

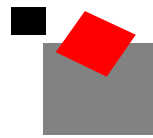


Looks Matter...

Legally.®

EGYPTIAN GODDESS **EXPOSED**

Perry J. Saidman

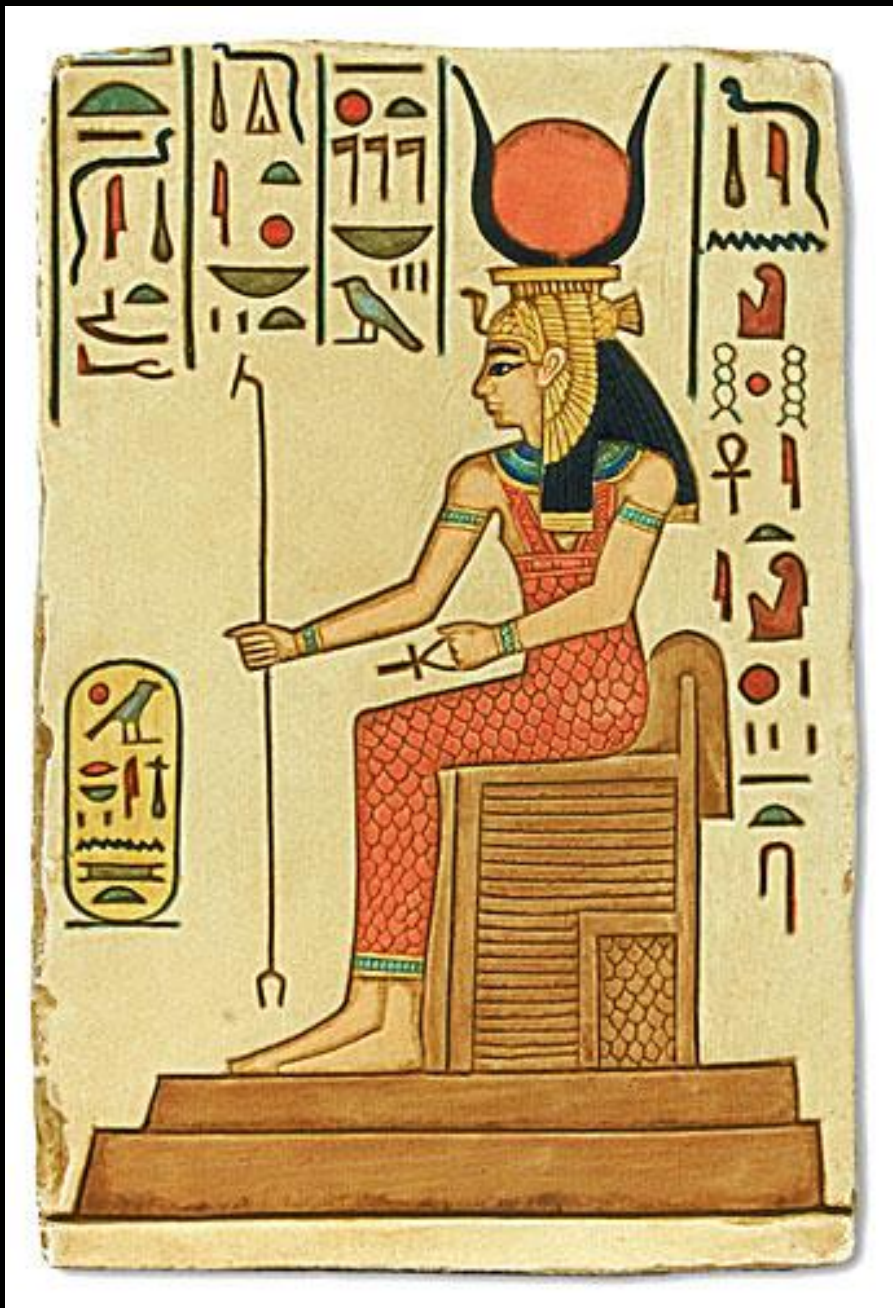


S A I D M A N

DesignLaw Group

8601 Georgia Ave., Suite 603
Silver Spring, MD 20910
301-585-8601

Florida Bar - Business Law Section
Intellectual Property Committee
Miami, Florida
January 15, 2009



*How DARE
you expose
me?*



C6 Corvette































EGYPTIAN GODDESS EXPOSED

Perry J. Saidman



S A I D M A N

DesignLaw Group

8601 Georgia Ave., Suite 603
Silver Spring, MD 20910
301-585-8601

*20th Annual IP Fall CLE Seminar
Williamsburg VA
September 27, 2008*

Egyptian Goddess

Issues

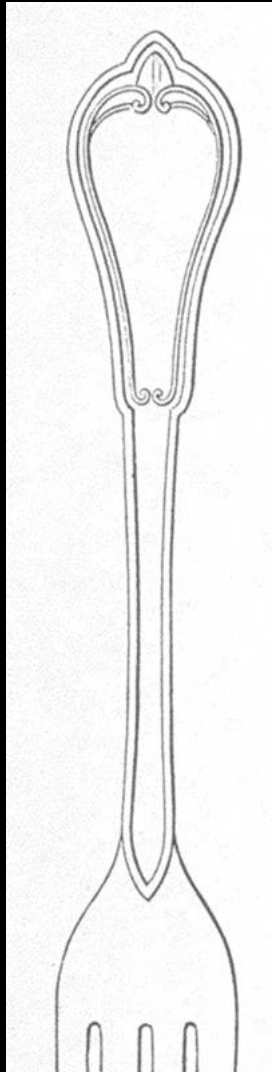
1. Point of Novelty Test

2. Markman Claim Construction

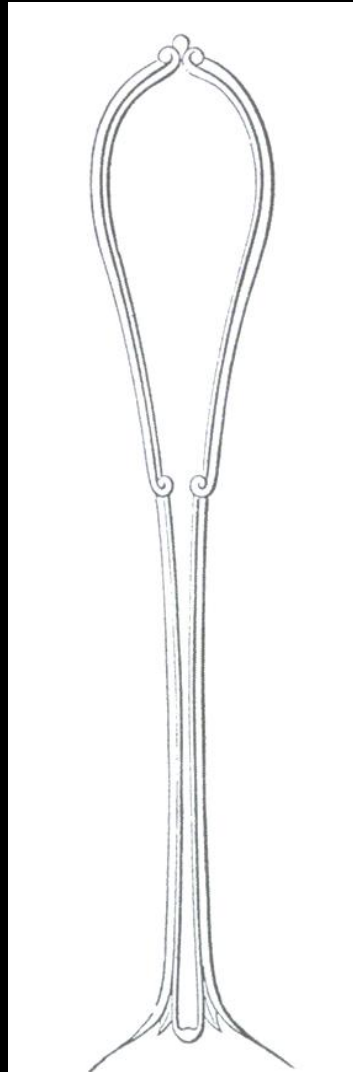


*What's
the test
for
design
patent
infringe-
ment?*

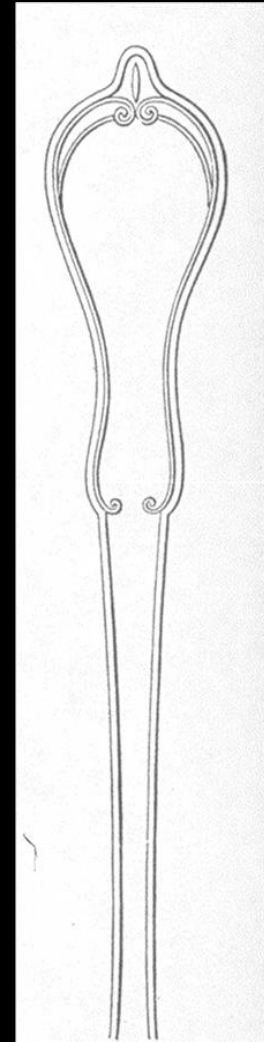
Gorham v. White (1871)



**White, 1867
accused design**



**Gorham Co.'s
patented design**



**White, 1868
accused design**

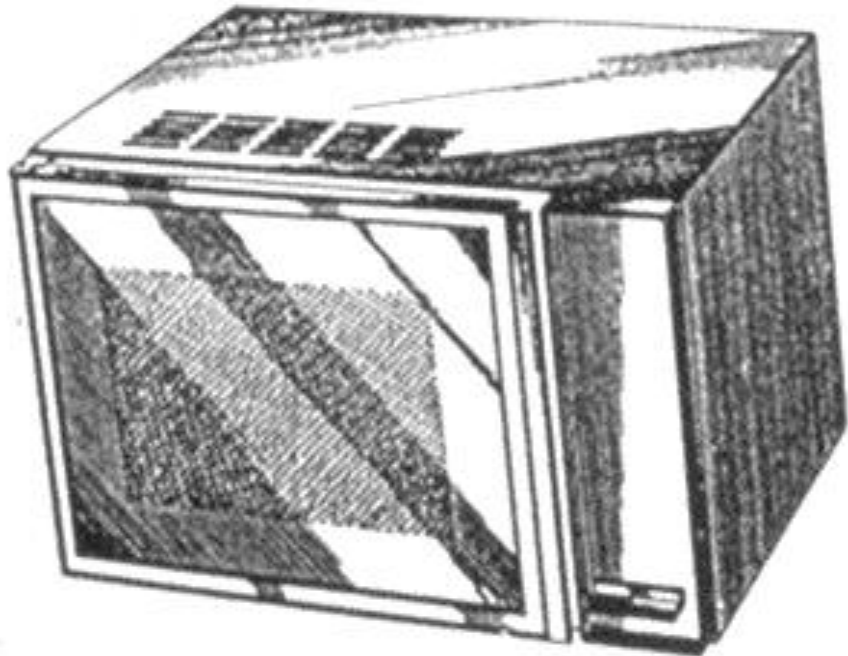
Gorham v. White (1871)

ORDINARY OBSERVER TEST:

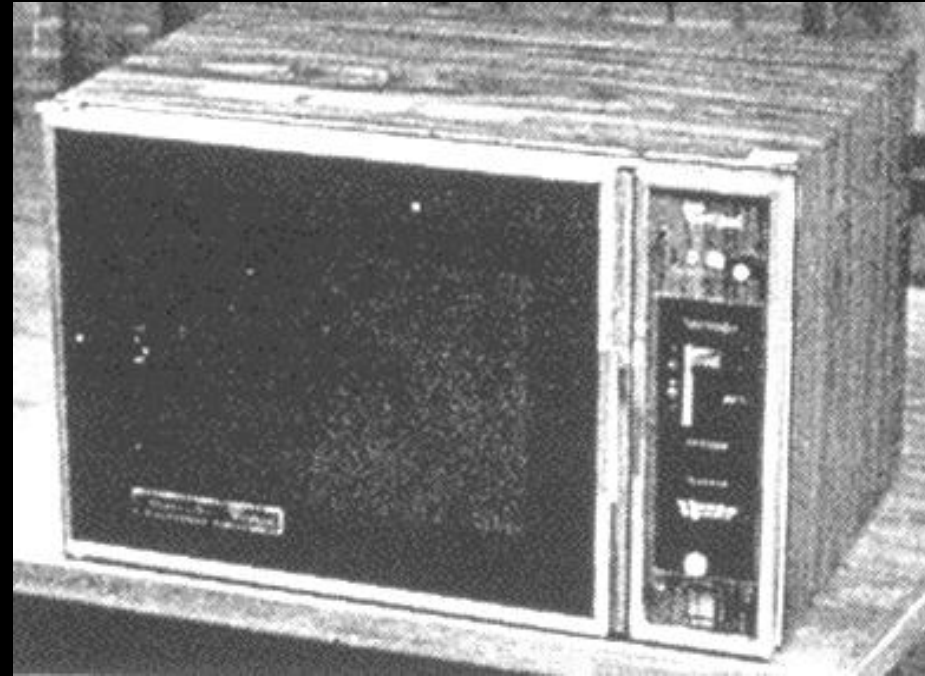
*...if, in the eye of an ordinary observer...
two designs are substantially the
same...[then] the ... one patented is
infringed by the other.*

Litton v. Whirlpool

(FED. CIR. 1984)



Litton's
U.S. Pat No. Des. 226,990



Whirlpool's Model
7600 Oven

Litton v. Whirlpool

(FED. CIR. 1984)

POINT OF NOVELTY TEST:

The accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.

Motorola v. Qualcomm

United States Patent [19]

Nagele et al.

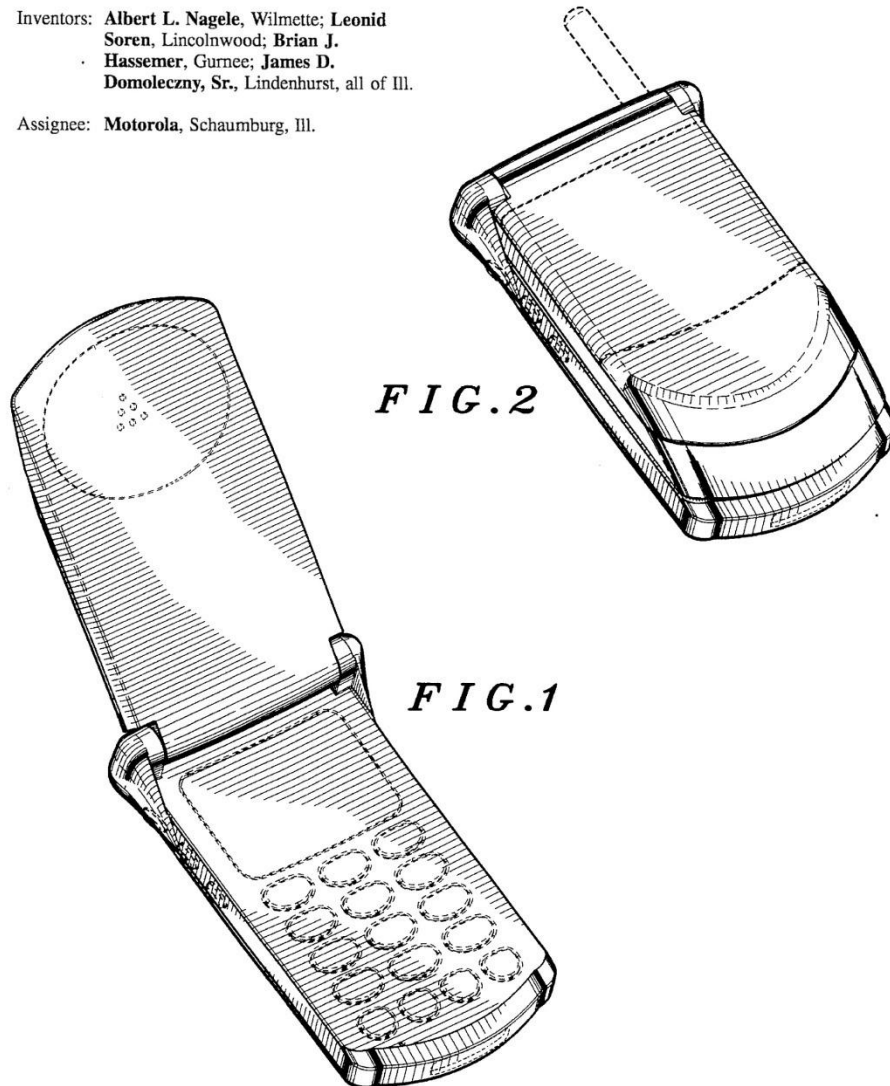
[11] Patent Number: Des. 369,598

[45] Date of Patent: **May 7, 1996

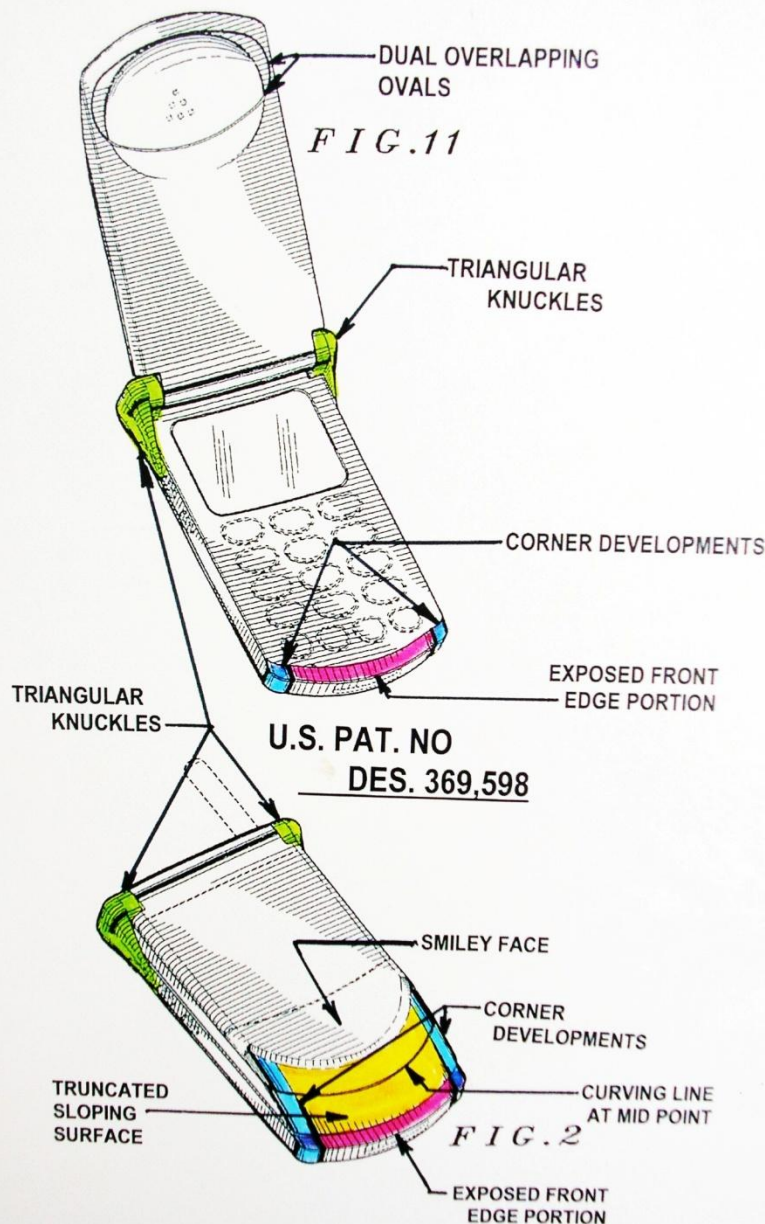
[54] HOUSING FOR A PORTABLE TELEPHONE

[75] Inventors: Albert L. Nagele, Wilmette; Leonid Soren, Lincolnwood; Brian J. Hassemer, Gurnee; James D. Domoleczny, Sr., Lindenhurst, all of Ill.

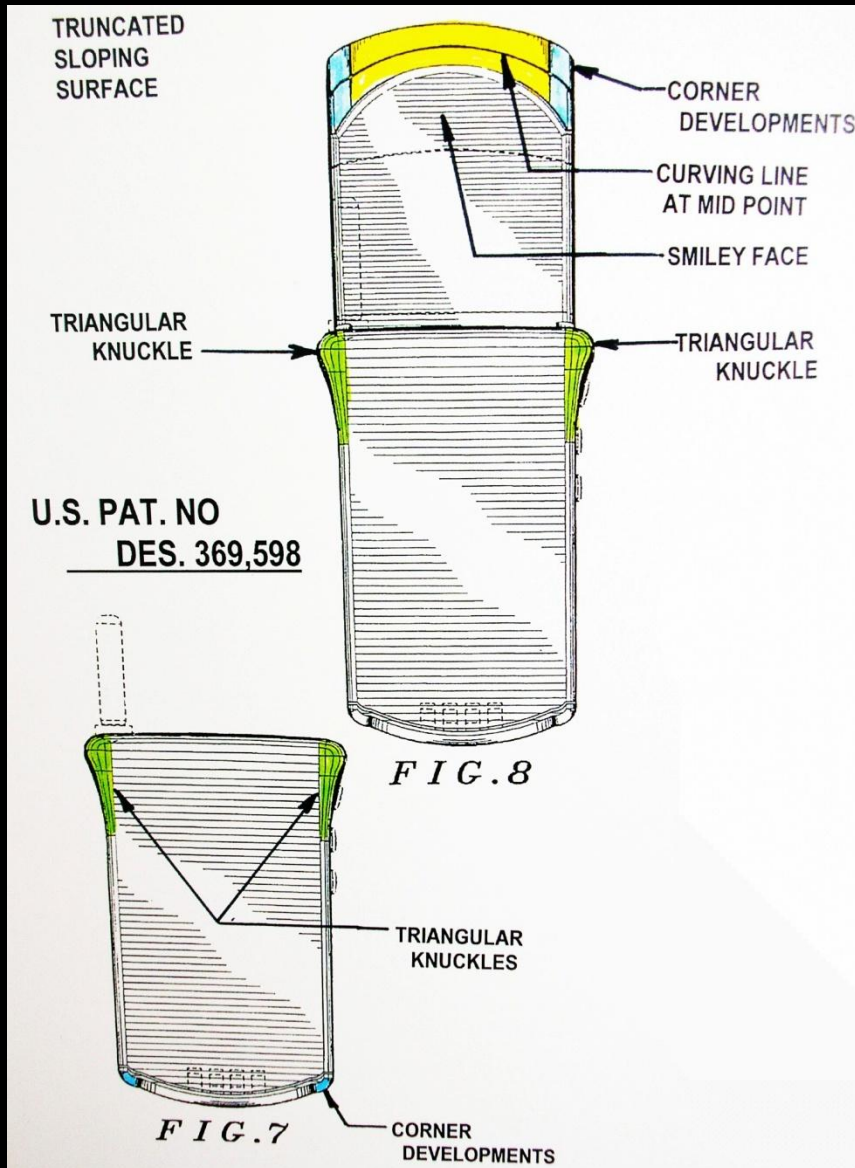
[73] Assignee: Motorola, Schaumburg, Ill.



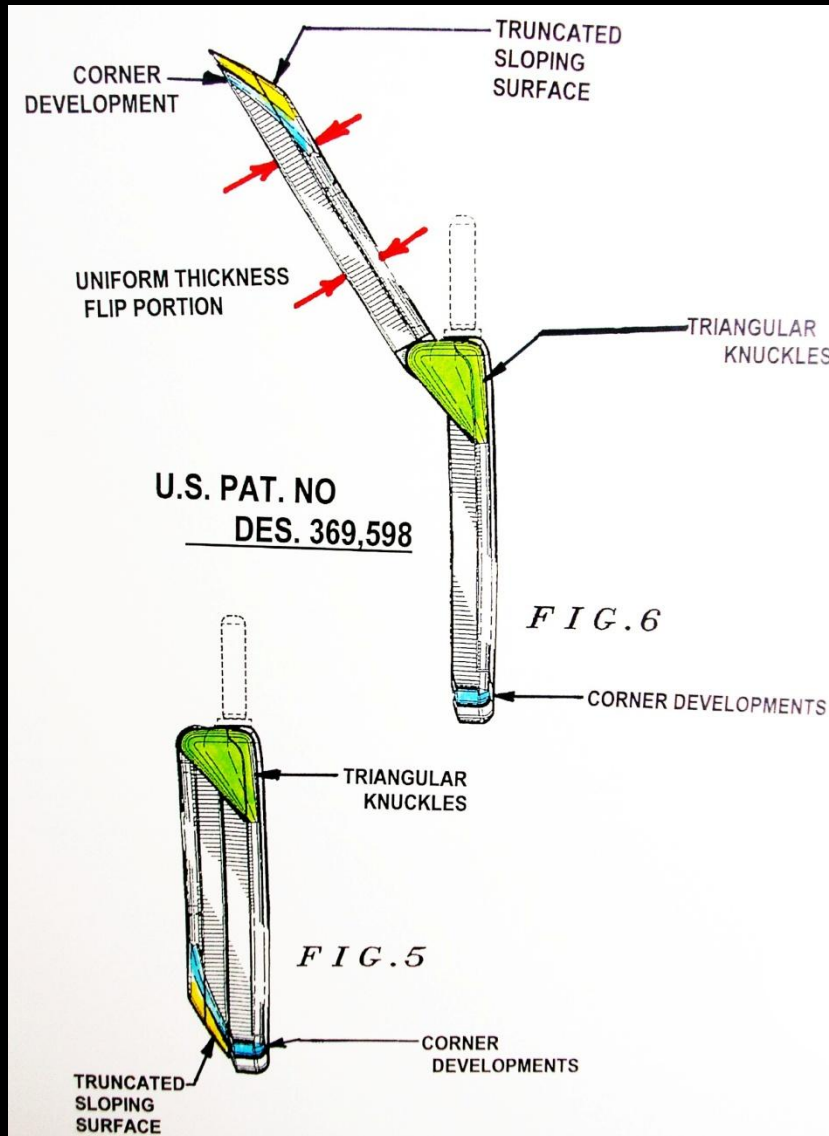
Motorola v. Qualcomm



Motorola v. Qualcomm

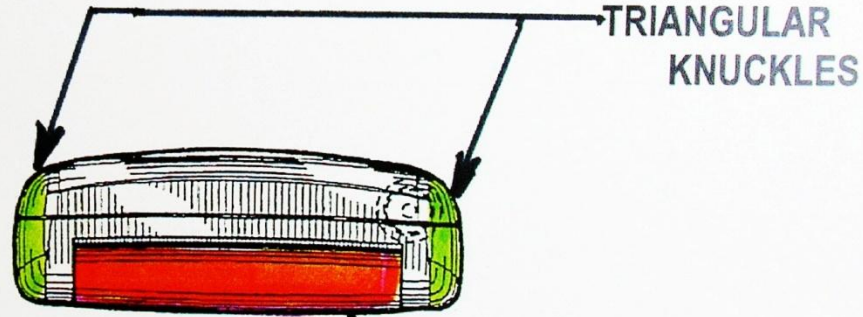


Motorola v. Qualcomm



Motorola v. Qualcomm

U.S. PAT. NO
DES. 369,598

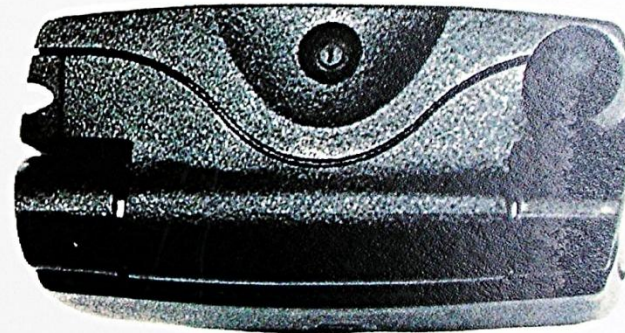


TRIANGULAR
KNUCKLES

FIG. 3

CENTRAL ROTATING
OFFSET HINGE

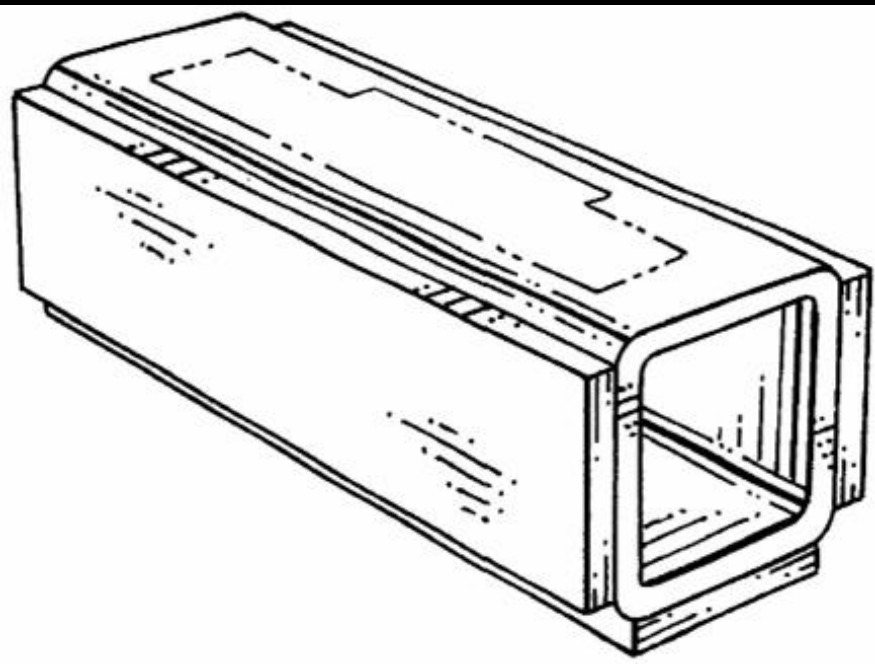
“Q” PHONE





*An Egyptian
Goddess
must, after
all, take care
of her nails...*

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

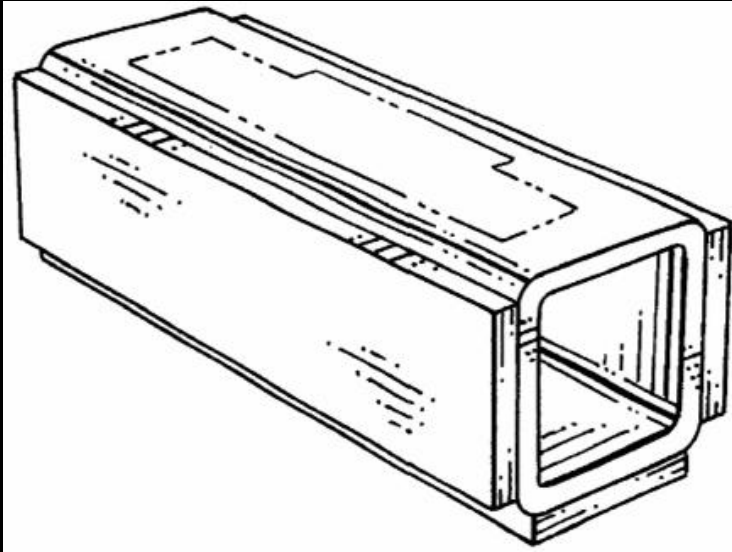


Patented Design



Accused Design

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)



Patented
Design



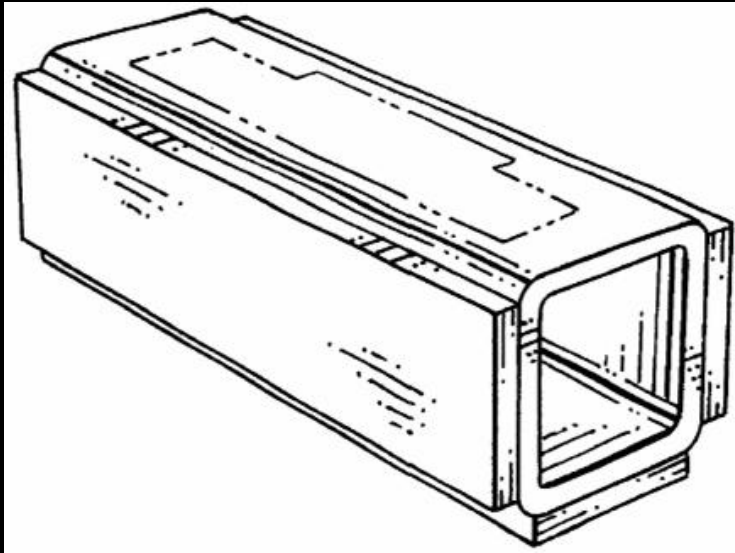
Accused Design



EG's
Closest
Prior
Art =
FALLEY

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

Patented Design



Accused Design

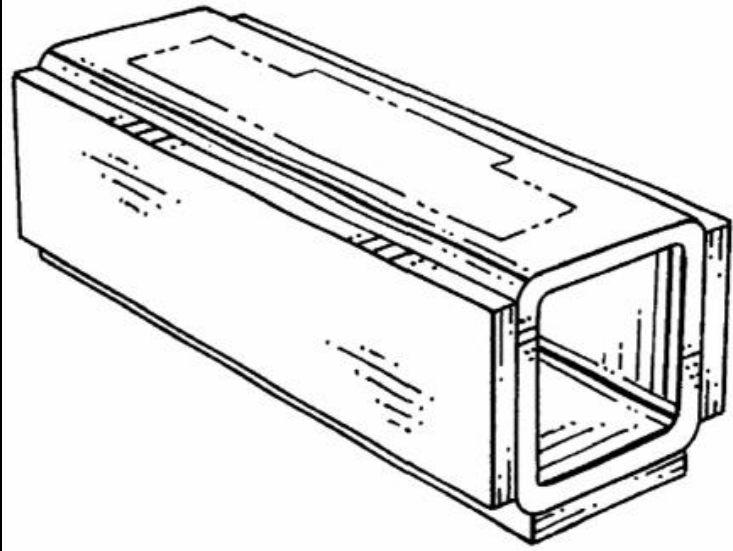


EG Point of Novelty

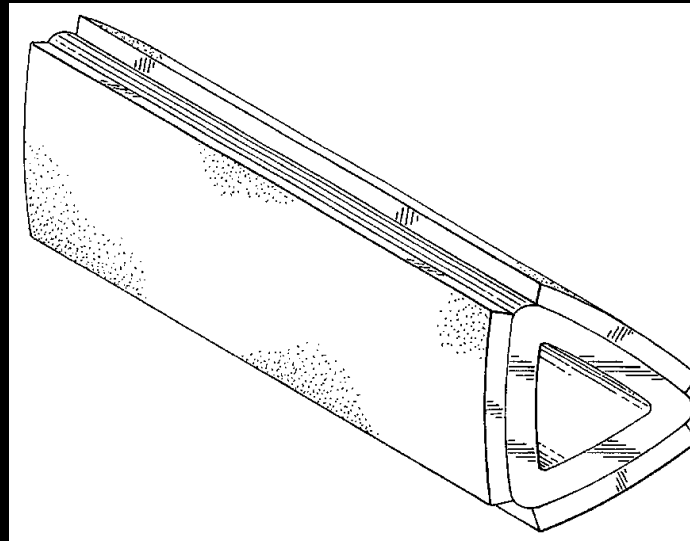
1. OPEN & HOLLOW BODY;
2. SQUARE CROSS-SECTION;
3. RAISED RECTANGULAR PADS; AND
4. EXPOSED CORNERS

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

Patented Design



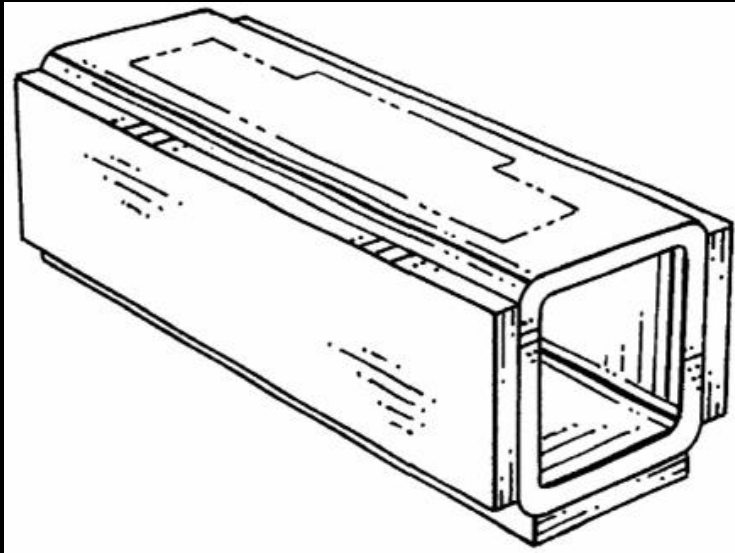
Accused Design



Swisa's
Closest
Prior
Art =
NAILCO

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

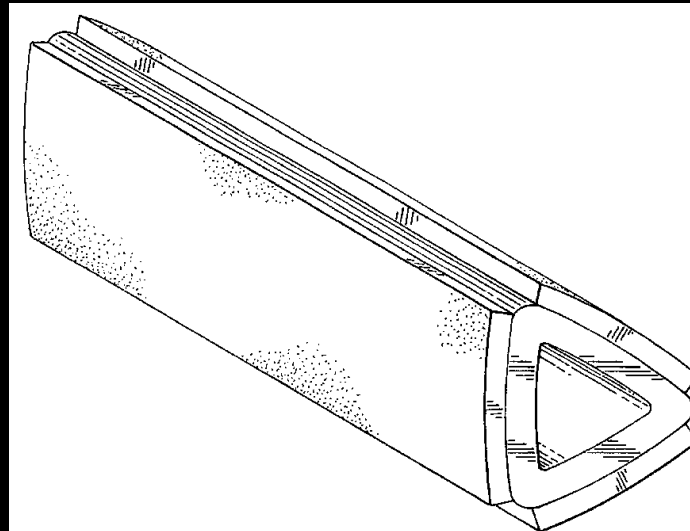
Patented Design



Accused Design



**Swisa: NAILCO
HAS
EVERYTHING
BUT IS
TRIANGULAR
NOT SQUARE**

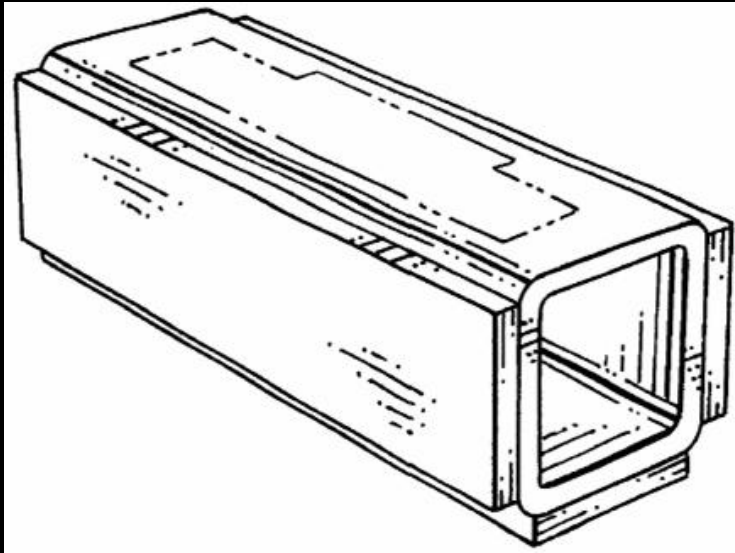


EG Point of Novelty

1. OPEN & HOLLOW BODY;
2. SQUARE CROSS-SECTION;
3. RAISED RECTANGULAR PADS; AND
4. EXPOSED CORNERS

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

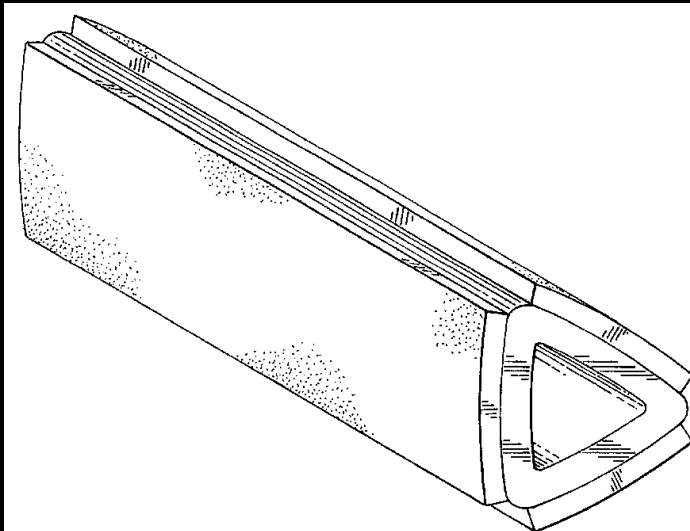
Patented Design



Accused Design

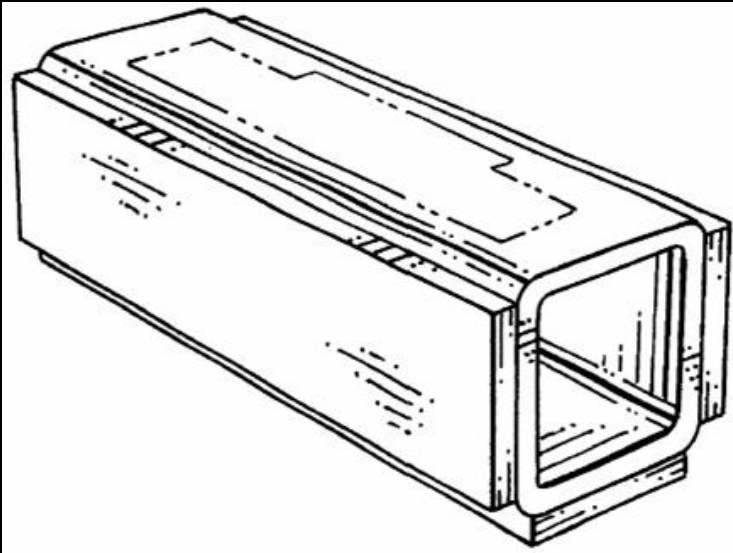


Swisa: *EG*
ADMITS
THAT
SQUARE
NAIL
BUFFERS
ARE OLD



Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

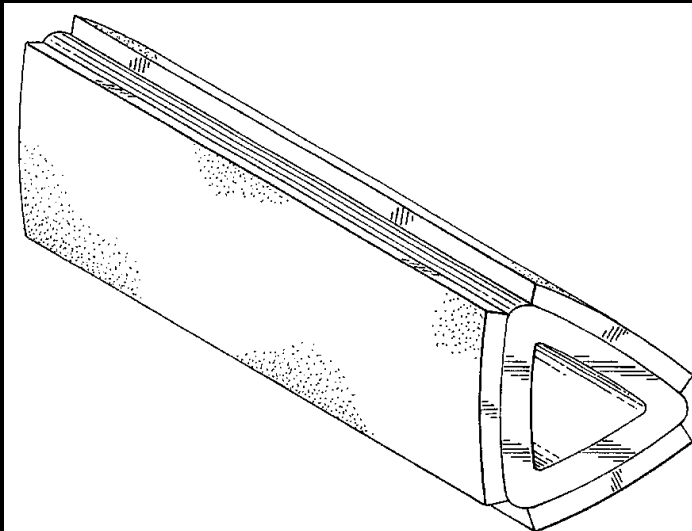
Patented Design



Accused Design

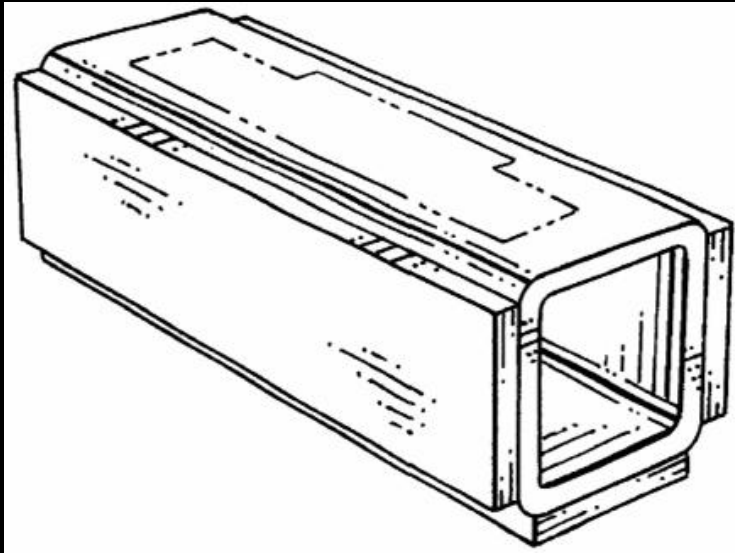


Court:
SQUARE
CROSS-
SECTION
NAIL
BUFFERS
ARE OLD



Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

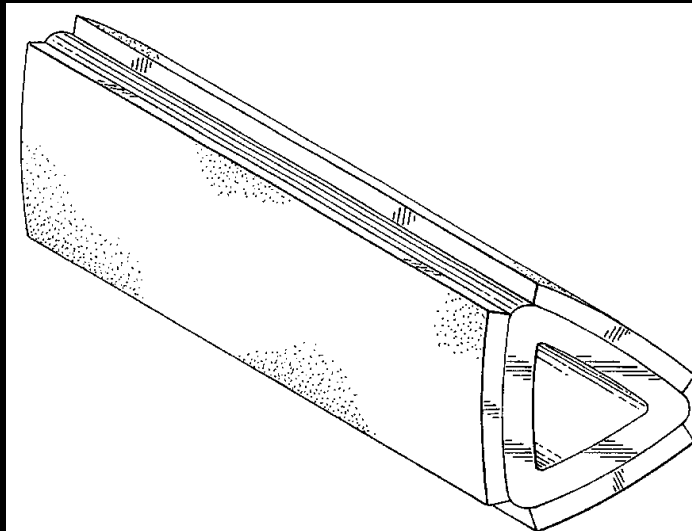
Patented Design



Accused Design

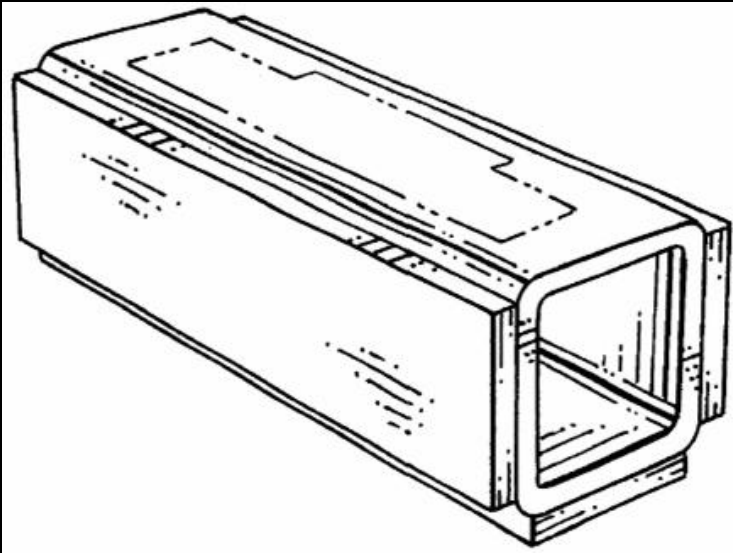


Court:
EG'S POINT
OF
NOVELTY
IS A
TRIVIAL
ADVANCE



Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

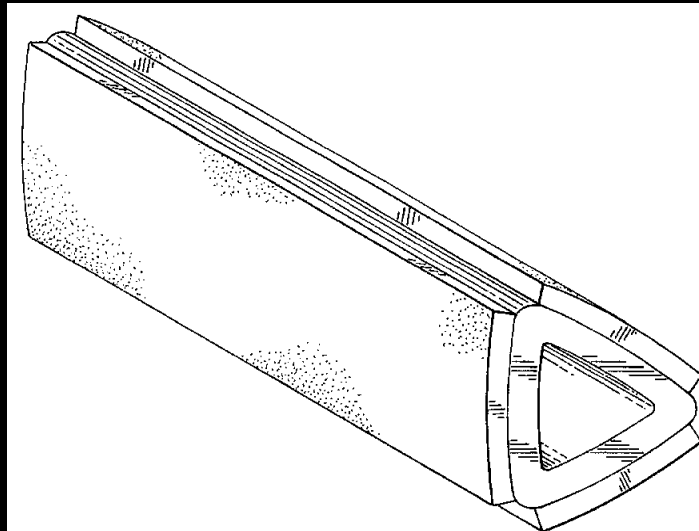
Patented Design



Accused Design

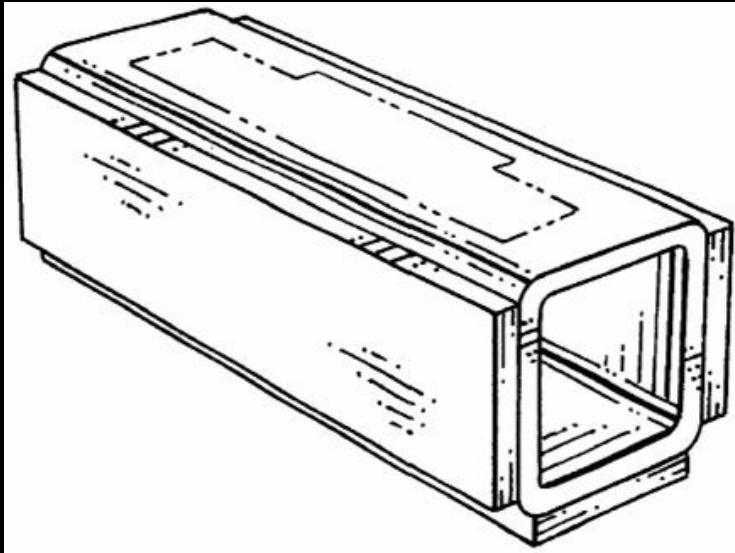


- TRIVIAL
ADVANCE:
1. OPEN,
HOLLOW ;
 2. SQUARE
CROSS-
SECTION;
 3. RAISED
PADS; AND
 4. EXPOSED
CORNERS



Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

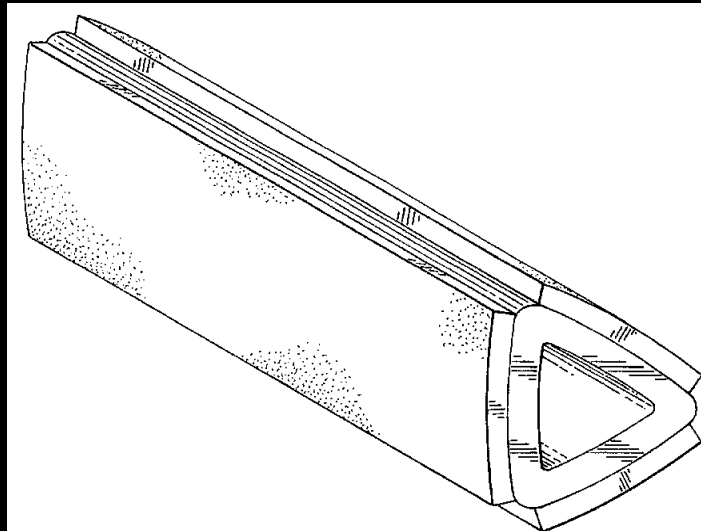
Patented Design



Accused Design

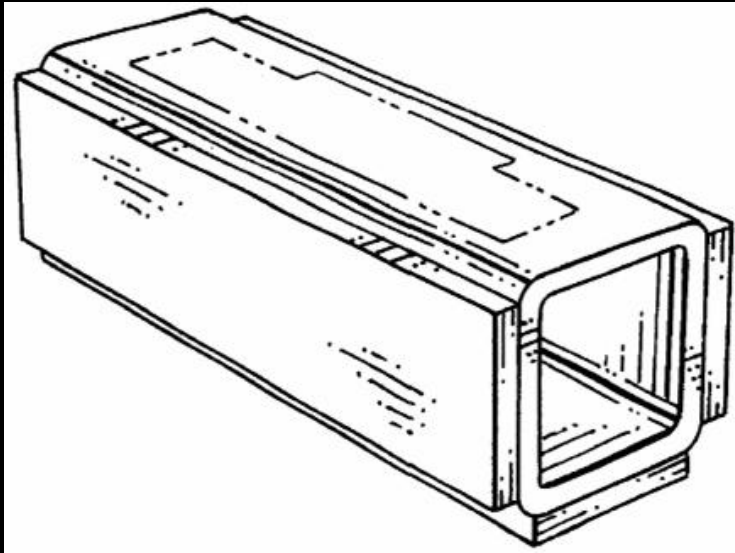


Court: ONLY IF
THE POINT OF
NOVELTY
INCLUDES THE
ABSENCE OF A
PAD ON THE 4TH
SIDE COULD IT
BE NON-
TRIVIAL



Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

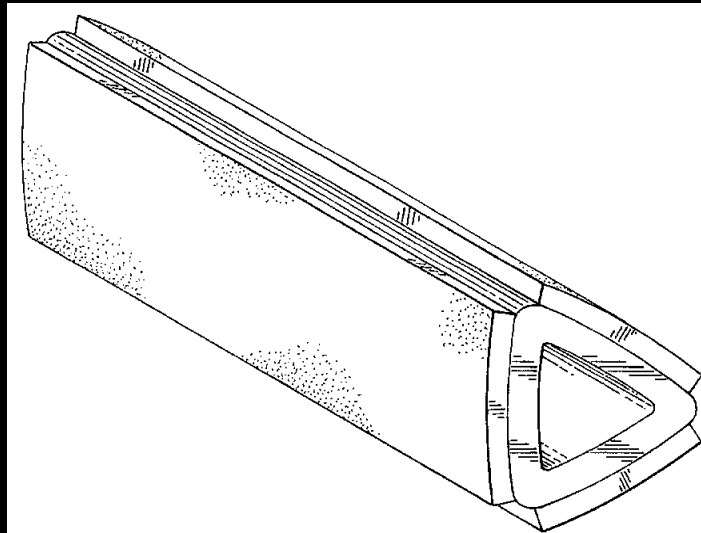
Patented Design



Accused Design

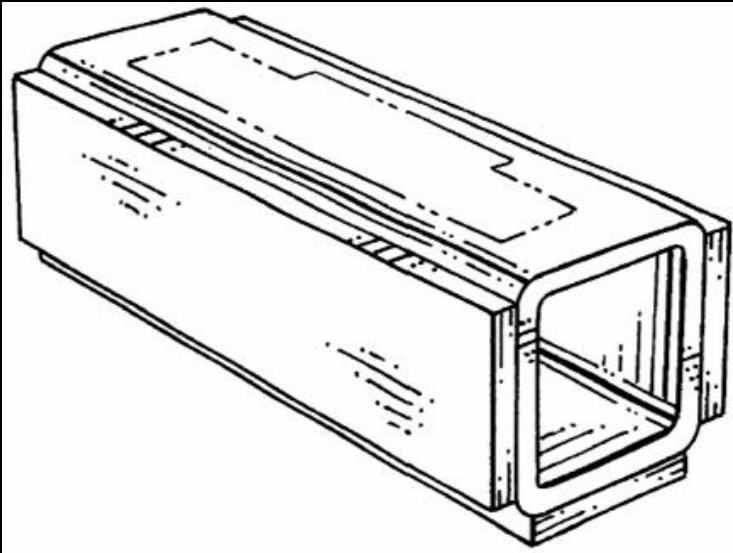


Court: SINCE THE SWISA BUFFER HAS PADS ON ALL 4 SIDES, IT DOES NOT HAVE THE POINT OF NOVELTY; NO INFRINGEMENT.



Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

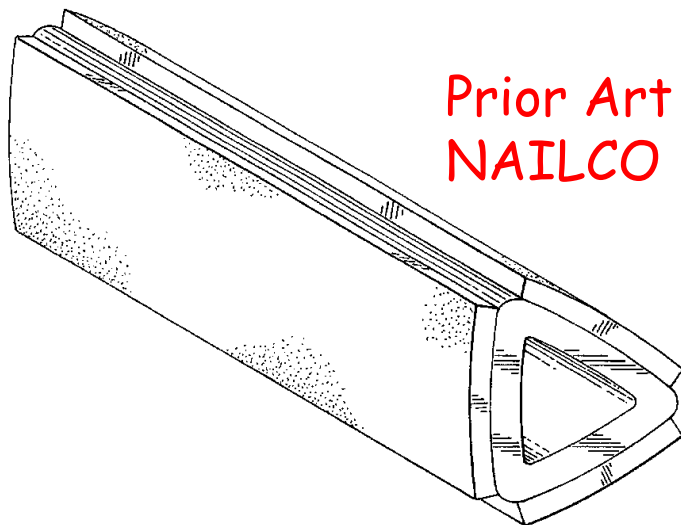
Patented Design



Accused Design



Prior Art
NAILCO



Prior Art
FALLEY



Egyptian Goddess v. Swisa

(EN BANC ORDER Fed. Cir. 11/26/07)

QUESTIONS:

1. SHOULD "POINT OF NOVELTY" BE A TEST FOR DESIGN PATENT INFRINGEMENT?

Egyptian Goddess v. Swisa (EN BANC ORDER Fed. Cir. 11/26/07)

QUESTIONS:

1. SHOULD "POINT OF NOVELTY" BE A TEST FOR DESIGN PATENT INFRINGEMENT?
2. IF SO:
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Egyptian Goddess v. Swisa

(EN BANC ORDER Fed. Cir. 11/26/07)

QUESTIONS:

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 - B. SHOULD IT BE PATENTEE'S BURDEN OR AN AFFIRMATIVE DEFENSE?

Egyptian Goddess v. Swisa (EN BANC ORDER Fed. Cir. 11/26/07)

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2. IF SO:
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 - B. SHOULD IT BE PATENTEE'S BURDEN OR AN AFFIRMATIVE 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?

Egyptian Goddess v. Swisa

(EN BANC ORDER Fed. Cir. 11/26/07)

QUESTIONS:

2. (con't)

D. SHOULD IT BE PERMISSIBLE TO FIND MORE THAN ONE "POINT OF NOVELTY" IN A PATENTED DESIGN;

Egyptian Goddess v. Swisa (EN BANC ORDER Fed. Cir. 11/26/07)

QUESTIONS:

2. (con't)

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?

Egyptian Goddess v. Swisa

(EN BANC ORDER Fed. Cir. 11/26/07)

QUESTIONS:

2. (con't)

D. SHOULD IT BE PERMISSIBLE TO FIND MORE THAN ONE "POINT OF NOVELTY" IN A PATENTED DESIGN; AND

E. SHOULD THE OVERALL APPEARANCE OF A DESIGN BE PERMITTED TO BE A POINT OF NOVELTY?

3. SHOULD CLAIM CONSTRUCTION APPLY TO DESIGN PATENTS, AND, IF SO, WHAT ROLE SHOULD THAT CONSTRUCTION PLAY IN THE INFRINGEMENT ANALYSIS?

Egyptian Goddess v. Swisa (EN BANC ORDER Fed. Cir. 11/26/07)

QUESTIONS:

1. SHOULD "POINT OF NOVELTY" BE A TEST FOR DESIGN PATENT INFRINGEMENT?
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Egyptian Goddess v. Swisa

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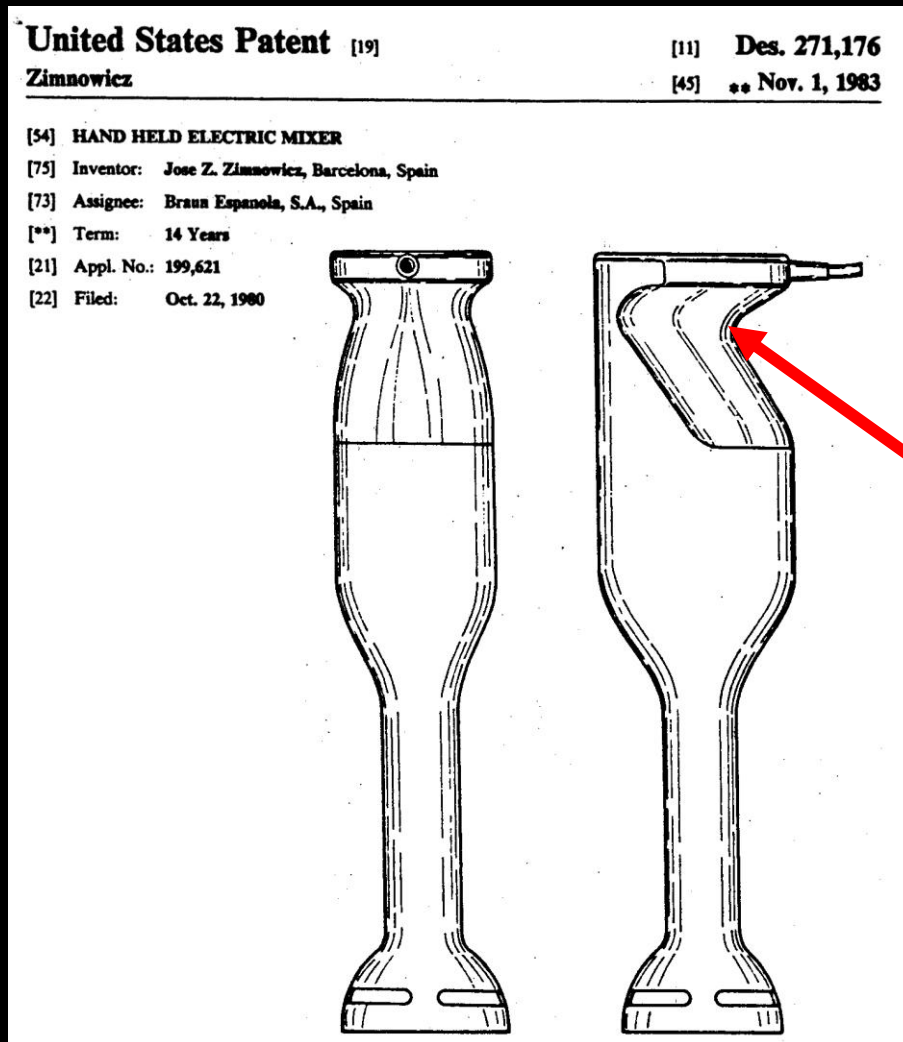
BY FEDERICO



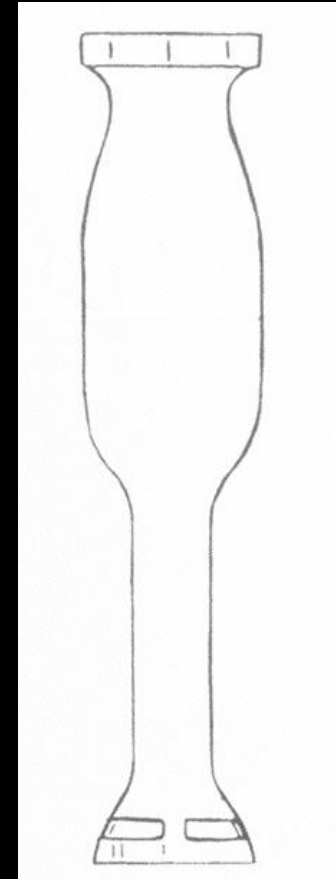
*Did our
Egyptian
Goddess
shed
some
light on
Markman?*

Braun v. Dynamics Corp. of America

(FED. CIR. 1992)

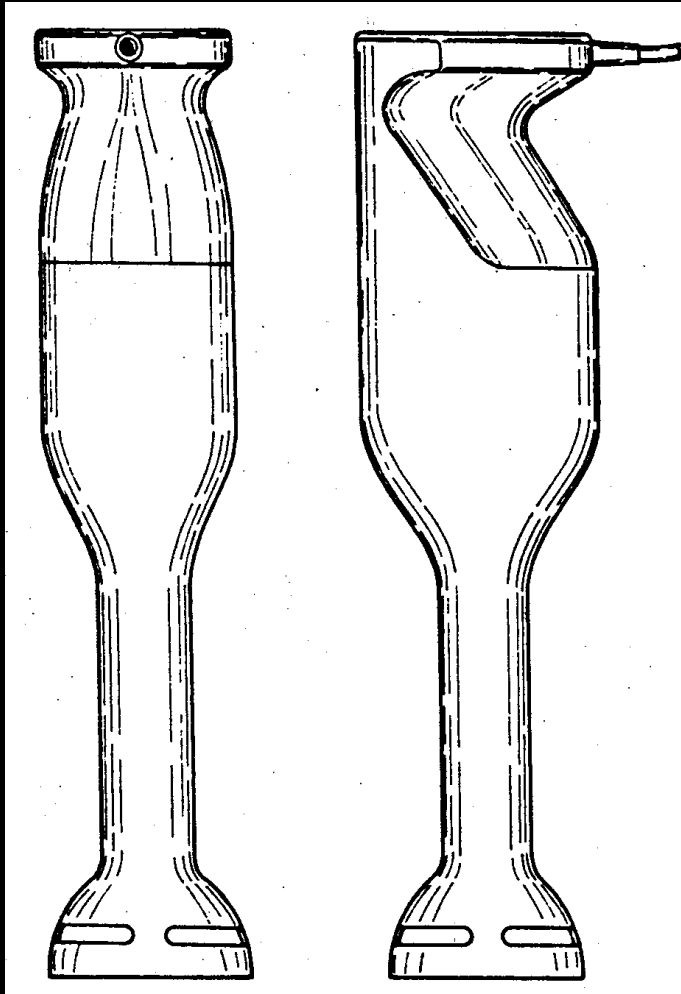


Braun's U.S. Pat. No.
Des. 271,176

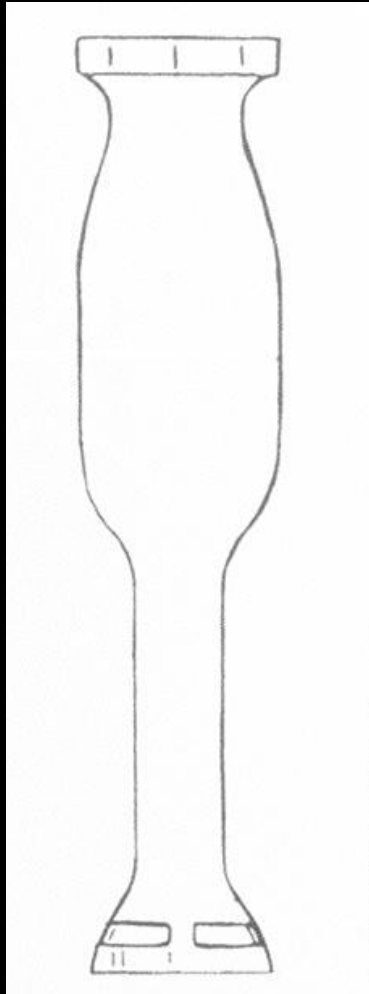


Accused Design

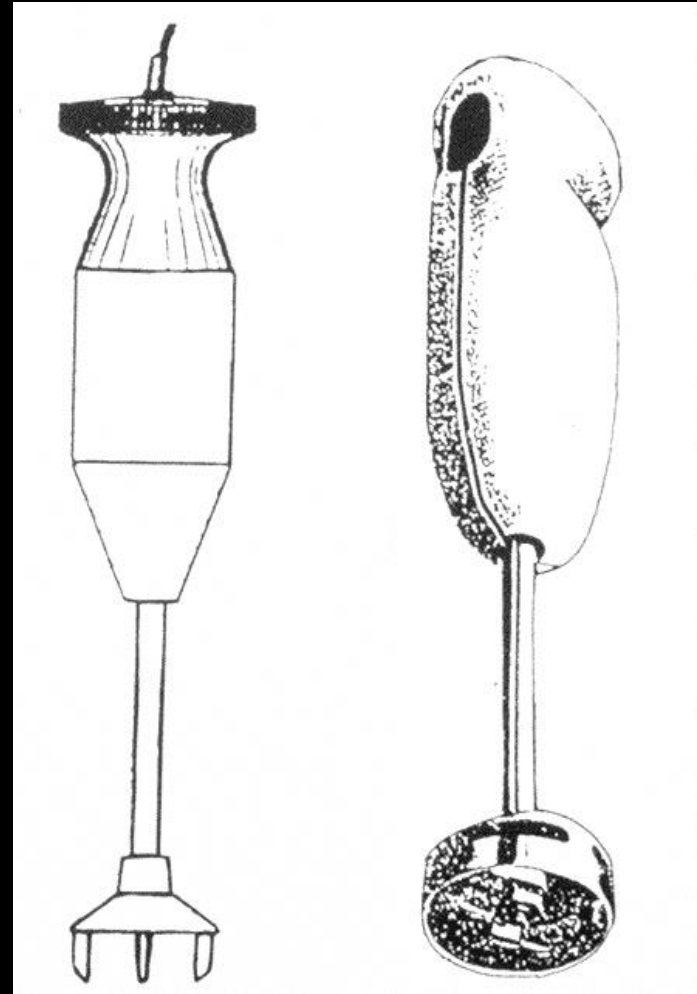
Braun v. Dynamics Corp. of America



Braun's U.S. Pat. No.
Des. 271,176

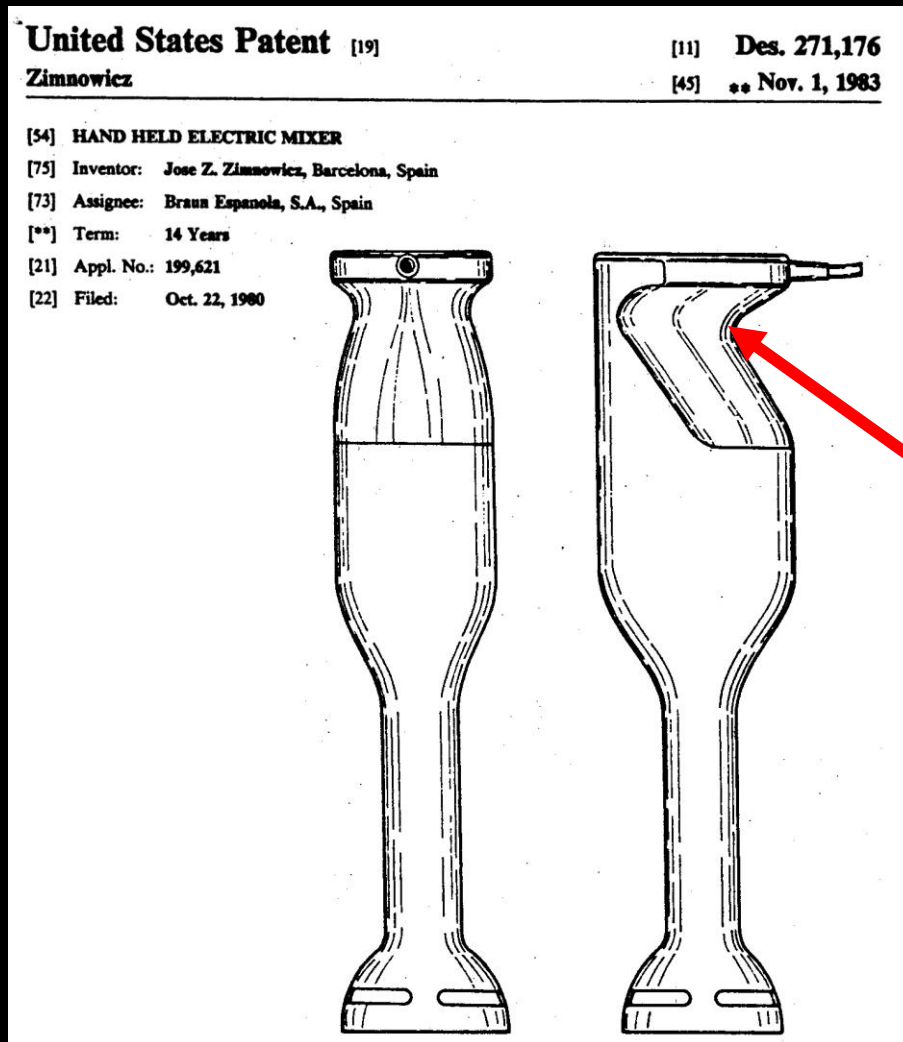


Accused Design

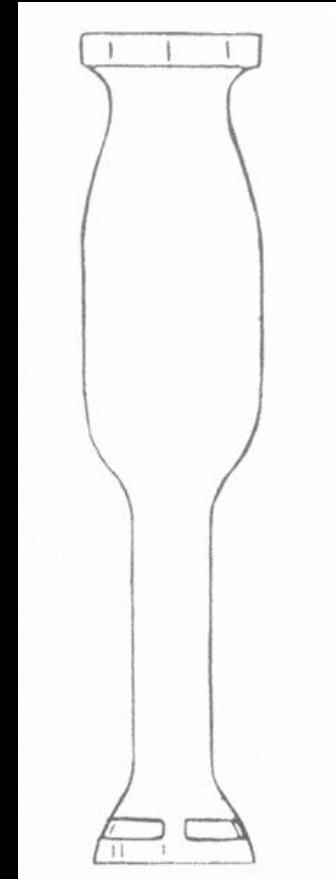


Closest Prior Art

Braun v. Dynamics Corp. of America



**Braun's U.S. Pat. No.
Des. 271,176**



Accused Design

OddzOn Products v. Just Toys

(FED. CIR. 1997)

United States Patent [19]
Stillinger et al.

[11] Patent Number: Des. 346,001

[45] Date of Patent: ** Apr. 12, 1994

[54] TOSSING BALL

[75] Inventors: Scott H. Stillinger, Monte Sereno;
Thomas H. Grimm, Menlo Park;
Christopher S. Page; William A.
Scott, both of Palo Alto, all of Calif.

[73] Assignee: OddzOn Products, Inc., Campbell,
Calif.

[**] Term: 14 Years

[21] Appl. No.: 4,428

[22] Filed: Feb. 4, 1993

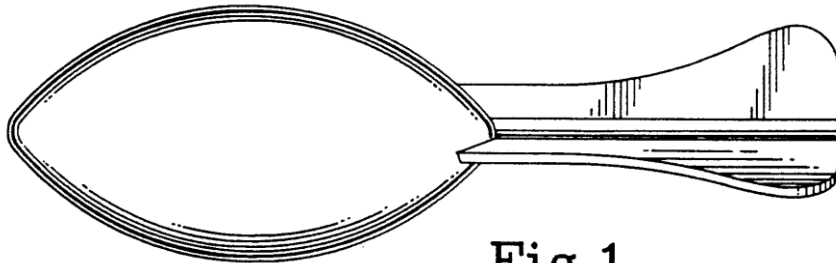
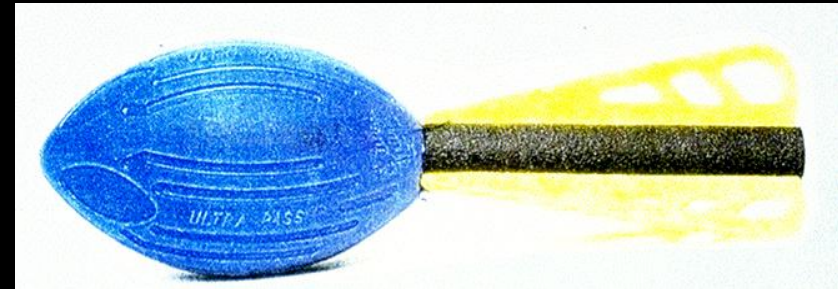
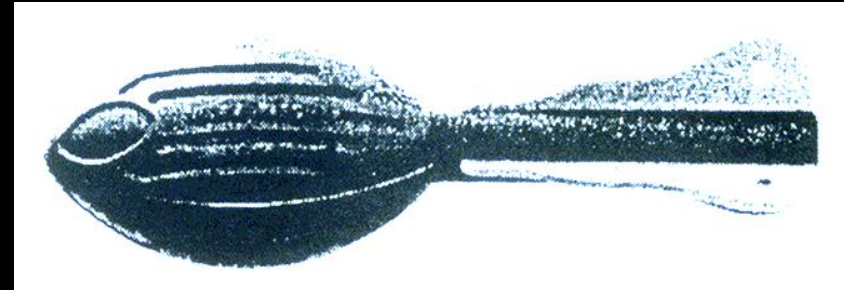


Fig. 1

PATENTED DESIGN



ACCUSED DESIGNS

OddzOn Products v. Just Toys

United States Patent [19]
Stillinger et al.

[11] Patent Number: Des. 346,001

[45] Date of Patent: ** Apr. 12, 1994

[54] TOSSING BALL

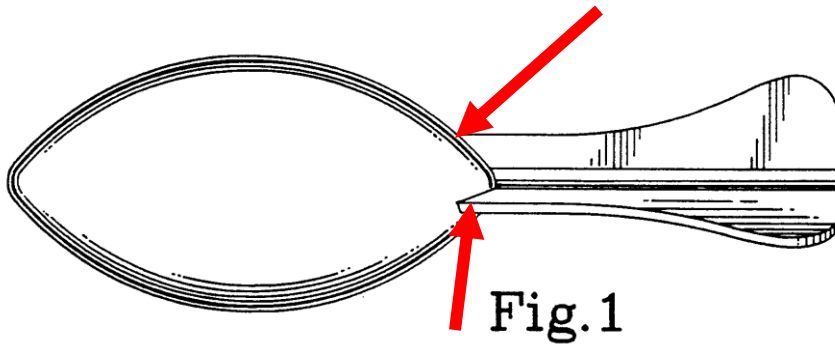
[75] Inventors: Scott H. Stillinger, Monte Sereno;
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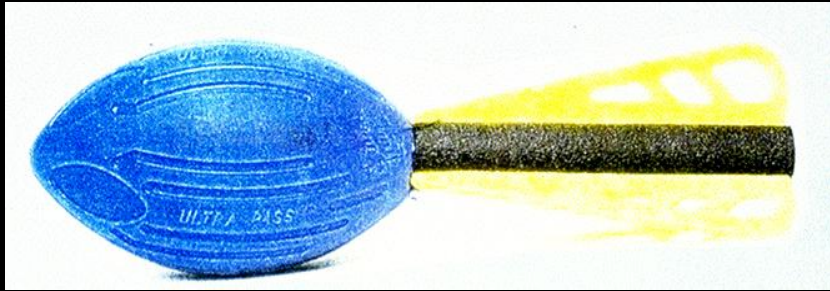
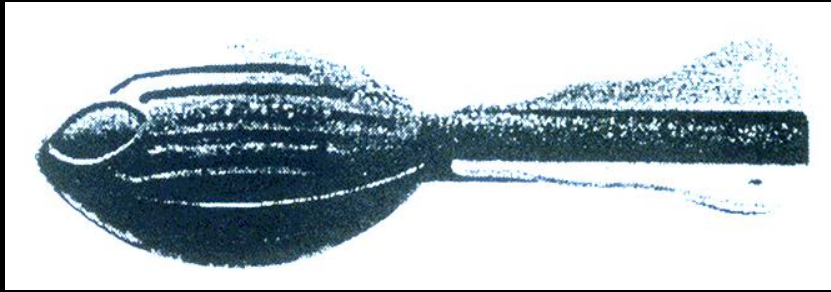
[22] Filed: Feb. 4, 1993



OddzOn's U.S. Pat. No.
Des. 346,001

CLAIM CONSTRUCTION: *a ball shaped like a football, with a slender, straight tailshaft projecting from the rear of the football...three fins symmetrically arranged around the tailshaft, each of which has a gentle curve up and outward which creates a fin with a larger surface area at the end furthest away from the ball. The fins flare outwardly along the entire length of the tailshaft, with the front end of the fin extending slightly up along the side of the football so that the fins seemingly protrude from the inside of the football.*

OddzOn Products v. Just Toys



Just Toys' Accused
Products

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OddzOn Products v. Just Toys

United States Patent [19]
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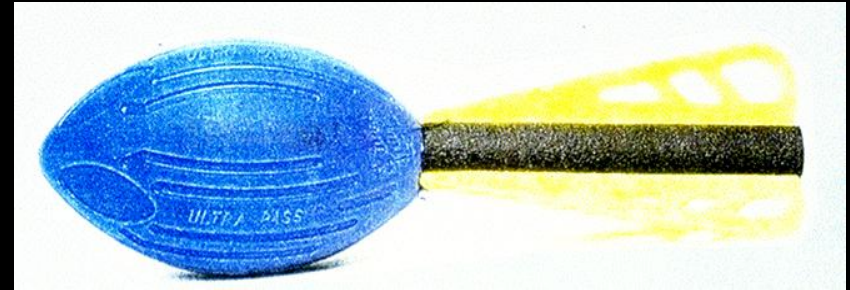
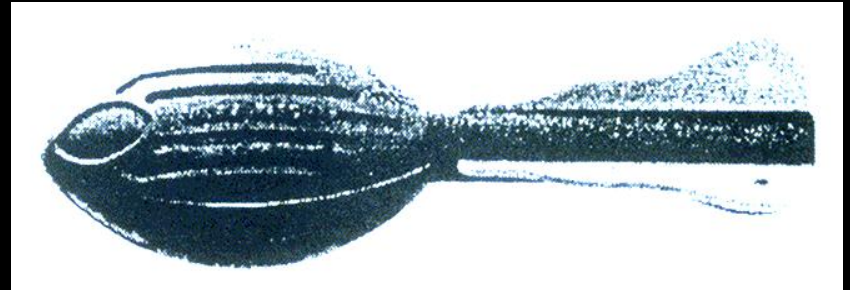
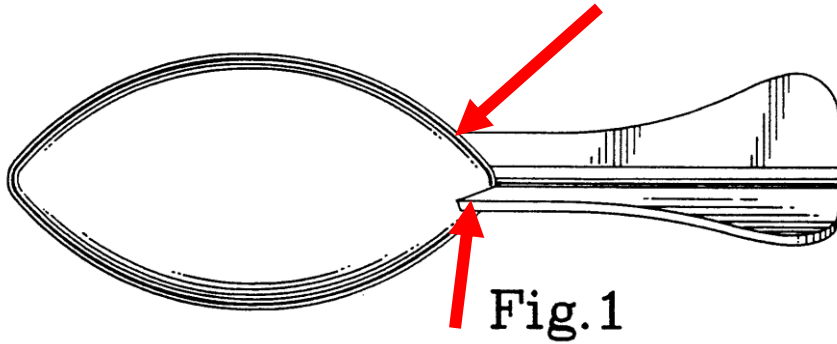
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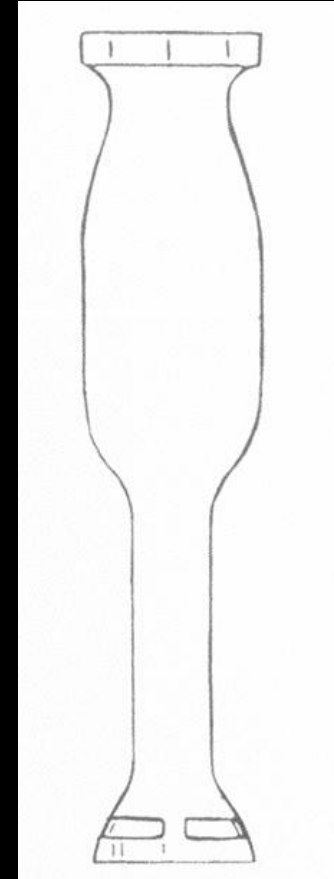
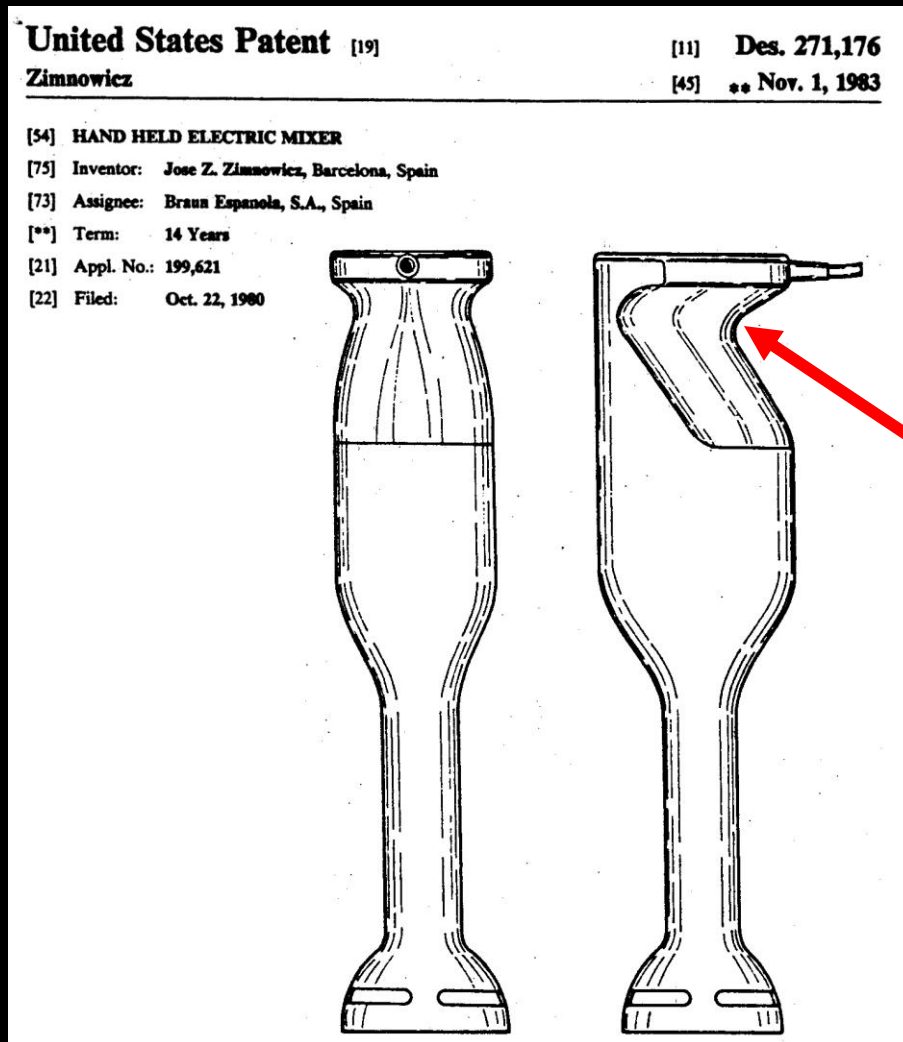
[21] Appl. No.: 4,428

[22] Filed: Feb. 4, 1993



NO INFRINGEMENT (1997)

Braun v. Dynamics Corp. of America



INFRINGEMENT (1992)

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

Given the recognized difficulties entailed in trying to describe a design in words, the *preferable course* ordinarily will be for a district court *not to attempt* to “construe” a design patent claim by providing a detailed verbal description of the claimed design.

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

A trial court can usefully guide
the finder of fact by:

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

A trial court can usefully guide the finder of fact by:

1. Pointing out similarities and differences between patented & claimed designs and the prior art;

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

A trial court can usefully guide the finder of fact by:

1. Pointing out similarities and differences between patented & claimed designs and the prior art;
2. Describing drawing conventions;

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

A trial court can usefully guide the finder of fact by:

1. Pointing out similarities and differences between patented & claimed designs and the prior art;
 2. Describing drawing conventions;
 3. Assessing prosecution history;
- and

Egyptian Goddess v. Swisa

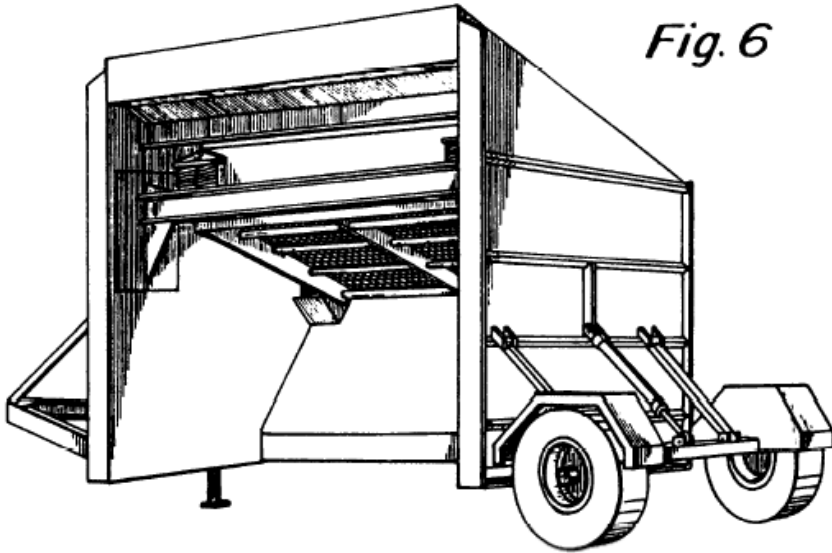
(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

A trial court can usefully guide the finder of fact by:

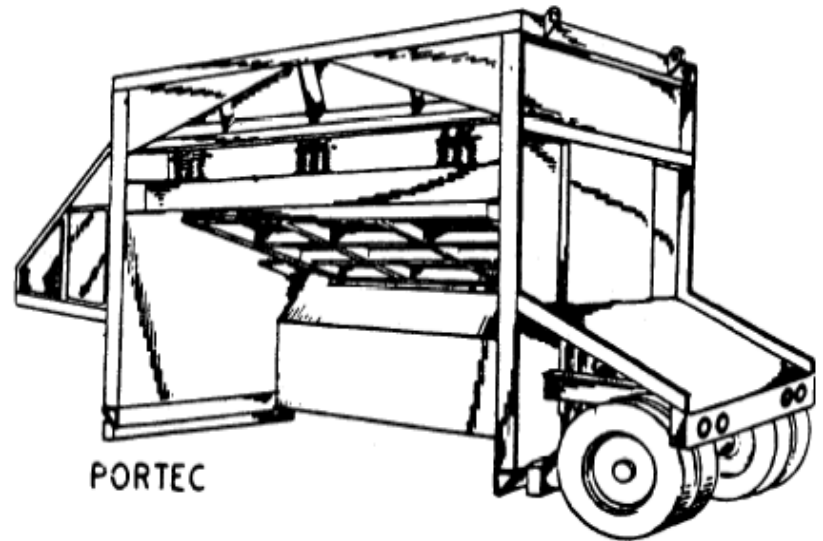
4. Distinguishing between those features of the claimed design that are ornamental and those that are purely functional (citing *OddzOn*).

Read v. Portec (Fed. Cir. 1992)

Fig. 6



Read's U.S. Pat.
No. Des. 263,836

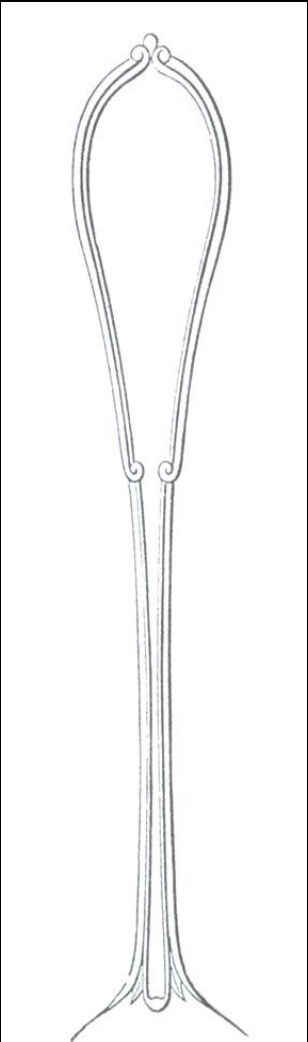


Portec's Accused
Design

Read v. Portec (Fed. Cir. 1992)

In *Gorham* ... there was no preliminary issue respecting what the ornamental features of the design in issue were. The *Gorham* design patent claimed only the scroll work on the handle portion of table flatware... Thus, all elements forming the claimed design were ornamental. *Where this is not the case, that is, 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.*

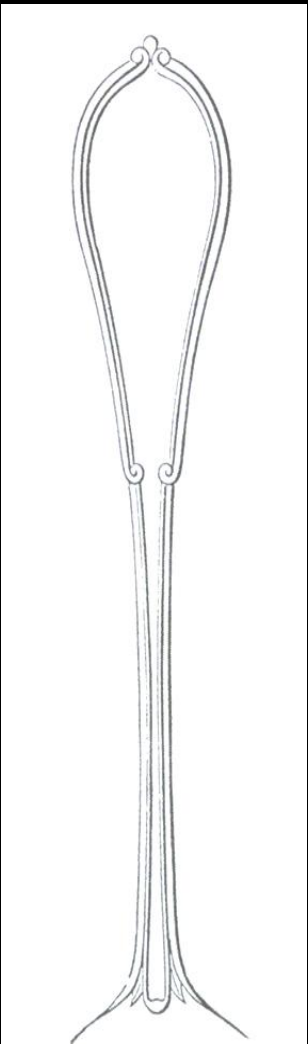
Read v. Portec (Fed. Cir. 1992)



"...there was no preliminary issue respecting what the ornamental features of the design in issue were...."

**PATENTED
DESIGN**

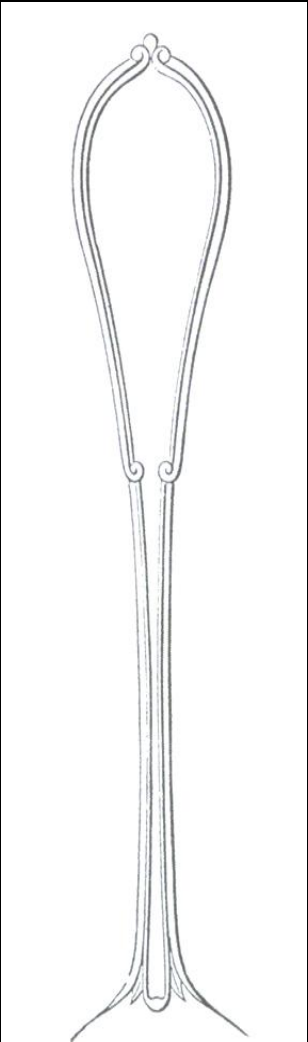
Read v. Portec (Fed. Cir. 1992)



"The Gorham design patent claimed only the scroll work on the handle portion of table flatware.... Thus, all elements forming the claimed design were ornamental."

**PATENTED
DESIGN**

Read v. Portec (Fed. Cir. 1992)



**PATENTED
DESIGN**

PURELY ORNAMENTAL?

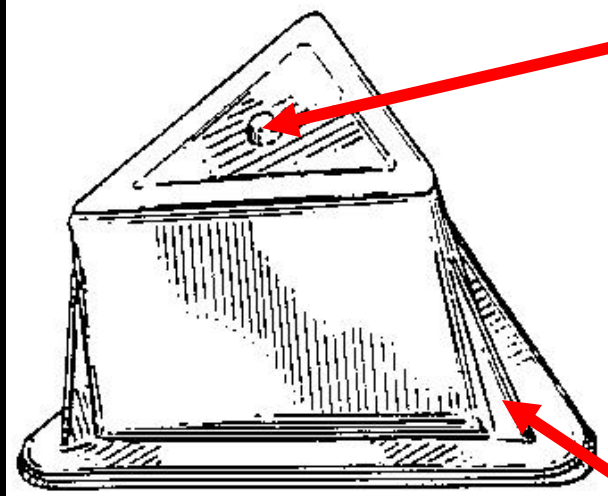
NO!

***A HANDLE FUNCTIONS
TO ENABLE A USER TO
HOLD THE
SILVERWARE***

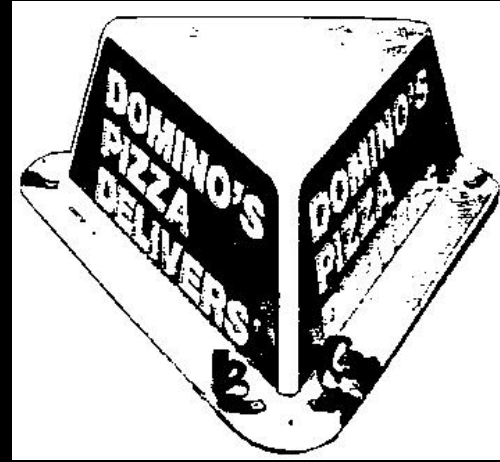
FUNDAMENTAL

ALL DESIGNS CONSIST OF FUNCTIONAL FEATURES. ALL FUNCTIONAL FEATURES ARE THEMSELVES ORNAMENTAL, UNLESS THERE IS NO OTHER WAY TO DESIGN THEM SO THAT THEY WORK FOR THEIR INTENDED FUNCTION.

Elmer v. ICC (Fed. Cir. 1995)

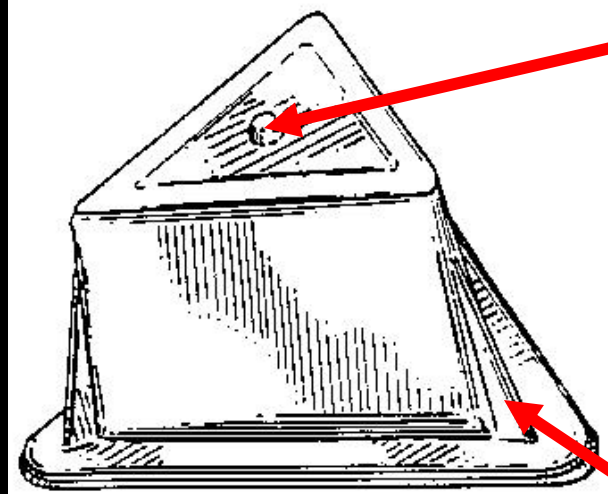


**Elmer's PATENTED
DESIGN**

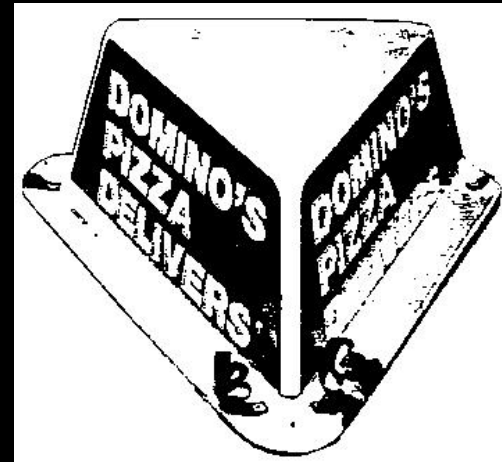


ACCUSED DESIGN

Elmer v. ICC (Fed. Cir. 1995)



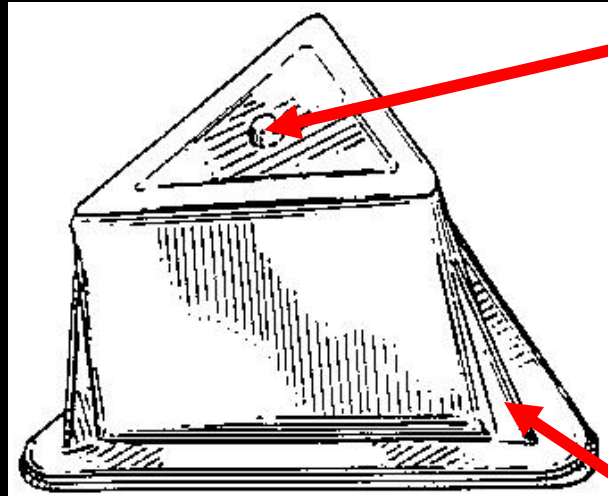
Elmer's PATENTED
DESIGN



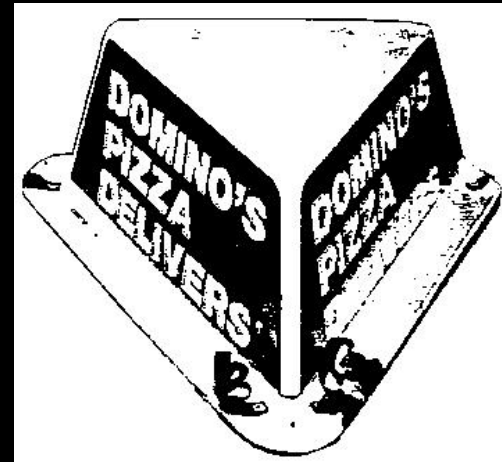
ACCUSED DESIGN

ELMER: *My fins and protrusion are functional, so do not include them in the infringement analysis.*

Elmer v. ICC (Fed. Cir. 1995)



Elmer's PATENTED
DESIGN



ACCUSED DESIGN

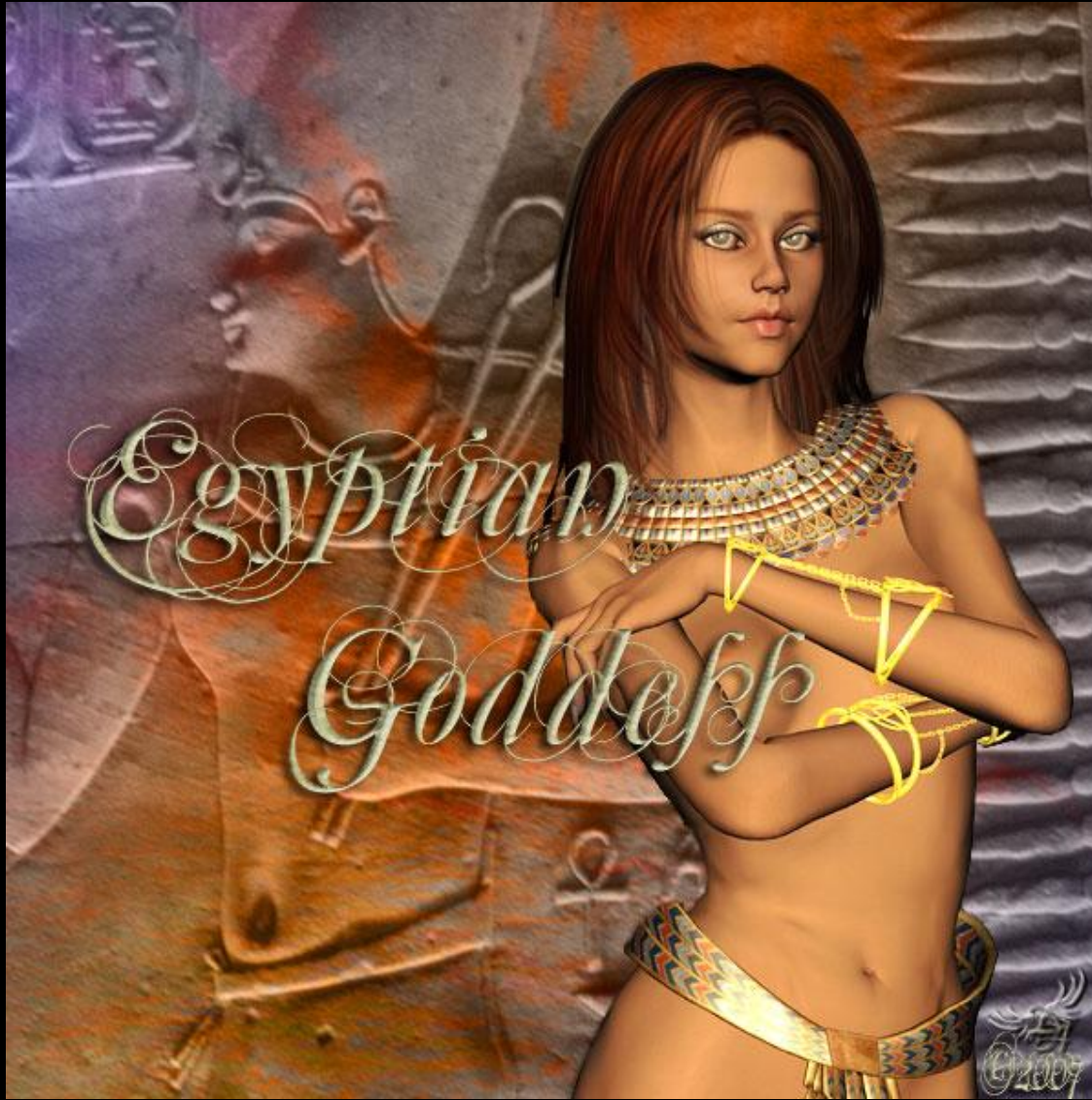
COURT: *Yes, the fins and protrusion perform a function, but since you showed them in solid lines in your drawings, they are included as part of the claimed design.*

FUNCTIONALITY IN PERSPECTIVE:

FUNCTIONALITY IS AN
INVALIDITY DEFENSE, NOT
SOMETHING THE ABSENCE OF
WHICH MUST BE PROVEN BY THE
PATENTEE IN ITS CASE IN CHIEF
IN ORDER TO ESTABLISH
INFRINGEMENT.

CONCLUSION:

You DO NOT need *Markman* to define the ornamental and functional elements before applying the *Gorham* test... because the overall claimed design is ornamental.



**BYE
BYE
Point of
Novelty
Test**



***SADDLE
UP!***

Smith v. Whitman Saddle (1893)

UNITED STATES PATENT OFFICE.

DESIGN.

R. E. WHITMAN.

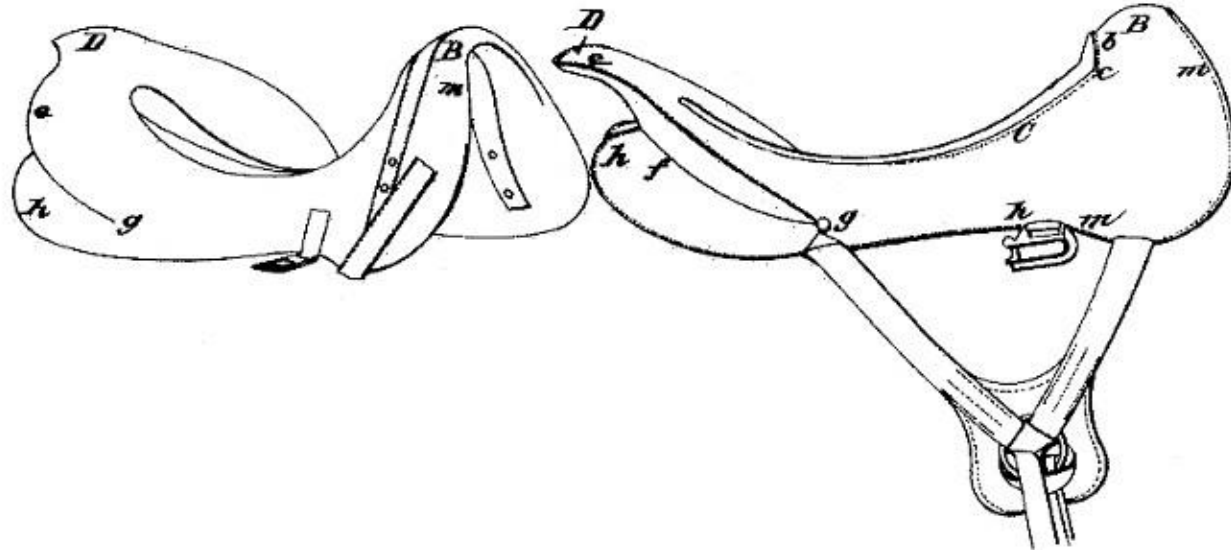
Saddle.

No. 10,844.

Patented Sept. 24, 1878.

Fig. 2.

Fig. 1.



U.S. Pat. No. D10,844

Smith v. Whitman Saddle (1893)

UNITED STATES PATENT OFFICE.

DESIGN.

R. E. WHITMAN.

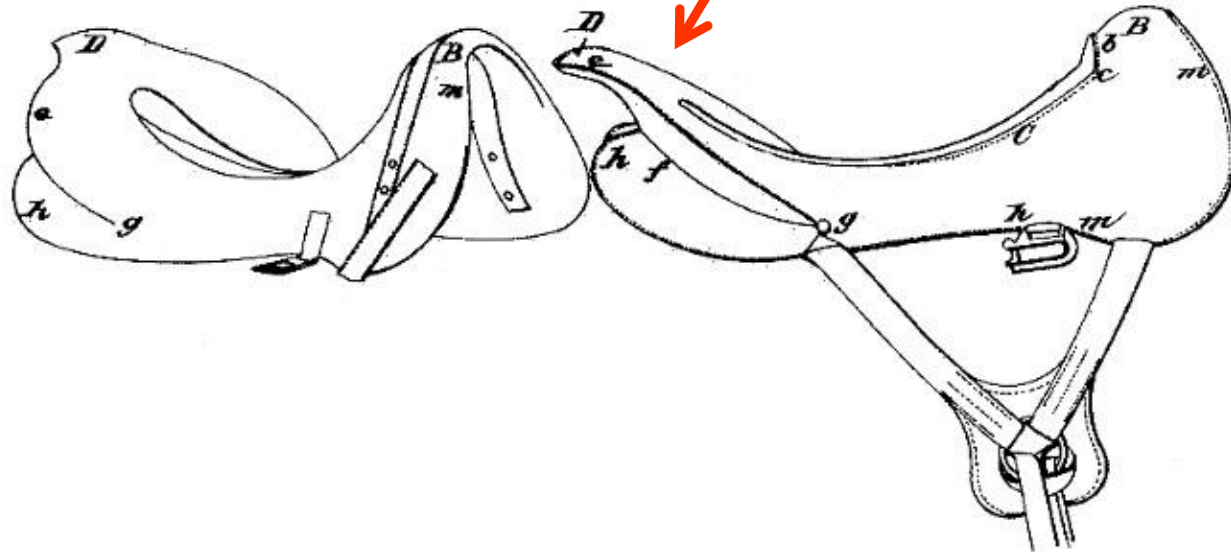
Saddle.

No. 10,844.

Patented Sept. 24, 1878.

Fig. 2.

Fig. 1.



U.S. Pat. No. D10,844

Smith v. Whitman Saddle (1893)

UNITED STATES PATENT OFFICE.

DESIGN.

R. E. WHITMAN.

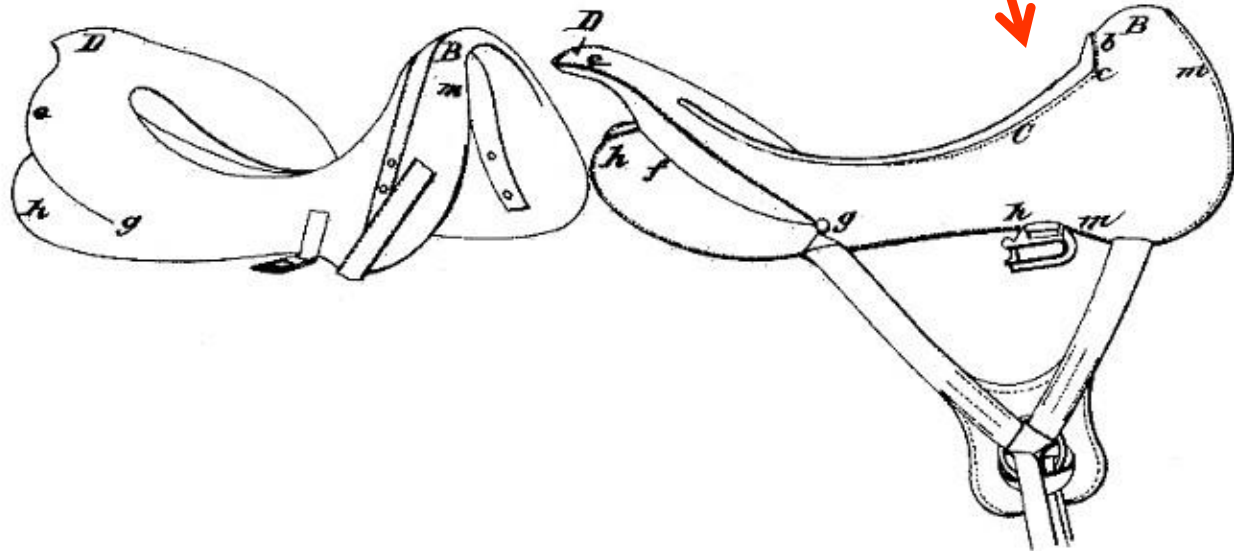
Saddle.

No. 10,844.

Patented Sept. 24, 1878.

Fig. 2.

Fig. 1.



U.S. Pat. No. D10,844

Smith v. Whitman Saddle (1893)

UNITED STATES PATENT OFFICE.

DESIGN.

R. E. WHITMAN.

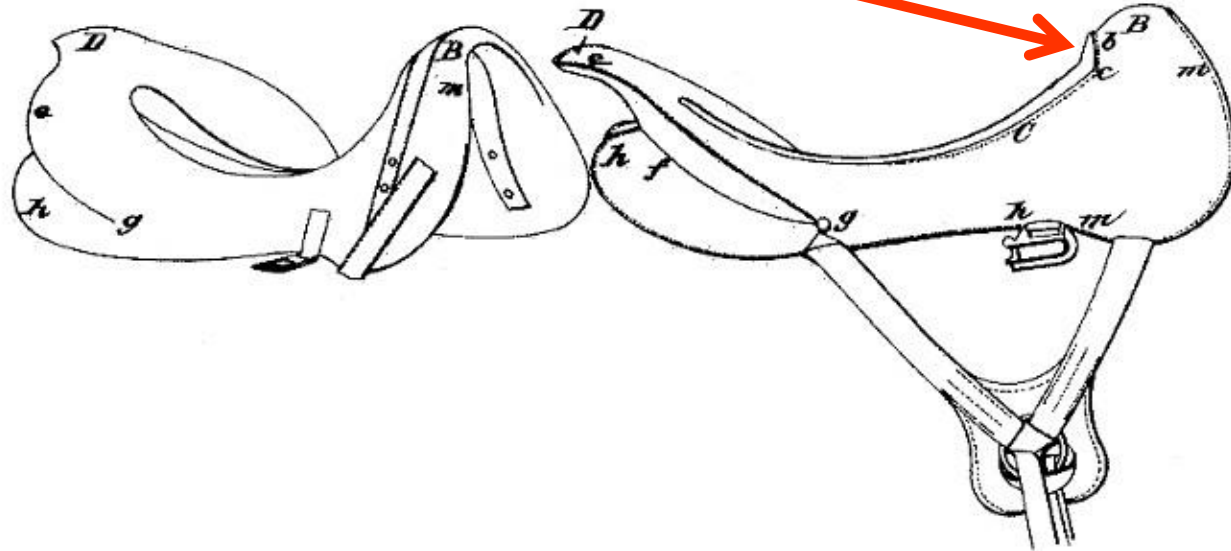
Saddle.

No. 10,844.

Patented Sept. 24, 1878.

Fig. 2.

Fig. 1.



U.S. Pat. No. D10,844

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

Whitman Analysis: [V]iewed in light of similarities between the prior art and the patented design, the accused design did not contain the single feature that would have made it appear distinctively similar to the patented design rather than like the numerous prior art designs.

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

HELD: [T]he point of novelty test should no longer be used in the analysis of a claim of design patent infringement.

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

HELD: [T]he point of novelty test should no longer be used in the analysis of a claim of design patent infringement.

[T]he “ordinary observer” test should be the sole test for determining whether a design patent has been infringed.

Gorham v. White (1871)

ORDINARY OBSERVER TEST:

*...if, in the eye of an ordinary observer...
two designs are substantially the
same...[then] the ... one patented is
infringed by the other.*

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

NEW LAW: [t]he ordinary observer is deemed to view the differences between the patented design and the accused product *in the context of the prior art.*

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

If the accused infringer elects to rely on the comparison prior art as part of its defense against the claim of infringement, the burden of production of that prior art is on the accused infringer."...but the ultimate burden of proof to demonstrate infringement falls on the patentee.

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #1:

1. When the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #1 and #2:

1. When the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.
2. If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing.

The 3-Way Visual Test

The 3-Way Visual Test

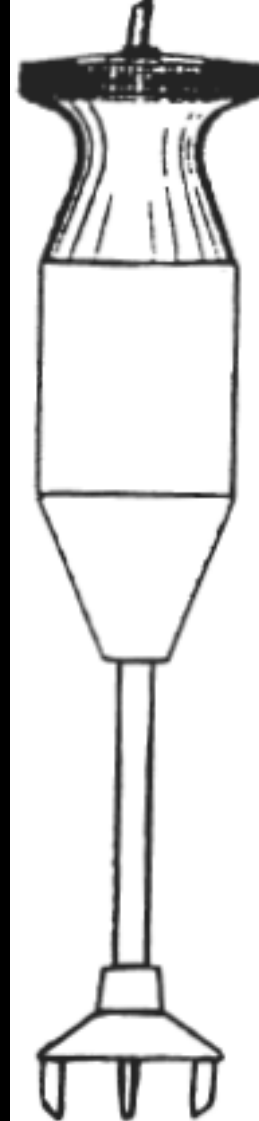
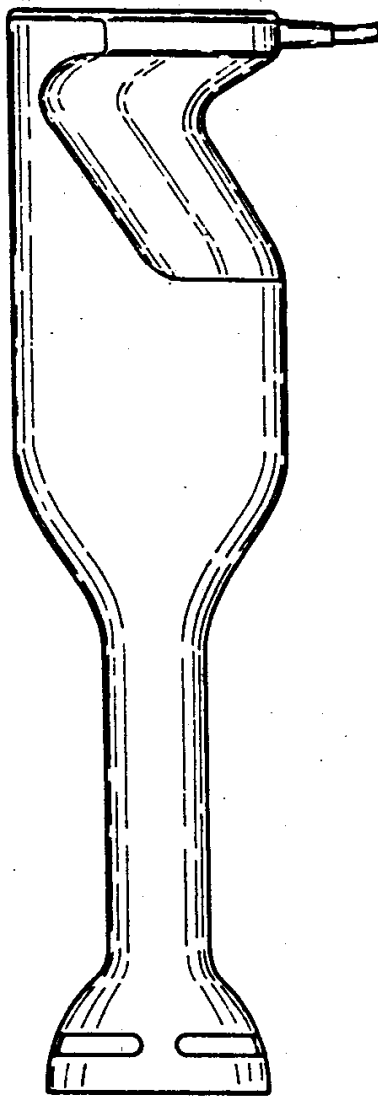
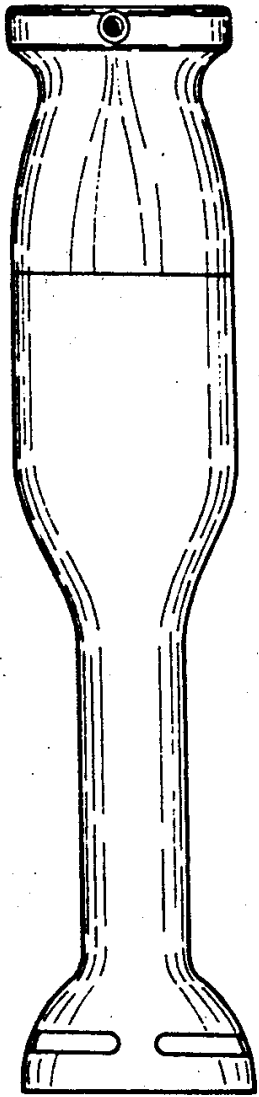
1. If claimed or accused design is closer to prior art than to each other = no likely infringement.

The 3-Way Visual Test

1. If claimed or accused design is closer to prior art than to each other = no likely infringement.
2. If claimed and accused designs are closer to each other than to prior art = infringement is more likely.

Braun v. Dynamics Corp.

(Fed. Cir. 1992)



Patented Design

Accused Design

Prior Art

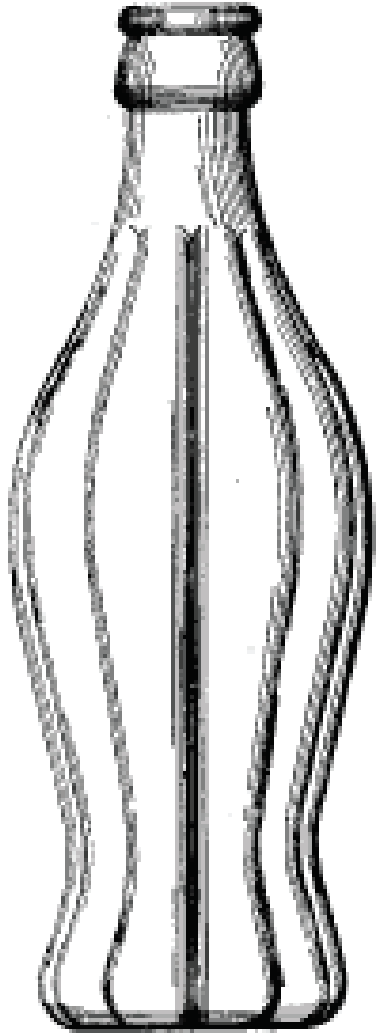
Braun v. Dynamics Corp.

Court:

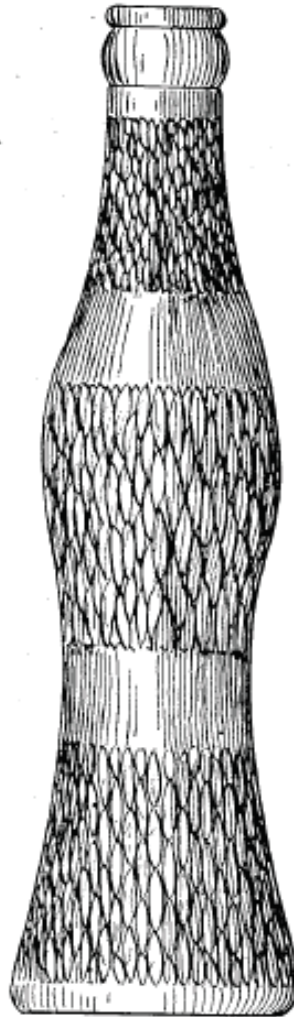
In contrast to [the prior art blenders], which had a utilitarian, mechanical appearance, both [defendant's] blender and Braun's blender share a fluid, ornamental, aerodynamic overall design.

Coca-Cola v. Whistle Co.

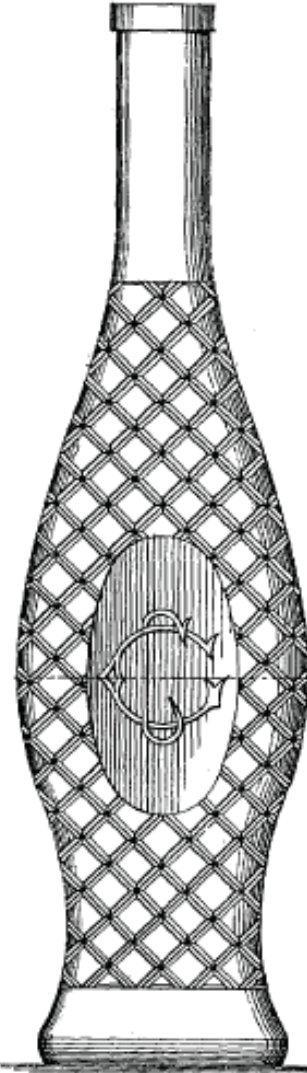
(D. Del. 1927)



Patented Design



Accused Design



Prior Art



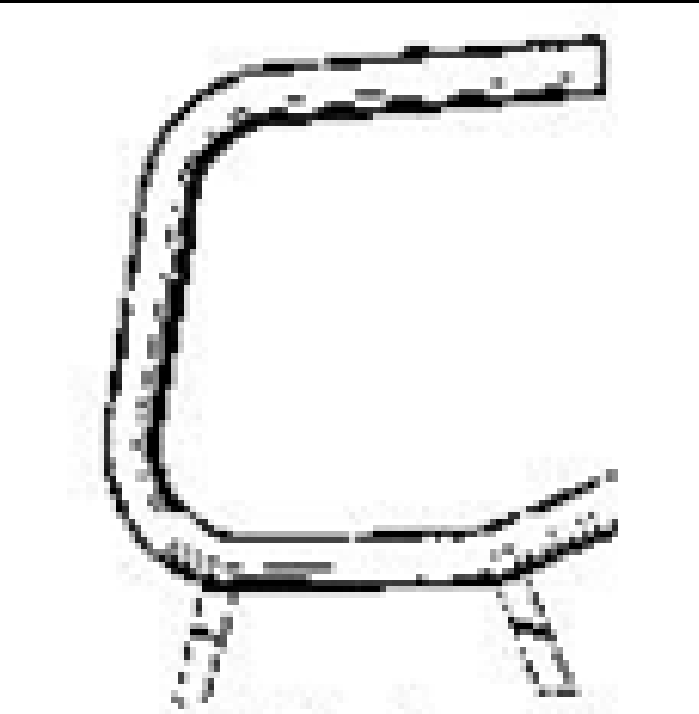
Coca-Cola v. Whistle Co

Court:

Save for such similarity as results from the common use of the prior art ogee curve, the most casual observer would find no difficulty in distinguishing [the patented] bottle from the [accused bottle].

Bergstrom v. Sears

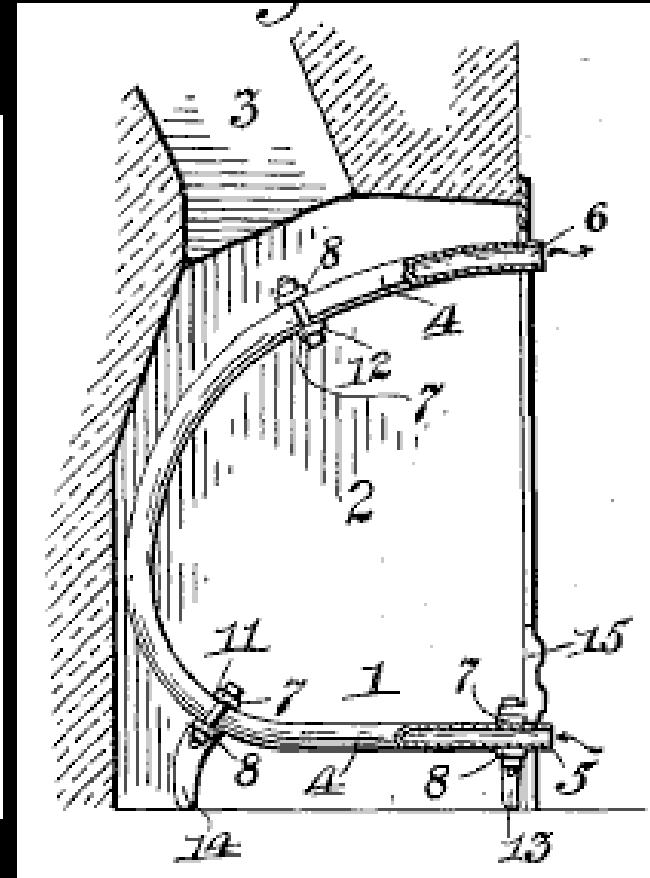
(D. Minn. 1980)



Patented Design



Accused Design



Prior Art

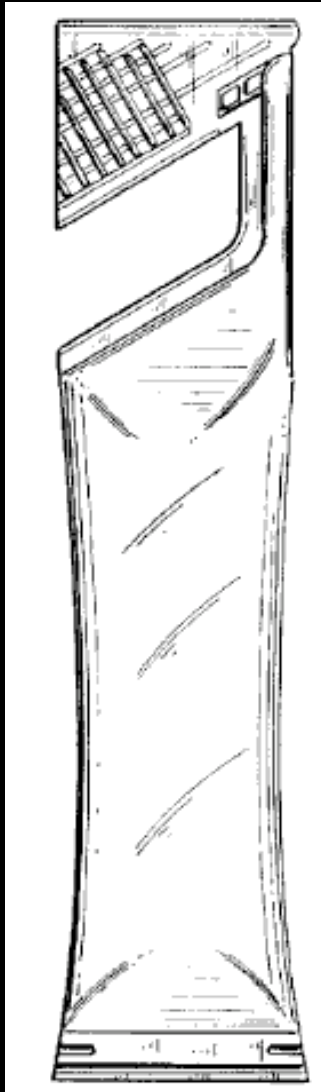
Bergstrom v. Sears

Court:

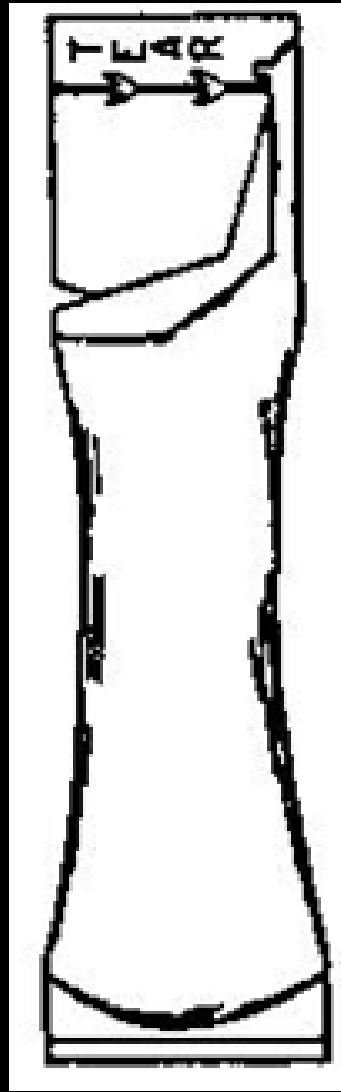
The [accused device] bore the closest resemblance to the [patented design] out of all the prior art.

Unette v. Unit Pack

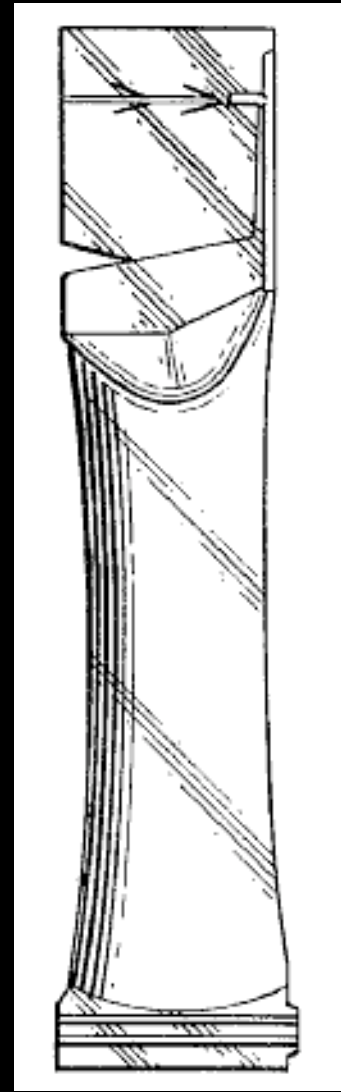
(D.N.J. 1985)



Patented Design



Accused Design



Prior Art

Unette v. Unit Pack

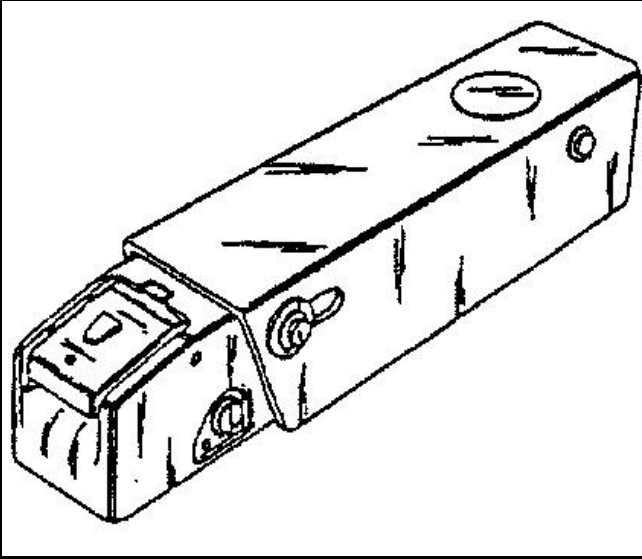
Court:

To the extent that defendant's design is derived not from plaintiff's, but from the prior art, infringement cannot be said to have occurred.

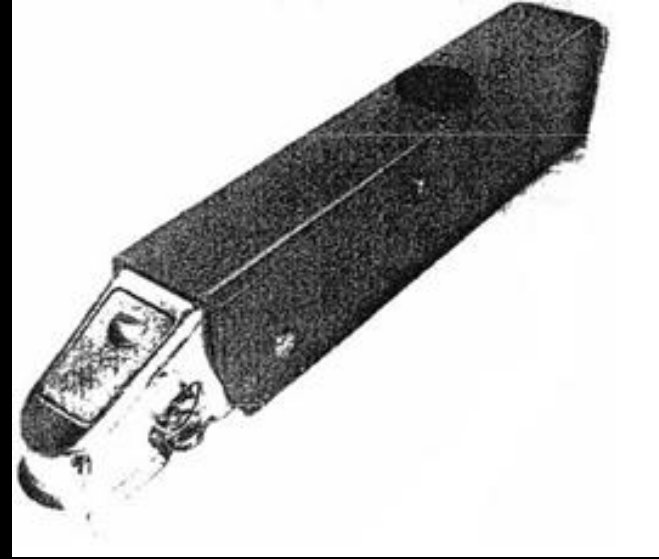
Unique v. Mastercraft Boat

(Fed. Cir. 1993)

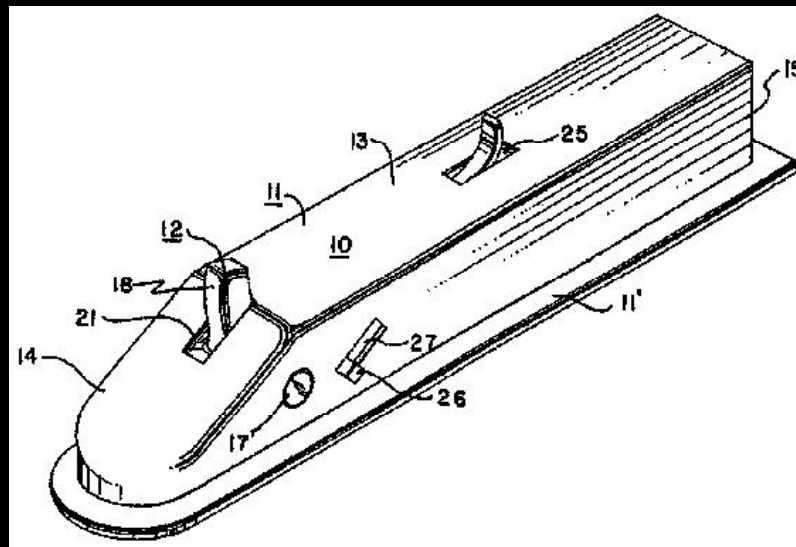
Patented
Design



Accused
Design



Prior Art

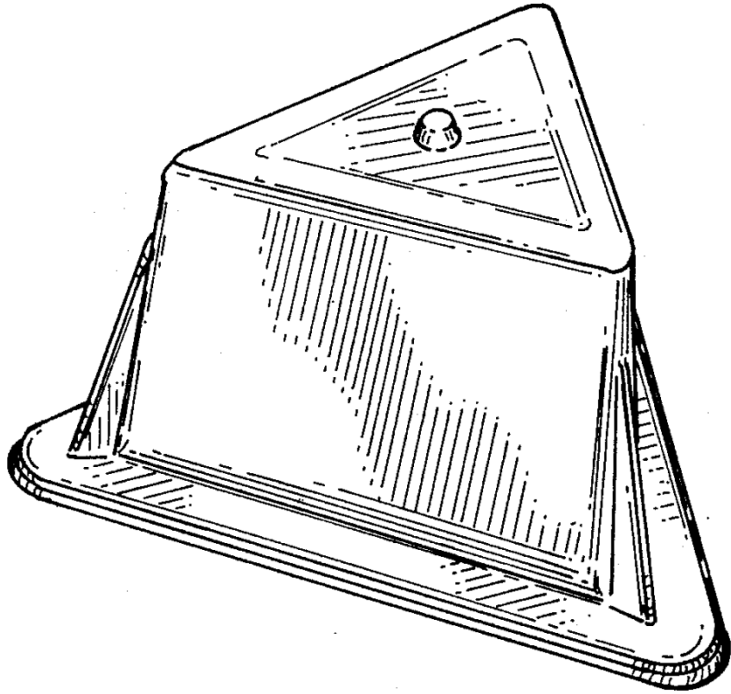


Unique v. Mastercraft Boat

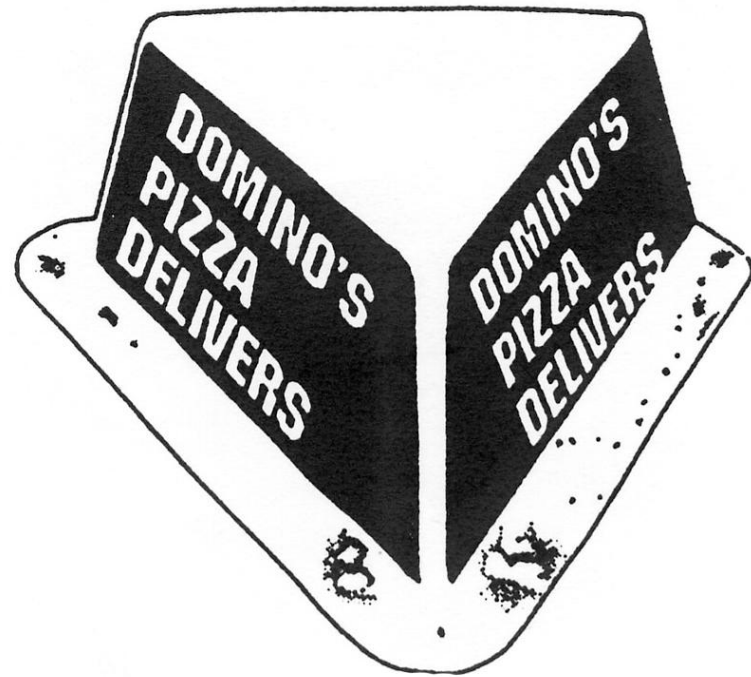
Court:

The accused design is dissimilar from the patented design and, indeed, much more closely resembles the design disclosed in the prior art...

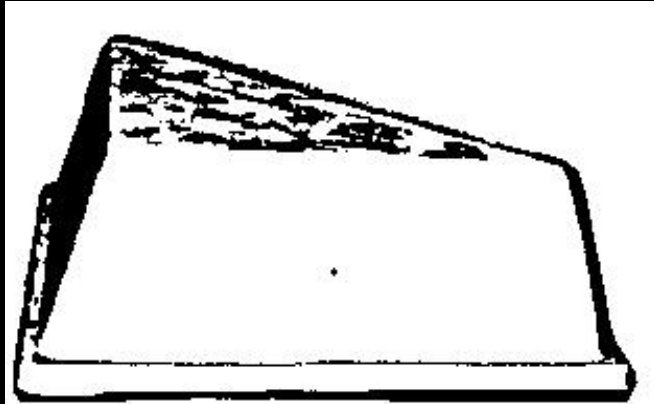
Elmer v. ICC Fabricating (Fed. Cir. 1995)



Patented Design



Accused Design



Prior Art

Elmer v. ICC Fabricating

Court:

...the...patented design differs from the prior art *and* the accused design in two respects: the protrusion that extends above the upper surface... and the triangular vertical ribs...

Egyptian Goddess v. Swisa

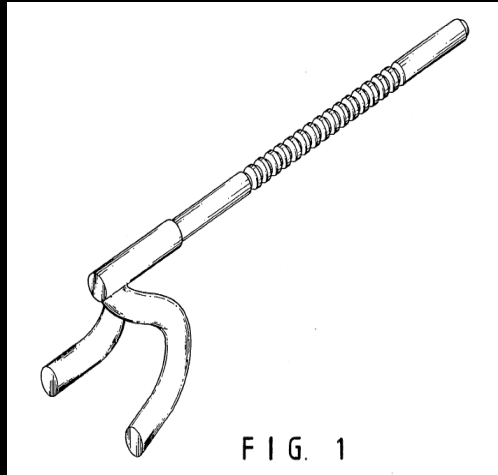
(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #3:

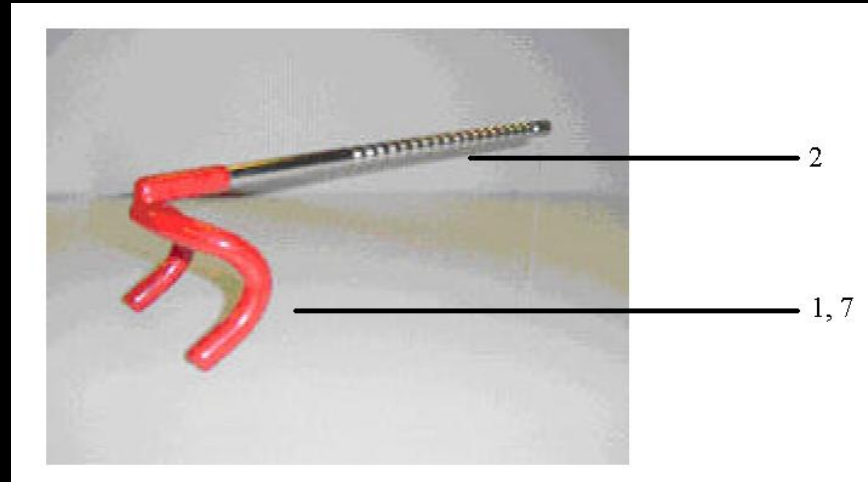
3. If the claimed design consists of a combination of old features that creates an appearance deceptively similar to the accused design, even to an observer familiar with similar prior art designs, a finding of infringement would be justified.

Lawman Armor Corp. v. Winner Int'l

(Fed. Cir. 2006)



PATENTED DESIGN



ACCUSED DESIGN

Lawman Armor Corp. v. Winner Int'l

(Fed. Cir. 2006)

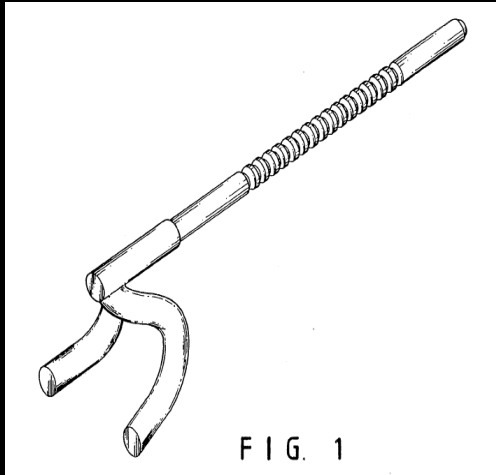
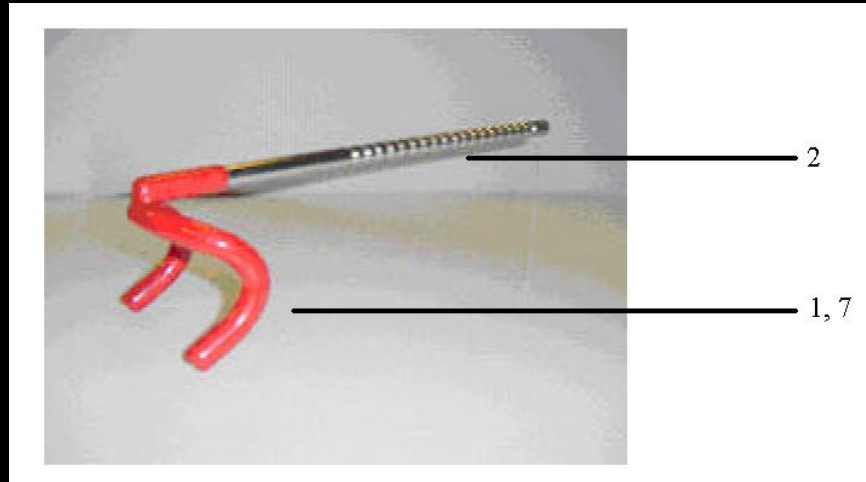


FIG. 1

PATENTED DESIGN



ACCUSED DESIGN

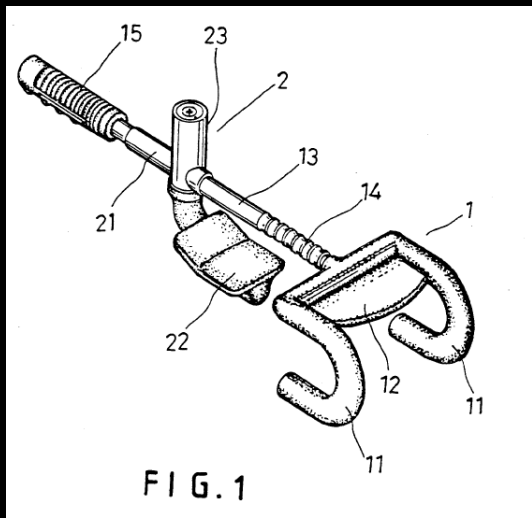


FIG. 1

**PRIOR
ART**

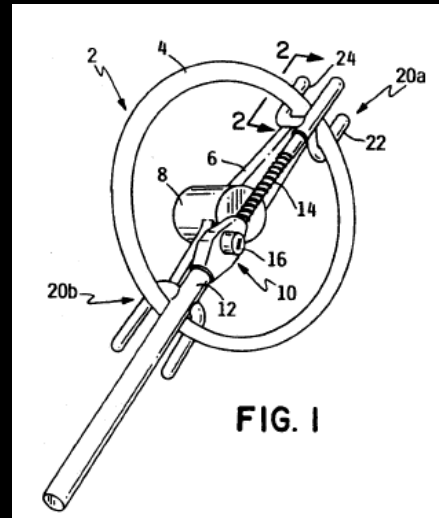


FIG. 1

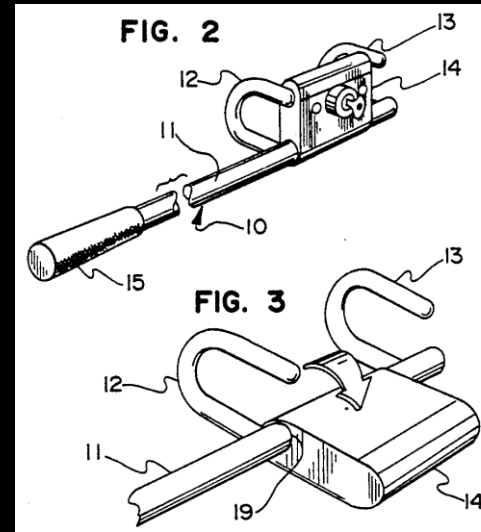


FIG. 2

FIG. 3

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #4:

4. In some instances, the claimed design and the accused design will be sufficiently distinct that it **will be clear without more** that the patentee has not met its burden of proving the two designs would appear "substantially the same" to the ordinary observer.

Motorola v. Qualcomm

United States Patent [19]

Nagele et al.

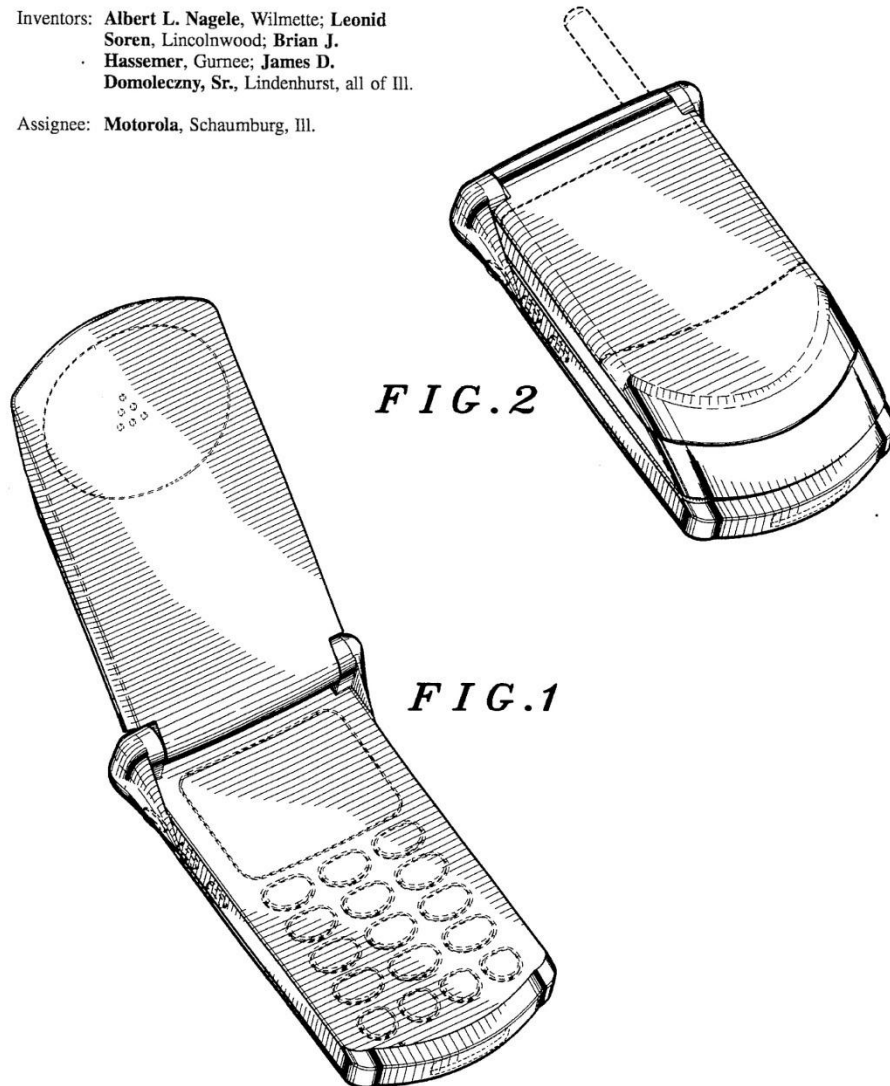
[11] Patent Number: Des. 369,598

[45] Date of Patent: **May 7, 1996

[54] HOUSING FOR A PORTABLE TELEPHONE

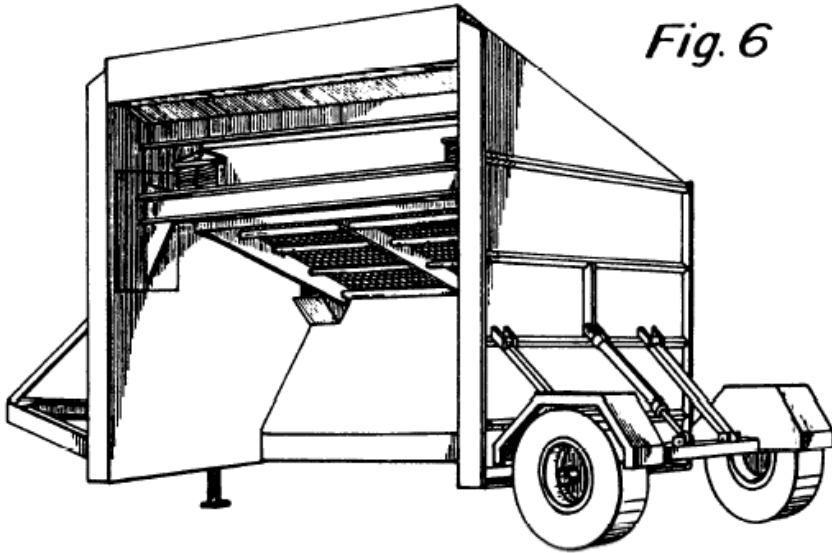
[75] Inventors: Albert L. Nagele, Wilmette; Leonid Soren, Lincolnwood; Brian J. Hassemer, Gurnee; James D. Domoleczny, Sr., Lindenhurst, all of Ill.

[73] Assignee: Motorola, Schaumburg, Ill.

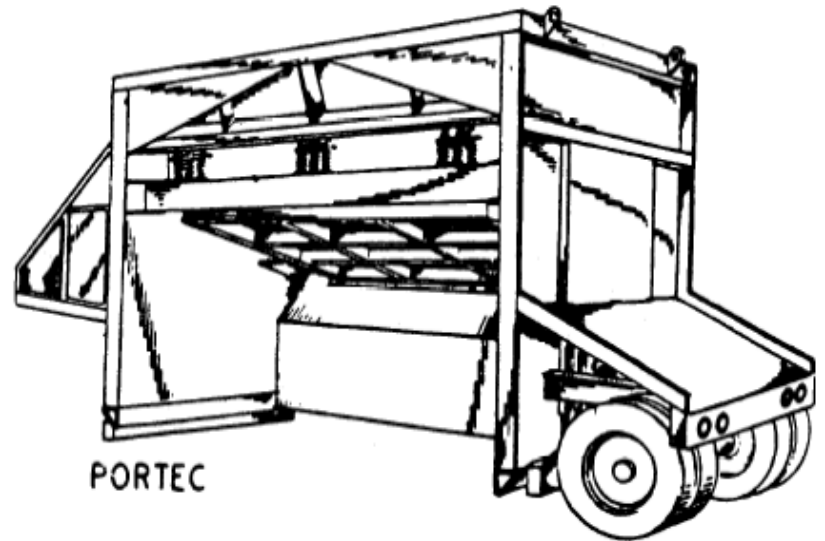


Read v. Portec (Fed. Cir. 1992)

Fig. 6



Read's U.S. Pat.
No. Des. 263,836



Portec's Accused
Design

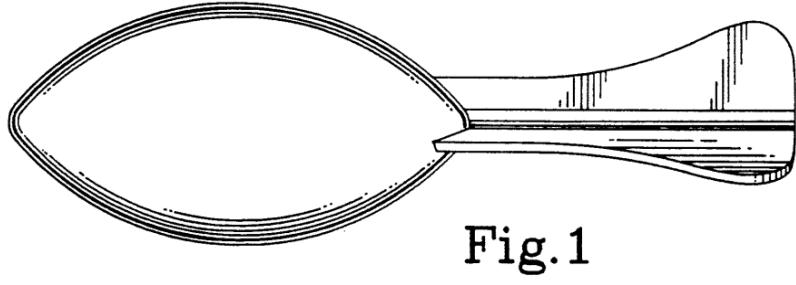
Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

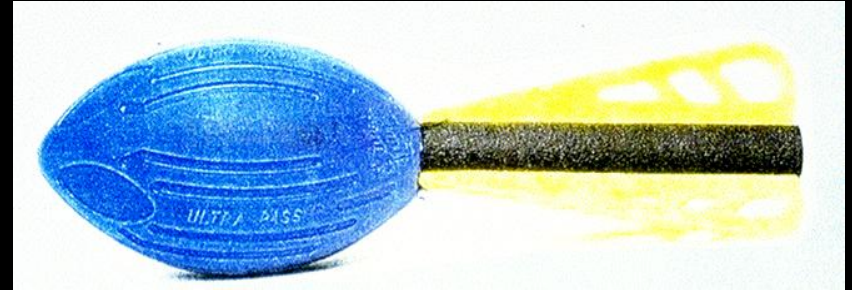
GUIDELINE #5:

5. [W]hen the claimed and accused designs are **not plainly dissimilar**, resolution of the question...will benefit from a comparison of the claimed and accused designs with the prior art.

OddzOn Products v. Just Toys



PATENTED DESIGN



ACCUSED DESIGN

OddzOn Products v. Just Toys

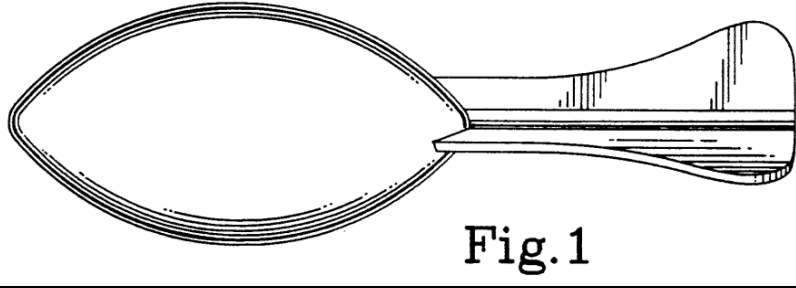
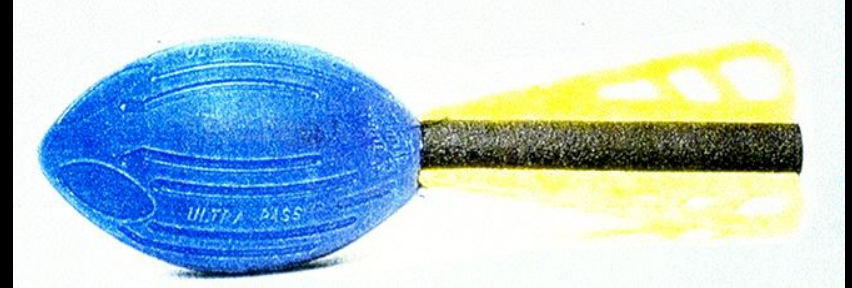


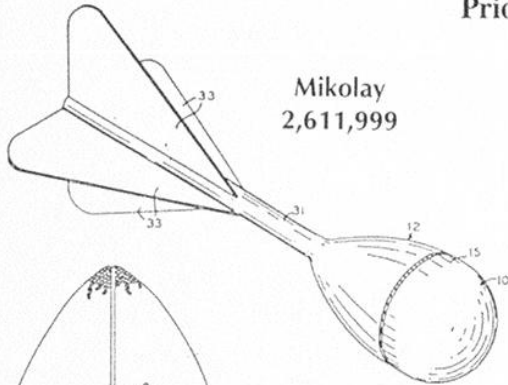
Fig. 1

PATENTED DESIGN

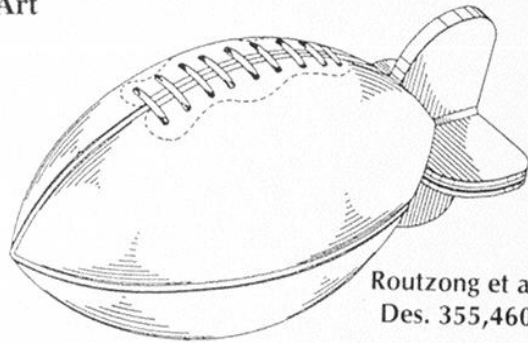


ACCUSED DESIGN

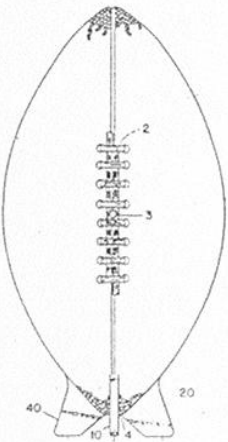
Prior Art



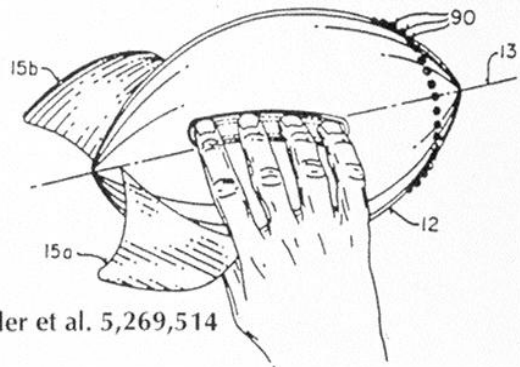
Mikolay
2,611,999



Routzong et al.
Des. 355,460



Smith 3,256,020



Adler et al. 5,269,514

Prior Art

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #6:

6. Where there are many examples of similar prior art designs, as in a case such as Whitman Saddle, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.

Smith v. Whitman Saddle (1893)

UNITED STATES PATENT OFFICE.

DESIGN.

R. E. WHITMAN.

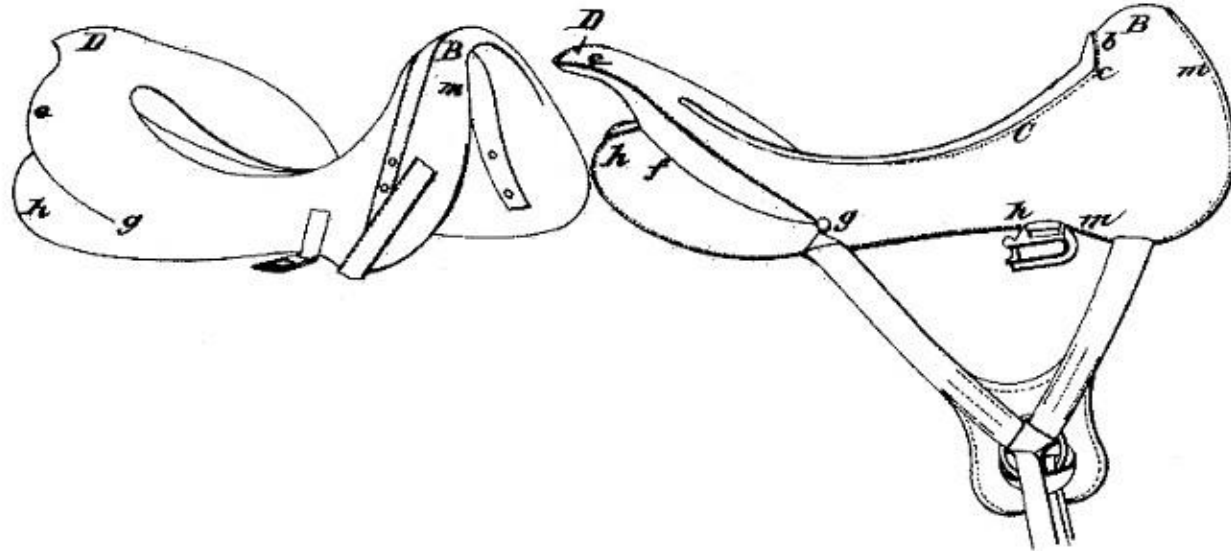
Saddle.

No. 10,844.

Patented Sept. 24, 1878.

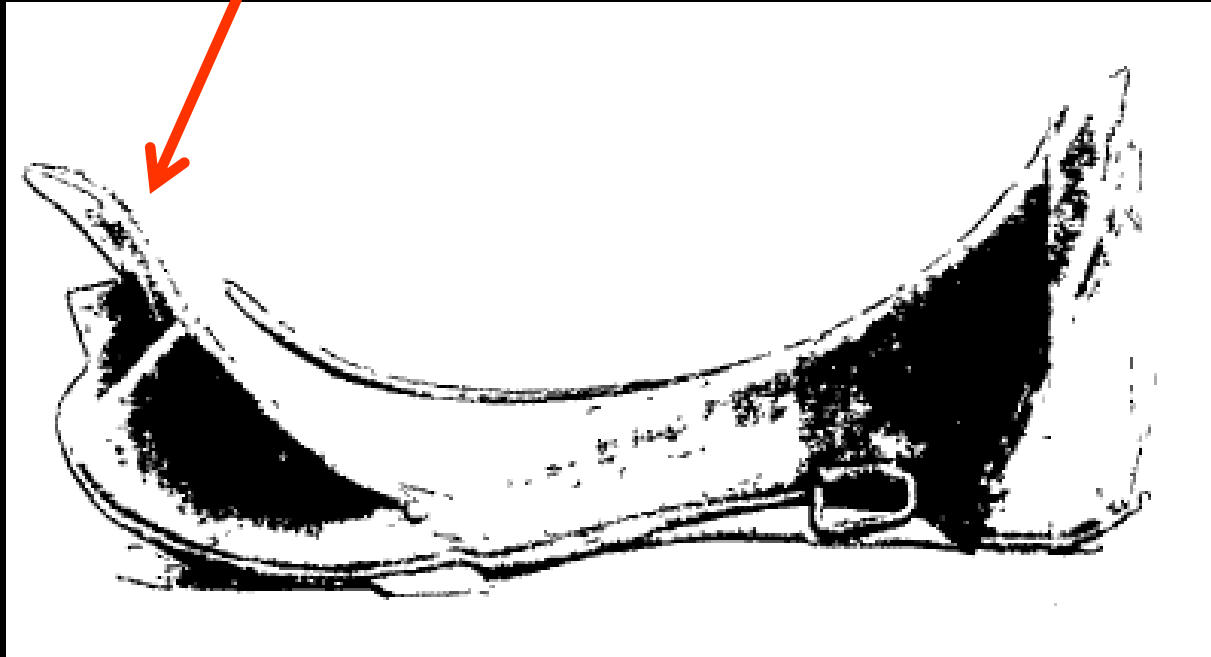
Fig. 2.

Fig. 1.



U.S. Pat. No. D10,844

Smith v. Whitman Saddle (1893)



Jenifer Cantle

Smith v. Whitman Saddle (1893)

UNITED STATES PATENT OFFICE.

DESIGN:

R. E. WHITMAN.

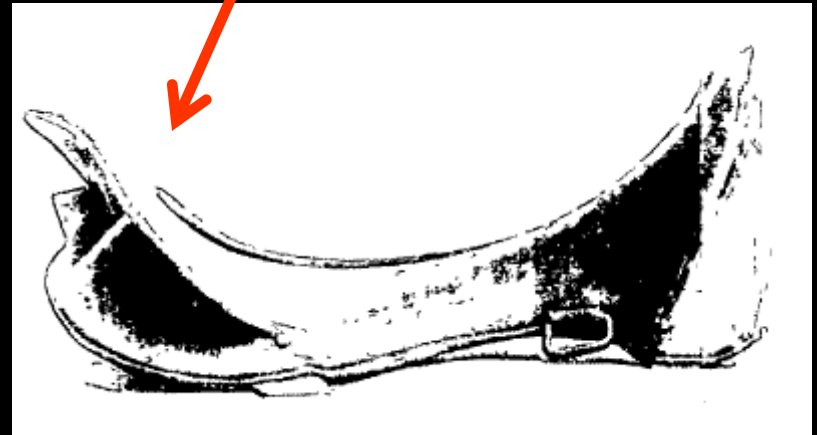
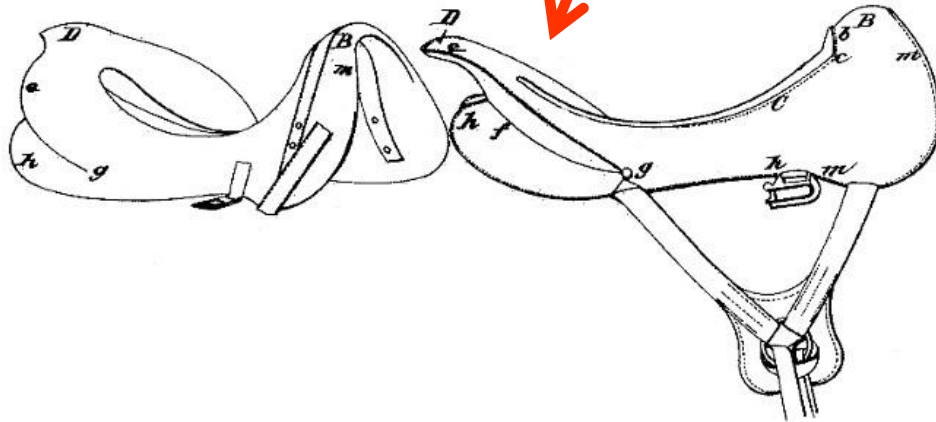
Saddle.

No. 10,844.

Patented Sept. 24, 1878.

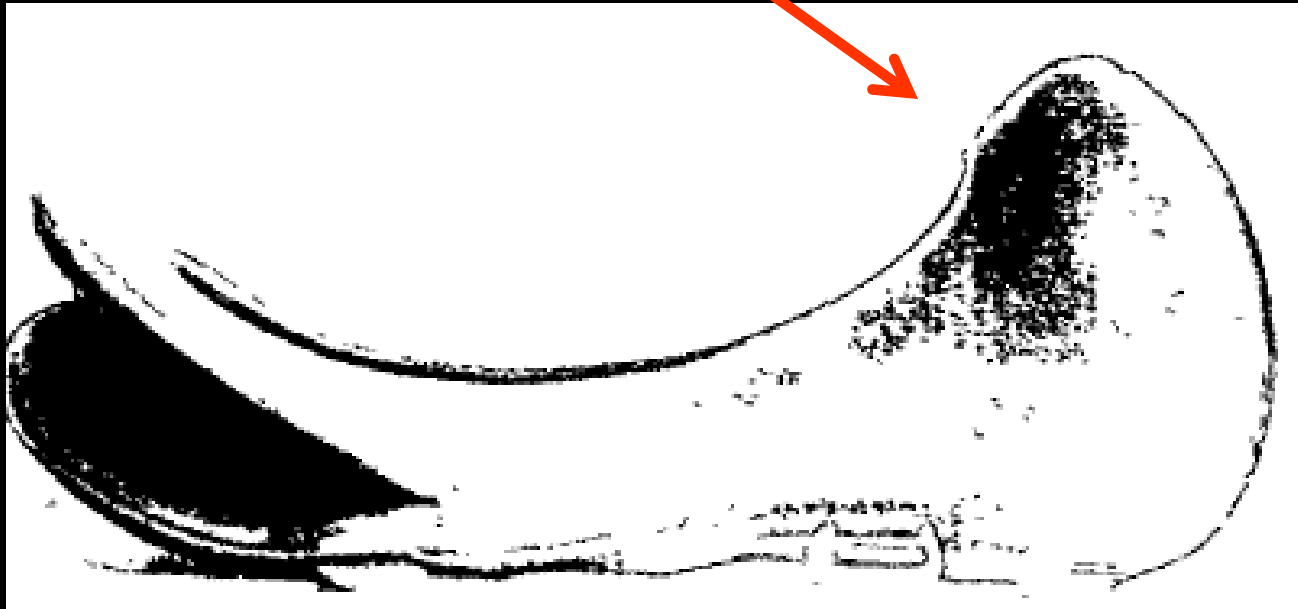
Fig. 2.

Fig. 1.



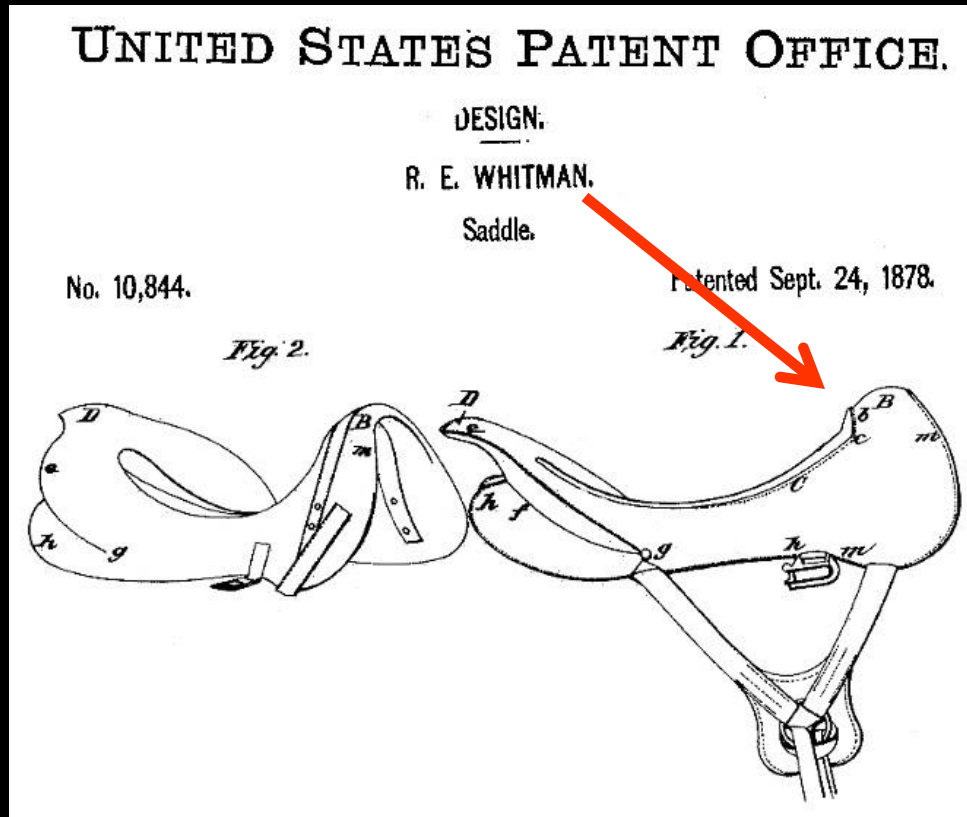
Comparison of Patented
Design & Jenifer Prior Art

Smith v. Whitman Saddle (1893)



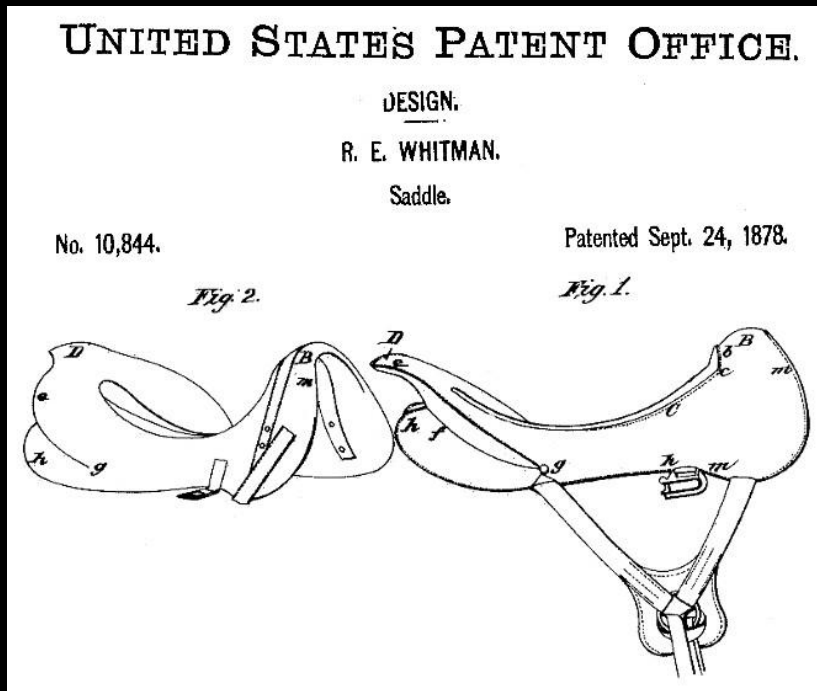
Granger Saddle

Smith v. Whitman Saddle (1893)

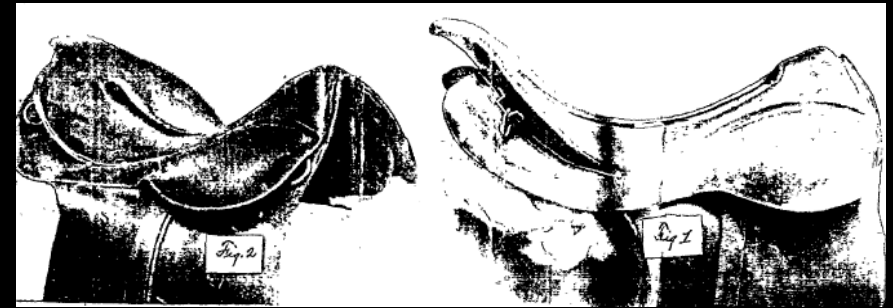


Comparison of Patented
Design & Granger Prior Art

Smith v. Whitman Saddle (1893)

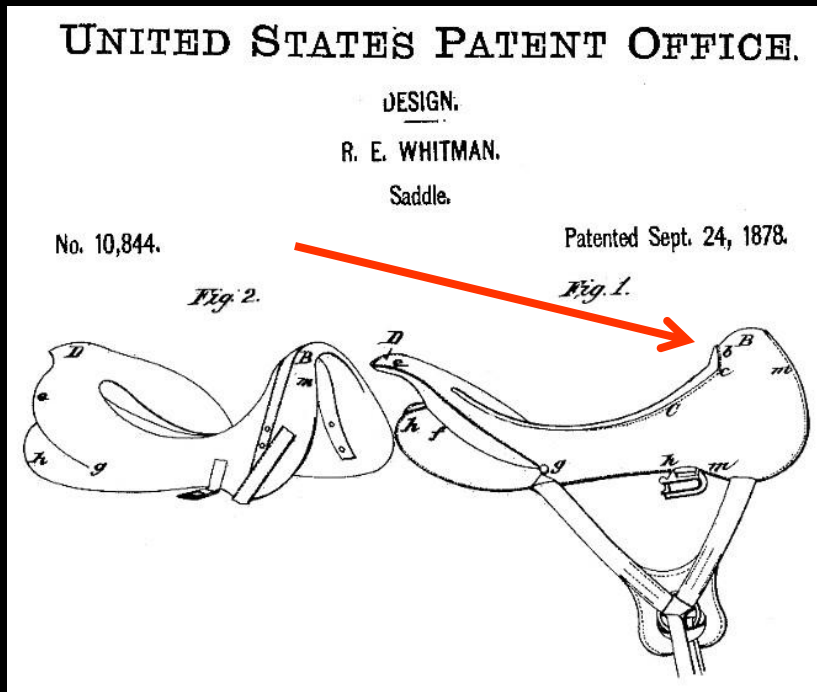


**Whitman's PATENTED
DESIGN**



**Smith's ACCUSED
DESIGN**

Smith v. Whitman Saddle (1893)



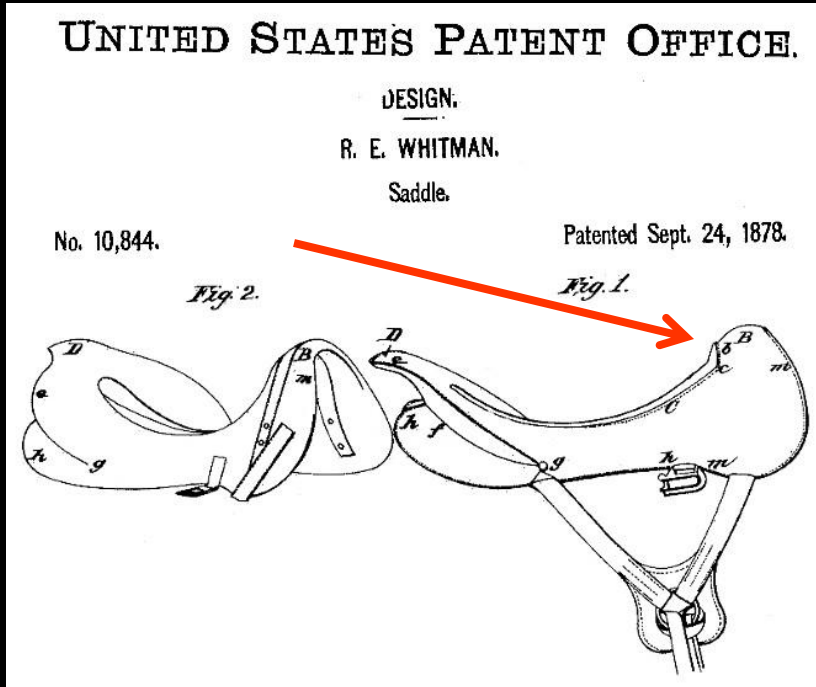
Whitman's PATENTED DESIGN



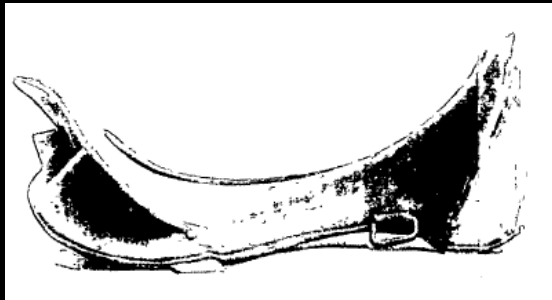
Smith's ACCUSED DESIGN

Smith v. Whitman Saddle (1893)

Whitman's PATENTED DESIGN



Smith's ACCUSED DESIGN



JENNIFER PRIOR ART



GRANGER PRIOR ART

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

Whitman Analysis: [V]iewed in light of similarities between the prior art and the patented design, the accused design did not contain the single feature that would have **made it appear** distinctively similar to the patented design rather than like the numerous prior art designs.

Smith v. Whitman Saddle (1893)

Whitman's PATENTED DESIGN

UNITED STATES PATENT OFFICE.

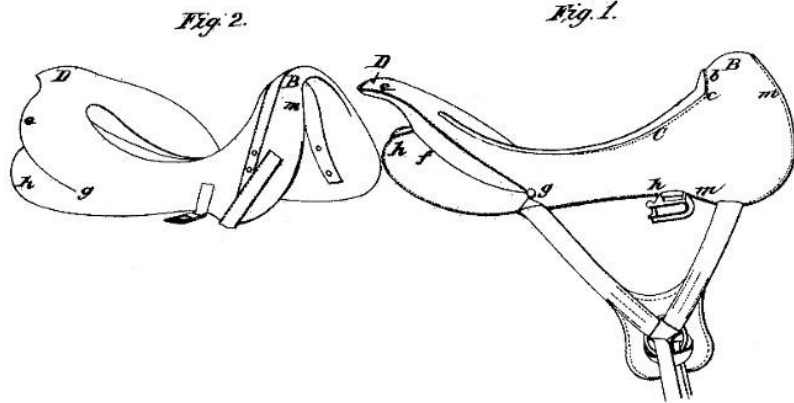
DESIGN.

R. E. WHITMAN.

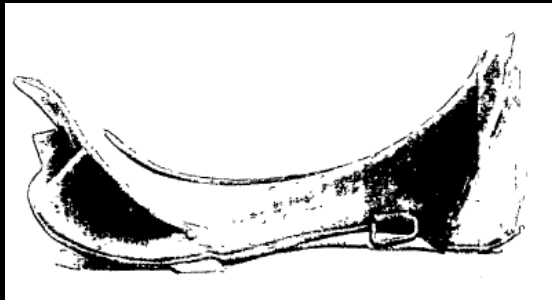
Saddle.

No. 10,844.

Patented Sept. 24, 1878.



Smith's ACCUSED DESIGN



JENNIFER PRIOR ART



GRANGER PRIOR ART

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

Whitman Analysis: To an observer familiar with the multitude of prior art saddle designs...the sharp drop at the rear of the pommel would be important to the overall appearance of the designs, and would serve to distinguish the accused design, which did not possess that feature, from the claimed design.

Smith v. Whitman Saddle (1893)

Whitman's CLAIMED DESIGN

UNITED STATES PATENT OFFICE.

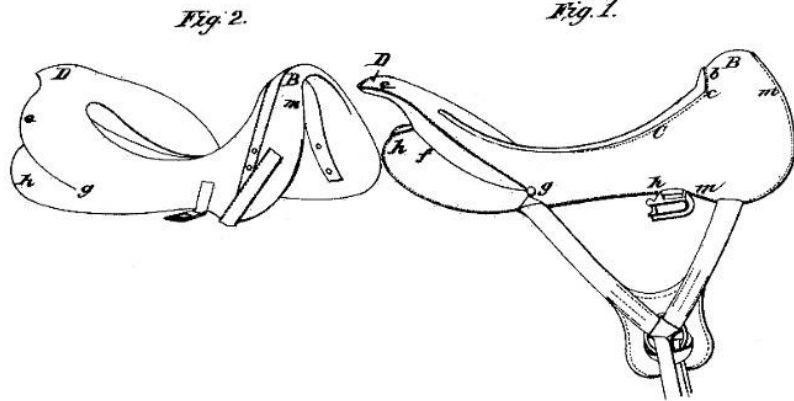
DESIGN.

R. E. WHITMAN.

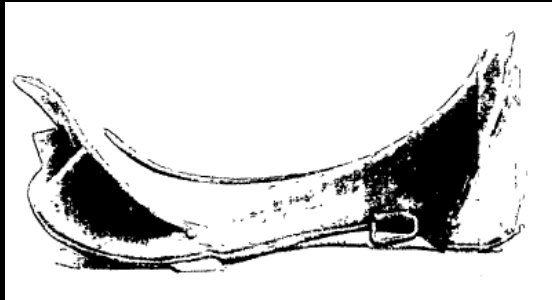
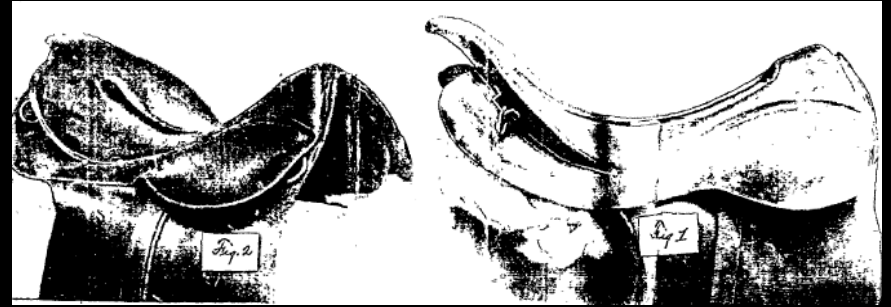
Saddle.

No. 10,844.

Patented Sept. 24, 1878.



Smith's ACCUSED DESIGN



JENNIFER PRIOR ART



GRANGER PRIOR ART

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #7:

7. ...examining the novel features of the claimed design can be an important component of the comparison of the claimed design with the accused design and the prior art. But the comparison of the designs, including the examination of any novel features, must be conducted as part of the ordinary observer test, not as part of a separate test focusing on particular points of novelty that are designated only in the course of litigation.

Novel Features

1. Jenifer cantle
2. Granger saddle
3. Open slot
4. Pommel drop

Smith v. Whitman Saddle (1893)

Whitman's PATENTED DESIGN

UNITED STATES PATENT OFFICE.

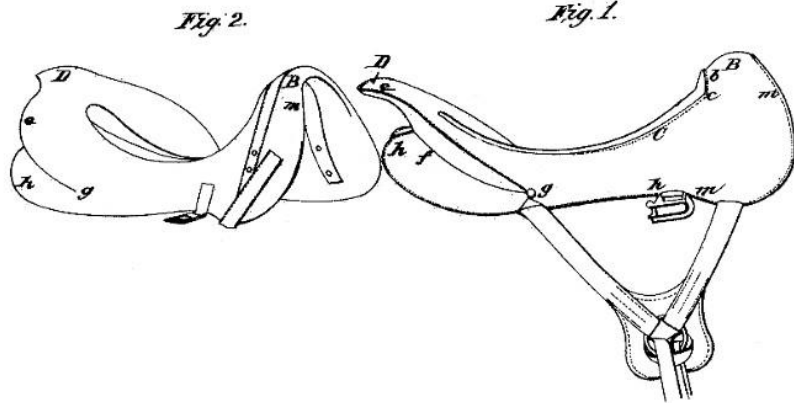
DESIGN.

R. E. WHITMAN.

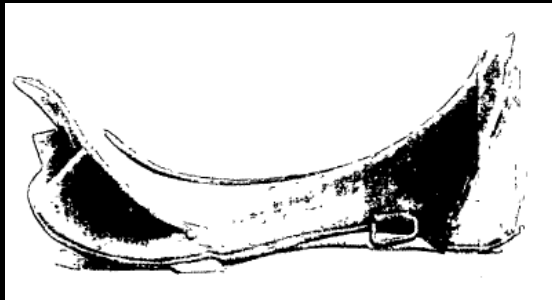
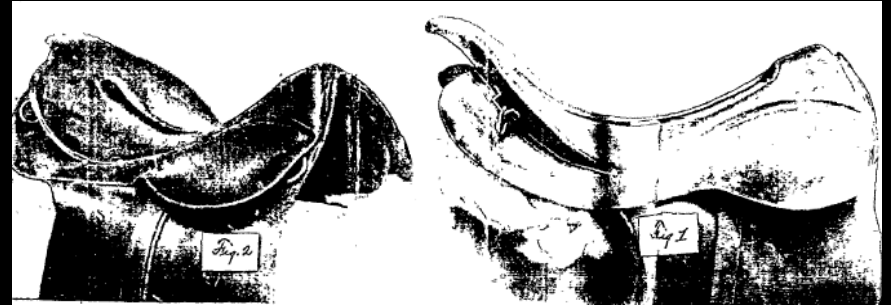
Saddle.

No. 10,844.

Patented Sept. 24, 1878.



Smith's ACCUSED DESIGN



JENNIFER PRIOR ART



GRANGER PRIOR ART

Novel Features

1. Jenifer cantle
2. Granger saddle
3. Open slot
4. Pommel drop

Novel Features

1. Jenifer cantle
2. Granger saddle
3. Open slot
4. Pommel drop

Smith v. Whitman Saddle (1893)

Whitman's PATENTED DESIGN

UNITED STATES PATENT OFFICE.

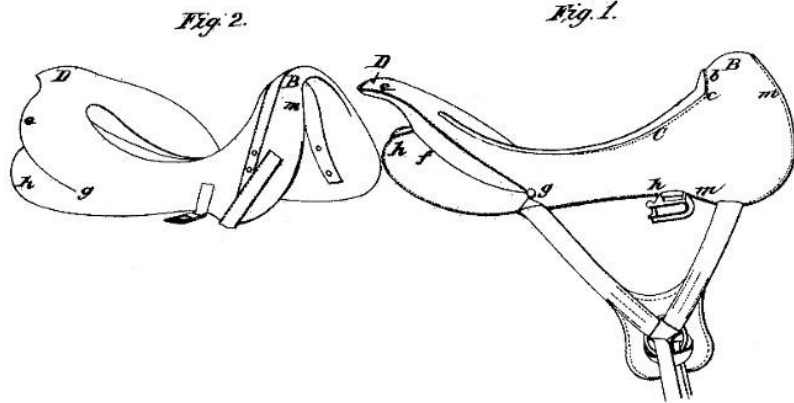
DESIGN.

R. E. WHITMAN.

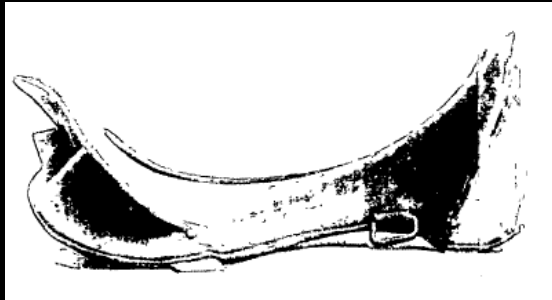
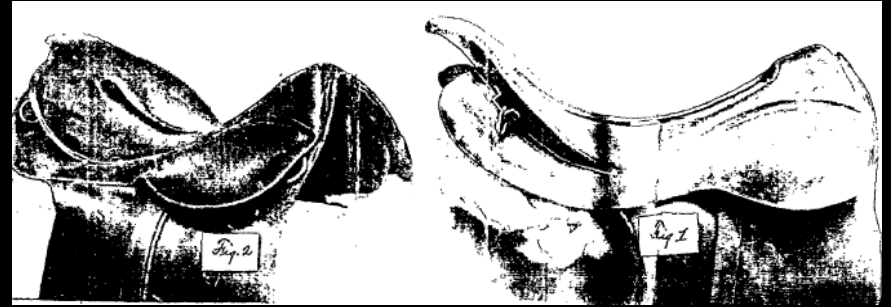
Saddle.

No. 10,844.

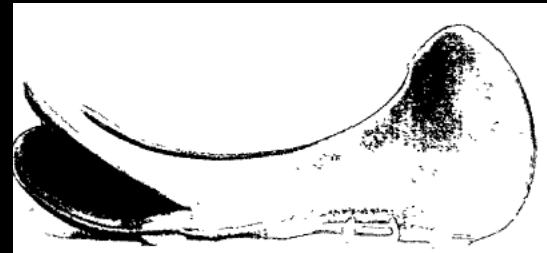
Patented Sept. 24, 1878.



Smith's ACCUSED DESIGN



JENNIFER PRIOR ART



GRANGER PRIOR ART

Egyptian Goddess v. Swisa

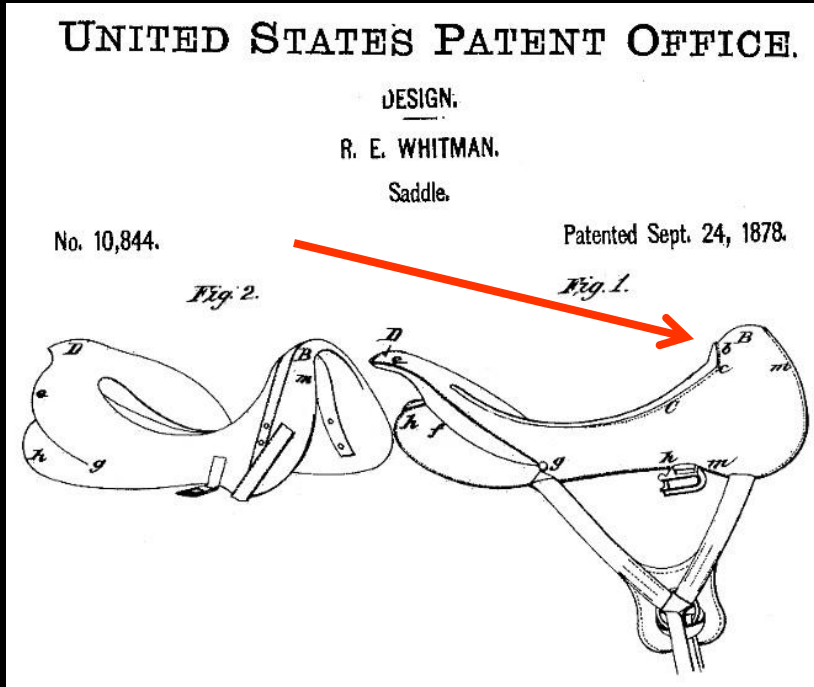
(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

FED. CIR.:

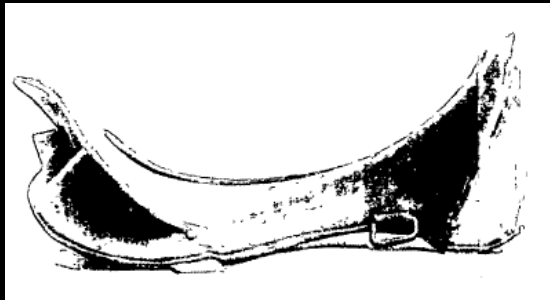
...unlike the point of novelty test, the ordinary observer test does not present the risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature...

Smith v. Whitman Saddle (1893)

Whitman's PATENTED DESIGN



Smith's ACCUSED DESIGN



JENNIFER PRIOR ART



GRANGER PRIOR ART



*Is
There
Anything
To Crow
About?*

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

HELD: No reasonable fact-finder could find that EG met its burden of showing...that an ordinary observer, taking into account the prior art, would believe the accused design to be the same as the patented design.

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

FED. CIR.

The question before this court under the standard we have set forth above is whether an ordinary observer, familiar with the prior art Falley and Nailco designs, would be deceived into believing the Swisa buffer is the same as the patented buffer.

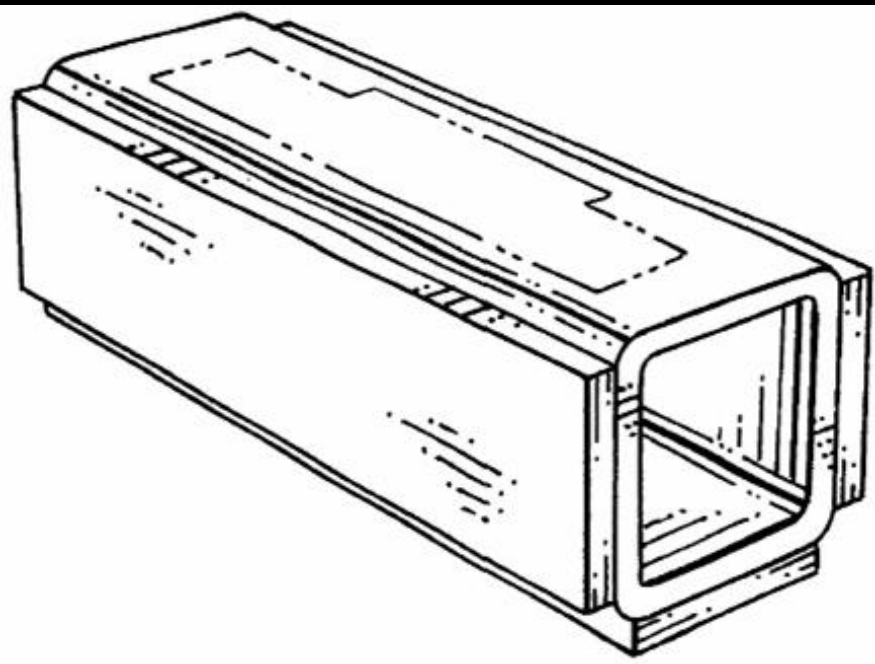
Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

FED. CIR.

The problem with Ms. Eaton's declaration is that she characterized the accused and patented designs as similar because they both have square cross sections and "multiple" raised buffer pads, without directly acknowledging that the patented design has three pads while the accused design has four, one on each side.

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)



Patented Design



Accused Design

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

EATON DECLARATION (para. 7):

"I understand that the accused nail buffer has one more buffer pad than the patented design."

Egyptian Goddess v. Swisa

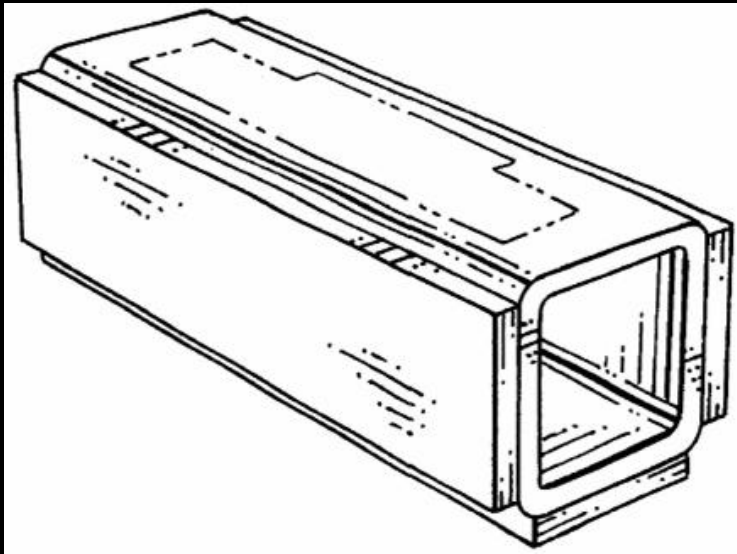
(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

FED. CIR.

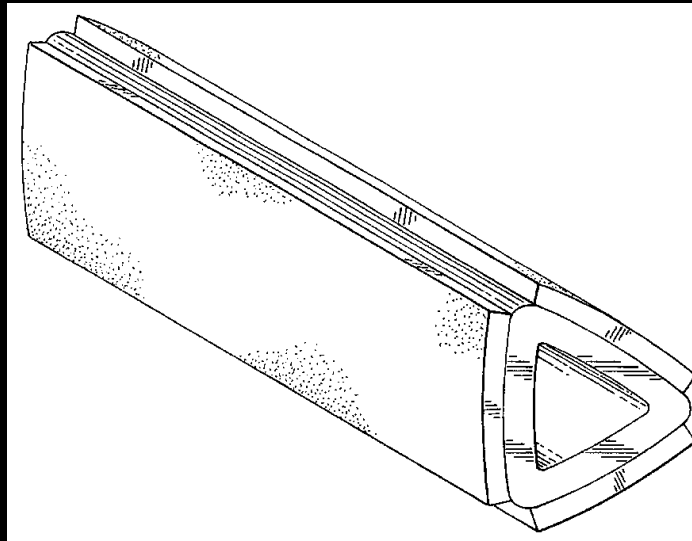
She also failed to address the fact that the design of the Nailco patent is identical to the accused device except that the Nailco design has three sides rather than four.

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

Patented Design



Accused Design



Prior Art
NAILCO

Egyptian Goddess v. Swisa

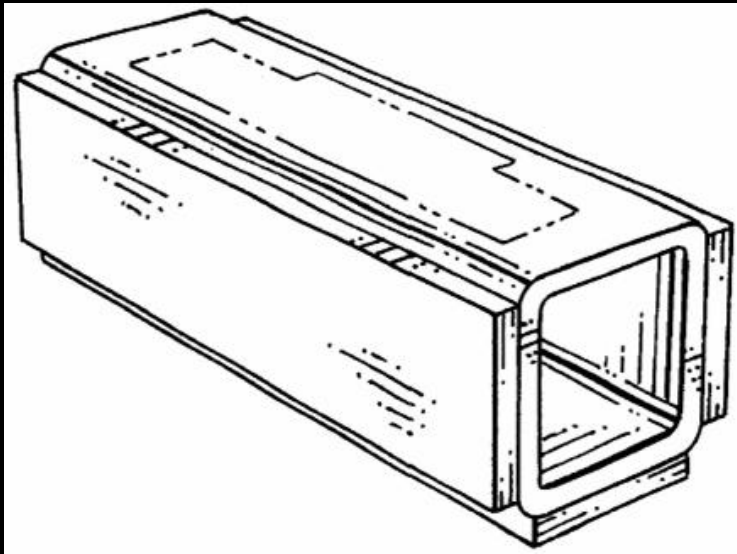
(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

FED. CIR.

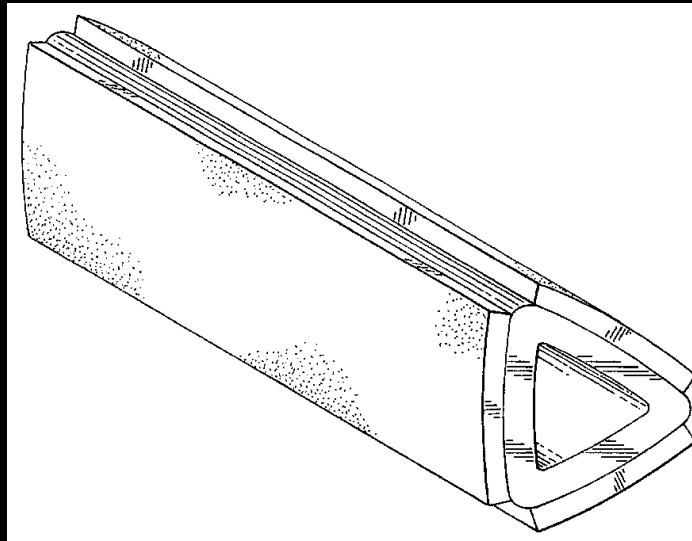
Thus, she could as easily have said that the Nailco buffer design "is like the accused design because both designs have a hollow tube, have multiple rectangular sides with raised rectangular pads mounted on each side that do not cover the corners of the tube," in which case the Nailco prior art buffer would be seen to closely resemble the accused design.

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

Patented Design



Accused Design



Prior Art
NAILCO

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

FED. CIR.

Nothing about Ms. Eaton's declaration **explains why** an ordinary observer would regard the accused design as being closer to the claimed design than to the Nailco prior art patent.

Egyptian Goddess v. Swisa

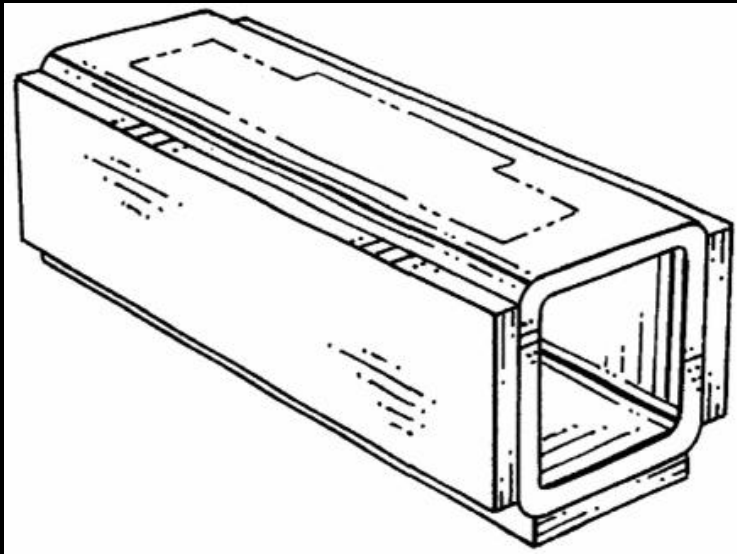
(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

EATON DECLARATION (para. 7):

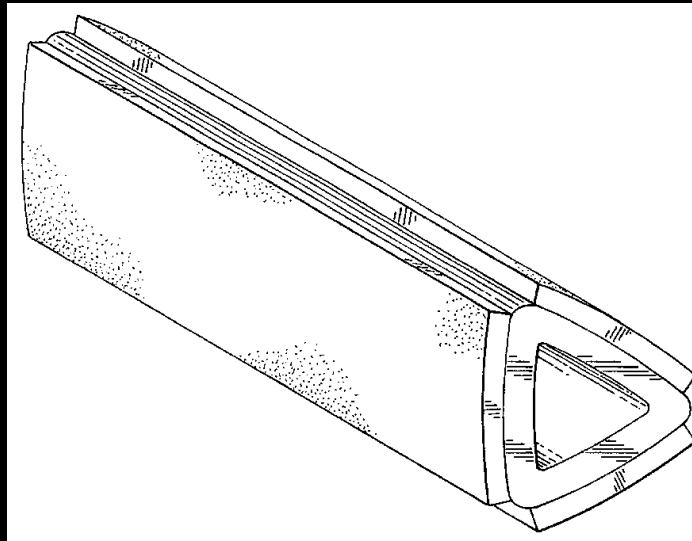
"In my opinion an ordinary observer and purchaser of nail buffers would consider that the patented design and the accused nail buffer have a substantially similar appearance in overall design, particularly in light of other nail buffers, such as a solid block buffer and the hollow triangular Nailco buffer. 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."

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

Patented Design



Accused Design



Prior Art
NAILCO

Egyptian Goddess v. Swisa

(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

FED. CIR.

While the district court focused on the differences in the particular feature at issue rather than the effect of those differences on the appearance of the design as a whole, we are satisfied that the difference on which the district court focused is important, viewed in the context of the prior art.

Egyptian Goddess v. Swisa

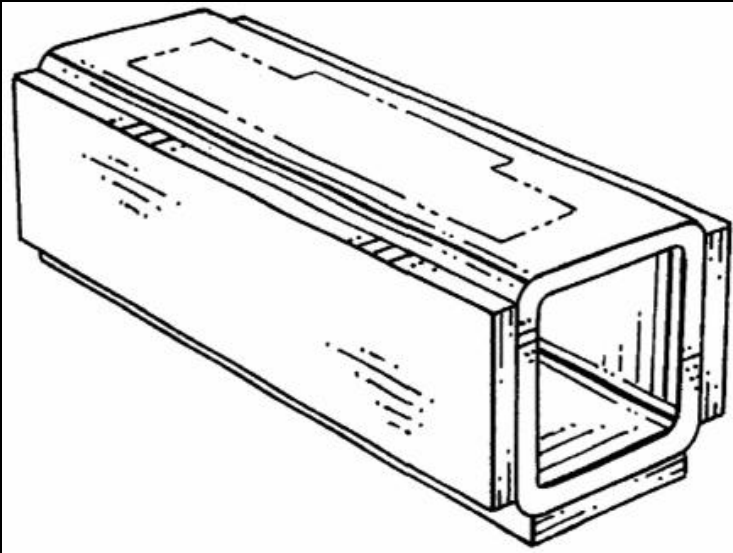
(*en banc* Fed. Cir. 2006-1562, Sept. 22, 2008)

GUIDELINE #7:

7. ...examining the novel features of the claimed design can be an important component of the comparison of the claimed design with the accused design and the prior art.

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

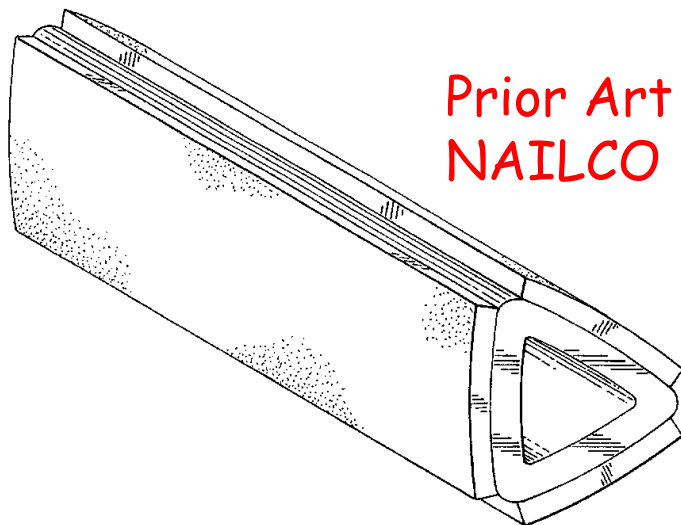
Patented Design



Accused Design



Prior Art
NAILCO

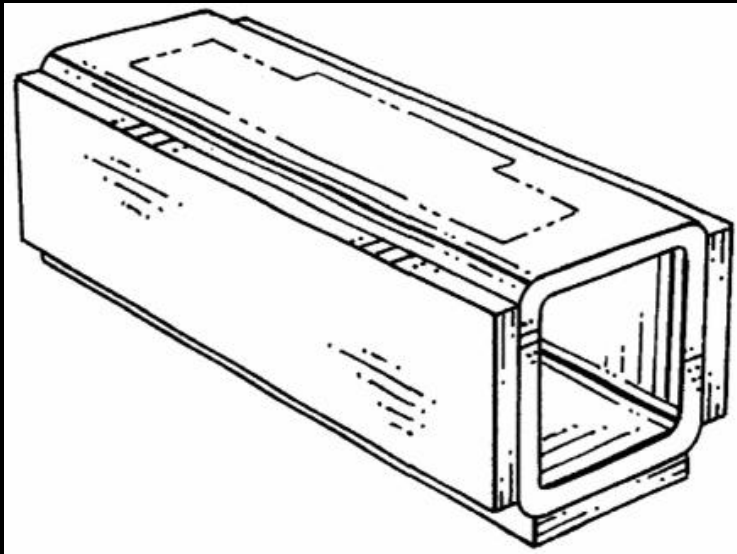


Prior Art
FALLEY

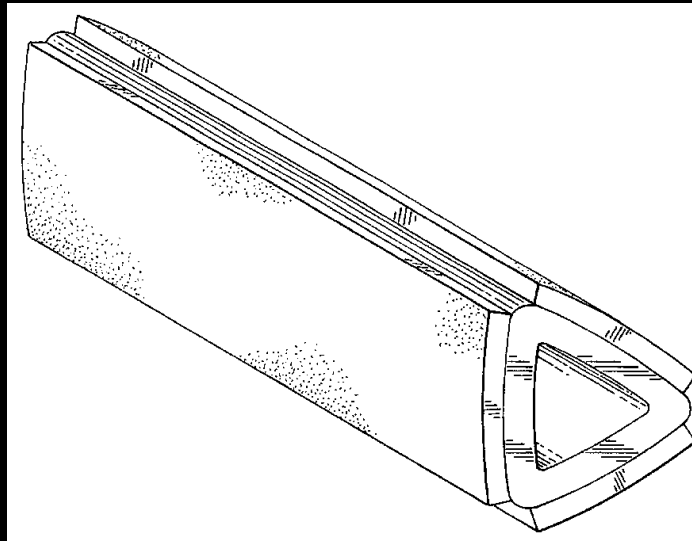


Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

Patented Design



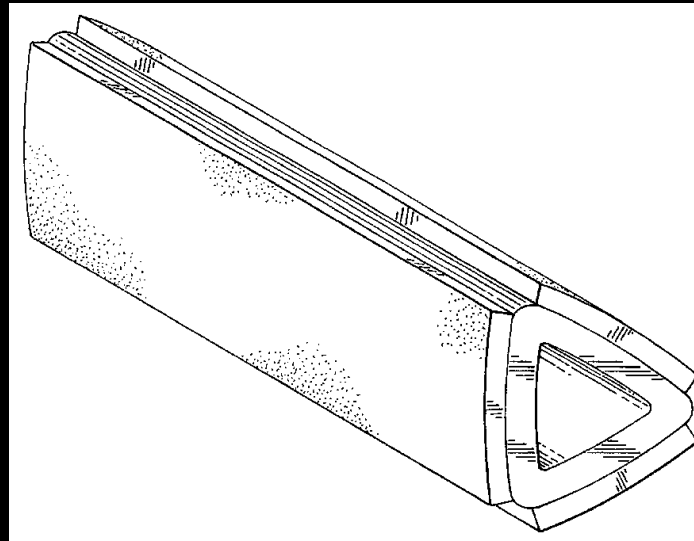
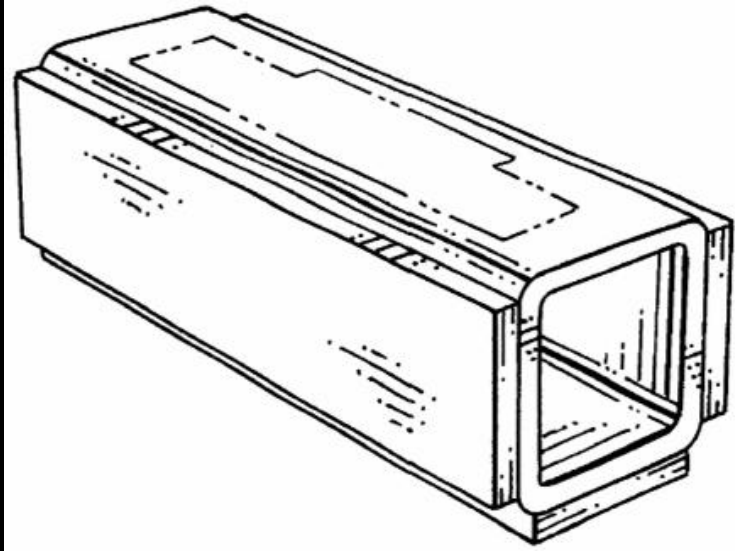
Accused Design



Prior Art
NAILCO

PATENTED DESIGN IS NON-OBVIOUS OVER NAILCO

Patented Design



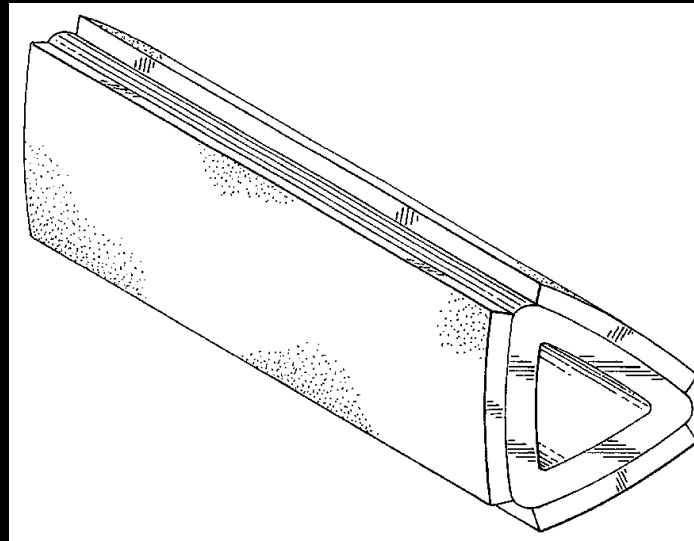
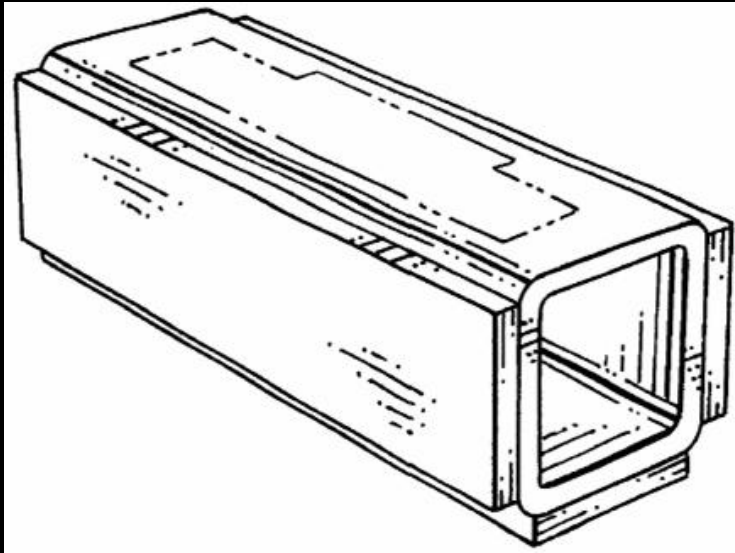
Prior Art
NAILCO

Test for *Prima Facie* Obviousness of A Design

... one must first find a single prior art reference, "a something in existence, the design characteristics of which are *basically the same* as the claimed design." *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982).

PATENTED DESIGN IS NON-OBVIOUS OVER NAILCO

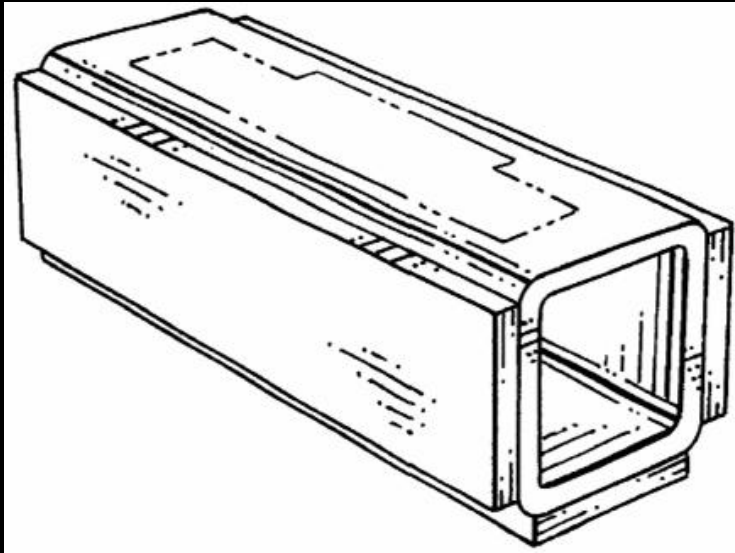
Patented Design



Prior Art
NAILCO =
NOT
BASICALLY
THE SAME
AS
PATENTED
DESIGN

Hypothetical

Prior Art



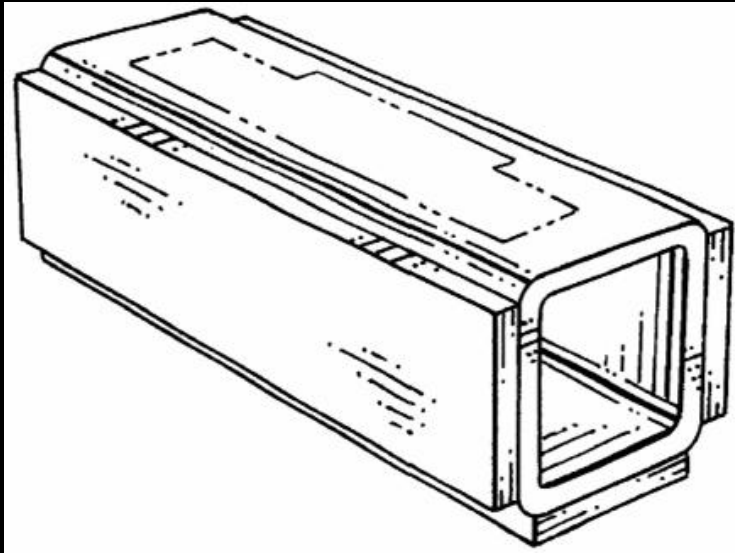
Claimed Design



Is the Prior Art (Egyptian Goddess) buffer a "Rosen reference" against the hypothetically claimed Swisa buffer?

Hypothetical

Prior Art



Claimed Design



Egyptian's buffer and Swisa's buffer would be deemed "basically the same"

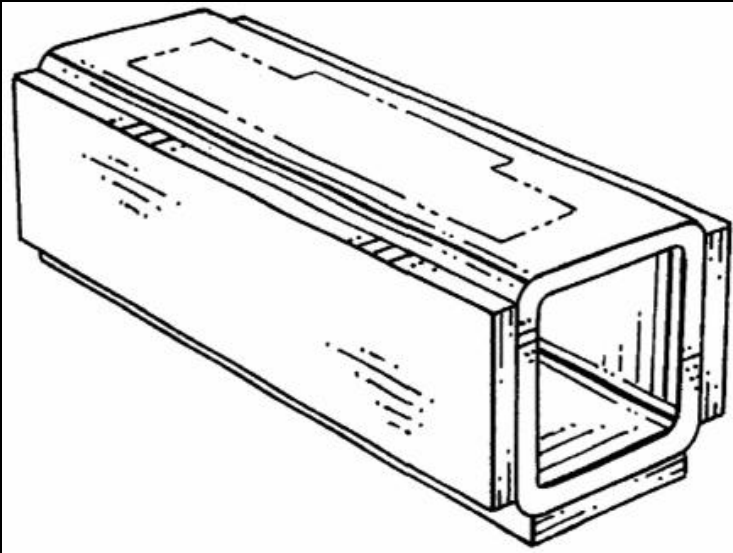
Gorham v. White (1871)

ORDINARY OBSERVER TEST:

*...if, in the eye of an ordinary observer...
two designs are substantially the
same...[then] the ... one patented is
infringed by the other.*

Hypothetical

Prior Art



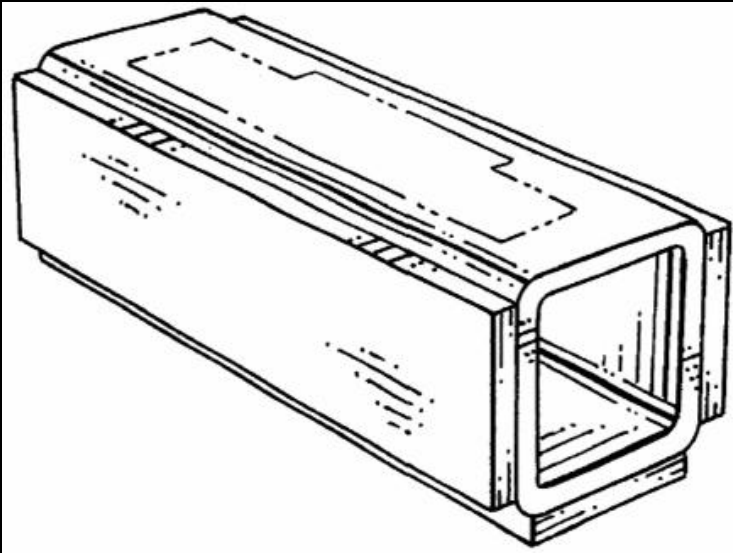
Claimed Design



If Egyptian's buffer and Swisa's buffer are "*basically the same*" to a designer of ordinary skill, they must be "*substantially the same*" to an ordinary observer.

Egyptian Goddess v. Swisa (Fed. Cir. 2006-1562)

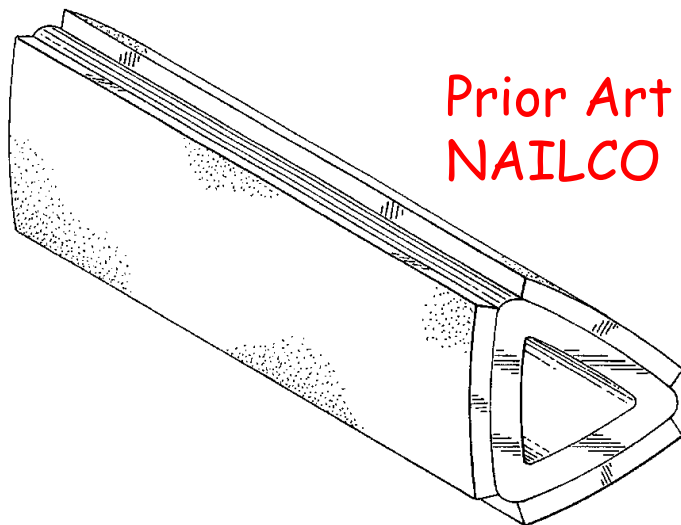
Patented Design



Accused Design



Prior Art
NAILCO

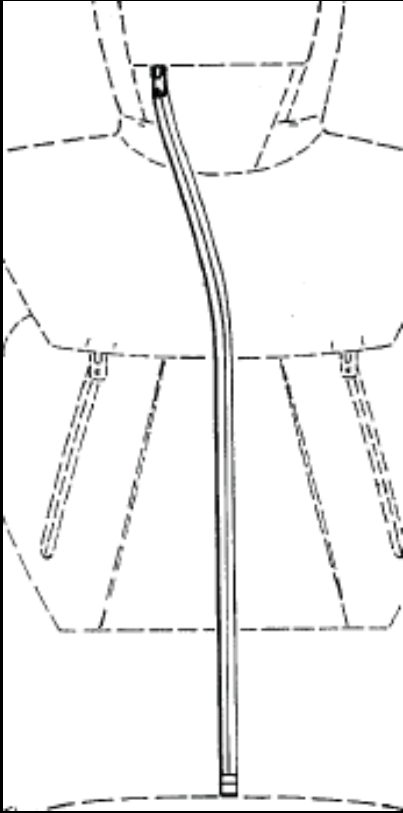


Prior Art
FALLEY





Arc'Teryx Equip. v. Westcomb Outerwear (D. Utah Nov. 4, 2008)



715 Patented
Design

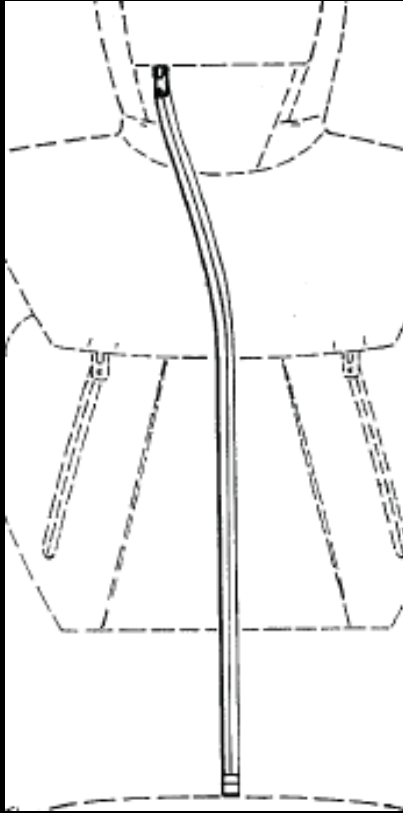


Accused
Design



Lowe Alpine DE356
Prior Art

Arc'Teryx Equip. v. Westcomb Outerwear (D. Utah Nov. 4, 2008)



715 Patented
Design

Court: An ordinary observer would be left with the impression that the 715 patent contains only two sections - straight and diagonal.

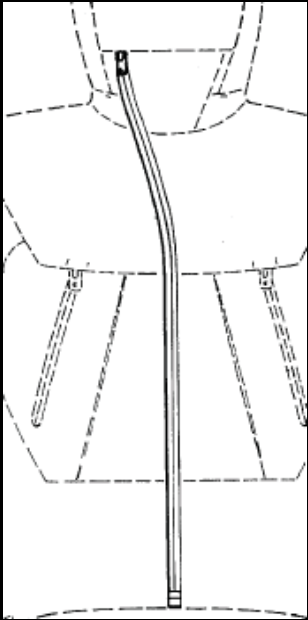
Arc'Teryx Equip. v. Westcomb Outerwear (D. Utah Nov. 4, 2008)



Accused
Design

Court: An ordinary observer of [the accused design] on the other hand would be left with the impression that the jacket contains three sections - straight, diagonal, and straight.

Arc'Teryx Equip. v. Westcomb Outerwear (D. Utah Nov. 4, 2008)



715 Patented
Design

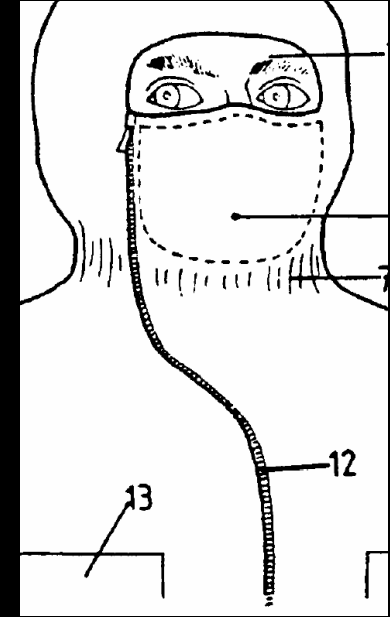


Accused
Design



Lowe Alpine

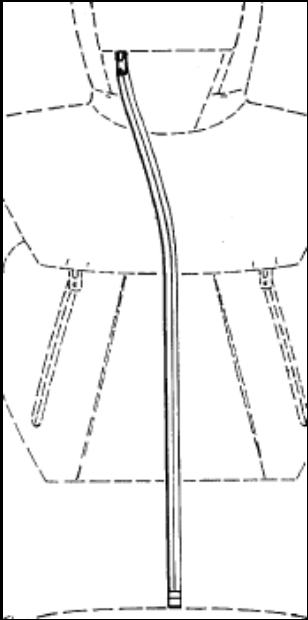
Prior Art



DE356

Court: The 715 patent is *much closer to* the Lowe Alpine jacket ... they both contain one straight and one diagonal section. The accused design *is similar to* the DE356 patent in that both contain a straight section, curving into a diagonal section, which curves into a 2nd straight section.

Arc'Teryx Equip. v. Westcomb Outerwear (D. Utah Nov. 4, 2008)



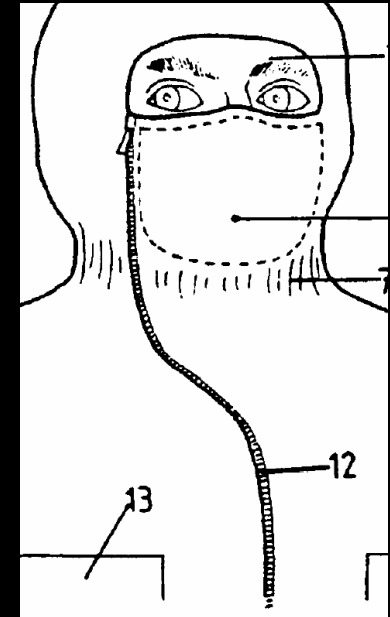
715 Patented
Design



Accused
Design



Lowe Alpine



DE356

Prior Art

3-way Visual Test: Both the patented design and the accused design were closer to the prior art than to each other, resulting in a holding on summary judgment of non-infringement.





Looks Matter...

Legally.®