

2006-1562

United States Court of Appeals
for the
Federal Circuit

EGYPTIAN GODDESS, INC.,

Plaintiff-Appellant,

and

ADI TORKIYA

Third Party Defendant,

vs.

SWISA, INC. and DROR SWISA,

*Defendant/Third Party
Plaintiffs-Appellees.*

*Appeal from the United States District Court for the Northern District
of Texas in Case No. 3:03-CV-0594, Judge David C. Godbey*

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

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February 5, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Egyptian Goddess, Inc. v. Swisa, Inc.

No. 2006-1562

CERTIFICATE OF INTEREST

Counsel for the *Amicus Curiae* Intellectual Property Law Association of Chicago (“IPLAC”) certifies the following:

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

The Intellectual Property Law Association of Chicago

2. The name of the real party in interest represented by me is:

The Intellectual Property Law Association of Chicago

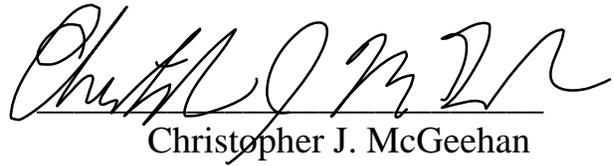
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

None

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

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RELEVANT STATUTES AND REGULATIONS

35 U.S.C. §171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. §289. Additional remedy for infringement of design patent

Whoever 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, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

37 C.F.R. §1.153

The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

37 C.F.R. § 1.154 Arrangement of application elements in a design application.

- (a) The elements of the design application, if applicable, should appear in the following order:**
- (1) Design application transmittal form.**
 - (2) Fee transmittal form.**
 - (3) Application data sheet (see § 1.76).**
 - (4) Specification.**
 - (5) Drawings or photographs.**
 - (6) Executed oath or declaration (see § 1.153(b)).**
- (b) The specification should include the following sections in order:**
- (1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.**
 - (2) Cross-reference to related applications (unless included in the application data sheet).**
 - (3) Statement regarding federally sponsored research or development.**
 - (4) Description of the figure or figures of the drawing.**
 - (5) Feature description.**
 - (6) A single claim.**

IDENTITY OF AMICUS, ITS INTEREST, AND AUTHORITY TO FILE

The Intellectual Property Law Association of Chicago (“IPLAC”) is the oldest bar association in the United States devoted exclusively to intellectual property law. With membership of nearly 1,000 lawyers, patent agents, law faculty, and others, it is one of the largest IP bars in the country. IPLAC regularly conducts seminars and symposia on significant developments in the law, provides continuing legal education, and sponsors scholarships to college. IPLAC’s interest in this matter is unrelated to any party.

The Litigation Committee of IPLAC has prepared an annual review of patent claim construction decisions of this Court since 2000. This review is now published annually by West Publishing as *Claim Construction in the Federal Circuit* (Manzo, editor) and is available as WESTLAW database CLAIMCFC. Further information about IPLAC is available at www.iplac.org.

All parties to this case have consented to the filing of IPLAC’s amicus brief under F.R.A.P. 29(a).

SUMMARY OF ARGUMENT

By statute and rule, the same law governing utility patents applies to utility patents with a number of express exceptions. However, under current precedent, different standards are applied to determine infringement of utility patents and design patents. For utility patents, the patent claims are construed and then the construed claims are compared to the infringing article. For design patent infringement, there are two tests: the ordinary observer test and the point of novelty test. The ordinary observer tests whether or not a consumer would find the two designs confusingly similar while the point of novelty test asks whether any similarity is caused by the appropriation of novel features unique to the patented design.

This current method of determining infringement for design patents is problematic as the relationship between claim construction and the two tests for infringement of design patents is unclear. Further, many aspects of the point of novelty test are still in dispute, including how to identify points of novelty and what can constitute a point of novelty. Additionally, the point of novelty test appears analagous to rejected utility patent doctrines such as the “essence of the invention” and the “practicing-the-prior-art” defenses. While the ordinary observer test corresponds to the application of a construed utility claim, there is no standard comparable to the point of novelty test for utility patents. Accordingly,

the point of novelty test should be eliminated as a separate test for design patent infringement.

The development of a separate point of novelty test appears to be a historic accident and now serves no purpose but to preserve a well-intended but doctrinally unsound deviation from patent law norms. Since most design patents are essentially improvement patents, the point of novelty test developed to protect accused infringers from design patent lawsuits caused by superficial similarities resulting from common prior art or functional features in the patented and accused designs. The courts that first referred to a “point of novelty test” articulated this standard as a clarification of the ordinary observer test, arguing that the ordinary observer would focus on the novel features of the patented design. However, the point of novelty standard has since evolved into a separate test. This transformation coincided with changes to format of design patent applications that diminished the ordinary observer test as a means for pretrial disposition.

However, the proper application of the Supreme Court’s *Markman* decision to design patents obviates the need for a separate point of novelty test and restores consistency between utility and design patent law. This approach also has the benefit of eliminating many of the problems surrounding the application of the point of novelty test. Accordingly, the district court should first construe the design patent claim in accordance with *Markman v. Westview Instruments*, 517

U.S. 370, 116 S.Ct. 1384 (1996) and then apply the ordinary observer test of *Gorham v. White*, 81 U.S. 511 (1871) using this construed claim. Further, the district court should allow for the application of the doctrine of equivalents, as the design patent law allows for a finding of infringement if the design is “confusingly similar” or a “colorable imitation,” serving the doctrine of equivalents’ purpose of preventing “fraud on the patent.”

ARGUMENT

I. THE POINT OF NOVELTY TEST SHOULD BE ELIMINATED AS A SEPARATE TEST FOR INFRINGEMENT

A. Standards for Design Patent Infringement

35 U.S.C. §171 provides that the provisions of Title 35 relating to patents for inventions shall apply to patents for designs, except as otherwise provided. Title 35 contains a number of express exceptions to the standard provisions governing utility patents for design patents: (1) the right of priority is limited to six rather than twelve months; 35 U.S.C. §172; (2) the term of a design patent is fourteen years; 35 U.S.C. §173; (3) maintenance fees do not need to be paid on design patents; 35 U.S.C. §41(b); and (4) the remedy of an accounting of profits is available for design patent infringement. 35 U.S.C. §289.² The Patent Rules provide an additional exception relating to the format of design patents. *See* 37 C.F.R. §1.153.

Although the standards for patentability are the same for design patents and utility patents, different standards for assessing infringement under 35 U.S.C. §271 have evolved over time for assessing infringement for utility patents and design patents. In utility patents, the standard is well established: the patent

² A complete list of the differences between utility and design patent practice can be found at M.P.E.P §1502.01.

claims are construed by the district court and the construed patent claims are then compared to the accused product by the trier of fact. In contrast, two distinct tests must be satisfied for design patent infringement to be found: the ordinary observer test and the point of novelty test.

The ordinary observer test was created by the Supreme Court in *Gorham Co. v. White*, 81 U.S. 511 (1871) . In that case, Gorham had obtained a patent on ornamental design for flatware in 1860. White obtained his own design patents on a similar design in 1867 and 1868. Gorham felt that White’s designs infringed his patent and filed suit. The Circuit Court found no infringement based on the testimony of experts in the silverware trade who noted fine distinctions between Gorham and White’s designs. The Supreme Court found infringement and reversed, holding that the proper standard involves determining the effect on an ordinary observer, namely, whether the accused design is so substantially the same in resemblance to the patented design that he is induced to purchase the (second) one, supposing it to be the (patented) one. *Id.* at 530-31. The Supreme Court noted that if the expert comparison standard was applied, “such a test would destroy all the protection which the act of Congress intended to give...there never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another -- so like that an expert could not distinguish them.” *Id.* at 527-28.

The point of novelty test was recognized by this Court in *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984). Under this test a design patent is not infringed unless the accused design appropriates the novelty that the patented design possesses over the prior art. *Id.* Numerous questions surround the application of point of novelty test including those noted by the Court in its order granting en banc review in this case. In particular, what features can serve as points of novelty and how are points of novelty to be identified remain unresolved questions almost a quarter century after *Litton*.

Further, it is not clear whether older decisions cited as the origin of the point of novelty test intended to create a new standard. Many of these decisions purport to be mere elucidations of the ordinary observer test. As a result, the point of novelty test may be the result of misunderstood prior precedent.

B. The Origins of the Point of Novelty Test

Litton cited two main Court of Appeals cases as precedent for the “point of novelty test”: *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944) and *Applied Arts Corp v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428 (6th Cir. 1933). Interestingly, *Litton* did not reference *Smith et al. v. Whitman Saddle Co.*, 148 U.S. 674, 13 S.Ct. 768 (1893), a Supreme Court decision that cited by the panel decision in this case as the first point of novelty case.

Smith is a design patent infringement case involving designs for saddles. By the late Nineteenth century saddle designs were a crowded art containing several hundred styles of saddles or saddletrees. The Supreme Court applied the design patent specification and held that while the patented design had an old “shape of the front end [and] the sharp drop of the pommel at the rear seems to constitute what was new and to be material.” 148 U.S. at 682, 13 S.Ct. at 771. The Court explained that if the accused design lacked the latter feature, there was no infringement. The Court also stated the “difference [between the patented design and the accused design] was so marked that in our judgment the defendant’s saddle could not be mistaken for the saddle of the complainant.” *Id.* The *Smith* Court followed the ordinary observer test framework, making it unclear whether the Supreme Court intended to create a new test for infringement or merely refine the ordinary observer test.

Applied Arts Corp v. Grand Rapids Metalcraft Corp., 67 F.2d 428 (6th Cir. 1933) expressly stated that it merely intended to refine who was the ordinary observer, and held that the “points of novelty” were merely features in the design that the ordinary observer would note in distinguishing between the patented design and the accused design. In particular, *Applied Arts* made clear that the ordinary observer was not a least sophisticated consumer or a person who had never seen the relevant products before. *Id.* at 429-31. Rather, the ordinary

observer was a person sufficiently familiar with the product designs that he would associate the novel features with the patented product.

Sears, Roebuck & Co. v. Talge, 140 F.2d 395 (8th Cir. 1944) involved juicers, a crowded art where much of the similarity between the two designs was the result of features common to all juicers. The Circuit Court noted that the patented juicer possessed a single line that appeared to separate it from the prior art, and that this line was absent from the accused product. *Id.* at 396-97. As a result, no infringement was found.

C. The Purpose of the Point of Novelty Test

Smith, Applied Arts and *Sears Roebuck* show that the point of novelty test began as a well-intended response to a recurrent problem in design patent litigation: how to quickly resolve cases where a similarity between the accused product and the patented design is not caused by the expropriation of the patented design by the accused product, but instead by the presence of features that are functional or found in the prior art.

No matter how dissimilar two designs may be, a court cannot grant summary judgment on the basis that the two designs do not look alike without articulating a factual basis for its ruling. Under the ordinary observer standard, this typically requires that the court explain (1) who is the ordinary observer; (2) how the ordinary observer perceives the patented and accused designs, and (2)

what differences the ordinary observer might notice between the two designs, if any. The point of novelty test substitutes a simpler analysis: (1) what features separate the patented design from the prior art and (2) are these features present in the accused design.

The problems applying the ordinary observer test were initially offset by early design patent practice. As can be seen in *Smith*, early design patents typically contained narrative specifications that served as *de facto* claims. If a feature recited in this description was missing from the accused product, courts had no difficulty finding noninfringement. Without such a narrative specification, it became increasingly difficult to prevail under ordinary observer test, as the two parties might simply file dueling affidavits attesting to the effect of the respective designs on the ordinary observer. However, as design patent practice changed and narrative claim descriptions disappeared, the point of novelty test became an increasingly favored method of disposing of design patent cases.

D. The Inconsistencies Between Utility and Design Patent Law created by the Point of Novelty Test

Although the point of novelty test is well-intended, it has the effect of creating an unnecessary divergence between design patent law and utility patent law. The first such problem is defining the points of novelty.

Utility patent claims are examined by the USPTO and frequently modified during the prosecution process before the patent issues. As a result issued patent claims have been examined for novelty and non-obviousness and approved by the USPTO.

In contrast, design patent claims do not change during prosecution since the drawings do not change and the claim language is standard. The applicant's representative may explain features in the drawings that the prior art lacks, or differences between the two, but in the end what emerges is a claim in a standard form preceded by a title, an identification of the several views, and the drawings so identified. 37 C.F.R. 1.154(a) An applicant is not required to point out or define points of novelty during prosecution although an applicant may 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." M.P.E.P. §1503.01 (II). Most applicants elect not to do so since the inclusion of a characteristic features statement creates an estoppel against the applicant. See *McGrady v. Aspenglas Corp.*, 487 F. Supp. 859 (S.D.N.Y. 1980).

Alternatively, an applicant may include a "descriptive statement" or narrative specification describing the invention. M.P.E.P §1503.01 Again most applicants do not provide characteristic feature statements or descriptive

statements either. Applicants typically only define and argue points of novelty in response to a rejection based on prior art.

A patentee should not have to identify novel aspects of the patent at the post-grant stage for the first time. Indeed this approach encourages the tired litigation tactic of arguing that the greatest points of visual similarity between the designs are the points of novelty and creates a likelihood that the points of novelty will vary depending on the accused product.

The second problem with this approach is that it conflicts with utility patent practice. In a utility case, the patentee is not required to provide an explanation of what portions of his claims are within the prior art and what represents his contributions. Prior art analyses are typically part of validity defenses under Section 102 and 103 of the Patent Act.

Indeed, the point of novelty test is essentially a Section 103 analysis, as the points of novelty are those features that are found in patented design that would not be found in a hypothetical combination of all relevant prior art. The panel decision in this case took the obviousness analysis one step further by importing Section 103's non-trivial difference standard into the determination of the points of novelty.

This Court has rejected similar attempts to transform validity defenses into infringement defenses, in particular in the “practicing the prior art cases.” *See*,

e.g., *Tate Access Floors v. Interface Architectural Resources, Inc.*, 279 F.3d 1357, 1365-69 (Fed. Cir. 2002). In these cases, the accused infringer unsuccessfully argues that it cannot infringe because it is “practicing the prior art,” and therefore the claim should be construed to exclude this “prior art” from the scope of the claims. *Id.* Similarly, this Court and its predecessors have rejected literal infringement standards based on whether the accused product appropriates the “essence” of the invention. See *e.g.* *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957 (Fed.Cir.1983) (rejecting the argument that the “essence” of the invention must be read into all the claims). Indeed, *Litton* itself cited a number of utility patent cases that rejected the point of novelty test in other contexts for the proposition that the point of novelty test should applied only to design patent infringement. 728 F.2d at 1444.

Preserving the points of novelty test will only prolong these doctrinal conflicts. Novelty means that which separates the patent from the prior art and is a statutory requirement under Section 102. It makes no sense for a design patentee to have the affirmative burden of proving that the patent is novel as part of the infringement analysis, especially when this Court has cautioned against combining validity and infringement analyses for utility patents.

IPLAC supports the holdings of the Supreme Court in *Gorham*, *Smith* and *Markman*. There can be no valid design patent without inventiveness (non-

obviousness) and novelty, and no design patent infringement without use of a competing design that has the same visual effect on the ordinary observer, or is perceived to be the same as the patented design by such ordinary. This is not to say that the concerns that the point of novelty was meant to address should be ignored. Points of novelty may well be subsumed within a correct *Markman* construction.

II. DESIGN PATENTS SHOULD BE SUBJECT TO *MARKMAN* CLAIM CONSTRUCTION

In a suit for design patent infringement, the trial court should construe the claim. Even prior to *Markman*, courts frequently applied analyses similar to claim construction to design patent infringement. In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384 (1996) , the Supreme Court held that patent claim interpretation is an issue of law. This basic rule of law is not affected by whether the claim is written in words or described in pictures. In interpreting the scope of a design patent, the trial judge should consider the features shown in the drawings and any prosecution history from these produce a clear claim construction for the jury and the parties. *See Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (“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.”)

This Court has long held that the requirement for claim construction extends to design patents. *Contessa Food Prods. v. ConAgra*, 282 F.3d 1370, 1376 (Fed. Cir. 2002); *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1574 (Fed. Cir. 1995). There is no sound basis for reconsidering these holdings. A proper claim construction will ensure that all features of the drawings are included, preventing the design patent from being construed too broadly. *See E.g., Durling v. Spectrum Furniture*, 101 F.3d at 104 (“the district court’s description merely represents the general concept of a sectional sofa with integrated end tables”); *Contessa Food Products, Inc. v. ConAgra, Inc.* 282 F.3d 1370, 1377 (Fed. Cir. 2002) (district court properly construed the scope of the claimed invention to be its overall ornamental visual impression rather than the broader general design concept).

The claim construction should embody these precepts and should be used in determining infringement. *Elmer*, 67 F.3d at 1577 (“Second, the claim as properly construed must be compared to the accused design to determine whether there has been infringement.”). Not only does a comprehensive claim construction assist the jury, but it is necessary for proper appellate review. *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (“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.”)

The same is true for functional features too. Infringement should not lie where primarily functional features are used. Protection for those falls in the realm of utility patents, not design patents. Design patents are not substitutes for utility patents. *Lee v. Dayton Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988) (“A device that copies the utilitarian or functional features of a patented design is not an infringement unless the ornamental aspects are also copied, such that the overall ‘resemblance is such as to deceive.’”) Further, design patent protection is not intended to be a substitute for utility model or petty patent protection available in foreign intellectual property systems. The trial judge must explain to the jury that the role of design patents in the intellectual property arena is to protect ornamentation.

This approach enables the accused infringer to use noninfringement or validity defenses depending on the claim construction, as is the case with utility patent construction. For example, if a feature in the construed patent claim is absent from the accused product, no infringement can be found. For example, the patents from *Smith*, *Applied Arts*, and *Sears* would be construed to require all features shown in the drawings. Since specific features identified in those

decisions would be part of the claim construction, these decisions would result in a finding of noninfringement without a point of novelty analysis.

Alternatively, if the accused infringer believes that the patentee has obtained broader claim scope than that to which he is entitled, the defendant may challenge the validity of the construed design patent claim as anticipated or obvious. While the presumption of validity applies, and a design patent is presumed to contain an original design (or portion) that is novel and non-obvious, the accused infringer is able to defend against infringement by showing that the alleged similarity is not due to the invented feature or combination of features but is due instead to features in the prior art, to purely functional features not subject to design patent protection, or a combination of the two.

Both the ordinary observer test and 35 U.S.C. §289 do not require identity between the patented design and the accused product, allowing for a finding of infringement in the case of a “confusing similarity” or “colorable imitation” between the two. Accordingly, it is proper for the trial court to inform the jury that a line-by-line or checklist approach is not the true test for infringement, and that the proper question concerns the effect of the invented design on the eye of the beholder. At the same time, however, it is critical that design patents not prolong patent protection on previously-invented or prior art designs. It is grossly

improper to allow infringement to be found where the patented design and the allegedly infringing design are similar merely where both use prior art features.

CONCLUSION

Accordingly, Amicus Curiae the Intellectual Property Law Association of Chicago respectfully suggests that this Court eliminate the point of novelty test as a separate requirement for a finding of infringement. Instead, a district court should first construe the design patent claim and then use this construed patent claim to apply the ordinary observer test.

Respectfully submitted,

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5 February 2008

**United States Court of Appeals
for the Federal Circuit**
Egyptian Goddess, Inc. v. Swisa Inc., No. 2006-1562

CERTIFICATE OF SERVICE

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

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February 5, 2008



CERTIFICATE OF COMPLIANCE

The undersigned certifies pursuant to FRAP 32(a)(7) that this brief uses 14 point Times New Roman font, double spaced except for footnotes and quoted text, and that according to the Microsoft WORD software on which this brief was prepared, it includes 3789 words, inclusive of footnotes but excluding any corporate disclosure statement, table of contents, table of citations, any addendum, and certificates of counsel.



Christopher J. McGeehan