

United States Court of Appeals
for the
Federal Circuit

EGYPTIAN GODDESS, INC.,

Plaintiff-Appellant,

and

ADI TORKIYA

Third Party Defendant,

vs.

SWISA, INC. and DROR SWISA,

*Defendant/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*

BRIEF OF AMICUS CURIAE APPLE INC.

PERRY J. SAIDMAN, ESQ.
SAIDMAN DESIGNLAW GROUP
8601 Georgia Ave., Suite 603
Silver Spring, MD 20910
(301) 585-8601

*Attorney for Amicus Curiae
Apple Inc.*

February 5, 2008

CERTIFICATE OF INTEREST

Counsel for *Amicus Curiae*, Apple Inc., certifies the following:

1. The full name of every party or *amicus* represented by me is:

Apple Inc.

2. The name of the real party in interest (if the party named in the caption is not 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 party or *amicus curiae* represented by me are:

None.

4. There is no such corporation as listed in paragraph 3.

5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or who are expected to appear in this court are:

SAIDMAN DESIGNLAW GROUP
Perry J. Saidman

February 5, 2008

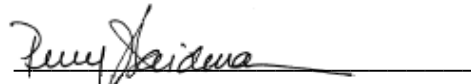

Perry J. Saidman

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STATEMENT OF INTEREST OF *AMICUS CURIAE*

This brief is being filed by Apple Inc. (“Apple”), a California Corporation founded in 1976 that is headquartered in Cupertino, California.

Apple designs, manufactures and sells consumer electronic products including personal computers, portable digital music players and mobile communication devices as well as related software, services, peripherals, accessories, and networking solutions worldwide.

Apple is well known for its industrial designs and its ability to excite the public with each new product. In addition, Apple’s iconic designs have received critical acclaim and have won many design awards. Some of Apple’s products have even been featured in museums worldwide.

Because of the importance of its designs, Apple frequently applies for and obtains U.S. design patents. In last three years, Apple has filed over 125 U.S. design patent applications covering software and hardware aspects of its iconic product designs. Apple’s design patent portfolio is very diverse, including both hardware and software design patents related to its Mac® line of computers, iPod® line of media devices and even to the revolutionary iPhone® smart phone (among others).

Exemplary Apple design patents cover its computers (e.g., D518,290), operating system icons and graphical user interfaces (GUIs) (e.g.,

D457,164), handheld electronic devices (e.g., D506,476), computer peripherals (e.g., D490,812), and handheld accessories (e.g., D533,347).

Apple's designs are subject to an ever-increasing number of knock-offs and copycats from companies trying to imitate, and simply copy, its success. Some copying has become bold and aggressive. As a result, Apple has a real and substantial interest in protecting its industrial designs, and in addressing the extremely significant issues raised in the Court's *en banc* order.

This brief is filed with the consent of all parties, and is not motivated by any desire to influence the outcome of any pending case.

I. INTRODUCTION AND SUMMARY OF ARGUMENT

“A picture shows me at a glance what it takes dozens of pages of a book to expound.” Ivan Sergeyevich Turgenev, *Fathers and Sons*, 1862.

Turgenev wrote those words even before the venerable *Gorham v. White* case was decided in 1871, but they still ring true today. Indeed, a picture conveys an impression that words can only seek imperfectly to summarize. This reality informs Apple’s answer to this Court’s question 3.

When interpreting a design patent, a court should initially direct attention to the design as shown in the patent’s drawings. The court should also provide general guidance to the fact-finder as to the legal meaning of broken lines, drafting and shading conventions, the prosecution history, multiple embodiments, indeterminate break lines, etc., to better assist the fact-finder in understanding the overall design as shown in the patent’s drawings. However, the post-Markman practice of summarizing in words, or verbalizing, the images in the drawings, is oftentimes confusing and potentially injurious to patentees. Moreover, this practice provides little benefit to the court, and distracts the trier of fact from their age-old mandate of visually comparing the design patent’s drawings to the accused design to determine if they are substantially the same. It also has the effect of unfairly narrowing the scope of a design patent and, much more often than not,

inappropriately subjecting the claim to summary judgment of non-infringement.

As regards the Court's question 1, the point of novelty test for infringement came about to address the possibility of inclusion of prior art elements in a claimed design. However, the modern infringement-invalidity dichotomy amply addresses this problem. If the patentee obtains an unduly narrow claim, a competitor can more easily design around it. If the novelty or patentability of the claimed design is in doubt, the proper response is an invalidity defense. Skillful advocates can draw the fact-finder's attention to prior art elements that may form the only similarity between a claimed design and an accused product.

As implemented, the point of novelty analysis creates a super-standard for design patent infringement, one which first requires the *Gorham* "substantially the same" standard to be met, and then a literal infringement test using an individually unclaimed and unexamined sub-combination of the claimed design. The patentee is unfairly put to the burden of proving in its infringement case in chief that this unexamined and unclaimed sub-combination of features, taken from his overall claimed design, is novel, and is literally found in the accused design. The point of novelty test is an anachronism, and the time has come to put it to rest. Proper application of

the *Gorham* test, followed by an invalidity analysis, will take into account the prior art and prevent the patentee from recovering for that which was already available to the public in the prior art.

Amicus directs its answers primarily to the Court's overarching questions 3 and 1 (in sections II and III, respectively), and concludes in section IV with a short response to question 2.

II. DESIGN PATENT CLAIM CONSTRUCTION UNDER MARKMAN

A. MARKMAN APPLIES DIFFERENTLY TO DESIGN PATENTS

It is well established that utility patent infringement analysis begins with claim construction, under which the court construes the meaning and scope of the allegedly infringed claim.¹ This Court has determined that a design patent claim must also be construed as a matter of law². Because a design patent's claim is defined by drawings and not words,³ claim construction must be fundamentally different than that for a utility patent.

¹ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

² *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571 (Fed. Cir. 1995).

³ *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113 (Fed. Cir. 1998).

B. VERBALIZING A DESIGN PATENT CLAIM IS UNNECESSARY AND MISLEADING

Construing design patent claims should involve little analysis by the court. The Patent and Trademark Office prescribes a standard format all design patent claims must follow: “The design for a [widget] as shown and described”.⁴ The design is “*shown*” in the patent’s drawing figures that visually represent the design.⁵ The design is “*described*” by standard figure descriptions in the specification.⁶ During *Markman* claim construction of a design patent, a court should direct attention to the design “as shown and described” in the patent’s drawings and figure descriptions. The court should also provide general legal guidance to the fact-finder as to the meaning of broken lines, drafting and shading conventions, the prosecution history, multiple embodiments, indeterminate break lines, etc., to better assist the fact-finder in understanding the legal principles governing the design as shown in the patent’s drawings. This level of explanation underpins the inherent aesthetic nature of design patent subject matter, as well as the experiential nature of the infringement test articulated in *Gorham*.

⁴ 37 C.F.R. § 1.153.

⁵ 37 C.F.R. § 1.152.

⁶ 37 C.F.R. § 1.154.

However, many courts, relying on early precedent,⁷ have gone far beyond the drawings to create written descriptions, or verbalizations, of the design “shown” and “described” by the drawings⁸. Some courts have struggled with the extent to which the design patent drawings need to be verbalized. *See, e.g., Lamps Plus, Inc. v. Dolan*, 2003 WL 22435702 (unpub., N.D. Tex. 2003). On at least one occasion, this Court has even struggled with the need for words in interpreting an illustrated design, observing that “a district court need not always verbally construe at length a design patent’s drawings.” *Minka Lighting, Inc. v. Craftmade International, Inc.*, 93 Fed.Appx. 214, 216 (unpub., Fed. Cir. 2004).

Neither the U.S. Patent Act nor *Markman* requires a court to convert the visual appearance of a claimed design shown in the design patent drawings into a written description. Indeed, reference to the drawings is amply sufficient to satisfy *Markman* claim construction, and makes more

⁷ *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 n.2 (Fed. Cir. 1996). However, the standard that verbal descriptions of designs be “properly done [in order to] evoke the visual image of the design” has proven unattainable; words simply cannot evoke accurate visual images.

⁸ *See Five Star Mfg. Inc. v. Ramp Lite Mfg., Inc.* 44 F.Supp.2d 1149, 1155 (D. Kan. 1999), *ZB Indus. Inc. v. Conagra Inc.*, 56 U.S.P.Q.2d 1739 (C.D. Cal. 2000), *aff’d. sub nom. Contessa Food Prods., Inc. v. Conagra, Inc.* 282 F.3d 1370 (Fed. Cir. 2002), *Lamps Plus, supra* at *5, *Calphalon Corp. v. Meyer Corp.*, 2006 WL 2474286, *2 (unpub., E.D. Cal. 2006), *Nichia Corp. v. Seoul Semiconductor Co., Ltd.*, 2007 WL 2972636, *1 (unpub., N.D. Cal. 2007).

sense. *See Black & Decker, Inc. v. Pro-Tech Power Inc.*, 47 U.S.P.Q.2d 1843, 1845 (E.D. Va. 1998); *Colgate-Palmolive Co. v. Ranir*, 2007 WL 2225888, *4 (D. Del. 2007).

In *Elmer*, this Court noted that in construing what a design patent entails, a court must focus on what is “*shown and described*” in the patent, since the patent claim expressly contains this limiting language. *Supra*, at 1577 (emphasis in original). The *Elmer* plaintiff argued that certain of the elements shown in solid lines were functional, rather than ornamental, and should not be included in the claim. The court properly rejected this argument,⁹ and held that a design patent claim is limited in scope to the entirety of what is contained in the patent application drawings themselves. *Id.* This Court emphasized throughout the opinion the importance of actually looking at the visual representations of the design, and noted that the infringement analysis requires the fact finder to “visually compare the patented and accused designs.” *Id.*

⁹ ...[The patentee] could have omitted these [allegedly functional] features from its patent application drawings...[but] did not do so, however, and thus effectively limited the scope of its patent claim by including those features in it. *Id.*

Numerous other cases construe design patent claims as the visual representations of the drawings, and not written descriptions of them¹⁰. In *Black & Decker*, the court held that “the proper claim construction . . . is limited to what is shown in the application drawings”, and rejected dissecting the design into a list of its individual components. *Supra*. The court relied in part on the PTO’s instruction that “any description of the claimed design in the specification other than a brief description of the drawing figures is generally not necessary.” *Id.* (quoting Donald Chisum, Chisum on Patents § 1.04[3], at 1-220.3 (1998)). The court’s analysis strongly suggests that design patent claim construction does not permit verbalization, let alone require it. *Id.* at *7 (“the illustration is its own best description”).

Long before *Markman* was decided, courts recognized the futility of trying to describe a visual representation in words:

[The design] is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration.

Dobson v. Dornan, 118 U.S. 10, 14 (1886) (emphasis added);

¹⁰ See *Black & Decker, supra*; *ADC Telecomm. v. Panduit Corp.*, 200 F. Supp.2d 1022, 1032-33 (D. Minn. 2002); *Caponey v. ADA Enterprises, Inc.*, 511 F.Supp.2d 618, 624 (D.S.C. 2007); *Colgate-Palmolive, supra*.

Undoubtedly, in the matter of application for a patent for a design, a picture of the design serves to convey a greatly more adequate idea of the design than any verbal description could possibly do; and *in the presence of the picture, a superadded verbal description is generally useless and oftentimes confusing.*

In re Freeman, 23 App. D.C. 226 (D.C. Cir. 1904) (emphasis added);

...it is very difficult to put in words a description which so differentiates [the claimed design] from the prior art as to convey any vivid impression to one reading this opinion. This is largely due to the *inherent difficulty of describing visual impressions in words*, which is, of course, heightened where the person attempting it is without technical training in drawing or art.

Friedley-Voshardt Co. v. Reliance Metal Spinning Co., 238 Fed. 800, 801 (S.D.N.Y. 1916) (emphasis added).

And now, the verbalization of design patent drawings that followed *Markman* renews this concurrence in the inadequacies of words in describing designs:

...setting down into words what visual impression is created by a fitting for a plastic trough carrying fiber optic cables is a remarkably different endeavor than describing one's visual impression of Rembrandt's 'The Sundics of the Drapers' Guild...*a picture is its own best description*".

ADC Telecomm., *supra* at 1032-33.

Substituting written descriptions for visual representations of a design introduces a layer of complexity that the PTO has expressly discouraged. In its Manual of Patent Examining Procedure, the PTO directs that there are

only a few situations where descriptions are suitable in a design patent application, indicating a strong preference for drawings over written descriptions¹¹. The PTO's preferred practice reflects that drawings and written descriptions of a design are fundamentally different from each other, and strongly suggests that a court should not create a detailed written description of what is present in the drawings as part of design patent claim construction.

**C. VERBALIZING A CLAIMED DESIGN EVISCERATES
GORHAM**

Under *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871), the ultimate question for the trier of fact requires a visual comparison of the accused design and the claimed design as shown in the design patent drawings to determine whether they are “substantially the same.” Verbalization of the drawings undermines this visual comparison by narrowing the scope of the patented design to the words that purportedly represent it. Since words are a poor substitute for how a design actually appears to the eye, *see Friedley-Voshardt Co., et al., supra*, a verbalized design patent claim can only divert the task of the jury from its age-old mandate.

¹¹ U.S.P.T.O., Manual of Patent Examining Procedure § 1503.01 (8th ed. 2001, rev. Sept. 2007).

The venerable *Gorham* test is not one of literal infringement; rather, *Gorham's* test subsumes a doctrine of equivalents for designs by asking whether the two designs are *substantially the same*. *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1190 (Fed. Cir. 1988). However, comparing the accused design to a verbalization, to a reduction to words of the drawing's solid lines, eviscerates *Gorham's* doctrine of equivalents. This is because the jury is likely to check whether each of the words in the verbalization are found in the accused design, akin to a literal infringement test, rather than whether the designs are visually substantially the same. Thus, verbalization derogates how the claimed design actually appears to the eye.

Gorham's test of whether the accused and claimed designs are “substantially the same” does not even reach the jury in many cases, because the defendant, having a verbalization that likely includes several elements missing or different from the accused design, more often than not moves for summary judgment of non-infringement. After a rather literal, verbalized claim construction that does not “read on” the accused design, summary judgment of non-infringement is granted eight times more frequently than summary judgment of infringement.¹² The attempted translation of design

¹² In a survey of 63 design patent cases reported since 1995 wherein claim construction consisted of a verbalization of the design patent's drawings, 43 were thereafter subject to a motion for summary judgment of non-

patent drawings into a verbalized, utility patent-like claim removes the *Gorham* test from the jury and simply does not work.¹³

D. VERBALIZING DESIGN PATENT CLAIMS RISKS 7TH AMENDMENT VIOLATIONS

A court may risk 7th Amendment violations during claim construction by ruling on fact questions such as identifying the point of novelty or ornamental and functional features. *Colgate-Palmolive, supra* at *8 (“The court’s pre-determination during the Markman phase of those features that are ornamental and those that are functional, for purposes of determining the scope of the design patent, could be fairly argued as improperly infringing upon a litigant’s *Seventh Amendment* right to a jury trial on invalidity, as well as being tantamount to a summary judgment decision on the issue”); *Black & Decker, supra* (functionality and point of novelty are questions of fact to be left to the jury).

In contrast, in *Colgate-Palmolive Co.* the court did not decide questions of fact during its *Markman* claim construction. The court quite

infringement, of which 31 were granted. In those same 63 cases, a motion for summary judgment of infringement was granted only 4 times. *See* Design Patents: Claim Construction Rules Lead to Summary Judgment of Non-Infringement, at <http://www.patentlyo.com/patent/2008/01/design-patents.html?cid=98131392#comment-98131392>.

¹³ Saidman and Singh, “The Death of *Gorham v. White*: Killing It Softly with Markman”, 86 *Journ. Pat. & Trademark Office Soc.* 792 (October, 2004).

properly construed seven design patent claims by referring to each patent's drawings and not verbalizations of the drawings (e.g., "The D882 patent claims the overall design of a toothbrush as shown in the figures in the patent." *Supra* at *4.). The court ruled on the meaning of broken line portions in the drawings (e.g., "The head of the toothbrush which is shown in broken lines forms no part of the claimed design." *Id.*), and also ruled on unique attributes shown in them (e.g., "The appearance of the area shaded with the line shading technique contrasts with the appearance of the area shaded with the stipple shading technique." *Id.* at 5).¹⁴ In this manner, the court properly interpreted the design patents, leaving questions of visual appearance and similarity to the fact-finder.

¹⁴ It is not necessary to parse ornamental and functional features during claim construction, since the design patentee has already claimed all features shown in solid lines in the drawings, regardless of whether such features are new, old, ornamental or functional. *Elmer, supra* at 1577. Functionality is a validity issue, not an infringement issue. Case law holding that so-called functional features must be extracted from an overall claimed design during claim construction, e.g., *Read Corporation v. Portec, Inc.*, 970 F.2d 816, 826 (Fed. Cir. 1992), are based on the erroneous premise that a design patent cannot claim a design having features that perform a function; it can (see *Elmer, supra*). But a design patent cannot claim an overall design which is dictated solely by functional considerations. *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 40 USPQ2d 1048 (Fed. Cir. 1996). Such a design patent is invalid as non-statutory subject matter (35 U.S.C. §171) and may be properly challenged by an appropriately pled invalidity defense. *Read Corporation* relied in turn on *Lee, supra*, but the court's point in *Lee*

III. THE POINT OF NOVELTY HAS OUTLIVED ITS USEFULNESS AS A TEST FOR DESIGN PATENT INFRINGEMENT

A. POINT OF NOVELTY ANALYSIS CREATES GREATER PROBLEMS THAN THOSE IT AIMS TO PROTECT AGAINST

In establishing the venerable “*substantially the same*” test for design patent infringement in *Gorham*, the U.S. Supreme Court made no comparison of the claimed design to the prior art, and performed no analysis to see if the patentable novelty was present in the accused designs.¹⁵ The Court subsequently identified the novel design feature in deciding infringement when a claimed design incorporated a great deal of the prior art. *See Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893).¹⁶ A district

was that functionality is an invalidity defense, and a design patent cannot be used to protect the general function of a particular design (*see* §III.C., *infra*).

¹⁵ The Court did not discuss the patentability, or novelty, of *Gorham*’s design, save to mention the lower court’s observation that the design was “the most successful plain [silverware] pattern, indeed, that had been in the market for many years” *Gorham, supra* at 512.

¹⁶ In *Whitman*, the patented design was a saddle, and in its discussion of the design patent’s validity, the Court found that the claimed design combined the front half of one well-known saddle, and the rear half of another. It also identified the novel feature of the patented design as a “sharp drop of the pommel at the rear” that it then found to be missing from the accused design. It concluded: “If, therefore, this drop were material to the design, and rendered it patentable as a complete and integral whole, there was no infringement.” *Id.* at 682. *See also Jennings v. Kibbe*, 24 F. 697 (S.D.N.Y. 1885), *Byram v. Friedberger*, 87 F. 559 (E.D. Pa. 1897), *Bevin Bros. Mfg. v. Starr Bros. Bell Co.*, 114 F. 362 (C.C. Conn. 1902), *Zidell v. Dexter*, 262 Fed. 145 (9th Cir. 1920), *Cola Co. v. Whistle Co. of America*, 20 F.2d 955

court later invoked an “appropriation of novel elements” requirement when a patentee attempted to use its design patent as a utility patent. *See Kruttschnitt v. Simmons*, 118 F. 851 (S.D.N.Y. 1902).¹⁷ This court in the 1984 *Litton* case¹⁸ identified novel elements of a claimed design during the second step of the *Graham* obviousness inquiry¹⁹, and used those novel elements in coining and applying the “point of novelty” formulation that was later deemed “conjunctive” with *Gorham*’s ordinary observer test.²⁰

However, a straight-forward application of the *Gorham* infringement test coupled with a consideration of prior art adequately address the presence of prior art in a claimed design and the over-reaching design patentee. By conflating these issues, a point of novelty analysis creates an infringement

(D.C. Del. 1927), *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933), *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395 (8th Cir. 1944).

¹⁷ In *Kruttschnitt*, the patentee essentially attempted to wield its design patent as a utility patent, *i.e.*, to halt sales of products that incorporated the *idea* expressed in the design patent but without incorporating the design itself. *Supra*. The court found no infringement. The court indicated the ordinary observer test “..cannot be applied without doing violence to the fundamental law of infringement - that in order to constitute infringement there must be an appropriation of the novel elements of the patented design.” *Supra* at 852. *See also Ashley v. Samuel C. Tatum, Co.*, 186 Fed. 339 (2nd Cir. 1911), *N.Y. Belting & P. Co. v. N.J. Car Spring & R. Co.*, 53 F. 810 (2nd Cir. 1892).

¹⁸ *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984).

¹⁹ *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

super-standard very difficult to meet and undermines a patent's presumption of validity.

**B. THE INFRINGEMENT-INVALIDITY DICHOTOMY
OBVIATES THE NEED FOR POINT OF NOVELTY
ANALYSIS**

The point of novelty test for infringement came about primarily to address the possibility of inclusion of prior art elements in a claimed design, *Whitman Saddle, supra* at 682. However, the modern infringement-invalidity dichotomy amply addresses this problem. In other words, if the patentee obtains an unduly narrow claim, a competitor can more easily design around it. On the other hand, if the novelty or patentability of the claimed design is in doubt, the proper response is an invalidity defense. Skillful advocates can draw the fact-finder's attention to prior art elements that may form the only similarity between a claimed design and an accused product (*see* §III.E, *infra*).

**C. GORHAM ALONE IS SUFFICIENT TO DEAL WITH
OVER-REACHING DESIGN PATENTEES**

Straight-forward reliance on *Gorham's* "substantially the same" infringement test, without resorting to point of novelty analysis, has been sufficient to rein in design patentees trying to enforce against those who use

²⁰ *Shelcore, Inc. v. Durham Industries, Inc.*, 745 F.2d 621, 628 n.16 (Fed. Cir. 1984).

the idea behind the design, rather than the claimed design itself. For example, in *Lee*, the patentee argued that its design patent covered a massage device having an elongated handle with two opposing balls at one end, and that a massage device with the same general configuration, but which looked quite different, was infringing. *Supra* at 1189. Relying only upon *Gorham Co. v. White*, the court quite properly found:

[A] design patent is not a substitute for a utility patent. A device that copies the utilitarian or functional features of a patented design is not an infringement unless the ornamental aspects are also copied, such that the overall “resemblance is such as to deceive”.

Id. at 1190.

D. THE POINT OF NOVELTY TEST HAS SYSTEMIC PROBLEMS

Design patent point of novelty analysis also has problems: it creates a difficult-to-meet super-standard for infringement, by adding a literal infringement test to *Gorham’s* doctrine of equivalents; it undermines the patent’s presumption of validity, by allowing an invalidity defense under a very low standard; and it overshadows the venerable *Gorham* test by allowing *Gorham’s* overall claimed design to be broken down into constituent elements.

Initially, there is no analog to the point of novelty test in utility patent jurisprudence. It is well settled that there is no legally recognizable

“essential” element, gist or “heart” of the invention test in determining infringement of a utility patent claim. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961). Rather, a utility patent claim is viewed as a whole in determining infringement.²¹ *Gen. Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1274 (Fed. Cir. 1992).

Secondly, point of novelty analysis creates an unnecessary super-standard for design patent infringement: Not only must the accused design be substantially the same overall as the patented design (*Gorham’s* doctrine of equivalents), but a sub-combination point of novelty, consisting of one or more novel features extracted from the overall claimed design, which was neither claimed nor examined individually, must literally be found in the accused design. No statute, precedent or policy necessitates such a super-standard for design patent infringement. Moreover, this unclaimed and unexamined sub-combination point of novelty is undefined until litigation ensues, when the patentee takes the position that its formulation of the point of novelty is found in the accused design, while the accused infringer quite

²¹ Infringement of a European community design registration also does not include a point of novelty test. The scope of protection of a community design “shall include any design which does not produce on the informed user a different *overall impression*”. Council of the European Union Regulation (EC) 6/2002, Art. 10 (emphasis added).

naturally proffers a point of novelty formulation that is nowhere to be found in the accused design.

Issued design patents enjoy a presumption of validity, 35 U.S.C. §282, having been examined and found novel and non-obvious over the prior art, 35 U.S.C. §§102, 103. Thus, the alleged infringer has a high burden to show invalidity: he must show the design lacks novelty, or would have been obvious, by clear and convincing evidence. *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1379 (Fed. Cir. 2004). Point of novelty analysis unfairly moves the burden to the patentee, who in her infringement case in chief must again prove the patented design has one or more novel elements.²² This time, however, the accused infringer can attack the proffered novel elements under the significantly lower preponderance of evidence standard, as occurred in *Lawman Armor Corp. v. Winner Int'l., LLC*, thereby undermining the patent's presumption of validity. 437 F.3d 1383, 1386 (Fed. Cir. 2006).

Finally, point of novelty analysis marginalizes the *Gorham* test. By breaking down a claimed design into component novel elements under point of novelty analysis, an infringement defendant can attempt to avoid each

²² See *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567 (Fed. Cir. 1983) (To ignore the presumption of novelty will “place on the patentee a non-statutory burden of proving validity.”)

novel feature individually, by changing or omitting one or more of those features, and thereby assert that the point of novelty has not been appropriated. This is far easier than avoiding the overall design, and relegates *Gorham's* overall “substantially the same” test to the background. Thus, an infringement finding can be avoided by a defendant drafting the point of novelty to include elements from the claimed design not present in the accused design, despite the fact that the overall appearance is substantially the same.

E. THE PRIOR ART CAN BE CONSIDERED WITHOUT ANALYZING THE POINT OF NOVELTY

In applying the *Gorham* test, many courts have well considered the prior art without undertaking point of novelty analysis, by making a 3-way visual comparison between the patented design, the accused design, and the closest prior art. For example, in *Bevin Bros. Mfg. Co., supra*, the court concluded:

The shape of defendants' bell differs from plaintiff's more widely than plaintiff's differs from the [prior art] door knob, and therefore defendants' construction does not infringe the patent.

In *Sidney Blumenthal & Co. v. Salt's Textile Mfg. Co.*, 21 F.2d 470 (D. Conn. 1927), the court found no infringement, stating:

There are more features of similarity between [the patented design] and the prior patents cited than there are between Salt's Company's fabric and the patented design. Therefore to view this design in such light as to find infringement would be to

bring the patented design within the prior art and thereby render the patent invalid.

In *Applied Arts Corp., supra*, in finding no infringement the court observed:

[I]t appears to us that while there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art.

Finally, this Court, in affirming a jury finding of infringement under *Gorham*, has said:

[I]n contrast to pre-existing hand held blenders [i.e., the prior art], which had a utilitarian, mechanical appearance, both Waring's blender and Braun's blender share a fluid, ornamental, aerodynamic overall design.

Braun Inc. v. Dynamics Corp. of America, 975 F.2d 815, 820 (Fed. Cir. 1992).

Thus, if the patented or accused designs appear to be visually closer to the prior art than they are to each other, then the trier of fact will more likely conclude that the designs are not substantially the same. This makes sense in that if the patented design is closer to the prior art than to the accused design, to enlarge the scope of the patented design to encompass the accused design will likely cause the patented design to run afoul of the prior art. In other words, the accused design is simply beyond the scope of the patented design. If the accused design is closer to the prior art than to the patented

design, the same situation obtains. In both cases, the principle is that the accused infringer is entitled to practice the prior art.

However, if the patented and accused designs appear to be visually closer to each other than either is to the closest prior art, then the trier of fact is more likely to conclude that the designs are substantially the same.²³ This also makes sense in that the accused infringer, having all the prior art available to him, chose instead to produce a design that was visually closer to the patented design, and therefore at higher risk of being held to be substantially the same.

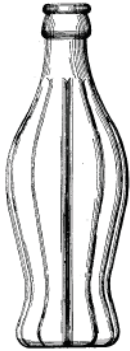
This 3-way visual comparison test, which considers the prior art, is on its face subjective, but so is the appearance of ornamental designs, making it an appropriate alternative to the purportedly objective and outmoded point of novelty analysis.²⁴ Several examples of this 3-way visual comparison between the patented design, accused design and prior art appear below.

²³ See also *Bergstrom v. Sears, Roebuck and Co.*, 496 F.Supp. 476, 492 (8th Cir. 1980); *Unette Corp. v. Unit Pack Co., Inc.*, 226 USPQ 715, 717 n.4 (D.N.J. 1985), *aff'd*, 228 USPQ 933 (Fed. Cir. 1986); *Unique Functional Products, Inc. v. Mastercraft Boat Co., Inc.*, 82 Fed.Appx. 683, 690 (unpub., Fed. Cir. 1993); *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 424 F.Supp.2d 1188 (C.D. Cal. 2006), *aff'd*, 501 F.3d 1314 (Fed. Cir. 2007).

²⁴ As with *Markman* construction of design patent claims (see §II., *supra*), the point of novelty test necessarily results in a verbalization of the point of novelty – with all the uncertainty and inaccuracies inherent in verbalization of design patent claims.

Coca-Cola Co. v. Whistle Co. of Am., 20 F.2d 955 (D. Del. 1927):

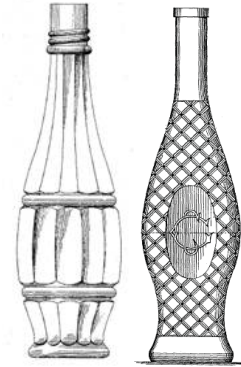
PATENTED
DESIGN



ACCUSED
DESIGN



PRIOR ART

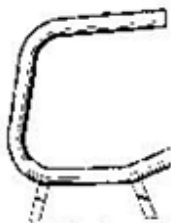


Save for such similarity as results from the common use of the ogee curve [found in the prior art], the most casual observer would find no difficulty in distinguishing [the patented] bottle from the [accused bottle]. *Id.* at 957.

HOLDING: NO INFRINGEMENT.

Bergstrom v. Sears, Roebuck and Co., 496 F.Supp. 476 (D. Minn. 1980):

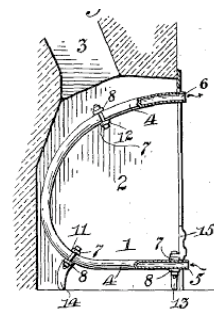
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DESIGN



ACCUSED
DESIGN



PRIOR ART

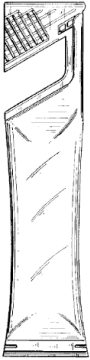


The [accused device] bore the closest resemblance to the [patented design] out of all the prior art. *Id.* at 492.

HOLDING: INFRINGEMENT

Unette Corp. v. Unit Pack Co., Inc., 1985 WL 5989 (D.N.J. 1985):

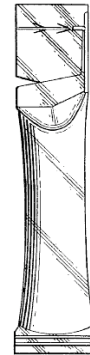
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DESIGN



ACCUSED
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PRIOR ART

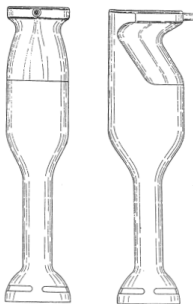


Moreover, to the extent that defendant's design is derived not from plaintiff's, but from the prior art, infringement cannot be said to have occurred. *Id.* at *3 n.4.

HOLDING: NO INFRINGEMENT.

Braun Inc. v. Dynamics Corp., 975 F.2d 815 (Fed. Cir. 1992):

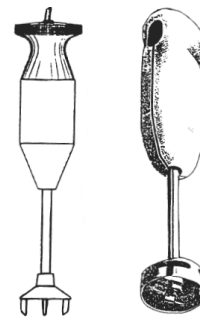
PATENTED
DESIGN



ACCUSED
DESIGN



PRIOR ART

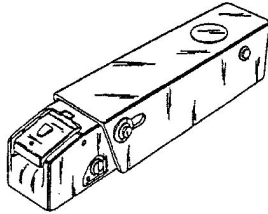


[I]n contrast to pre-existing hand held blenders [i.e., the prior art], which had a utilitarian, mechanical appearance, both [defendant's] blender and Braun's blender share a fluid, ornamental, aerodynamic overall design. *Id.* at 820.

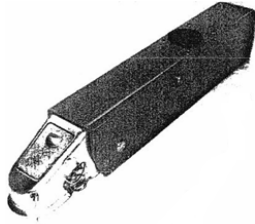
HOLDING: INFRINGEMENT.

Unique Functional Products, Inc. v. Mastercraft Boat Co., Inc., 82 Fed.Appx. 683 (unpub., Fed. Cir. 1993):

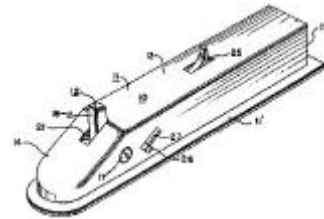
PATENTED
DESIGN



ACCUSED
DESIGN



PRIOR ART

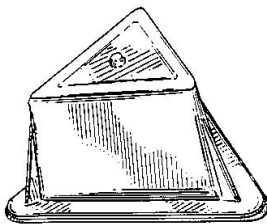


We also agree with [defendant] that the [accused] coupler is dissimilar from the design shown in the [patented design] and, indeed, much more closely resembles the design disclosed in the prior art... *Id.* at 689.

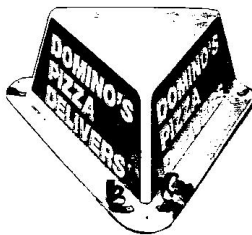
HOLDING: NO INFRINGEMENT.

Elmer v. ICC Fabricating, 67 F.3d 1571 (Fed. Cir. 1995):

PATENTED
DESIGN



ACCUSED
DESIGN



PRIOR ART



...the... patented design differs from the prior art sign... and ICC's own sign... in two respects: the protrusion that extends above the upper surface... and the triangular vertical ribs... *Id.* at 1576.

HOLDING: NO INFRINGEMENT.

IV. QUESTION 2: IF THE POINT OF NOVELTY TEST SURVIVES

In the event the Court decides to answer question 1 “yes”, *Amicus* offers the following comments regarding question 2.

(a) The Court should not adopt the non-trivial advance test since it would raise even higher the existing super-standard of infringement (see §III.D, *supra*). That is, in order to prevail the patentee would then have to prove that: (i) the accused design is substantially the same as the patented design overall; (ii) a sub-combination of its overall claimed design is found literally in the accused design; and (iii) such sub-combination is non-trivial. The lack of guidance for what would be “trivial” and what would be “non-trivial” is also problematic.

(b) If the accused infringer believes that the patented design lacks novelty, or is trivial, or would have been obvious, or is dictated solely by functional considerations, the appropriate response should be an invalidity counterclaim. To allow such validity factors to be considered during the patentee’s infringement case unfairly encourages back door attacks on validity with a lower burden of proof (preponderance of evidence) than would obtain in an invalidity counterclaim (clear and convincing evidence).

(c) and (d) One of the great difficulties with the point of novelty analysis is in defining in any given case exactly what the point of novelty is

or how it is to be properly determined. For example, the case law interchangeably uses both phrases “point” and “points” of novelty²⁵, confuses the *Gorham* and *Litton* tests by requiring “substantially the same points of novelty” to be found in the accused design²⁶, and in at least one case has declined to perform the point of novelty test saying that the result would be the same under either the *Gorham* or *Litton* tests²⁷. Whether the visual features that make up the point of novelty are divided or integrated is in the hands of the point of novelty formulator and the trier of fact. A thoughtful patentee will likely proffer a point of novelty that is a combination of novel elements since it is more difficult to attack the novelty of such a combination. In contrast, a thoughtful defendant will likely proffer a list of disparate novel elements so as to more easily subject them to attack, as occurred in *Lawman, supra*.

(e) There is no rational reason why the overall appearance of a claimed design cannot constitute the point of novelty, especially considering modern day minimalist designs²⁸, and those which, through extensive use of

²⁵ *Arminak & Assocs., supra, Bernhardt, L.L.C. v. Collezione Europa USA, Inc., supra*.

²⁶ *Goodyear, supra* at 1118 (Fed. Cir. 1998).

²⁷ *Shelcore, Inc., supra* at 628 n.16.

²⁸ *See, e.g.*, U.S. Pat. No. D557,606 (filed May 23, 2003).

broken lines, are claimed quite broadly.²⁹ One of the early cases which formulated the rule against having the overall design constitute the point of novelty, *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.*, was simply in reaction to the lower court's failure to even attempt to identify any novel elements at all - it had characterized the point of novelty as "the ornamental gestalt."³⁰ 48 F.3d 1193, 1197 (Fed. Cir. 1995).

V. CONCLUSIONS

This Court should find that *Markman* construction of a design patent's claim excludes verbalization, or a translation into words, of the visual features shown in the design patent drawings. Further, the Court should find that the point of novelty test has outlived its usefulness, and reaffirm the venerable *Gorham Co. v. White* test as one which can properly take into account the prior art in determining design patent infringement.

Respectfully submitted,



Perry J. Saidman

Attorney for *Amicus Curiae*

FEBRUARY 5, 2008

²⁹ See, e.g., U.S. Pat. No. Des. 351,310 (filed Dec. 24, 1992).

³⁰ *Sun Hill Industries* represents another attempt by a design patentee to protect the *idea* of a claimed design rather than the design itself. See §III.C., *supra*.

CERTIFICATE OF SERVICE

**United States Court of Appeals
for the Federal Circuit**

No. 2006-1562

-----)
EGYPTIAN GODDESS, INC.,
Plaintiff-Appellant,

and

ADI TORKIYA
Third Party Defendant,

vs.

SWISA, INC. and DROR SWISA,
Defendant/Third Party Plaintiffs-Appellees.
-----)

I, John C. Kruesi, Jr., being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

I am retained by SAIDMAN DESIGNLAW GROUP, Attorneys for *Amicus Curiae*.

On the **5th Day of February 2008**, I served the within **Brief of *Amicus Curiae* Apple Inc.** upon:

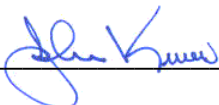
Robert G. Oake, Jr.
Oake Law Office
1333 W. McDermott
Suite 200
Allen, Texas 75013
469-519-2755
Attorney for Appellant

Frederick L. Medlin
Kirkpatrick & Lockhart Preston Gates
Ellis LLP
2828 North Harwood Street
Suite 1800
Dallas, Texas 75201
214-929-4900
Attorney for Appellees

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February 5, 2008



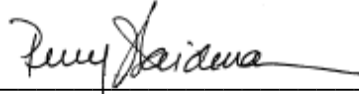
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LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE STYLE
REQUIREMENTS**

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B).

The brief contains 5,608 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6).

The brief has been prepared in a proportionally spaced typeface using Microsoft Word 97-2003 in font size 14 of Times New Roman.



Perry J. Saidman
Attorney for *Amicus Curiae*

FEBRUARY 5, 2008