

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 *AMICUS CURIAE* THE
INTELLECTUAL PROPERTY OWNERS ASSOCIATION
IN SUPPORT OF NEITHER PARTY

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The Intellectual Property Owners Association (“IPO”) submits this brief as an *amicus curiae* pursuant to Fed. R. App. P. 29(a), Rule 29(a) of this Court and the Court’s November 26, 2007 order setting the case for *en banc* rehearing. The parties have consented to the filing of this brief in support of neither party.

INTEREST OF *AMICUS CURIAE*

Amicus curiae IPO is a nonprofit, national organization of more than 140 large and midsize companies and more than 560 small businesses, universities, inventors, authors, executives, law firms and attorneys who are interested in patents, trademarks, copyrights and other intellectual property. Founded in 1972, IPO represents the interests of all owners of intellectual property. IPO members receive about thirty percent of the patents issued by the Patent and Trademark Office to U.S. nationals. IPO regularly represents the interests of its members before Congress and the PTO and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law. The members of IPO’s Board of Directors, which approved the filing of this brief, are listed in the Appendix.¹

¹ IPO procedures require approval of positions in briefs by a three-fourths majority of directors present and voting.

SUMMARY OF THE ARGUMENT

This case affords the Court an opportunity to clarify important issues with regard to design patents, issues that have either not been addressed or remain uncertain in today's body of patent law. IPO believes that current design patent law has become unnecessarily focused on verbalization of the scope of design patents – which are inherently represented in drawings, not words – as a result of osmosis of utility patent principles into the body of design patent law. This case affords the Court an opportunity to return design patent law to the fundamental principles articulated by the Supreme Court in *Gorham v. White*, 81 U.S. 511 (1872). This brief will address each of the questions posed by the Court in its *en banc* order and suggest positions that will, IPO believes, result in a body of law that is more consistent with the fundamental purpose of design patents than is the case today.

INTRODUCTORY STATEMENT

IPO believes there is substantial confusion in the law of design patents today about the way to construe such patents in litigation. IPO believes that this confusion has arisen because of inadequate attention on the part of lawyers and courts to the historic origins of design patent jurisprudence and the fundamental differences between utility and design patents. More specifically, IPO believes

that in the years since this Court and the Supreme Court's decisions in *Markman v. Westview Instruments*, 52 F. 3d 967 (Fed. Cir. 1995), *aff'd* 517 U.S. 370 (1996), an excessive tendency to verbalize the scope of design patents has led to a process in which litigants, courts and juries fail to focus attention on the design itself and instead treat a design patent as embodying something described in very specific and detailed verbal terms through a process of "construction" and explicit articulation of "points of novelty."

Design patents protect the "new, original and ornamental design" for an article of manufacture. 35 U.S.C. § 171 (2000). A design patent may include only one claim, which today is typically stated as "the ornamental design for (the article which embodies the design or to which it is applied) as shown" in the patent drawings. MPEP § 1503.02.

Although modern design patents do not contain a written description of the design protected by the patent, that has not always been the case. The relevant statutory provisions have not changed materially since 1836 when the first design patent statute was enacted, but the practice has changed considerably over the years. "[T]he uniform practice of the Patent Office and its rules, from 1836, the date of the enactment of the first statute providing for the grant of patents for designs, down to 1904, permitted and provided for a description of the design, and that for the most of the time down to at least 1897 the form of the claim

recommended included a description of the design, or of a portion thereof.” *In re Mygatt*, 26 App. D.C. 366, 370-71 (1905). In 1904, the PTO Rules of Practice provided that “[s]ince a design patent gives the patentee the exclusive right to make, use, and vend articles having the appearance of that disclosed, and since the appearance can be disclosed only by a picture of the article, the claim should be in the broadest form for the article as shown.” Rule 81, Rules of Practice in the United States Patent Office (Revised February 28, 1905). This rule was later challenged as prohibiting any written description of the design. That challenge was upheld on appeal and while descriptions were permitted, they were no longer mandatory. *In re Mygatt* at 3 (“It may be that it unnecessarily limits applicant’s monopoly.... A written description in accordance with the claim should be permitted”).

In *Gorham* the design patent in issue, D1440, contained the following verbal description of the patented design:

In figs. 1 and 2 of the accompanying drawings a. represents the stem of the handle either of a spoon or fork, and b. the enlarged end thereof. The stem is gradually but slightly increased in width from about the middle of the length towards each end, the swell being more sudden at c. where it joins the bowl or fork. At the rear extremity (*sic*) of the stem, where the enlarged part b. commences, it spread out on each side with a rounded shoulder d.d. and then gradually spreads out in concave lines, as at e.e., these lines gradually becoming convex to the widest part where they run back and inwards, as at f.f. finally uniting to form a nearly semi-circular end. Along each edge there is a small rounded moulding g.g. and just within this a second moulding

h.h. and at the shoulders d.d. these moldings that look like wires are united by two rosettes having somewhat the appearance produced by twisting together the ends of wires to unite them.

And at the rear end the two sets of mouldings from each side are turned into a rosette, the two rosettes as at i.i. coming in contact with the middle of the width of the handle, a small rounded tip j. making the central finish. Between the two inner mouldings the surface is swelled as at k. figs, 3 and 4, this swell being gradually flattened towards the widest part of the handle.

According to *Gorham*, a design patent is infringed “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.” *Gorham*, 81 U.S. at 528. The Supreme Court opinion contained drawings of the patented design as well as a verbal description that was essentially the same as the one contained in the patent itself. *Id.* at 520, 528. The opinion did not say that the verbal description came from the actual patent and thus a reader might well mistakenly believe the Court was “construing” the drawing to give it verbal content when in fact it was only reciting the description of the design as stated in the patent itself.

Modern design patents do not contain verbal descriptions of the design, but instead consist only of the figures with a simple statement that the patentee claims the design “as shown in the figures.” The Supreme Court has not itself addressed

the issue of the “construction” of a design patent that does not have any narrative description.

Design patents are different from utility patents in several important ways. Most importantly, design patents have a single claim which refers to the drawings. There is no description of the design. Indeed, it is impossible to accurately cast in words the visual impression of a design. If a picture is worth a thousand words, a description of a design might be crafted using a thousand words. However, the verbalized design would never be infringed – except in rare cases of exact copying – if the interpretation of the claimed design required an infringer to have each and every feature of the design because no infringing design is exactly like the design patent drawings. In fact, the two-dimensional design patent drawings are rarely exactly like the actual three-dimensional article they represent, given the inherent limitations of two-dimensional representations.

Because design patents rely exclusively on the drawings, they differ dramatically from utility patents. While a utility patent claims the “metes and bounds” of the patent protection sought through the words of the claims, a design patent claims the “center” of the protection sought. The maximum scope of a design patent is set forth in *Gorham*. In *Gorham*, the scope of protection extends to all designs which have the same effect on the eye of an ordinary observer as the patented design does. *Gorham* holds that comparison is to be made between the

patented design and the accused infringing product by an ordinary observer and not by an expert. In doing so, according to *Gorham*, the observer must focus on “the true test of identity of design. Plainly it must be sameness of appearance, and . . . slight variations in configuration [of the accused design] . . . will not destroy the substantial identity.” *Gorham* at 526-27.

If one compares this process of determining infringement of a design patent with terminology employed in utility patent litigation, it is readily seen that there cannot be any “literal” infringement of a design patent except in rare cases of exact copying. Almost all litigated cases involve “look-alike” products that embody the patented design with a number of insubstantial changes. In such cases the conclusion of infringement is much more akin to application of the doctrine of equivalents in utility patent litigation than it is to literal infringement. Yet judicial opinions and academic writings do not make note of this reality. The absence of that recognition may explain, in part, why there has been so much attention in recent litigation to setting out detailed verbal descriptions of the patented design. That process is common in utility patent litigation where the words of the claims often have to be construed in light of the intrinsic evidence to produce a claim construction that can be used in the specific litigation to give more precise meaning to the patent – that is, the “*Markman* Process.” The *Markman* process is appropriate for determining literal infringement of utility claims. But courts do not

undertake any similar detailed verbalization when it comes to infringement under the doctrine of equivalents. Juries routinely determine DOE infringement by a simple instruction that refers to “insubstantial” variations from the literal claims.

Despite the simplicity of the *Gorham* test, courts since at least as early as 1902 have consistently supplemented the *Gorham* test with a judicial interpretation of design patents that ensures the scope of the patent does not cover the prior art. In *Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co.*, 114 F. 362 (C.C. Conn. 1902), the trial court, sitting in equity, was asked to determine whether certain bells infringed a design patent. The defendants contended that the patent was invalid because the design lacked “patentable novelty.” Recognizing that the ultimate test of infringement was *Gorham*’s test of “identity [in] the eye of the ordinary observer,” 114 F. at 363, the trial court went on to observe that when it came to deciding the validity of the patent, “[t]he fundamental question is whether the inventive faculty has been exercised to produce anything that is original” *Id.* The court cited *Gorham* and the 1891 decision of another circuit court in *Cahoone Barnet Mfg. Co. v. Rubber & Celluloid Harness Co.*, 45 F. 582 (C.C.N.J. 1891). It is important to note that the court was not deciding an issue of infringement, but whether the design was “new and original” – an issue of validity.

This test was adopted by the earlier trial and appellate courts to insure that what infringes a design patent includes at least the essence of what made it

patentable. Over the years this test became one of ascertaining the “points of novelty.” While it was originally used in the context of determining the *validity* of the patent, it has evolved into being a part of a recognized “two-step” infringement determination.

The 1933 decision in *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428 (6th Cir. 1933), well illustrates this transition. The district court had found infringement of a design patent, but had seemingly rested its decision entirely on whether the allegedly infringing product met the *Gorham* test for substantial resemblance, without any consideration of what was in the prior art. Citing, among other cases, the 1902 *Bevin Bros.* decision, the Sixth Circuit stated that “on the issue of infringement a design patent is not infringed by anything that does not present the appearance which distinguishes the design claimed in the patent from the prior art.” 67 F.2d at 429. The court went on to discuss the design patent and the prior art. In doing so it articulated the “scope” of the patented design:

[Two prior patents] both disclose a backplate, the upper portion of which is comparatively wide and has attached thereto a receptacle for ashes, and the lower portion of which is narrowed by curving side edges to a circular downward extension accommodating a cylindrical forwarding extending lighter. 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. *Conceding validity to the patent*, it is quite clear it is entitled

to a very limited interpretation, and that so limited the defendant's designs do not infringe. The ash tray of the patented design is semi-cylindrical, that of the defendant's first structure is semi-octagonal, and that of its second is a combination of three connected arcuate portions. The defendant's devices are ornamented with fluted or beveled designs not at all found in the drawings of the patent, and the narrowing of the backplate to accommodate the lighter is accomplished by downward and outward curves, rather than by the downward and inner curves of the patent. There are also other differences in detail not necessary to note. 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.

67 F.2d at 430. (Emphasis added.)

While the word “novelty” was not used in the *Applied Arts* decision, the Eighth Circuit in citing to *Applied Arts* for the test for infringement, referred to the need for the accused design to “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). This Court adopted – without significant discussion – this same “point of novelty” language when it first adopted the principle in *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984). Thus the transition was completed and the “points of novelty” issue became part of the

well-established two-part test for design patent infringement that was described in the panel decision in this case.²

The Supreme Court has not questioned the validity of this test over the many years of its established use. In recent years, however, this old precedent has become bound up with the debate over the respective roles of the judge and jury – a debate that is perhaps more significant in utility patents containing technical words in need of interpretation. Borrowing from precedent related to utility patents, the courts have used the established two-part infringement test for designs to set up a formal process of verbalizing specific design features and points of novelty. This trend may have the unintended effect of undermining the scope of design patents as articulated in *Gorham*. This Court has been less than clear on how the test actually relates to design patents and the respective roles of judge and jury. Part of the confusion may be attributable to the fact that all the early design patent infringement cases were tried to the court, sitting in equity, because the early law did not provide for damages in design patent infringement.³ In that legal

² This history helps explain the accuracy of Judge Moore’s observation that “design patent law has already intertwined the infringement and validity tests.” Vacated majority opinion at n. 3, slip opinion at 5.

³ Prior to 1887 “the design patent laws provide[d] no effectual money recovery for infringement.” H.R. Rep. No. 1966 at 1 (1886), reprinted in 18 Cong. Rec. 824 (1877). That situation resulted from application of the “rule of apportionment” that required the plaintiff to prove what portion of the infringer’s profits was

environment it was not necessary to draw fine distinctions between issues of law and issues of fact, or the respective role of judges and juries.

The situation today is markedly different. Design patent cases are often tried to juries, the role of the court in construing the scope of utility patents has become established as part of the *Markman* process, but the precise role of “points of novelty” in design patent litigation has yet to be delineated in any authoritative opinion of this Court. Thus, it is a good time for the Federal Circuit to revisit design jurisprudence and carefully enunciate the test for design infringement in a way that does not unnecessarily entwine it with doctrines developed in utility patent cases. This case presents the appropriate opportunity for that long-overdue clarification.

attributable to the design rather than to other features of the product. *See Dobson v. Hartford Carpet Co*, 114 U.S. 439 (1885) and *Dobson v. Dornan*, 118 U.S. 10 (1886); *see also Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437 (Fed. Cir. 1998)(discussing the change when Congress passed the Act of 1887, 24. Stat. 387, which provided for an effective damage remedy in design patent cases).

ARGUMENT

I. Question 1: Should “point of novelty” be a test for infringement of a design patent?

At least as far back as 1902, appellate courts have recognized that the “substantially the same” analysis of *Gorham* and other cases “is to be judged by the scope of the patent in relation to the prior art.” *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933) (citing prior cases as early as 1891). That is because a design patent should not be infringed by any design that does not “present the appearance which distinguishes the design claimed in the patent from the prior art.” *Id.* Otherwise, the patentee would be able to recover for ornamentation that is not “new and original.”

The “point of novelty” test is a well intentioned test which appears to be designed to protect an accused infringer when the allegedly infringing product has the same overall appearance as both the design patent *and* the prior art. Unfortunately, a “point of novelty” test for infringement could permit an accused infringer to appropriate a design that is substantially the same as the patented design and avoid infringement. Specifically, the “point of novelty” test is currently applied in every design case. Thus even for a design patent that is far removed

from any prior art and thus is essentially totally “new and original,” the court nonetheless articulates the numerous “points of novelty” that set the patented design apart from the far distant prior art. The more novel the design, the more points of novelty. The more points of novelty, the more points of novelty that are invariably missing from the accused device. Thus, the court in applying the points of novelty test will make a scorecard and methodically record which novel elements are present and which are not. Ultimately, the analysis can devolve into a mere tally of novel elements, forgetting that the test set forth in *Gorham* was fully met and that the prior art is not remotely close to the patented design.

While consideration of the prior art in determining the scope of the patent has been a part of design patent jurisprudence for more than a century, a detailed point by point verbalization is more recent. Such explicit verbalization tends to unnecessarily narrow the scope of the patent, and create ambiguity and disputes among the parties over the meaning of words that are not present in the patent itself.

As with utility cases, the scope of a claim is to be determined by the court. The scope of the design patent claim should encompass **all** designs which have the sameness of effect on the eye of an ordinary observer as the design patent drawings *unless*:

- There is something in the prosecution history of the design which would suggest that the patentee has given up something in prosecution. That is, a design patentee cannot recapture property given up during prosecution ;
or
- The court determines that the design patent is protecting either a nuanced or improved design. In such a case, the infringing device may have the same overall appearance as both the design patent and the prior art. Only if the court makes a determination that the overall appearance of an accused product is the same as both the prior art and the patent should the court determine the features which allowed the patent in suit to be patentable. The reasons for patentability can be a single design element, a combination of elements or multiple elements. Once the reasons for patentability are determined by the court, infringement can only be found if the accused design is substantially similar in overall appearance and one or more of the identified features are found in the accused design. In a jury case, the jury should be so instructed with regard to the identified features.

As discussed above, the test for patent infringement of a design patent is analogous to the test for infringement of a utility patent under the doctrine of

equivalents. In a utility patent, the scope of a patent is expanded beyond the scope of the literal language of the claims. However, the doctrine is tempered by other principles such as recapture. In the same way, a design must be given the full scope recognized in the *Gorham* case unless that design is so close to the prior art that an accused infringer could have the same appearance as both the design and the prior art.

II. Question 2:

This question raises five separate sub-questions that will be addressed in the order presented in the Court's November 26, 2007 order.

A. Should the Court adopt the non-trivial advance test adopted by the panel majority in this case?

If the court maintains the point of novelty test or something like it, it should not adopt the non-trivial advance test adopted by the panel majority in this case. It should not matter if the differences between the patented design and the accused design are trivial or not because triviality is the standard for determining obviousness under 35 U.S.C. § 103, and the burden of proving invalidity is on the defendant, not on the patentee. Thus, requiring the patentee to show that the patented design has non-trivial points of novelty, as was done in the panel's

majority opinion in this case, should not be sustained. IPO submits that Judge Dyk correctly analyzed this issue in his dissent.

B. Should the point of novelty test be part of the patentee's burden on infringement or should it be an available defense?

IPO submits that the primary issue in all design patent cases should be the determination of “substantial similarity” using the well-established *Gorham* standard. That determination of infringement will be made by the jury, if one has been requested, guided by the accepted standard instructions. Any analysis under any variation of the “points of novelty” approach becomes necessary only if the accused design infringes under the *Gorham* test, and should be limited to only those cases where, as discussed above, the rule against recapture applies, or the design patent is protecting a nuanced or improvement design.

IPO believes, for the reasons stated in its Introductory Statement, that the proper role for any “points of novelty” analysis is as part of a challenge to the validity of a design patent and not as part of a determination of infringement under *Gorham*. Because of this conclusion, IPO submits that the test should be available as a defense of invalidity, assuming infringement has been found under *Gorham*. Of course if the trial court determines that no reasonable jury could find substantial similarity between the patented design and the accused design, it should ordinarily

grant summary judgment of non-infringement or a Judgment of non-infringement as a Matter of Law after a jury verdict of infringement.

C. Should a design patentee be permitted to divide closely related or ornamentally integrated features of the patented design to match features contained in an accused design?

The valid scope of a patented design that is entirely “new and original” will, as noted earlier, be very broad and will of necessity include many individual “points of novelty.” This condition will exist regardless of whether those numerous novel elements are “closely related” or “ornamentally integrated.” If the fact-finder determines as an initial matter that the challenged design infringes under the *Gorham* test and if the accused infringer contends that the design patent is invalid under prior art, then the patentee should be able to respond to that challenge by identifying all of the features of the challenged design that are present in the patented design but not in the prior art. In effect the patentee should be permitted to “match” the new and original features of the patented design to the challenged design, regardless of whether that process is seen as being a “shopping list” approach.

D. Should it be permissible to find more than one “point of novelty” in a patented design?

Yes. While some patented designs may present only a single difference, most designs will include multiple differences from the prior art. There is no rational reason for restricting the patentee to arguing a single “point of novelty,” unless the patentee believes, as it appears to believe in this case, that each and every element of its design is in the prior art and that the only valid scope of the patent is in the total combination, in which case there truly is only a “single point of novelty” encompassed in the totality of all design elements.

E. Should the overall appearance of a design be permitted to be a point of novelty?

Yes.

III. Question 3: Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis?

In 1995, the Federal Circuit, sitting *en banc*, determined that claim construction of a utility patent is a purely legal issue and is to be reviewed *de novo* on appeal. *Markman v. Westview Instruments, Inc.*, 52 F.3d at 979. The Supreme Court affirmed that decision but significantly pointed out that the allocation was not the result of any distinction between issues of fact and issues of law, but was

based on the historical allocation of functions between judges and juries. That decision was based in part on the reasoning that “[j]udges ... are the better suited to find the acquired meaning of patent terms.” *Markman* 517 U.S. at 388. Because design patents consist of drawings and not words and because the touchstone, according to *Gorham*, is what the design appears to be in the eye of the ordinary person, “the court's experience with 'document construction' and 'standard construction rules' regarding terms contained in a document, are not of help in the design patent context.” *Black & Decker (U.S.) Inc. v. Pro-Tech Power, Inc.*, 1998 U.S. Dist. LEXIS 9162, *10 47 USPQ2d (BNA) 1843 (E.D. Va. 1998).

Cases since *Markman* have produced a wide range of differing approaches to claim construction as it applies to design patents. At one end of the spectrum there are cases like Judge Cacheris' decision in *Black & Decker*, where he declined the defendants' invitation to adopt a lengthy highly verbalized claim construction and instead adopted a “*Gorhamesque* position that the proper claim construction was the “overall ornamental visual impression’ as shown in the six orthogonal drawings” in the patent and that the claim had to be “interpreted by viewing the claimed design in its entirety.” *Id.* slip op. at 17. At the other end of the spectrum is the claim construction in this case, a highly detailed and comparatively verbose description of the patented design as:

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.

(Vacated panel slip op. at 2.)

This court has accepted both extremes of claim construction. In *Contessa Food Products, Inc. v. Conagra, Inc.*, 282 F.3d 1370 (Fed. Cir. 2002), the court approved a claim construction that stated simply the patent covered “a tray of a certain design, as shown in Figures 4-5, containing shrimp arranged in a particular fashion, as shown in Figures 1-3.” *Id.* at 1377. In this case, the majority opinion noted – without objection – that “[n]either party challenges the district court’s claim construction.” Vacated panel slip op. at 2. IPO is not aware of any decision from this Court that explains how the *Markman* process applies in design patent cases or which of the ends of the apparent spectrum is more appropriate. When this Court stated in *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) that “[d]etermining whether a design patent claim has been infringed requires, first, as with utility patents, that the claim be properly construed to determine its meaning and scope. *See Markman*, 52 F.3d at 976,” it did so in an

off-hand statement that provided no significant guidance as to how the *Markman* process would apply in design patent cases.

IPO submits that the *Markman* process of highly detailed verbalized explications of claims that is common in utility patent litigation has no place in design patent cases. The Supreme Court enunciated the test for design patent infringement in *Gorham*: “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.” *Gorham*, 81 U.S. at 528. That is, the focus in design patent infringement is the **visual appearance** of the patented design, as seen by an ordinary observer. In view of the focus on the visual aspect, it is inappropriate to describe the patented design in words. Verbalizations can create lists of features but they are ill-equipped to convey the appearance of such features and the relationship of such features to one another. Translation of a drawing into words takes the observation away from the ordinary observer. The visual comparison between the claimed design and the accused design rests with the eyes of the beholder. The USPTO grants design patents using drawings, not words. MPEP § 1503.1

The approach taken in *Black & Decker* and *Contessa Food Products* is, IPO submits, the appropriate approach in design patent cases. Because a fact finder

functions as an ordinary observer at least as well as does a court, there is no need to explain to the fact finder what the eyes can readily see. Utility patent claim construction steps have been improperly imported into design patent infringement analysis.

To the extent that a court is to construe the scope of a design patent claim for the purpose of infringement, the scope should encompass **all** designs which have the sameness of effect on the eye of an ordinary observer as the design patent drawings, unless there is a reason to narrow the scope, such as those mentioned above.

Conclusion

The Court should take this opportunity to consider the views of the parties and the numerous *amici* and issue an opinion that clarifies the fundamental difference between design and utility patents and points in a new direction of design patent litigation that avoids excessive verbalization of the scope of design patents.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tracy G. Durkin". The signature is fluid and cursive, with a long horizontal stroke at the end.

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APPENDIX

APPENDIX¹

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