shown in solid lines, In re Zahn, 204 USPQ 988, 994 (CCPA 1980), Elmer v. ICC Fabricating, Inc., 36 USPQ2d 1417, 1421 (Fed. Cir. 1995), if those elements are found in a single piece of the prior art, the design is not patentable as it does not meet Section 102 novelty requirements. On the other hand, **if what is claimed in solid lines is new relative to the prior art, it is by definition novel.**

Hence, for a design patent to be granted and to be valid, the whole design which is being claimed in solid lines must as a matter of law be novel. Thus, the whole design inherently constitutes “a point of novelty”. This is why design patents are generally considered very narrow in scope, In re Mann, 861 F.2d 1581, 1582, 8 USPQ2d 2030, 2031 (Fed. Cir. 1991), because in order to infringe the “point of novelty” which is the whole design, an allegedly infringing product must come very close to the design. If the alleged infringer eliminates elements of the claim, it avoids infringement.

Johnson v. IVAC Corp., 12 USPQ2d 1382, 1384 (Fed. Cir. 1989). The way to obtain a broader patent is to claim only a novel, non-obvious portion of a product design, and to show the remainder of the product in dotted lines. In re Zahn, 204 USPQ 988, 994 (CCPA 1980); Elmer v. ICC Fabricating, Inc.,

36 USPQ2d 1417, 1421 (Fed. Cir. 1995). Then, the remaining solid lined portion must constitute a “point of novelty”.

This Court states in its opinion (for which reconsideration is requested) that “if the combination of old elements shown in the prior art is itself sufficient to constitute a ‘point of novelty’ of a new design, it would be a rare design that would not have a point of novelty”. That is absolutely true. It is the rare design that does not have a point of novelty – most design patents (and patent applications) which are claimed narrowly (without dotted lines) almost immediately meet Section 102 requirements even if they are made up of a combination of elements old in the art. Parenthetically, the same is true for narrowly drafted utility applications. The combination of old elements, however, may in certain cases (not the instant case) be obvious – i.e., the combination may not meet Section 103 requirements.

IV. The “point-of-novelty” test contradicts basic patent law tenets set forth by the U.S. Supreme Court and the Court of Appeals for the Federal Circuit.

While it is possible to follow the Litton (and progeny) guidelines for design patent infringement by accepting that a combination of “points of novelty” constitute the point of novelty for a determination of infringement (as set forth in II. above) and/or that the entire design constitutes the point of

novelty (as set forth in III. above), it is respectfully submitted that the Litton case improperly incorporated a “point of novelty” infringement requirement into design patent infringement law, and should either be modified to rephrase the point of novelty law or should be overturned. In particular, in an attempt to resolve a reasonable issue (i.e., the Gorham test for infringement only deals with confusion of an ordinary observer, but does not account for the fact that the accused design may be closer to the prior art than to the claimed design), the Court borrowed the “point of novelty” test from decisions of other courts: Sears, Roebuck & Co. v. Talge, 140 F.2d 395 (8th Cir. 1944); Horwitt v. Longines Wittnauer Watch Co., 388 F.Supp 1257, 185 USPQ 123 (SDNY 1975). In doing so, the Litton Court limited the “point of novelty” test to determinations of infringement only as it recognized an inherent danger, stating:

“This court has avoided the point of novelty approach in other contexts. See, e.g. Carman Industries, Inc. v. Wahl, No. 83-683 slip op. at 16 (Fed. Cir. 1983) (double patenting); In re Gulack, 703 F.2d 1381, 1835 n.8 217 USPQ 401, 403 n.8 (Fed. Cir. 1983) (unobviousness).” Litton 221 USPQ at 110.

What the Court failed to recognize is that the Supreme Court in Diamond v. Diehr, 450 U.S. 175, 209 USPQ 1 (1981) set forth the exact same principle

with respect to another context (35 USC Section 101) in slightly different terminology; i.e., that in determining patentability, the “claims must be considered as a whole.” Id. 209 USPQ at 9. According to the Supreme Court, “It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis.” 209 USPQ at 9. Considering a claim as a whole would mean avoiding a “point of novelty” approach.

By adopting the “point of novelty” approach with respect to design patent infringement only, the Litton Court attempted to address the issue as to how could there be an infringement if the accused design is closer to the prior art than to the claimed design? However, the adoption of the “point of novelty” approach while ostensibly resolving that issue, results in various self-contradictions or inequities which are explained in detail below. At the same time, another test which will proposed below can properly resolve the issue addressed by the Litton Court while properly reading the claim as a whole.

What self-contradictions and inequities arise from the “point of novelty” approach? Consider the following. A design patent issues to a patentee. Assume that two different parties A and B have devices whose two different designs are substantially the same as the patent such than an

ordinary observer would be confused. In the two possible litigations, in order to have an infringement, the patentee must show that the designs of the alleged infringers incorporate the “points of novelty” of the design patent. Now assume that five different “points of novelty” (1, 2, 3, 4, 5) are identified by the patentee, but the device of party A only has elements 1, 2, 3, 4, while the device of party B has elements 1, 2, 3, 5. The patentee then has the incentive to set forth that there are **fewer** points of novelty (i.e., elements 1, 2, 3 only) than there truly are! On the other hand, each of parties A and B must argue (if given the chance) that the patented design includes **more** points of novelty, as both will avoid infringement by avoiding a single point of novelty; or, given the state of the law as it presently exists (but see Sections I - III above) that there are no points of novelty. Indeed, in most cases, it will be desirable for the patentee to settle on a single element being a “point of novelty” so that infringement is easily proved, whereas, it will be desirable for the infringer to try to allege that there as many points of novelty as possible (or no points of novelty – but see Sections I - III above). Thus, the patentee must set out to find prior art which can be argued to show that a possible point of novelty is not in fact such, whereas the infringer must either prove that a “point of novelty” in the design not identified by the patentee and not present in the allegedly infringing design is actually a

“point of novelty” or that no points of novelty exist. Effectively, then, by using a “point of novelty” approach, the claim of the design patent is subject to being improperly twisted like the proverbial “nose of wax”, see, White v. Dunbar, 119 U.S. 47, 51 (1886) to satisfy the needs of the particular situation of either the patentee or the defendant.

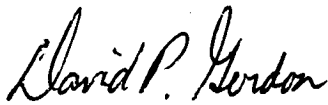
It is respectfully submitted that the proper approach in dealing with the issue that faced the Litton Court is first to determine the scope of the design patent claim *considering all of the prior art and file history*, and then to determine whether the alleged infringing device falls within the scope of that claim. In fact, this two step procedure complies with existing law as set forth by this Court. That the claims must be properly construed to determine their meaning and scope is set forth in Elmer v. ICC Fabricating, Inc., 36 USPQ2d 1417, 1421 (Fed. Cir. 1995). The scope of a claim is initially determined by the solid lines of the drawings. See In re Zahn, 204 USPQ 988, 994 (CCPA 1980). *However, the scope of the claim must also be considered in light of the prior art.* See Winner at 15 USPQ2d 1077. Where the claim is novel relative to the prior art, a range of equivalents can be provided. As in utility patent law, the more novel (“pioneering”) the invention, the more scope given the claim through the doctrine of equivalents. See Warner Jenkinson v. Hilton Davis Chemical, 520 U.S. 17

(1997). Thus, the “points of novelty”, to the extent they are identified, should be used only to expand the scope of the claim shown in the solid lines of the drawings. Once the scope of the claim has been determined in light of the prior art, then a determination may be had as to whether the alleged infringing device is within the scope of the claim. As a result, if an alleged infringing device is substantially close to the prior art in design, there will be no infringement because the breadth of the claim will not reach the alleged infringing device. If, on the other hand, the alleged infringing device is not substantially close to the prior art but is within the breadth of the claim as expanded under the doctrine of equivalents (e.g., using the points of novelty), there will be an infringement. This result satisfies the concerns raised by this Court in Litton, satisfies the principle of reading the claim as a whole as set forth by the Supreme Court in Diamond v. Diehr, provides more certainty to the scope of the design claim prior to litigation, is much more similar to the analysis of claim interpretation and infringement utilized in utility patents, and is more consistent and logical than the “points of novelty” test set forth in Litton.

V. Request for Remand

It is respectfully requested that this Court, after reconsideration of the law, remand this case to the District Court with instructions to: (1) determine the scope of the claim in light of the prior art and consistent with the “point of novelty” law set out in this case; and (2) to determine the issue of infringement after determining the scope of the claim.

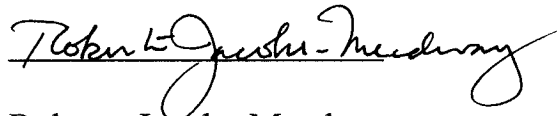
Respectfully submitted,



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ADDENDUM: AFFIRMANCE OPINION
ISSUED FEBRUARY 22, 2006

United States Court of Appeals for the Federal Circuit

05-1253

LAWMAN ARMOR CORPORATION,

Plaintiff-Appellant,

v.

WINNER INTERNATIONAL, LLC
and WINNER HOLDING LLC,

Defendants-Appellees.

Roberta Jacobs-Meadway, Ballard Spahr Andrews & Ingersoll, LLP, of Philadelphia, Pennsylvania, argued for plaintiff-appellant. With her on the brief were Lynn E. Rzonca and Corey Field.

Philip J. Moy, Jr., Fay, Sharpe, Fagan, Minnich & McKee, LLP, of Cleveland, Ohio, argued for defendants-appellees. With him on the brief was Jude A. Fry.

Appealed from: United States District Court for the Eastern District of Pennsylvania

Senior Judge Robert F. Kelly

United States Court of Appeals for the Federal Circuit

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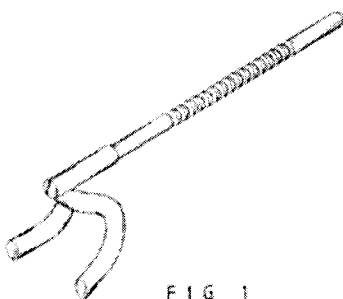
DECIDED: February 22, 2006

Before MICHEL, Chief Judge, FRIEDMAN, Senior Circuit Judge, and DYK, Circuit Judge.

FRIEDMAN, Senior Circuit Judge.

In this design patent case, the district court held that infringement had not been shown because each of the alleged “points of novelty” of the patented design was disclosed in the prior art. Lawman Armor Corp. v. Winner Int’l, 2005 U.S. Dist. LEXIS 2078, No. 02-CV-4595 (E.D. Pa. Feb. 15, 2005) (slip opinion). We affirm that ruling, and reject the patentee’s contention that the combination in the patent of the many non-novel “points of novelty” itself was an additional “point of novelty.” We therefore affirm the district court’s grant of summary judgment of non-infringement.

The basic facts are largely undisputed. The appellant Lawman Armor Corporation (“Lawman”) is the exclusive licensee of U.S. Design Patent No. Des. 357,621 (“’621 patent”), which claims “[t]he ornamental design for a sliding hook portion of a vehicle steering wheel lock assembly, as shown and described.” The patent contains seven drawings of different views of the device. Figure 1 of the patent shown below, illustrates the device, which has two curving hooks that are attached to the steering wheel to lock it in place:



Lawman sued the appellees Winner International, LLC and Winner Holding LLC (collectively “Winner”) in the United States District Court for the Eastern District of Pennsylvania for infringement of the ’621 patent. After the district court construed the claim in the patent, Winner moved for summary judgment of non-infringement. In opposition, Lawman listed eight specific “points of novelty” in the patented design. These included “[t]he open ends of the hooks face outward from the shaft” and “[t]he shaft includes a pattern of ridges.” In response, Winner “simply list[ed] Lawman’s proposed points of novelty and cite[d] to automobile wheel lock patents that depict Lawman’s proposed points.” 2005 U.S. Dist. LEXIS 2078.

The district court granted Winner summary judgment of non-infringement. The court held that “Lawman’s proposed points of novelty are found in the prior art” and thus that “Lawman has failed to create a material issue of fact regarding the point of novelty test.” Id.

II

In comparing a design patent claim to the accused design to determine infringement, a court must apply “two distinct tests, both of which must be satisfied in order to find infringement: (a) the ‘ordinary observer’ test, and (b) the ‘point of novelty’ test.” Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1377 (Fed. Cir. 2002). See Unidynamics Corp. v. Automatic Prods. Int’l, Ltd., 157 F.3d 1311, 1323 (Fed. Cir. 1998). The “ordinary observer” test requires comparison of the two designs from the viewpoint of the ordinary observer to “determine whether the patented design as a whole is substantially the same as the accused design.” Tropicana Prods., Inc. v. Land O’ Lakes, Inc., 286 F. Supp. 2d 343, 345 (D. Del. 2003) (citing Braun Inc. v. Dynamics Corp. of Am., 975 F.2d 815, 820 (Fed. Cir. 1992)). Under the “point of novelty” test, a court must determine whether “the accused device . . . appropriate[s] the novelty in the patented device which distinguishes it from the prior art.” Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984), (quoting Sears, Roebuck & Co. v. Talge, 140 F.2d 395, 396 (8th Cir. 1944)). See generally Bernhardt, L.L.C. v. Collezione Europa USA, Inc., 386 F.3d 1371, 1384 (Fed. Cir. 2004) (discussing the required showing for the “point of novelty” test).

The district court ruled that factual disputes precluded summary judgment under the “ordinary observer” test, but granted summary judgment for Winner under the “point

of novelty” test. Lawman had specified eight “points of novelty” that allegedly distinguished the patented design in the '621 patent from the prior art. In response, Winner had listed specific prior art patents that allegedly disclosed each of Lawman’s “points of novelty.” As noted, the district court held that “Lawman’s proposed points of novelty are found in the prior art.”

Lawman does not directly challenge this latter ruling. It makes no attempt to show either that the district court incorrectly accepted the eight “points of novelty” or that the prior art patents do not disclose those points. Instead, it argues only that the district court failed to make sufficient findings as to the scope and content of the prior art, and also failed to determine the “points of novelty” of the '621 patent. Basically, it argues only that there are factual issues on these points, not that the district court erroneously resolved those questions.

We review the district court’s grant of summary judgment de novo. Contessa, 282 F.3d at 1376; Conroy v. Reebok Int’l, Ltd., 14 F.3d 1570, 1575 (Fed. Cir. 1994). There is no general requirement that a district court make specific findings before granting summary judgment. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250 (1985). See also Union Carbide Corp. v. Am. Can Co., 272 F.2d 1567, 1573-74 (Fed. Cir. 1984). All that is required is that district courts provide “sufficient findings and reasoning to permit our review.” Cunningham v. Laser Golf Corp., 222 F.3d 943, 951 (Fed. Cir. 2000). See also Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1540 (Fed. Cir. 1983) (“[W]e sit to review judgments, not opinions.”).

The district court’s memorandum shows that the court accepted Lawman’s proposed “points of novelty” in their entirety, and also agreed with Winner that the prior

art (various different design patents) disclosed each of those “points of novelty.” We have examined the patents that Winner cited and conclude that they disclose the eight “points of novelty” that Lawman specified. The district court was not required to make the more detailed rulings or findings that Lawman apparently seeks, or to specify which particular patents disclosed each of the eight points of novelty.

Lawman stresses that there is no “suggestion to combine visual elements in the alleged prior art to achieve the ‘621 patent.” Whether there is any suggestion to combine prior art references may be relevant in a validity inquiry to determine obviousness. Litton, 728 F.2d at 1444. It has no place in the infringement issue in this case. Id.

What Lawman’s contention comes down to is that the D’621 patent contains a ninth “point of novelty,” namely, the combination in a single design of the eight non-novel “points of novelty” it embodies. This argument is inconsistent with, and would seriously undermine, the rationale of the “points of novelty” test.

“The purpose of the ‘points of novelty’ approach . . . is to focus on those aspects of a design which render the design different from prior art designs.” Winner Int’l Corp. v. Wolo Mfg. Corp., 905 F.2d 375, 376 (Fed. Cir. 1990), overruled in part on other grounds by Cardinal Chem. Co. v. Morton Int’l., 508 U.S. 83 (1993). “New” designs frequently involve only relatively small changes in the shape, size, placement, or color of elements of old designs. It is those changes in and departures from the old designs that constitute the “points of novelty” in the patented new design.

If the combination of old elements shown in the prior art is itself sufficient to constitute a “point of novelty” of a new design, it would be the rare design that would not

have a point of novelty. The practical effect of Lawman's theory would be virtually to eliminate the significance of the "points of novelty" test in determining infringement of design patents, and to provide patent protection for designs that in fact involve no significant changes from the prior art. Id. ("To consider the overall appearance of a design without regard to prior art would eviscerate the purpose of the 'point of novelty' approach, which is to focus on those aspects of a design which render the design different from prior art designs.").

Lawman seeks support for its argument in our decision in Litton Systems v. Whirlpool, 728 F.2d 1423. That decision does not aid Lawman.

In Litton we reversed a district court's finding of infringement of a design patent because of a trial court's "failure to apply the correct legal standard of infringement in design patent cases." Id. at 1444. This court explained that under the "points of novelty" test, "even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art." Id. Litton did not hold that the combination of several points of novelty was itself a point of novelty, but rather held that there were several points of novelty in the patented design, none of which was found in the accused design. Lawman's argument would stand the "points of novelty" test on its head, and defeat its purpose.

CONCLUSION

The district court's summary judgment of non-infringement is

AFFIRMED.

CERTIFICATE OF SERVICE

I hereby certify that fifteen copies of the foregoing COMBINED PETITION FOR PANEL REHEARING AND FOR REHEARING EN BANC OF PLAINTIFF-APPELLANT LAWMAN ARMOR CORPORATION, consisting of the original and fourteen copies were for purposes of filing dispatched to a courier (Federal Express) for overnight delivery to:

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CERTIFICATE OF COMPLIANCE

I hereby certify that pursuant to F.R.A.P. 40(b) the instant Petition does not exceed 15 pages. I further certify that to the best of my knowledge the instant Petition meets all the other requirements of the Rules of Practice of the United States Court of Appeals for the Federal Circuit.

Date: March 7, 2006



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