

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*

**AMICUS CURIAE BRIEF ON BEHALF OF
THE HOUSTON INTELLECTUAL PROPERTY
LAW ASSOCIATION**

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February 5, 2008

CERTIFICATE OF INTEREST

COUNSEL FOR Amicus Curiae, the Houston Intellectual Property Law Association, certifies the following:

1. The full name of every party or amicus represented by me is the Houston Intellectual Property Law Association.

2. The name of the real party in interest represented by me is the Houston Intellectual Property Law Association.

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. X There is no such corporation listed in paragraph 3.

5. The name of all law firms and the partners or associates that appeared for the amicus now represented by me in the trial court or agency or are expected to appear in this Court are:

Valerie K. Friedrich, of Baker & Mckenzie, LLP.

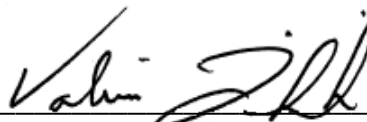

Valerie K. Friedrich

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I. STATEMENT OF INTEREST OF THE AMICUS CURIAE

The Houston Intellectual Property Law Association (HIPLA) is an association of over 400 lawyers and other professionals who work in the Houston, Texas area. The practice of most of the HIPLA membership relates in substantial part to the field of intellectual property law. Founded in 1961, HIPLA is one of the largest regional associations of intellectual property practitioners. No HIPLA member represents (or has represented) either party in the subject of this appeal.

On November 26, 2007, this court entered an Order inviting *amicus curiae* briefs in accordance with Federal Rule of Appellate Procedure 29 and Federal Circuit Rule 29 to address certified questions involving issues associated with the point of novelty test and claim construction issues in design patent infringement cases. HIPLA addresses these certified questions below, and takes no position with respect to the merits of this case. HIPLA obtained consent of the parties to HIPLA's filing this brief.

II. QUESTION PRESENTED AND BRIEF ANSWERS

The Court identified the following three questions in its November 26, 2007

Order setting this matter for *en banc* consideration:

1. Should "point of novelty" be a test for infringement of design patent?
2. If so, (a) should the court adopt the non-trivial advance test adopted by the panel majority in this case; (b) should the point of novelty test be part of the patentee's burden on infringement or should it be an available defense; (c) should a design patentee, in defining a point of novelty, be permitted to divide closely related or ornamentally integrated features of the patented design to match features contained in an accused design; (d) should it be permissible to find more than one "point of novelty" in a patented design; and (e) should the overall appearance of a design be permitted to be a point of novelty?
3. Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis?

III. SUMMARY OF ARGUMENT

HIPLA believes these questions should be answered as follows:

1. The "point of novelty" test should not be a separate prong in the standard for design patent infringement. The test for design patent infringement was established by the Supreme Court in *Gorham v. White* and requires that an accused design be substantially similar to the patented design in visual appearance

to an ordinary observer for infringement of the design patent to exist. 81 U.S. 511, 528 (1872). The distinctiveness of the visual appearance of the accused and patented designs is a component of the ordinary observer test and not a separate and distinct consideration. Moreover, novelty is one of the statutory requirements for validity of a patented design. Therefore, consideration of the novel aspects of a patented design unintentionally merges issues of infringement and validity. In light of the lower standard, *i.e.*, preponderance of the evidence, for infringement analysis and the higher standard, *i.e.*, clear and convincing evidence, for validity findings, it is particularly inappropriate to meld these two issues.

2. If the “point of novelty” test is maintained:

(a) the Court should not adopt the non-trivial advance test adopted by the panel majority in this case as such standard has never been enunciated by the Supreme Court or Congress;

(b) the point of novelty test should be an available defense but should not be a part of the patentee’s burden;

(c) a design patentee should be permitted to divide closely related or ornamentally integrated features of the patented design to match features contained in an accused design;

(d) it should be permissible to find more than one “point of novelty” in a patented design; and

(4) the overall appearance of a design should not be permitted to be a point of novelty but a unique combination of known design elements should be permitted to be a point of novelty.

3. Claim construction in which the patented design is verbally described in detail should not apply to design patents. The focus in design patent infringement is the visual appearance of the patented design, as seen by an ordinary observer. Moreover, the Supreme Court's *Markman* opinion does not require detailed verbalization of patented designs. Nevertheless, a reasonable explanation of limitations on patented designs arising, for example, from the use of broken lines or from actions taken during prosecution of the design patent application may be appropriate. In addition, should the points of novelty test be maintained, identification of such novel aspects of a patented design may be better determined by a court in its claim construction.

IV. ARGUMENT

A. "Point of novelty" should not be a test for design patent infringement.

1. The *Gorham* Supreme Court's "ordinary observer" test is the correct test to determine design patent infringement.

In 1872 the Supreme Court established the test for design patent infringement:

[I]f, 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 Co. v. White, 81 U.S. 511, 528. Since 1872, the Supreme Court has neither modified nor overturned the *Gorham* “ordinary observer” test for design patent infringement. Moreover, while amending and re-writing the Patent Act, the legislature has not undertaken to overturn the *Gorham* “ordinary observer” test to determine design patent infringement. As such, the “ordinary observer” test is the law for determining infringement of a design patent. *See, e.g., Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (“More than one hundred years ago, the Supreme Court established a test for determining infringement of a design patent which, to this day, remains valid”).

In its *Gorham* opinion, the Supreme Court acknowledged the statutory requirement that patented designs be novel. 81 U.S. at 524-25. The *Gorham* Court discussed at length the value of a “new or original impression or ornament to be placed on any article of manufacture” noting that a distinctive appearance “may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public.” *Id.* at 525. That is, the Supreme Court’s reference to novelty occurs in its discussion regarding the *patentability* of a design, and particularly, *why* novel designs are patentable.

Turning to its infringement analysis, the *Gorham* Court did not again expressly discuss the novelty requirement. Rather, the entirety of the *Gorham* Court's infringement finding is based upon the similarity in overall visual impression of the patented and accused designs imparted by the similarity between a number of specific elements in the designs, irrespective of whether such elements were novel. Specifically, the *Gorham* Court expressly points out similarities between the accused and patented designs in: (a) the rounded shoulder; (b) concavity and convexity of the stem; (c) the rounded moulding or bead; and (d) inwardly turning scrolls. *Id.* at 529. It defies credulity that, even at the time of the *Gorham* patent, any of these ornamental features were, in fact, novel.

While the *Gorham* Court did take into account the "distinctiveness" of the patented design in its infringement analysis, the Court did not enunciate such consideration separate and apart from its "ordinary observer" analysis. 81 U.S. at 528-29. That is, the *Gorham* Court considered the distinctiveness of the patented design as a whole, looking to the designs' "effect upon the eye" and their "general appearance and effect" without parsing those elements which alone may have been novel. *Id.* at 527 & 531. Thus, to the extent the Supreme Court's reference to "distinctiveness" could be read as requiring a consideration of novelty in an infringement analysis, such consideration is subsumed within the "ordinary observer" test and is not treated separately.

2. The *Litton* “point of novelty” test is not based on Supreme Court precedent.

In 1984, the Federal Circuit established the “point of novelty” test as a second prong required to find design patent infringement. *Litton*, 728 F.2d at 1444. The *Litton* court acknowledged and quoted the *Gorham* “ordinary observer” test but then stated:

For a design patent to be infringed, however, no matter how similar two items look, ‘the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.’

Id. (quoting *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944)).

The *Sears* Eighth Circuit opinion, in turn, relied on the Supreme Court’s opinion in *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893). Careful examination of the *Whitman Saddle* opinion, however, shows that the Supreme Court did not establish a separate point of novelty test for design patent infringement.

The design at issue in *Whitman Saddle* was for a saddle that modified and combined features present in the prior art. 148 U.S. at 680-81. Specifically, the patented design included a novel combination of a known front end shape and a known, but partially modified, back end shape. *Id.* As is the norm in design patent cases, the accused infringer had not slavishly copied the patented design. *Id.* at 681-82. Rather, the accused saddle incorporated both front and back end shapes which were known in the prior art. *Id.* First, the *Whitman Saddle* Court

acknowledged the infringement test established in *Gorham*. 148 U.S. at 678. Without expressly enunciating a “doctrine of equivalents,”¹ the *Whitman Saddle* Court held there could be no infringement because the accused saddle differed from the patented device by incorporation of design elements existing in the prior art. *Id.* at 682. That is, the *Whitman Saddle* Court applied the well-established principle that one cannot capture by way of equivalents what one could not have patented. *See, e.g., Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 900 (Fed. Cir. 1984) (device in prior art cannot be found infringing under doctrine of equivalents).

The Supreme Court’s refusal to extend protection of a patented design under the doctrine of equivalents to encompass prior art designs should not be transmuted into a “point of novelty” test for design patent infringement. Moreover, as is clear from *Whitman Saddle*, it is unnecessary to do so. That is, accused infringers are sufficiently protected to the extent they practice the prior art. If an accused infringer practices a design that is found to wholly exist within the prior art, any patent on such design would necessarily be invalid as lacking novelty. If an accused infringer practices a design that resembles a patented design only in those

¹ The *Gorham* court had recognized that a design patent could be infringed by “equivalents.” 81 U.S. at 530 (“Is the adornment in the White design used instrumentally to produce an appearance, a distinct device, or does it work the same result in the same way, and is it, therefore, a colorable evasion of the prior patent, amounting at most to a mere equivalent?”).

elements in the prior art, the accused design should be found not to infringe under the doctrine of equivalents. Consequently, the more crowded the art, the narrower the scope, both literally and equivalently, accorded to the patented design. Therefore, it is unnecessary to turn the “distinctiveness” considerations of *Gorham* and *Whitman Saddle* into a rigid second prong for design patent infringement analysis.

3. The Point of Novelty test unnecessarily commingles infringement and validity considerations.

The Patent Act provides patent protection on new, original and ornamental designs for articles of manufacture. 35 U.S.C. § 171. Thus, novelty (and, in fact, non-obviousness) is a requirement for a valid design patent. The point of novelty test, however, brings validity considerations, arguments and authorities into an infringement discussion, thereby confusing, if not completely obfuscating, the issues addressed by the fact finder. Fact finders are well-equipped to apply the ordinary observer test, a relatively straightforward test applying the level of attention of a purchaser. Inclusion of the point of novelty test, however, forces the fact finder to delve into more complicated issues, such as what constitutes prior art, what the prior art discloses, and which parts of the patented design are parseable over the prior art. The resulting morass is sufficiently difficult to untangle when the fact finder is a court and, as a practical matter, almost impossible when a jury is charged with the duty.

Moreover, there is no harm in resecting the point of novelty analysis from the infringement context and transplanting it into a validity analysis. Upon issuance, a design patent is entitled to the presumption of validity. 35 U.S.C. § 282. As with presumptively valid utility patents, an accused infringer is permitted to challenge the validity of a design patent by presenting evidence of anticipation or obviousness, or failure to comply with another statutory requirement. 35 U.S.C. § 171 (“the provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided”). Except for specific statutory provisions, the legislature has not expressed any intent that design patents be treated differently from or less than utility patents. Similarly, the Supreme Court has not opined that design patents are less valid or enforceable than utility patents. In fact, as discussed *supra*, the *Gorham* Court noted the extreme importance of a product’s appearance and design to its salability. 81 U.S. at 525. Indeed, the Federal Circuit has, on more than one occasion, opined that utility and design patents are held to the same standards. *Litton Sys., Inc.*, 728 F.2d at 1440-41. Therefore, it is appropriate that an accused infringer be required to present clear and convincing evidence to prove a presumptively valid design patent invalid. *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371 , 1377 (Fed. Cir. 2004) (test for validity of design patent under 35 U.S.C. § 171 identical to test for

validity of utility patent under 35 U.S.C. § 101). Indeed, substantially more harm is caused by maintaining the current point of novelty practice.

By conflating infringement and invalidity considerations, the point of novelty test does indeed weaken design patent protection. For example, in *Lawman Armor Corp. v. Winner*, an accused infringer avoided liability by presenting evidence that the patent holder's proposed points of novelty were disclosed by the prior art. 2005 U.S. Dist. LEXIS 2078 (E.D. Pa. 2005), *aff'd*, 437 F.3d 1383 (Fed. Cir. 2006). The *Lawman* district court agreed with the accused infringer and held that, individually, each of the proposed points of novelty were in the prior art. Thus, the district court held there was no material question regarding the point of novelty and granted summary judgment of non-infringement. *Id.* That is, under a mere preponderance of the evidence standard, the trial court was permitted to (essentially) opine that the patented design had no novel elements. *Id.* Although the *Lawman* district court did not find the design patent in suit invalid, none can argue that the district court crippled any future attempt at enforcing the patent in suit and emboldened all would be infringers. This is an unfair result where the accused infringer was held to a mere preponderance of the evidence standard.

B. IF MAINTAINED, THE POINT OF NOVELTY TEST SHOULD HAVE A VERY LIMITED ROLE IN INFRINGEMENT ANALYSIS.

HIPLA briefly addresses the Court's second question for *en banc* consideration in the event the Court decides to maintain the point of novelty test.

1. The non-trivial advance test should not be adopted.

As discussed *supra*, the legislature and the Supreme Court have, for over a hundred years, recognized the importance of product design and have accorded protection to those who invent novel designs. The Federal Circuit panel cites *Whitman Saddle* as support for its non-trivial advance test. The *Whitman Saddle* Court, however, did not require that the patented saddle design “non-trivially” combine known elements. 148 U.S. at 682. Rather, the *Whitman Saddle* Court noted that the patented design had two differences over the prior art. *Id.* Moreover, the *Gorham* Court clearly held, if not expressly then by implication, that combinations of known elements could yield a distinctive, *i.e.*, patentable, design. 81 U.S. at 528-29 (“[The peculiarities of outline, configuration, and ornamentation] make up whatever is distinctive in appearance, and of these, the outline or configuration is most impressive to the eye.”). That is, the *Gorham* Court did not require that the combination be non-trivial so as to render the design patentable. Indeed, the patented design in *Gorham* does not readily exhibit any non-triviality in the combined design elements.

2. Point of novelty should be a component of an invalidity consideration and lack of any point of novelty should be an affirmative defense available to the defendant.

As discussed *supra*, determination of the points of novelty of a patented design is most appropriately considered as part of a validity analysis. That is, if a patented design possesses no point of novelty, then the design may be held invalid. Because a design patent is entitled to a presumption of validity, an accused infringer should only be permitted to establish lack of novelty by clear and convincing evidence as part of an affirmative defense (or counterclaim).

3. Points of novelty may lie in parts of integrated features.

As the present case shows, almost all fields of product design can be accurately described as “crowded arts.” That is, few products are entirely new and therefore, improvements on product designs often necessarily involve changes to an existing design element or part of a design element. *See Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (“Virtually all inventions are combinations and virtually all are combinations of old elements.”). Because even such partial changes can impact the “salability” of the product, a design patentee should be permitted to rely on them for the “distinctiveness” of the design. *Paraphrasing Gorham*, 81 U.S. at 525. For example, the *Whitman Saddle* Court dissected the front end of the patented saddle design, noting that the overall shape of the front end was in the prior art, namely the Granger saddle. 148 U.S. at

609. However, the Supreme Court further noted that the pommel, a portion of the front end of the saddle, of the patented design had an accentuated drop falling nearly perpendicularly several inches. *Id.* at 682. Thus, the *Whitman Saddle* Court closely divided one part of the patented design to find a novel feature.

Moreover, courts should not usurp the role of the fact-finder and decide in the first instance what constitutes a whole or a part of a design element. In *Gorham*, for example, were the inward turned scrolls at the base of the stem part of the moulding or a separate design element? The *Gorham* Court parsed them separately but another court may have reached a different conclusion as the scrolls extend continuously from the moulding. Similarly, another court may not have divided the front end of the patented saddle design as did the *Whitman Saddle* court. How finely a design may be divided or parsed to find novelty should, therefore, be left to the eye of the “ordinary observer, giving such attention as a purchaser usually gives.” That is, if a design element, whether clearly separable from its surrounding elements or not, is noticeable to the ordinary purchaser then such element should be permitted to serve as a point of novelty.

4. There may be multiple points of novelty in a patented design.

While not expressly pointing out novel features, the *Gorham* Court considered several design elements in its infringement analysis. 81 U.S. at 528-29.

The *Whitman Saddle* Supreme Court expressly pointed out two novel aspects of the patented saddle design. 148 U.S. at 682. Therefore, the Supreme Court has acknowledged that a patented design may have more than a single novel aspect.

In addition, the validity aspect of the point of novelty test supports allowing finding more than one point of novelty. In allowing a design patent application to issue as a design patent, a patent examiner is not required to specify what elements of the design are novel over the prior art. Furthermore, the patent examiner does not articulate whether the design would have been patentable had some, but not all, of the novel elements been included in the design. Much less does a patent examiner state which, if not all, of the design elements would have been required for novelty. Particularly in crowded arts, a patentable design may have multiple modifications of prior art design elements, some or most of which may be necessary for novelty.

Furthermore, the *Gorham* Supreme Court established that design patents have a non-trivial scope. 81 U.S. at 531. In fact, the Supreme Court's opinion on the scope of a design patent claim bears repeating:

It leaves undisputed the facts that whatever difference there may be between the plaintiffs' design and those of the defendant in details of ornament, they are still the same in

general appearance and effect, so much alike that in the market and with purchasers they would pass for the same thing . . . Unless, therefore, the patent is to receive such a construction that the act of Congress will afford no protection to a designer against imitations of his invention, we must hold that [sale of the defendant's designs] is an infringement of the complainants' rights.

81 U.S. at 531. Although the *Gorham* Court couched this discussion in the context of its ordinary observer test, the goal of providing real protection for novel designs by way of a design patent is relevant to any infringement test formulated by this Court. That is, should the Federal Circuit maintain a point of novelty test distinct and separate from the ordinary observer test, such test should be sufficiently flexible to grant design patent claims a reasonable scope, as envisioned by the *Gorham* Supreme Court.

To permit reasonable design patent claim scope, a point of novelty test should acknowledge that protectible designs may have more than one point of novelty. Moreover, a point of novelty test should be sufficiently flexible to permit the fact finder to determine whether it is necessary that all, or only some, of the novel features must be incorporated into the accused design to find infringement.

“Unless, therefore, [a point of novelty test is so prescribed] the act of Congress will afford no protection to a designer against imitations of his invention.” *Paraphrasing Gorman*, 81 U.S. at 531. A point of novelty test for design patent infringement that must be rigidly applied necessarily weakens the *Gorham* “ordinary observer” standard and is, therefore, antithetical to the Supreme Court’s intent.

5. A novel combination of known design elements may be a point of novelty.

The *Whitman Saddle* Court found, by implication, the plaintiff’s saddle design patentable while noting that it combined design elements disclosed in prior art saddle designs. 148 U.S. at 680. This Court has also recognized that a novel combination of known design elements may be a point of novelty. *Lawman*, 49 F.3d at 1192; *L.A. Gear v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993); *Avia Group Int’l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988). In its second *Lawman* opinion, this Court held that “in appropriate circumstances a combination of design elements itself may constitute the point of novelty.” 49 F.3d at 1149. However, the Court did not elucidate what would satisfy the “appropriate circumstances” requirement. *Id.* Should the Court maintain a point of novelty test, HIPLA requests the Court clarify the

standard for when a combination of known elements may serve as a separate point of novelty. In accordance with the foregoing section, a combination of known elements should function as a point of novelty when an ordinary purchaser views the combination, as part of an integrated ordinary observer test, as sufficiently “distinct” to impact a purchaser’s decision.

C. CLAIM CONSTRUCTION INVOLVING THE DETAILED VERBALIZATION OF DESIGN PATENT CLAIMS IS UNWARRANTED AND ILL-ADVISED.

1. The Supreme Court’s *Markman* decision does not require that a design patent claim be translated into words.

Claim construction, or *Markman*, rulings were mandated by the Supreme Court’s 1996 opinion of that name. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). To understand the need for, and more importantly the applicability of, claim construction proceedings, the Supreme Court’s *Markman* reasoning is properly examined. The *Markman* case, of course, dealt with a utility patent. *Id.* at 374.

Writing for a unanimous court, Justice Souter examined the right of a patent litigant to have the claims of a patent in suit determined by a jury in light of the Seventh Amendment right to a jury trial. Relying on the Supreme Court’s long-

established interpretation of the Seventh Amendment,² the *Markman* Court looked to the treatment of patent claims under English common law at the time the Seventh Amendment was adopted. The *Markman* Supreme Court addressed the issue in two parts: (1) first, whether a cause for patent infringement was “tried at law at the time of the founding;”³ and (2) if so, whether a particular issue - claim construction - occurring within a jury trial must necessarily be determined by the jury in order to “preserve the right to a jury’s resolution of the ultimate dispute.” 517 U.S. at 376 - 77. The current case deals solely with the second issue.

In resolving the second issue, Justice Souter again turned to a historical analysis. *Id.* at 378. Finding no exact antecedent, the *Markman* Court sought guidance by reference to analogous jury trial issues. *Id.* Fundamental to the Supreme Court’s decision that claim construction is properly determined as a matter of law for a court was the fact that, at the time of the Seventh Amendment, courts at law, rather than juries, construed *written* instruments. *Id.* at 381-82. Because there was “no more reason to infer that juries supplied plenary interpretation of written instruments in patent litigation than in other cases

² *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935) (“the right of trial by jury thus preserved is the right which existed under the English common law when the [Seventh] Amendment was adopted”).

³ There is no question that today’s patent actions descended from infringement actions tried at law, and not in equity, in the 18th century. *Markman*, 517 U.S. at 377. Therefore, the Seventh Amendment right to trial by jury in patent infringement cases is well established. *Id.*

implicating the meaning of documentary terms,” the *Markman* court reasoned that 18th-century judges, not juries, interpreted the meaning of patents. *Id.* The *Markman* Court further drew on the analogy between patent and land grants: “[t]hese indications of our patent practice are the more impressive for being all of a piece with what we know about the analogous contemporary practice of interpreting terms within a land patent, where it fell to the judge, not the jury, to construe the words.” *Id.* at 382-83.

Thus, the clear focus of the *Markman* Supreme Court was the *written, documentary* nature of the utility patent claims at issue. In contrast, a design patent grant is *visually* defined. Thus, the *Markman* Court’s reasoning for jurist interpretation of utility patent claims is inapposite in a design patent case.

2. The Supreme Court’s *Markman* opinion “teaches away” from detailed verbalization of design patent claims.

Further examination of the Supreme Court’s *Markman* opinion shows that not only is verbalization of design patent claims not mandated, but, in fact, invites improper violation of a design patent litigant’s jury trial right. The *Markman* Court enunciated the second prong of the Seventh Amendment analysis as requiring determination whether a particular issue must be decided by a jury to “preserve the right to a jury’s resolution of the ultimate dispute.” 517 U.S. at 377. One district court has cautioned against overly narrow construction of a design patent claim, arguing that such construction could improperly divest the jury of its

“ordinary observer” test. *Lamps Plus, Inc. v. Dolan*, 2003 U.S. Dist. LEXIS 19578 at *12-*13 (N.D. Tex. 2003). That is, the appropriate focus of the fact finder is to compare the drawings of the design patent with the accused design. *Id.* It is not appropriate for the fact finder to compare a court’s detailed description of the patented design with the accused design. *Id.* Overly detailed description of a design patent’s drawings, however, invites the fact finder to not observe, *i.e.*, to not conduct the fundamental exercise required to determine whether infringement exists. As such, a design patent litigant may, as a practical matter, be deprived of its right to trial by jury of the ultimate issue of infringement.

3. The scope of a design patent claim is circumscribed by the overall visual impression created by the patent drawings.

The *Gorham* Supreme Court established the test for determining design patent infringement. In so doing, the Supreme Court referred to and relied upon the opinion of Lord Chancellor Hatherly in *McCrea v. Holdsworth* in a suit involving a fabric design. 81 U.S. at 526 (*citing McCrea*, 6 Chancery Appeal Cases, Law Reports, 418). Both the patented and accused designs in *McCrea* included a star but in the accused design the star was turned in an opposite direction from the patented design. 81 U.S. at 526. Yet, “the effect of the ornament was the same to the eye” and therefore infringing. *Id.* The *Gorham* Supreme Court adopted the Chancery Court’s approach stating “it is the effect upon the eye which adds value to articles of trade or commerce.” *Id.* Indeed, the

Gorham Court refers to the “effect upon the eye” as the relevant inquiry for design patent infringement no less than ten times. *See, e.g.*, 81 U.S. at 526 (“Now in the case of those things in which the merit of the invention lies in the drawing, or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of the identity of the two things.”) (quoting *Holdsworth v. McCrea*, 2 Appeal Cases, House of Lords, 388).

The Federal Circuit has also consistently held that a design patent protects the *overall visual impression* created by the combination of the ornamental features shown in the patent's drawings. *Amini Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365, 1370-71 (Fed. Cir. 2006) (design patent protects non-functional aspects of ornamental design seen as a whole), *citing Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993); *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 104 (Fed. Cir. 1996); *Lamps Plus, Inc. v. Dolan*, 2003 U.S. Dist. LEXIS 19578 at *9 (N.D. Tex. 2003) (proper construction of design patent focuses on overall visual impression of ornamental, novel features), *aff'd*, 2006 U.S. App. LEXIS 1076 (Fed. Cir. 2006). While design patents are treated the same as utility patents under the Patent Act (except as expressly indicated otherwise), this Court should properly acknowledge that the scope and importantly, the manner in which the scope of a design patent claim is determined, is a fundamental difference between utility and design patents.

Because of this fundamental difference, application of *Markman* rulings to design patents by trial courts has been confusing at best and at times, indecipherable.

Truisms are often based, at least in part, in fact. In the case of design patents, the saying that “a picture speaks a thousand words” could not be more true. Thus, trial courts have frequently struggled to sufficiently describe design patent drawings, often using hundreds of words to describe patented designs. For example, in one case the trial court described the design for a contemporary ceiling fan that exhibited relatively simple geometric lines, as follows:

The '539 design patent claim is directed to an ornamental design for a combined ceiling fan and light having fan blades that overlie corresponding arms of a central bracket. The central bracket has a circular central opening through which a light fixture dome protrudes downward. The bracket has curved, fin-shaped arms, each of which sweeps outward from its base at the central opening and each of which terminates in a slightly rounded tip. The arms of the bracket are equally spaced about the central opening, and the length of each bracket arm is roughly one-third the length of the corresponding blade. The light fixture dome exhibits a partial sphere that transitions into a generally cylindrical portion adjacent the central bracket. A central housing, located above the fan blades, exhibits a generally cylindrical portion just above the fan blades that transitions into a concave portion.

When viewed from below, the fin-shaped arms of the central bracket [sweep] outward from the central opening in a clockwise

direction, which gives the appearance of a "running" pointed star. A symmetrical, elongated, generally football shaped cutout appears behind the leading edge of each arm. The fan blades are also swept in the clockwise direction, with the leading edges of the blades forming a sweeping curve near the bracket central opening. The trailing edges of the blades are straight but slightly offset from a diameter of the bracket central opening. The trailing edge of each blade smoothly transitions into the trailing edge of the corresponding bracket arm, which further forms a curved transition into the leading edge of the next bracket arm. A gently receding are in front of each bracket arm's leading edge runs from the tip of each arm to the middle of the smooth transition. Each fan blade terminates in a gently rounded corner on the leading edge and a sharply angled, rounded corner on the trailing edge. From its tip, the trailing edge of each bracket arm flares inwardly and rearwardly away from the straight trailing edge of the corresponding blade until it intersects the leading edge of the following blade. Due to the sweep of the bracket arms, the leading edge of each fan blade is substantially more exposed than in the trailing edge of each fan blade.

When viewed from above, the fan blades are swept in the counter-clockwise direction, which also gives the appearance of a pointed "running" star. Also when viewed from above, the trailing edge of the bracket arm is visible at the base of each fan blade.

Minka Lighting, Inc. v. Craftmade Int'l, Inc., 2002 U.S. Dist. LEXIS 8693, *7-9 (N.D. Tex. 2002),⁴ *aff'd*, 93 Fed. Appx. 214, 2004 U.S. App. LEXIS 770 (Fed. Cir. 2004). Close reading of the *Minka* trial court's order clearly evidences that the court did not make the required visual comparison between the design patent drawings and the accused ceiling fan. Rather, the trial court compared the above-cited four hundred and twenty-one word description of the design patent drawings to the accused device, quoting this verbalization *verbatim*. *Id.* at *10-17. Although this Court affirmed the trial court's grant of summary judgment of non-infringement, it did recognize that:

[A] district court need not always verbally construe at length a design patent's drawings. The infringement analysis essentially involves comparing the drawings to an accused device; a verbal description of the drawings does not necessarily aid such a comparison.

93 Fed. Appx. 214 at *5.

This Court has provided some guidance to trial courts on how to properly approach design patent claim construction. For example, in *Durling*, this Court advised that trial courts should endeavor to "translate visual descriptions into words" that "evoke the visual image of the design." 101 F.3d at 103. In *Minka*, this Court further advised that more extensive verbalizations "may be helpful

⁴ This citation is for the magistrate's ruling which was subsequently adopted in its entirety by the trial court. *Minka Lighting, Inc. v. Craftmade Int'l, Inc.*, 2002 U.S. Dist. LEXIS 10760 (N.D. Tex. 2002).

particularly if the drawings contain features that are not part of the patented design, e.g., if the drawings contain functional features or if there is a point of novelty issue to consider.” 2004 U.S. App. LEXIS 770 at *5.

HIPLA urges this Court to provide clarity to trial courts in the proper approach to construing design patent claims. Specifically, trial courts should adhere to a balanced approach when translating the patent drawings into a written description by providing only such detail as necessary to evoke the *overall* visual impression imparted by the design patent drawings. Trial courts should be instructed that overly detailed descriptions are not acceptable and invite the fact finder to undertake an improper comparison of the verbalization to the accused design. Moreover, following this Court’s guidance, trial courts may properly exclude those parts of a patented design that are functional in its claim construction. In addition, it may be appropriate for a trial court to construe the claim of a design patent to exclude from the scope of the claim that territory surrendered during prosecution of the patent application.

4. The points of novelty may be considered during claim construction.

Under the current practice, points of novelty are not identified by the court during claim construction. *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1383 (Fed. Cir. 2004). Rather, it is left to the fact finder to review the evidence, identify the prior art, and determine the points of novelty. *Id.* In

contrast, verbalizing or understanding the overall visual impression imparted by a patented design, an exercise well within the abilities of fact finders, is relegated to courts as a matter of law.

Should this Court maintain a point of novelty test, identification of the points of novelty may be better determined by a court as a matter of law as a part of a court's claim construction rather than by the fact finder. Specifically, identification of points of novelty implicates legally complicated matters, including what constitutes prior art, whether a prior art reference is enabling, and what is disclosed by a prior art reference. Fact finders are ill-equipped to make such determinations that are rooted in decades of court-made rules. While not an easy determination even for courts, judges are much better suited to understanding and applying concepts such as enablement. Therefore, HIPLA urges the Court to consider reallocation of the duties of the court and fact finder in the event the Court maintains both the point of novelty test and verbalization of design patent claims by way of *Markman* rulings.

V. CONCLUSION

For the reasons set forth above, HIPLA requests the Court: (1) cease the use of the point of novelty test as part of the infringement analysis for design patents; and (2) modify the current practice of design patent claim construction by prohibiting detailed verbal description of design patent claims and further detailing those limitations properly included in a design patent claim construction.

Respectfully submitted,



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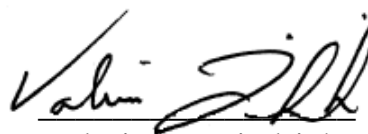
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February 5, 2008



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**United States Court of Appeals
for the Federal Circuit**
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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 BAKER & MCKENZIE, LLP, Attorneys for *Amicus Curiae*.

On the **5th Day of February 2008**, I served the within **AMICUS CURIAE BRIEF ON BEHALF OF THE HOUSTON INTELLECTUAL PROPERTY LAW ASSOCIATION** upon:

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February 5, 2008

