

# **EGYPTIAN GODDESS EXPOSED!**

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*MIDYEAR MEETING OF THE FLORIDA BAR*

*BUSINESS LAW SECTION – INTELLECTUAL PROPERTY COMMITTEE*

HYATT REGENCY, MIAMI

JANUARY 15, 2009

## **I. INTRODUCTION**

*Egyptian Goddess, Inc. v. Swisa, Inc.*, 256 Fed. Appx. 357 (Fed. Cir., 2007):

The petition for rehearing *en banc* is granted. The parties are requested to file briefs that should address the following questions:

(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).

## II. THE POINT OF NOVELTY TEST

### A. FROM WHENCE DOTHT IT COMETH?

We hold therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871).

“...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.” *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 682 (1893).

*Gorham’s* ordinary observer test “..cannot be applied without doing violence to the fundamental law of infringement - that in order to constitute infringement there must be an appropriation of the novel elements of the patented design.” *Kruttschnitt v. Simmons*, 118 F. 851, 852 (S.D.N.Y. 1902).

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 Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984):

### B. RECENT DEVELOPMENTS

None of the alleged 8 points of novelty were novel; summary judgment granted to defendant due to failure of plaintiff to satisfy the point of novelty test. *Lawman Armor Corp. v. Winner Int’l, LLC*, 2005 WL 354103 (E.D. Pa. 2005).

Since all 8 of the elements were not themselves novel, the plaintiff could not rely on a combination of non-novel elements to constitute a “9<sup>th</sup> point of novelty”. *Lawman Armor Corp. v. Winner*, 437 F.3d 1383 (Fed. Cir. 2006).

Although a combination of design elements can be a point of novelty this is a different concept than the overall appearance of a design which ... our cases have recognized cannot be a point of novelty. *Lawman Armor Corp. v. Winner Int'l*, 449 F.3d 1190 (*reh. den.*, Fed. Cir. 2006).

Failure to grant rehearing on this issue could place design patent holders in a “state of limbo.” *Lawman Armor Corp. v. Winner Int'l*, 449 F.3d 1192, 1194 (*en banc reh. den.*, Fed. Cir. 2006) (J. Newman dissenting).

Egyptian Goddess’ point of novelty did not rise to the level of being a “non-trivial advance” over the prior art, and thus was not sufficient to actually be a point of novelty. No court has ever before mentioned the words “non-trivial advance” when discussing the point of novelty. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354 (*vacated*, Fed. Cir. 2007)

### **C. SYSTEMIC PROBLEMS WITH THE POINT OF NOVELTY TEST**

#### **It Creates An Illogical Super-Standard for Design Patent Infringement**

Not only must the accused design be substantially the same overall as the patented design (*Gorham’s* doctrine of equivalents), but a sub-combination point of novelty, consisting of one or more novel features extracted from the overall claimed design, which was neither claimed nor examined individually, must be literally found in the accused design.

#### **It Encourages Back Door Attacks on Validity**

The accused infringer can attack the proffered novel elements under the significantly lower preponderance of evidence standard, rather than the higher clear and convincing evidence standard, as occurred in *Lawman Armor Corp. v. Winner Int'l, LLC*, thereby undermining the patent’s presumption of validity. 437 F.3d 1383, 1386 (Fed. Cir. 2006).

#### **Modern Design Patent Claim Drafting Obviates The Need For Point of Novelty Analysis**

Modern claim drafting for design patents, in which the scope of a claim is clearly shown by presenting design features in either solid or broken lines, further minimizes the rationale for point of novelty analysis. In *Whitman Saddle*, presented with a narrow design patent claim (all features in solid lines), consisting mostly of prior art design features, the Court perhaps felt compelled to determine what was novel, in order to allow the defendant to practice the prior art, as was her right.

**D. THE PRIOR ART CAN BE TAKEN INTO ACCOUNT WITHOUT ANALYZING THE POINT OF NOVELTY: THE 3-WAY VISUAL COMPARISON**

**Many Courts Have Already Used A 3-Way Visual Comparison**

The shape of defendants' bell differs from plaintiff's more widely than plaintiff's differs from the [prior art] door knob, and therefore defendants' construction does not infringe the patent. *Bevin Bros. Mfg. v. Starr Bros. Bell Co.*, 114 F. 362, 364 (C.C. Conn. 1902).

There are more features of similarity between [the patented design] and the prior patents cited than there are between Salt's Company's fabric and the patented design. Therefore to view this design in such light as to find infringement would be to bring the patented design within the prior art and thereby render the patent invalid. *Sidney Blumenthal & Co. v. Salt's Textile Mfg. Co.*, 21 F.2d 470 (D. Conn. 1927).

[I]t 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. *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6<sup>th</sup> Cir. 1933):

[I]n contrast to pre-existing hand held blenders [i.e., the prior art], which had a utilitarian, mechanical appearance, both Waring's blender and Braun's blender share a fluid, ornamental, aerodynamic overall design. *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 820 (Fed. Cir. 1992):

**The 3-Way Visual Comparison Test Proposed As A Replacement for the Point of Novelty Test**

If the patented or accused designs appear to be visually closer to the prior art than they are to each other, then the trier of fact will more likely conclude that the designs are not substantially the same.

On the other hand, if the patented and accused designs appear to be visually closer to each other than either is to the closest prior art, then the trier of fact is more likely to conclude that the designs are substantially the same.

## E. DISMOUNTING *WHITMAN SADDLE*

If *Whitman Saddle* were litigated today, based on the current amorphous point of novelty test, it could go either way. A more just and predictable result, however, could only come by using the 3-way visual comparison test as a replacement for the point of novelty test.

### **Material Facts Not Apparent from the Reported Decision**

**First:** The most material fact discovered from 1893 Supreme Court records was the *appearance* of the accused design and prior art.

**Second:** The patented and accused designs were extremely close visually, easily satisfying the *Gorham* ordinary observer test.

**Third:** The combination of the Granger saddle with the Jenifer cantle was in fact novel.

**Fourth:** The pommel drop was a visually insignificant design feature.

### **The Fly in the Accused Infringer's Ointment**

Under today's standard of non-obviousness for designs, the combination Granger/Jenifer would not likely be held obvious to a designer of ordinary skill, i.e., the combination Granger/Jenifer would today be patentable.

There were actually 3 elements to the novel combination: the Jenifer cantle, the Granger saddle, and the open slot. The combination was clearly patentable over the prior art using today's standards.

The underpinnings of the *Whitman Saddle* case do not hold water today – the point of novelty test is not necessary to resolve infringement. The 3-way visual comparison test works much better.

### **The Point of Novelty Test Simply Doesn't Work**

The point of novelty test does not work because the outcome of any case depends on the uncertain formulation of the point of novelty, i.e., the winner of the battle as to whose point of novelty is the “correct” point of novelty would likely win the case.

**Plaintiffs:** An informed plaintiff likely presents the point of novelty as a combination of elements (which is inherently more difficult to attack as not being novel). For example, the patentee Whitman would present the point of novelty as the *combination* of the Granger saddle, the Jenifer cantle and the open slot. This combination was clearly novel.

**Defendants:** An informed defendant presents a list of the individual “points” of novelty (which are inherently easier to attack and avoid). For example, the accused infringer Smith lists the individual points of novelty as: the Granger saddle (which is old); the Jenifer cantle (which is old); the open slot (which is old); and the pommel drop (which is nowhere to be found).

Thus, a classic point of novelty analysis applied to the *Whitman Saddle* facts might today result in a finding of no infringement in spite of the fact that 90% of the novel and unobvious patented design was found in the accused design.

## F. CONCLUSIONS REGARDING THE POINT OF NOVELTY TEST & WHITMAN SADDLE

**First:** The 3-way *visual* comparison of the patented design, the accused design and the prior art makes all the difference to the fact finder: it is clear from the illustrations that the accused design and patented design are much closer to each other than either is to the prior art, that 90% of the claimed design is *visually* found in the accused design, and that the pommel drop “b” is so *visually insignificant* as to be barely noticeable.

**Second:** The inherent uncertainty in modern day *Whitman Saddle* situations by controverted formulations of the point of novelty can be avoided by using the 3-way test.

## II. MARKMAN CLAIM CONSTRUCTION FOR DESIGN PATENTS

### A. MARKMAN APPLIES DIFFERENTLY TO DESIGN PATENTS

Because a design patent’s claim is defined by drawings and not words, claim construction must be fundamentally different than that for a utility patent.

### B. VERBALIZING A DESIGN PATENT CLAIM IS UNNECESSARY AND MISLEADING

Neither the U.S. Patent Act nor *Markman* requires a court to convert the visual appearance of a claimed design shown in the design patent drawings into a written

description. Indeed, reference to the drawings is amply sufficient to satisfy *Markman* claim construction, and makes more sense. See *Black & Decker, Inc. v. Pro-Tech Power Inc.*, 47 U.S.P.Q.2d 1843, 1845 (E.D. Va. 1998); *Colgate-Palmolive Co. v. Ranir*, 2007 WL 2225888, \*4 (D. Del. 2007); *ADC Telecomm. v. Panduit Corp.*, 200 F. Supp.2d 1022, 1032-33 (D. Minn. 2002); *Caponey v. ADA Enterprises, Inc.*, 511 F.Supp.2d 618, 624 (D.S.C. 2007).

**C. IT IS FUTILE TO TRY AND DESCRIBE A VISUAL REPRESENTATION IN WORDS**

*[The design] is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration, Dobson v. Dornan*, 118 U.S. 10, 14 (1886) (emphasis added).

Undoubtedly, in the matter of application for a patent for a design, a picture of the design serves to convey a greatly more adequate idea of the design than any verbal description could possibly do; and *in the presence of the picture, a superadded verbal description is generally useless and oftentimes confusing. In re Freeman*, 23 App. D.C. 226 (D.C. Cir. 1904) (emphasis added)

...it is very difficult to put in words a description which so differentiates [the claimed design] from the prior art as to convey any vivid impression to one reading this opinion. This is largely due to the *inherent difficulty of describing visual impressions in words*, which is, of course, heightened where the person attempting it is without technical training in drawing or art. *Friedley-Voshardt Co. v. Reliance Metal Spinning Co.*, 238 Fed. 800, 801 (S.D.N.Y. 1916) (emphasis added).

**D. VERBALIZING A CLAIMED DESIGN EVISCERATES GORHAM**

The venerable *Gorham* test is not one of literal infringement; rather, *Gorham's* test subsumes a doctrine of equivalents for designs by asking whether the two designs are *substantially the same*. *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1190 (Fed. Cir. 1988). However, comparing the accused design to a verbalization, to a reduction to words of the drawing's solid lines, eviscerates *Gorham's* doctrine of equivalents. This is because the jury is likely to check whether each of the words in the verbalization are found in the accused design, akin to a literal infringement test, rather than whether the designs are visually substantially the same. Thus, verbalization derogates how the claimed design actually appears to the eye.

**E. VERBALIZING A CLAIMED DESIGN INCREASES THE RISK OF A SUMMARY JUDGMENT OF NON-INFRINGEMENT**

*Gorham's* test of whether the accused and claimed designs are “substantially the same” does not even reach the jury in many cases, because the defendant, having a verbalization that likely includes several elements missing or different from the accused design, more often than not moves for summary judgment of non-infringement. After a rather literal, verbalized claim construction that does not “read on” the accused design, summary judgment of non-infringement is granted eight times more frequently than summary judgment of infringement.

In a survey of 63 design patent cases reported since 1995 wherein claim construction consisted of a verbalization of the design patent's drawings, 43 were thereafter subject to a motion for summary judgment of non-infringement, of which 31 were granted. In those same 63 cases, a motion for summary judgment of infringement was granted only 4 times. See *Design Patents: Claim Construction Rules Lead to Summary Judgment of Non-Infringement*, at <http://www.patentlyo.com/patent/2008/01/design-patents.html?cid=98131392#comment-98131392>.

**F. VERBALIZING DESIGN PATENT CLAIMS RISKS 7<sup>TH</sup> AMENDMENT VIOLATIONS**

The court's pre-determination during the Markman phase of those features that are ornamental and those that are functional, for purposes of determining the scope of the design patent, could be fairly argued as improperly infringing upon a litigant's *Seventh Amendment* right to a jury trial on invalidity, as well as being tantamount to a summary judgment decision on the issue, *Colgate-Palmolive Co. v. Ranir*, 2007 WL 2225888, \*8 (D. Del. 2007).

**G. PARSING OF ORNAMENTAL AND FUNCTIONAL FEATURES DURING CLAIM CONSTRUCTION IS UNNECESSARY**

It is not necessary to parse ornamental and functional features during claim construction, since the design patentee has already claimed all features shown in solid lines in the drawings, regardless of whether such features are new, old, ornamental or functional. *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). Functionality is a validity issue, not an infringement issue. Case law holding that so-called functional features must be extracted from an overall claimed design during claim construction, e.g., *Read Corporation v. Portec, Inc.*, 970 F.2d 816, 826 (Fed. Cir. 1992), are based on the erroneous premise that a design patent cannot claim a design having features that perform a function; it can (see *Elmer*,



*supra*). But a design patent cannot claim an overall design which is dictated solely by functional considerations. *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 40 USPQ2d 1048 (Fed. Cir. 1996). Such a design patent is invalid as non-statutory subject matter (35 U.S.C. §171) and may be properly challenged by an appropriately pled invalidity defense. *Read Corporation* relied in turn on *Lee, supra*, but the court's point in *Lee* was that functionality is an invalidity defense, and a design patent cannot be used to protect the general function of a particular design.

#### H. CONCLUSIONS REGARDING MARKMAN CLAIM CONSTRUCTION OF DESIGN PATENTS

When interpreting a design patent, a court should initially direct attention to the design as shown in the patent's drawings. The court should also provide general guidance to the fact-finder as to the legal meaning of broken lines, drafting and shading conventions, the prosecution history, multiple embodiments, indeterminate break lines, etc., to better assist the fact-finder in understanding the overall design as shown in the patent's drawings. However, the post-Markman practice of summarizing in words, or verbalizing, the images in the drawings, is oftentimes confusing and potentially injurious to patentees. Moreover, this practice provides little benefit to the court, and distracts the trier of fact from their age-old mandate of visually comparing the design patent's drawings to the accused design to determine if they are substantially the same. It also has the effect of unfairly narrowing the scope of a design patent and, much more often than not, inappropriately subjecting the claim to summary judgment of non-infringement.