

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 (Hon. David C. Godbey)*

**BRIEF FOR *AMICUS CURIAE* INDUSTRIAL DESIGNERS
SOCIETY OF AMERICA IN SUPPORT OF THE REVERSAL
SOUGHT BY PLAINTIFF-APPELLANT**

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February 1, 2008

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CERTIFICATE OF INTEREST

Counsel for *Amicus Curiae* Industrial Designers Society of America certifies the following:

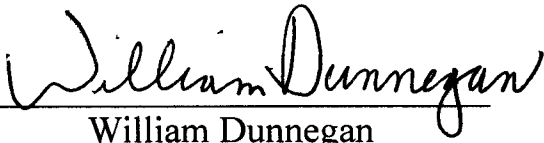
1. The full name of every party or *amicus curiae* represented by me is:

Industrial Designers Society of America.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: N/A.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or *amicus curiae* represented by me are: None.
4. There is no such corporation as listed in paragraph 3.
5. The names of all law firms and the partners or associates that appeared for the party or *amicus curiae* not represented by me in the trial court or agency or who are expected to appear in this Court are:

William Dunnegan
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Dunnegan LLC

February 1, 2008


William Dunnegan

STATEMENT OF INTEREST OF *AMICUS CURIAE*

The Industrial Designers Society of America (“IDSA”) respectfully submits this brief in support of plaintiff-appellant, and specifically to address the questions the Court has raised in its order dated November 26, 2007. The IDSA is a not-for-profit corporation whose members include more than 3,300 industrial designers. Industrial designers create the form of a manufactured product, considering both the needs of the people using the product, as well as the industrial process that will produce it. Typically, industrial designers design the parts of a product with which humans interact.

The members of the IDSA have a substantial interest in the issues the Court raised in its November 26, 2007 order. An informal survey conducted in 2004 revealed that IDSA members, as a whole, held approximately 2,000 design patents. The protection afforded by these patents greatly concerns the IDSA, which perceives that the current standard for design patent infringement is flawed, and in need of revision.

All the parties to this appeal, plaintiff-appellant Egyptian Goddess, Inc. and defendants/third party plaintiffs-appellees Swisa, Inc. and Dror Swisa, have consented to the filing of this brief.

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Summary Of The Argument

I. 35 U.S.C § 289 and Gorham Co. v. White, 81 U.S. (14 Wall) 511, 20 L. Ed. 731 (1871), should compel this Court to eliminate the “Point of Novelty” test as a requirement for proving design patent infringement. The plain language of 35 U.S.C. § 289 demonstrates that the only test for design patent infringement should involve an examination of the accused product to determine whether it is the same as, or a "colorable imitation" of, the patented design. The Supreme Court reached essentially the same conclusion in Gorham. Congress implicitly adopted Gorham when enacting the Patent Act of 1952. Litton Systems, Inc. v. Whirlpool Corp., 728 F.2d 1423 (Fed. Cir. 1984), and its progeny, while attempting to address the problem that the Gorham test could capture subject matter in the prior art, provided an imprecise solution to that problem. The precise solution is for the accused infringer to argue that if the design patent covers the accused device, and if the accused device (i) is anticipated by the prior art or (ii) made obvious by the prior art, then the design patent is invalid.

II. It serves no purpose to construe the design patent drawings in words, and then to compare those words to the accused design. The words will necessarily either broaden or restrict the scope of the design patent claim, in an unpredictable manner. Construing the design patent drawings to

eliminate any functional features depicted in them is, however, necessary to protect patentees who have expressed functional features in solid lines, as the rules allow them to do, from having their design patents declared invalid under 35 U.S.C. § 171 because they claim functional subject matter.

Argument

I.

THE DETERMINATION OF DESIGN PATENT INFRINGEMENT SHOULD NOT INVOLVE A "POINT OF NOVELTY" TEST

A. Congress Did Not Intend To Analyze Design Patent Infringement With A "Point Of Novelty" Test.

The plain language of 35 U.S.C. § 289 does not allow a "point of novelty" test. 35 U.S.C. § 289 provides that design patent infringement occurs when the design of the accused product is the same as, or a "colorable imitation" of, the patented design.

“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.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.” (Emphasis added.)

The plain meaning of the term “colorable imitation” requires a trier of fact to compare the patented design with the design of the accused product.

The term “colorable imitation” leaves no room for an analysis of the differences between the design patent and its prior art, i.e., the “Point of Novelty.” Accordingly, this Court should not depart from the statutory language to apply a “Point of Novelty” test.

B. The “Point Of Novelty” Test Is Inconsistent With Supreme Court Precedent.

In Gorham, the Supreme Court stated:

"We are now prepared to inquire what is the true test of identity of design. Plainly, it must be sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if sufficient to change the effect upon the eye, will not destroy the substantial identity.

If, then, identity of appearance, or (as expressed in McCrea v. Holdsworth) sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case is, whether it is essential that the appearance should be the same to the eye of an expert. The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer. The learned judge thought there could be no infringement unless there was ‘substantial identity’ ‘in the view of the observation of a person versed in designs in the particular trade in question -- of a person engaged in 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.’ There must, he thought, be a comparison of the features which make up the two designs. With this we cannot concur. 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. No counterfeit bank note is so identical in appearance with the true that an experienced artist cannot discern a difference. It is said an engraver distinguishes impressions made by the same plate. Experts, therefore, are not the persons to be deceived. Much less than that which would be substantial identity in their eyes would be undistinguishable in the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be, if, for example, they are led to purchase forks or spoons, deceived by an apparent resemblance into the belief that they bear the ‘cottage’ design, and, therefore, are the production of the holders of the Gorham, Thurber, and Dexter patent, when in fact they are not, the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed. The purpose of the law must be effected if possible; but, plainly, it cannot be if, while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, by those who buy and use, are sufficient to relieve an imitating design from condemnation as an infringement.

We hold, therefore, 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." 81 U.S. (14 Wall) at 527-28, 20 L. Ed. at 737 (Emphasis added.)

Because the Supreme Court has not adopted any test for design patent infringement other than the Gorham test, and because the “Point of Novelty” test changes the infringement analysis by adding an additional test to the

Gorham test, this Court should reject the “Point of Novelty” test as inconsistent with Supreme Court precedent.

C. The “Point of Novelty” Test Is Not Necessary To Ensure That A Design Patent Will Not Ensnare The Prior Art Under The Gorham Test.

In creating the "Point of Novelty" test in Litton, and in applying that test for the following 24 years, this Court has not expressly stated the purpose of the “Point of Novelty” test. We nevertheless agree with appellant that the purpose of the “Point of Novelty” test is to prevent a design patent from being infringed, as a result of the Gorham test, by a design that would have been anticipated, or made obvious, by the prior art.

The "Point of Novelty" test does not provide a precise solution to this problem, and cannot be reformulated to do so. The difficulty of the issues that the Court has raised in the second question of the November 26, 2007 order demonstrates that.

The solution to the problem that the Gorham test may ensnare the prior art is for the accused infringer to present an invalidity defense available under the current law. Specifically, the accused infringer may argue that if the design patent is broad enough to include the accused product under the Gorham test, and if the accused design is either (i) prior art, or (ii) subject matter made obvious by the prior art under KSR Int’l Co. v. Teleflex Inc., __ U.S. __, 127 S. Ct. 1727, 1739 (2007),

then the design patent is invalid based upon the prior art. Thus, if the Court eliminates the “Point of Novelty” defense, it need not replace it with any other formulation.

Adopting this analysis would make it unnecessary to accept appellant’s argument that the trier of fact should consider the prior art in determining the issue of infringement. The statutory purpose of the prior art in a litigation is to determine whether the patent is invalid. Because the Patent Office granted the design patent based upon a claim set forth in the patent drawings, using the prior art to determine the scope of a valid patent would lead to unnecessary imprecision in determining whether the accused product was a “colorable imitation” of the design patent. Moreover, allowing the trier of fact to consider the prior art at the infringement stage will afford the accused infringer a second opportunity to argue unfairly, and often to a jury, that the patentee has not invented any non-obvious subject matter.

This Court can, and should, overrule its precedent when appropriate. In re Seagate Technology LLC, 497 F.3d 1360, 1371 (Fed. Cir. 2007)(“Accordingly, we overrule the standard set forth in Underwater Devices. . . “); Knorr-Bremse Systeme Fuerr Nutzgahrzeuge GmbH v. Dana Corp., 383 F.3d 1337, 1343-44 (Fed Cir. 2004)(“While judicial departure

from stare decisis always requires ‘special justification’ . . . ‘conceptual underpinnings’ of this precedent . . . have significantly diminished in force.”)¹

II.

CLAIM CONSTRUCTION SHOULD PLAY NO ROLE IN THE INFRINGEMENT ANALYSIS, EXCEPT TO FILTER OUT THE FUNCTIONAL ELEMENTS OF THE PATENTED DESIGN, IF ANY.

A. Claim Construction Of A Design Patent Should Not Involve Describing The Patented Design In Words.

The Gorham test involves comparing the patented design to the accused product. The patented design is necessarily set forth only in the patent drawings. 35 C.F.R. § 1.152. The Gorham test should therefore involve comparing the design drawings to the accused product. It would serve no purpose to describe the design patent drawing in words.

In any event, expressing the design patent drawings in words creates imprecision. Even the most precise verbal description cannot provide a more precise construction of the claim than the design patent drawings. Any verbal description of the patent drawings would either expand or restrict the actual scope of those drawings. As a result, any attempt to construe the

¹Because the “Point of Novelty” test should not be applied, we will not address the second question that the Court has raised in its November 26, 2007 order.

design patent in words will unfairly alter its scope, creating an unfair, and unpredictable, advantage for one party.

B. **The Only Legitimate Purpose Of Claim Construction Is To Remove The Functional Elements Of The Patented Design, If Any, Before Applying The Gorham Test.**

Products that are the subject of design patents may contain functional features, meaning features that can have only one shape or a small number of shapes. Consider, for example, a hypothetical design patent for a bowling ball with novel surface ornamentation. The spherical shape of the bowling ball is, by any definition, functional.

During prosecution of the design patent application on that hypothetical bowling ball, the applicant need not use dotted lines to set forth the functional feature, the spherical shape, in the design patent drawings. 37

C.F.R. §1.152 provides:

"Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces which cannot be seen through opaque materials. Alternate positions of a design component, illustrated by full and broken lines in the same view are not permitted in a design drawing." (Emphasis added.)

The Manual of Patent Examining Procedures provides at M.P.E.P §1503.2

¶15.49:

"The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim. Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines." (Emphasis added.)(M.P.E.P §1503.2 ¶15.49)

Returning to our hypothetical example of the bowling ball, if the patent drawings did not show the outer surface of the bowling ball in dotted lines, a court would have two basic alternatives when comparing the design patent on the bowling ball to an accused bowling ball.

- First, a court could exclude, or instruct a jury to exclude, the functional features of the patented design, the spherical shape of the bowling ball, before comparing it to the accused bowling ball under the Gorham test.
- Second, a court could compare, or direct a jury to compare, the design patent and the accused bowling ball under the Gorham test based upon the spherical shape of both.

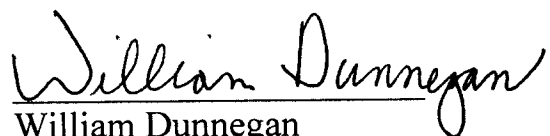
By broadening the scope of the design patent for infringement purposes, the second alternative could, unfairly, result in the invalidity of that design patent. If the accused bowling ball met the Gorham test because the bowling ball disclosed in the design patent and the accused bowling ball were spherical, a court may hold the design patent invalid on the ground that the design is not "ornamental" under 35 U.S.C. § 171. As a result, the Court

would subject the patentee, who exercised the right to show functional features in the design patent drawings with solid lines, to the risk of having the design patent declared invalid based upon the exercise of that right. The Court should therefore construe the design patent to determine what portions of it, if any, are functional because they can only have one shape or a limited number of shapes. The Court should then exclude those functional features from the design patent before applying Gorham test.

Conclusion

Amicus Curiae Industrial Designers Society of America respectfully requests that this Court reverse the judgment of the district court, eliminate the "Point of Novelty" test for design patent infringement, and hold that claim construction for a design patent should involve no more than eliminating the functional elements from the design drawings before applying the Gorahm test.

Dated: February 1, 2008



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Certificate Of Compliance

I certify that this brief complies with the type-volume limitation set forth in Rules 29(d) and 32(a)(7)(B) of the Federal Rules of Appellate Procedure. This brief contains 2,679 words.

Dated: February 1, 2008



William Dunnegan

Certificate Of Service

I, Jennifer Siewert, hereby declare pursuant to 28 U.S.C. § 1746 that I am over the age of 18, and that on February 1, 2008, I caused 2 copies of the **BRIEF FOR AMICUS CURIAE** Industrial Designers Society of America to be served upon:

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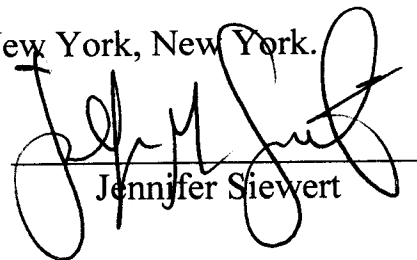
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