

SAN FRANCISCO BAY AREA INTELLECTUAL PROPERTY  
AMERICAN INN OF COURT

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May 2008 Meeting Announcement:

***“Novel” by Design?***

Currently, a design patent holder has the initial burden to demonstrate that its infringement claim meets both the “ordinary observer test” – which considers whether an ordinary observer would find the two designs substantially the same – and the “point of novelty” test, which requires that “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.’” But in *Egyptian Goddess v. Swisa*, No. 2006-1562, the *en banc* Federal Circuit shortly will consider, *inter alia*, whether “point of novelty” should remain one of the tests for infringement of a design patent, and whether and how claim construction should apply to design patents. The May program will feature a mock *en banc* argument in the *Egyptian Goddess* case.

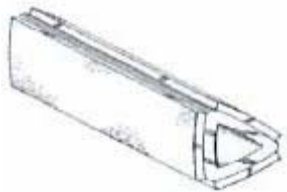
Panelists:	<b>Nicole Lee</b>	<i>Sheppard Mullin</i>
	<b>Gregory Lippetz</b>	<i>Bingham McCutchen</i>
	<b>Martin F. Majestic</b>	
	<b>Scott Schrader</b>	<i>Covington &amp; Burling</i>
	<b>Hon. Bernard Zimmerman</b>	<i>United States Magistrate Judge</i>

Time and Location: **Wednesday, May 21, 2008 at 6:00pm**  
United States Federal Building  
Courtroom G, 15th Floor  
450 Golden Gate Avenue  
San Francisco, California

Dinner to Follow at: Bodega Bistro  
607 Larkin Street (at Eddy)  
415.921.1218

May 2008 Meeting Handout:

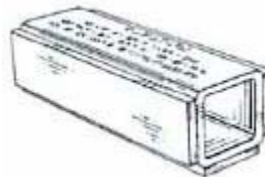
## *“Novel” by Design?*



### *Referenced Prior Art*

*Principal Prior Art:* Nailco Buffer (U.S. Patent D416,648) (top image)

*Other Prior Art References:* Falley Buffer Block (bottom image)



### *Patented Design*

EGI Nail Buffer  
(U.S. Patent D467,389)



### *Accused Design*

Swisa Nail Buffer

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 PLAINTIFF-APPELLANT EGYPTIAN GODDESS, INC.**  
**FOR EN BANC APPEAL**

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January 25, 2008

**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

Egyptian Goddess, Inc. v. Swisa, Inc.  
2006-1562

**CERTIFICATE OF INTEREST**

Counsel for Plaintiff-Appellant certifies the following:

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

Egyptian Goddess, Inc.  
Adi Torkiya

2. The real 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:

Not Applicable

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

Robert G. Oake, Jr., Oake Law Office  
Rudolf O. Siegesmund, Siegesmund and Associates

January 25, 2008

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Robert G. Oake, Jr.  
Attorney for Plaintiff-Appellant

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## STATEMENT OF RELATED CASES

Plaintiff-Appellant Egyptian Goddess, Inc. is not aware of any specific case currently pending in this Court, the Supreme Court, or any other Circuit Court of Appeals that will directly affect or be directly affected by the Court's decision in this case. Egyptian Goddess is generally aware that any design patent case with infringement issues that is currently pending in this Court will be directly affected by the Court's decision in this case.

## JURISDICTION

Appellant and Plaintiff below, Egyptian Goddess, Inc., (Egyptian Goddess) appeals from the following final determinations of the United States District Court for the Northern District of Texas in the action entitled *Egyptian Goddess, Inc. v. Swisa, Inc., et al.*; Civil Action No. 3-03-CV-0594-N: (1) Final Judgment entered July 6, 2006 (JA1) and (2) Order granting motion for summary judgment of Defendants Swisa, Inc. and Dror Swisa (collectively “Swisa”) entered December 14, 2005 (JA2-JA8).

The determinations set forth in (1) and (2) above became final for the purposes of appeal when the district court entered final judgment on July 6, 2006. Pursuant to Federal Rule of Civil Procedure 4(a)(1)(A), Egyptian Goddess filed a timely Notice of Appeal on August 1, 2006 (JA14-JA15).

This Court has jurisdiction under 28 U.S.C. § 1295(a)(1), granting it exclusive jurisdiction over final determinations of a district court if the jurisdiction of that court was based, in whole or in part, on 28 U.S.C. § 1338. The District Court of the Northern District of Texas had subject matter jurisdiction over this action under 28 U.S.C. § 1338(a), as the action arose under Title 35.

## STATEMENT OF THE ISSUES

By the Court:

- (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? *See Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).
- (3) Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

Additionally by Egyptian Goddess:

- (4) Should the district court have granted summary judgment of non-infringement since a material issue of fact exists concerning whether Swisa's buffer infringes under the ordinary observer test?

## STATEMENT OF THE CASE

On March 21, 2003, Egyptian Goddess sued Swisa, Inc. and Dror Swisa for patent infringement in the Northern District of Texas, *Egyptian Goddess, Inc. v. Swisa, Inc., et al.*; Civil Action No. 3-03-CV-0594-N. (JA23; JA37-JA40). Swisa filed an answer and a declaratory judgment counterclaim on April 10, 2003. (JA23; JA41-JA46). Egyptian Goddess answered the counterclaim on April 23, 2003. (JA23; JA47-JA49). On January 21, 2004, Swisa filed a first amended answer and counterclaim against Egyptian Goddess and a third-party complaint against Adi Torkiya. (JA25; JA50-JA56). On February 19, 2004, Egyptian Goddess and Adi Torkiya filed a first amended answer to counterclaim and third party complaint. (JA25; JA57-JA61). A motion for claim construction was filed on October 18, 2004 (JA27), and an order construing the claim of the subject Patent was entered on March 7, 2005 (JA9-JA13).

Swisa filed a motion for summary judgment (JA62-JA63) with brief (JA64) and appendix (JA96) on April 1, 2005. Egyptian Goddess responded (JA289) with appendix (JA333), and Swisa replied (JA419). The district court granted Swisa's motion for summary judgment of non-infringement on December 14, 2005. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 2005 U.S. Dist. LEXIS 32931 (D. Tex. 2005) (JA2-JA8). Both parties filed motions for reconsideration (JA30), and both motions were denied by order entered January 30, 2006. (JA31).

A final judgment was entered by the district court on July 6, 2006, which (1) ordered that Egyptian Goddess take nothing by its claims for patent infringement against Swisa and dismissed those claims with prejudice, and (2) ordered that Swisa's declaratory judgment claims against Egyptian Goddess and Adi Torkiya be dismissed without prejudice. (JA1). Costs of court were taxed in favor of Swisa and against Egyptian Goddess. (JA1). Egyptian Goddess filed a notice of appeal on August 1, 2006. (JA14-JA15). This appeal followed.

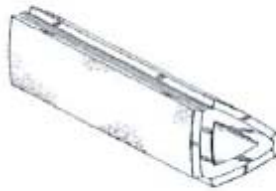
Egyptian Goddess filed a brief, Swisa responded, and Egyptian Goddess replied. Oral argument was held on March 5, 2007. By opinion dated August 29, 2007, this Court affirmed the district court's order. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354 (Fed. Cir. 2007). Egyptian Goddess timely filed a combined petition for panel rehearing and rehearing en banc. Swisa responded. On November 26, 2007, this Court denied the petition for panel rehearing, granted the petition for rehearing en banc, vacated the opinion dated August 29, 2007, and reinstated this appeal. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 2007 U.S. App. LEXIS 27456 (Fed. Cir. 2007). The parties were requested to file briefs addressing issues (1), (2), and (3) listed in the Statement of the Issues above. This Court stated that this appeal would be heard en banc on the basis of briefs addressing, inter alia, issues (1), (2), and (3) set forth above.

## STATEMENT OF FACTS

Egyptian Goddess is the exclusive licensee of all right, title and interest in and to United States Design Patent No. D467,389 (“the D’389 Patent) issued on December 17, 2002 by the United States Patent and Trademark Office. (JA38). Swisa has sold a nail buffer that is substantially similar in distinctive appearance to the D’389 Patent in that the Swisa buffer has a hollow and open ended tube, square in cross section and rectangular in length, with multiple raised rectangular buffer pads mounted on the sides that do not cover the corners of the tube. (JA300-JA301). The Swisa buffer has one more buffer pad than the patented design. The prior art includes solid block buffers (e.g., Falley Buffer Block) and Design Patent No. 416,648 to Letherby (the D’648 Patent, “Nailco” buffer, or “Nailco Patent”) (JA383). Swisa reproduced in its initial response brief (page 7) two prior art buffers and the accused and patented designs as follows:



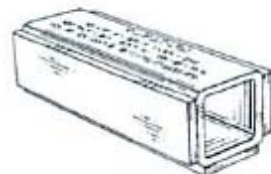
*Falley Buffer  
Block*



*Nailco Patent*



*Swisa Buffer*



*'389 Patent*

An expert witness for Egyptian Goddess, Kathleen Eaton, stated in relevant part as follows in a declaration dated May 3, 2005 (JA334-JA335):

4. Over the years, I have sold thousands of nail buffers to customers. The nail buffers were in a variety of designs, including block buffers. In my experience, when purchasing a nail buffer, customers do not know the difference between, or express a preference for, a “three way” or a “four way” nail buffer.

5. I have looked at the nail buffer design depicted in United States Patent D467,389 (patented design). I also have looked at the nail buffer accused of infringement in the above-styled case (accused nail buffer).

6. In my opinion an ordinary observer and purchaser of nail buffers would consider that the patented design and the accused nail buffer have a substantially similar appearance in overall design, particularly in light of other nail buffers, such as a solid block buffer and the hollow triangular Nailco buffer. In my opinion, the substantially similar appearance in overall design results from both designs having a hollow tube, square in cross section and rectangular in length, with multiple raised rectangular pads mounted on the sides, and that do not cover the corners of the tube.

7. I understand that the accused nail buffer has one more buffer pad than the patented design. However, I do not believe that, to an ordinary observer and purchaser of nail buffers, the presence of one more buffer pad greatly alters the ornamental effect and appearance of the whole design as compared to the whole patented design.

8. In my opinion, the overall designs of the patented design and the accused nail buffer are so similar that in the eyes of an ordinary observer and purchaser of nail buffers, their resemblance is such as to confuse an ordinary observer into purchasing the accused buffer thinking it to be the patented buffer design.

The district court made no determination under the ordinary observer test, but determined that the point of novelty of the D’389 Patent is a fourth side without a buffer pad. Since the accused Swisa buffer does not have a fourth side without a pad, the district court granted summary judgment of non-infringement.

## SUMMARY OF ARGUMENT

### (1) Point of Novelty

The “point of novelty” test should not be a separate and distinct test from the ordinary observer test. Rather, the ordinary observer test should be performed in relation to the prior art. This means that the accused design, to infringe, must present to the eye of an ordinary observer the substantial overall appearance, or visual effect, that distinguishes the patented design from the prior art.

### (2) Claim Construction Issue

In a jury trial, the court should not construe design patent drawings with words. Words have a tendency to make all portions of the drawing perceptively equivalent unless the words expressly increase or decrease the perceptive importance of a particular feature, *i.e.*, by using adjectives and adverbs and by describing a feature as major, minor, prominent, dominant, etc. Using words to increase or decrease the perceptive importance of a particular design feature is improper, however, because the drawing then is not being merely observed by the jury, but rather is being observed by the jury as the design has been interpreted and expressed in words by the court. A jury may or may not place the same perceptive emphasis on a design element as the court. Therefore, in a jury trial, claim construction only should be used to identify the correct design drawing(s) for the

jury (*i.e.*, explain the effect of properly used broken lines and give effect to any words used by the patentee).

### (3) Infringement Analysis

A fact issue exists concerning whether the Swisa nail buffer infringes upon the D'389 Patent because the Swisa buffer substantially appropriates the overall appearance and visual effect that distinguishes the D'389 patented design from the prior art. Both designs have hollow tubes that are square in cross section and rectangular in length, and that have multiple raised pads with exposed gaps at the corners. The Swisa buffer design does not differ from the patented design more widely than the patented design differs from the prior art. While the hollowness, square cross section, and raised pads with exposed gaps create an overall distinctive appearance that widely distinguishes the patented design from the prior art, the only difference in the patented and accused designs is the addition of one buffer pad. An ordinary observer is unlikely to focus on the addition of one buffer pad as a distinguishing characteristic because the prior art is not crowded with generally similar designs (hollow, square in cross section, with multiple raised pads).

## SHORT ANSWERS TO QUESTIONS

- (1) Should "point of novelty" be a test for infringement of design patent?

“Point of novelty” should not be a separate and distinct test for infringement. The ordinary observer test should be performed in relation to the prior art as explained in the argument section below.

- (2) If so, (a) should the court adopt the non-trivial advance test adopted by the panel majority in this case;

This Court should not adopt the non-trivial advance test for the reasons stated by Judge Dyk in his dissenting opinion. Further, the non-trivial advance test is not necessary when the ordinary observer test is made in relation to the prior art.

(b) should the point of novelty test be part of the patentee's burden on infringement or should it be an available defense;

The “novelty” requirement should be returned to the ordinary observer test by requiring that the accused design substantially appropriate the overall appearance or “visual effect” that distinguished the patented design from the prior art. The burden of proof is on the patentee to prove infringement under the ordinary observer test.

(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;

When determining whether two designs are substantially the same under the ordinary observer test, differences in design elements may be considered, but the controlling consideration is the resultant overall visual effect and the comparison is done in relation to the prior art.

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

It should not be necessary to identify a point of novelty. Patented designs often have more than one design element difference, or "point of novelty" from the prior art (whether considered singularly or in combination), but the controlling consideration is the resultant overall visual effect and distinctive appearance of all the design elements as an integrated whole.

and (e) should the overall appearance of a design be permitted to be a point of novelty? *See Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).

It should not be necessary to identify a point of novelty and the issue of whether the overall appearance of a design may be a point of novelty should no longer matter. However, to the extent this Court finds that the issue does matter, *Egyptian Goddess* answers the question in the context of this Court's current "point of novelty" test, as follows:

The argument against allowing the overall appearance of a design to be the point of novelty is that since the overall design is considered in the ordinary observer test, if the overall design is also considered as the point of novelty, it would effectively collapse the point of novelty test into the ordinary observer test. The flaw in this argument, however, is that although the “ordinary observer” test and “point of novelty” test may both produce the “overall design” as a common test result, the common result is arrived at by two fundamentally different processes.

Under the ordinary observer test, the overall patented design is compared to the accused design. Under the point of novelty test, however, the process is different. The overall patented design is compared to the prior art and the point of novelty is that aspect of a design which renders the design different from prior art designs. The point of novelty may be an individual design element, or when all the individual design elements are in the prior art, it may be a combination of design elements. In the situation where the novel combination happens to be the same as the overall design, then the overall design may be the point of novelty. There is no principled reason to automatically disqualify a point of novelty just because it turns out to be the same as the overall design. What is important is that the point of novelty was determined by the process of comparing the design to the prior art and not by simply looking at the overall design.

(3) Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

In a jury trial, design patent drawings should not be construed in words by the court. The ordinary observer test should be performed by visually comparing the patented design to the accused design. Claim construction only should be used to perform such functions as explaining the effect of properly used broken lines in the patent drawings and to give effect to any words used by the patentee.

## STANDARD OF REVIEW

### (1) Summary Judgment of Non-Infringement

The Federal Circuit reviews a district court's grant of summary judgment de novo. *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315 (Fed. Cir. 1998). Summary judgment is appropriate only when there are no genuine issues of material fact and the moving party is entitled to judgment as a matter of law. *See Fed. R. Civ. P. 56(c)*. "In determining whether there is a genuine issue of material fact, the evidence must be viewed in the light most favorable to the party opposing the motion, with doubts resolved in favor of the opponent." *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307 (Fed. Cir. 1998). If there are no material facts in dispute precluding summary judgment, the Federal Circuit's "task is to determine whether the judgment granted is correct as a matter of law." *Marathon Oil Co. v. United States*, 177 F.3d 1331, 1337 (Fed. Cir. 1999).

## ARGUMENT

### I. Point of Novelty

#### A. Law Predating Creation of the Federal Circuit

In *Gorham Co. v. White*, 81 U.S. 511 (1871), the United States Supreme Court established the test for design patent infringement. The Court held 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.” *Id.* at 528. The Court also explained that the “controlling consideration” was whether the “effect” of the designs was the same. *Id.* at 525, 526. (“We do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect.”). The “main test of substantial identity of appearance” was considered to be “sameness of effect upon the eye.” *Id.* at 527.

Cases following *Gorham* emphasized “that on the issue of infringement a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent from the prior art.” *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933)

(and cases cited therein). Although the “distinctive appearance” principle was not expressly stated as a requirement for infringement in *Gorham*, a careful review of the Court’s infringement analysis indicates that the principle had been satisfied. In *Gorham*, the Supreme Court stated:

Applying this rule to the facts of the present case, there is very little difficulty in coming to a satisfactory conclusion. The Gorham design, and the two designs sold by the defendant, which were patented to White, one in 1867, and the other in 1868, *are alike the result of Peculiarities of outline, or configuration, and of ornamentation.* These make up whatever is *distinctive in appearance*, and of these, the outline or configuration is most impressive to the eye.

*Id.* at 528-529. (emphasis added).

“Distinctive” is a comparative term. The Gorham and White designs could not accurately be described as “distinctive” unless they were being compared against the prior art spoon designs that an ordinary observer was generally familiar with.

In *Applied Arts*, the court found no conflict between the *Gorham* ordinary observer test and the requirement that the accused design must present the appearance that distinguished the patented design from the prior art. The full rationale of the court is worth reproducing:

It has been held, however, that a design patent stands on as high a plane as utility patents, [cites omitted], and that on the issue of infringement a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent from the prior art. [cites omitted]. Thus is presented a difficulty. The Supreme Court has said (*Gorham v. White, supra*) that

sameness of effect upon the eye is the main test of substantial identity of design, but it is not essential that the appearance should be the same to the eye of the expert. It is sufficient if it is the same to the ordinary observer. Yet it is clearly the rule that similitude of appearance is to be judged by the scope of the patent in relation to the prior art. The question at once presents itself: Are these tests of identity in conflict? What does the ordinary observer, at least in the common acceptance of that phrase, know of the prior art? If the two tests are to be reconciled, some qualification must be recognized as applied to the ordinary observer. A careful analysis of *Gorham v. White*, and other adjudicated cases supplies the answer. The ordinary observer is not any observer, but one who, with less than the trained faculties of the expert, is "a purchaser of things of similar design," or "one interested in the subject." The mythical prudent man in negligence cases is not the Hottentot or Abyssinian who has never seen a locomotive or driven an automobile, but one who has average familiarity with such instrumentalities, and can form a reasonable judgment as to their speed and mode of operation. So is the average observer not one who has never seen an ash tray or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it. This view is confirmed by the factual analysis which the Supreme Court gave to the evidence in the *Gorham* Case, laying its greatest stress upon the evidence of sameness there given by the large number of witnesses "familiar with designs, and most of them engaged in the trade."

The court reasoned there was no conflict because the ordinary observer, who already possessed reasonable familiarity with the prior art,<sup>1</sup> necessarily made the

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<sup>1</sup> In *Gorham*, the Supreme Court held that ordinary observers were not experts. Rather, ordinary observers were observers of "ordinary acuteness," having "ordinary intelligence," and who "are the principal purchasers of the articles to which designs have been given novel appearances." *Gorham, supra*, at 528. The Supreme Court disagreed with the lower court's opinion that "there could be no infringement unless there was 'substantial identity' 'in view of the observation of a person versed in designs in the particular trade in question – of a person engaged in

comparison in relation to the prior art. The requirement that the accused design must present the appearance that distinguished the patented design from the prior art was not a second test distinct from the ordinary observer test, but was rather *part of the ordinary observer test* and a necessary requirement of infringement.

Importantly, the court stated that the accused design had to present the *appearance* that distinguished the patented design from the prior art. Although there was consideration of the individual design elements that contributed to the distinct appearance, the court did not attempt to identify a precise point of novelty in the patented design and then determine whether the accused design contained that point of novelty. Rather, the ultimate consideration was whether the overall appearance that distinguished the patented design from the prior art also was present in the accused design. The court's analysis was consistent with the *Gorham* teaching that "[w]e do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect." *Gorham, supra*, at 526.

The court's opinion then explained why it was important to make the comparison in relation to the prior art:

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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.” *Id.* at 527.

So viewing the test that is to be applied on the issue of infringement, it appears to us that while there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art. .... 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.

*Applied Arts, supra*, at 430. In short, it was important to make the comparison in relation to the prior art because designs that may appear similar in isolation may appear different when compared in light of the prior art.

The Court also used a practical test for analyzing infringement. When the accused design differed from the patented design more widely than the patented design differed from the prior art, there was no infringement. This practical test had been used in other cases as well. *See, e.g., Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co.*, 114 F. 362, 363 (U.S. Court of Appeals 1902) (“The shape of defendants' bell differs from plaintiff's more widely than plaintiff's differs from the [bell shaped] door knob, and therefore defendants' construction does not infringe the patent.”). The practical test made sense because if the ordinary observer was able to distinguish the patented design from the prior art, and the differences between the accused design and the patented design were greater than the differences

between the patented design and the prior art, then the ordinary observer also was able to distinguish between the accused and patented designs.

The Court in *Applied Arts* also made a useful observation concerning the ability of an ordinary observer to distinguish designs when the prior art was crowded:

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.

*Applied Arts, supra*, at 430. This made sense because an ordinary observer accustomed to making distinctions based on relatively minor differences in a crowded field was less likely to be confused by general design similarities.

In sum, the test for design patent infringement as expressed in *Gorham* and *Applied Arts* was whether the appearance of the patented and accused designs had such similar effect upon the eye that an ordinary observer would purchase the accused design thinking that it was the patented design. The comparison was made in relation to the prior art, which as a practical matter, meant three things. First, to infringe, the accused design had to present the appearance that distinguished the patented design from the prior art. Second, if the accused design differed from the patented design more widely than the patented design differed from the prior art, then there was no infringement. Third, when the prior art was crowded, the

ordinary observer made a more discriminative examination and comparison of the patented and accused designs, which meant that the scope of the design patent was construed more narrowly in a crowded field of prior art.

## B. Federal Circuit Law

This Court's first design patent case involving issues of infringement<sup>2</sup> was *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423 (Fed. Cir. 1984).

This Court's entire discussion of the infringement issue was as follows:

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. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 20 L. Ed. 731 (1871). This test requires 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." *Id.* at 528.

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." *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944); *Horwitt v. Longines Wittnauer Watch Co.*, 388 F. Supp. 1257, 1263, 185 USPQ 123, 128 (S.D.N.Y. 1975). That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art. (This "point of novelty" approach applies only to a determination of infringement. *See, e.g., Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983). This court

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<sup>2</sup> Two earlier design patent cases before the Federal Circuit involved issues of validity (*In re Salmon*, 705 F.2d 1579 (Fed. Cir. 1983) and double patenting (*Carman Industries, Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983)).

has avoided the point of novelty approach in other contexts. *See, e.g., Carman Industries, Inc. v. Wahl*, 724 F.2d 932 at 940 (Fed. Cir. 1983) (double patenting); *In re Gulack*, 703 F.2d 1381, 1385 n. 8, 217 USPQ 401, 403 n. 8 (Fed. Cir. 1983) (unobviousness).)

The novelty of the '990 patent consists, in light of our analysis in the previous section on the '990 patent's validity, of the combination on a microwave oven's exterior of a three-stripe door frame, a door without a handle, and a latch release lever on the control panel. The district court expressly found, however, that the Whirlpool design had none of these features.

We recognize that minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement. In this case, however, "while there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art." *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933). Where, as here, a field is crowded with many references relating to the design of the same type of appliance, we must construe the range of equivalents very narrowly.

We hold, therefore, that the scope of protection which the '990 patent affords to a microwave oven is limited in application to a narrow range: the three-stripe effect around a door with no handle and the latch release mounted on the control panel. The Whirlpool ovens, therefore, do not infringe the '990 design patent. The contrary conclusion of the district court is clearly erroneous, being attributable to its failure to apply the correct legal standard of infringement in design patent cases.

*Id.* at 1444.

In *Litton Systems*, this Court acknowledged the *Gorham* and *Applied Arts* principles that (1) the *Gorham* "ordinary observer" test was the test for design

patent infringement, (2) to infringe the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art, (3) if the accused design differed from the patented design more widely than the patented design differed from the prior art, then there was no infringement, and (4) when the prior art was crowded with generally similar designs, the range of equivalents<sup>3</sup> was construed narrowly.

However, in *Litton Systems* this Court did not state that the “novelty” requirement was part of the ordinary observer test. Rather, this Court appeared to treat the novelty requirement as separate from the ordinary observer test. This Court 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." [cite omitted]. *That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art.*

*Litton Systems, supra*, at 1444. (emphasis added).

The italicized statement suggested that the test for design patent infringement is performed in two distinct steps. First, the court compares the two designs through the eye of an ordinary observer. Second, if the designs are

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<sup>3</sup> This Court has stated that “it has long been recognized that the principles of equivalency are applicable under *Gorham*.” *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988)).

confusingly similar to an ordinary observer, then to find infringement the court must attribute the similarity to the novelty that distinguished the patented design from the prior art. The “two distinct tests” approach is, in fact, the way this Court has expressed the design patent infringement test after *Litton Systems*. See *Shelcore, Inc. v. Durham Industries, Inc.*, 745 F.2d 621, 629 (Fed. Cir. 1984) (*Litton* ... supplements the [ordinary observer] test with the requirement that “the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.”); *Sun Hill Indus. v. Easter Unlimited*, 48 F.3d 1193, 1197 (Fed. Cir. 1995) (“Beyond the substantial similarity requirement of *Gorham* and *L.A. Gear*, design patent infringement requires that the accused product ‘appropriate the novelty in the patented device which distinguishes it from the prior art.’”) (quoting *Litton*); *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1320 (Fed. Cir. 2007) (“In a separate and distinct inquiry, the ‘point of novelty’ test requires proof that the accused design appropriated the novelty which distinguishes the patented design from the prior art.”).

### C. Problems with the Point of Novelty Test

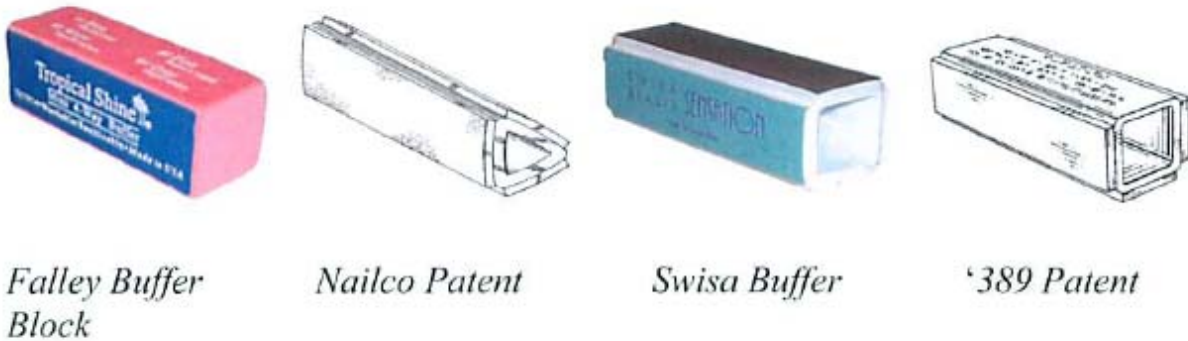
When the “novelty” requirement is separated from the ordinary observer test, the overall patented and accused designs no longer are compared in relation to the prior art. This eliminates the infringement requirement that the accused design present the substantial overall appearance (visual effect to the eye) that

distinguishes the patented design from the prior art. A separate and distinct point of novelty test therefore departs from the infringement principles discussed in *Gorham* and *Visual Arts*.

Further, a separate and distinct point of novelty test creates two problems. First, often it is difficult to identify a “point of novelty.” A design with several design elements may have several points of novelty over any given prior art design. The number depends on whether the points of novelty may be individual design elements, combinations of design elements, and whether the overall design can be identified as a point of novelty. When the patented design is compared against more than one prior art design, each of which has multiple and varied design elements, the difficulty of identifying a single and precise point of novelty increases. Under these circumstances, it becomes extremely difficult, if not impossible, to consistently and predictably identify a single point of novelty.

The instant case provides an example. Even though the claimed buffer design is relatively simple, there are several different possible points of novelty. If the claimed ‘389 Patent design is compared against the Nailco Patent, then possible points of novelty are the square cross section (as opposed to triangular cross section) and the absence of a raised buffer pad on one side. These were the points of novelty identified by Swisa below. *See Egyptian Goddess, Inc. v. Swisa, Inc.*,

2005 U.S. Dist. LEXIS 32931, \*6, n.5 (D. Tex. 2005) (“Swisa appears to count this as two points of novelty (fourth bare side and square cross section)”).



However, if the patented design is compared against the prior art solid block buffer, then possible points of novelty are the hollow and open tube and raised buffer pads with open corners. If the claimed design is compared against both these prior art buffers, then the point of novelty can be expressed as an “open, hollow tube, square in cross section, with raised pads that do not cover the corners of the tube.” This is the combination point of novelty proposed by Egyptian Goddess below. *Id.* at \*5, n.4. The point of novelty also possibly could be the overall appearance of the claimed buffer, in which case it would be an “open, hollow tube, square in cross section and rectangular in length, with three raised pads that do not cover the corners of the tube.”

Finally, even after certain design elements are identified as novel, the “point of novelty” can be expressed in different ways that will influence the infringement outcome. For example, the district court expressed Swisa’s proposed point of

novelty of a square cross section and the absence of a raised buffer pad on one side as “a fourth side without a pad.”<sup>4</sup> *See Id.* at \*6 (“Because the Swisa product does not include the point of novelty of the D’389 Patent -- a fourth side without a pad -- there is no infringement.”).<sup>5</sup> This particular expression of the “point of novelty” resulted in a summary judgment of non-infringement even though the expression did not describe the overall visual “effect” and appearance of the patented design that distinguished it from the prior art (for example that the ‘389 Patent Design was square in cross section and the Nailco Patent was triangular in cross section).

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<sup>4</sup> Egyptian Goddess argued below that a “fourth side without a pad” cannot be a point of novelty by itself because a “fourth side without a pad” already existed in the Tammy Taylor prior art buffer. (JA82; JA103; JA120).

<sup>5</sup> In some rare cases, a point of novelty can be relatively easy to identify. For example, in *Horwitt v. Longines Wittnauer Watch Co.*, *supra*, (cited by this Court directly after the *Sears* citation in *Litton Systems*), the patented design was a blank watch face with a single dot at the twelve o’clock position. The point of novelty was determined to be the single dot on the watch face (as compared against two prior art watches with blank faces). In such a rare case, it is tempting to express the infringement requirement that the accused design possess the same distinctive overall appearance that distinguishes the patented design from the prior art as a “point of novelty” test. It is tempting because such a “point of novelty” test is a quick and objective way to analyze whether infringement has occurred. Further, since a single possible point of novelty always creates the distinctive appearance from the prior art, the “point of novelty” test is easy to apply and provides the same result as the test which asks whether the accused design has the same distinctive overall appearance that distinguishes the patented design from the prior art. However, in the usual case when there are several possible points of novelty resulting from multiple design differences and multiple varied prior art designs, a separate “point of novelty” test quickly becomes difficult to apply and capricious in result for the reasons discussed in this brief. In such a situation, the *Gorham* and *Applied Arts* principles should be used not only because they are precedential, but because they offer a more complete and durable analysis that provides an objective and more predictable result.

When multiple points of novelty are available, the plaintiff patentee usually chooses one that is in the accused design,<sup>6</sup> and the accused infringer usually chooses one that is not in accused design. Contrary to *Gorham*, there currently is no required consideration of the visual impact the chosen points of novelty have on the overall appearance of the design and the effect they have upon the eye of an ordinary observer. But even if this Court began to require such a consideration when choosing a “point of novelty”, the test still would be contrary to *Gorham* because the “controlling consideration” under *Gorham* is not individual design differences or combinations of design differences, but rather the resultant overall effect of the design upon the eye of an ordinary observer.

The second problem is that when the “novelty” (distinctiveness from the prior art) requirement is separated from the ordinary observer test, designs that are in the prior art or obvious over the prior art can satisfy the ordinary observer test. Although the separate “point of novelty” test prevents exact prior art designs from

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<sup>6</sup> This so-called “shopping list” approach has been condemned by district courts. See *Hosley Int’l Trading Corp. v. K Mart Corp.*, 237 F. Supp. 2d 907, 911-13 (N.D. Ill. 2002); *Bush Indus., Inc. v. O’Sullivan Indus., Inc.*, 772 F. Supp. 1442, 1452 (D. Del. 1991). This Court in *Egyptian Goddess* agreed with Swisa “that the point of novelty should be determined by comparing the claimed design to the prior art and not to the accused design.” 498 F.3d at 1357, n.1. This Court further stated that “[a]s an appellate court, however, we review the merits of the asserted point of novelty and not the motive behind its selection.” *Id.* The problem remains concerning which point of novelty to choose from when more than one has merit.

being captured under the infringement test,<sup>7</sup> there is nothing to prevent designs obvious in light of the prior art from being considered infringements.<sup>8</sup> The need to provide such protection may have motivated this Court to create the “non-trivial advance” test.<sup>9</sup> However, the “non-trivial advance” test,<sup>10</sup> having substantive similarities to an obviousness test, is not the proper solution for the reasons stated by Judge Dyk in his dissent. *See Egyptian Goddess, supra*, 498 F.3d at 1359.

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<sup>7</sup> An accused design that is an exact copy of a prior art design will not possess the “point of novelty” that distinguishes the patented design from the copied design.

<sup>8</sup> Such a result can be prevented in utility patent cases through a hypothetical claim obviousness analysis. *See Key Mfg. Group, Inc. v. Microdot, Inc.*, 925 F.2d 1444, 1449 (Fed. Cir. 1991).

<sup>9</sup> Another motivation may have been the instinctive and common sense desire to make the initial visual comparison between the patented and accused designs in relation to the prior art, a requirement that had been removed from the ordinary observer test after *Litton Systems*. Such a comparative instinct was demonstrated by expert witness Kathleen Eaton when she stated in her May 3, 2005 Declaration that “[i]n my opinion an ordinary observer and purchaser of nail buffers would consider that the patented design and the accused nail buffer have a substantially similar appearance in overall design, *particularly in light of other nail buffers*, such as a solid block buffer and the hollow triangular Nailco buffer.” (emphasis added) (JA335).

<sup>10</sup> This Court cited *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893) as support for the “non-trivial advance” test. 498 F.3d at 1357. Following the case citation, this Court added the parenthetical “(analyzing whether the accused device contained the aspects of the claimed design that ‘rendered it patentable as a complete and integral whole’)”. *Id.* Egyptian Goddess respectfully submits that the quoted phrase from *Whitman Saddle* is better understood as the Supreme Court determining whether the accused saddle substantially appropriated the distinctive overall appearance of the patented saddle design that distinguished it from the prior art (and made it patentable). The Court did not just identify a “point of novelty” in the patented saddle design and then determine whether the identified point of novelty was in the accused saddle. Rather, the Court considered the novel aspect of the saddle design as being inseparable from “a complete and integral whole” for purposes of an infringement comparison with the accused saddle.

#### D. Proposed Solution to the Problems

To solve these problems, this Court should eliminate the separate and distinct point of novelty test and return the “novelty” (distinctiveness from the prior art) requirement to the ordinary observer test. The comparison between the patented and accused designs then will be made in relation to the prior art and the test for design patent infringement will be consistent with *Gorham*. Since under *Gorham* the accused design must substantially present the overall *appearance* (effect upon the eye of an ordinary observer) that distinguishes the patented design from the prior art, there is no need to identify a precise point of novelty and then determine whether the identified point of novelty is in the accused design.

Further, when the “novelty” requirement is returned to the ordinary observer test, the accused device also is compared to the prior art, which then eliminates the need for a requirement that the point of novelty be a non-obvious or “non-trivial” advance over the prior art. If the accused design contains a distinctive appearance substantially similar to that which distinguished the patented device from the prior art (and made it patentable), then the accused design also should constitute a non-trivial and non-obvious advance over the prior art.<sup>11</sup>

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<sup>11</sup> This should eliminate the need for the type of hypothetical claim obviousness analysis currently performed in utility patent cases to limit the range of equivalents.

## II. Claim Construction

In *Gorham*, the Supreme Court explained that the “controlling consideration” was whether the “effect” of the designs was the same, *id.* at 525, 526, and the “main test of substantial identity of appearance” was considered to be “sameness of effect upon the eye.” *Id.* at 527. The Court quoted Lord Westbury’s statement in *Holdsworth v. McCrea*, 2 Appeal Cases, House of Lords, 388 that “the eye alone is the judge of the identity of the two things.” *Id.* at 526. This Court has stated that the scope of the claim of a patented design “encompasses ‘its visual appearance as a whole,’ and in particular ‘the visual impression it creates.’” *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104-05 (Fed. Cir. 1996)).

Since the controlling consideration is sameness of effect upon the eye, a court should not construe a design with words. Although a court should instruct a jury on *how* to make a comparison between the patented design and the prior art, a court should not tell a jury what it is seeing when the jury looks at the patented design, for the following reasons:

First, it is difficult to properly and precisely describe with words a design that consists of anything more than simple geometric shapes. Usually the scope of the description will be too broad, too narrow, or too ambiguous. When presented

with the same written description and asked to produce a drawing, ten people may produce ten different designs.

Second, when a drawing is described in words, the words have a tendency to make all portions of the drawing perceptively equivalent unless the words expressly increase or decrease the visually perceptive importance of a particular feature, i.e., by using adjectives and adverbs and by using descriptive terms such as major, minor, prominent, dominant, etc. If such words are not used, then it is virtually impossible for the court to express what the court believes is the visual “effect” of the design upon the eye of an ordinary observer.

However, when descriptive words are used to increase or decrease the visually perceptive importance of a particular design feature, the drawing then is not being merely observed by the jury, but rather is being observed by the jury *as the design has been interpreted and expressed in words by the court*. The problem with this is that a jury (after being properly instructed on the ordinary observer test) may or may not place the same perceptive emphasis on a design element as the court. It is the jury’s perception, and not the court’s, that is important on the factual infringement issue in a jury trial. Therefore, in general, patent design claim drawings<sup>12</sup> should not be expressed in writing by the court. Rather, after the

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<sup>12</sup> The claim of a design patent usually is just the design drawings. *See* MPEP 1503.01 (“No description, other than a reference to the drawing, is ordinarily required.”). The MPEP further states that “[n]o description of the design in the

appropriate claimed drawing(s) have been identified by the Court (i.e., by explaining the effect of broken lines<sup>13</sup> and by giving effect to any words used by the patentee), such patent design drawing(s) should be shown to the jury for a comparison with the accused design for the infringement or invalidity analysis.<sup>14</sup>

In *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) this Court stated that a court should construe a design drawing in words so “the parties and appellate courts can discern the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design.” *Durling* involved a bench trial on the invalidity issue of whether a primary reference existed in an obviousness analysis. Since *Durling* was a bench trial, the court’s claim construction had no effect on a jury. However,

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specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. *In re Freeman*, 23 App. D.C. 226 (App. D.C. 1904).”

<sup>13</sup> 37 CFR 1.152 provides that “[b]roken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that cannot be seen through opaque materials.”

<sup>14</sup> Claim construction also has been used to eliminate aspects of the design considered functional and therefore not ornamental. See *OddzOn Prods. v. Just Toys*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”). The district court in the instant case stated in its claim construction order, that “[t]he Court must next consider whether any of the design features are functional.” (JA11). However, since under *Gorham* the overall visual effect of the design is to be considered when determining infringement, the overall visual effect is what must be non-functional (ornamental). See *Berry Sterling Corp. v. Prescor Plastics, Inc.*, 122 F.3d 1452, 1455 (Fed. Cir. 1997). If the overall design is found to be functional, however, then the issue is one of validity and not infringement.

even though a court should not construe a design with words for a jury, a court still can express the design or parts of the design in words to explain the court's own internal reasoning on issues of law involving the design. For example, although in *Gorham* there was no written "claim construction" of the patented design, the Supreme Court used words to describe the designs and the reasoning supporting its decision.

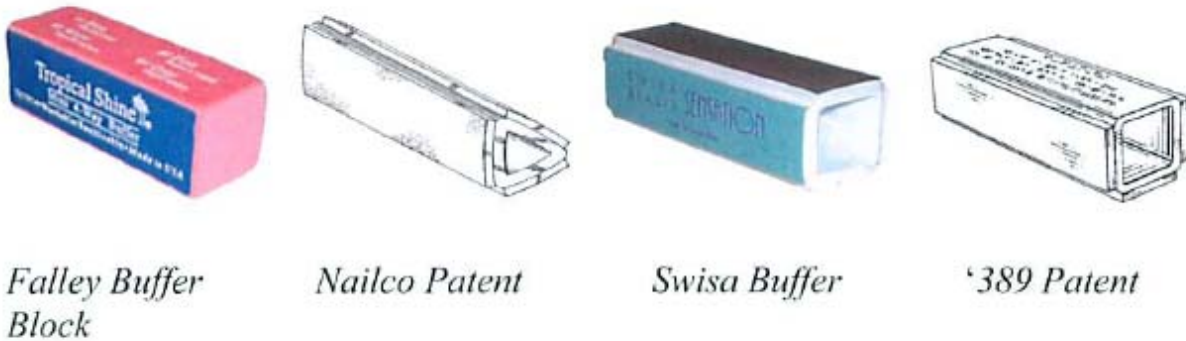
### III. Infringement Analysis

Under *Gorham*, the ultimate infringement issue is whether in the eye of an ordinary observer, the appearance of the Swisa nail buffer is similar enough to the patented design to deceive such an observer, inducing him or her to purchase the Swisa buffer supposing it to be the patented design. The controlling consideration is whether the visual effect of the designs is substantially the same in the eye of an ordinary observer.

The comparison is to be made in light of the prior art, which means that to infringe, the Swisa buffer design has to present substantially the appearance that distinguishes the D'389 Patent design from the prior art. If the prior art is crowded with generally similar designs, then the ordinary observer may make a more discriminative examination and comparison of the Swisa and patented designs.

Each party should be allowed to argue the infringement issue as a factual matter. Egyptian Goddess will argue that the distinctive appearance of the D'389

Patent design in relation to the prior art is created by the hollow tube that is square in cross section and that has raised pads with exposed gaps at the corners.



The hollowness and raised pads distinguish the D'389 Patent design's overall appearance and visual effect from the solid buffer pads with no raised pads and the square cross section distinguishes the D'389 Patent's overall appearance and visual effect from the Nailco Patent.<sup>15</sup> Egyptian Goddess will argue that the Swisa nail buffer appropriates the distinctive overall appearance and visual effect of the D'389 Patent design because the Swisa buffer also has a hollow tube that is square in cross section and that has raised pads with exposed gaps at the corners.<sup>16</sup>

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<sup>15</sup> There should be no dispute concerning whether an ordinary observer should be generally familiar with the Falley block buffers and the Nailco buffer design because these buffers were being widely marketed and sold during the time of alleged infringement in this case. Whether an ordinary observer should be familiar with other prior art buffer designs should be a question of fact.

<sup>16</sup> Kathleen Eaton, expert witness for Egyptian Goddess, supports this conclusion in her May 3, 2005 declaration by stating "[i]n my opinion, the substantially similar appearance in overall design results from both designs having a hollow tube, square in cross section and rectangular in length, with multiple raised rectangular pads mounted on the sides, and that do not cover the corners of the tube." (JA335).

If appropriate,<sup>17</sup> Egyptian Goddess will argue further that the Swisa buffer design does not differ from the D’389 Patent design more widely than the patented design differs from the prior art. While the hollowness, square cross section, and raised pads create an overall distinctive appearance that widely distinguishes the D’389 Patent design from the prior art, the only difference in the patented and accused designs is the addition of one buffer pad. Finally, Egyptian Goddess will argue that an ordinary observer is unlikely to focus on the addition of one buffer pad as a distinguishing characteristic because the prior art is not crowded with generally similar designs.<sup>18</sup>

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<sup>17</sup> *Gorham* did not mention the “practical test” for determining infringement. There appear to be different ways of expressing a test of this nature. For example, in *Applied Arts* the test was expressed once in terms of similarities and once in terms of differences. (Compare the statement “... it appears to us that while there is some *similarity* between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such *similarity* as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art” with the statement “[t]here 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.”). 67 F.2d at 430 (emphasis added). The issue is factual in nature and to the extent it is included in a jury instruction, it may be appropriate to make such a “practical test” a relevant infringement factor rather than a strict test. While Egyptian Goddess believes the practical test outcome is clear in this case, it may be closer in others.

<sup>18</sup> The patented and accused designs have been pictured side by side in this brief for reader convenience. However, in *Gorham* the Supreme Court cautioned that the ordinary observer test is not a side by side comparison. 81 U.S. at 527.

Swisa likely will argue something contrary. The important point is that a genuine issue of material fact exists on the *Gorham* ordinary observer test and a jury should decide the issue after being properly charged by the court.

#### CONCLUSION AND RELIEF SOUGHT

The final judgment entered by the district court on July 6, 2006, which ordered that Egyptian Goddess take nothing by its claims for patent infringement against Swisa, dismissed those claims with prejudice, and taxed court costs in favor of Swisa and against Egyptian Goddess, should be reversed and remanded for trial. Egyptian Goddess respectfully requests that this Court apply the patent infringement principles as discussed above to the patented and accused designs and remand this case for trial with instructions consistent with the principles of law discussed herein.

Respectfully submitted this 25th day of January, 2008.

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Attorney for Plaintiff-Appellant

## ADDENDUM

<u>Item</u>	<u>Description</u>	<u>Page(s)</u>
1.	Final Judgment	JA1
2.	Summary Judgment Order	JA2-JA8
3.	Claim Construction Order	JA9-JA13
4.	Notice of Appeal	JA14-JA15
5.	United States Design Patent 467,389	JA16-JA19

IN THE UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

EGYPTIAN GODDESS, INC.,

Plaintiff,

v.

SWISA, INC., *et al.*,

Defendants.

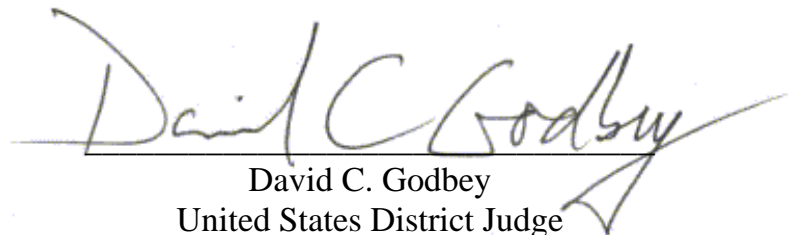
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Civil Action No. 3:03-CV-0594-N

**FINAL JUDGMENT**

By Order dated December 14, 2005, the Court granted Defendants Swisa, Inc. and Dror Swisa's (collectively, "Swisa") motion for summary judgment finding no infringement. By separate Order of this same date, the Court had determined to dismiss Swisa's declaratory judgment claims. It is, therefore, ordered that Plaintiff Egyptian Goddess, Inc.'s take nothing by its claims for patent infringement against Swisa and those claims are dismissed with prejudice. It is further ordered that Swisa's declaratory judgment claims against Egyptian Goddess, Inc. and Adi Torkiya are dismissed without prejudice. Costs of court are taxed in favor of Swisa and against Egyptian Goddess, Inc. All relief not expressly granted is denied. This is a final judgment.

SIGNED July 6, 2006.

  
David C. Godbey  
United States District Judge

IN THE UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

EGYPTIAN GODDESS, INC.,

Plaintiff,

v.

SWISA, INC., *et al.*,

Defendants.

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Civil Action No. 3:03-CV-0594-N

**ORDER**

Before the Court is the motion for summary judgment of Defendants Swisa, Inc. and Dror Swisa (collectively, “Swisa”) on Plaintiff Egyptian Goddess, Inc.’s (“EGI”) claims for infringement of United States Design Patent 467,389 (the “D’389 Patent”) for a nail buffer.<sup>1</sup> The Court holds that Swisa’s allegedly infringing product does not incorporate the point of novelty of the D’389 Patent – a fourth, bare side to the buffer. Accordingly, the Court grants Swisa’s motion without reaching its other noninfringement and obviousness arguments.

**I. BACKGROUND**

The designs at issue in this case involve simple geometric shapes – triangles, squares, rectangles, rounded corners. The D’389 Patent is for a fingernail buffer designed to hold

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<sup>1</sup>This being a device that polishes or buffs the surface of a person’s fingernail, e.g., in the course of a manicure.

buffing pads of different abrasiveness in a way that is easy for the manicurist to hold.<sup>2</sup> A page of the drawings from the D’389 Patent is attached as Exhibit “A.”

In its Order of March 3, 2005 (the “Markman Order”), the Court construed the D’389 Patent as follows:

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.

Markman Order at 3. In deference to *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371 (Fed. Cir. 2004), the Court declined to address points of novelty in the course of claims construction, but noted the possibility that a court could in an appropriate case and appropriate record address points of novelty at summary judgment. Markman Order at 2 n.1. This now appears to be an appropriate case.

## II. POINT OF NOVELTY

A plaintiff in a design patent infringement case must prove both that the accused device is “substantially similar” under the “ordinary observer” test, and that the accused device contains “substantially the same points of novelty that distinguished the patented design from the prior art.” *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162

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<sup>2</sup>This explanation is for background only; the Court is not importing functionality into its design patent analysis.

F.3d 1113, 1121-22 (Fed. Cir. 1998). “The points of novelty relate to differences from prior designs, and are usually determinable based on the prosecution history.” *Id.* at 1118. In the context of design patents, “[t]he scope of prior art is not the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of articles sufficiently similar that a person of ordinary skill would look to such articles for their designs.” *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997).<sup>3</sup>

Unsurprisingly, the parties disagree as to the points of novelty in the D’389 Patent. EGI identifies four design elements,<sup>4</sup> and then for each element identifies prior art that does not embody that element. Based on this reasoning, EGI claims that the point of novelty of the D’389 Patent is the combination of those four elements. *See, e.g., L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993); *Rubbermaid Commercial Prods. v. Contico Int’l, Inc.*, 836 F. Supp. 1247, 1258-60 (W.D. Va. 1993). Swisa condemns this as an impermissible “shopping list approach.” *See, e.g., Bush Indus., Inc. v. O’Sullivan Indus., Inc.*, 772 F. Supp. 1422, 1452-54 (D. Del. 1991); *Int’l Trading Corp. v. K-Mart Corp.*, 237 F. Supp. 2d 907, 911-13 (N.D. Ill. 2002).

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<sup>3</sup>*Hupp* used this scope for prior art in an obviousness analysis. Swisa suggests applying it in the points of novelty context also. The Court sees no reason not to follow *Hupp* in the points of novelty context. The fact that infringement is judged from the viewpoint of an ordinary observer intending to purchase the patented object suggests that the pertinent field is that of the patented object, rather than all design. Moreover, so limiting the scope of prior art favors EGI.

<sup>4</sup>The design elements were: (1) open and hollow body; (2) square cross section; (3) raised rectangular pads; and (4) exposed corners. *See* EGI Brief at 20-21.

The Court need not resolve the “combination vs. shopping list” dispute, because here a single prior reference combines all of EGI’s alleged design elements, save one. United States Design Patent No. 416,648 (the “Nailco Patent”) discloses a nail buffer with an open and hollow body, raised rectangular pads, and open corners. *See* Exhibit “B” (drawings from the Nailco Patent). EGI cannot claim the combination of those three elements in the D’389 Patent as novel when they were already combined in the Nailco Patent. The only point of novelty in the D’389 Patent over the Nailco Patent is the addition of the fourth side without a pad, thereby transforming the equilateral triangular cross-section into a square.<sup>5</sup> In the context of nail buffers, a fourth side without a pad is not substantially the same as a fourth side with a pad. Because the Swisa product does not include the point of novelty of the D’389 Patent – a fourth side without a pad – there is no infringement. Accordingly, the Court grants Swisa’s motion for summary judgment.<sup>6</sup>

### CONCLUSION

Swisa’s motion is not entirely clear which claims and causes of action it intends to address in its motion. EGI originally sued Swisa for infringement. Swisa asserted a reflexive counterclaim for declaratory judgment. Swisa then joined Torkiya as a third-party defendant

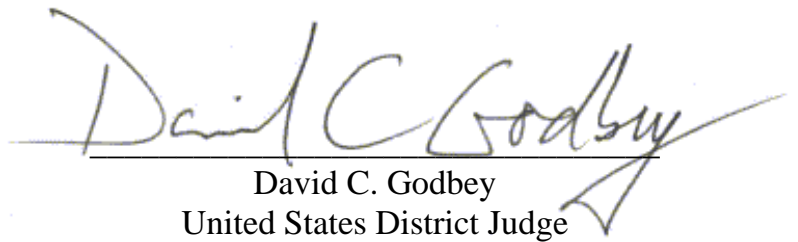
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<sup>5</sup>Swisa appears to count this as two points of novelty (fourth bare side and square cross section), *see* Swisa Reply Brief at 11, apparently allowing for the possibility that the fourth side might be a different length or joined at other than a right angle. Because all of the prior art cited to the Court has involved regular polygons, the Court tends to discount that possibility. In any event, whether it is counted as one or two points of novelty is immaterial to the analysis.

<sup>6</sup>Given the Court’s finding of no infringement, it need not reach Swisa’s invalidity argument.

to its declaratory judgment claims. It appears to the Court that this ruling probably resolves all matters presently in dispute among the parties, but that may not be correct. Accordingly, the Court directs the parties to confer regarding the possibility of an agreed form of judgment consistent with this Order, and if agreement is not possible, to promptly place before the Court any other matters that must be resolved prior to entry of a final judgment.

SIGNED December 14, 2005.



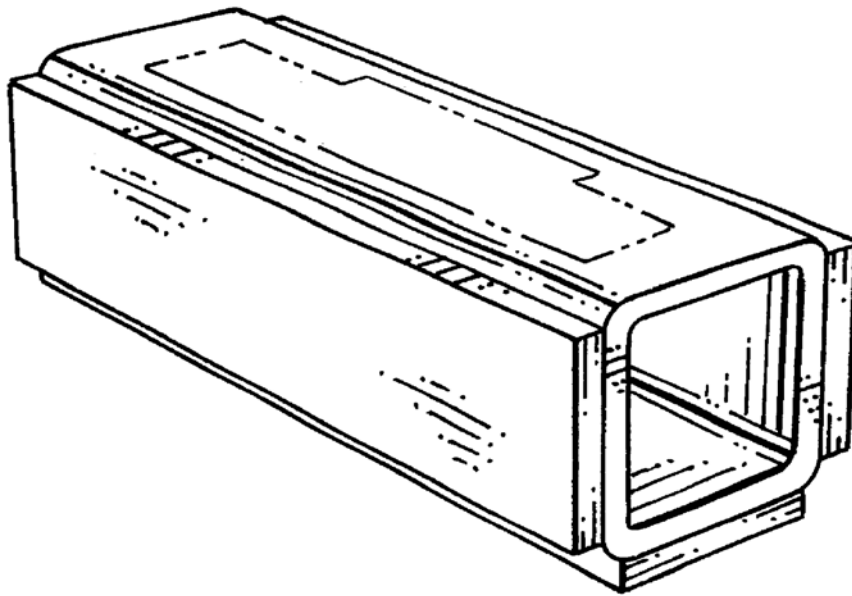
David C. Godbey  
United States District Judge

**U.S. Patent**

Dec. 17, 2002

Sheet 1 of 3

**US D467,389 S**



**FIG. 1**

Exhibit "A" – the D'389 Patent

**U.S. Patent**

Nov. 16, 1999

Sheet 1 of 2

**Des. 416,648**

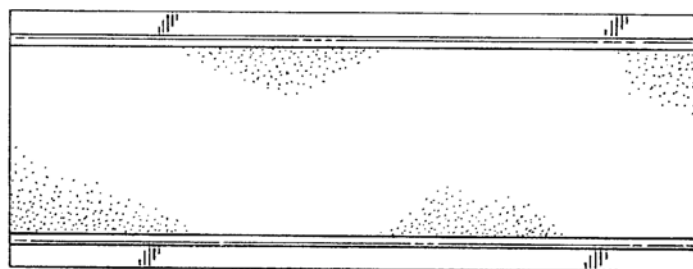
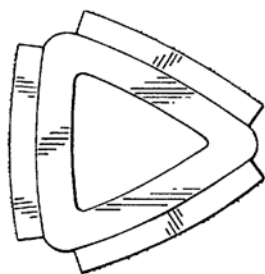
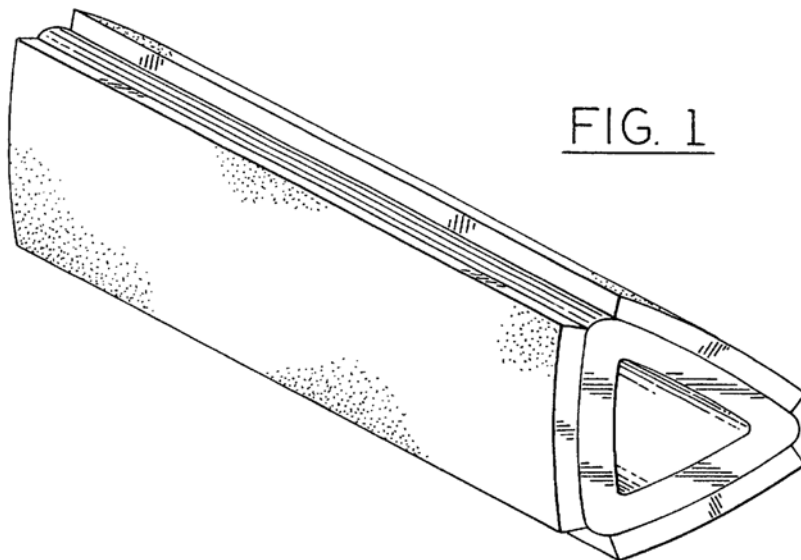
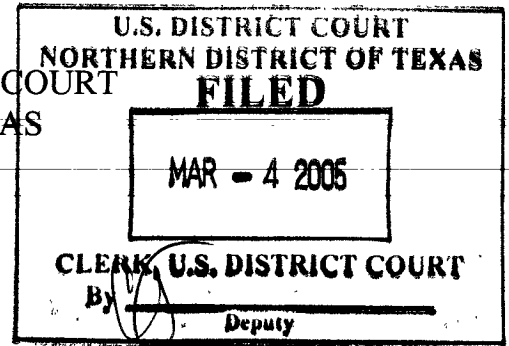


Exhibit "B" – The Nailco Patent

ORIGINAL

IN THE UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



EGYPTIAN GODDESS, INC.,

Plaintiff,

v.

SWISA, INC., *et al.*,

Defendants.

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Civil Action No. 3:03-CV-0594-N

**ORDER**

Before the Court is Plaintiff Egyptian Goddess, Inc.'s ("EGI") motion for claim construction, pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). The Court holds that points of novelty should not be addressed as a matter of law at the claim construction stage. The Court also holds that none of the salient design features of the nail buffer are functional. Finally, and perhaps most important, the Court construes the design at issue as having three sides with abrasive surfaces and a fourth side with no abrasive surface.

EGI is the holder of United States Design Patent D467,389 (the "Buffer Patent"). The Buffer Patent claims "[t]he ornamental design for a nail buffer, as shown and described." A nail buffer apparently is an implement that a manicurist, for example, would utilize in giving a nail manicure to a customer. EGI claims in this action that Swisa, Inc. ("Swisa") sells a product that infringes on the Buffer Patent. In the instant motion, the parties devote

the bulk of their briefing to points of novelty and functionality, with strangely little said about claim construction.

The point of novelty issue has been clarified by *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371 (Fed. Cir. 2004). As here, the parties in *Bernhardt* disagreed on whether points of novelty should be considered at claim construction or at infringement. “Finding that the points of novelty issue was a question for the fact finder, the [district] court postponed a determination of the points of novelty until trial.” *Id.* at 1375. The Federal Circuit did not expressly address this holding. However, it did address “the question, ‘What evidence must be presented to prove infringement under the point of novelty test?’” *Id.* at 1383. By framing the issue in that manner, the Federal Circuit was at least implicitly holding that the district court correctly determined that the point of novelty test was a question of fact for the fact finder when considering infringement, and not a matter to be addressed by the Court at claim construction. This Court will likewise decline to address points of novelty at claim construction. *Accord Lamps Plus, Inc. v. Dolan*, 2003 WL 22435702, \*4 (N.D. Tex. 2003).<sup>1</sup>

The Court must now construe the claim of the Buffer Patent. In doing this, the Court is guided by *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996):

In the design patent context, however, the judge’s explanation of the decision is more complicated because it involves an additional level of abstraction not required when comprehending the matter claimed in a utility

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<sup>1</sup>This holding does not mean that a court could not in an appropriate case determine points of novelty as a matter of law on an appropriate record at summary judgment.

patent. Unlike the readily available verbal description of the invention and of the prior art that exists in a utility patent case, a design patent case present the judge only with visual descriptions. Given the lack of a visual language, the trial court must first translate these visual descriptions into words – *i.e.*, into a common medium of communication.<sup>2</sup> From this translation, the parties and appellate courts can discern the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design.

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<sup>2</sup>When properly done, this verbal description should evoke the visual image of the design.

Although *Durling* was not decided in the context of claim construction, many courts have applied its teaching to claim construction of design patents. *See, e.g., Lamps Plus, supra*, at \*3; *Minka Lighting, Inc. v. Craftmade Int'l, Inc.*, 2001 WL 1012685, \*20 (N.D. Tex. 2001); *Bernhardt L.L.C. v. Collezione Europa USA, Inc.*, 2003 WL 21254634, \*1 (M.D.N.C. 2003), *rev'd on other grounds*, 386 F.3d 1371 (Fed. Cir. 2004). Accordingly, the Court will attempt to translate the visual descriptions of the drawings in the Buffer Patent into words that evoke the visual image of the design.

The Court construes the Buffer Patent as claiming:

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.

The Court must next consider whether any of the design features are functional.

We apply a stringent standard for invalidating a design patent on grounds of functionality: the design of a useful article is deemed functional where “the appearance of the claimed design is ‘dictated by’ the use or purpose of the article.” *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (citing *In re Carletti*, 328 F.2d 1020, 1022 (C.C.P.A. 1964)). “[T]he design must not be governed solely by function, i.e., that this is not the only possible form of the article that could perform its function.” *Seiko Epson Corp. v. Nu-Kote Int’l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999). “When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.” *L.A. Gear*, 988 F.2d at 1123 (citations omitted). That is, if other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional.

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

[T]he utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.


*L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (citations omitted).

Here Swisa has not shown that the appearance of the Buffer Patent is dictated by its utilitarian purpose. Swisa argues that the gap between the abrasive pads is required to prevent damage to the cuticle. But, Swisa has not made a satisfactory showing that damage would occur without the gap, or that the rounded radius providing the gap is the only way such a gap could be made, i.e., a flat side separating the pads would also provide a gap between the abrasive pads. Swisa argues that the hollow tube configuration is functional because it permits the manicurist to insert a finger in the buffer and control the buffer. But

Swisa has not shown that inserting a finger in the buffer is the only way to control the buffer, nor has it shown that other shapes could not provide the same result, i.e., a cylindrical hollow. Finally, Swisa has not shown that a four-sided block shape is required for a nail buffer. A variety of geometrical shapes could conceivably perform a similar function. Thus, the Court holds that the design of the Buffer Patent is not functional.

Based on the briefing, the Court has the impression that Swisa may view the Court's claim construction as dispositive of the merits of this case. Accordingly, the case is stayed for fourteen days to permit Swisa to file a motion for summary judgment on that basis, if it chooses to do so. If Swisa chooses to file such a motion, the case is stayed pending disposition of that motion.

SIGNED this 3 day of March, 2005.

  
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David C. Godbey  
United States District Judge

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

EGYPTIAN GODDESS, INC.,	§	
	§	
Plaintiff and Counter-Defendant,	§	
	§	
VS.	§	
	§	
	§	
SWISA, INC. and DROR SWISA,	§	
INDIVIDUALLY,	§	
	§	CIVIL ACTION NO. 3-03-CV-0594-N
Defendants, Counter-Plaintiffs and	§	
Third-Party Plaintiffs,	§	ECF
	§	
VS.	§	
	§	
ADI TORKIYA,	§	
	§	
Third-Party Defendant.	§	

NOTICE OF APPEAL

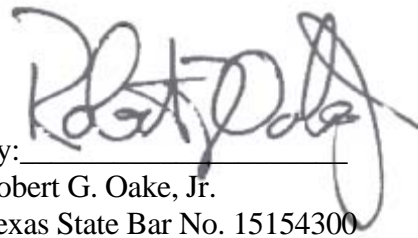
1. Pursuant to rules 3 and 4 of the Federal Rules of Appellate Procedure, Plaintiff Egyptian Goddess, Inc. files this Notice of Appeal.
2. The party taking the appeal is Plaintiff Egyptian Goddess, Inc.
3. The judgment and orders being appealed are:
  - a. Judgment filed and entered July 6, 2006 ordering that Plaintiff Egyptian Goddess, Inc. take nothing by its claims for patent infringement and dismissing the claims with prejudice and taxing costs of court against Egyptian Goddess, Inc. [Document 99];
  - b. Order granting motion for summary judgment dated and entered on December 14, 2005 [Document 75];
  - c. Order denying Plaintiff Egyptian Goddess, Inc.'s motion for reconsideration [Document 85] signed January 27, 2006 and entered on January 30, 2006; and

d. Order signed March 3, 2005, filed March 4, 2005, and entered March 7, 2004 construing the patent at issue [Document 60].

4. Plaintiff Egyptian Goddess, Inc. also gives notice of intent to appeal all non-final orders and rulings which produced or are related to the judgment and orders specifically referred to in paragraph 3 above.

5. This appeal is taken to the United States Court of Appeals for the Federal Circuit.

Respectfully submitted,



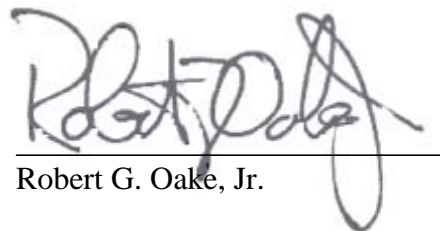
By: \_\_\_\_\_  
Robert G. Oake, Jr.  
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Oake Law Office  
1333 W. McDermott Dr., Suite 200  
Allen, Texas 75013  
(469) 519-2755  
(469) 519-2756 (Fax)

Attorney for Plaintiff and Third-Party Defendant

CERTIFICATE OF SERVICE

I certify that on August 1, 2006, a true and correct copy of the foregoing was served under the Federal Rules of Civil Procedure and by agreement of the parties to the following:

Frederick L. Medlin  
KIRKPATRICK & LOCKHART LLP  
2828 North Harwood Street, Suite 1800  
Dallas, Texas 75201  
Attorneys for Defendant



Robert G. Oake, Jr.



US00D467389S

(12) **United States Design Patent** (10) **Patent No.:** **US D467,389 S**  
**Torkiya** (45) **Date of Patent:** **\*\* Dec. 17, 2002**

(54) **NAIL BUFFER**

(76) Inventor: **Adi Torkiya**, 114 Oak Bend Dr.,  
Coppell, TX (US) 75019

(\*\*) Term: **14 Years**

(21) Appl. No.: **29/155,619**

(22) Filed: **Feb. 13, 2002**

**Related U.S. Application Data**

(62) Division of application No. 29/149,507, filed on Oct. 11,  
2001, now Pat. No. Des. 459,548.

(51) **LOC (7) Cl. .... 28-03**

(52) **U.S. Cl. .... D28/59**

(58) **Field of Search .... D28/56, 57, 59;**  
D4/119, 121, 137; D8/90-94; D32/40, 52;  
132/73, 73.5, 75, 75.6, 76.4, 76.5; 451/490,  
522-525, 540, 552-558; 15/167.3

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\* cited by examiner

*Primary Examiner*—Ted Shooman

*Assistant Examiner*—C. Tuttle

(74) *Attorney, Agent, or Firm*—Gardere Wynne Sewell LLP

(57) **CLAIM**

The ornamental design for a nail buffer, as shown and described.

**DESCRIPTION**

FIG. 1 is a perspective view of a nail buffer in accordance with my invention;

FIG. 2 is a left side elevation view of the nail buffer shown in FIG. 1;

FIG. 3 is a right side elevation view of the nail buffer shown in FIG. 1;

FIG. 4 is a front elevation view of the nail buffer shown in FIG. 1;

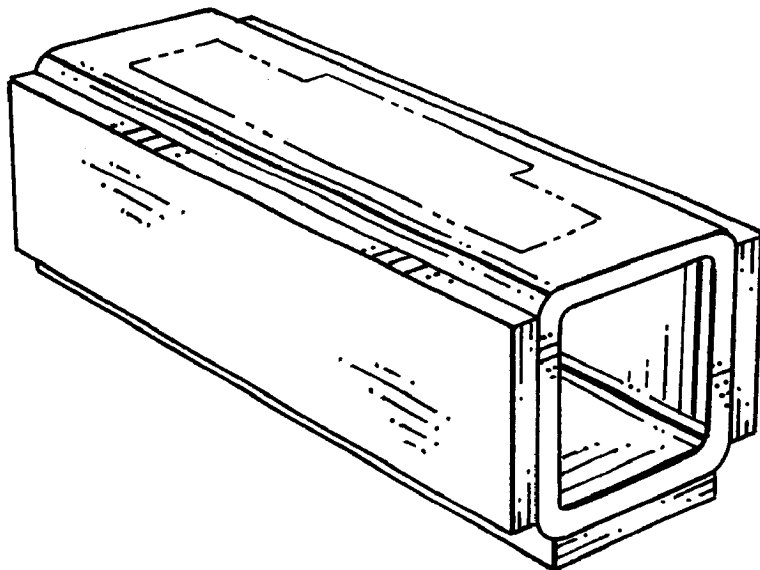
FIG. 5 is a rear end elevation view of the nail buffer shown in FIG. 1;

FIG. 6 is a top plan view of the nail buffer shown in FIG. 1; and,

FIG. 7 is a bottom plan view of the nail buffer shown in FIG. 1.

The dashed outlines in the views of FIGS. 1 and 6 showing the location of indicia are for illustrative purposes only and form no part of the claimed design.

**1 Claim, 3 Drawing Sheets**



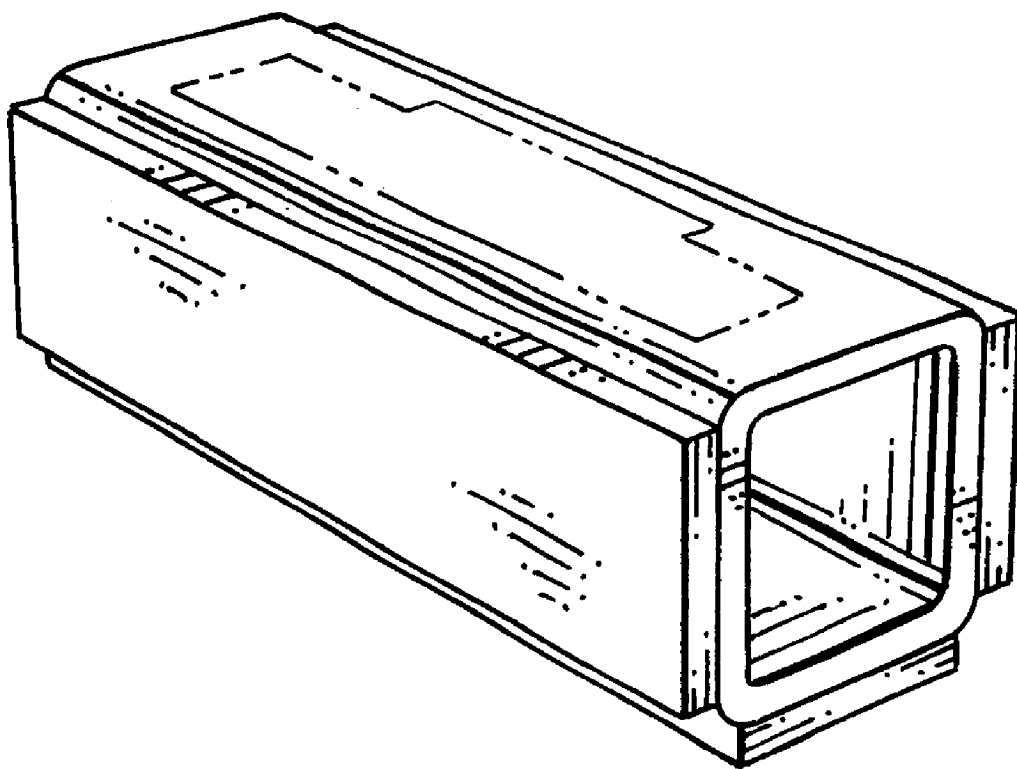


FIG. 1

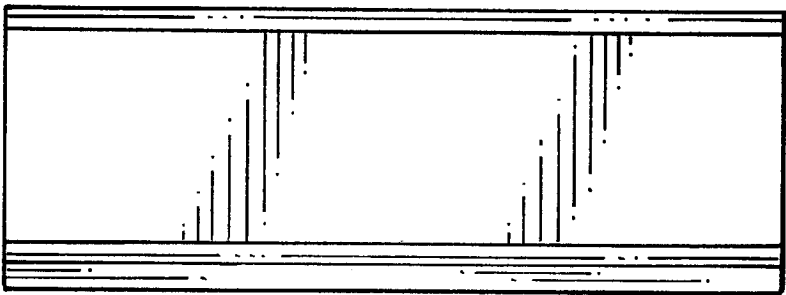


FIG. 2

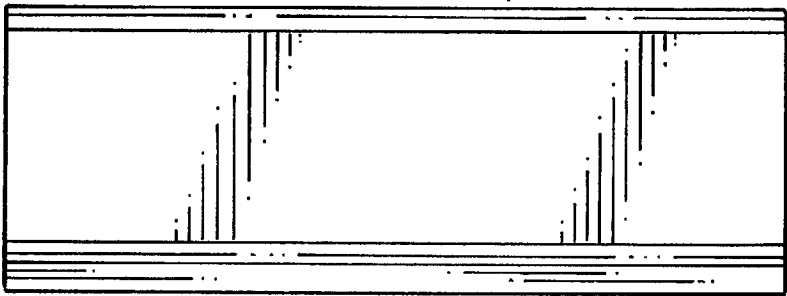


FIG. 3

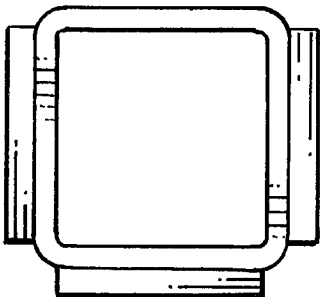


FIG. 4

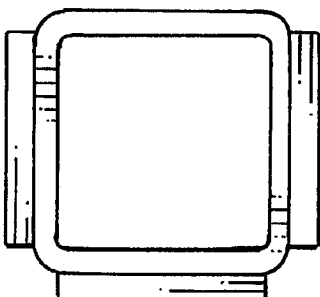


FIG. 5

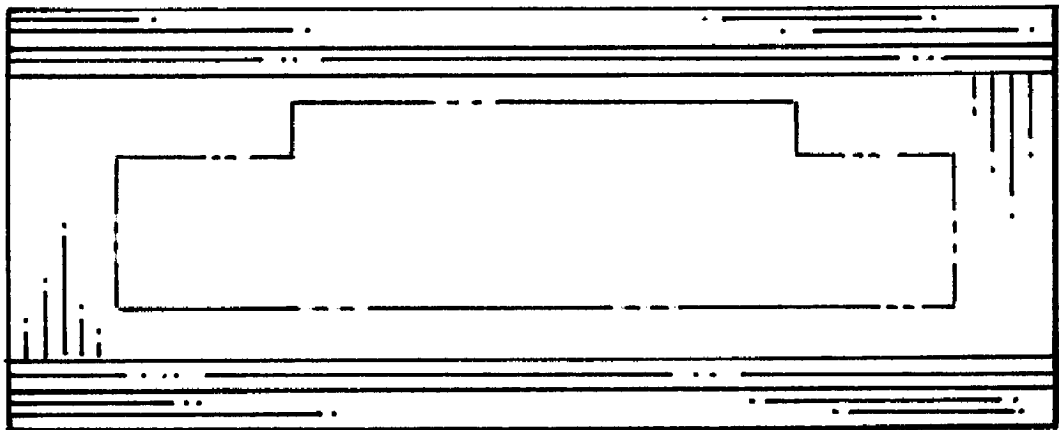


FIG. 6

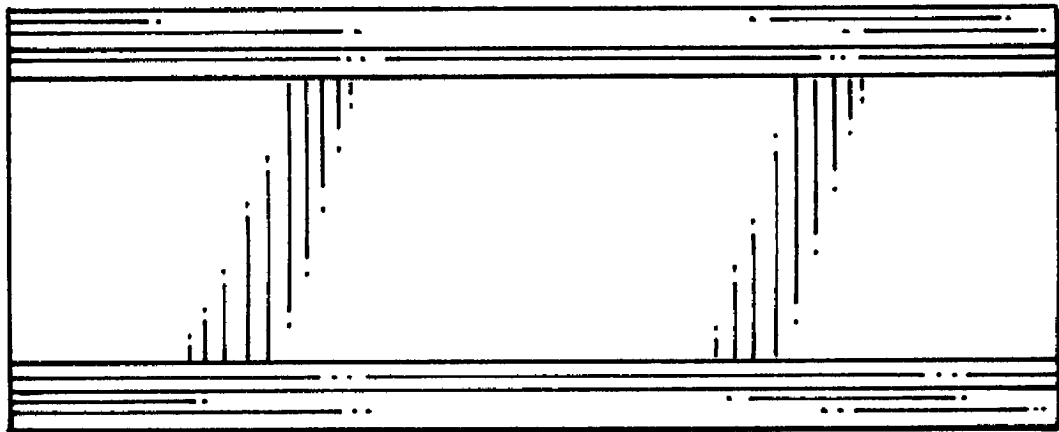


FIG. 7

CERTIFICATE OF SERVICE

Pursuant to this Court's order dated November 26, 2007, and pursuant to Fed. R. Civ. P. 25(d)(1)(B), I certify that on January 25, 2008, I caused 2 copies of the foregoing brief to be served via U.S. Mail on the attorney listed below:

Frederick L. Medlin  
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Attorneys for Swisa

I also certify pursuant to Fed. R. Civ. P. 25(d)(2) that on January 25, 2008, pursuant to this Court's order dated November 26, 2007, and pursuant to Fed. R. Civ. P. 25(a)(2)(B)(ii), I served upon the Clerk of this Court the original and thirty copies of the foregoing brief by dispatch to a third-party commercial carrier (Federal Express) for delivery to the Clerk of this Court within 3 calendar days (for Monday Morning delivery, January 28, 2008).

---

Robert G. Oake, Jr.  
Attorney for Plaintiff-Appellant  
January 25, 2008

### CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B). This brief contains 9,349 words, excluding the parts of the brief exempted by the Federal Rules of Appellate Procedure 32(a)(7)(B)(iii).
2. This brief complies with the typeface requirements of Federal Rules of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rules of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman font.

---

Robert G. Oake, Jr.  
Attorney for Plaintiff-Appellant  
January 25, 2008

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

**REPLY BRIEF OF PLAINTIFF-APPELLANT**  
**EGYPTIAN GODDESS, INC. FOR EN BANC APPEAL**

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**FILED**  
U.S. COURT OF APPEALS FOR  
THE FEDERAL CIRCUIT

MAR 24 2008  
JAN HOFBALY  
CLERK

## FORM 9. Certificate of Interest

## UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Egyptian Goddess, Inc. v. Swisa, Inc.

No. 2006-1562

## CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

Egyptian Goddess, Inc. certifies the following (use "None" if applicable; use extra sheets if necessary):

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

Egyptian Goddess, Inc.  
Adi Torkiya

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:

Not Applicable

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:

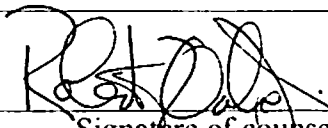
None

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 now represented by me in the trial court or agency or are expected to appear in this court are:

Robert G. Oake, Jr., Oake Law Office  
Rudolf O. Siegesmund, Siegesmund and Associates

March 24<sup>th</sup> 2008  
Date

  
Signature of counsel  
Robert G. Oake, JR.  
Printed name of counsel

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## REPLY ARGUMENT

### INTRODUCTORY COMMENT

A major problem with the “point of novelty” test is that when multiple possible points of novelty exist in a patented design, it is extremely difficult, if not impossible, to consistently and predictably identify a point of novelty. This is particularly true over a variety of designs and fact patterns. This major problem was pointed out and illustrated by Egyptian Goddess in its principal brief.

Swisa agrees there is a problem. Swisa states: “[t]he nature of the point of novelty test, however, becomes far more complex in situations where the alleged points of novelty draw on several items of prior art, none of which are that close to the patented design.” (Swisa Response, page 12). However, after recognizing the problem, Swisa sidesteps it. Swisa states: “[b]ut such scenarios are far from the facts before the Court in this case.” *Id.*

Egyptian Goddess believes that the collective task in this en banc appeal is to formulate an infringement test that works well over a variety of designs, and not to sidestep the difficult issues. Swisa advocates a customized infringement test for this case. However, there already is enough confusion in the law of design patents. Developing a customized test for each type of design patent case would not lead to less confusion. Rather, it would lead to more confusion as parties then began arguing over which customized test to apply to a given fact pattern.

I. Point of Novelty test

A. *Whitman Saddle*

As a brief review, Egyptian Goddess proposes that the “novelty” aspect of the infringement test be returned to the ordinary observer test. This is accomplished by comparing the patented and accused designs in light of the prior art. To infringe, an accused design has to present substantially the appearance that distinguishes the patented design from the prior art. If the prior art is crowded with generally similar designs, the ordinary observer may make a more discriminative examination and comparison of the patented and accused designs. Finally, a potential “practical test” asks whether the accused device is closer to the prior art than it is to the patented design. If so, then infringement is unlikely.

Swisa argues against the proposed Egyptian Goddess test and in favor of a separate and distinct point of novelty test. Swisa cites *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893) for support. Swisa states “the *Whitman Saddle* Court focused on the presence or absence of a single innovative feature in the allegedly infringing saddle rather than asking the less precise question of whether the difference between the Whitman saddle and the accused saddle was greater than between the Whitman saddle and the prior art saddles.” Swisa Brief, page 16. (Swisa’s emphasis).

Swisa then posits: “[s]uppose the test for infringement had been the less precise formulation of whether the Whitman saddle with its Jenifer/Granger combination with a dropped pommel was closer to the accused saddle, a Jenifer/Granger combination but without a dropped pommel, than the accused saddle was to the prior art (which apparently lacked the precise combination of the Jenifer/Granger saddles).” Swisa Brief, page 18. Swisa continues “[u]nder such a test a modern jury could easily hold that, despite the lack of a dropped back to the pommel, the accused saddle was closer to the Whitman design than to the prior art,” and “[t]hus, under this less precise test—which would not identify what element was novel in the patented design and determine if it were present in the accused design—infringement could be found.” *Id.*

In short, Swisa argues that if the test proposed by Egyptian Goddess is applied to the facts of *Whitman Saddle*, a modern jury could find infringement, whereas the Supreme Court in *Whitman Saddle* found no infringement. Swisa concludes that “*Whitman Saddle* thus illustrates a problem in weighing the difference between the patented design and the accused design against the difference between the accused design and the prior art,” *id.*, with the problem being that “[t]he accused design can seem closer to the patented design than to the prior art, but yet not incorporate the inventive feature of the accused design.” *Id.*

There are two major problems with Swisa's analysis. First, Swisa makes an unjustified assumption about the prior art in *Whitman Saddle*. Specifically, Swisa incorrectly assumes that the prior art did not include the specific Granger/Jenifer saddle tree combination. Second, the infringement decision in *Whitman Saddle* was influenced heavily by the patentability analysis in the opinion, and the standard for patentability in *Whitman Saddle* was different than the standard for patentability in either this case or in *Gorham v. White*, 81 U.S. 511 (1871).

To properly understand the prior art in *Whitman Saddle*, it is helpful to understand basic saddle technology. The foundation of the saddle is called the saddle tree. It is the frame upon which everything else is built. It is called a saddle tree because originally it was always made of wood. A saddle tree consists of different parts that are attached together and then covered with leather. A good explanation of the parts of a western saddle tree can be found at <http://www.western-saddle-guide.com/saddle-tree.html>. A good explanation for the way a western saddle tree is constructed can be found at [http://www.freckerssaddlery.com/saddle\\_tree.php](http://www.freckerssaddlery.com/saddle_tree.php).

The saddle trees in *Whitman Saddle* are not western saddle trees because they do not have horns. However, the designs do consist of different parts, which include the front portion, or pommel, and the back portion, or cantle. The important point is that the pommel and cantle are separate wooden parts, and

different styles of pommel and cantle can be put together in different arrangements before being attached together and covered with leather by the manufacturer.

Swisa states that “the [*Whitman Saddle*] opinion never states that the prior art contained a saddle that combined the rear or cantle of the Jenifer saddle and the front of the Granger saddle, but without the drop at the back of the Granger pommel.” Swisa Brief, page 17. Swisa then states “[r]ather it states that it was common to combine the Jenifer cantle with **other** saddles.” *Id.* (Swisa’s emphasis). With respect, that is wrong. The *Whitman Saddle* opinion never states “that it was common to combine the Jenifer cantle with other saddles,” and the opinion never states that the Granger/Jenifer combination was not found in the prior art. To the contrary, a thorough and fair reading of the entire opinion indicates otherwise.

*Whitman Saddle* states that two designs for trees and saddles in the prior art were the Granger tree (Granger) and the Jenifer tree or Jenifer-McClellan saddle (Jenifer). *Whitman Saddle, supra*, at 680. The Granger had a cut-back pommel and a low, broad cantle. *Id.* The Jenifer had a high, prominent pommel and a high-backed cantle, or hind protuberance, in the shape of a duck’s tail. *Id.* The opinion states that both of these styles were “well-known.” *Id.* The saddle and saddle tree exhibits admitted at trial included, among others, “a slotted Granger saddle, the Jenifer-McClellan, the Sullivan-Black-Granger tree, and the saddle sold

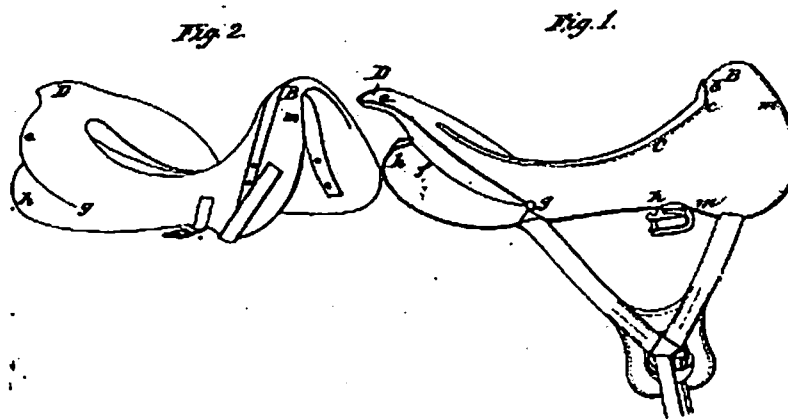
by defendants, the latter being substantially the Granger saddle with the Jenifer cantle.” *Id.*

The Supreme Court discussed the prior art evidence as follows: “The evidence established that there were several hundred styles of saddles or saddle-trees belonging to the prior art, and that it was customary for saddlers to vary the shape and appearance of saddle-trees in numerous ways according to the taste and fancy of the purchaser.” *Id.* at 681. A reasonable interpretation of this sentence is that saddlers would combine different parts and styles of saddle tree components to build custom saddle trees desired by buyers.

The opinion continues: “[a]nd there was evidence tending to show that the Granger tree was sometimes made up with an open slot and sometimes without, and sometimes with the slot covered and padded at the top and sometimes covered with plain leather; while it clearly appeared that the Jenifer cantle was used upon a variety of saddles, as was the open slot.” *Id.* The “open slot”<sup>1</sup> is the center longitudinal slot that extends from pommel to cantle. The open slot is illustrated in the drawings of United States Design Patent 10,844 (“the ‘844 Patent”), as follows:

---

<sup>1</sup> The inventor explained in the ‘844 Patent that “I am aware that portions of the curves employed by me have been used in the designing of saddles; but when combined with a longitudinally-slotted tree, the lines I employ to give the profile form a new design for saddles...”



The sentence quoted above includes the phrase “while it clearly appeared that the Jenifer cantle was used upon a variety of saddles.” Swisa interprets this phrase as meaning that the Jenifer cantle was used upon a variety of saddles *other than the Granger saddle*. But that is not what the sentence states. Rather, a fair interpretation of the next two sentences in the opinion indicates that the Jenifer cantle had been combined with the Granger pommel.

The next sentence states: “[n]othing more was done in this instance (except as hereafter noted) than to put the two halves of these saddles together in the exercise of the ordinary skill of workmen of the trade, *and in the way and manner ordinarily done.*” *Id.* (emphasis added). The next sentence states: “[t]he presence or the absence of the central open slot was not material, and we do not think that the addition of a known cantle [Jenifer] to a known saddle [Granger], *in view of the fact that such use of the cantle was common*, in itself involved genius or invention, or produced a patentable design.” *Id.* (emphasis added).

A fair interpretation of the emphasized language is that it was common to combine the Jenifer cantle with other saddles, *including* the Granger. This is a fair interpretation because the opinion states “there were several hundred styles of saddles or saddle-trees belonging to the prior art,” and the Jenifer and Granger were both “well known.” Indeed, the Supreme Court states that such a combination was “common”: (“we do not think that the addition of a known cantle [Jenifer] to a known saddle [Granger], *in view of the fact that such use of the cantle was common*, in itself involved genius or invention, or produced a patentable design.”). *Id.* (emphasis added).

Finally, near the end of the *Whitman Saddle* opinion, the Supreme Court states:

As before said, the design of the patent had two features of difference as compared with the Granger saddle, one the [Jenifer] cantle, the other the drop. And unless there was infringement as to the latter there was none at all, since the saddle design of the patent does not otherwise differ from the old [Granger] saddle with the old [Jenifer] cantle added, *an addition frequently made*. (emphasis added).

*Id.* at 682. A fair interpretation of this language is that according to the Supreme Court’s interpretation of the prior art evidence, the Jenifer cantle was frequently added to the Granger saddle.

The conclusion that the prior art included the Granger/Jennifer combination also is supported by language used by the inventor in his patent. The inventor states: “I am aware that portions of the curves employed by me have been used in

the designing of saddles; but when combined with a longitudinally-slotted tree, the lines I employ to give the profile form a new design for saddles...." '844 Patent. The inventor expressly claims the novelty in his design is created by the addition of the longitudinal slot. Notably, the inventor does not claim the novelty is created by combining a Jenifer cantle with a Granger pommel. If such design had been new to the art, the inventor no doubt would have mentioned it. He did not.

Why then did the trial court believe the Jenifer/Granger combination was novel and deserving of patent protection? The answer lies in the language used by the trial court to explain its rationale on patentability. The court stated:

It is truly said that the military Jenifer or the Jenifer-McClellan saddle-tree had a high, peaked cantle, and a high, prominent pommel, whereas the Granger tree had a "cut back" pommel, and a low, broad cantle; and the argument is that the front half of the Granger and the rear half of the military Jenifer made the Whitman, without the exercise of invention. *It is true, using language broadly, that the Whitman tree shows prominent features of each of these two trees, and united two halves of old trees, but the inference that therefore the product or result of Whitman's study and experiment was destitute of invention, does not follow.* A mechanic may take the legs of one stove, and the cap of another, and the door of another, and make a new design which has no element of invention; *but it does not follow that the result of the thought of a mechanic who has fused together two diverse shapes, which were made upon different principles, so that new lines and curves, and a harmonious and novel whole, are produced, which possesses a new grace, and which has a utility resultant from the new shape, exhibits no invention.* This was effected by the patentee, and I entertain no doubt that the shape which he produced was entitled to a patent.

*Whitman Saddle Co. v. Smith*, 38 F. 414, 416 (U.S. Court of Appeals 1889).

By this language, the trial court expressed its belief that the inventor went beyond merely combining the Jenifer cantle with the Granger pommel. Rather, in the words of the trial court, the inventor “fused together two diverse shapes, which were made upon different principles, so that new lines and curves, and a harmonious and novel whole, are produced, which possesses a new grace, and which has a utility resultant from the new shape...” *Id.* The trial court’s belief echoed the words of the inventor in the ‘844 patent, which were as follows:

I am aware that portions of the curves employed by me have been used in the designing of saddles; but when combined with a longitudinally-slotted tree, the lines I employ to give the profile form a new design for saddles, and giving the general idea in the front, lower, and rear lines of a sea-fowl or vessel modeled upon the same curves, and by these curves and lines giving the impression of lightness, grace, and comfort, that could not as well be conveyed by any others, as the impression of comfort is given by the large amount of bearing-surface obtained without undue elevation above the back of the animal, combined with the large seat for the rider, and lightness and grace by the small surface of tree shown in vertical plan, coupled with the form in which it is presented.

The emphasis of the inventor was not on the particular combination of cantle and pommel, but rather on the longitudinal slot and “lightness and grace” of the design that allowed for a large amount of bearing-surface without undue elevation above the back of the animal.

Two other aspects of the lower court opinion should be noted. First, the lower court states that “[n]o saddle-tree in existence prior to 1878 has been produced which at all resembles the patented shape.” 38 F. at 415. This language

clearly is a reference to the exhibits actually produced at trial, and is consistent with the Supreme Court's description that "[t]he exhibits embrace, among others, a slotted Granger saddle, the Jenifer-McClellan, the Sullivan-Black-Granger tree, and the saddle sold by defendants, the latter being substantially the Granger saddle with the Jenifer cantle." 148 U.S. at 680. This language should not be interpreted as meaning that there was no other evidence at trial (e.g., testimony) of a Jenifer/Granger combination in the prior art.

Second, the trial court stated as follows:

The defendant's position upon the question of patentability is that the shapes of all saddles were altered by manufacturers to suit the requirements of purchasers, and that old shapes, if modified by the rejection of existing features, and by the substitution therefor of other features which were known before the date of the patent, would be the patented shape. This position is most strongly exhibited in the *supposed* combination of the Jenifer-McClellan and the Granger saddles, each of which existed prior to 1878.

38 F. at 415-416. (emphasis added).

Without the trial transcript, the testimony concerning the presence of the Jenifer/Granger combination in the prior art is not known. It also is not known exactly what the trial court meant by the term "supposed." Did the trial court mean that the Jenifer/Granger combination was an inference based on other testimony, or was the word "supposed" used to emphasize that a Jenifer/Granger combination existed only in testimony because no exhibit of the combination was produced at trial? We do not know. In any event, it seems clear that the trial court's use of the

term “supposed” meant there was at least some evidence that the Jenifer/Granger combination existed in the prior art, and that the combination was not merely a new, but obvious, combination of prior art elements.

Further, since the trial court upheld the validity of the patent in the face of the defendants’ contrary argument and evidence, it is understandable that the trial court might tend to describe testimony concerning the prior art combination as “supposed” in the absence of any tangible trial exhibit of the Jenifer/Granger combination. Finally, it also is understandable that the trial court was not entirely clear in its description of evidence concerning the presence of the Jenifer/Granger combination in the prior art because, in the trial court’s mind, the patentability of the Whitman saddle design did not depend on whether such a combination existed in the prior art.

It is clear the Supreme Court was not as impressed as the trial court with the apparent subtleties of the *Whitman* saddle design. After quoting a portion of the trial court’s reasons for finding patentability, the Supreme Court stated: “[b]ut we cannot concur in that view.” 148. U.S. at 681. The Supreme Court reasoned “[t]he presence or the absence of the central open slot was not material, and we do not think that the addition of a known cantle to a known saddle, in view of the fact that such use of the cantle was common, in itself involved genius or invention, or produced a patentable design.” *Id.* In short, the Supreme Court *did* believe that

the patentability of the Whitman saddle design should be determined in relation to the Jenifer/Granger combination. For that reason, the Supreme Court's analysis and interpretation of the evidence and statements that the Jenifer/Granger combination *was* found in the prior art should be considered as more carefully considered than the trial court's interpretation and statements concerning the Jenifer/Granger prior art combination.

The Supreme Court did not stop at simply disagreeing with the trial court's patentability analysis. Rather, the Court went on to discuss another aspect of the Whitman design not considered by the trial court in its patentability analysis. The Court stated "[t]here was, however, a difference between the pommel of this saddle and the pommel of the Granger saddle, namely, the drop at the rear of the pommel, which is thus described in the specification: 'The pommel, on its rear side, falls nearly perpendicularly for some inches, when it is joined by the line forming the profile of the seat....'" *Id.* The Court then stated: "[t]he shape of the front end being old, the sharp drop of the pommel at the rear seems to constitute what was new and to be material." *Id.* at 682.

The Court then proceeded to conduct an infringement analysis of the patented and accused designs, as follows:

Now, the saddles of the defendants, while they have the slight curved drop at the rear of the pommel, similar to the Granger saddle, do not have the accentuated drop of the patent, which "falls nearly perpendicularly several inches," and has a "straight inner side." If,

therefore, this drop were material to the design, and rendered it patentable as a complete and integral whole, there was no infringement. As before said, the design of the patent had two features of difference as compared with the Granger saddle, one the cantle, the other the drop. And unless there was infringement as to the latter there was none at all, since the saddle design of the patent does not otherwise differ from the old saddle with the old cantle added, an addition frequently made. Moreover, that difference was so marked that in our judgment the defendants' saddle could not be mistaken for the saddle of the complainant.

*Id.*

The Court's analysis began by assuming that the sharp drop of the pommel in the Whitman saddle design was enough to render the design patentable over the prior art. The Court then described the sharp drop as the only difference between the Whitman design and the prior art because "the saddle design of the patent does not otherwise differ from the old saddle with the old cantle added, an addition frequently made." *Id.* In other words, contrary to the improper assumption made by Swisa, the Court *did* believe the prior art included the Jenifer/Granger combination. The Court then concluded that infringement did not exist because the accused saddle design did not include the sharp drop, which was the feature that "rendered [the Whitman design] patentable as a complete and integral whole." *Id.* Finally, the Court stated that "[m]oreover, that difference was so marked that in our judgment the defendants' saddle could not be mistaken for the saddle of the complainant." *Id.*

The Supreme Court's analysis in *Whitman Saddle* is the same as the analysis proposed by Egyptian Goddess. Egyptian Goddess proposes that the patented and accused designs be compared in light of the prior art. That is, to infringe, an accused design has to present substantially the appearance that distinguishes the patented design from the prior art. If the prior art is crowded with generally similar designs, the ordinary observer may make a more discriminative examination and comparison of the patented and accused designs. Finally, a potential "practical test" asks whether the accused device is closer to the prior art than it is to the patented design.

In *Whitman Saddle*, the Supreme Court made the comparison in light of the prior art because the Court asked whether the accused saddle presented substantially the appearance that distinguished the patented design from the prior art. Specifically, the Supreme Court considered that the appearance which distinguished the patented design from the prior art (and presumably rendered it patentable), included the sharp pommel drop. Significantly, the Supreme Court was careful not to single out the sharp pommel drop as a separate and distinct "point of novelty." Rather, the Court stated that the sharp pommel drop's presumed materiality rendered the saddle design "patentable as a complete and integral whole." *Id.* Since the accused design did not include the sharp pommel

drop, the accused design did not present substantially the appearance that distinguished the patented design from the prior art, and there was no infringement.

Contrary to Swisa's argument, application of the "practical test" also renders the same result. In this case the accused saddle design was closer to the prior art than it was to the patented design because the accused design did not have the sharp pommel drop. Therefore, under the practical test, infringement also is unlikely, and that is the result found by the Supreme Court.

The Supreme Court stated "[m]oreover, that [sharp pommel drop] difference was so marked that in our judgment the defendants' saddle could not be mistaken for the saddle of the complainant." *Id.* The trial court came to a different conclusion regarding the difference in the pommels, as follows:

The difference between the patented and the manufactured [pommel] shapes is not important enough to justify a serious question in regard to the fact of infringement. There is a substantial sameness in the two designs, as a whole, which would deceive the eye of an ordinary purchaser of manufactured saddles.

38 F. at 415.

The difference in views is due to the Supreme Court properly applying a principle that arises from making the comparison in relation to the prior art. The principle, mentioned previously, is "if the prior art is crowded with generally similar designs, the ordinary observer may make a more discriminative examination and comparison of the patented and accused designs." In this case it

was clear that the prior art was crowded. Indeed, the Supreme Court stated “there were several hundred styles of saddles or saddle-trees belonging to the prior art.” 148 U.S. at 681. As discussed above, these styles included the Jenifer/Granger combination. Therefore, an ordinary observer, who was accustomed to observing these many prior art saddles and making distinctions between them, necessarily made a more discriminative comparison between the patented and accused saddle designs.

The trial court did not take into account the crowded prior art and the effect such art would have on the mind and discriminative abilities of the objective ordinary observer. The discriminative abilities of the objective ordinary observer should be taken into account. *See, e.g., Byram v. Friedberger*, 87 F. 559, 560 (U.S. Court of Appeals 1897) (“the extent of discriminative examination likely to be made [of the design] by the purchasers thereof, [is] to be taken into account.”) (*Byram* was cited with approval in *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933) and affirmed at 100 F. 963 (U.S. Court of Appeals 1900). In *Whitman Saddle*, the Supreme Court properly took the heightened discriminative abilities of the ordinary observer into account when finding no infringement.<sup>2</sup>

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<sup>2</sup> In the instant case, the ordinary observer will not have heightened discriminative abilities because the prior art is not crowded with designs generally similar to the Egyptian Goddess patented buffer design. Indeed, the only prior art buffer with a

In sum, and with respect, Swisa is wrong when it argues that *Whitman Saddle* is inconsistent with the infringement test proposed by Egyptian Goddess. To the contrary, *Whitman Saddle* confirms that the Egyptian Goddess infringement test is correct and already has been used by the Supreme Court.

The second problem with Swisa's analysis is that even if we ignore the Supreme Court's language in *Whitman Saddle* and assume *arguendo* that the prior art did not include a Jenifer/Granger combination, *Whitman Saddle* still should not prevent adoption of the Egyptian Goddess infringement test. That is because the infringement decision in *Whitman Saddle* was influenced heavily by the patentability analysis in the opinion, and the standard for patentability in *Whitman Saddle* is different than the standard for patentability in either this case or in *Gorham v. White, supra*.

In *Whitman Saddle*, due to the particular statute then in effect, the patentability standard included a utility requirement. 148 U.S. at 678. The *Whitman Saddle* statute is different from the statute in effect when *Gorham v. White* was decided, *id.*, and the statute is different than the patentability standard now in effect (that requires novelty and not utility). Further, currently for a design to be held invalid as obvious by a combination of prior art references, the prior art

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hollow frame and raised pads is the Nailco buffer, and the Nailco Buffer has a triangular cross section that is clearly distinguishable from the square cross section of the Egyptian Goddess buffer design.

first must contain a primary reference that is basically the same as the patented design. See *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982). Assuming *arguendo* that the *Whitman Saddle* prior art did not include the Jenifer/Granger combination, then no primary reference would have existed as a basis to combine the Jenifer cantle and Granger pommel to render the Whitman saddle design invalid. The Supreme Court then would have been facing an entirely different infringement analysis, the rationale and results of which cannot be known because it was never done.

Further, the situation would have been different for application of Swisa's separate and distinct point of novelty test. Rather than determining the "point of novelty" between the Whitman patented design and the Jenifer/Granger combination, the Court would have had to determine the point of novelty between the Whitman design and the Jenifer saddle tree and the Granger saddle tree (and the rest of the prior art as well, if relevant).

What would the point of novelty be? In the instant case the trial court compared the Egyptian Goddess patented design against only one piece of prior art. Following this rational, if the patented design were compared against the Granger saddle tree, then possible points of novelty could be (1) the Jenifer style cantle, (2) the sharply dropped pommel, or (3) a combination point of novelty of the Jenifer style cantle and the sharply dropped pommel. If the patented design

were compared against the Jenifer saddle tree, then the possible points of novelty could be (4) the Granger style cantle (5) the sharply dropped pommel, or (6) the Granger style cantle with the sharply dropped pommel.

Some of the above points of novelty, (1) and (4), result in a finding of infringement, and the others, (2), (3), (5), and (6), result in a finding of no infringement (ignoring for a moment the rule that a point of novelty need only be substantially infringed). Plaintiff Whitman Saddle no doubt would argue for point of novelty (1) or (4) because those are contained in the accused saddle, the "point of novelty" test would be satisfied, and infringement would be found. The defendants no doubt would argue for (2), (3), (5), and (6), because (again ignoring the substantial infringement rule), those are not contained in the accused saddle, the "point of novelty" test would not be satisfied, and infringement would not be found. Should the plaintiff be allowed to choose, or should the defendant be allowed to choose? And if so, how?

Further, should there be a rule that evaluates the prominence or significance of competing possible points of novelty? Is the difference between a Granger saddle with a Jenifer cantle and a Granger saddle without a Jenifer cantle more prominent than the difference between a Granger saddle with a regular pommel and a Granger saddle with a sharp dropped pommel? It would clearly appear so. If prominence is a consideration and requirement, then the Jenifer cantle point of

novelty would be selected, the point of novelty test would be satisfied, and there would be infringement.

The analysis could continue into increasing levels of complexity, but the point has been made. If a separate and distinct point of novelty had to be determined under the facts assumed *arguendo* for *Whitman Saddle*, many of the vexing questions raised in this en banc appeal would arise.

Swisa cites and discusses *Kruttschnitt v. Simmons*, 118 F. 851 (C.C.S.D.N.Y. 1902), *aff'd*, 122 F. 1020 (2<sup>nd</sup> Cir. 1903) (per curiam) for the proposition that a “point of novelty” check is needed on the ordinary observer test. Quoting the case in part, Swisa states “[t]he ‘eye test’ by itself may fail to take into account the ‘fundamental law of infringement’ that ‘there must be an appropriation of novel elements of the patented design.’” Swisa Brief, page 20.

Swisa’s reliance on *Kruttschnitt* is misplaced. In *Kruttschnitt*, the plaintiff patentee had a design patent for a particular design on sign plates. The patent did not cover the idea of placing designs on aluminum sign plates and did not cover any design other than the one in the patent. Further, the design patent did not mention aluminum, or any type of metal for that matter. However, since the idea of placing a design on an aluminum design plate was new, people apparently were confused when the defendant placed the plaintiff’s design *and other designs* on aluminum sign plates.

The problem the patentee faced is that the patent did not protect the idea of placing *any* design on an aluminum face plate. Rather, the patent was limited to the design in the patent - and the court properly so held. *Kruttschnitt* therefore does not highlight the need for a separate and distinct point of novelty test.

Swisa cites *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944) for the proposition that the test for design patent infringement involves two considerations: “first, to infringe, the identity of appearance, or sameness of effect as a whole upon the eye of an ordinary purchaser must be such as to deceive him, inducing him to purchase one, supposing it to be the other, [cites omitted] and, second, to infringe, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.” *Id.* *Sears* did express the ordinary observer test as involving two considerations, but it is clear the Court did not believe the “novelty” consideration was separate and distinct from the “sameness of effect” consideration. Rather, consistent with the test proposed by *Egyptian Goddess*, the court believed that the overall visual comparison should be made in light of the prior art. And the court did just that, concluding “[w]hen the patented and the accused designs are viewed *as a whole* there can be observed no “identity of appearance” and there exists no “sameness of effect” such as to deceive an intelligent purchaser.” *Id.* (emphasis added). The *Sears* court did say the trial court erred in failing “to limit the comparison of the accused device to the novel

features of the patents,” *id.* at 397, but is unclear what the court meant by that. The *Sears* court itself made the comparison *as a whole* and therefore did not limit the comparison of the accused device to the novel features of the patent. Perhaps the comment, while inartfully worded, was directed to the idea that when making the comparison in light of the prior art, to infringe, the accused device must substantially appropriate the novelty (distinctive appearance) that distinguishes the patented device from the prior art.

B. Check on Equivalents

Swisa argues that the point of novelty test is needed as a check so that the doctrine of equivalents can never be used to capture what is in the prior art or is obvious in view of the prior art. Swisa Brief, page 26, 27. When the Egyptian Goddess proposed infringement test is used, such a check is not necessary. Under the proposed test, a finding of infringement requires that the accused design substantially appropriate the distinctive overall visual appearance that makes the patented design distinctive (and patentable) over the prior art. In order for a design to be obvious over the prior art, there must be a design in the prior art that is “basically the same” as the first design to serve as a primary reference. If an accused design substantially appropriates the distinctive overall visual appearance of a patented design to the point that infringement is found, then there will never be a design in the prior art that is “basically the same” as the accused design to

serve as a primary reference for obviousness. That is because, virtually by definition, an accused design cannot be at the same time “basically the same” as a prior art reference and substantially similar to a distinct overall visual appearance that is patentably distinct from the prior art.

In any event, even if there were the need for such a check, the proper way to provide the check would be to compare the accused design to the prior art in a hypothetical claim analysis and not to compare the patented design to the prior art. The hypothetical claim analysis is the way the doctrine of equivalents is prevented from capturing what is obvious over the prior art in utility patent law. It should be noted that a problem with the hypothetical claim analysis is that it cannot properly take into account secondary considerations since it is being performed on a design that follows in time the patented design.

C. Zone of Uncertainty and *Markman*

Swisa argues that the test proposed by Egyptian Goddess creates a zone of uncertainty that is contrary to the holding of *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996). Swisa Brief, page 29. With respect, given the present zone of uncertainty in design patent law, the test proposed by Egyptian Goddess is a marked improvement. Can the Egyptian Goddess test make comparative design infringement decisions with objective precision? No, but the comparison of designs is very much a subjective process and the infringement test

used for comparison needs to be flexible enough to work over a wide variety of designs and fact patterns. The separate and distinct “point of novelty” test clearly does not.

Egyptian Goddess agrees that increasing the amount of objectivity and predictability in design patent infringement law is a worthy goal. Indeed, one of the broad themes running through all of intellectual property law is the constant search for objective principles that will add predictability to decisions in what is inherently a subjective area. However, the history of intellectual property law has shown that usually the best test is one with certain objective principles, but that is flexible enough to cover a wide variety of varied fact patterns. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1746 (U.S. 2007) (rejecting a perceived rigid obviousness test for a more flexible standard and stating that “[a]pplication of the [section 103] bar must not be confined within a test or formulation too constrained to serve its purpose.”). When a test attempts to create too much certainty in an inherently uncertain field, the result is usually more uncertainty, not less. The “point of novelty” test is a perfect example.

Further, Egyptian Goddess disagrees that the proposed test creates unacceptable uncertainty. The test asks whether an accused design presents substantially the overall visual appearance that distinguishes the patented design from the prior art. This is a test that can be applied in a jury instruction and

understood. While the test does not provide for rigid formulaic precision, it is no less uncertain than many other comparative tests now successfully existing in patent and trademark law. Further, the test is principled enough that a court will be able to dispense with those cases upon which no reasonable jury could disagree.

The test contains other helpful objective principles as well. If the prior art is crowded with generally similar designs, then the ordinary observer may make a more discriminative examination and comparison of the patented and accused designs. This principle can be explained and understood by a jury. Finally, the potential “practical test” provides an effective method to make a three way comparison between the patented and accused designs and the prior art.

In sum, the proposed infringement test, while still subjective, provides meaningful objective guidance in what is inherently a subjective area of law. Most importantly, it is a durable and flexible test that keeps on working long after the “point of novelty” test has broken down.

## II. Non-Trivial Advance

Swisa fails to address the concerns expressed by Judge Dyk in his dissent. Further, the non-trivial advance test is not needed when the ordinary observer test is made in relation to the prior art.

## III. Burden of Proof

No reply needed.

#### IV. Division of Closely Related or Ornamentally Integrated Features

No reply needed.

#### V. More than One Point of Novelty

No reply needed other than Egyptian Goddess notes (1) Swisa cannot explain how the “point of novelty” test will work when there is no single piece of prior art that is plainly the nearest and (2) one can argue whether the Nailco patent is plainly the nearest prior art in this case because it does not have a square cross section while other prior art buffer pads do have square cross sections.

#### VI. Can the Overall Appearance be the Point of Novelty?

No reply needed other than Egyptian Goddess again notes that Swisa cannot explain how the “point of novelty” test will work in certain cases.

#### VII. Claim Construction

There is no need to construe a claim to identify the non-functional aspects of a design. A proper infringement test asks whether the accused design substantially appropriates the distinct overall visual appearance of the patented design that distinguishes the patented design from the prior art. It is improper to break the patented design into separate elements for visual comparison or to determine if they are non-functional. If the overall visual appearance is non-ornamental (functional in a design patent sense), then the design patent is invalid. If the overall visual appearance is ornamental, then it is irrelevant whether certain design

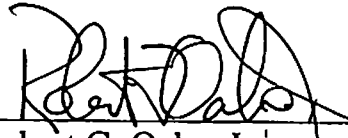
aspects in isolation are functional, because they are not being considered in isolation. Finally, since the separate and distinct point of novelty test should be abandoned, there is no need to determine points of novelty as a matter of law.

### CONCLUSION AND RELIEF SOUGHT

The centerpiece of Swisa's attack on the test proposed by Egyptian Goddess is *Whitman Saddle*. However, when *Whitman Saddle* is properly analyzed and understood, it not only supports the return of "novelty" (distinctiveness from the prior art) to the ordinary observer test, it also helps highlight the unfixable flaws in a separate and distinct "point of novelty" test.

The final judgment entered by the district court on July 6, 2006, which ordered that Egyptian Goddess take nothing by its claims for patent infringement against Swisa, dismissed those claims with prejudice, and taxed court costs in favor of Swisa and against Egyptian Goddess, should be reversed and remanded for trial. Egyptian Goddess respectfully requests that this Court apply the patent infringement principles as discussed above and in the principal brief of Egyptian Goddess to the patented and accused designs and remand this case for trial with instructions consistent with the principles of law discussed herein.

Respectfully submitted this 24th day of March, 2008.

A handwritten signature in black ink, appearing to read "Robert G. Oake, Jr.", written over a horizontal line.

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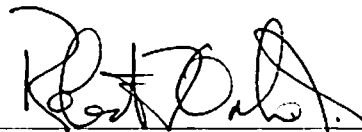
CERTIFICATE OF SERVICE

Pursuant to this Court's order dated November 26, 2007, and pursuant to Fed. R. Civ. P. 25(d)(1)(B), I certify that on March 24, 2008, I caused 2 copies of the foregoing brief to be served via U.S. Mail on the attorney listed below:

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I also certify pursuant to Fed. R. Civ. P. 25(d)(2) that on March 24, 2008, pursuant to this Court's order dated November 26, 2007, and pursuant to Fed. R. Civ. P. 25(a)(2)(B)(ii), I served upon the Clerk of this Court the original and thirty copies of the foregoing brief by dispatch to a third-party commercial carrier (Federal Express) for overnight delivery to the Clerk of this Court within 3 calendar days (for Tuesday Morning delivery, March 25, 2008).



Robert G. Oake, Jr.  
Attorney for Plaintiff-Appellant  
March 24, 2008

## CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B). This brief contains 6,999 words, excluding the parts of the brief exempted by the Federal Rules of Appellate Procedure 32(a)(7)(B)(iii).
2. This brief complies with the typeface requirements of Federal Rules of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rules of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman font.



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March 24, 2008

In The  
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  
DEFENDANTS/THIRD PARTY PLAINTIFFS-APPELLEES SWISA INC.  
AND DROR SWISA FOR EN BANC APPEAL**

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**FILED**  
U.S. COURT OF APPEALS FOR  
THE FEDERAL CIRCUIT

**MAR 7 2008**

**JAN HORBALY  
CLERK**

In The  
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## FORM 9. Certificate of Interest

## UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Egyptian Goddess, Inc. v. Swisa, Inc.No. 2006-1562

## CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)  
appellee certifies the following (use "None" if applicable; use extra sheets  
if necessary):

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

Dror Swisa and Swisa, Inc.

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:

Not applicable

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:

Not applicable

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 now represented by me in the trial court or agency or are expected to appear in this  
court are:

Frederick Linton Medlin, Linda G. Moore, and Jeffrey Snow of  
Kirkpatrick & Lockhart Preston Gates Ellis LLP

May 8 2008  
Date

Frederick Linton Medlin  
Signature of counsel

Frederick Linton Medlin

Printed name of counsel

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### **STATEMENT OF RELATED CASES**

The only other appeal filed from this same civil action was a premature appeal to this Court filed by Egyptian Goddess, Inc., No. 2006-1176. This appeal was dismissed as premature on March 20, 2006.

Defendants/Third Party Plaintiffs-Appellees Swisa Inc. and Dror Swisa are not aware of any specific case currently pending in this Court, the Supreme Court, or any other Circuit Court of Appeals that will directly affect or be directly affected by the Court's decision in this case, although they are aware that, more generally, this case has the potential to affect any design patent case currently in litigation where the point of novelty test is an issue.

## STATEMENT OF THE ISSUES

1. Should 'point of novelty' be a test for infringement of a 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? *See Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).

3. Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

## STATEMENT OF FACTS

In 1985, Michael Falley created a nail buffer in the traditional shape of a nail file that had four different abrasive surfaces. Three of the surfaces were abrasive of progressively finer grit, to be used in a three-step nail buffing process. One surface was for removing ridges in the nail, another was for smoothing the nail, and a third was for buffing the nail to a shine. The fourth abrasive surface was for shortening and shaping the nail. This buffer was called a “4-way” buffer. Falley placed a layer of foam between the substrate and abrasive layers to dissipate heat created by the buffing process. JA102, JA652.

In 1987, Falley had the idea of putting the four different surfaces on the four long sides of a rectangular foam block with square ends. Falley was the first to make and sell nail buffers in such a block form. JA102, JA652-653. The company of which Falley was CEO from 1984 until his death, Realys Inc. (“Realys”), has been making and selling this 4-way buffer block (the “Falley Buffer Block”) since 1987. JA102, JA653. A Falley Buffer Block is pictured below:

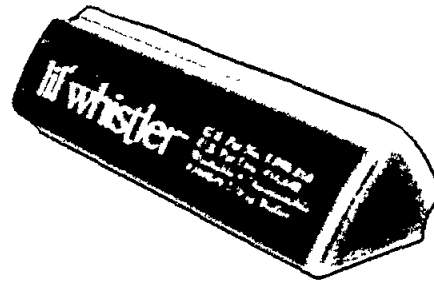
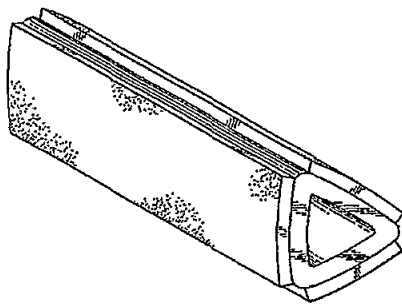


JA103, JA115-116, JA671, JA689-690. The abrasive surfaces do not touch each other along the buffer’s long sides. A gap—a “cuticle protection edge”—is left so

that during the buffing process the adjacent abrasive surface will not make contact with the cuticle. JA756-757. Realys' brochure, printed in 1987 and in use ever since, described the buffer as "[b]lock shaped for easier handling, cuticle protection edge for safety." JA102-103, JA653.

Realys not only sold the Falley Buffer Block under its own brand name, but sold it to other companies for resale under their brand names. JA103, JA117-118, JA671, JA691-692. Since 1987, Realys has also manufactured for Tammy Taylor, a prominent brand of acrylic nail products, a buffer block that has abrasive surfaces added on only three sides (the "Tammy Taylor Buffer"). JA103, JA653-654. In imitation of the Falley Buffer Block, numerous other foreign and domestic manufacturers make and sell "4-way" and "3-way" buffer blocks. JA105-106, JA127-129, JA653, JA675-677, JA720-739.

Realys also began making for Nailco Inc. ("Nailco") in 1987 a flat, four-way buffer in a nail-file shape. Then in about 1998, Nailco asked Falley to make a three-sided hollow buffer with the ends being open triangles. JA103, JA654. This three-sided hollow buffer ("the Nailco Buffer") is covered by Design Patent D416,648 (the "Nailco Patent") (found at JA121-124). A drawing from the design patent is shown below, alongside an image of an actual Nailco Buffer manufactured by Realys:



JA105, JA122 (page from design patent), JA126 (image of Nailco Buffer). The Nailco Patent shows another image, which is for a nail file rather than a buffer. Cuticle protection edges are functionally unnecessary for files, and are omitted from the design for a nail file as opposed to the one for a buffer. JA104, JA655.

The underlying form of the Nailco Buffer consists of a hollow tube of extruded plastic with triangular ends. Between the abrasive surfaces and the underlying plastic form are intermediate layers of foam. The foam layers, like the underlying foam block in a Falley Buffer Block, serve the purpose of dissipating the heat produced by the friction of the nail buffing process, as well as serving as a double-sided adhesive between the abrasive surfaces and the plastic form. As in the Falley Buffer Block, the foam layers do not touch each other along the sides of the buffer, but rather a gap is left to provide a cuticle protection edge. Thus, the corners of the plastic form are left exposed, giving the abrasive surfaces a “raised” look. It was Falley who suggested including the intermediate foam layers, making the underlying form out of a tube of extruded plastic, and the cuticle protection

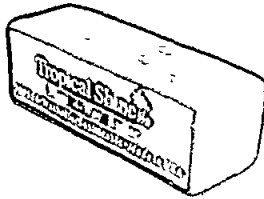
edges. JA103-104, JA654-655. The Nailco Patent has the same overall dimensions of 1 x 1 x 3 as the Falley Buffer Block. JA108.

In the past, Appellant EGI sold the Nailco Buffer, and Nailco in turn sold some of these buffers to Adi Torkiya's company, EGI. Realys printed the name "Egyptian Goddess" on those buffers it made for Nailco that were intended for resale to EGI. The first order from Nailco with the name "Egyptian Goddess" printed on it was on September 7, 1999. At least until October 2003, Realys was receiving buffer orders from Nailco for buffers for EGI. JA105-106, JA655.

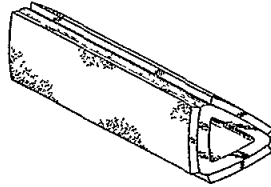
Both 3-way and 4-way buffer blocks have been on sale continuously since their invention and have been common in the market. JA105-106, JA128-129, JA675-677, JA720-7739. These were all derivatives of the Falley Buffer Block. JA106, JA675. Various foreign manufacturers have been making both 3-way and 4-way buffer blocks for many years. JA106, JA675-677, JA720-735. They were available nationwide and advertised on the internet. JA680.

In 2001, Falley agreed that Realys would manufacture the "Swisa Buffer" for Dror Swisa and his company, Swisa Inc. JA674. The Swisa Buffer, like the Nailco Buffer, had abrasive surfaces that were attached on top of one-eighth inch foam layers that are in turn attached to a plastic frame. Once more the intermediate foam layer served the dual purposes of dissipating heat and acting as an adhesive between the abrasive surface and the substrate. JA656. The Falley

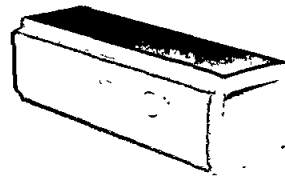
Buffer Block, Nailco Patent design, and the Swisa Buffer are shown below, along with the design for the D'389 Patent.



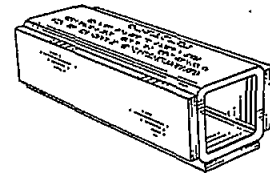
*Falley Buffer  
Block*



*Nailco Patent*



*Swisa Buffer*



*'389 Patent*

JA-116, JA122, JA158, JA160.

In October 2001, Adi Torkiya, who owned EGI and who had been selling the Nailco Buffer, filed an application for what would become the D'389 Patent. Torkiya did not disclose to the Patent Office any of Falley's Buffer Blocks or any of the many other buffer blocks on the market. JA668, JA678-680, JA777-778, JA786-787. The D'389 design copied precisely every feature of the Nailco Buffer, but added a fourth side without an abrasive pad, resulting in square ends. JA5, JA108-111. Like the Falley Buffer Block and Nailco Patent, the D'389 design's overall dimensions were 1 x 1 x 3. JA011, JA108.

After the Swisa Buffer appeared on the market, EGI brought this lawsuit against Swisa alleging infringement of the D'389 Patent.

Swisa, in moving for summary judgment under both the ordinary observer and point of novelty tests, presented extensive evidence that 3-way and 4-way buffers were "apples and oranges." Its experts testified that consumers of multi-

step nail buffers discriminate between 3-way buffers (with three different abrasive pads) and 4-way buffers (with four different abrasive pads). JA111, 145. Otherwise the two types would not have both been competing in the market since 1987 when Michael Falley invented the multi-step buffing block. JA111-112, 818. Swisa pointed out that when such multi-step nail buffers were advertised, the ads distinguished between 3-way and 4-way buffers. JA166, 169, 173, 178, 182, 187, 192-193, 197. EGI's own advertising as of March 29, 2005, three days before Swisa moved for summary judgment, was *centered entirely around the fact that the EGI buffer was for a three-step process*. JA167, 200-201. By the same token, Swisa's advertising for the Swisa Buffer stressed that it was for a four-step process. JA192-193.

### SUMMARY OF THE ARGUMENT

#### 1. Should 'point of novelty' be a test for infringement of a design patent?

*Smith v. Whitman Saddle*, 148 U.S. 674 (1893) held that an accused design may not be found to infringe unless it has incorporated what is inventive in the patented design. It has been a fundamental rule of design patent law since *Whitman Saddle* that to constitute infringement, there must be an appropriation of the novel elements of the patented design.

Courts have also long recognized a tension between this rule and the ordinary observer test. EGI urges abandoning the point of novelty test as a

separate test, and instead using only the ordinary observer test, but performing it with a comparison with prior art, and an inquiry into whether the accused design is closer to the patented design than to the prior art. This modified version of the ordinary observer test would be at best an imprecise and unreliable replacement for the point of novelty test. It could easily lead to designs being held to infringe even though they did not contain that which was inventive in the patented design. The result of employing this modified test, without the point of novelty test, would be to create a zone of uncertainty as to the scope of design patents.

This Court's jurisprudence regarding the doctrine of equivalents also underscores the necessity of retaining the point of novelty test. The ordinary observer test subsumes a doctrine of equivalents analysis, and the present point of novelty test is a check on that equivalents analysis. It ensures that in design patent law, as in utility patent law, the doctrine of equivalents cannot be used to capture what is in the prior art or obvious in view of that prior art.

**2(a) Should the Court adopt the non-trivial advance test adopted by the panel majority in this case?**

The non-trivial advance test only applies where the asserted point of novelty is a combination of prior art elements. The test reflects the principle that when such combinations are obvious in light of the prior art, they cannot be points of novelty for purposes of infringement without expanding the scope of design patents to embrace uninventive aspects of the design. This principle is solidly

rooted in *Whitman Saddle*. In *Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190, 1192 (Fed. Cir. 2006), this Court noted that in “appropriate circumstances,” a combination of prior art design elements may constitute a point of novelty. The non-trivial advance test explains what these circumstances are. The combination point of novelty in such cases is at most the difference between the patented design’s combination and the nearest subset combination in the prior art, but only if the addition to that prior art subset combination is a non-trivial advance over the prior subset.

The non-trivial advance test is also consistent with the principle that points of novelty act as checks on an equivalence analysis. Again, a doctrine of equivalents approach may not be used in utility patent cases to “ensnare” prior art or to claim what would be obvious under prior art. The non-trivial advance test serves the purpose of preventing the *Gorham* equivalence analysis from capturing what would have been obvious over the prior art.

**2(b) Should the point of novelty test be part of the patentee’s burden on infringement or should it be an available defense?**

The point of novelty test should remain as part of the patentee’s burden on infringement, as the patent owner has always borne the burden of proving infringement.

**2(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?**

Patent holders should not be allowed to whittle elements away from the actual differences between their patented designs and the nearest prior art, as this case illustrates. Accepting EGI's asserted combination point of novelty, which ignores the fourth side without a pad, would potentially allow an infringement finding without the accused design having incorporated the novelty of the patented design, and would impermissibly increase the scope of the D'389 to cover what was in the prior art.

**2(d) Should it be permissible to find more than one 'point of novelty' in a patented design?**

Yes, but not in a case such as the present one, where the patented design is a close modification of a prior art design, and that modification is another prior art element. Here the only point of novelty is the difference between the Nailco Patent and the D'389 Patent.

**2(e) Should the overall appearance of a design be permitted to be a point of novelty? See *Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).**

Again, in a case like the present one, the point of novelty is *at most* the difference between the combination of elements in the patented design and the closest subset combination of elements in the prior art. To allow the combination point of novelty, in circumstances like those before the Court here, to be instead the entire combination of the design, or its "overall appearance," would be to ignore what was new and inventive about the patented design.

3. Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

Claim construction remains vital. Design patents protect only the novel and ornamental features of the patented design. Construing the scope of patents is the province of the court, rather than the jury. Thus there needs to be claim construction in which the court determines what aspects of the drawings are functional and thus not protected by the patent, so that the fact-finder may delete these elements from the ordinary observer comparison.

Determining the points of novelty, which is part of ascertaining the scope of the design patent, should also be part of the claim construction. All the reasons set out in *Markman v. Westview Instruments*, 517 U.S. 370 (1996) for claim construction by the courts in utility patent cases also point to having the court construe the points of novelty in design patent cases.

### ARGUMENT

This case presents relatively simple designs with a readily apparent evolution. These factors make this case in some ways ideal for an examination of how the infringement analysis should be structured so as to assure that only what is inventive in a patented design is protected.

As the background facts and accompanying illustrations demonstrate, in creating the D'389 design, Adi Torkiya took the 3-way Nailco buffer, which he

was selling at the time, back to the four-sided square-ended shape of the widely-known Falley Buffer block by adding a fourth side. The resulting design, the D'389 Patent, was still a 3-way buffer, because this added fourth side did *not* have a raised abrasive pad. Michael Falley, in creating his 4-way Swisa Buffer, also simply took the Nailco Buffer back to the four-sided shape of his original Falley Buffer Block, with an abrasive surface on all four surfaces. Both the D'389 Patent and the Swisa Buffer *copy every element of the Nailco Patent* with the exception of the addition of a fourth side *without* an abrasive pad in the D'389 Patent, and the addition of a fourth side *with* an abrasive pad in the Swisa Buffer. JA5, JA108-111. As the district court found, “[i]n the context of nail buffers, a fourth side without a pad is not substantially the same as a fourth side with a pad.” JA5.

Thus, this case is an excellent one in which to examine the point of novelty test in the context of small departures from the prior art when the alleged inventor of the design patent has made only a very limited modification of a pre-existing design, and when the alleged inventor has plainly taken that modification from another readily apparent prior art reference. The nature of the point of novelty test, however, becomes far more complex in situations where the alleged points of novelty draw on several items of prior art, none of which are that close to the patented design. But such scenarios are far from the facts before the Court in this case.

**In Response to the Court's Question 1: Should 'point of novelty' be a test for infringement of a design patent?**

**I. The *Litton* 'point of novelty' test should continue to be a test for infringement of a design patent.**

**A. The *Litton* Point of Novelty Test is a particular articulation of the analysis introduced in *Whitman Saddle* and considered fundamental for more than a century.**

Design patents were never meant to protect the uninventive aspects of a design. The statute itself states that “[w]hoever *invents any new, original and ornamental design* for an article of manufacture may obtain a patent therefor . . . .” 35 U.S.C. § 171 (emphasis added). The term “point of novelty” has the unfortunate tendency to mislead as to what an accused design must appropriate from a patented design in order to infringe. The better term might be “point of invention.” The Sixth Circuit explained that even though a patent might have novelty such that prior art does not anticipate it, the prior art may negative *invention* because the patented device would have been obvious.

[I]t should be clear that even though the prior art may not anticipate the patent in question, the disclosures of the prior art may negative invention. That is, a prior device may not be substantially identical to the patented device and therefore cannot anticipate; however, it may be that in the light of this prior device the patented device would have been obvious.

*Schnadig Corp. v. Gaines Mfg. Co., Inc.*, 494 F.2d 383, 387 (6<sup>th</sup> Cir. 1974) (citations omitted) (discussing invention in the context of validity). A design patent may be valid because it has inventive aspects, but without a proper check on

the ordinary observer test, an accused infringer could be held liable without ever appropriating those inventive elements.

The Supreme Court, even as it introduced the ordinary observer test, explained that design patents protected “new and original appearances.” “The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both, but, in whatever way produced, it is the new thing, or product, which the patent law regards.” *Gorham Co. v. White*, 81 U.S. 511, 525 (1871) (emphasis added). Yet *Gorham*’s ordinary observer test did not focus on determining with precision whether the “new and original” inventive elements contained in the patent were in the accused design.

Twenty two years later the Supreme Court in *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893) made explicit the process by which such “new and original” appearances were protected in a decision that also made clear that these protected appearances required “invention.” The rear half of the patented design for the Whitman saddle was that of the prior art Jenifer saddle. The front half was that of the prior art Granger saddle, except that it had “a nearly perpendicular drop of some inches at the rear of the pommel, that is, distinctly more of a drop than the Granger saddle had.” 148 U.S. at 680. The trial court believed that an exercise of invention could be shown where a designer “fused together two diverse shapes, which were made upon different principles, so that new lines and curves and

harmonious and novel whole are produced,” and that the combination of elements would be patentable. 148 U.S. at 680-81. But the Supreme Court rejected this view. Adding a “known cantle [the raised rear portion of a saddle] to a known saddle, in view of the fact that such use of the cantle was common” did not involve “genius or invention,” or produce “a patentable design.” 148 U.S. at 681. Thus “the sharp drop of the pommel at the rear seem[ed] to constitute what was new and . . . material.” 148 U.S. at 682. But the saddles of the defendants did not have this accentuated drop at the rear of the pommel. Therefore, the Court held, if this drop were what rendered the saddle patentable, then there was no infringement. *Id.*

Thus the *Whitman Saddle* Court made plain that *only* by copying the “new” inventive aspect of a patented design could there be infringement of that design, and that making what would now be called an “obvious” combination of elements did not create an innovation that, through its appropriation, could lead to a finding of infringement. Arguing that “no case has come close to requiring a showing of nonobviousness as part of the point of novelty test,” the dissenting judge on the *Egyptian Goddess* panel noted that *Whitman Saddle* “long predated the statutory obviousness requirement.” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354, 1360 n.2 (Fed. Cir. 2007) (Dyk, J., dissenting), *rehearing en banc granted, opin. vacated* 2007 WL 4179111 (Fed. Cir. Nov. 26, 2007). But 35 U.S.C. § 103 only

codified judicial precedents regarding the necessary general level of innovation going back to more than forty years before *Whitman Saddle*.

We have concluded that the 1952 Act was intended to codify judicial precedents embracing the principle long ago announced by this Court in *Hotchkiss v. Greenwood*, 11 How. 284, 13 L.Ed. 683 (1851), and that, while the clear language of § 103 places emphasis on an inquiry into obviousness, the general level of innovation necessary to sustain patentability remains the same.

*Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 3-4 (1966).

The *Whitman Saddle* Court was not using an analysis of what we would call obviousness in order to invalidate the patent, but rather to determine what features of the patented design had to be present in the accused design in order for there to be infringement. *If* the curved drop at the rear of the pommel rendered the design patentable as a whole, *then* there was no infringement because that element was not present in the accused design. 148 U.S. at 682 (“If, therefore, this drop were material to the design, and rendered it patentable as a complete and integral Whole, there was no infringement.”). Moreover, the *Whitman Saddle* Court *focused on the presence or absence of a single innovative feature in the allegedly infringing saddle* rather than asking the less precise question of whether the difference between the Whitman saddle and the accused saddle was greater than between the Whitman saddle and the prior art saddles.

Nor is it apparent from the *Whitman Saddle* opinion what the answer would have been had this less precise question been asked. The opinion notes that among other saddles "that were old in the prior art" was the Granger and the Jenifer. 148 U.S. at 680. But the opinion never states that the prior art contained a saddle that combined the rear or cantle of the Jenifer saddle and the front of the Granger saddle, but without the drop at the back of the Granger pommel. Rather it states that it was common to combine the Jenifer cantle with *other* saddles.

The evidence established that there were several hundred styles of saddles or saddletrees belonging to the prior art, and that it was customary for saddlers to vary the shape and appearance of saddletrees in numerous ways, according to the taste and fancy of the purchaser. And there was evidence tending to show that the Granger tree was sometimes made up with an open slot and sometimes without, and sometimes with the slot covered and padded at the top and sometimes covered with plain leather; *while it clearly appeared that the Jenifer cantle was used upon a variety of saddles*, as was the open slot. Nothing more was done in this instance (except as hereafter noted) than to put the two halves of these saddles together in the exercise of the ordinary skill of workmen of the trade, and in the way and manner ordinarily done. The presence or the absence of the central open slot was not material, and we do not think that *the addition of a known cantle to a known saddle, in view of the fact that such use of the cantle was common, in itself involved genius or invention*, or produced a patentable design.

148 U.S. at 681.

The reason that the combination of the Jenifer cantle and the Granger saddle front failed to make the design patentable was apparently not because someone had made that precise combination, but rather because it was common to combine the Jenifer cantle with other saddles. Suppose the test for infringement had been the less precise formulation of whether the Whitman saddle with its Jenifer/Granger combination with a dropped pommel was closer to the accused saddle, a Jenifer/Granger combination but without a dropped pommel, than the accused saddle was to the prior art (which apparently lacked the precise combination of the Jenifer/Granger saddles). Under such a test a modern jury could easily hold that, despite the lack of a dropped back to the pommel, the accused saddle was closer to the Whitman design than to the prior art. Thus, under this less precise test--which would not identify what element was novel in the patented design and determine if it were present in the accused design--infringement could be found.

*Whitman Saddle* thus illustrates a problem in weighing the difference between the patented design and the accused design against the difference between the accused design and the prior art. The accused design can seem closer to the patented design than to the prior art, but yet not incorporate the inventive feature of the accused design. Rather the perceived similarity between the patented design and the accused design may be based on both designs including some obvious

combination of known elements that was not inventive in the patented design, and thus not protected.

Nor is it an answer to say that the accused has the recourse of challenging the validity of the patent. The Whitman Saddle patent could have been valid based on the sharp drop at the back of the pommel. But it could also appear in the infringement analysis that the accused saddle infringed if the test were not specifically whether this inventive feature had been appropriated but rather whether the accused saddle seemed closer to the Whitman saddle than to the prior art. Similarly, the D'389 patent in this case might withstand an obviousness challenge based on the inventiveness of adding a fourth side *without an abrasive pad*, yet the Swisa Buffer, under the imprecise alternative test proposed by EGI, might still be found to infringe even though it lacked that feature.

Another early case involving a separate analysis of whether the accused design appropriated the inventiveness or novelty of the patented design was *Kruttschnitt v. Simmons*, 118 F. 851 (C.C.S.D.N.Y. 1902), *aff'd* 122 F. 1020 (2<sup>nd</sup> Cir. 1903) (per curiam). The *Kruttschnitt* court was writing at a time when bordered aluminum signs were new. The design at issue was an ornamental border adapted for use on aluminum sign plates, with an ornamental scroll figure. The court recognized that in such circumstances the ordinary observer test would “do

violence” to the rule that there had to be an appropriation of novel elements of a design in order for there to be infringement.

Counsel for plaintiff, therefore, invokes the application of the familiar test,—‘the eye of the ordinary observer, giving such attention as a purchaser usually gives.’

*For the reasons already stated, this test cannot be applied in this case without doing violence to the fundamental law of infringement—that in order to constitute infringement there must be an appropriation of novel elements of the patented design.* Because such aluminum signs are new, the purchasing public may mistake defendant’s design, which every one has a right to make, for the design which only the plaintiff has the right to make. But the defendants cannot be deprived of their common right. The plaintiff, then, must be limited in such test to configurations which appropriate his design.

118 F. at 851 (emphasis added). *Kruttschnitt* thus also goes to the deficiency of the ordinary observer test when it is left unchecked by a precise identification of novel elements in the patented design and the elimination of prior art elements from the comparison of the patented design and the accused design. The “eye test” by itself may fail to take into account the “fundamental law of infringement” that “there must be an appropriation of novel elements of the patented design.” 118 F. at 851. One commentator has identified this 105 year old case as the first to propose the “point of novelty test.” Aaron Cook, *Points of Novelty, Lawman Armor, and the Destruction of Design Patents*, 12 J. TECH. L. & POLICY 103, 114 & n. 77 (2007).

EGI and certain *amici* make much of *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428 (6<sup>th</sup> Cir. 1933), in which the Sixth Circuit reversed a finding below that an accused design infringed under *Gorham*. The *Applied Arts* court recognized “that on the issue of infringement a design patent is not infringed by anything which does not present the appearance which distinguishes the design claimed in the patent from the prior art,” and for this proposition cited several cases, including *Kruttschnitt*, but not mentioning *Whitman Saddle*. 67 F.2d at 429. The *Applied Arts* court went on to note a tension between *Gorham* and the rule that the design patent’s scope was to be judged by the prior art.

Thus is presented a difficulty. The Supreme Court has said (*Gorham v. White*, *supra*) that sameness of effect upon the eye is the main test of substantial identity of design, but it is not essential that the appearance should be the same to the eye of the expert. It is sufficient if it is the same to the ordinary observer. Yet it is clearly the rule that similitude of appearance is to be judged by the scope of the patent in relation to the prior art.

*Id.* The *Applied Arts* court recognized that “[t]he question at once” presented itself were “these tests of identity in conflict?” *Id.* For what did “the ordinary observer, at least in the common acceptance of that phrase, know of the prior art?” 67 F.2d at 429-30.

The *Applied Arts* court tried to “reconcile” the two tests by redefining the ordinary observer as one who had a “reasonable familiarity” with such objects as

the one at issue and who would be able to make a reasonable judgment as to whether it presented distinctiveness from the prior art.

If the two tests are to be reconciled, some qualification must be recognized as applied to the ordinary observer. A careful analysis of *Gorham v. White*, and other adjudicated cases supplies the answer. The ordinary observer is not any observer, but one who, with less than the trained faculties of the expert, is 'a purchaser of things of similar design,' or 'one interested in the subject.' . . . So is the average observer not one who has never seen an ash tray or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it.

67 F.2d at 430. This attempted "reconciliation" of the two tests fails because it obscures any real focus on the second test, giving short shrift "to the fundamental law of infringement,—that in order to constitute infringement there must be an appropriation of novel elements of the patented design." *Kruttschnitt, supra*, 118 F. at 852.

The *Applied Arts* court noted that applying this test with its definition of ordinary observer, it appeared to the court that while there was "some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration [was] no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art."

*Applied Arts*, 67 F.2d at 430. Apparently the properly defined observer would also be shown the prior art, and was to engage in this weighing process. But again, this is a far less precise approach than determining, in a separate test, whether the inventive elements in the patented design are in the accused design, as was done in *Whitman Saddle*. As a practical matter, this alternative approach based on the *Applied Arts* language *only works if the “ordinary observer” performs in his or her mind the mental exercise of deleting the prior art elements from the comparison*, but by making this aspect of the analysis less formal and separate, one guarantees that it will be performed less exactly. The point of novelty test is a means of achieving focused attention; the alternative proposal is a way of deliberately blurring that focus.

While in *Applied Arts* the Sixth Circuit ignored *Whitman Saddle*, the Eighth Circuit did not in *Sears Roebuck & Co. v. Talge*, 140 F.2d. 395 (8<sup>th</sup> Cir. 1944). The *Sears* court recognized that the test of whether one design infringes another involved two considerations. 140 F.2d at 395. First, the identity of appearance or sameness of effect as a whole upon the eye of an ordinary purchaser must be such as to deceive him. Second, “to infringe, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.” *Id.* (citing, *inter alia*, *Whitman Saddle*).

The *Sears* court identified the “novel elements embodied” in the patented design for a juicer and then found that these elements were not in the accused device. It determined that the district court below had erred in finding infringement. “*The error consisted in failing* to take into consideration the importance of the prior art, and *to limit the comparison of the accused device to the novel features of the patents.*” 140 F.2d at 397 (emphasis added). The proper procedure thus was not just to compare the accused design to the patented design and the prior art, but to limit the comparison of the accused device and the patented design to the features that are not in the prior art. This is a far more accurate means of making sure that a finding of infringement is based on the appropriation of elements actually protected by the patent.

This Court in *Litton Systems, Inc. v. Whirlpool Corp., LLC*, 728 F.2d 1423 (Fed. Cir. 1984), relied explicitly on *Sears*, and although the Court cited the language from *Applied Arts*, the *Litton* opinion embraced the approach of *Whitman Saddle*, *Kruttschnitt* and *Sears*. “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.’” *Litton*, 728 F.2d at 1444 (citing, *inter alia*, *Sears*, 140 F.2d at 396). “That is, even though the court compares two items through the eyes of the ordinary observer, it must, nevertheless, to find infringement, attribute their similarity to the novelty which

distinguishes the patented device from the prior art.” *Id.* The *Litton* court identified the “novelty” of the patent before it as a combination of three elements, a conclusion it arrived at “in light of” its previous analysis regarding whether the patent was invalid as obvious. The patent protected only those designs in the narrow range that included these elements:

We recognize that minor differences between a patented design and an accused article’s design cannot, and shall not, prevent a finding of infringement. In this case, however, “while there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is not greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art.” *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6<sup>th</sup> Cir. 1933). Where, as here, a field is crowded with many references relating to the design of the same type of appliance, we must construe the range of equivalents very narrowly.

***We hold, therefore, that the scope of protection which the ‘990 patent affords to a microwave oven is limited in application to a narrow range: the three-stripe effect around a door with no handle and the latch release mounted on the control panel.***

728 F.2d at 1444 (emphasis added).

Again, EGI and some *amici* have argued that the language from *Applied Arts* quoted in *Litton* should be adopted as a part of the ordinary observer test and that with this check on the ordinary observer test, the point of novelty test presently

employed should be eliminated. But, while the *Litton* court quoted this language, it used the process, employed as far back as *Whitman Saddle*, of identifying what elements made the design novel and asking whether they were present in the accused design. The admonition in *Litton*--that where the field is crowded with prior art, “we must construe the range of equivalents very narrowly”--points to the need to employ this approach, which is a far more precise check on an overly broad application of the ordinary observer test than the proposed alternative. EGI tries to argue here that the field is not “crowded” with prior art—but the very proximity of the D’389 Patent to the Nailco Patent and its closeness to the common ancestor it shares with the Nailco Buffer, the much-imitated Falley Buffer Block (JA 102-108), highlights the necessity here of “construing the range of equivalents very narrowly.”

**B. The point of novelty test serves as a necessary check on the equivalents analysis under *Gorham*.**

A design patent is a patent, and can be infringed either literally or under the doctrine of equivalents. The “substantial similarity” ordinary observer test is comparable to an unchecked use of the doctrine of equivalents. In finding infringement, the *Gorham* court had employed the “function way result” test of the doctrine of equivalents: “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?” *Gorham*, 81 U.S. at 530 (1871). See Robert A. Matthews, Jr., *Doctrine of Equivalents Applied to Design Patents*, 4 ANNOTATED PATENT DIGEST § 29:67 (updated Mar. 2008) (“A close reading of the *Gorham* opinion supports the proposition that the infringement found in *Gorham* was under the doctrine of equivalents . . .”).

This Court recognized that the point of novelty test was a check on the application of the doctrine of equivalents to design patent law in *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1199 (Fed. Cir. 1995). There this Court explained that a patentee could not evade the point of novelty test through the doctrine of equivalents. While the doctrine applied to design patent cases, it only applied when the accused product included “features equivalent to the novel claimed design features.” 48 F.3d at 1199. A patentee could not “invoke the doctrine to evade scrutiny of the point of novelty, because to do so would ‘eviscerate the purpose of the ‘point of novelty’ approach,’” which was “to *focus* on those aspects of the design which render the design different from prior art designs.” *Id.* (emphasis added). Thus, there did not have to be a separate consideration of the doctrine of equivalents when the accused product did not appropriate any of the novel claimed features. *Id.* As a commentator has recognized, the point of novelty test thus applies to design patents the principle that

one cannot use the doctrine of equivalents to protect features that are either in the prior art *or obvious* based on the prior art.

Given that the basic test for design patent infringement set forth in *Gorham* subsumes an equivalence analysis, and therefore, every ‘literal’ infringement analysis of a design patent applies in some measure an equivalents analysis, the ‘point of novelty’ test can be viewed as applying the well settled principle applicable to utility patents that the doctrine of equivalents can never be used to capture what is in the prior art or is obvious in view of the prior art.

Robert A. Matthews, Jr., *General Aspects of the Point of Novelty Test*, 4 ANNOTATED PATENT DIGEST § 29.58 (updated Mar. 2008.). Thus, “[t]he points of novelty can be compared with the limitations of the claims of a utility patent for purposes of the doctrine of equivalents analysis.” Robert A. Matthews, Jr., *Doctrine of Equivalents Applied to Design Patents*, 4 ANNOTATED PATENT DIGEST § 29:68 (updated Mar. 2008).

Using the point of novelty test as a means to limit a patent’s protection to what is inventive in the patented design is relatively straightforward when dealing with new elements that are simply absent in the prior art. But the calculation necessarily becomes more complicated when what is asserted to be inventive in the patented design is the combination of old elements already present in the prior art. It was this situation that the panel majority addressed in this case when it articulated the non-trivial advance test, as discussed below in Section II.

**C. The reasoning of *Markman* runs counter to creating a “zone of uncertainty” by eliminating the separate point of novelty test.**

As discussed above, the proper scope of a design patent is limited to the visual *inventiveness* of the patent. “To entitle a party to the benefit of the act . . . there must be originality, and the exercise of the inventive faculty . . . The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention.” *Whitman Saddle*, 148 U.S. at 679 (quoting *Northrup v. Adams*, 18 F. Cas. 374 (E.D. Mich. 1877) (No. 10,328) (*Northrup* held a design patent invalid). *See also Unidynamics Corp. v. Automatic Products Int’l, Ltd.*, 157 F.3d 1311, 1323 (Fed. Cir. 1998) (“A design patent only protects the novel, ornamental features of the design patented.”) (quoting from *Oddzon Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)). This scope, again encompassing what is inventive, must be as precisely identified as possible.

‘[T]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public.’ Otherwise, a ‘*zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field* and ‘[t]he public [would] be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.’

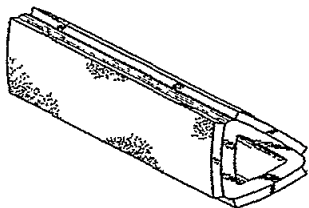
*Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996) (citation omitted, emphasis added).

It is just such a “zone of uncertainty” that EGI and some who own portfolios of existing design patents would create. By eliminating the point of novelty test, they would deny courts the power to determine the scope of design patents in the infringement analysis through a summary judgment procedure that allows for such identification of the novel or inventive aspects. They would also make less precise the manner in which juries and courts as fact finders identify points of novelty, allowing application of the *Gorham* test without any precise check on whether accused infringers are really appropriating the inventiveness or novelty of a plaintiff’s patent. As a result any producer of a competing product would be at risk even if the similarities between its product and the patented design arose only because of similarities common to the prior art or obvious in light of the prior art. Put differently, a defendant like the one in *Whitman Saddle* might be intimidated away from selling his competing saddle that combines the Jenifer cantle and the Granger saddle front, because a jury would be too likely to find infringement of the patent, even though the invention in that patented design is a feature of the pommel not present in the accused design.

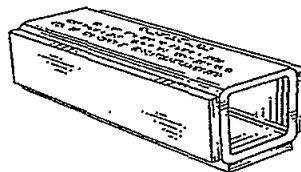
In response to Court's Question 2(a): Should the court adopt the non-trivial advance test adopted by the panel majority in this case?

II. This Court should adopt the non-trivial advance test as a way of assuring that design patents protect only the "invention" in the design.

The panel majority made clear that the non-trivial advance test applies *only* to situations where a patent has no individual element not already present in the prior art, so that the patent's only possible inventiveness consists of some combination of such elements. If the entire combination comprising a patented design is present in a single item of prior art, there is manifestly no invention. Closest to that case are situations such as the present one, where the prior art contains a subset combination of the elements contained in the patented design, with only a very narrow difference between the two combinations.



*The Nailco Patent*



*The D'389 Patent*

JA122, JA160.

In granting summary judgment below, the district court held that the difference between the D'389 and the Nailco Buffer was not present in the Swisa Buffer, so there could be no infringement.

The only point of novelty in the D'389 Patent over the Nailco Patent is the addition of the fourth side without a pad, thereby transforming the equilateral triangular cross-

section into a square. In the context of nail buffers, a fourth side without a pad is not substantially the same as a fourth side with a pad. Because the Swisa product does not include the point of novelty of the D'389 Patent—a fourth side without a pad—there is no infringement.”

Summary Judgment Order at p. 4. Swisa submits that, regardless of the merits of the non-trivial advance test, that test’s application was not required in this case because the D’389 Patent’s only departure from the prior art was simply not present in the Swisa Buffer.

To avoid this problem, EGI argued that the D’389 Patent’s point of novelty was some combination other than the elements that comprised the narrow difference between its combination of elements in the D’389 Patent and the subset of that combination contained in the Nailco Patent. As the panel majority noted, the combination point of novelty that EGI asserted was the open and hollow body of the Nailco Buffer, the raised rectangular pads of the Nailco Buffer, and the exposed corners of the Nailco Buffer, plus a square cross section. *Egyptian Goddess, Inc.*, 498 F.3d at 1358. EGI asserted this particular combination because it left out the fourth side without an abrasive pad. Swisa argued that because of this omission from the narrow difference between the Nailco Patent and the D’389 design, the asserted combination could not be the point of novelty. EGI was engaging in the “shopping list” approach of only using that part of the actual point of novelty that was present in the accused design, rather than presenting a point of

novelty that reflected the real difference between the Nailco Patent and the D'389 Patent. *See Hosely Int'l Trading Corp. v. K Mart Corp.*, 237 F.Supp.2d 907, 911-13 (N.D. Ill. 2002); *Bush Indus., Inc. v. O'Sullivan Indus., Inc.*, 772 F.Supp. 1442, 1452 (D. Del. 1991).

The majority of the panel stated that it agreed “with Swisa that the point of novelty should be determined by comparing the claimed design to the prior art and not to the accused design,” but that as an appellate court it reviewed “the merits of the asserted point of novelty and not the motive behind its selection.” *Egyptian Goddess, Inc.*, 498 F.3d at 1357 n.1. Yet it was not necessary here to look at EGI's motive in selecting its asserted point of novelty. It was only necessary to compare the actual difference between the Nailco Patent and the D'389 Patent to determine that EGI was not employing what actually distinguished the two patents, but rather only a selected portion of that very narrow difference. Regardless of motive, patentees should not be allowed to expand the scope of what is protected by the patent by asserting such incomplete combination points of novelty.

The majority of the panel articulated, however, a valuable rule that would serve in cases more difficult than the one presented here. The non-trivial advance test reflects the principle that combinations of prior art elements that are obvious in light of the prior art cannot be “points of novelty” for purposes of the infringement test without expanding the scope of design patents to embrace uninventive aspects

of the design. The majority held that the asserted combination, given that there were numerous prior art buffers with a square cross section, was too trivial an advance over the Nailco Patent to properly constitute inventiveness. “In light of the prior art, no reasonable juror could conclude that EGI’s asserted point of novelty constituted a non-trivial advance over the prior art.” 498 F.3d at 1358. “[O]nly if the point of novelty included a fourth side without a raised pad could it even arguably be a non-trivial advance over the prior art.” *Id.*

This non-trivial advance test applies the requirement that to infringe an accused design must appropriate what is inventive in the patented design, and the test reflects the reasoning and holding in *Whitman Saddle*. Because it was commonplace to combine the Jenifer cantle with other saddles, combining it with the Granger saddle front was just a trivial advance, and the Supreme Court held that the patentee could not successfully sue an accused infringer who only copied the Jenifer cantle/Granger saddle front but omitted the drop at the back of the pommel. In accord with this, the panel majority in this case recognized that in combination point of novelty cases, in order to limit infringement to situations where the inventiveness of the patented design was appropriated, the test had to involve obviousness. If it did not, a combination with even the most trivial difference could be a point of novelty.

The question is: When the patentee claims a combination of old prior art elements as its asserted point of novelty

should the test be one of anticipation or obviousness? We conclude that non-triviality ought to apply—if the standard is akin to anticipation then a combination with even the most trivial difference would meet the standard.

498 F.3d at 1358 n.3. Therefore a patentee, when arguing a combination point of novelty that includes old elements of prior art, must point to a combination that that is a non-trivial advance, and cannot, for example, just combine a Jenifer cantle with a Granger saddle front, or give square ends to a pre-existing multi-step nail buffer design with equilateral triangles at the ends, when square ended multi-step nail buffers are ubiquitous. JA105-06.

*Lawman Armor Corp. v. Winner International, LLC*, 437 F.3d 1383 (Fed. Cir. 2006), did not involve a piece of prior art anywhere near as close to the patented design in appearance as the Nailco Patent is to the D’389 Patent. But the prior art in *Lawman* also contained subsets of the plaintiff’s combination of prior art elements. The district court below had noted that in its claim construction of the patent at issue it had found that “similar points of novelty were present in the prior art, most notably utility Patent No. 5,197,308 [hereafter “Pazik ‘308 Patent”].” *Lawman Armor Corp. v. Winner Int’l, LLC*, No. 02-4595, 2005 WL 354103, at \*5 (E.D. Pa. Feb. 15, 2005), *aff’d*, 437 F.3d 1383 (Fed. Cir. 2006). The *Lawman* district court cited to its opinion in *Lawman Armor Corp. v. Master Lock Co.*, No. 02-6605, 2004 WL 440177, at \*9 (E.D. Pa. Mar. 11, 2004), where it had

found that all of Lawman's nine purported points of novelty in that case were contained in the Pazik '308 Patent.

On appeal to this court, Lawman did not try to fashion an argument that some subset of the combination of eight asserted "points of novelty," when compared to prior art patents combining many of the same elements, differed by some subset of elements that might be termed a combination point of novelty. Instead Lawman argued that there was "no suggestion to combine visual elements in the alleged prior art to achieve the '621 patent." 437 F.3d at 1385. This Court recognized that this was simply asserting that the *entire* combination of non-novel elements in the design was a point of novelty. But to simply accept the whole combination as a point of novelty, without examining how the combination differed from prior subset combinations, would virtually eliminate the significance of the point of novelty test.

"The purpose of the 'points of novelty' approach . . . *is to focus on those aspects of a design which render the design different from prior art designs.*" "New" designs frequently involve only relatively small changes in the shape, size, placement, or color of elements of old designs. *It is those changes in and departures from the old designs that constitute the 'points of novelty' in the patented new design.*

If the combination of old elements shown in the prior art is itself sufficient to constitute a "point of novelty" of a new design, it would be the rare design that would not have a point of novelty. The practical effect of Lawman's theory would be virtually to eliminate the

significance of the “points of novelty” test in determining infringement of design patents, *and to provide patent protection for designs that in fact involve no significant changes from the prior art.*

*Lawman*, 437 F.3d at 1385-1386 (citation omitted, emphasis added).

Later the same panel, in its opinion denying a petition for rehearing, stated that it “did not intend to cast any doubt upon [the Court’s] prior decisions indicating that in appropriate circumstances a combination of design elements itself may constitute a ‘point of novelty.’” *Lawman Armor Corp. v. Winner Int’l, LLC*, 449 F.3d 1190, 1192 (Fed. Cir. 2006). But “[s]uch a combination is a different concept than the overall appearance of a design which, as indicated, our cases have recognized cannot be a point of novelty.” *Id.* This Court then denied a petition for rehearing en banc. *Lawman Armor Corp. v. Winner Int’l, LLC*, 449 F.3d 1192 (Fed. Cir. 2006).

The non-trivial advance test answers the question of what the “appropriate circumstances” are in which a combination of prior art design elements itself may constitute a point of novelty. *Lawman* itself made apparent that the combination point of novelty in such cases would not be the entire combination when prior art contained subsets of the combination. Instead, the point of novelty is at most those features comprising the difference between the patented design’s combination and the nearest subset combination in the prior art. The question then becomes whether the patentee made a non-trivial advance by adding the other previously

known prior art elements that he combined with the prior art subset combination. The addition to that subset combination of another element already present in the prior art creates a viable combination point of novelty only if the addition is a “non-trivial advance” over the prior subset.

Application of the non-trivial advance rule for combination points of novelty is also consistent with the principle that points of novelty act as checks on an equivalence analysis. As previously discussed, “literal” infringement under the *Gorham* test seems to subsume a doctrine of equivalence analysis, and the “points of novelty” may be compared to the limitations that the claims of a utility patent impose on a doctrine of equivalents analysis. A doctrine of equivalents approach may not be used in utility patent cases to “ensnare” prior art *or claim what would be obvious under prior art*. E.g., *General American Transp. Corp. v. Cryo-Trans, Inc.*, 93 F.3d 766, 771 (Fed. Cir. 1996) (“[S]ince allowing the claims to encompass GATC’s car would cause the claims to cover subject matter obvious over the prior art, the car cannot be held to infringe the ‘876 patent under the doctrine of equivalents.”). For the same reason, in design patent cases the doctrine of equivalents may only be applied when the accused design “includes features equivalent to the novel claimed design features.” *Sun Hill*, 48 F.3d at 1199. Requiring that combination points of novelty be non-trivial advances serves the

purpose of preventing the equivalence analysis from ensnaring what would have been obvious over the prior art.

EGI and certain *amici*, as well as the panel dissent, argue that the non-trivial advance test allows in effect a holding of patent invalidity based on obviousness while circumventing the requirements of clear and convincing evidence. But the summary judgment in this case does not achieve “in effect” an invalidation of the D’389 Patent. EGI can still sue accused infringers who use buffers like EGI’s that have abrasive pads on only three of the four sides. Even were this not true, it is a fundamental rule that one cannot be held liable for infringement when the accused design does not appropriate what is new and inventive in the patented design, and infringement should not be found in the absences of such appropriation simply because a patent has been granted and not declared invalid. The alternative to applying the non-trivial advance test in appropriate cases would be to allow findings of infringement where the accused infringer had not appropriated any inventive aspect of the design patent, so that the patentee could not carry his burden of proving infringement.

**Responding to the Court’s Question No. 2(b):**

**III. The point of novelty test should remain as part of the patentee’s burden on infringement rather than be turned into an available defense.**

This Court has previously held that, in order to establish the points of novelty in a design patent infringement action, “the patentee must introduce into

evidence, at a minimum, the design patent at issue, its prosecution history, and the relevant prior art references cited in the prosecution history; and must present, in some form, its contentions as to points of novelty.” *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1384 (Fed. Cir. 2004). This should remain unchanged, but to the extent that there is relevant prior art other than what is in the prosecution history, such as the Falley Buffer Block in the present case, it should be up to the accused to come forward with that evidence.

Given that the point of novelty test serves the function of imposing a check on an equivalence analysis, it is instructive to look to the approach employed in utility patent cases where the patentee claims infringement under the doctrine of equivalents. This Court noted in *National Presto Indus., Inc. v. West Bend Co.*, 76 F.3d 1185, 1192 (Fed. Cir. 1996), that when a patentee had made a prima facie case under the doctrine of equivalents, the burden of coming forward with evidence to show that the accused device was in the prior art was on the accused infringer. This Court subsequently explained further that, while the *burden of going forward* rested with the accused infringer, the burden of persuasion was on the patentee to prove that the range of equivalents that it sought “would not ensnare the prior art . . . . The patent owner always has borne the burden of proving infringement.” *Streamfeeder, LLC v. Sure-Feed Systems, Inc.*, 175 F.3d 974, 983 (Fed. Cir. 1999).

As a practical matter, it can be expected that design patent defendants will point to prior art that they assert demonstrates that the allegedly novel features incorporated in the accused design are not points of novelty, but are either found in the prior art or are obvious in view of the prior art. The burden should then be on the patentee to show otherwise, just as a utility patent plaintiff must show that its equivalence assertion does not cover the prior art or what is obvious over prior art.

As previously discussed, where the alleged point of novelty is a combination point of novelty consisting of prior art elements, in order for the point of novelty test to prevent an equivalents analysis from capturing what would be obvious over the prior art, one must utilize the non-trivial advance test.

**Responding to the Court's Question No. 2(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?"**

**IV. A design patentee, in defining a point of novelty, should not be permitted to divide closely related or ornamentally integrated features of the patented design to match features contained in an accused design.**

EGI, as discussed above, sought to ignore the inconvenient fact that what distinguished the D'389 design from the Nailco Patent was adding a fourth side without an abrasive pad. Instead, EGI selectively asserted a combination point of novelty that included square ends but not the addition of the fourth side without an abrasive pad. But it is the "changes in and departures from the old designs that constitute the 'points of novelty' in the patented new design." *Lawman*, 437 F.3d

at 1386. The point of novelty of the D'389 Patent cannot be some convenient subset of the “changes in and departures from” the Nailco Patent. The “changes in and departures from” the Nailco Patent are the actual difference between the D'389 Patent and the Nailco Patent—which is the difference that the Patent Office saw when it granted the D'389 Patent over the Nailco Patent. To whittle away elements of that difference in the infringement analysis is not fair to defendants or to the public, which should not have to speculate as to what selected portion of the real difference between the patented design and the prior art might constitute the point of novelty.

The oft-repeated principle from *In re Mann*, 861 F.2d 1581, 1582 (Fed.Cir. 1988), that “design patents have almost no scope” bears directly on this issue. EGI is trying to tailor its combination point of novelty, through subtraction of elements, to increase impermissibly the scope of its patent beyond that for which it was given a patent and to ensnare what is found in the prior art or at least obvious over the prior art. But again, the claims of design patents are “limited to what is shown in the application drawings.” *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (rejecting argument that allegedly functional elements in the patent drawings should be eliminated from the infringement analysis, and interpreting the claim as being limited to a design that *included* these features as shown in the drawing, while quoting *In re Mann*, 861 F.2d at 1582).

**In response to the Court's Question 2(d): "Should it be permissible to find more than one 'point of novelty' in a patented design?"**

**V. It should be permissible to find more than one 'point of novelty' in a patented design.**

A design can have more than one novel feature that is not present in the prior art, and these should be treated as multiple points of novelty. The situation changes, however, when the asserted point or points of novelty consist of one or more combinations of features, and all of the constituent features are present in the prior art.

As previously discussed, this case involves a patent where the inventor made a very small change over a very near piece of prior art, the Nailco Buffer, and where that small change consisted of applying a feature of the prior art. This case thus does not present the best vehicle with which to make general determinations regarding point of novelty issues embracing designs that are not such close modifications of prior art.

With regard to cases like this one, in defining a combination point of novelty consisting entirely of known elements from the prior art, one should be limited to the actual difference between the combination of elements in the patented design and the subset of those elements contained in the nearest prior art. But in many cases there will be no single piece of prior art that is plainly the nearest, and there may be two or more prior art designs that are equally close to the patented design.

In such circumstances, the Patented Design will have different points of novelty over different prior art.

But again, that is not this case.

**Responding to the Court's Question No. 2(e): Should the overall appearance of a design be permitted to be a point of novelty? See *Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).**

**VI. The overall appearance of a design cannot be the point of novelty when there are prior art designs that are close to the patented design.**

As previously discussed, in a case like this one, the point of novelty is *at most* the difference between the combination of elements in the patented design and the closest subset combination of elements in the prior art. To hold in these circumstances that the combination point of novelty is the overall combination of the patented design itself instead of the difference between the patented design and the prior art design would be to ignore what was new or inventive about the patented design. Without identifying that new, inventive element, it is impossible to determine if the accused infringer has appropriated it.

Again, there will be other sorts of cases in which the patented design is not a close modification of a single prior art design. In such cases, when there are two or more pieces of prior art that contain subsets of the combination of elements in the patented design, the patented design may have different points of novelty over different pieces of prior art. As previously stated, the facts of this case do not present a good vehicle by which to decide this issue.

In dealing with such more complicated fact patterns than the one in this case, the guiding principle, as embodied in *Whitman Saddle*, should be that the point of novelty test seeks to protect what is inventive in the patent. The facts of *Whitman Saddle* demonstrate the danger of calling a combination of all the elements in the design its combination point of novelty. If an overall design could be the combination point of novelty, then the Whitman saddle's novelty could have been its combination of the Jenifer cantle, the Granger front, and the drop in the pommel. Then the patentee suing on the patent could assert that this combination point of novelty was "substantially present" in the accused saddle, and therefore there was infringement even under a point of novelty test.

**In response to the Court's Question No. 3: "Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? See *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995)."**

**VII. Claim construction is necessary to identify the design's functional aspects, and should include the identification of novel features.**

The claim construction process is as vital for design patents as for utility patents, because design patents do not protect the functional elements of the drawn designs, and they should not protect aspects that are not part of the patent's visual inventiveness. *Unidynamics*, *supra* 157 F.3d at 1323 ("A design patent only protects the novel, ornamental features of the design patented."); *Oddzon Products*, 122 F.3d at 1405 (same language). This Court has recognized that "the scope of

the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.” *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1383 (Fed. Cir. 2004) (quoting *Oddzon*, 122 F.3d at 1405). This identification step is necessary to eliminate the functional features from the comparison that the fact finder, during the infringement analysis, makes between the patented design and the accused design. Otherwise, fact finders might find infringement based on an identity or similarity of functional features. “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.” *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 825 (Fed.Cir. 1992), *abrogated on other grounds by Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 975 (Fed.Cir. 1995) (en banc).

Courts thus should continue construing claims and identifying the functional aspects of designs with words, although supplementing these words with images of the functional aspects may sometimes be appropriate. There then remains, however, the question what role, if any, claim construction should play with regard to the identification of the inventive aspects of the design patent. Such identification would seem as much a part of construing the claim’s scope as the identification of the functional features.

Prior to this Court's 2004 decision in *Bernhardt*, various district courts had recognized that construing the scope of a design patent also involved determining which elements were "novel" so that the construed claim could then be compared against the accused device. For example, in *Metrokane, Inc. v. Wine Enthusiast*, 185 F. Supp.2d 321, 326-27 (S.D.N.Y. 2002), the court stated that "[b]ecause a design patent only protects the novel, ornamental aspects of the design as shown in the patent, a court must identify these aspects in order to construe the scope of protection of the patent." (citation omitted). The court reached a similar conclusion in *In re Plastics Research Corp. Litigation*, 63 U.S.P.Q.2d 1924, 1925 (E.D. Mich. 2002). After carefully reviewing "the implications" of the *Markman* decision and this Court's holding in *Cybor Corporation v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998), the *In re Plastics* court was persuaded that the point of novelty was a question of law to be resolved by the judge, as it had been in *Sun Hill Industries*. 63 U.S.P.Q.2d at 1925 (citing to *Sun Hill*, *supra*, 48 F.3d at 1197-98 as a case "treating the point of novelty as a question of law that did not warrant 'exercise of the fact-finding function.'").

Similarly, the court in *Hosely International Trading Corp. v. K. Mart Corp.*, 237 F. Supp. 2d 907, 912 n.4 (N.D. Ill. 2002) noted that "[b]ecause the court concludes that the intrinsic evidence, specifically the patent and prosecution history, is sufficient *to construe the point of novelty of the '369 patent*, the court

need not rely on extrinsic evidence in the instant case” (emphasis added). Another district court recognized that, in construing the claim of a patent, it could “consider only the ornamental, novel and non-functional features of the design,” and therefore, “[t]he prior art is also relevant to construing the claim of the design patent, for a design patent covers only those design elements that are novel.” *Child Craft Indus. Inc. v. Simmons Juvenile Products Co., Inc.*, 990 F. Supp. 638, 640 (S.D. Ind. 1998).

Then, in 2004, the *Bernhardt* Court noted that both the ordinary observer and the point of novelty tests were “factual inquiries that are undertaken by the fact finder during the infringement stage of proceedings, after the claim has been construed by the court.” 386 F.3d at 1383. The Court observed that “the fact finder generally will be able to determine the points of novelty that distinguish the design patent from the prior art by comparing the design patent with the cited prior art references, aided by any written statements of the applicant and examiner in the prosecution history.” 386 F.3d at 1384.

Another panel of this Court stated, citing *Bernhardt*, that the point of novelty test was a factual inquiry. *Arminak and Associates, Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1320 (Fed. Cir. 2007). But the same opinion also noted that the case law did not “disapprove” claim construction that did not go *beyond determining novel and ornamental features*:

Our case law does not prohibit detailed claim construction of design patent drawings. It merely disapproves claim construction that goes beyond the novel, nonfunctional ornamental features visually represented by the claimed drawings, or that fails to encompass the claimed ornamental features of the design as a whole.

501 F.3d at 1321 (citations omitted). But a court could only be sure that its claim construction did not “go beyond the novel, nonfunctional ornamental features” of the patented design if it could identify the novel features.

The process of identifying points of novelty properly consists of the procedure the *Whitman Saddle* Court went though back in 1893: comparing the claimed design to the prior art, along with an examination of the prosecution history, and thereby determining what new element or combination of elements constitutes the inventiveness of the patent. Under *Bernhardt*, courts apparently cannot perform this process as part of claim construction and can only identify points of novelty on motions for summary judgment when there is no issue of fact as to what the novel feature can be. This Court should take this opportunity to hold that the identification of points of novelty is part of the claim construction process to be performed prior to the infringement test in which the jury then determines whether the points of novelty have been appropriated (only, of course, in those cases where there remains a fact issue). Identifying points of novelty is part of the process of construing the scope of the design patent’s protection. If the jury

identifies the points of novelty, it is construing the patent's scope. Yet *Markman* decision states that "construction of a patent . . . is exclusively within the province of the court." 517 U.S. at 372 (1996).

The *Markman* Court based its conclusions that construing the scope of utility patents was for the court rather than the jury on existing precedent and "the relative interpretive skills of judges and juries and the statutory policies that ought to be furthered by the allocation." 517 U.S. at 384. These three factors all also indicate that juries should not be construing the scope of design patents.

With regard to precedent, the *Markman* Court looked back to cases such as *Winans v. Denmead*, 15 How. 330, 338, 56 U.S. 330, 338 (1854). There Justice Curtis, writing for the Court, held that patent construction was a question of law to be determined by the court, "construing the letters-patent, and the description of the invention and specification of claim annexed to them," while determining whether infringement had occurred was a question of fact to be submitted to the jury. *Id.* Similarly, older precedent does not require that juries determine the point of novelty in a design patent. The *Whitman Saddle* Court overruled the decision of the "experienced judge" below and determined that the drop at the rear of the pommel had to be present in the accused design for there to be infringement. 148 U.S. 680-82. In *Kruttschnitt*, the court, sitting in equity, determined which accused devices did not infringe and which one did. 118 F. at 852. The Sixth Circuit held

as a matter of law that the district court had erred in finding infringement in *Applied Arts*, as did the Eighth Circuit in *Sears*. *Applied Arts Corp.*, 67 F.2d at 431; *Sears*, 140 F.2d at 397.

After looking at precedent, the *Markman* Court then looked to whether one judicial actor was better positioned than the other to decide the issue in question, and concluded that a judge, from his training and discipline, was better suited to construe claims than was a jury. Unlike the ordinary observer test, to which a jury is well suited, identification of points of novelty is not a task for which a jury is better suited than a judge. *Markman* involved construing written claims, and courts are traditionally the interpreters of writing. To this extent courts are better suited to interpret the prosecution histories of the patented designs as required in determining the points of novelty. But courts are also better suited to determine what elements of a design drawing represent a novel advance over prior drawings, as the Supreme Court did in *Whitman Saddle*. The strengths that a jury brings to fact finding are irrelevant for this purpose, just as they were in *Markman*. “[I]n these cases a jury’s capabilities to evaluate demeanor, to sense the ‘mainsprings of human conduct,’ or to reflect community standards, are much less significant than a trained ability to evaluate the testimony in relation to the overall structure of the patent.” 517 U.S. at 389-90 (citations omitted). Similarly, in making determinations about whether elements of a design patent claim, compared to the

prior art, are points of novelty does not require the evaluation of demeanor or a sense of the ‘mainsprings of human conduct,” or a reflection of community standards. Rather what is called for is a sensibility trained to evaluate precedents and determine when and precisely how a given design departs from the precedent designs.

The appropriate decision maker must also be able to express in words the findings with regard to a point of novelty, because even if this Court determines that *Markman* does not require a detailed verbal description of the entire design, it will still be necessary for functional features of the design to be expressed in words. So too should points of novelty be expressed in words. Otherwise infringement decisions regarding points of novelty will become unnecessarily opaque to reviewing courts and to interested parties trying to understand the scope of the design patents that have been litigated.

This need for decisions as to points of novelty to be articulated in words also goes to the third of the factors upon which the *Markman* Court based its decision. The *Markman* Court saw “the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of construction to the court.” 517 U.S. at 390. As set out previously, the *Markman* Court recognized that the limits of a patent needed to be known not only for the protection of the patentee, but for the encouragement of the inventive genius of others. “Otherwise, a ‘zone

of uncertainty which enterprise and experimentation” might “enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field . . . .” 517 U.S. at 390.

Allowing juries to determine the scope of design patents while courts construe the scope of utility patents would also run counter to the equality of treatment to which design patents are entitled. The statutory provision creating design patents requires that the “provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.” 35 U.S.C. § 171. More specifically, this Court has expressly held that claim construction is required for design patents, stating 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.” *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). In its *Markman* opinion, this Court held that the first step of an infringement analysis is “determining the meaning and scope of the patent claims asserted to be infringed,” and also held “that in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim.” *Markman v. Westview Instruments*, 52 F.3d 967, 976, 979 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996)

All these reasons point to the conclusion that courts should identify the points of novelty as a part of claim construction—the very opposite of the position urged by EGI, in which the point of novelty test is abandoned entirely as a separate analysis. Just as EGI’s approach would blur the analysis of whether an accused design appropriates the “inventiveness” of the patented design, assigning the identification of points of novelty to the courts as part of claim construction would sharpen the focus in examining the question.

### CONCLUSION

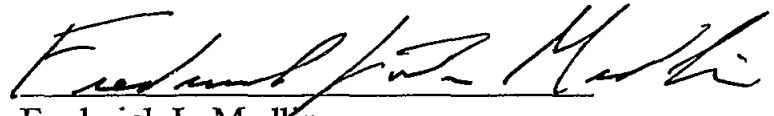
In this case the district court properly put EGI’s claim of infringement under the microscope of the point of novelty test, carefully examined it, saw that the Swisa Buffer did not appropriate any inventive aspect of the D’389 Patent, and granted a summary judgment. On appeal, the panel majority put an even sharper lens in the microscope--the non-trivial advance test--and again found that the Swisa Buffer did not appropriate any inventive aspect of the D’389 Patent, so that there could be no infringement.

EGI and various *amici* now argue that the best course is to throw out the lens entirely, and to see what the jury does in an opaque weighing process, shielded from the review of judges and the sort of more focused analysis that has twice resulted in the rejection of EGI’s claim. But more focus and clarity, not less, should be the goal here.

Swisa asks this Court to retain the point of novelty test of *Litton*. Although Swisa does not believe that the non-trivial advance test is necessary to sustain the summary judgment here where there was no point of novelty under the traditional *Litton* test that Swisa appropriated, Swisa believes the Court should adopt the non-trivial advance test. This Court should reject the suggestion that the holders of patents like the D'389 Patent, with designs that are slight modifications of single pieces of prior art from which they take almost all their features, should be able to claim that their combination point of novelty is their “overall appearance”—their entire combination of elements—rather than simply the new features that they have added to the prior art combination. The Court should retain claim construction for design patents, so that district courts may construe what the functional features of a design patent are. This Court to take the further step of holding that district courts should identify the points of novelty during the claim construction process, since such identification is a necessary part of construing a design patent's scope.

Swisa was granted a summary judgment under the traditional point of novelty test as it existed at the time, and that summary judgment was subsequently affirmed under the non-trivial advance test. Even if this Court decides not to adopt the non-trivial advance test, the summary judgment should be affirmed, and there is no need for a remand.

Respectfully submitted,



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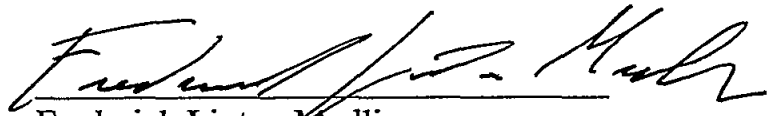
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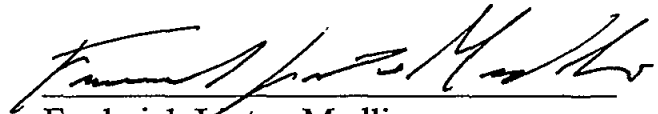
I certify that on March 7, 2006, I caused two copies of the foregoing Brief of Defendants/Third Party Plaintiffs—Appellees Swisa Inc. and Dror Swisa for En Banc Appeal to be served via U.S. Mail on Robert G. Oake, Jr., Oake Law Office, 1333 W. McDermott Dr., Suite 200, Allen, Texas 75013.

  
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### CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of the Federal Rules of Appellate Procedure 32(a)(7)(B). This brief contains 13,908 words, excluding the parts of the brief exempted by the Federal Rules of Appellate Procedure 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Federal Rules of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rules of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionately spaced typeface using Microsoft Word in 14 point Times New Roman font.



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