

2009-1354

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**United States Court of Appeals**  
*for the*  
**Federal Circuit**

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DAVID A. RICHARDSON,

*Plaintiff-Appellant,*

v.

STANLEY WORKS, INC.,

*Defendant-Appellee.*

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*Appeal from the United States District Court for the District of  
Arizona in Case No. 08-CV-1040, Judge Neil V. Wake.*

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**BRIEF OF *AMICUS CURIAE* APPLE INC. IN  
SUPPORT OF PLAINTIFF-APPELLANT'S  
PETITION FOR REHEARING *EN BANC***

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## **STATEMENT OF INTEREST OF *AMICUS CURIAE***

This brief is being filed by Apple Inc. (“Apple”), a California Corporation founded in 1976 that is headquartered in Cupertino, California.

Apple designs, manufactures and sells consumer electronic products including personal computers, portable digital music players and mobile communication devices as well as related software, services, peripherals, accessories, and networking solutions worldwide.

Apple is well known for its industrial designs and its ability to excite the public with each new product. In addition, Apple’s iconic designs have received critical acclaim and have won many design awards. Some of Apple’s products have even been featured in museums worldwide.

Because of the importance of its designs, Apple frequently applies for and obtains U.S. design patents. In last three years, Apple has filed over 125 U.S. design patent applications covering software and hardware aspects of its iconic product designs. Apple’s design patent portfolio is very diverse, including both hardware and software design patents related to its Mac® line of computers, iPod® line of media devices, and the revolutionary iPhone® smart phone (among others).

Exemplary Apple design patents cover its computers (e.g., D518,290), operating system icons and graphical user interfaces (GUIs) (e.g., D457,164),

handheld electronic devices (e.g., D506,476), computer peripherals (e.g., D490,812), and handheld accessories (e.g., D533,347).

Apple's designs are subject to an ever-increasing number of knock-offs and copycats from companies trying to imitate, and simply copy, its success. Some copying has become bold and aggressive. As a result, Apple has a real and substantial interest in protecting its industrial designs.

This brief is not motivated by any desire to influence the outcome of any pending case. Plaintiff–Appellant David A. Richardson has given his consent for Apple Inc. to file this brief; Defendant–Appellee Stanley Works, Inc. has not.

## SUMMARY OF THE ARGUMENT

It is exceptionally important for the Court to reconsider *en banc* the panel's finding that it is proper to factor out functional aspects of a claimed design prior to determining infringement.

The parsing of ornamental and functional features should be abolished. Whether an individual feature of an overall design performs a function is simply not relevant to design patent infringement.

Functional features that make up an overall design are nearly always themselves ornamental, and those functional features are no more or less relevant to design patent *infringement* than any other feature, all contributing to the overall appearance of the claimed design.

The proper place in design patent law to consider functionality is when evaluating the *validity* of a design patent, *i.e.*, whether the overall claimed design is dictated solely by function. This use of functionality in the validity inquiry is supported by the Supreme Court's *Bonito Boats* decision.

This Court's *Egyptian Goddess* decision, in rejecting the old deconstructionist analysis of novelty, also changed the underpinning of older case law that similarly dissected functionality element-by-element – a flawed analysis with the same infirmities that led this Court to abolish the point of novelty test in *Egyptian Goddess*.

## **I. THE FUNCTIONALITY OF INDIVIDUAL FEATURES HAS NO DIRECT BEARING ON DESIGN PATENT INFRINGEMENT OR VALIDITY**

The only designs that qualify for design patent protection are, *inter alia*, “...ornamental designs *for an article of manufacture...*” 35 U.S.C. §171 (emphasis added). Thus, patentable industrial designs consist of articles of manufacture that inherently have functional characteristics and features<sup>1</sup>.

The Supreme Court set forth the test for design patent functionality: “To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989). It follows that a claimed design is invalid under 35 U.S.C. §171 if there are no alternate designs that perform substantially the same general function as the overall claimed design.<sup>2</sup> The existence of such alternate designs is excellent evidence that the design patentee is not improperly monopolizing that general function, *i.e.*, that the overall claimed design is ornamental.<sup>3</sup>

Somewhere along the way, however, design patent functionality changed from being strictly a validity issue under 35 U.S.C. §171 into an infringement issue

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<sup>1</sup> *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997) (“...the fact that the article of manufacture serves a function is a prerequisite of design patentability, not a defeat thereof.”).

<sup>2</sup> *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002).

<sup>3</sup> *Id.*

requiring individual functional features of a design to be “factored out” prior to applying the ordinary observer infringement test. This is improper.<sup>4</sup>

Whether individual features of a claimed design perform a function, or not, should have no bearing whatsoever on design patent infringement. While individual features can play a role in determining infringement<sup>5</sup>, ultimately it is the overall appearance of the claimed design, including all functional and non-functional features, that matters, and whether that overall appearance is substantially the same as the accused design, in which case the design patent claim is infringed.<sup>6</sup>

Similarly, whether individual features of a claimed design perform a function has no bearing whatsoever on design patent validity.<sup>7</sup> It is only the overall appearance of the claimed design, including all functional and non-

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<sup>4</sup> If individual features of an article of manufacture were factored out prior to applying the infringement test simply because they perform a function, there would in many cases be little left of the patented design to compare to the accused design. This cannot be the law.

<sup>5</sup> For example, as stated in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008): “If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing.”

<sup>6</sup> *Id.* at 678.

<sup>7</sup> *Avia Group Int’l Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988) (“There is no dispute that shoes are functional and that certain features of the shoe designs in issue perform functions. However, a distinction exists between the functionality of an article or features thereof and the functionality of the particular design of such article or features thereof that perform a function.”)

functional features, that matters, and whether that overall appearance is dictated solely by function in which case the design patent claim is invalid.

A patentee is not improperly monopolizing individual functional features if the design patent claim is directed to the overall ornamental appearance of an article of manufacture of which the functional features, and more particularly their appearance, are only a part.

## **II. THE ORNAMENTAL/FUNCTIONAL DICHOTOMY IS A FALSE ONE**

The delineation between ornamental and functional features was first set forth in *Read Corporation v. Portec, Inc.*, 970 F.2d 816 (Fed. Cir. 1992):

Where ... a design is composed of functional as well as ornamental features, to prove infringement a patent owner must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental. *Id.* at 825.

This unfortunately created a subtle but troubling shift in the case law from functionality being strictly a validity issue to an infringement issue.<sup>8</sup>

The major problem with *Read's* delineation between ornamental and functional features is that it created a false dichotomy. There are designs that have

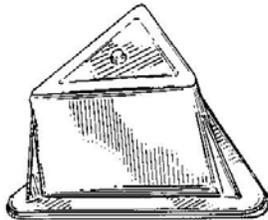
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<sup>8</sup> The only case cited in *Read* for its ornamental/functional dichotomy is *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186 (Fed. Cir. 1988). However, the *Lee* court never suggested that ornamental and functional features must be identified before performing the test for infringement. In contrast, the *Lee* court quite properly spoke of functionality only as a validity issue. *Lee's* underlying lesson – still true today – is that a design patent can only protect the appearance of functional features, not how they work (“...a design patent is not a substitute for a utility patent.”) *Id.* at 1189.

features which perform a function on the one hand, and features which are purely ornamental on the other, but there is no need to distinguish between the two. Nearly all individual functional features are themselves *also* ornamental and part and parcel of the overall claimed design.

This is clear from *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995) in which the overall claimed design, a triangular sign holder for mounting on the top of a vehicle, included vertical ribs at each corner of the triangle, plus an upper protrusion extending from the top of the sign holder.

**Elmer's U.S. Patent No. D290,620**



**Accused Design**



The patentee argued that the vertical ribs and upper protrusion features shown in solid lines in his drawings were functional, rather than ornamental, and should therefore not be included in the claim.<sup>9</sup>

This Court rejected the argument:

If, as [Elmer] now contends, the vertical ribs and upper protrusion were functional, not ornamental, features, [Elmer] could have omitted these features from its patent application drawings. [Elmer] did not

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<sup>9</sup> Almost needless to say, the vertical rib and upper protrusion features were not found in the accused design.

do so, however, and thus effectively limited the scope of its patent claim by including those features in it.” *Id.* at 1577.

In so doing, this Court implicitly recognized that although the ribs and protrusion are indeed functional, they are also ornamental in that they could be formed in many different shapes and still perform their general function. Further, such functional features were not factored out of the infringement analysis, and the design patent did not give Elmer a monopoly over the function of those features.

*Read* and its progeny<sup>10</sup> have also improperly shifted the focus from the overall appearance of a claimed design to its design *features*. The test for design patent infringement does not compare individual features, but rather requires the accused design to be substantially the same **overall** as the patented design.<sup>11</sup> And the overall ornamental appearance of a claimed design is composed of the combination of individual features that may themselves be novel, old, obvious, non-obvious, ornamental, and/or functional. During examination, the PTO reviews the entire claimed design, with all such features. In the enforcement context, the fact-finder should determine validity by reference to the entire design. By shifting the functionality analysis to the infringement inquiry, the panel’s decision substitutes a deconstructionist view for the proper holistic analysis. In that sense, it suffers from the same analytical defect that was rectified in *Egyptian Goddess*.

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<sup>10</sup> *E.g., Oddzon Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997).

<sup>11</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008).

In dispatching the point of novelty test, this Court in *Egyptian Goddess* determined that novelty is a validity issue rather than something the presence of which must be proven by a design patentee in its infringement case in chief. Similarly, this Court should affirm that functionality is also a validity issue rather than something the absence of which must be proven by a design patentee in its infringement case in chief.

### III. CONCLUSION

Individual functional features of a claimed design are no more relevant in design patent infringement and validity as individual non-functional features - the appearance of each feature is part of the overall appearance of the claimed design.

Functionality should be returned to the same footing as lack of novelty – both are invalidity defenses, not to be determined prior to or as part of the infringement case in chief.

For these reasons, this Court should grant the petition for rehearing *en banc*.

Respectfully submitted,



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April 22, 2010

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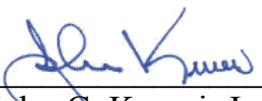
**DECLARATION OF AUTHORITY PURSUANT TO  
28 U.S.C. § 1746 AND FEDERAL CIRCUIT RULE 47.3(d)**

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:

I am an employee of Counsel Press's Washington DC Office. Counsel Press was retained by SAIDMAN DESIGNLAW GROUP, Attorneys for Amicus Curiae to print the enclosed documents.

The attached Brief has been submitted to Counsel Press, by the above attorneys, electronically and/or has been reprinted to comply with the Court's rules. Because of time constraints and the distance between counsel of record and Counsel Press, counsel is unavailable to provide an original signature, in ink, to be bound in one of the briefs. Pursuant to 28 U.S.C. §1746 and Federal Circuit Rule 47.3(d), I have signed the documents for Perry J. Saidman, Esq., with actual authority on his behalf as an attorney appearing for the party.

April 22, 2010

  
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John C. Kruesi, Jr.

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-----)

**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:

I am retained by SAIDMAN DESIGNLAW GROUP, Attorneys for *Amicus Curiae*.

On the **22<sup>nd</sup> Day of April 2010**, I served the within **Brief of *Amicus Curiae*** upon:

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April 22, 2010

  
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