

CORRECTED BRIEF

BRIEF BY AMICUS CURIAE
FOR REVERSAL OF THE JUDGMENT UNDER REVIEW

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2006-1562

EGYPTIAN GODDESS, INC.,

Plaintiff-Appellant

and

ADI TORKIYA

Third Party Defendant

v.

SWISA, INC. and DROR SWISA,

Defendants/ Third Party

Plaintiffs-Appellees

Appeal from a decision of the United States District Court of the
Northern District of Texas in case No. 3:03-CV-0594,
Judge David C. Godbey

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February 27, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

EGYPTIAN GODDESS v. SWISA, INC.

2006-1562

CERTIFICATE OF INTEREST

Counsel for amicus certifies the following:

- (1) The full name of the amicus curiae represented by me is: William T. Fryer, III
- (2) The name of the real party in interest if the party named in the caption is not the real party in interest is: None
- (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 name of all law firms and partners or associates that have appeared for the amicus now represented by me in the trial court or agency or are expected to appear in this court are: None.

Signature of Counsel

Printed name of counsel

Date: February 27, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

EGYPTIAN GODDESS v. SWISA, INC.

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STATEMENT OF IDENTITY

Counsel is a full time professor at the University of Baltimore School of Law, teaching primarily intellectual Property law subjects there for the last 27 years. A prior amicus curiae brief by counsel was accepted by this Court on an important design patent case, In re Daniels, Appeal 97-1225, Serial No. 29/020,782, filed August 11, 1997, 144 F.3d 145 (Fed. Cir. 1998).

The counsel scholarship and participation in conferences and other intellectual property law related activities have been primarily in the field of design protection. An up to date CV with counsel=s activities and publications can be found at URL <http://www.fryer.com>. Counsel has been chair of the American Intellectual Property Law Association Industrial Designs Committee, chair of the American Bar Association, Section of IP Law (ABA IP Section) Committee 412 (Industrial Designs), and chair of a special ABA IP Section Committee that assisted in the development of the Hague Agreement Concerning the International Registration of Industrial Designs, Geneva Act, on which he has written a book.

His next publication (approximately April 2008), for Cambridge Press, is

a chapter in a book organized by the World Intellectual Property Organization on how to teach intellectual property law. His chapter describes how to teach industrial design law with an international perspective.

The subject appeal presents very important issues on design patent law. It is respectfully requested that counsel be allowed to submit his comments on how the design patent law related to this case should be interpreted.

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STATEMENT OF ISSUES

ISSUES

ISSUE 1 Should Apoint of novelty@ be a test for infringement of design patent?

2. If so,

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

ISSUE 3 (b) should the point of novelty test be part of the patentee=s burden on infringement or should it be an available defense;

ISSUE 4 (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;

ISSUE 5 (d) should it be permissible to find more than one Apoint of novelty@ in a patented design; and

ISSUE 6 (e) should the overall appearance of a design be permitted to be a point of novelty? See Lawman Armor Corp. v. Winner Int=1, 449 F.3d 1190 (Fed. Cir, 2006)?

STATEMENT OF THE CASE

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The District Court held , on summary judgment , that Egyptian Goddess had not met its burden of proof that the points of novelty of its nail buffer patented design had been appropriated.

This case comes to the Federal Circuit, Court of Appeals, on the aforementioned issue. It will be reviewed de novo.

SUMMARY OF ARGUMENT

1. The basic design patent law is reviewed. The current law is a two stage review to determine what a design patent protects and infringement. The first stage is the patentability analysis. It defines the nonobvious design, the whole design, that is the basis for protection. The next stage is the infringement analysis. This analysis determines whether the patented whole design is infringed. The conclusion from this review is that there is no need for a **Apoint of novelty@** test. There are adequate safeguards so that merely functional, merely novel and obvious features will not be protected under current design patent law.

2. The analysis of how a point of novelty@ test would apply, based on various assumptions, as posed in the Court=s questions, concludes with a finding that the

Apoint of novelty@ test is difficult to apply and would continue to created confusion and conflict in applying design patent law.

3. The conclusion is that the Apoint of novelty test should be eliminated. A district court=s claim interpretation and jury instructions will be used to guide the jury=s infringement determination.

ARGUMENT

ISSUE I: Should Apoint of novelty@ be a test for infringement of a design patent?

Answer: No

A. Review of this author=s understanding of design patent law applicable to this case.

1. Introduction. The basic design patent law issues in this case are patentability and infringement and the relation between the aforementioned laws. It is important in this introduction to start at the beginning of design protection analysis, the patentability stage and then go to the infringement stage. The patentability stage analysis will use the In re Nalbandian case, 661 F.2d 1241 (CCPA 1981). This case is a fundamental tool for teaching design patent law patentability under 35 U.S.C. sections 102 and 103. The two cases used to review infringement analysis will be opinions the U.S. Supreme Court: Gorham Company

v. White, 81 U.S. 511 (1871) and Smith v. Whitman Saddle Co., 148 U.S. 674 (1893).

A very important step in design patent analysis, for a person who usually works with technology inventions, is to realize that one has to start thinking visually on some issues and on other topics the functional role of a product part may be important. It is not an easy transition for some patent attorneys to make, speaking from this author=s experience.

2. Patentability Analysis of a Design Patent. The In re Nalbandian case involved a design patent application for a pocket type product with a combined flashlight at one end, tweezers at the other end and a central portion connecting the two useful parts (See images of design patent application drawing and prior art, In re Nalbandian, 1215, 1220). In the central portion were circumferential, spaced grooves, creating a different image for the application design compared to the prior art that had the essentially the same image created by functional parts with longitudinal grooves in the central portion. The Court of Customs and Patent Appeals affirmed was obvious under 35 U.S. C. section 103 to replace the circular grooves with the longitudinal ones found in the prior art for related devices. This patentability analysis denied design patent protection for a novel feature that provided ornamentation for the overall design image in the same way the prior art did. The issue was whether the whole design was obvious. This example is

mentioned to show that having a novel design feature and a different overall product, does not necessarily mean that there will be design protection. Novelty is not the ultimate issue. The question is whether the whole design is obvious to an ordinary design in that art.

If the In re Nalbandian case design patent product had a spiral groove surrounding the central portion between the flashlight and the tweezers that continued as painted strips on to the light housing and the tweezers surface, that novel difference would create an overall design that integrated with the other parts and significantly change the overall appearance. It would be harder to conclude that this visual combination was obvious, even if spiral grooving was old for related device ornamentation. What is learned from this changed product design is that simply looking at the visual novelty of some feature on a product is not relevant to what is protected by design patents.

The In re Nalbandian case and the modification thereof helps illustrate the conclusion that the Point of novelty test, when referring to what may be distinctive in a novelty sense under 35 U.S.C. section 102 has no relation to what may be protected under design patent law.

A further conclusion is that the Point of novelty test is not needed. For example Litton Systems, Inc. V. Whirlpool Corp., 728 F.2d 1423, was one of the

early cases that used the point of novelty test. The Litton Federal Circuit Court of Appeals decision probably gracefully avoided use of the points of novelty test. It looked at what visual features were on the Litton microwave oven, compared them to the prior art, and considering the overall appearances of the ovens. The Court had a good sense of how the Litton oven design features integrated to create one design. The Court could have started with analyzing the overall design shown in the design patent for similarity to the defendant's oven image to determine more quickly and surely whether there was infringement, following the Gorham case. The point of novelty test was not needed. The Court avoided the point of novelty confusing role, Litton, 1444.

Another fact demonstrated by the In re Nalbandian case examples is that the patentability analysis makes sure that merely functional as well as obvious features are not protected. The flashlight was a technical device and the tweezers performed a function that had a shape essential for that function. The patentability analysis would not allow those features alone or together to be protected by a design patent. It is clear that the patentability analysis has the effect of eliminating design protection unless there is non-obvious ornamentation, such as the proposed central portion spiral

feature and coordinated strip combined with the functional features what make up the protected design. The design patent law requires that for protection there must be ornamentation in the claimed design, 35 U.S.C. section 171.

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. @ 35 U.S. S. section 171

There is no need to have a point of novelty test to protect against design patents from claiming merely a functional, or merely novel or nonobvious design features. All the elements of the nonobvious design patent drawing are part of the protected design, and the next stage is to determine what is an infringement.

3. Design Patent Infringement Analysis. Once design patent patentability is determined the design patent drawings, the protected overall design is used to determine if there is infringement, by comparing it with the alleged infringing product design visual image. The test was explained in the Gorham case , 524, where the comparison is for substantial similarity that is likely to cause confusion in distinguishing the design patent design from the alleged infringing product design. The images do not have to be identical, Gorham, 529. Incidental other features may not prevent infringement, if there is evidence that design patent design has been

used.

The design patent infringement analysis step will find similarities between the two designs, some of the similarities may be due to merely functional features needed for the product to operate. There will be no design patent infringement from use only of the functional features, as the essentially the whole design must be used to have infringement, and the patentability stage determined there was ornamentation present in the whole design. The design that is protected will include the nonobvious design, as a part of the whole design. Infringement similarity must include the nonobvious design as a whole. A design patent has a presumption that the design patent drawing design is nonobvious, 35 U.S.C. section 282.

B. A Point of Novelty analysis is not needed to Protect Against Design Patents issuing for Obvious or Merely Function features.

1. When the present design patent law of patentability and infringement is applied correctly, there is no need for a A point of novelty test. It should be eliminated.

One main reason that the A point of novelty test should be eliminated is that it can seriously complicates design patent litigation. The Lawman Armor Corp., 449 F.3d 1190 (Fed. Cir. 2006), Supplemental Opinion from the Federal Circuit and the amicus curiae petitions that spirited that revision are ample evidence that there is a

problem with full understanding and applying the **Apoint** of novelty@ test.

Fundamentally the point of novelty test is a misnomer, as more than novelty is needed to determine what design features are protected. This fact was illustrated in the the Issue 1, Part A Introduction.

C. The U.S. Supreme Court opinion on Smith v. Whitman Saddle Co. is not precedent for using a **Apoint of novelty@ infringement test.**

1. Instead, the Smith case used the patentability analysis to prevent design patent protection of a design that was obvious. The court in that case rendered a decision that the saddle design was not patentable, Smith, 680-1. The Court proceeded to analyze the appearance of the alleged design patent saddle and compared it with the alleged infringing saddle. The Court noted a visual feature created by the combination of the prior art saddle designs in the design patent saddle. This difference was not present in the alleged infringing saddle. What the court appeared to be saying was the designs were not similar and there was no infringement, even if the design patent saddle design was patentable.. The White case used a similarity test to find out whether there was infringement. It did not use a **Apoint** of novelty@ approach.

D. It is submitted that the the **Apoint of novelty@ test is not valid under U.S. Supreme Court precedent.**

1, The Apoint of novelty@ test is in conflict with the Gorham, 524-529, where that Court used a similarity test to determine infringement. The use of an additional another infringement test complicates infringement analysis, as evidenced by the Lawman Supplemental Opinion and the petitions for amicus review of that decision.

The U.S. Supreme Court in KSR Intern v. Teleflex, __ U.S. __, 12 S. Ct. 1720 (2007), has cautioned against lower courts creating exclusive or alternative tests that are not clearly useful. The guidance from the U.S. Supreme Court is to provide flexibility, while not excluding other tests, KSR, 1739, 1741, 1746. The concern with the Apoints of novelty@ test is that it does not provide clarification. In fact it causes great confusion. It complicates the basic two stage analysis of patentability and infringement, as explained in the Issue 1, Part. For this reason, and others, the Apoint of novelty@ test should be eliminated.

A leading historical review of the U.S. design patent System from its start in 1842 to 1890 was written by Professor William C. Robinson, The Law of Patents for Useful Inventions (1890), sections 109, 200-209, 501, 533 and 929. This author=s review of the relevant Robinson material did not find any reference to Apoints of novelty@ or an equivalent infringement analysis approach. This book provides a detailed explanation of design patent law and practice during that time. A particularly useful

topic in the book, to help understanding how to analyze design patents in section 201

A Design distinct from its component parts@, volume 1, page 286.

E. The design patent law adequately protects the public against protection of merely function, merely novel or obvious designs.

1. The A point of novelty= test grew out of legitimate concern. Probably, it was created to be certain that non-patentable subject matter for design patents would not be protected. It had a worthy purpose. The complications it created were not first appreciated, but the evidence is in now that the test is not helpful. The safeguard to protect the public against invalid design patents is already built into the design patent law. The first analysis stage in litigating a design patent determines patentability, where merely functional product designs, merely novel designs and obvious designs are not patentable. In the second stage of design patent analysis, where infringement is determined, the similarity test will determine if the whole design that was found patentable has been infringed. The whole design infringement analysis does not allow protection of merely functional, merely novel or obvious features. There must be ornamentation for a design patent to be valid, and the patentability analysis will assure that infringement of the whole design shown in the design patent protects statutory subject matter.

F. A district court will provide suitable instructions on infringement to a jury.

1. Design patent protection is a comprehensive process that includes a major role for

district courts. These courts will determine the scope of the design patent claim and provide jury instructions on the infringement determination. These jury instructions will include a statement that only the whole design can be infringed, based on the similarity test. It is the whole design that is patentable. With the Gorham infringement approach used, the jury will be guided away from finding infringement due to similarities for parts of a design that should not be protected. The overall design image in the design patent drawing and in the alleged infringing product must be substantially the same. This test is a focused analysis determined by visual image comparison and not based on how a product works. The court will provide instructions on what can be protected. This analysis is explained in Issue 1, Part A Introduction. There is no need for a **point of novelty** test to protect the public or to help a jury.

ISSUE 2: If the **point of novelty test should be adopted, should the court adopt the non-trivial advance test adopted by the panel majority in this case**

Answer: No

A. The Non-Trivial Advance Test appears to Conflict with Patentability and Similarity Infringement determinations.

1. **A non-trivial advance test is effectively a patentability test.** In that respect it would easily confuse practitioners, courts and juries. If it use as an aid for infringement determination, it would stand in the way of an effective use of the

ordinal observer test, grounded in the Gorham case. The patent law has basic principles that are rooted in case law and statutes to determine patentability and infringement. The way the law works is explained in the Issue 1, Part A Introduction. For this reason a non-trivial advance test should not be used.

2. The U.S. Supreme Court in the KSR decision has urged courts to use caution in developing new alternative tests for implementing statutory requirements..

The recent KSR decision __ U.S. __ , 127 S. Ct. 1720, 1739, 1741 (2007), addressed alternatives test to determine obviousness. While the issue in that case was whether an alternative test was too rigid, in determining whether a combination of prior references rendered a claim obvious, the caution in using alternative tests in place of the basic statutory analysis was evident. The KSR court strongly suggested that the statute should be the focus, KSR, 1746. It is submitted that the Anon-trivial advance@ test is not helpful in determining infringement. The basic law explained in the Issue 1, Part A addresses this concern. For this reason, the Anon-trivial advance@ test should not be used as a part of the infringement analysis for design patents.

ISSUE 3: If the Apoint of novelty@ test is used, should the point of novelty test be part of the patentee=s burden on infringement or should it be an available defense.

Answer: It is the role of the court to point out the scope of the design patent design right. Then, it should be the burden of the design patent owner to show that there is infringement of that claim, including the Apoint of novelty@, if it is a nonobvious design feature. The difficulty in dealing with this complex approach is apparent.

1. The district court should identify the patentable design, under the Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996), using the design patent drawing that shows the protected design. The design as a whole is what is patentable and protected. The court can include in its jury instructions reference to design patent law that eliminates merely functional, merely novel and obvious features from protection. The court will stress it is the similarity of the patented design as a whole and the allege infringing design that the jury must determine and find substantial similarity for infringement.

If the Apoint of novelty@ test is used, the court would address in its instructions what features contribute to the overall, nonobvious, protected design. This step is as far as the court should go, in order not to confuse the jury. The design patent owner has the burden to prove infringement.

This explanation and the Issue 1 Part A Introduction illustrate how complex this determination of infringement is with the Apoint of novelty@ test included. It will require very careful instructions to a jury.

ISSUE 4: If the Apoint of novelty A test is used, 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?

Answer: No

1. The practice of selecting points of novelty to facilitate a finding of infringement should not be used, The Gorham case test of similarity infringement is applied to focus on the protected whole image, Gorham,

524-529. Since design patent infringement requires a finding what the whole design in the design patent is infringed, it is not clear whether the Court is suggesting that less than the whole design is being protected. Since the similarity test in the Gorham does allow a comparison of likelihood of confusion, some features as a whole design may stand out in relation to other features that are added by alleged infringers. If the alleged infringing design is a distinctly different design it will not be an infringement.

If the Court is asking the question whether having some features in an alleged infringing design that are the same as the patented design, but the overall design patent image is not the same, the present of the points of novelty similarities would not result in infringement. If the overall designs were the same to the ordinary observer, than there will be infringement, as in the Gorham case.

It seems to the author that the fundamentals explained in Issue 1, Part A Introduction make clear that the Apoint of novelty@ use in infringement analysis

creates a lot of confusion in applying the basic design patent law. For this reason, and others, the Apoint of novelty test@ should not be used.

The Court=s questions are an excellent, in that they help identify if there are problems in applying the Apoint of novelty A test.

ISSUES 5 If the Apoints of novelty@ test is applied should it be permissible to find more than one Apoint of novelty@ in a patented design; and ISSUE 6: should the overall appearance of a design be permitted to be a point of novelty? See Lawman Armor Corp. V. Winner Int=l, 449 F.3d 1190 (Fed. Cir. 2006)?

Answer: No to each issue

1. The approaches described in Issues 5 and 6 would create extreme confusion in design patent law. The answers on Issues 1 through 4 should be read in connection with Issues 5 and 6. As understood, the approach described in Issue 5 would be in conflict with basic patent law principle that the whole design is protected. What makes up that design includes the design features. The whole design has been determined to be nonobvious. It is not one or more features that need to be found to find an infringement. It is a substantial similarity of the whole protected design that must create a likelihood of confusion for their to be infringement. In addition, singling out one or more points of novelty is visually impractical where the design has a distinct interactive effect due to the features present. It is the overall design images that are compared.

The mere thought of this type of analysis creates confusion in thinking about

the issue, which is one reason the author is having difficulty giving a clear answer to the Issue 5.

2. Issue 6 is an expansion of the Issue 5 approach that creates the same problems as Issue 5. Question 6 seems to suggest overall design being a point of novelty. This approach returns the analysis to the basic test of patent law, and the question is why is the Apoint of novelty@ analysis needed?

If all the features of a design are in the point of novelty, it is the same as saying all features are new, individually, and they make up a new design never known publically before . If all these features are merely functional, what is the result? How does the Apoint of novelty@ test help the analysis? Of course the confusion over the relation to nonobvious features remain, as discussed already.

Issues 5 and 6 are good ones ,as they help us to test the real role of the Apoint of novelty@ test. When the answers are almost impossible to give without making a lot assumptions, it is time to think about how the lower courts, attorneys and juries will respond to the instructions involving the Apoint of novelty@ test. The author considers the Apoint of novelty@ test is not helpful.

The Federal Circuit, Court of Appeals Supplemental Opinion in the Lawman case did not provide sufficient explanation to understand how the Apoint of novelty=

test would work, in the context of the current design patent law. The en banc review of the Egyptian Goddess district court decision is an essential step in clarifying the law.

CONCLUSIONS

It respectfully submitted that the District Court=s decision should be reversed and the case remanded with instructions on the proper infringement test to apply. The Apoint of novelty@ test should not be used.

The author of this brief wishes to thank the court for the opportunity to submit his views on this important case.

ORAL ARGUMENT

The author of this brief requests to participate in the oral argument

SIGNATURE OF BRIEF

William T. Fryer, III

Counsel

Date: February 27, 2008

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS,
TYPEFACE REQUIREMENTS, AND TYPE STYLE REQUIREMENTS

1. This brief complies with the type-volume limitation of Federal Rules of Appellate Procedures 32(a)(7)(B).

The brief contains 3924 words, excluding the parts of the brief exempted by the Federal rules of Appellate Procedure 32(a)(7)(B)(iii).

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The brief has been prepared in a proportionally spaced typeface using WordPerfect 12 program, in size 14 point and Times New Roman type style.

Counsel=s Signature

Date: February 27, 2008

CERTIFICATE OF SERVICE

I hereby certify that two true copies and corrected copies of the foregoing Brief by Amicus Curiae for Reversal of the Judgment under Review and Counsel's Entry of Appearance have been provided by overnight delivery this 27th day of February 2008, to:

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I hereby certify that on this 27th day of February 2008, I hand-filed the original and 30 copies of the foregoing Brief, original and three copies of the Certificate of Interest and Entry of Appearance with the Clerk's Office of the United States Court of Appeals for the Federal Circuit.

William T. Fryer, III

Counsel

Date: February 27, 2008