

2006-1562

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

EGYPTIAN GODDESS, INC.,

Plaintiff-Appellant,

and

ADI TORKIYA,

Third Party Defendant-
Appellant,

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. 303-CV-0594-N
Judge David C. Godbey

**BRIEF OF AMICUS CURIAE
FEDERAL CIRCUIT BAR ASSOCIATION**

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CERTIFICATE OF INTEREST

In accordance with Fed. Cir. Rule. 47.4 and Fed. R. App. P. 26.1, counsel for the Federal Circuit Bar Association certifies the following:

1. The full name of every party represented by us is the Federal Circuit Bar Association.

2. The name of the real party in interest represented by us is the Federal Circuit Bar Association.

3. All parent corporations and any publicly held companies that own ten percent or more of the stock of the parties represented by us are:
None.

4. The names of the law firms and the partners that appeared for the party now represented by us and that are expected to appear in this Court are: Edward R. Reines, Weil, Gotshal & Manges, LLP, of the Federal Circuit Bar Association; Kevin T. Kramer of Pillsbury Winthrop Shaw Pittman, LLP; and, Mark P. Walters of Darby & Darby.

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STATEMENT OF INTEREST OF *AMICUS CURIAE*

The Federal Circuit Bar Association (“FCBA”) is a national bar organization with over 2,600 members from all geographic areas of the country, all of whom practice before or have an interest in the decisions of the Court of Appeals for the Federal Circuit. The FCBA offers a forum for discussion of common concerns between bar and Court, litigator and corporate counsel. One of the FCBA’s purposes is to render assistance to the Court in appropriate instances, both in procedural and substantive practice areas, whenever the FCBA or the Court believes a contribution can be made.

The FCBA submits this brief in response to the Court’s November 26, 2007 order for rehearing *en banc* of this appeal. This brief is being filed with the consent of the parties, and the FCBA takes no position with respect to the ultimate merits of this case. The FCBA only expresses views on Questions 2(a) and (3) of the Court’s order.

ARGUMENT

A split panel in this case affirmed the district court’s summary judgment grant of non-infringement. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354 (Fed. Cir. 2007). In affirming, the panel majority premised its decision on Egyptian’s failure to satisfy its burden under the “point of novelty” test for design patent infringement. The panel majority explained that for “a combination of individually known design elements to constitute a point of novelty, the combination must be a non-trivial advance over the prior art.” *Id.* at 1357. The panel majority concluded that Egyptian’s asserted point of novelty did not satisfy this “non-trivial advance” test, and, as a result, affirmed the district court’s judgment.

Question 2(a) of the Court’s *en banc* rehearing Order addresses the appropriateness of the “non-trivial advance” test. While the FCBA does not take a position on the appropriateness of the “point of novelty” test, the FCBA believes that the Court should *not* include the “non-trivial advance test” in any part of the design patent infringement analysis.

Question (3) addresses the role of claim construction in design patent infringement. The FCBA believes that the Court should continue to apply claim construction principles as part of the design patent infringement analysis. The claim construction analysis should remain focused on the

drawings in the patent, but all relevant evidence, such as for example, the prosecution history, should be considered.

I. THE COURT SHOULD NO LONGER EMPLOY THE NON-TRIVIAL ADVANCE TEST

Question 2(a) of the Court’s order granting *en banc* review asks whether, if the Court retains the point of novelty test, the Court should embrace the non-trivial advance test adopted by the panel majority in this case.

The FCBA respectfully answers this question in the negative because the test lacks support, conflicts with the presumption of validity, and needlessly complicates the design patent infringement inquiry beyond what is necessary to confirm that the accused device incorporates the patented design.

A. The Non-Trivial Advance Test Lacks Support and Conflicts with the Patent Act

The panel majority broke from precedent when it applied the non-trivial advance test for design patent infringement, a test that improperly conflates the issue of infringement with the issue of invalidity. As the dissent correctly stated: “It is one thing to suggest that a feature that renders a design nonobvious is also a point of novelty. It is quite another to hold

that a point of novelty cannot exist unless it would also render the design nonobvious.” *Id.* at 1360.

The root of the problem with the non-trivial advance test is that in addition to simply *identifying* a difference in the patented design over the prior art as is typically done in a point of novelty determination, this new test also requires substantive evaluation of the *quality and sufficiency* of that difference. For example, the majority states that “a combination with even the most trivial difference would meet the standard.” *Id.*, at 1357 n.2. Because a district court must evaluate what qualifies as “a trivial difference,” it would be inherently assessing the quality and sufficiency of that difference in the context of an infringement analysis.

The FCBA respectfully submits that this is the wrong focus. When analyzing infringement, a fact finder should focus on comparing the properly construed design claim to the accused device to assess whether the accused design is substantially similar to the patented design. To assess infringement, the fact finder *should not* be performing a substantive evaluation of the quality and sufficiency of the difference between the prior art and the claimed invention.

Further, the panel majority’s view that, in the design patent area, the infringement and validity analyses are “already” conflated does not justify

the non-trivial advance test. *Egyptian Goddess*, at 1358 n.3. Even if overlap between those analyses exists already, there is no good reason to intensify such overlap further with this unprecedented new test. Put simply, the patentee should not be required to substantiate the validity of the patent when assessing infringement. The infringement and validity inquiries should remain separate analyses keyed to separate legal issues. *See Lawman Armor Corp. v. Winner Int'l, LLC*, 437 F.3d 1383, 1385 (Fed. Cir. 2006) (“[w]hether there is any suggestion to combine prior art references may be relevant in a validity inquiry to determine obviousness ... it has no place in the infringement issue in this case.”).

Finally, the non-trivial advance test threatens to eliminate the statutory presumption of validity applicable to design patents under 35 U.S.C. § 282. This test would place the burden on the plaintiff to prove the quality and sufficiency of the differences between the claimed design and the prior art in order to prove infringement. Under such an analysis, a court may be tempted to hold the patent invalid because the plaintiff failed to prove a non-trivial advancement – improperly mixing the issues of invalidity and infringement.

B. The Non-Trivial Advance Test Needlessly Complicates the Infringement Inquiry

The non-trivial advance test has the potential to needlessly complicate the design patent infringement inquiry by focusing on the concepts of “triviality” and “advancement.”

A design patent may be issued for “any new, original and *ornamental* design for an article of manufacture.” 35 U.S.C. § 171 (emphasis added). Because design patents cover ornamental features, it is unclear as to what constitutes an “advance” in the context of design patent infringement. For example, if the article of manufacture is bathroom tissue, and the court is assessing whether an accused bathroom tissue incorporates the ornamental features of the claimed pattern shown in the asserted design patent, what qualifies as an advance? Does the change of positioning of the lines in the pattern qualify as an advance? Does a deletion of part of the line in the pattern qualify as an advance? The panel majority’s opinion provides no guidance on the very issues that would appear to be critical to assessing what constitutes an advance in any given case.

Further, the panel majority’s opinion gives no guidance on whose perspective should govern the question of “triviality.” It is unclear whether the non-trivial advance test is to be judged from the perspective of one having ordinary skill in the art or from some other perspective. *Compare In*

re Nalbandian, 661 F.2d 1214, 1216 (CCPA 1981) (a person having ordinary skill in the art under § 103 is a hypothetical “designer of ... articles of the types presented”) *with Gorham Co. v. White*, 81 U.S. 511 (1871) (for purposes of assessing infringement, the perspective is the ordinary purchaser of the articles at issue). Assessing triviality from the perspective of an ordinary designer would achieve the strange result of having to apply two different standards to assess design patent infringement – the ordinary purchaser standard under *Gorham* and the ordinary designer standard under *Egyptian Goddess*.

The design patent inquiry should avoid the application of different perspectives to assess infringement. If the point of novelty test survives, there is no need to complicate it by adopting the requirement for a non-trivial advance.

II. CLAIM CONSTRUCTION SHOULD CONTINUE TO APPLY, BUT SHOULD EMPHASIZE THE DRAWINGS

Question No. 3 of the Court’s order granting *en banc* review asks whether claim construction should apply to design patents, and, if so, what role should that construction play in the infringement analysis.

Section 289 of the Patent Act governs design patent infringement and provides that “[w]hoever during the term of a patent for a design, without license of the owner, (1) *applies the patented design, or any colorable*

imitation thereof, to any article of manufacture for the purpose of sale ... shall be liable to the owner to the extent of his total profit....” 35 U.S.C. § 289 (emphasis added). Accordingly, a design patent is infringed by the “unauthorized manufacture, use, or sale of the article *embodying the patented design* or any colorable imitation thereof.” *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1116-17 (Fed. Cir. 1998) (emphasis added). In order to determine whether the accused device embodies the patented design, a comparison must be made to assess whether the patented design as a whole is substantially similar in appearance to the accused design.

As with utility patents, claim construction is the first step in assessing design patent infringement. Although a claim construction exercise should primarily focus on the drawings, other relevant evidence should be considered so that the patent is given its proper scope when making a comparison to the accused device.

A. There are Good Reasons Why Claim Construction is Appropriate in the Context of Design Patents

As a threshold matter, there is no dispute that in assessing infringement of utility patents that construction of the claims is the first step in the exercise. *See, e.g., Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), *aff'd* 517 U.S. 370 (1996). There is no

reason to treat design patents differently. Certainly, neither the holdings of *Markman* nor this Court's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) is expressly limited to utility patents.

The Patent Act expressly requires that its provisions apply to patents for designs, except as otherwise specified. 35 U.S.C. § 171. The Patent Act does not except design patents from the requirement of having claims. Section 112, paragraph 2 applies equally to utility and design patents. 35 U.S.C. § 112, ¶ 2 (“specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention”). Because both utility and design patents are both subject to Section 112, it would be desirable to treat them uniformly. *See In re Zahn*, 617 F.2d 261, 265 n.3 (CCPA 1980) (holding the requirements of Section 112 applicable to designs); *Fitzgerald v. Arbib*, 268 F.2d 763, 768 (CCPA 1959)(Rich, J., concurring) (“it is desirable, simply for the sake of uniformity, to have the same rules ... with respect to all types of inventions obtaining protection under Title 35 of the United States Code”).

The difference between utility claims and design claims is that design claims are “in formal terms to the ornamental design for the article (specifying name) as shown or as shown and described.” 37 C.F.R.

§ 1.153(a). In both types of cases, however, the first question to answer in assessing infringement is what does the asserted claim cover. *See, e.g., Contessa Food Prods. Inc. v. Conagra Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002); *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997); *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

The very purpose behind the claim construction exercise is to define the metes and bounds of the patented design. *OddzOn Prods.*, 122 F.3d at 1405. In fact, the district court is charged with this exercise. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) (“construction of a patent, including terms of art within its claim, is exclusively within the province of the court”).

Even Appellant supports the notion that design claims have scope and meaning that need to be assessed as the first step in the infringement inquiry.

Appellant argues that:

after the appropriate claimed drawing(s) have been identified by the Court (*i.e., by explaining the effect of broken lines 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.

Appellant’s En Banc Brief at 32 (footnotes omitted; emphasis added). The FCBA submits that the exercise of “explaining the effect of broken lines and

giving effect to any words used by the patentee” are the very steps of claim construction. Claim construction requires the court to review the specification and prosecution history and determine the meaning and scope of the asserted claim. *See Phillips*, 415 F.3d at 1313. In design cases, the broken lines in the drawing are part of the specification, and the words used by the patentee may be part of the claim, specification, or prosecution history. The only way for the court to properly give effect to lines and words is to review the patent and prosecution history and instruct the jury on the proper scope of the claim as warranted.

Under the ordinary observer test established in *Gorham*, the district court must still focus the jury on the scope of the design patentee’s rights to ensure that the design patent at issue is infringed and not some other design patent. The need to construe the claim and compare the claim as properly construed to the accused design does not disappear simply because the ordinary observer test is used. *See, e.g., Gorham*, 81 U.S. at 531 (“the patent is to receive such a *construction*”) (emphasis added); *Contessa Food Prods.*, 282 F.3d at 1377 (assessing claim construction before reviewing the district court’s judgment of non-infringement under the ordinary observer test); *Elmer*, 67 F.3d at 1577-78 (assessing claim construction prior to affirming judgment of non-infringement under the ordinary observer test).

B. The Drawings Should be the Primary Claim Construction Tool for Design Patents

The FCBA recognizes the inherent tension created by the claim construction exercise in the context of design patents. As discussed, design patent claims are “in formal terms to the ornamental design for the article (specifying name) *as shown or as shown and described.*” 37 C.F.R. § 1.153(a) (emphasis added). The claimed design is then shown by solid lines in the drawings of the patent. *See* 37 C.F.R. § 1.152 (broken lines used only to show environment). Thus, in general, it is the drawings that define the design patent claim, and any claim construction should focus on the drawings. *Goodyear*, 162 F.3d at 1116.

Experience shows that it has often been difficult to accurately and easily reduce the features of design patent drawings to words which define the scope of the design patent claim. *See, e.g., Bernardo Footwear, L.L.C. v. Fortune Dynamics, Inc.*, 2007 WL 4561476, *2 (S.D. Tex. 2007) (setting forth detailed description of ornamental design for a thong sandal, including evaluation of broken line environment); *Durbin v. Kuryakyn Holdings Inc.*, 440 F. Supp.2d 921, 932 (W.D. Wis. 2006) (setting forth an elaborate and lengthy description of ornamental design for a motorcycle brake or clutch lever); *Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, 2002 WL 1331883, *3

(N.D. Tex. 2002) (setting forth a description of approximately 500 words for an ornamental design for a ceiling fan).

Because claim construction should focus on the drawings, requiring verbalization of the features of the drawings makes the exercise more complicated than it might otherwise have to be. *See, e.g., Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (“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 patent”). It may be easier in many cases to simply refer to the drawings than to require an elaborate description that does not necessarily clarify the task of comparing appearances in order to find infringement. In fact, the Manual of Patent Examining Procedure expressly recognizes that written descriptions in design patents are not necessary “since as a rule the illustration in the drawing views is its own best description.” Manual of Patent Examining Procedure (“MPEP”) § 1503.01, subsection II (8th ed., rev. 5, Aug. 2006).

Because the drawing is typically the best description of the claim and the best indicator of claim scope, claim construction does not necessarily require a Court to verbalize a drawing in construing the claims. Rather, claim construction should rely primarily on the drawings and need not

require a court to reduce the features of the design patent claim into words in all cases. Relying on the drawings to define claim scope avoids the possibility of a court incorrectly describing a feature of the patented design, confusing the jury, or wrongly limiting the claim to certain articles of manufacture. Depending upon the facts of the case, it may, however, be appropriate for a court to simply say that it has reviewed the intrinsic evidence of record and that the claim is as shown in the figures of the patent. The court may only need to instruct the jury to include all of the features shown in solid lines in the drawing when making a comparison to the accused product.

C. All Relevant Evidence Should be Considered

Although the FCBA believes that there should be no requirement that the ornamental features shown in the design claims be reduced to words in every case, a court should do so when necessary to clarify the scope of the design claim in view of the specification and prosecution history.

For example, if the patentee makes a characteristic feature statement that defines the claim scope then that must be taken into consideration during construction. *See* 37 C.F.R. § 1.154 (providing that the “feature description” may appear as part of the specification of a design patent); MPEP, § 1503.01, subsection II.(E) (it is permissible to include “[a]

‘characteristic features’ statement describing a particular feature of the design that is considered by applicant to be a feature of novelty or nonobviousness over the prior art”); *McGrady v. Aspenglas Corp.*, 487 F. Supp. 859 (S.D.N.Y. 1980) (limiting scope of design patent claim in view of adding characteristic features statement to overcome rejection during prosecution); *Ashley v. Weeks-Numan Co.*, 220 F. 899, 903 (2d. Cir. 1915) (concluding that the characteristic features statement entitled the patentee to “the protection of the court against the making and marketing inkstands which contain the dominant features of the design described in the specification”).

If the patentee makes statements to the PTO about the features of the design in order to get the patent issued, then those statements must also be taken into consideration during construction. The Patent Act requires the PTO to “cause an examination to be made of the application” and to provide the applicant notice of the reasons for any “rejection, or objection or requirement.” 35 U.S.C. §§ 131-32. The Patent Act also gives applicants the opportunity to persist in their claim for a patent and the ability to amend the application. 35 U.S.C. § 132. The Rules of Practice in Patent Cases (“the Rules”) provide applicants with the ability to file remarks arguing over a prior art rejection or requirement for patentability. *See* 37 C.F.R.

§§ 1.111-1.121. Design patent applicants also have the ability to “petition to make special” to advance examination of their applications out of turn. To obtain such special status, an applicant must submit a “detailed discussion of the references, which discussion points out ... how the claimed subject matter is patentable over the references.” MPEP, § 708.02, section VIII.(E). There is no dispute that the examination system provided for by the Patent Act and the Rules applies to design patents. 35 U.S.C. § 171; 37 C.F.R. § 1.151.

So long as the design patent system is based upon examination of applications, the prosecution history of a design patent application, if in evidence, must be reviewed to assess claim scope. In any given case, the patentee may have argued over a prior art reference or amended its claim in order to obtain the patent. When such instances arise, as for example in connection with a petition to make special, they impact the scope of a design patent claim and the district court must go through the exercise of assessing how and why. As this Court has previously indicated, what the patentee said to the PTO in order to get the patent allowed may be used to limit the scope of the claim, “making the claim scope narrower than it would otherwise be.” *Phillips*, 415 F.3d at 1317.

This practice of evaluating the prosecution history to assess claim scope in design cases is a good one because a design patentee, just like a utility patentee, cannot say one thing to get his or her patent issued and a contrary thing when asserting the patent. *See, e.g., Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996). To allow such conduct would be grossly unfair and contrary to the notice function of the prosecution history. *See, id.* As a result, the practice of evaluating the prosecution history has been routinely followed in design patent infringement cases. *See, e.g., Goodyear*, 162 F.3d at 1116 (construing claim scope in view of prosecution history of design patent at issue); *In re Plastics Research Corp. Litig.*, 63 USPQ2d. 1924, 1925-26 (E.D. Mich. 2002) (limiting design patent claim scope in view of prosecution history); *Victus Ltd. v. Collezione Europa U.S.A. Inc.*, 48 USPQ2d 1145, 1146-47 (M.D.N.C. 1998) (construing design patent claim in view of events occurring before the PTO).

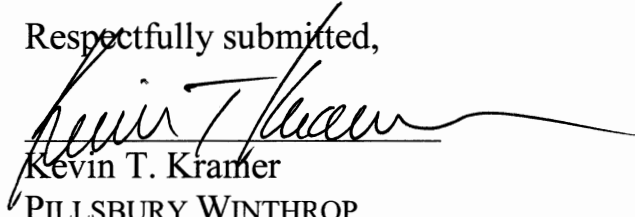
CONCLUSION

Because the non-trivial advance test has no support in the case law and needlessly complicates the infringement inquiry, the FCBA respectfully submits that the Court should reject that test as articulated by the panel majority in this case. The Court should continue to apply claim construction

principles to design patent infringement cases, but emphasize that not every claimed drawing needs to be verbalized.

Date: February 5, 2008

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of February 2008, one original and 30 copies of the foregoing **BRIEF OF *AMICUS CURIAE* FEDERAL CIRCUIT BAR ASSOCIATION** were hand filed with the Clerk of Court, U.S. Court of Appeals for the Federal Circuit, 717 Madison Place, NW, Room 401, Washington, DC 20439, and two copies of the foregoing brief were served by Federal Express Overnight Delivery on each of the following counsel of record for the parties:

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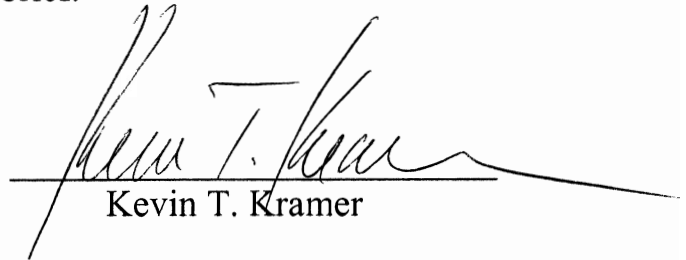
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CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing **BRIEF OF *AMICUS CURIAE***
FEDERAL CIRCUIT BAR ASSOCIATION complies with the type-
volume limitation of Fed. R. App. P. 29(d) and 32(a)(7)(B)(i), is
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Dated: February 5, 2008


Kevin T. Kramer