

In The  
**United States Court of Appeals**  
For The Federal Circuit

**EGYPTIAN GODDESS, INC.,**

*Plaintiff – Appellant,*

**and**

**ADI TORKIYA,**

*Third Party Defendant,*

v.

**SWISA, INC. and DROR SWISA,**

*Defendants/Third Party Plaintiffs-Appellees.*

**APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
IN CASE NO. 3:03-CV-0594,  
JUDGE DAVID C. GODBEY.**

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**BRIEF OF *AMICUS CURIAE*  
AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION  
IN SUPPORT OF NEITHER PARTY**

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***Dated: February 5, 2008***

## **CERTIFICATE OF INTEREST**

In accordance with FED. CIR. R. 47.4 and FED. R. APP. P. 26.1, counsel for the Amicus the American Intellectual Property Law Association (AIPLA) certifies the following:

1. The full name of every party represented by me is:  
**American Intellectual Property Law Association.**
2. The name of the real party in interest represented by me is: **N/A.**
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the parties represented by me are:  
**None.**
4. The names of all law firms and the partners or associates that appeared for the party now represented by me and that are expected to appear in this court are:

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## **STATEMENT OF INTEREST OF AMICUS CURIAE**

The American Intellectual Property Law Association (“AIPLA”) is a national bar association of more than 17,000 members engaged in private and corporate practice, in government service, and in the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA has no stake in any of the parties to this litigation or the result of this case other than its interest in seeking correct and consistent interpretation of the law as it relates to intellectual property issues.<sup>1</sup> This brief is filed with the consent of Appellants Egyptian Goddess, Inc. and Adi Torkiya and Appellees Swisa and Dror Swisa.

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<sup>1</sup> After reasonable investigation, AIPLA believes that (a) no member of its Board or *amicus* Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (b) no representative of any party to this litigation participated in the authorship of this brief, and (c) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

## ARGUMENT

### **I. RESPONSE TO QUESTION 1: THE “POINT OF NOVELTY” SHOULD BE ABROGATED AS A SEPARATE AND DISTINCT TEST FOR INFRINGEMENT**

#### **A. The Supreme Court’s “Ordinary Observer” Test Fully Accommodates the Concerns the Point of Novelty Test Was Intended to Address**

In *Gorham Co. v. White*, 81 U.S. 511, 528 (1871), the Supreme Court set forth the test that has governed design patent infringement for more than 100 years:

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.

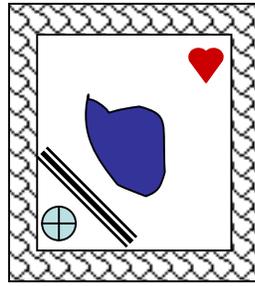
Thus, to find infringement, the trier of fact must find that “the patented design as a whole is substantially similar in appearance to the accused design.” *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997).

However, in *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), this Court stated:

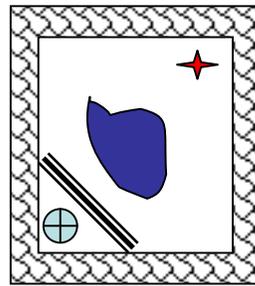
For a design patent to be infringed, however, no matter how similar two items look, “the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.” *Sears Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944); *Horwitt v. Longines Wittnauer Watch Co.*, 388 F. Supp 1257, 1263 (S.D.N.Y. 1975). That is, 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.

*Litton*, 728 F.2d at 1444. Based on this language from *Litton*, subsequent opinions of the Federal Circuit have transformed a concern regarding infringement findings where the accused design was merely practicing the prior art into a separate and distinct “point of novelty test” for design patent infringement. *See, e.g., Contessa Food Prods. Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002) (“Comparison to the accused product includes 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.’”) (*emphasis added*); *see also Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1320 (Fed. Cir. 2007) (describing the point of novelty test as a “separate and distinct inquiry”). The point of novelty test is itself divided into two sub-inquiries for the fact-finder: (1) What is the design patent’s point of novelty? (*i.e.* the differences between the prior art and the claimed design.) (“Identification Step”), and (2) Is the point of novelty appropriated by the accused design? (“Appropriation Step”). *See Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1384 (Fed. Cir. 2004).

The primary purpose of the point of novelty test has been to prevent infringement where the accused design is substantially similar to both the claimed design *and* the prior art. For example, consider the following situation wherein a claimed design is on the left and an accused design on the right:

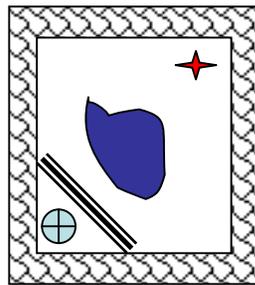


Claimed Design

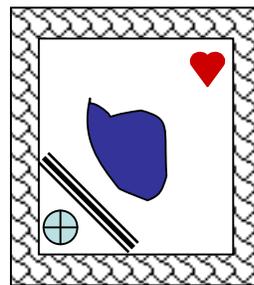


Accused Design

Simply applying the ordinary observer test *in a vacuum*, a fact-finder might reasonably conclude that the overall visual appearances of the claimed and accused designs are “substantially similar,” and thus find infringement. The point of novelty, however, applies a second step, which analyzes the relationship between the claimed design and the prior art.

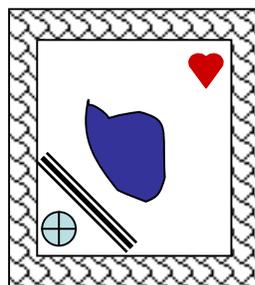


Prior Art Design

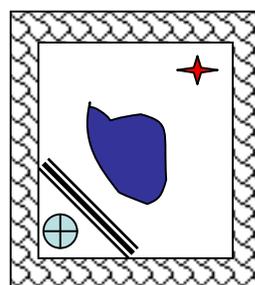


Claimed Design

When comparing the claimed design to the prior art, the point of novelty over the prior art is the red heart. Once identified, the point of novelty is then compared to the accused design to see if it has been appropriated.



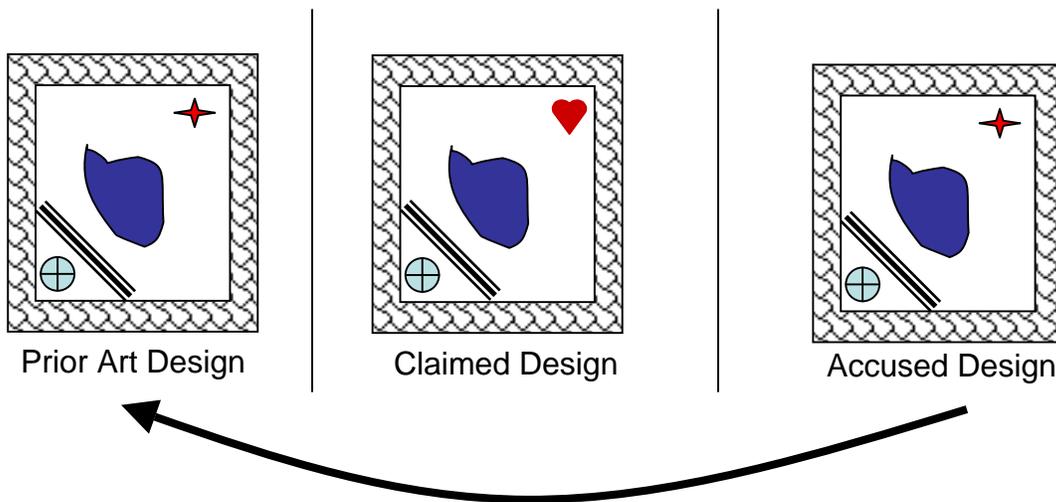
Claimed Design



Accused Design

Here, because the accused design does not incorporate that point of novelty (*i.e.*, the heart), there would be no infringement.

While the purpose of the “point of novelty” addresses the valid concern of preventing infringement findings where the accused design simply reads on the prior art, the creation of a separate and distinct test is unnecessary because *Gorham’s* ordinary observer test already takes the prior art into account. *See Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933) (“Yet it is clearly the rule that similitude of appearance is to be judged by the scope of the patent in relation to the prior art.”). The need for the point of novelty test has been founded upon the false notion that the prior art is not considered when conducting the ordinary observer test. Simply put, the *Gorham* ordinary observer test is not applied in a vacuum. Rather, the *Gorham* test into account the (1) accused design, (2) claimed design, and (3) prior art.



In evaluating whether two designs are “substantially similar,” the fact-finder must conduct the analysis in view of the prior art. When placed in this proper context, *Gorham’s* ordinary observer test also yields a finding of non-infringement without the need for an additional point of novelty test.

In *Applied Arts*, the court acknowledged that the *Gorham* ordinary observer test must be conducted in view of the prior art:

It has been held, however, that a design patent stands on as high a plane as utility patents and that on the issue of infringement a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent from the prior art. Thus is presented a difficulty. The Supreme Court has said (*Gorham v. White, supra*) that sameness of effect upon the eye is the main test of substantial identity of design, but it is not essential that the appearance should be the same to the eye of the expert. It is sufficient if it is the same to the ordinary observer. Yet it is clearly the rule that similitude of appearance is to be judged by the scope of the patent in relation to the prior art. The question at once presents itself: Are these tests of identity in conflict? What does the ordinary observer, at least in the common acceptance of that phrase, know of the prior art? If the two tests are to be reconciled, some qualification must be recognized as applied to the ordinary observer. A careful analysis of *Gorham v. White*, and other adjudicated cases supplies the answer. The ordinary observer is not any observer, but one who, with less than the trained faculties of the expert, is “a purchaser of things of similar design,” or “one interested in the subject.” The mythical prudent man in negligence cases is not the Hottentot or Abyssinian who has never seen a locomotive or driven an automobile, but one who has average familiarity with such instrumentalities, and can form a reasonable judgment as to their speed and mode of operation. So is the average observer not one who has never seen an ash tray or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded

it. This view is confirmed by the factual analysis which the Supreme Court gave to the evidence in the *Gorham* Case, laying its greatest stress upon the evidence of sameness there given by the large number of witnesses “familiar with designs, and most of them engaged in the trade.

*Applied Arts*, 67 F.2d at 429-30 (*internal citations omitted*). *Applied Arts* thus properly acknowledges that the ordinary observer test is not conducted in a vacuum, but rather *in view of the prior art*.

Similarly, the Supreme Court’s decision in *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893) accords with this understanding. In *Whitman Saddle*, the Supreme Court reversed the lower court’s findings that: 1) the patented saddle design was valid; and 2) the accused design infringed. With respect to infringement, the Supreme Court, employed the *Gorham* ordinary observer test, and concluded that the accused design was not substantially similar to the patented design because it lacked a “prominent feature” of the patented design, in light of the prior art. *Id.* at 682 (“the difference was so marked that in our judgment the defendants’ saddle could not be mistaken for the saddle of the complainant.”). While the Supreme Court’s decision in *Whitman Saddle* analyzed the patented design in view of the prior art, it did not apply a “point of novelty” analysis of the type developed in the Federal Circuit. Rather, the Court (properly) applied *Gorham* and its substantial similarity determination in light of the prior art.

**B. As a Separate Test for Infringement, The Point of Novelty Test Is Unworkable**

Applied as a separate and distinct test for infringement, the Point of Novelty test is unworkable because there are fundamental flaws with both the Identification and Appropriation Steps.

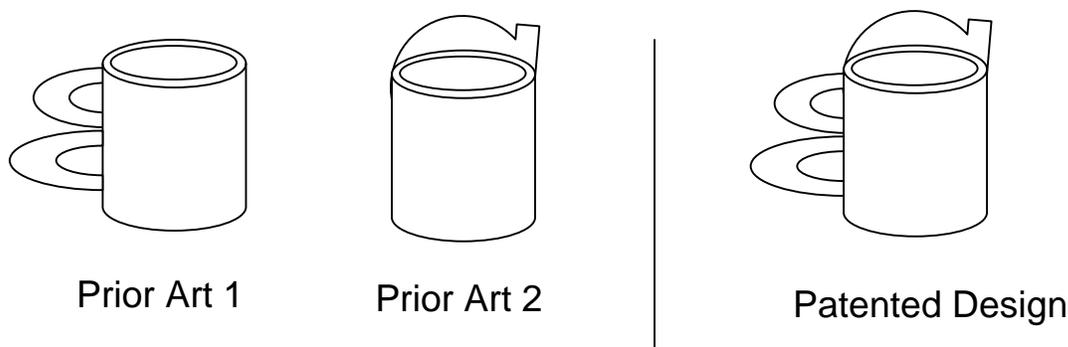
With respect to the Identification Step, it is unrealistic to expect fact-finders to identify and dissect subparts of an overall visual design. Design patents are granted on the basis of a novel *overall appearance*, not novel individual subparts. This Court has commented that “[a] *design is a unitary thing* and all of its portions are material in that they contribute to the appearance which constitutes the design.” *In re Blum*, 374 F.2d 904, 907 (CCPA 1967) (*emphasis added*); *see also, Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (holding that every solid line in drawings forms part of the claim) (*citing In re Blum*). In the context of design, the novelty is truly found in the overall effect of all combined components, whether new or old. Contrary to this truism, the point of novelty test improperly analyzes only *portions* of the design.

Design, in the view of the patent law, is that characteristic of a physical substance which, by means of lines, images, configuration and the like, taken as a whole, makes an impression, through the eye upon the mind of the observer. *The essence of a design resides, not in the elements individually, nor in the their method of arrangement, but in their tout ensemble, in that indefinable whole that awakens some sensation in the observer’s mind.* Impressions thus imparted may be

complex or simple, in one a mingled impression of gracefulness and strength, in another the impressions, there is attached in the mind of the observer, to object observed, a sense of uniqueness and character.

*Pelouze Scale Co. v. American Cutley Co.*, 102 Fed. 916, 918-19 (7th Cir. 1900)(J. Grosscup)(*emphasis added*).

Another fundamental flaw with the test rests with how to articulate the identified point of novelty. The outcome of the point of novelty Identification Step will depend on which prior art design the claimed design is compared to, yielding an arbitrary result. The example below illustrates this irreconcilable dilemma.



When the Patented Design is compared to Prior Art 1, the point of novelty is the appearance of the lid. However, when the Patented Design is compared to Prior Art 2, the point of novelty is the appearance of the handle.<sup>1</sup> Of course, this is a

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<sup>1</sup> As discussed in Section II C below, and further conflating the Identification Step, the point of novelty in this example could also be said to reside in the appearance of either of the following novel *combinations* of elements: (1) the lid and the handle, or (2) the lid, handle and cup.

simple and straightforward example.<sup>2</sup> In reality the comparisons are not always so clear. (e.g. 3-dimensional prior art references, irregular and asymmetric forms and surface contours, etc.) For example, the problems are only further exacerbated when there is more prior art, the patented design contains other non-novel elements, and the patent is not so easily dissectible into discrete subparts.

Yet another flaw of the point of novelty test is that it has been used as a “watered-down” back-door validity attack. *See, e.g., Lawman Armor Corp. v. Winner Int’l LLC*, No. 02-4595, 2005 U.S. Dist. LEXIS 2078 (E.D. Pa. Feb. 15, 2005); *aff’d*, *Lawman Armor Corp. v. Winner Int’l LLC*, 437 F.3d 1383 (Fed. Cir. 2006). Once the patentee has identified the point of novelty, an alleged infringer could render a design patent effectively unenforceable (or more accurately, “uninfringeable”) by showing by a mere *preponderance of the evidence*, that the point of novelty is found in the prior art, thereby bypassing the rigors of an invalidity challenge. *See Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1312 (Fed. Cir. 2001) (“to invalidate a design patent the evidence must be clear and convincing.”) Furthermore, an accused infringer could achieve this goal simply by showing that only a *portion* of the overall design (*i.e.* the alleged point

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<sup>2</sup> Assume, for purposes of this example, that the patented design is indeed patentable in light of the prior art. As discussed *infra*, any challenges as to the *sufficiency of the novelty* should be brought within the context of an obviousness challenge, replete with its safeguards, not within any point of novelty infringement analysis.

of novelty) was found in the prior art, not the entire claimed design. *See Sharper Image Corp. v. Target Corp.*, 425 F. Supp. 2d 1056, 1070 (N.D. Cal. 2006) (granting motion for summary judgment of non-infringement where point of novelty was found to be “non-novel,” despite that fact that no validity challenge was mounted) (*citing Lawman.*)

Another problem with the Identification Step occurs when there is no prior art or the closest prior art is very far from the claimed design. Such circumstances set up an undesirable paradox: the larger the leap beyond the prior art (*e.g.*, a pioneering design), the more difficult it is for a design patentee to prove infringement. Under such circumstances, the patent claim is effectively narrowed because the point of novelty will include all or almost all of the elements of the design. Thus, when it comes time for the Appropriation Step, the accused design will have to appropriate all of these features in order to infringe. This inescapable paradox is yet another unworkable consequence of the point of novelty test.

Accordingly, applied as a separate and distinct test for infringement, the point of novelty test can cause unintended and undesirable results. Because the concerns addressed by the point of novelty test are fully accommodated by a proper *Gorham* analysis as illustrated by the *Applied Arts* decision discussed above, the test should be discarded and design patent infringement returned to its *Gorham* roots.

## II. RESPONSE TO QUESTION 2

If the Court chooses to retain the point of novelty test as a separate test within the infringement analysis, AIPLA responds to the Court's Question 2, and the subparts thereto, below.

### A. The Court Should Not Adopt The Non-Trivial Advance Test

The Court should not adopt the non-triviality requirement set forth by the panel majority in this case.<sup>3</sup> The new non-triviality requirement places a new infringement burden on a design patentee to prove that an issued design patent's point of novelty, if comprised of a combination of known elements, is a "non-trivial advance of the prior art." *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1357 (Fed. Cir. 2007). Accordingly, the non-triviality requirement asks the fact-finder to not only *identify* the point of novelty, but now also *assess the sufficiency of the novelty in* the point of novelty. Simply put, a design patentee should not have to establish non-obviousness for purposes of patentability and then again establish non-obviousness/non-triviality for purposes of infringement. The non-triviality requirement effectively eliminates the presumption of validity by forcing design patentees to affirmatively prove that the issued design patent's novelty is a non-trivial advance over the prior art as part of its burden to show

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<sup>3</sup> For more discussion on AIPLA's position regarding the non-triviality requirement, AIPLA directs the Court's attention to its Brief In Support Of The Combined Petition For Rehearing And Rehearing *En Banc*.

infringement, even though the Patent Office already has examined and concluded that the overall design was non-obvious. The non-triviality requirement thus improperly grafts a new burden onto the infringement analysis, thereby placing it in conflict with the presumption of validity set forth in 35 U.S.C. § 282.

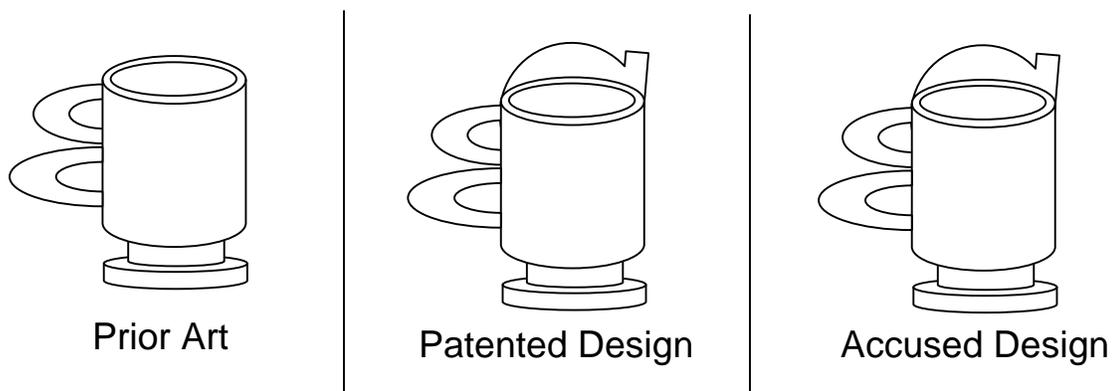
Furthermore, the new non-triviality requirement would permit watered-down “back-door” invalidity attacks on design patents under the guise of the point of novelty test. An accused infringer could use the point of novelty test (in the infringement analysis) as the vehicle for challenging the sufficiency of a patent’s novelty. The non-triviality requirement, however, lacks many of the elements that govern obviousness challenges, such as the “clear and convincing” evidence standard, the prohibition against hindsight analyses, the *Rosen* reference requirement, and the analogous art requirement.<sup>4</sup> An obviousness analysis would permit a design patentee to introduce secondary indicia of non-obviousness, yet the non-triviality requirement does not. Thus, a full obviousness analysis is the only proper mechanism for assessing and weeding out designs having only “trivial” advances over the prior art and thus the non-triviality requirement should not be adopted.

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<sup>4</sup> See *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1288 (Fed. Cir. 2002) (clear and convincing evidentiary standard; cautioning against hindsight analyses); *In re Rosen*, 673 F.2d 388 (CCPA 1982) (to show obviousness of a design patent claim, the challenger must provide “primary reference” that is almost the same as the patented design); *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (analogous art requirement).

**B. If The Point Of Novelty Test Is Retained, It Should Be Relegated To An Affirmative Defense To Infringement**

Because the purpose of the point of novelty test is to prevent infringement findings where the accused infringer is essentially practicing the prior art, the proper role (if any) of the test is as an affirmative defense to infringement. The burden would be on the accused infringer to prove that it is, in fact, merely practicing the prior art, *in view of the patented design*. Consider the following example:



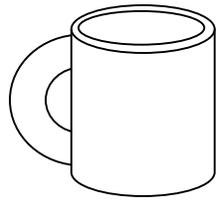
Here, the accused infringer would not prevail on the affirmative defense because the accused design is closer to the patented design than to the prior art. As with the *Gorham* analysis, it would be important to conduct the analysis in light of the entire landscape: the prior art, the patented design and the accused design. Placing the burden on the accused infringer is also consistent with the presumption of patent validity and guards against the erosion of that presumption in the infringement context.

**C. A Patentee Should Be Permitted To Divide Closely Related Or Ornamentally Integrated Features Of The Patented Design To Match Features Contained In An Accused Design**

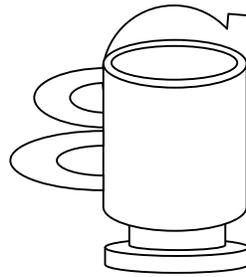
A patentee should be able to identify and assert whatever elements of the design it believes it can *prove* are novel as its point of novelty. The point of novelty assertion, however, is a question of fact and thus subject to the fact-finder's determination. A patentee who asserts an unsupportable and contrived point of novelty simply to encompass the accused design proceeds at their own peril. If the fact-finder does not accept the design patentee's asserted point of novelty, they will not have carried their burden of establishing the point of novelty. Conversely, if a patentee defines the point of novelty too narrowly, they increase the risk of an invalidity finding.

**D. There Can Be More Than One "Point Of Novelty" In A Patented Design**

Given the test for determining a design patent's point of novelty (i.e., what are the differences between the claimed design and the prior art?), there is no reason why a design patent could not have more than one point of novelty. By way of example, illustrated below is a hypothetical design patent (on the right) covering a coffee mug comprised of a cup portion, a handle portion, lid portion and base portion.



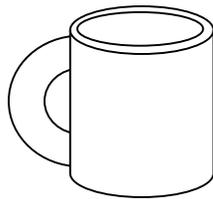
Prior Art



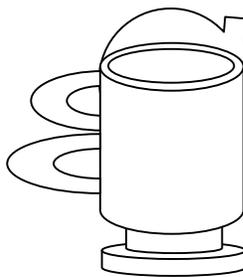
Patented Design

In view of the prior art, the appearances of the handle, lid and base portions could *each* be considered *individual* points of novelty. It could equally be said that the novel aspect of the design is a point of novelty (singular), which resides in the appearance of the *combination* of the handle, lid and base portion.<sup>5</sup> Under the Court’s formula for determining the point of novelty, all of these articulations would appear to be acceptable.

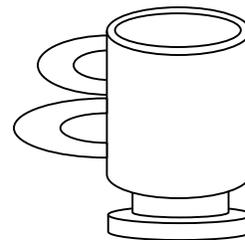
However, whether a point of novelty is articulated as a combination point of novelty, or separate and individual points of novelty, can have a significant effect on the infringement analysis, given the Court’s current jurisprudence on the Appropriation Step. Consider the following example:



Prior Art



Patented Design



Accused Design

<sup>5</sup> Furthermore, any one of the appearances of the following combinations could serve as a valid point novelty: (1) handle, lid, base and cup; (2) handle, lid and cup; (3) handle, cup and base; (4) lid, cup and base; (5) handle and lid; (6) handle and cup; (7) handle and base; (8) base and lid; (9) base and cup; (10) lid and cup. None of these combinations are found in the prior art.

If the point of novelty is articulated as the novel appearance of the combination of the handle, lid, and base, then the accused design would not infringe<sup>6</sup> under the point of novelty test because it does not appropriate the appearance of the articulated novel combination; the accused design appropriates only the handle and base, but not the lid, yielding a different appearance compared to the articulated point of novelty. If, however, the point of novelty is articulated as three *individual* points of novelty (*i.e.*, the respective appearances of the lid, the handle, and the base), then the accused design might infringe because it appropriates two out of three of the elements (*i.e.*, the handle and base) which is “substantially all” of the points of novelty. *See Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998) (“The accused design must also contain *substantially the same points of novelty* that distinguished the patented design from the prior art.”) (*emphasis added*).

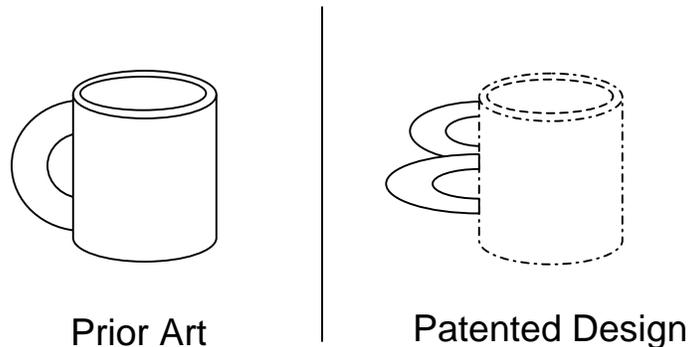
**E. The Overall Appearance Of A Design Should Be Permitted To Be A Point Of Novelty**

There is no principled reason why the overall appearance of a design could not serve as a point of novelty and the *en banc* Court should reject the position taken by the panel in *Lawman Armor Corp. v. Winner Int’l LLC*, 437 F.3d 1383 (Fed. Cir. 2006), and that panel’s supplemental opinion at 449 F.3d 1190 (Fed. Cir.

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<sup>6</sup> Assume for purposes of this example that the fact-finder would find the patented design and the accused design to have substantially similar overall appearances.

2006). Consider the following example in which the patented design only covers the handle because it is the only portion shown in solid lines:



Thus, it is this singular feature that is the novelty of the design. Because the patentee only claimed the novel feature, the overall appearance of the claim and the point of novelty are *identical*. Indeed, design patentees frequently claim only the novel aspects of their designs with solid lines. Old or unimportant parts of the design are often disclaimed using phantom lines. *See In re Zahn*, 617 F.2d 261, 267 (CCPA 1980) (ratifying the use of phantom lines to disclaim portions of the design.)

Even if the design patentee has not disclaimed the non-novel features of the design, design patentees will rarely attempt to assert the overall design as the point of novelty because the more elements that they identify as the point of novelty during the Identification Step, the more elements they must show have been appropriated by the accused design to satisfy the Appropriation Step.

## **F. If The Court Retains The Point Of Novelty Test, It Should Provide Guidance On Fundamental Questions Regarding The Test’s Application**

If the Court retains the point of novelty test, it will perpetuate confusion and conflicting case law on these and other issues:

- Can a point of novelty be found in a combination of **old** elements?
- Is the point of novelty determined by comparing the claimed design to the cited prior art or to any prior art, and can the point of novelty change as the prior art pool is augmented in litigation?
- Does the doctrine of equivalents apply to the point of novelty determination, *i.e.*, must the accused device appropriate all or substantially all of the points of novelty, or will appropriation of any point of novelty suffice? *See Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir. 1995) (“A patentee cannot invoke the doctrine [of equivalents] to evade scrutiny of the point of novelty.”); *but see, Goodyear Tire*, 162 F.3d at 1118 (“The accused design must also contain *substantially the same points of novelty* that distinguished the patented design from the prior art.”)(*emphasis added*).
- If the point of novelty is articulated as a combination, must every element of the combination be appropriated?
- If anticipation is simply the infringement test in “reverse,” does the point of novelty test apply to anticipation? *See Door-Master*, 256 F.3d at 1312 (“Because ‘[t]hat which infringes, if later, would anticipate, if earlier,’ the design patent infringement test also applies to design patent anticipation.”)(*quoting Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889)).

Answers to these fundamental questions are necessary to any application of the point of novelty test.

### III. RESPONSE TO QUESTION 3: CLAIM CONSTRUCTION APPLIES TO DESIGN PATENTS AND MUST BE FOCUSED ON THE ORDINARY OBERVER'S PERCEPTION OF THE DRAWINGS

Design patents have their statutory roots in 35 U.S.C. § 171, which authorizes “patents” in ornamental designs. While *Markman* did not involve a design patent, on its face, the Supreme Court did not limit the types of “patents” to which claim construction applies. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Ever since this Court first applied claim construction to a design patent in *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995), courts have taken different approaches to design patent claim construction. Some have simply relied on the design patent drawings,<sup>7</sup> while others have translated the design patent drawings into long recitations of words.<sup>8</sup> This confusing set of approaches begs for further guidance from this Court, which should hold that, even though claim construction applies to design patents, the ordinary observer’s perception of the drawings should be the controlling consideration.

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<sup>7</sup> See, e.g., *Black & Decker (U.S.), Inc. v. Pro-Tech Power Inc.*, No. 97-1123-A, 1998 U.S. Dist. LEXIS 9162 \* 6-7, (E.D. Va. June 2, 1998) (“the scope of the '173 design patent is its ‘overall ornamental visual impression’ as shown in the six orthogonal drawings.”); see also *Colgate-Palmolive Co. v. Ranir, L.L.C.*, No. 06-417-GMS, 2007 U.S. Dist. Lexis 55258 (D. Del. July 31, 2007); see also *Nike, Inc. v. Meitac Int’l Ent. Co.*, No. 2:06-CV-0934, 2006 U.S. Dist. LEXIS 94662 \* 6 (D. Nev. Oct. 11, 2006).

<sup>8</sup> See, e.g., *Sofpool, LLC, v. Intex Recreation Corp.*, No. 02:07-CV-0972007 U.S. Dist. LEXIS 3057 (E.D. Tex. Dec. 19, 2007); *Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, No. 3-00-CV-0888-G, 2002 U.S. Dist. LEXIS 8693 (N.D. Tex. May 15, 2002), *aff’d* 2004 U.S. App. LEXIS 770 (Fed. Cir. 2004).

Any discussion of design should be placed against the backdrop that words are most often futile in describing the appearance of a design. For example, if one were asked to describe the overall appearance of the *Mona Lisa*, which would be more efficient – words or the image itself?



Whether an art aficionado or an ordinary observer, the answer is clear: the image of the *Mona Lisa* itself is the most effective means for communicating its overall appearance. The same is true for design patents.

**A. Unlike Utility Patents, The Claims Of Design Patents Are The Drawings**

Utility patents present claims in words; design patents present claims in drawings. *See Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1464 (Fed. Cir. 1997) (“the drawing themselves are the claims to the patented subject matter”). In this case, the claim reads: “The ornamental design for a nail buffer as shown and

described.” The claim is then followed by a short description of seven figures and then the figures. There is no detailed description of the nail buffer as would be found in a utility patent, nor is there a verbalization of the claim for the nail buffer, rather, the figures define the scope of what is covered. *Id.*

A design patent claim is thus defined by the drawings; every solid line in the drawings form part of the claim. *See, Elmer*, 67 F.3d at 1577 (holding that every solid line forms part of the claim). “A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design.” *In re Blum*, 374 F.2d at 907; *see also In re Zahn*, 617 F.2d at 265 (“There are no portions of a claimed design which are immaterial.”) (*emphasis added*).

Verbal descriptions are often either too broad or too narrow to fully capture every element of a design. While words are capable of *listing* some, or even all, of the individual *features* of the drawings, they are simply ill-suited for communicating the “controlling consideration” of a design patent claim – the *overall appearance* of all of the elements, including the relative and spatial relationships of each and every solid line in the claim. Moreover, when verbalizations are employed to capture the entire claim and a list of features is set forth, the verbalizations may inaccurately convey that the listed features all have an

equivalent effect on the eye.<sup>9</sup> Thus, inasmuch as design patents are claimed with drawings, the only means by which to communicate each and every aspect of the claimed design are the drawings. In short, the best description of the drawings is the drawings themselves.

**B. *Gorham* Makes Clear That The Ordinary Observer’s Perception Of The Drawings Should Control Claim Construction**

The Supreme Court explained that the “controlling consideration is the “resultant effect” of the overall design on the eye of the ordinary observer. *Gorham*, 81 U.S. at 526. It is thus the perception in the eye of the ordinary observer, not the court, which should control claim construction. The *Gorham* Court quoted Lord Westbury’s statement in *Holdsworth v. McCrea*, 2 Appeal Cases, House of Lords, 388 that “the eye alone is the judge of the *identity of the two things*.” *Id.* (*emphasis added*). Thus, the test seeks the ordinary observer’s perception of two designs: (1) the accused design, and (2) *the claimed design*. By attempting to translate an entire design into words, a court would improperly usurp half of the ordinary observer’s role.

Moreover, because of the primacy of the drawings, verbalization of the entire claim has no role in the design patent infringement analysis. As this Court

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<sup>9</sup> Even if the court were to include words to emphasize the relative predominance of certain aspects of the design (i.e., major, minor, etc.), here again, the court would be improperly substituting its perception for that of the trier of fact. In reality, depending on the observer, the eye may very well focus on certain aspects of the drawings and minimize others.

has made clear, “[i]n determining questions of infringement, the district court must instruct the jury to follow the standard articulated in *Gorham Co. v. White*.” *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 819 (Fed. Cir. 1992). *Gorham* makes clear that the test for infringement is a visual test, comparing images to images, not words to images, through “the eye of an ordinary observer.”<sup>10</sup> It is the claim drawings themselves, and more particularly, the ordinary observer’s perception of those drawings, and their “resultant effect,” that is the “controlling consideration.”<sup>11</sup>

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<sup>10</sup> Whether determining questions of design patent infringement or validity, the tests are visual. *See, e.g., Elmer*, 67 F.3d at 1577 (for infringement, “the patented and accused designs are compared for overall visual similarity”)(*emphasis added*) (citing *Gorham*); *see also In re Zahn*, 617 F.2d at 270 (“in determining the non-obviousness of new designs under 35 U.S.C. 103, has stated that “[the] test is inherently a visual test, for the design is nothing more than appearance, and the appearance is that of the article as a whole”) (*emphasis added*) (*quoting In re Laverne*, 356 F.2d 1003, 1006 (CCPA 1966)).

<sup>11</sup> Determinations regarding whether aspects of a patented design are functional or ornamental is a question for the fact-finder, not the court. *See, e.g., PHG Techs., LLC v. St. John Cos., Inc.*, 469 F.3d 1361, 1365 (Fed. Cir. 2006); *see also Hupp*, 122 F.3d at 1467; *see also Five Star Mfg., Inc. v. Ramp Lite Mfg., Inc.*, 44 F. Supp. 2d 1149, 1155 (D. Kan. 1999) (“whether the features of a design are functional or ornamental is an issue of fact.”); *see also Black & Decker*, 1998 U.S. Dist. LEXIS 9162 \*15 (“the Court will leave the question of whether certain elements of the ‘173 design patent are functional to the jury.”); *see also Sofpool*, 2007 U.S. Dist. LEXIS 93057 \*5 (whether element of design is functional is a question of fact for jury). Moreover, the issue of “functionality” is a validity issue, not an infringement issue. *See Rosco Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002) (“We apply a stringent standard for invalidating a design patent on grounds of functionality...”)

Giving primacy to the drawings is not to say that a court cannot provide instruction to the fact-finder on *how* to conduct the visual comparison. *See, e.g., Black & Decker*, 1998 U.S. Dist. LEXIS 9162 \*6-7 (providing guidance on how to conduct infringement analysis). Moreover, a court is not hamstrung from providing appropriate guidance that will assist the fact-finder in better understanding the claim. For example, a court may instruct the jury on the specific meaning of drafting conventions that may appear in the drawing, such as, phantom lines, indeterminate break lines, stippling, oblique lines, surface shading, color markings, and multiple embodiments. *See, e.g., Colgate-Palmolive*, 2007 U.S. Dist. LEXIS 55258 \*12-17 (claim construction including instruction on specific meaning of phantom lines in the drawings, but not a verbalization of the overall appearance of the design). Furthermore, in appropriate circumstances (*e.g.,* prosecution history estoppel, terminal disclaimers, characteristic features statements, *etc.*), a court may also explain individual elements of the design. In addition, there may be a circumstance where clarification of a portion of the drawing is needed. But, in general, courts should not attempt to verbalize the overall visual appearance of the claimed design patent drawing.<sup>12</sup>

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<sup>12</sup> To be sure, cautioning district courts against attempting to completely verbalize the overall appearance of a design during claim construction does not mean that a court cannot use words to explain its *factual findings* in a written or oral opinion (*e.g.,* summary judgment opinions, bench trials, *etc.*).

Attempts to completely verbalize the entire claim also have great potential to confuse jurors. If the juror is charged with conducting the visual test mandated by *Gorham*, but then given a written claim construction from the court, which should control? A juror's perception of the overall appearance of the claimed design may very well differ from the court's expressed verbalization (and for that matter the court's perception). It is also possible that a juror's perception may change after reading the court's construction. Even if the court only provides the written instruction as a guide, the same problems of undue influence or changed perception may arise. Such a predicament is bound to yield inconsistent and compromised results.

The following is an example of a district court's verbalization of the overall appearance of a design patent. *Minka*, 2002 U.S. Dist. LEXIS 8693, *aff'd* 2004 U.S. App. LEXIS 770 (Fed. Cir. 2004).

**Ceiling Fan**  
**U.S. Pat. No. D380,539**

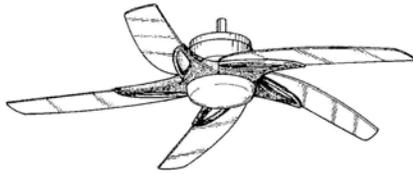


Fig. 1, Perspective View

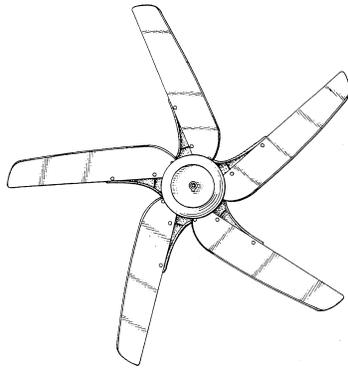


Fig. 7, Bottom View

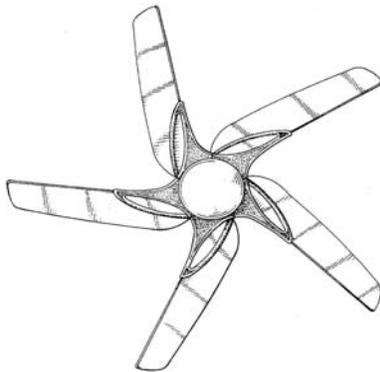


Fig. 8, Top View

The '539 design patent claim is directed to an ornamental design for a combined ceiling fan and light having fan blades that overlie corresponding arms of a central bracket. The central bracket has a circular central opening through which a light fixture dome protrudes downward. The bracket has curved, fin-shaped arms, each of which sweeps outward from its base at the central opening and each of which terminates in a slightly rounded tip. The arms of the bracket are equally spaced about the central opening, and the length of each bracket arm is roughly one-third the length of the corresponding blade. The light fixture dome exhibits a partial sphere that transitions into a generally cylindrical portion adjacent the central bracket. A central housing, located above the fan blades, exhibits a generally cylindrical portion just above the fan blades that transitions into a concave portion. When viewed from below, the fin-shaped arms of the central bracket [sweep] outward from the central opening in a clockwise direction, which gives the appearance of a "running" pointed star. A symmetrical, elongated, generally football shaped cutout appears behind the leading edge of each arm. The fan blades are also swept in the clockwise direction, with the leading edges of the blades forming a sweeping curve near the bracket central opening. The trailing edges of the blades are straight but slightly offset from a diameter of the bracket central opening. The trailing edge of each blade smoothly transitions into the trailing edge of the corresponding bracket arm, which further forms a curved transition into the leading edge of the next bracket arm. A gently receding are in front of each bracket arm's leading edge runs from the tip of each arm to the middle of the smooth transition. Each fan blade terminates in a gently rounded corner on the leading edge and a sharply angled, rounded corner on the trailing edge. From its tip, the trailing edge of each bracket arm flares inwardly and rearwardly away from the straight trailing edge of the corresponding blade until it intersects the leading edge of the following blade. Due to the sweep of the bracket arms, the leading edge of each fan blade is substantially more exposed than in the trailing edge of each fan blade. When viewed from above, the fan blades are swept in the counter-clockwise direction, which also gives the appearance of a pointed "running" star. Also when viewed from above, the trailing edge of the bracket arm is visible at the base of each fan blade.

Despite the district court's attempt to reduce the drawings into words (over 400 words), the drawings are still a clearer description of the design. Words and phrases such as the following, which were used in *Minka*, only serve to conflate the matter rather than clarify: "fin-shaped", "sweeps", "partial sphere", "“running” pointed star", "generally football shaped", and "sharply angle rounded corner." *Id.*

When the drawings are the “controlling consideration,” the jury’s task is much simpler and straightforward: look at the two designs and determine whether the overall appearances of the claimed and the accused designs are substantially similar.

**C. The USPTO Has Long Recognized That Drawings Are The Best Method For Defining Property Grants For Designs**

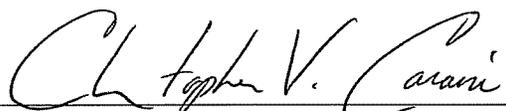
The Patent Office has recognized that a design is best communicated and disclosed through drawings, not words. The Patent Office requires no descriptions of the design in a design patent, other than perfunctory explanations of the various views and perspectives contained in the drawings. *See L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1122-23 (Fed. Cir. 1993). Indeed, the Manual of Patent Examining Procedure explains that “[a]s a rule, the illustration in the drawing views is its own best description.” Manual of Patent Examining Procedure § 1503.01 (citing *In re Freeman*, 23 App. D.C. 226 (App. D.C. 1904)). Inasmuch as drawings are the basis for claiming, and thereby defining, the initial property grant, these same drawings should be used when determining questions of claim construction.

**CONCLUSION**

For the reasons discussed herein, this Court should (1) abrogate point of novelty test as a separate test for design patent infringement; and (2) make clear that while claim construction applies to design patents, the ordinary observer's perception of the resultant effect of the drawings is the controlling consideration in any claim construction determination.

February 5, 2008

Respectfully submitted,



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