

2006-1562

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

BRIEF OF PLAINTIFF-APPELLANT EGYPTIAN GODDESS, INC.
FOR EN BANC APPEAL

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January 25, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Egyptian Goddess, Inc. v. Swisa, Inc.
2006-1562

CERTIFICATE OF INTEREST

Counsel for Plaintiff-Appellant certifies the following:

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

Egyptian Goddess, Inc.
Adi Torkiya

2. The real 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:

Not Applicable

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. 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 are expected to appear in this court are:

Robert G. Oake, Jr., Oake Law Office
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January 25, 2008

Robert G. Oake, Jr.
Attorney for Plaintiff-Appellant

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STATEMENT OF RELATED CASES

Plaintiff-Appellant Egyptian Goddess, Inc. is not aware of any specific case currently pending in this Court, the Supreme Court, or any other Circuit Court of Appeals that will directly affect or be directly affected by the Court's decision in this case. Egyptian Goddess is generally aware that any design patent case with infringement issues that is currently pending in this Court will be directly affected by the Court's decision in this case.

JURISDICTION

Appellant and Plaintiff below, Egyptian Goddess, Inc., (Egyptian Goddess) appeals from the following final determinations of the United States District Court for the Northern District of Texas in the action entitled *Egyptian Goddess, Inc. v. Swisa, Inc., et al.*; Civil Action No. 3-03-CV-0594-N: (1) Final Judgment entered July 6, 2006 (JA1) and (2) Order granting motion for summary judgment of Defendants Swisa, Inc. and Dror Swisa (collectively “Swisa”) entered December 14, 2005 (JA2-JA8).

The determinations set forth in (1) and (2) above became final for the purposes of appeal when the district court entered final judgment on July 6, 2006. Pursuant to Federal Rule of Civil Procedure 4(a)(1)(A), Egyptian Goddess filed a timely Notice of Appeal on August 1, 2006 (JA14-JA15).

This Court has jurisdiction under 28 U.S.C. § 1295(a)(1), granting it exclusive jurisdiction over final determinations of a district court if the jurisdiction of that court was based, in whole or in part, on 28 U.S.C. § 1338. The District Court of the Northern District of Texas had subject matter jurisdiction over this action under 28 U.S.C. § 1338(a), as the action arose under Title 35.

STATEMENT OF THE ISSUES

By the Court:

- (1) Should "point of novelty" be a test for infringement of design patent?
- (2) If so,
 - (a) should the court adopt the non-trivial advance test adopted by the panel majority in this case;
 - (b) should the point of novelty test be part of the patentee's burden on infringement or should it be an available defense;
 - (c) should a design patentee, in defining a point of novelty, be permitted to divide closely related or ornamentally integrated features of the patented design to match features contained in an accused design;
 - (d) should it be permissible to find more than one "point of novelty" in a patented design; and
 - (e) should the overall appearance of a design be permitted to be a point of novelty? *See Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).
- (3) Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

Additionally by Egyptian Goddess:

- (4) Should the district court have granted summary judgment of non-infringement since a material issue of fact exists concerning whether Swisa's buffer infringes under the ordinary observer test?

STATEMENT OF THE CASE

On March 21, 2003, Egyptian Goddess sued Swisa, Inc. and Dror Swisa for patent infringement in the Northern District of Texas, *Egyptian Goddess, Inc. v. Swisa, Inc., et al.*; Civil Action No. 3-03-CV-0594-N. (JA23; JA37-JA40). Swisa filed an answer and a declaratory judgment counterclaim on April 10, 2003. (JA23; JA41-JA46). Egyptian Goddess answered the counterclaim on April 23, 2003. (JA23; JA47-JA49). On January 21, 2004, Swisa filed a first amended answer and counterclaim against Egyptian Goddess and a third-party complaint against Adi Torkiya. (JA25; JA50-JA56). On February 19, 2004, Egyptian Goddess and Adi Torkiya filed a first amended answer to counterclaim and third party complaint. (JA25; JA57-JA61). A motion for claim construction was filed on October 18, 2004 (JA27), and an order construing the claim of the subject Patent was entered on March 7, 2005 (JA9-JA13).

Swisa filed a motion for summary judgment (JA62-JA63) with brief (JA64) and appendix (JA96) on April 1, 2005. Egyptian Goddess responded (JA289) with appendix (JA333), and Swisa replied (JA419). The district court granted Swisa's motion for summary judgment of non-infringement on December 14, 2005. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 2005 U.S. Dist. LEXIS 32931 (D. Tex. 2005) (JA2-JA8). Both parties filed motions for reconsideration (JA30), and both motions were denied by order entered January 30, 2006. (JA31).

A final judgment was entered by the district court on July 6, 2006, which (1) ordered that Egyptian Goddess take nothing by its claims for patent infringement against Swisa and dismissed those claims with prejudice, and (2) ordered that Swisa's declaratory judgment claims against Egyptian Goddess and Adi Torkiya be dismissed without prejudice. (JA1). Costs of court were taxed in favor of Swisa and against Egyptian Goddess. (JA1). Egyptian Goddess filed a notice of appeal on August 1, 2006. (JA14-JA15). This appeal followed.

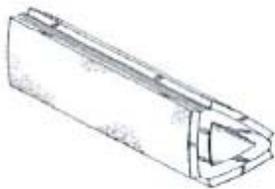
Egyptian Goddess filed a brief, Swisa responded, and Egyptian Goddess replied. Oral argument was held on March 5, 2007. By opinion dated August 29, 2007, this Court affirmed the district court's order. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354 (Fed. Cir. 2007). Egyptian Goddess timely filed a combined petition for panel rehearing and rehearing en banc. Swisa responded. On November 26, 2007, this Court denied the petition for panel rehearing, granted the petition for rehearing en banc, vacated the opinion dated August 29, 2007, and reinstated this appeal. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 2007 U.S. App. LEXIS 27456 (Fed. Cir. 2007). The parties were requested to file briefs addressing issues (1), (2), and (3) listed in the Statement of the Issues above. This Court stated that this appeal would be heard en banc on the basis of briefs addressing, inter alia, issues (1), (2), and (3) set forth above.

STATEMENT OF FACTS

Egyptian Goddess is the exclusive licensee of all right, title and interest in and to United States Design Patent No. D467,389 (“the D’389 Patent) issued on December 17, 2002 by the United States Patent and Trademark Office. (JA38). Swisa has sold a nail buffer that is substantially similar in distinctive appearance to the D’389 Patent in that the Swisa buffer has a hollow and open ended tube, square in cross section and rectangular in length, with multiple raised rectangular buffer pads mounted on the sides that do not cover the corners of the tube. (JA300-JA301). The Swisa buffer has one more buffer pad than the patented design. The prior art includes solid block buffers (e.g., Falley Buffer Block) and Design Patent No. 416,648 to Letherby (the D’648 Patent, “Nailco” buffer, or “Nailco Patent”) (JA383). Swisa reproduced in its initial response brief (page 7) two prior art buffers and the accused and patented designs as follows:



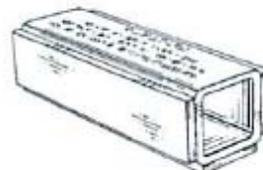
*Falley Buffer
Block*



Nailco Patent



Swisa Buffer



'389 Patent

An expert witness for Egyptian Goddess, Kathleen Eaton, stated in relevant part as follows in a declaration dated May 3, 2005 (JA334-JA335):

4. Over the years, I have sold thousands of nail buffers to customers. The nail buffers were in a variety of designs, including block buffers. In my experience, when purchasing a nail buffer, customers do not know the difference between, or express a preference for, a “three way” or a “four way” nail buffer.

5. I have looked at the nail buffer design depicted in United States Patent D467,389 (patented design). I also have looked at the nail buffer accused of infringement in the above-styled case (accused nail buffer).

6. In my opinion an ordinary observer and purchaser of nail buffers would consider that the patented design and the accused nail buffer have a substantially similar appearance in overall design, particularly in light of other nail buffers, such as a solid block buffer and the hollow triangular Nailco buffer. In my opinion, the substantially similar appearance in overall design results from both designs having a hollow tube, square in cross section and rectangular in length, with multiple raised rectangular pads mounted on the sides, and that do not cover the corners of the tube.

7. I understand that the accused nail buffer has one more buffer pad than the patented design. However, I do not believe that, to an ordinary observer and purchaser of nail buffers, the presence of one more buffer pad greatly alters the ornamental effect and appearance of the whole design as compared to the whole patented design.

8. In my opinion, the overall designs of the patented design and the accused nail buffer are so similar that in the eyes of an ordinary observer and purchaser of nail buffers, their resemblance is such as to confuse an ordinary observer into purchasing the accused buffer thinking it to be the patented buffer design.

The district court made no determination under the ordinary observer test, but determined that the point of novelty of the D’389 Patent is a fourth side without a buffer pad. Since the accused Swisa buffer does not have a fourth side without a pad, the district court granted summary judgment of non-infringement.

SUMMARY OF ARGUMENT

(1) Point of Novelty

The “point of novelty” test should not be a separate and distinct test from the ordinary observer test. Rather, the ordinary observer test should be performed in relation to the prior art. This means that the accused design, to infringe, must present to the eye of an ordinary observer the substantial overall appearance, or visual effect, that distinguishes the patented design from the prior art.

(2) Claim Construction Issue

In a jury trial, the court should not construe design patent drawings with words. Words have a tendency to make all portions of the drawing perceptively equivalent unless the words expressly increase or decrease the perceptive importance of a particular feature, *i.e.*, by using adjectives and adverbs and by describing a feature as major, minor, prominent, dominant, etc. Using words to increase or decrease the perceptive importance of a particular design feature is improper, however, because the drawing then is not being merely observed by the jury, but rather is being observed by the jury as the design has been interpreted and expressed in words by the court. A jury may or may not place the same perceptive emphasis on a design element as the court. Therefore, in a jury trial, claim construction only should be used to identify the correct design drawing(s) for the

jury (*i.e.*, explain the effect of properly used broken lines and give effect to any words used by the patentee).

(3) Infringement Analysis

A fact issue exists concerning whether the Swisa nail buffer infringes upon the D'389 Patent because the Swisa buffer substantially appropriates the overall appearance and visual effect that distinguishes the D'389 patented design from the prior art. Both designs have hollow tubes that are square in cross section and rectangular in length, and that have multiple raised pads with exposed gaps at the corners. The Swisa buffer design does not differ from the patented design more widely than the patented design differs from the prior art. While the hollowness, square cross section, and raised pads with exposed gaps create an overall distinctive appearance that widely distinguishes the patented design from the prior art, the only difference in the patented and accused designs is the addition of one buffer pad. An ordinary observer is unlikely to focus on the addition of one buffer pad as a distinguishing characteristic because the prior art is not crowded with generally similar designs (hollow, square in cross section, with multiple raised pads).

SHORT ANSWERS TO QUESTIONS

(1) Should "point of novelty" be a test for infringement of design patent?

“Point of novelty” should not be a separate and distinct test for infringement. The ordinary observer test should be performed in relation to the prior art as explained in the argument section below.

(2) If so, (a) should the court adopt the non-trivial advance test adopted by the panel majority in this case;

This Court should not adopt the non-trivial advance test for the reasons stated by Judge Dyk in his dissenting opinion. Further, the non-trivial advance test is not necessary when the ordinary observer test is made in relation to the prior art.

(b) should the point of novelty test be part of the patentee's burden on infringement or should it be an available defense;

The “novelty” requirement should be returned to the ordinary observer test by requiring that the accused design substantially appropriate the overall appearance or “visual effect” that distinguished the patented design from the prior art. The burden of proof is on the patentee to prove infringement under the ordinary observer test.

(c) should a design patentee, in defining a point of novelty, be permitted to divide closely related or ornamentally integrated features of the patented design to match features contained in an accused design;

When determining whether two designs are substantially the same under the ordinary observer test, differences in design elements may be considered, but the controlling consideration is the resultant overall visual effect and the comparison is done in relation to the prior art.

(d) should it be permissible to find more than one "point of novelty" in a patented design;

It should not be necessary to identify a point of novelty. Patented designs often have more than one design element difference, or "point of novelty" from the prior art (whether considered singularly or in combination), but the controlling consideration is the resultant overall visual effect and distinctive appearance of all the design elements as an integrated whole.

and (e) should the overall appearance of a design be permitted to be a point of novelty? *See Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).

It should not be necessary to identify a point of novelty and the issue of whether the overall appearance of a design may be a point of novelty should no longer matter. However, to the extent this Court finds that the issue does matter, *Egyptian Goddess* answers the question in the context of this Court's current "point of novelty" test, as follows:

The argument against allowing the overall appearance of a design to be the point of novelty is that since the overall design is considered in the ordinary observer test, if the overall design is also considered as the point of novelty, it would effectively collapse the point of novelty test into the ordinary observer test. The flaw in this argument, however, is that although the “ordinary observer” test and “point of novelty” test may both produce the “overall design” as a common test result, the common result is arrived at by two fundamentally different processes.

Under the ordinary observer test, the overall patented design is compared to the accused design. Under the point of novelty test, however, the process is different. The overall patented design is compared to the prior art and the point of novelty is that aspect of a design which renders the design different from prior art designs. The point of novelty may be an individual design element, or when all the individual design elements are in the prior art, it may be a combination of design elements. In the situation where the novel combination happens to be the same as the overall design, then the overall design may be the point of novelty. There is no principled reason to automatically disqualify a point of novelty just because it turns out to be the same as the overall design. What is important is that the point of novelty was determined by the process of comparing the design to the prior art and not by simply looking at the overall design.

(3) Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

In a jury trial, design patent drawings should not be construed in words by the court. The ordinary observer test should be performed by visually comparing the patented design to the accused design. Claim construction only should be used to perform such functions as explaining the effect of properly used broken lines in the patent drawings and to give effect to any words used by the patentee.

STANDARD OF REVIEW

(1) Summary Judgment of Non-Infringement

The Federal Circuit reviews a district court's grant of summary judgment de novo. *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315 (Fed. Cir. 1998). Summary judgment is appropriate only when there are no genuine issues of material fact and the moving party is entitled to judgment as a matter of law. *See Fed. R. Civ. P. 56(c)*. "In determining whether there is a genuine issue of material fact, the evidence must be viewed in the light most favorable to the party opposing the motion, with doubts resolved in favor of the opponent." *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307 (Fed. Cir. 1998). If there are no material facts in dispute precluding summary judgment, the Federal Circuit's "task is to determine whether the judgment granted is correct as a matter of law." *Marathon Oil Co. v. United States*, 177 F.3d 1331, 1337 (Fed. Cir. 1999).

ARGUMENT

I. Point of Novelty

A. Law Predating Creation of the Federal Circuit

In *Gorham Co. v. White*, 81 U.S. 511 (1871), the United States Supreme Court established the test for design patent infringement. The Court held that “if, 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.” *Id.* at 528. The Court also explained that the “controlling consideration” was whether the “effect” of the designs was the same. *Id.* at 525, 526. (“We do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect.”). The “main test of substantial identity of appearance” was considered to be “sameness of effect upon the eye.” *Id.* at 527.

Cases following *Gorham* emphasized “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.” *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933)

(and cases cited therein). Although the “distinctive appearance” principle was not expressly stated as a requirement for infringement in *Gorham*, a careful review of the Court’s infringement analysis indicates that the principle had been satisfied. In *Gorham*, the Supreme Court stated:

Applying this rule to the facts of the present case, there is very little difficulty in coming to a satisfactory conclusion. The *Gorham* design, and the two designs sold by the defendant, which were patented to White, one in 1867, and the other in 1868, *are alike the result of Peculiarities of outline, or configuration, and of ornamentation.* These make up whatever is *distinctive in appearance*, and of these, the outline or configuration is most impressive to the eye.

Id. at 528-529. (emphasis added).

“Distinctive” is a comparative term. The *Gorham* and White designs could not accurately be described as “distinctive” unless they were being compared against the prior art spoon designs that an ordinary observer was generally familiar with.

In *Applied Arts*, the court found no conflict between the *Gorham* ordinary observer test and the requirement that the accused design must present the appearance that distinguished the patented design from the prior art. The full rationale of the court is worth reproducing:

It has been held, however, that a design patent stands on as high a plane as utility patents, [cites omitted], 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. [cites omitted]. 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."

The court reasoned there was no conflict because the ordinary observer, who already possessed reasonable familiarity with the prior art,¹ necessarily made the

¹ In *Gorham*, the Supreme Court held that ordinary observers were not experts. Rather, ordinary observers were observers of "ordinary acuteness," having "ordinary intelligence," and who "are the principal purchasers of the articles to which designs have been given novel appearances." *Gorham, supra*, at 528. The Supreme Court disagreed with the lower court's opinion that "there could be no infringement unless there was 'substantial identity' 'in view of the observation of a person versed in designs in the particular trade in question – of a person engaged in

comparison in relation to the prior art. The requirement that the accused design must present the appearance that distinguished the patented design from the prior art was not a second test distinct from the ordinary observer test, but was rather *part of the ordinary observer test* and a necessary requirement of infringement.

Importantly, the court stated that the accused design had to present the *appearance* that distinguished the patented design from the prior art. Although there was consideration of the individual design elements that contributed to the distinct appearance, the court did not attempt to identify a precise point of novelty in the patented design and then determine whether the accused design contained that point of novelty. Rather, the ultimate consideration was whether the overall appearance that distinguished the patented design from the prior art also was present in the accused design. The court's analysis was consistent with the *Gorham* teaching that “[w]e do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect.” *Gorham, supra*, at 526.

The court's opinion then explained why it was important to make the comparison in relation to the prior art:

the manufacture or sale of articles containing such designs – of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side.” *Id.* at 527.

So viewing the test that is to be applied on the issue of infringement, it 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. There are differences of course in lines and curves between the outer configuration of the patented design and those noted in the prior art, but such differences are no greater than those that exist between the patented design and the alleged infringing designs.

Applied Arts, supra, at 430. In short, it was important to make the comparison in relation to the prior art because designs that may appear similar in isolation may appear different when compared in light of the prior art.

The Court also used a practical test for analyzing infringement. When the accused design differed from the patented design more widely than the patented design differed from the prior art, there was no infringement. This practical test had been used in other cases as well. *See, e.g., Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co.*, 114 F. 362, 363 (U.S. Court of Appeals 1902) (“The shape of defendants' bell differs from plaintiff's more widely than plaintiff's differs from the [bell shaped] door knob, and therefore defendants' construction does not infringe the patent.”). The practical test made sense because if the ordinary observer was able to distinguish the patented design from the prior art, and the differences between the accused design and the patented design were greater than the differences

between the patented design and the prior art, then the ordinary observer also was able to distinguish between the accused and patented designs.

The Court in *Applied Arts* also made a useful observation concerning the ability of an ordinary observer to distinguish designs when the prior art was crowded:

We are quite aware that similarity is not to be determined by making too close an analysis of detail, yet where in a crowded art the composite of differences presents a different impression to the eye of the average observer (as above defined), infringement will not be found.

Applied Arts, supra, at 430. This made sense because an ordinary observer accustomed to making distinctions based on relatively minor differences in a crowded field was less likely to be confused by general design similarities.

In sum, the test for design patent infringement as expressed in *Gorham* and *Applied Arts* was whether the appearance of the patented and accused designs had such similar effect upon the eye that an ordinary observer would purchase the accused design thinking that it was the patented design. The comparison was made in relation to the prior art, which as a practical matter, meant three things. First, to infringe, the accused design had to present the appearance that distinguished the patented design from the prior art. Second, if the accused design differed from the patented design more widely than the patented design differed from the prior art, then there was no infringement. Third, when the prior art was crowded, the

ordinary observer made a more discriminative examination and comparison of the patented and accused designs, which meant that the scope of the design patent was construed more narrowly in a crowded field of prior art.

B. Federal Circuit Law

This Court's first design patent case involving issues of infringement² was *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423 (Fed. Cir. 1984).

This Court's entire discussion of the infringement issue was as follows:

More than one hundred years ago, the Supreme Court established a test for determining infringement of a design patent which, to this day, remains valid. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 20 L. Ed. 731 (1871). This test requires that "if, 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." *Id.* at 528.

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, 185 USPQ 123, 128 (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. (This "point of novelty" approach applies only to a determination of infringement. *See, e.g., Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983). This court

² Two earlier design patent cases before the Federal Circuit involved issues of validity (*In re Salmon*, 705 F.2d 1579 (Fed. Cir. 1983) and double patenting (*Carman Industries, Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983)).

has avoided the point of novelty approach in other contexts. *See, e.g., Carman Industries, Inc. v. Wahl*, 724 F.2d 932 at 940 (Fed. Cir. 1983) (double patenting); *In re Gulack*, 703 F.2d 1381, 1385 n. 8, 217 USPQ 401, 403 n. 8 (Fed. Cir. 1983) (unobviousness.)

The novelty of the '990 patent consists, in light of our analysis in the previous section on the '990 patent's validity, of the combination on a microwave oven's exterior of a three-stripe door frame, a door without a handle, and a latch release lever on the control panel. The district court expressly found, however, that the Whirlpool design had none of these features.

We recognize that minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement. In this case, however, "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." *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933). Where, as here, a field is crowded with many references relating to the design of the same type of appliance, we must construe the range of equivalents very narrowly.

We hold, therefore, that the scope of protection which the '990 patent affords to a microwave oven is limited in application to a narrow range: the three-stripe effect around a door with no handle and the latch release mounted on the control panel. The Whirlpool ovens, therefore, do not infringe the '990 design patent. The contrary conclusion of the district court is clearly erroneous, being attributable to its failure to apply the correct legal standard of infringement in design patent cases.

Id. at 1444.

In *Litton Systems*, this Court acknowledged the *Gorham* and *Applied Arts* principles that (1) the *Gorham* "ordinary observer" test was the test for design

patent infringement, (2) to infringe the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art, (3) if the accused design differed from the patented design more widely than the patented design differed from the prior art, then there was no infringement, and (4) when the prior art was crowded with generally similar designs, the range of equivalents³ was construed narrowly.

However, in *Litton Systems* this Court did not state that the “novelty” requirement was part of the ordinary observer test. Rather, this Court appeared to treat the novelty requirement as separate from the ordinary observer test. 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." [cite omitted]. *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 Systems, supra, at 1444. (emphasis added).

The italicized statement suggested that the test for design patent infringement is performed in two distinct steps. First, the court compares the two designs through the eye of an ordinary observer. Second, if the designs are

³ This Court has stated that “it has long been recognized that the principles of equivalency are applicable under *Gorham*.” *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988)).

confusingly similar to an ordinary observer, then to find infringement the court must attribute the similarity to the novelty that distinguished the patented design from the prior art. The “two distinct tests” approach is, in fact, the way this Court has expressed the design patent infringement test after *Litton Systems*. See *Shelcore, Inc. v. Durham Industries, Inc.*, 745 F.2d 621, 629 (Fed. Cir. 1984) (*Litton* ... supplements the [ordinary observer] test with the requirement that “the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.”); *Sun Hill Indus. v. Easter Unlimited*, 48 F.3d 1193, 1197 (Fed. Cir. 1995) (“Beyond the substantial similarity requirement of *Gorham* and *L.A. Gear*, design patent infringement requires that the accused product ‘appropriate the novelty in the patented device which distinguishes it from the prior art.’”) (quoting *Litton*); *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1320 (Fed. Cir. 2007) (“In a separate and distinct inquiry, the ‘point of novelty’ test requires proof that the accused design appropriated the novelty which distinguishes the patented design from the prior art.”).

C. Problems with the Point of Novelty Test

When the “novelty” requirement is separated from the ordinary observer test, the overall patented and accused designs no longer are compared in relation to the prior art. This eliminates the infringement requirement that the accused design present the substantial overall appearance (visual effect to the eye) that

distinguishes the patented design from the prior art. A separate and distinct point of novelty test therefore departs from the infringement principles discussed in *Gorham* and *Visual Arts*.

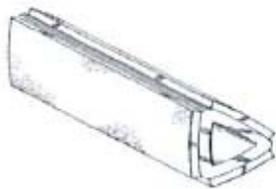
Further, a separate and distinct point of novelty test creates two problems. First, often it is difficult to identify a “point of novelty.” A design with several design elements may have several points of novelty over any given prior art design. The number depends on whether the points of novelty may be individual design elements, combinations of design elements, and whether the overall design can be identified as a point of novelty. When the patented design is compared against more than one prior art design, each of which has multiple and varied design elements, the difficulty of identifying a single and precise point of novelty increases. Under these circumstances, it becomes extremely difficult, if not impossible, to consistently and predictably identify a single point of novelty.

The instant case provides an example. Even though the claimed buffer design is relatively simple, there are several different possible points of novelty. If the claimed ‘389 Patent design is compared against the Nailco Patent, then possible points of novelty are the square cross section (as opposed to triangular cross section) and the absence of a raised buffer pad on one side. These were the points of novelty identified by Swisa below. *See Egyptian Goddess, Inc. v. Swisa, Inc.*,

2005 U.S. Dist. LEXIS 32931, *6, n.5 (D. Tex. 2005) (“Swisa appears to count this as two points of novelty (fourth bare side and square cross section)”).



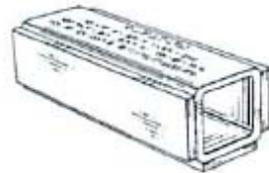
Falley Buffer Block



Nailco Patent



Swisa Buffer



'389 Patent

However, if the patented design is compared against the prior art solid block buffer, then possible points of novelty are the hollow and open tube and raised buffer pads with open corners. If the claimed design is compared against both these prior art buffers, then the point of novelty can be expressed as an “open, hollow tube, square in cross section, with raised pads that do not cover the corners of the tube.” This is the combination point of novelty proposed by Egyptian Goddess below. *Id.* at *5, n.4. The point of novelty also possibly could be the overall appearance of the claimed buffer, in which case it would be an “open, hollow tube, square in cross section and rectangular in length, with three raised pads that do not cover the corners of the tube.”

Finally, even after certain design elements are identified as novel, the “point of novelty” can be expressed in different ways that will influence the infringement outcome. For example, the district court expressed Swisa’s proposed point of

novelty of a square cross section and the absence of a raised buffer pad on one side as “a fourth side without a pad.”⁴ *See Id.* at *6 (“Because the Swisa product does not include the point of novelty of the D’389 Patent -- a fourth side without a pad -- there is no infringement.”).⁵ This particular expression of the “point of novelty” resulted in a summary judgment of non-infringement even though the expression did not describe the overall visual “effect” and appearance of the patented design that distinguished it from the prior art (for example that the ‘389 Patent Design was square in cross section and the Nailco Patent was triangular in cross section).

⁴ Egyptian Goddess argued below that a “fourth side without a pad” cannot be a point of novelty by itself because a “fourth side without a pad” already existed in the Tammy Taylor prior art buffer. (JA82; JA103; JA120).

⁵ In some rare cases, a point of novelty can be relatively easy to identify. For example, in *Horwitt v. Longines Wittnauer Watch Co.*, *supra*, (cited by this Court directly after the *Sears* citation in *Litton Systems*), the patented design was a blank watch face with a single dot at the twelve o’clock position. The point of novelty was determined to be the single dot on the watch face (as compared against two prior art watches with blank faces). In such a rare case, it is tempting to express the infringement requirement that the accused design possess the same distinctive overall appearance that distinguishes the patented design from the prior art as a “point of novelty” test. It is tempting because such a “point of novelty” test is a quick and objective way to analyze whether infringement has occurred. Further, since a single possible point of novelty always creates the distinctive appearance from the prior art, the “point of novelty” test is easy to apply and provides the same result as the test which asks whether the accused design has the same distinctive overall appearance that distinguishes the patented design from the prior art. However, in the usual case when there are several possible points of novelty resulting from multiple design differences and multiple varied prior art designs, a separate “point of novelty” test quickly becomes difficult to apply and capricious in result for the reasons discussed in this brief. In such a situation, the *Gorham* and *Applied Arts* principles should be used not only because they are precedential, but because they offer a more complete and durable analysis that provides an objective and more predictable result.

When multiple points of novelty are available, the plaintiff patentee usually chooses one that is in the accused design,⁶ and the accused infringer usually chooses one that is not in accused design. Contrary to *Gorham*, there currently is no required consideration of the visual impact the chosen points of novelty have on the overall appearance of the design and the effect they have upon the eye of an ordinary observer. But even if this Court began to require such a consideration when choosing a “point of novelty”, the test still would be contrary to *Gorham* because the “controlling consideration” under *Gorham* is not individual design differences or combinations of design differences, but rather the resultant overall effect of the design upon the eye of an ordinary observer.

The second problem is that when the “novelty” (distinctiveness from the prior art) requirement is separated from the ordinary observer test, designs that are in the prior art or obvious over the prior art can satisfy the ordinary observer test. Although the separate “point of novelty” test prevents exact prior art designs from

⁶ This so-called “shopping list” approach has been condemned by district courts. See *Hosley Int'l Trading Corp. v. K Mart Corp.*, 237 F. Supp. 2d 907, 911-13 (N.D. Ill. 2002); *Bush Indus., Inc. v. O'Sullivan Indus., Inc.*, 772 F. Supp. 1442, 1452 (D. Del. 1991). This Court in *Egyptian Goddess* agreed with Swisa “that the point of novelty should be determined by comparing the claimed design to the prior art and not to the accused design.” 498 F.3d at 1357, n.1. This Court further stated that “[a]s an appellate court, however, we review the merits of the asserted point of novelty and not the motive behind its selection.” *Id.* The problem remains concerning which point of novelty to choose from when more than one has merit.

being captured under the infringement test,⁷ there is nothing to prevent designs obvious in light of the prior art from being considered infringements.⁸ The need to provide such protection may have motivated this Court to create the “non-trivial advance” test.⁹ However, the “non-trivial advance” test,¹⁰ having substantive similarities to an obviousness test, is not the proper solution for the reasons stated by Judge Dyk in his dissent. *See Egyptian Goddess, supra*, 498 F.3d at 1359.

⁷ An accused design that is an exact copy of a prior art design will not possess the “point of novelty” that distinguishes the patented design from the copied design.

⁸ Such a result can be prevented in utility patent cases through a hypothetical claim obviousness analysis. *See Key Mfg. Group, Inc. v. Microdot, Inc.*, 925 F.2d 1444, 1449 (Fed. Cir. 1991).

⁹ Another motivation may have been the instinctive and common sense desire to make the initial visual comparison between the patented and accused designs in relation to the prior art, a requirement that had been removed from the ordinary observer test after *Litton Systems*. Such a comparative instinct was demonstrated by expert witness Kathleen Eaton when she stated in her May 3, 2005 Declaration that “[i]n my opinion an ordinary observer and purchaser of nail buffers would consider that the patented design and the accused nail buffer have a substantially similar appearance in overall design, *particularly in light of other nail buffers*, such as a solid block buffer and the hollow triangular Nailco buffer.” (emphasis added) (JA335).

¹⁰ This Court cited *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893) as support for the “non-trivial advance” test. 498 F.3d at 1357. Following the case citation, this Court added the parenthetical “(analyzing whether the accused device contained the aspects of the claimed design that ‘rendered it patentable as a complete and integral whole’)”. *Id.* Egyptian Goddess respectfully submits that the quoted phrase from *Whitman Saddle* is better understood as the Supreme Court determining whether the accused saddle substantially appropriated the distinctive overall appearance of the patented saddle design that distinguished it from the prior art (and made it patentable). The Court did not just identify a “point of novelty” in the patented saddle design and then determine whether the identified point of novelty was in the accused saddle. Rather, the Court considered the novel aspect of the saddle design as being inseparable from “a complete and integral whole” for purposes of an infringement comparison with the accused saddle.

D. Proposed Solution to the Problems

To solve these problems, this Court should eliminate the separate and distinct point of novelty test and return the “novelty” (distinctiveness from the prior art) requirement to the ordinary observer test. The comparison between the patented and accused designs then will be made in relation to the prior art and the test for design patent infringement will be consistent with *Gorham*. Since under *Gorham* the accused design must substantially present the overall *appearance* (effect upon the eye of an ordinary observer) that distinguishes the patented design from the prior art, there is no need to identify a precise point of novelty and then determine whether the identified point of novelty is in the accused design.

Further, when the “novelty” requirement is returned to the ordinary observer test, the accused device also is compared to the prior art, which then eliminates the need for a requirement that the point of novelty be a non-obvious or “non-trivial” advance over the prior art. If the accused design contains a distinctive appearance substantially similar to that which distinguished the patented device from the prior art (and made it patentable), then the accused design also should constitute a non-trivial and non-obvious advance over the prior art.¹¹

¹¹ This should eliminate the need for the type of hypothetical claim obviousness analysis currently performed in utility patent cases to limit the range of equivalents.

II. Claim Construction

In *Gorham*, the Supreme Court explained that the “controlling consideration” was whether the “effect” of the designs was the same, *id.* at 525, 526, and the “main test of substantial identity of appearance” was considered to be “sameness of effect upon the eye.” *Id.* at 527. The 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.* at 526. This Court has stated that the scope of the claim of a patented design “encompasses ‘its visual appearance as a whole,’ and in particular ‘the visual impression it creates.’” *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104-05 (Fed. Cir. 1996)).

Since the controlling consideration is sameness of effect upon the eye, a court should not construe a design with words. Although a court should instruct a jury on *how* to make a comparison between the patented design and the prior art, a court should not tell a jury what it is seeing when the jury looks at the patented design, for the following reasons:

First, it is difficult to properly and precisely describe with words a design that consists of anything more than simple geometric shapes. Usually the scope of the description will be too broad, too narrow, or too ambiguous. When presented

with the same written description and asked to produce a drawing, ten people may produce ten different designs.

Second, when a drawing is described in words, the words have a tendency to make all portions of the drawing perceptively equivalent unless the words expressly increase or decrease the visually perceptive importance of a particular feature, i.e., by using adjectives and adverbs and by using descriptive terms such as major, minor, prominent, dominant, etc. If such words are not used, then it is virtually impossible for the court to express what the court believes is the visual “effect” of the design upon the eye of an ordinary observer.

However, when descriptive words are used to increase or decrease the visually perceptive importance of a particular design feature, the drawing then is not being merely observed by the jury, but rather is being observed by the jury *as the design has been interpreted and expressed in words by the court*. The problem with this is that a jury (after being properly instructed on the ordinary observer test) may or may not place the same perceptive emphasis on a design element as the court. It is the jury’s perception, and not the court’s, that is important on the factual infringement issue in a jury trial. Therefore, in general, patent design claim drawings¹² should not be expressed in writing by the court. Rather, after the

¹² The claim of a design patent usually is just the design drawings. *See* MPEP 1503.01 (“No description, other than a reference to the drawing, is ordinarily required.”). The MPEP further states that “[n]o description of the design in the

appropriate claimed drawing(s) have been identified by the Court (i.e., by explaining the effect of broken lines¹³ and by giving effect to any words used by the patentee), such patent design drawing(s) should be shown to the jury for a comparison with the accused design for the infringement or invalidity analysis.¹⁴

In *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) this Court stated that a court should construe a design drawing in words so “the parties and appellate courts can discern the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design.” *Durling* involved a bench trial on the invalidity issue of whether a primary reference existed in an obviousness analysis. Since *Durling* was a bench trial, the court’s claim construction had no effect on a jury. However,

specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. *In re Freeman*, 23 App. D.C. 226 (App. D.C. 1904).”

¹³ 37 CFR 1.152 provides that “[b]roken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that cannot be seen through opaque materials.”

¹⁴ Claim construction also has been used to eliminate aspects of the design considered functional and therefore not ornamental. See *OddzOn Prods. v. Just Toys*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”). The district court in the instant case stated in its claim construction order, that “[t]he Court must next consider whether any of the design features are functional.” (JA11). However, since under *Gorham* the overall visual effect of the design is to be considered when determining infringement, the overall visual effect is what must be non-functional (ornamental). See *Berry Sterling Corp. v. Prescor Plastics, Inc.*, 122 F.3d 1452, 1455 (Fed. Cir. 1997). If the overall design is found to be functional, however, then the issue is one of validity and not infringement.

even though a court should not construe a design with words for a jury, a court still can express the design or parts of the design in words to explain the court's own internal reasoning on issues of law involving the design. For example, although in *Gorham* there was no written "claim construction" of the patented design, the Supreme Court used words to describe the designs and the reasoning supporting its decision.

III. Infringement Analysis

Under *Gorham*, the ultimate infringement issue is whether in the eye of an ordinary observer, the appearance of the Swisa nail buffer is similar enough to the patented design to deceive such an observer, inducing him or her to purchase the Swisa buffer supposing it to be the patented design. The controlling consideration is whether the visual effect of the designs is substantially the same in the eye of an ordinary observer.

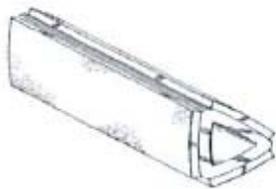
The comparison is to be made in light of the prior art, which means that to infringe, the Swisa buffer design has to present substantially the appearance that distinguishes the D'389 Patent design from the prior art. If the prior art is crowded with generally similar designs, then the ordinary observer may make a more discriminative examination and comparison of the Swisa and patented designs.

Each party should be allowed to argue the infringement issue as a factual matter. Egyptian Goddess will argue that the distinctive appearance of the D'389

Patent design in relation to the prior art is created by the hollow tube that is square in cross section and that has raised pads with exposed gaps at the corners.



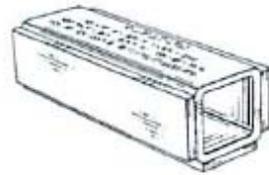
Falley Buffer Block



Nailco Patent



Swisa Buffer



'389 Patent

The hollowness and raised pads distinguish the D'389 Patent design's overall appearance and visual effect from the solid buffer pads with no raised pads and the square cross section distinguishes the D'389 Patent's overall appearance and visual effect from the Nailco Patent.¹⁵ Egyptian Goddess will argue that the Swisa nail buffer appropriates the distinctive overall appearance and visual effect of the D'389 Patent design because the Swisa buffer also has a hollow tube that is square in cross section and that has raised pads with exposed gaps at the corners.¹⁶

¹⁵ There should be no dispute concerning whether an ordinary observer should be generally familiar with the Falley block buffers and the Nailco buffer design because these buffers were being widely marketed and sold during the time of alleged infringement in this case. Whether an ordinary observer should be familiar with other prior art buffer designs should be a question of fact.

¹⁶ Kathleen Eaton, expert witness for Egyptian Goddess, supports this conclusion in her May 3, 2005 declaration by stating “[i]n my opinion, the substantially similar appearance in overall design results from both designs having a hollow tube, square in cross section and rectangular in length, with multiple raised rectangular pads mounted on the sides, and that do not cover the corners of the tube.” (JA335).

If appropriate,¹⁷ Egyptian Goddess will argue further that the Swisa buffer design does not differ from the D'389 Patent design more widely than the patented design differs from the prior art. While the hollowness, square cross section, and raised pads create an overall distinctive appearance that widely distinguishes the D'389 Patent design from the prior art, the only difference in the patented and accused designs is the addition of one buffer pad. Finally, Egyptian Goddess will argue that an ordinary observer is unlikely to focus on the addition of one buffer pad as a distinguishing characteristic because the prior art is not crowded with generally similar designs.¹⁸

¹⁷ *Gorham* did not mention the “practical test” for determining infringement. There appear to be different ways of expressing a test of this nature. For example, in *Applied Arts* the test was expressed once in terms of similarities and once in terms of differences. (Compare the statement “... it 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” with the statement “[t]here are *differences* of course in lines and curves between the outer configuration of the patented design and those noted in the prior art, but such *differences* are no greater than those that exist between the patented design and the alleged infringing designs.”). 67 F.2d at 430 (emphasis added). The issue is factual in nature and to the extent it is included in a jury instruction, it may be appropriate to make such a “practical test” a relevant infringement factor rather than a strict test. While Egyptian Goddess believes the practical test outcome is clear in this case, it may be closer in others.

¹⁸ The patented and accused designs have been pictured side by side in this brief for reader convenience. However, in *Gorham* the Supreme Court cautioned that the ordinary observer test is not a side by side comparison. 81 U.S. at 527.

Swisa likely will argue something contrary. The important point is that a genuine issue of material fact exists on the *Gorham* ordinary observer test and a jury should decide the issue after being properly charged by the court.

CONCLUSION AND RELIEF SOUGHT

The final judgment entered by the district court on July 6, 2006, which ordered that Egyptian Goddess take nothing by its claims for patent infringement against Swisa, dismissed those claims with prejudice, and taxed court costs in favor of Swisa and against Egyptian Goddess, should be reversed and remanded for trial. Egyptian Goddess respectfully requests that this Court apply the patent infringement principles as discussed above to the patented and accused designs and remand this case for trial with instructions consistent with the principles of law discussed herein.

Respectfully submitted this 25th day of January, 2008.

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ADDENDUM

<u>Item</u>	<u>Description</u>	<u>Page(s)</u>
1.	Final Judgment	JA1
2.	Summary Judgment Order	JA2-JA8
3.	Claim Construction Order	JA9-JA13
4.	Notice of Appeal	JA14-JA15
5.	United States Design Patent 467,389	JA16-JA19

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

EGYPTIAN GODDESS, INC.,

Plaintiff,

v.

SWISA, INC., *et al.*,

Defendants.

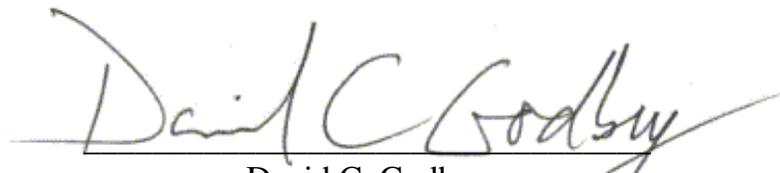
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Civil Action No. 3:03-CV-0594-N

FINAL JUDGMENT

By Order dated December 14, 2005, the Court granted Defendants Swisa, Inc. and Dror Swisa's (collectively, "Swisa") motion for summary judgment finding no infringement. By separate Order of this same date, the Court had determined to dismiss Swisa's declaratory judgment claims. It is, therefore, ordered that Plaintiff Egyptian Goddess, Inc.'s take nothing by its claims for patent infringement against Swisa and those claims are dismissed with prejudice. It is further ordered that Swisa's declaratory judgment claims against Egyptian Goddess, Inc. and Adi Turkiya are dismissed without prejudice. Costs of court are taxed in favor of Swisa and against Egyptian Goddess, Inc. All relief not expressly granted is denied. This is a final judgment.

SIGNED July 6, 2006.


David C. Godbey
United States District Judge

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

EGYPTIAN GODDESS, INC.,

Plaintiff,

v.

SWISA, INC., *et al.*,

Defendants.

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Civil Action No. 3:03-CV-0594-N

ORDER

Before the Court is the motion for summary judgment of Defendants Swisa, Inc. and Dror Swisa (collectively, “Swisa”) on Plaintiff Egyptian Goddess, Inc.’s (“EGI”) claims for infringement of United States Design Patent 467,389 (the “D’389 Patent”) for a nail buffer.¹ The Court holds that Swisa’s allegedly infringing product does not incorporate the point of novelty of the D’389 Patent – a fourth, bare side to the buffer. Accordingly, the Court grants Swisa’s motion without reaching its other noninfringement and obviousness arguments.

I. BACKGROUND

The designs at issue in this case involve simple geometric shapes – triangles, squares, rectangles, rounded corners. The D’389 Patent is for a fingernail buffer designed to hold

¹This being a device that polishes or buffs the surface of a person’s fingernail, e.g., in the course of a manicure.

buffing pads of different abrasiveness in a way that is easy for the manicurist to hold.² A page of the drawings from the D'389 Patent is attached as Exhibit "A."

In its Order of March 3, 2005 (the "Markman Order"), the Court construed the D'389 Patent as follows:

A hollow tubular frame of generally square cross section, where the square has sides of length S , the frame has a length of approximately $3S$, and the frame has a thickness of approximately $T = 0.1S$; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately $1.25T$, and the inner corner of the cross section rounded on a 90 degree radius of approximately $0.25T$; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.

Markman Order at 3. In deference to *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371 (Fed. Cir. 2004), the Court declined to address points of novelty in the course of claims construction, but noted the possibility that a court could in an appropriate case and appropriate record address points of novelty at summary judgment. Markman Order at 2 n.1. This now appears to be an appropriate case.

II. POINT OF NOVELTY

A plaintiff in a design patent infringement case must prove both that the accused device is "substantially similar" under the "ordinary observer" test, and that the accused device contains "substantially the same points of novelty that distinguished the patented design from the prior art." *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162

²This explanation is for background only; the Court is not importing functionality into its design patent analysis.

F.3d 1113, 1121-22 (Fed. Cir. 1998). “The points of novelty relate to differences from prior designs, and are usually determinable based on the prosecution history.” *Id.* at 1118. In the context of design patents, “[t]he scope of prior art is not the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of articles sufficiently similar that a person of ordinary skill would look to such articles for their designs.” *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997).³

Unsurprisingly, the parties disagree as to the points of novelty in the D’389 Patent. EGI identifies four design elements,⁴ and then for each element identifies prior art that does not embody that element. Based on this reasoning, EGI claims that the point of novelty of the D’389 Patent is the combination of those four elements. *See, e.g., L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993); *Rubbermaid Commercial Prods. v. Contico Int’l, Inc.*, 836 F. Supp. 1247, 1258-60 (W.D. Va. 1993). Swisa condemns this as an impermissible “shopping list approach.” *See, e.g., Bush Indus., Inc. v. O’Sullivan Indus., Inc.*, 772 F. Supp. 1422, 1452-54 (D. Del. 1991); *Int’l Trading Corp. v. K-Mart Corp.*, 237 F. Supp. 2d 907, 911-13 (N.D. Ill. 2002).

³*Hupp* used this scope for prior art in an obviousness analysis. Swisa suggests applying it in the points of novelty context also. The Court sees no reason not to follow *Hupp* in the points of novelty context. The fact that infringement is judged from the viewpoint of an ordinary observer intending to purchase the patented object suggests that the pertinent field is that of the patented object, rather than all design. Moreover, so limiting the scope of prior art favors EGI.

⁴The design elements were: (1) open and hollow body; (2) square cross section; (3) raised rectangular pads; and (4) exposed corners. *See* EGI Brief at 20-21.

The Court need not resolve the “combination vs. shopping list” dispute, because here a single prior reference combines all of EGI’s alleged design elements, save one. United States Design Patent No. 416,648 (the “Nailco Patent”) discloses a nail buffer with an open and hollow body, raised rectangular pads, and open corners. *See* Exhibit “B” (drawings from the Nailco Patent). EGI cannot claim the combination of those three elements in the D’389 Patent as novel when they were already combined in the Nailco Patent. The only point of novelty in the D’389 Patent over the Nailco Patent is the addition of the fourth side without a pad, thereby transforming the equilateral triangular cross-section into a square.⁵ In the context of nail buffers, a fourth side without a pad is not substantially the same as a fourth side with a pad. Because the Swisa product does not include the point of novelty of the D’389 Patent – a fourth side without a pad – there is no infringement. Accordingly, the Court grants Swisa’s motion for summary judgment.⁶

CONCLUSION

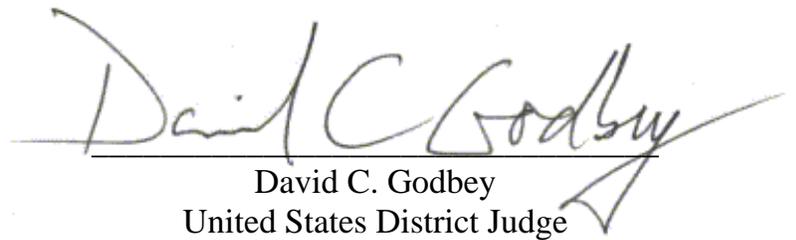
Swisa’s motion is not entirely clear which claims and causes of action it intends to address in its motion. EGI originally sued Swisa for infringement. Swisa asserted a reflexive counterclaim for declaratory judgment. Swisa then joined Torkiya as a third-party defendant

⁵Swisa appears to count this as two points of novelty (fourth bare side and square cross section), *see* Swisa Reply Brief at 11, apparently allowing for the possibility that the fourth side might be a different length or joined at other than a right angle. Because all of the prior art cited to the Court has involved regular polygons, the Court tends to discount that possibility. In any event, whether it is counted as one or two points of novelty is immaterial to the analysis.

⁶Given the Court’s finding of no infringement, it need not reach Swisa’s invalidity argument.

to its declaratory judgment claims. It appears to the Court that this ruling probably resolves all matters presently in dispute among the parties, but that may not be correct. Accordingly, the Court directs the parties to confer regarding the possibility of an agreed form of judgment consistent with this Order, and if agreement is not possible, to promptly place before the Court any other matters that must be resolved prior to entry of a final judgment.

SIGNED December 14, 2005.


David C. Godbey
United States District Judge

U.S. Patent

Dec. 17, 2002

Sheet 1 of 3

US D467,389 S

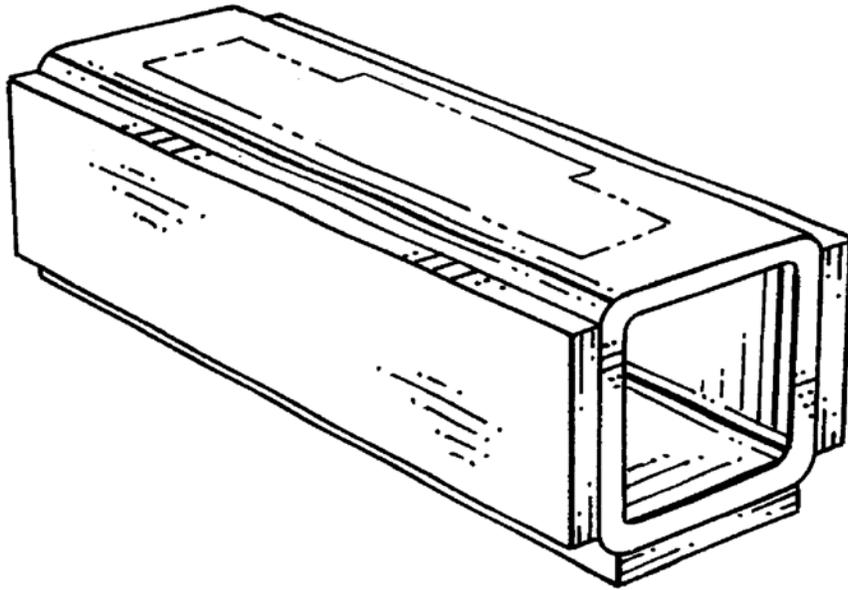


FIG. 1

Exhibit "A" – the D'389 Patent

U.S. Patent

Nov. 16, 1999

Sheet 1 of 2

Des. 416,648

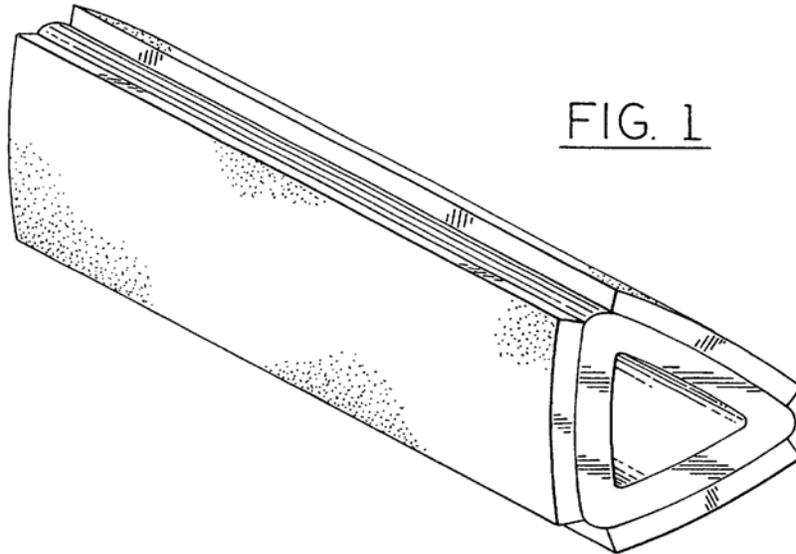


FIG. 1

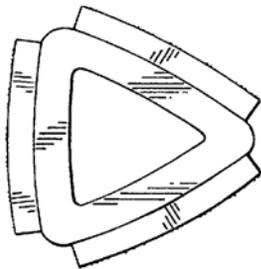


FIG. 2

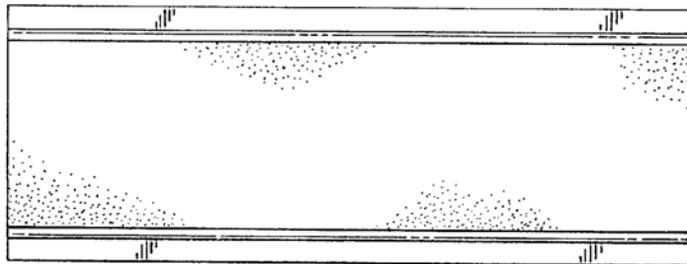
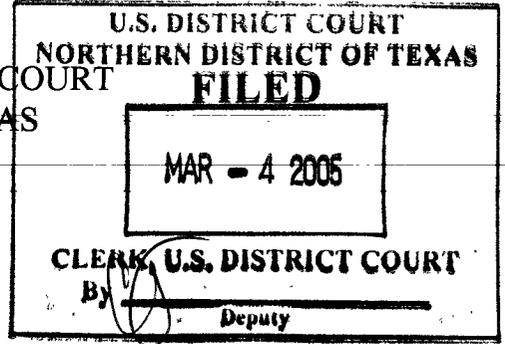


FIG. 3

Exhibit "B" – The Nailco Patent

ORIGINAL

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION



EGYPTIAN GODDESS, INC.,

Plaintiff,

v.

SWISA, INC., *et al.*,

Defendants.

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Civil Action No. 3:03-CV-0594-N

ORDER

Before the Court is Plaintiff Egyptian Goddess, Inc.’s (“EGI”) motion for claim construction, pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). The Court holds that points of novelty should not be addressed as a matter of law at the claim construction stage. The Court also holds that none of the salient design features of the nail buffer are functional. Finally, and perhaps most important, the Court construes the design at issue as having three sides with abrasive surfaces and a fourth side with no abrasive surface.

EGI is the holder of United States Design Patent D467,389 (the “Buffer Patent”). The Buffer Patent claims “[t]he ornamental design for a nail buffer, as shown and described.” A nail buffer apparently is an implement that a manicurist, for example, would utilize in giving a nail manicure to a customer. EGI claims in this action that Swisa, Inc. (“Swisa”) sells a product that infringes on the Buffer Patent. In the instant motion, the parties devote

the bulk of their briefing to points of novelty and functionality, with strangely little said about claim construction.

The point of novelty issue has been clarified by *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371 (Fed. Cir. 2004). As here, the parties in *Bernhardt* disagreed on whether points of novelty should be considered at claim construction or at infringement. “Finding that the points of novelty issue was a question for the fact finder, the [district] court postponed a determination of the points of novelty until trial.” *Id.* at 1375. The Federal Circuit did not expressly address this holding. However, it did address “the question, ‘What evidence must be presented to prove infringement under the point of novelty test?’” *Id.* at 1383. By framing the issue in that manner, the Federal Circuit was at least implicitly holding that the district court correctly determined that the point of novelty test was a question of fact for the fact finder when considering infringement, and not a matter to be addressed by the Court at claim construction. This Court will likewise decline to address points of novelty at claim construction. *Accord Lamps Plus, Inc. v. Dolan*, 2003 WL 22435702, *4 (N.D. Tex. 2003).¹

The Court must now construe the claim of the Buffer Patent. In doing this, the Court is guided by *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996):

In the design patent context, however, the judge’s explanation of the decision is more complicated because it involves an additional level of abstraction not required when comprehending the matter claimed in a utility

¹This holding does not mean that a court could not in an appropriate case determine points of novelty as a matter of law on an appropriate record at summary judgment.

patent. Unlike the readily available verbal description of the invention and of the prior art that exists in a utility patent case, a design patent case present the judge only with visual descriptions. Given the lack of a visual language, the trial court must first translate these visual descriptions into words – *i.e.*, into a common medium of communication.² From this translation, the parties and appellate courts can discern the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design.

²When properly done, this verbal description should evoke the visual image of the design.

Although *Durling* was not decided in the context of claim construction, many courts have applied its teaching to claim construction of design patents. *See, e.g., Lamps Plus, supra*, at *3; *Minka Lighting, Inc. v. Craftmade Int'l, Inc.*, 2001 WL 1012685, *20 (N.D. Tex. 2001); *Bernhardt L.L.C. v. Collezione Europa USA, Inc.*, 2003 WL 21254634, *1 (M.D.N.C. 2003), *rev'd on other grounds*, 386 F.3d 1371 (Fed. Cir. 2004). Accordingly, the Court will attempt to translate the visual descriptions of the drawings in the Buffer Patent into words that evoke the visual image of the design.

The Court construes the Buffer Patent as claiming:

A hollow tubular frame of generally square cross section, where the square has sides of length S , the frame has a length of approximately $3S$, and the frame has a thickness of approximately $T = 0.1S$; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately $1.25T$, and the inner corner of the cross section rounded on a 90 degree radius of approximately $0.25T$; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.

The Court must next consider whether any of the design features are functional.

We apply a stringent standard for invalidating a design patent on grounds of functionality: the design of a useful article is deemed functional where “the appearance of the claimed design is ‘dictated by’ the use or purpose of the article.” *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (citing *In re Carletti*, 328 F.2d 1020, 1022 (C.C.P.A. 1964)). “[T]he design must not be governed solely by function, i.e., that this is not the only possible form of the article that could perform its function.” *Seiko Epson Corp. v. Nu-Kote Int’l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999). “When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.” *L.A. Gear*, 988 F.2d at 1123 (citations omitted). That is, if other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional.

Rosco, Inc. v. Mirror Lite Co., 304 F.3d 1373, 1378 (Fed. Cir. 2002).

[T]he utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.

L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) (citations omitted).

Here Swisa has not shown that the appearance of the Buffer Patent is dictated by its utilitarian purpose. Swisa argues that the gap between the abrasive pads is required to prevent damage to the cuticle. But, Swisa has not made a satisfactory showing that damage would occur without the gap, or that the rounded radius providing the gap is the only way such a gap could be made, i.e., a flat side separating the pads would also provide a gap between the abrasive pads. Swisa argues that the hollow tube configuration is functional because it permits the manicurist to insert a finger in the buffer and control the buffer. But

Swisa has not shown that inserting a finger in the buffer is the only way to control the buffer, nor has it shown that other shapes could not provide the same result, i.e., a cylindrical hollow. Finally, Swisa has not shown that a four-sided block shape is required for a nail buffer. A variety of geometrical shapes could conceivably perform a similar function. Thus, the Court holds that the design of the Buffer Patent is not functional.

Based on the briefing, the Court has the impression that Swisa may view the Court's claim construction as dispositive of the merits of this case. Accordingly, the case is stayed for fourteen days to permit Swisa to file a motion for summary judgment on that basis, if it chooses to do so. If Swisa chooses to file such a motion, the case is stayed pending disposition of that motion.

SIGNED this 3 day of March, 2005.



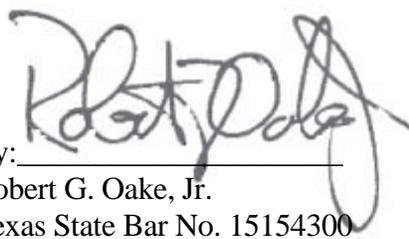
David C. Godbey
United States District Judge

d. Order signed March 3, 2005, filed March 4, 2005, and entered March 7, 2004 construing the patent at issue [Document 60].

4. Plaintiff Egyptian Goddess, Inc. also gives notice of intent to appeal all non-final orders and rulings which produced or are related to the judgment and orders specifically referred to in paragraph 3 above.

5. This appeal is taken to the United States Court of Appeals for the Federal Circuit.

Respectfully submitted,



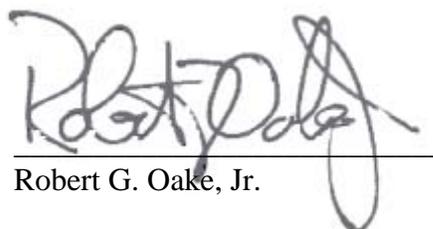
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Attorney for Plaintiff and Third-Party Defendant

CERTIFICATE OF SERVICE

I certify that on August 1, 2006, a true and correct copy of the foregoing was served under the Federal Rules of Civil Procedure and by agreement of the parties to the following:

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KIRKPATRICK & LOCKHART LLP
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Attorneys for Defendant



Robert G. Oake, Jr.



US00D467389S

(12) **United States Design Patent** (10) **Patent No.:** **US D467,389 S**
Torkiya (45) **Date of Patent:** **** Dec. 17, 2002**

(54) **NAIL BUFFER**
(76) Inventor: **Adi Torkiya**, 114 Oak Bend Dr.,
Coppell, TX (US) 75019
(**) Term: **14 Years**

5,177,909 A 1/1993 Klocke
D360,121 S 7/1995 Anderson
D369,438 S 4/1996 Resler
D406,394 S 3/1999 Mulaisho
5,899,210 A 5/1999 Letherby et al.
D416,648 S 11/1999 Letherby et al.
6,006,413 A 12/1999 Farley

(21) Appl. No.: **29/155,619**
(22) Filed: **Feb. 13, 2002**

* cited by examiner

Related U.S. Application Data

Primary Examiner—Ted Shooman
Assistant Examiner—C. Tuttle
(74) *Attorney, Agent, or Firm*—Gardere Wynne Sewell LLP

(62) Division of application No. 29/149,507, filed on Oct. 11,
2001, now Pat. No. Des. 459,548.
(51) **LOC (7) Cl.** **28-03**
(52) **U.S. Cl.** **D28/59**
(58) **Field of Search** D28/56, 57, 59;
D4/119, 121, 137; D8/90-94; D32/40, 52;
132/73, 73.5, 75, 75.6, 76.4, 76.5; 451/490,
522-525, 540, 552-558; 15/167.3

(57) **CLAIM**

The ornamental design for a nail buffer, as shown and described.

(56) **References Cited**

DESCRIPTION

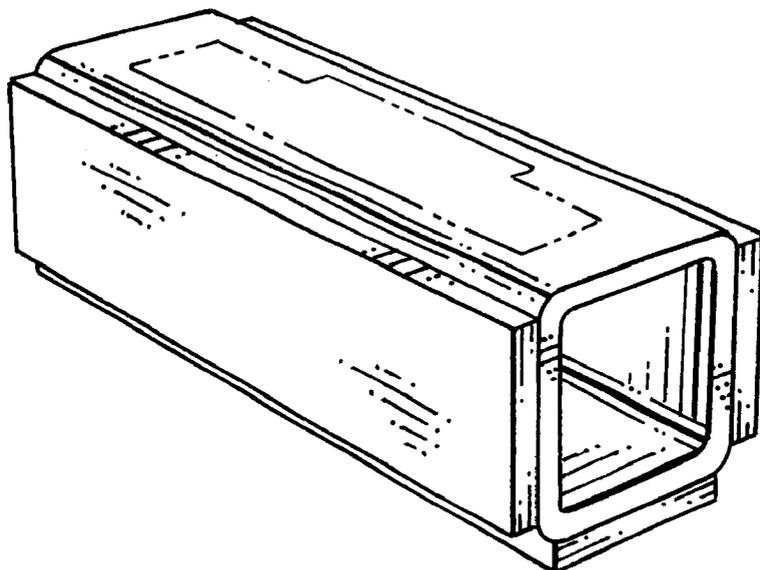
U.S. PATENT DOCUMENTS

651,479 A 6/1900 Essich et al.
965,444 A 7/1910 Dahl
1,072,046 A 9/1913 Seymoure
2,505,295 A * 4/1950 Meyers 401/205
2,557,175 A 6/1951 Cortes
2,838,057 A 6/1958 Smith
2,911,769 A * 11/1959 Trussell 451/503
D201,944 S 8/1965 Leopoldi
4,246,914 A 1/1981 Keyser
D260,356 S 8/1981 Hall
4,366,828 A * 1/1983 Hokama 132/75.6
4,757,571 A 7/1988 Young
4,785,586 A 11/1988 Kratfel
D328,847 S * 8/1992 Button et al. D8/93

FIG. 1 is a perspective view of a nail buffer in accordance with my invention;
FIG. 2 is a left side elevation view of the nail buffer shown in FIG. 1;
FIG. 3 is a right side elevation view of the nail buffer shown in FIG. 1;
FIG. 4 is a front elevation view of the nail buffer shown in FIG. 1;
FIG. 5 is a rear end elevation view of the nail buffer shown in FIG. 1;
FIG. 6 is a top plan view of the nail buffer shown in FIG. 1; and,
FIG. 7 is a bottom plan view of the nail buffer shown in FIG. 1.

The dashed outlines in the views of FIGS. 1 and 6 showing the location of indicia are for illustrative purposes only and form no part of the claimed design.

1 Claim, 3 Drawing Sheets



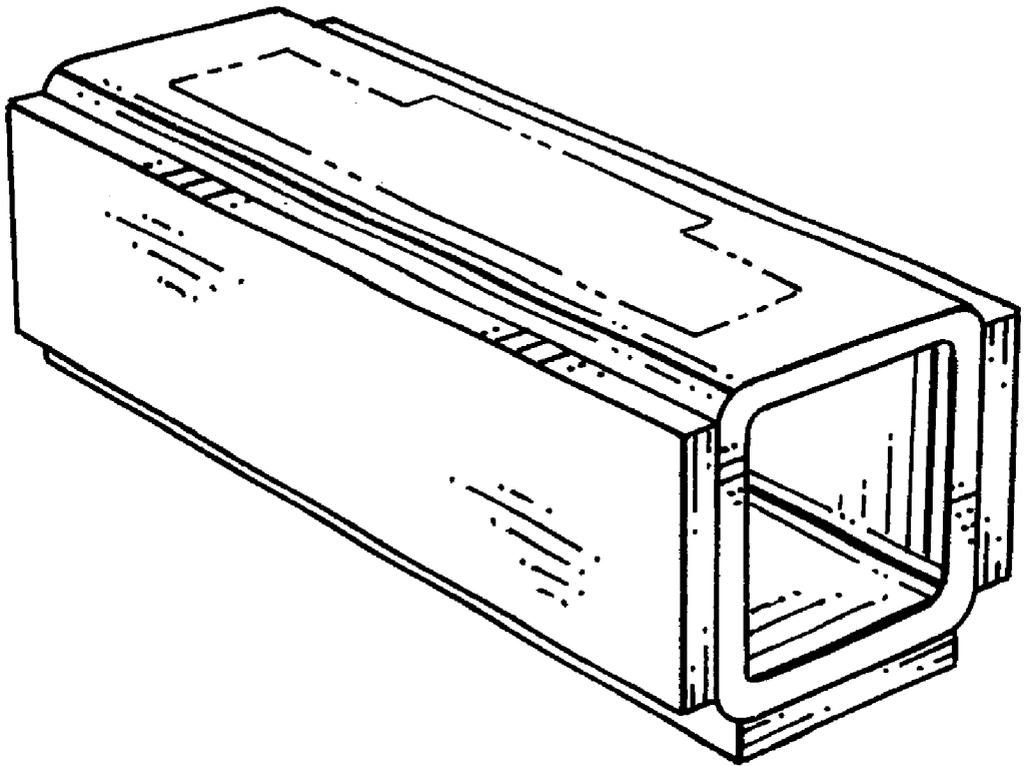


FIG. 1

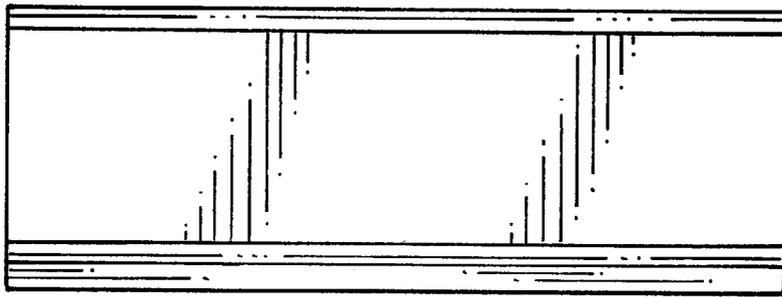


FIG. 2

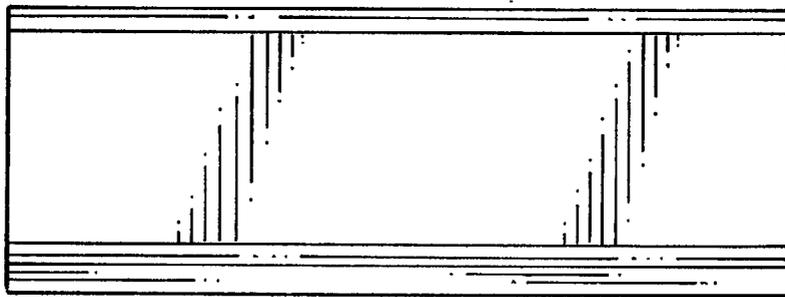


FIG. 3

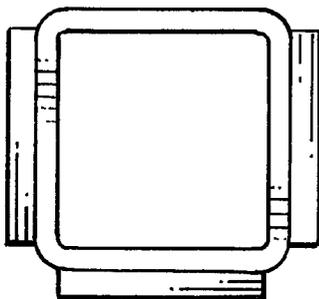


FIG. 4

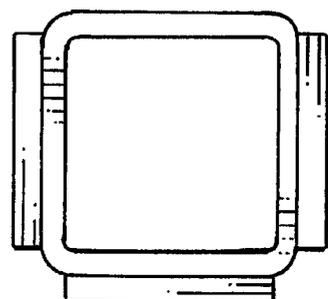


FIG. 5

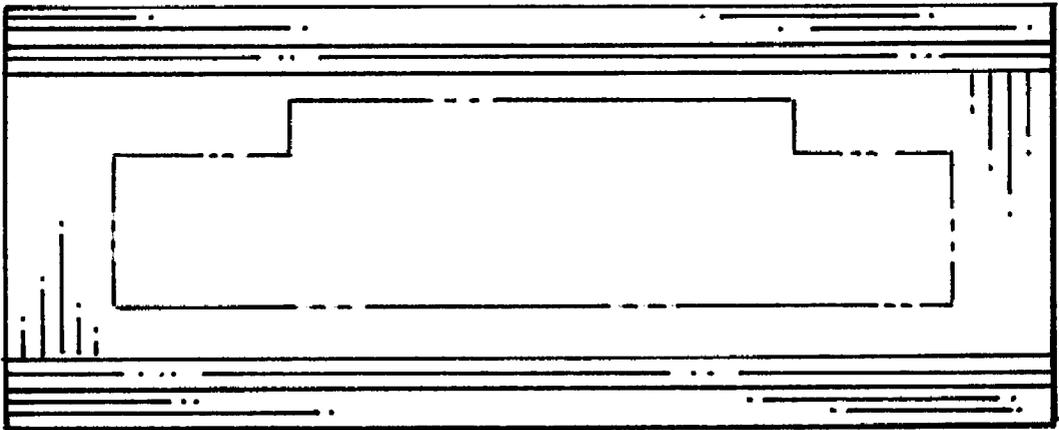


FIG. 6

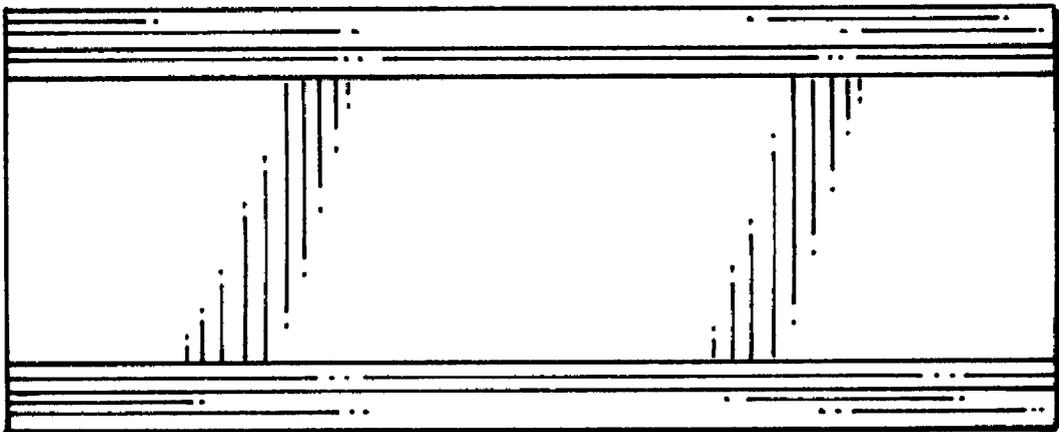


FIG. 7

CERTIFICATE OF SERVICE

Pursuant to this Court's order dated November 26, 2007, and pursuant to Fed. R. Civ. P. 25(d)(1)(B), I certify that on January 25, 2008, I caused 2 copies of the foregoing brief to be served via U.S. Mail on the attorney listed below:

Frederick L. Medlin
KIRKPATRICK & LOCKHART LLP
2828 North Harwood Street, Suite 1800
Dallas, Texas 75201

Attorneys for Swisa

I also certify pursuant to Fed. R. Civ. P. 25(d)(2) that on January 25, 2008, pursuant to this Court's order dated November 26, 2007, and pursuant to Fed. R. Civ. P. 25(a)(2)(B)(ii), I served upon the Clerk of this Court the original and thirty copies of the foregoing brief by dispatch to a third-party commercial carrier (Federal Express) for delivery to the Clerk of this Court within 3 calendar days (for Monday Morning delivery, January 28, 2008).

Robert G. Oake, Jr.
Attorney for Plaintiff-Appellant
January 25, 2008

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B). This brief contains 9,349 words, excluding the parts of the brief exempted by the Federal Rules of Appellate Procedure 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Federal Rules of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rules of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman font.

Robert G. Oake, Jr.
Attorney for Plaintiff-Appellant
January 25, 2008