
United States Court of Appeals
for the
Federal Circuit

LAWMAN ARMOR CORPORATION,

Plaintiff-Appellant,

v.

WINNER INTERNATIONAL, LLC,
and WINNER HOLDING LLC,

Defendants-Appellees.

*Appeal from the United States District Court for the Eastern District
of Pennsylvania in No 02-CV-4595, Senior Judge Robert F. Kelly*

BRIEF FOR *AMICUS CURIAE*
INDUSTRIAL DESIGNERS SOCIETY OF AMERICA IN
SUPPORT OF APPELLANT'S COMBINED PETITION FOR
PANEL REHEARING AND REHEARING EN BANC

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MARCH 24, 2006

CERTIFICATE OF INTEREST

Counsel for *Amicus Curiae*, the Industrial Designers Society of America, certifies the following:

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

Industrial Designers Society of America.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: **N/A.**

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or *amicus curiae* represented by me are: **None.**

4. There is no such corporation as listed in paragraph 3.

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

SAIDMAN DESIGNLAW GROUP
Perry J. Saidman

Industrial Designers Society of America
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March 24, 2006



Perry J. Saidman

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STATEMENT OF INTEREST OF *AMICUS CURIAE*

This brief is submitted by the INDUSTRIAL DESIGNERS SOCIETY OF AMERICA (IDSA), a national association of more than 3,300 industrial designers.

“Industrial design” refers to the profession of designing the form of a manufactured product. Such designers consider both the needs of the people using the product, as well as the industrial process that will produce it. Typically, industrial designers design the parts of a product with which humans interact. According to the Bureau of Labor Statistics, there are presently about 35,000 people who claim to work as industrial designers in the United States. Of the over 3,300 members of the IDSA, about half work as consultants and one third work as corporate employees.

An informal survey conducted in 2004 revealed that IDSA members, as a whole, held approximately 2,000 design patents. The protection afforded by these patents is of great concern to the IDSA, which has led it to step forward and address the threat posed to its members through the Panel decision.

In an Order dated March 17, 2006, the Court granted the IDSA leave to file this *amicus* brief on or before April 14, 2006.

SUMMARY OF THE ARGUMENT

For the first time, this Court has held that a combination of old elements shown in the prior art cannot constitute a point of novelty in determining infringement of a design patent. There are five reasons why it is exceptionally important for this holding to be reconsidered.

First, the Panel decision ignores the real world reality that all designs are combinations of old elements. If left to stand, the Panel decision would render a vast number of valid design patents unenforceable.

Second, the Panel's fear that permitting a combination of old elements to be a point of novelty would undermine the rationale of the point of novelty test is unfounded. If a valid patent's point of novelty were found to reside in a combination of old elements, the design patent would be narrow. To enforce it against an infringer who appropriated that same combination of old elements serves the interest of justice. There is nothing untoward about enforcing narrow, as well as broad, design patents.

Third, the Panel decision encourages "back door" attacks on design patent validity using a much lower burden of proof that would otherwise be required. Why should an infringer be permitted to prove that a patent's point of novelty, that distinguishes it over the prior art, is old using a preponderance of evidence

standard rather than a clear and convincing standard required of invalidity showings?

Fourth, there is no precedent for the Panel decision. All courts that have previously considered the issue have found that a combination of known elements may well constitute the point of novelty.

Fifth, the underlying factual determination that all 8 of Lawman's novel elements were found in the prior art is clearly erroneous. In order to anticipate a novel design element, the *visual appearance* of the design element must be in the prior art, rather than its functional attributes.

In sum, this Court should reconsider and reverse the Panel's conclusion that a combination of old elements shown in the prior art cannot constitute a point of novelty in determining infringement of a design patent.

I. THE PANEL DECISION DOES NOT TAKE INTO ACCOUNT THAT ALL DESIGNS ARE COMBINATIONS OF OLD ELEMENTS

The Panel decision is eerily reminiscent of the thoroughly discredited utility patent argument (stemming from the *A&P* case¹) that "old-elements-do-not-an-invention-make". See *Kayton on Patents*, 1979, pp. 5-12 et seq.

In the utility patent world, this argument was roundly and properly

¹ *A&P Tea Co. v. Supermarket Equipment Co.*, 340 U.S. 147, 87 U.S.P.Q. 303 (1950).

criticized:

Carried to its logical conclusion, the argument here would result in a rule to the effect that *A&P* precludes the patenting of virtually every new mechanical or electrical device, since the vast majority, if not all, involve the construction of some new device (or machine or combination) from old elements. *Reeves Instrument Corp. v. Beckman Instruments, Inc.*, 444 F.2d 263, 170 USPQ 74 (9th Cir. 1971).

As stated succinctly by this Court, “Virtually all inventions are combinations and virtually all are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983).

The same logic applies to design patents, since all designs are combinations of existing stylistic features (‘old elements’), many of which individually look the same as they always have. But it is their artful combination into an ornamental whole that is worthy of design patent protection, and is the reason that the design patent is granted in the first place. As always, competitors are free to use those existing stylistic features in whatever combination they desire, as long as it doesn’t look substantially the same as the patented design, and does not appropriate that which rendered it patentable in the first place, the so-called point of novelty.

II. THE PRACTICAL EFFECT OF LAWMAN’S THEORY WOULD NOT UNDERMINE THE “POINT OF NOVELTY” TEST

Analysis of design patent infringement is performed in two steps. After the court has interpreted the claim, the design must be compared to the accused design

to determine whether there has been infringement. This comparison is performed in two tests that are referred to as the “ordinary observer” test and the “point of novelty” test. The first test requires the accused design to be overall substantially the same in appearance as the patented design in the eyes of an ordinary observer. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871). The second test requires the accused design to have appropriated the point of novelty of the claimed design that distinguishes it from the prior art. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 U.S.P.Q. 97 (Fed. Cir. 1984). Both tests must be met in order to find infringement.

The ordinary observer test is applied by comparing the accused design to the entire claimed design as shown in the design patent drawings. No claimed ornamental design elements are excluded from the overall “substantially the same” analysis. Before the advent of *Markman*², this overall similarity test was fairly subjective.

If the overall similarity test is satisfied, then the point of novelty test is applied by first comparing the patented design to the prior art, and determining which design elements, of all the claimed ornamental design elements used in the overall similarity test, are indeed novel (i.e., not taught *visually*) in view of the

² *The Death of Gorham Co. v. White: Killing It Softly with Markman*, Saidman & Singh, 86 Journal of The Patent and Trademark Office Society (JPTOS) 792, October 2004.

prior art. In practice, the novel elements are generally far fewer than all of the claimed ornamental design elements. The subset of design elements that are in fact novel together constitute the “point of novelty” that distinguishes the design over the prior art and is presumably the reason the design patent was granted in the first place. The rationale of the point of novelty test is simply that, when it comes to infringement, the patentee cannot ignore that which permitted him to obtain his design patent in the first place. This test is much more objective than the overall similarity test. And, properly analyzed, almost always involves a combination of design elements.

If the point of novelty of a patented design happens to comprise a combination of elements that are individually ‘old’, that would not diminish or destroy the point of novelty test, because that same combination must still be found in the accused device in order for infringement to be made out.

If the point of novelty were in a combination of old elements, the scope of the design patent would presumably be relatively narrow. Competitors would not have to exercise much imagination in order to avoid such a design patent. However, if a competitor appropriates the very same combination of ‘old’ elements, in the same way as the patentee, then that competitor is an infringer, and society is served by enforcing the design patent, however narrow.

III. THE PANEL DECISION ENCOURAGES BACK DOOR ATTACKS ON PATENT VALIDITY COUCHED AS NON- INFRINGEMENT DEFENSES

If the combination of ‘old’ elements would have been obvious to a designer of ordinary skill (a position explicitly eschewed by Winner), then the design patent is likely invalid, and the competitor is free to copy the ‘old’ combination of elements. Under the Panel decision, without any holding of invalidity of the design patent claiming the ‘old’ combination, the infringer escapes liability with a much lower burden of proof. That is, the infringer escapes liability under the preponderance of evidence standard used for infringement determinations, rather than the clear and convincing standard required for invalidity holdings. This ‘back door’ attack on design patent validity should not be encouraged.

IV. THE PANEL DECISION CONFLICTS WITH THE WEIGHT OF AUTHORITY

Although the Court has held that the point of novelty can consist of a combination of elements³, until the *Lawman* case, it had not explicitly decided whether the point of novelty can consist of a combination of old or known elements.

³ *Litton Systems v. Whirlpool Corp.*, 728 F.2d 1423 (Fed Cir. 1984); *Avia Group Int’l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557 (Fed. Cir. 1988); *L.A. Gear v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993).

However, all of the district courts that have considered the issue have concluded that a combination of known elements may well constitute the point of novelty. In *Lakewood Eng'g & Mfg. Co. v. Lasko Metal Prods.*, 2001 U.S. Dist. LEXIS 13491 (N.D. Ill. 2001), the court stated:

In order to determine the '907's points of novelty, the court must examine prior art to determine how the '907 design differs from it. [citation omitted]. Examining the references to prior art that Lakewood has submitted, it does not appear that the elements of the '907 patent, in themselves, are novel....What is novel about Lakewood's '907 patent is its combination of all these elements to create a distinctive design.

The court in *Rockport Co., Inc. v. Deer Stags, Inc.*, 65 F.Supp.2d 189 (S.D.N.Y. 1999) said: "A unique combination of known elements can satisfy the point of novelty requirement", *id.* at 195. And in *Hosley Int'l Trading Corp. v. K Mart Corp.*, 237 F.Supp.2d 907 (N.D. Ill. 2002), the court found: "In appropriate circumstances, a combination of known elements may constitute a point of novelty." *Id.* at 913.

V. THE PATENTS CITED BY WINNER DO NOT DISCLOSE THE EIGHT "POINTS OF NOVELTY" THAT LAWMAN SPECIFIED

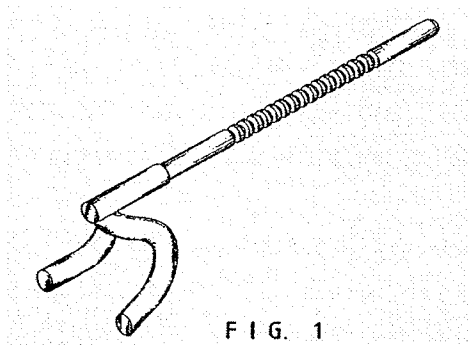
The Court erred in that the prior art relied upon by Winner did not in fact teach the 8 novel elements verbalized by Lawman.

The fundamental error was that the design elements in the cited prior art did not look like the novel elements claimed in Lawman's patent. Although the prior

art did teach the functional relationships recited in each verbalized novel element, it did not teach the *appearance* of such novel element as claimed in Lawman's patent.

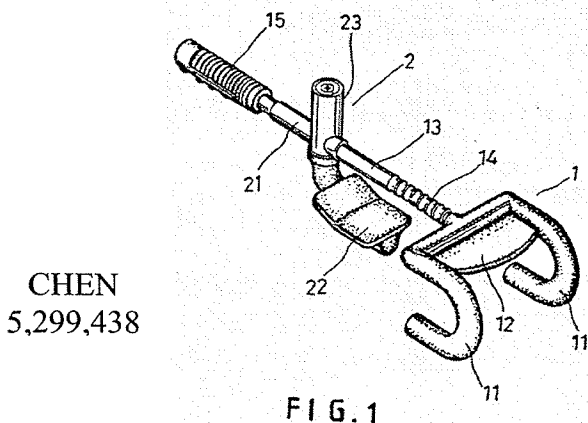
As one example, the first novel element from Lawman's design patent (U.S. Pat. No. Des. 357,621, shown below) was verbalized as:

"A sliding arm of a steering wheel locking device that includes a shaft with 2 hooks attached at approximately one end of the shaft."⁴



LAWMAN'S
U.S. PAT. NO. DES. 357,621

The district court found this design element to be shown in U.S. Pat. No. 5,299,438 to Chen, and in U.S. Pat. No. 5,197,308 to Pazik, illustrated below:



CHEN
5,299,438

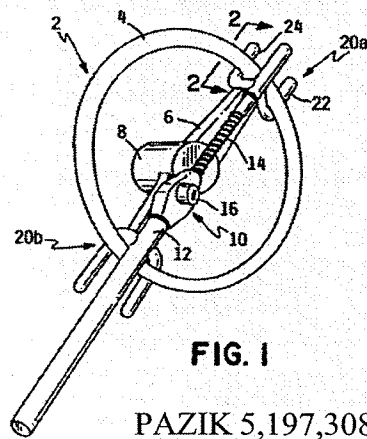


FIG. 1
PAZIK 5,197,308

⁴ *Lawman Armor Corp. v. Winner Int'l*, 2005 U.S. Dist. LEXIS 2078, *13 (E.D. Pa. February 15, 2005).

As can be seen, although both Chen and Pazik teach the verbalized functional relationship, neither teaches the *appearance* of this claimed novel element as it appears in the Lawman '621 patent.

It is settled law that in order to defeat a design patent's point of novelty, it is the *appearance* of the point of novelty that must be disclosed in the prior art, not the function. For example, in *Rockport Co., Inc. v. Deer Stags, Inc.*, 65 F.Supp.2d 189 (S.D.N.Y. 1999), the court, in considering the defendant's contention that the novel design elements were disclosed in the prior art, said:

Although these four shoes contain elements found in the '594 patent, the Court notes that the individual elements *differ in appearance* from those in the '594 patent and each of the four shoes has a different overall visual appearance than the '594 patent... Thus, the Court rejects Deer Stags' argument that the combination of elements found in the '594 patent fails to satisfy the point of novelty requirement because the same combination appears in the prior art. [emphasis added].

One cannot determine the presence or absence of a point of novelty by reading the verbalized language onto the prior art, as one might do in utility patent practice; instead, one must look for the *appearance* of the claimed element in the prior art. For this reason alone, the Panel decision should be reheard.

VI. CONCLUSION

For the foregoing reasons, this Court should grant the combined petition for rehearing.

Respectfully submitted,



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CERTIFICATE OF SERVICE

**United States Court of Appeals
For the Federal Circuit
No. 05-1253**

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I, John C. Kruesi, Jr., being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

I am retained by SAIDMAN DesignLaw Group, Attorney for Appellants.

That on the **24th day of March, 2006**, I caused 2 copies of the within **BRIEF FOR AMICUS CURIAE** in the above captioned matter to be served upon:

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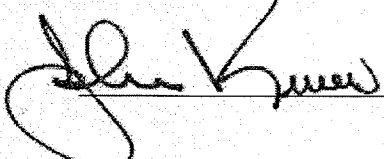
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March 24, 2006



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1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) because this brief contains 2221 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).
2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2003 in Times New Roman type style and a font size of 14.



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March 27, 2006