

No. 07-

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IN THE  
SUPREME COURT OF THE UNITED STATES

SAINT-GOBAIN CALMAR, INC.,  
(now known as MeadWestvaco Calmar, Inc.)  
*Petitioner,*

—v.—

ARMINAK & ASSOCIATES, INC.,  
HELGA ARMINAK and ARMIN ARMINAK,  
*Respondents.*

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On Petition for a Writ of Certiorari to the  
United States Court of Appeals for the Federal Circuit

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PETITION FOR WRIT OF CERTIORARI

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## QUESTIONS PRESENTED

To determine infringement of a design patent, this Court in *Gorham Co. v. White*, 81 U.S. 511, 528 (1871), created a test that expressly excluded expert viewpoints in favor of unsophisticated and general “ordinary observers” when considering the overall similarity of a patented design to an accused design. Since *Gorham*, and without further guidance from this Court, lower courts have reformulated the test to allow the ordinary observer to be an expert and also to force the ordinary observer, in some instances, to be only the first purchaser of a product embodying the design. The questions presented in this case are:

1. Whether the United States Court of Appeals for the Federal Circuit’s use of expert viewpoints to determine design patent infringement is in direct conflict with this Court’s decision in *Gorham Co. v. White*, 81 U.S. 511, 529 (1871)?
2. Whether the United States Court of Appeals for the Federal Circuit’s test for design patent infringement of a component product, which considers deceptive similarities only as to the first purchaser of any product including the patented design, directly conflicts with its own precedent and with this Court’s “ordinary observer” test mandated by *Gorham Co. v. White*, 81 U.S. 511, 529 (1871), by excluding not only unsophisticated purchasers but also later purchasers of products including the patented design as a component?

**LIST OF PARTIES**

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Petition for a Writ of Certiorari.

**CORPORATE DISCLOSURE STATEMENT**

Counsel for petitioner certifies as follows:

All patent corporations and publicly held companies that own ten (10) percent or more of petitioner Saint-Gobain Calmar, Inc. (now known as MeadWestvaco Calmar, Inc.) are as follows: Saint-Gobain Calmar, Inc. (now known as MeadWestvaco Calmar, Inc.) is a wholly-owned subsidiary of MeadWestvaco Corporation.

Petitioner notes that MeadWestvaco Corporation acquired Saint-Gobain Calmar, Inc. after the filing of a Notice of Appeal from the district court's decision to the United States Court of Appeals for the Federal Circuit.

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## OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is reported at 501 F.3d 1314 (Fed. Cir. 2007) and is set forth in the Appendix (“App.”) at App. 1a-23a. The circuit’s order denying the Combined Petition for Panel Rehearing and Rehearing *En Banc* (App. 60a-62a) is unreported. The decision of the district court is reported at 424 F. Supp. 2d 1188 (C.D. Cal. 2006) and is set forth at App. 24a-59a.

## STATEMENT OF JURISDICTION

The United States Court of Appeals for the Federal Circuit entered its judgment in this case on September 2, 2007, and denied the Combined Petition for Panel Rehearing and Rehearing *En Banc* on December 5, 2007. Chief Justice Roberts issued an order on February 27, 2008, extending the time to file the petition for a writ of certiorari to April 3, 2008 (Docket No. 07A709). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

## STATUTES AND REGULATIONS INVOLVED

This case involves provisions of the Patent Act, 35 U.S.C. § 101, *et seq.*, and specifically those directed to the infringement of design patents. 35 U.S.C. § 171 entitled “Patents for Designs” is set forth at App. 63a. 35 U.S.C. § 271 entitled “Infringement of Patents” is set forth at App. 64a-69a. 35 U.S.C. § 289 entitled “Additional Remedy for Infringement of Design Patent” is set forth at App. 70a.

## STATEMENT OF THE CASE

Unlike utility patents that cover “any new and useful process, machine, manufacture, or composition of matter” (35 U.S.C. § 101), design patents specifically protect “any new, original and ornamental design for an article of manufacture” (35 U.S.C. § 171, App. D). Patented designs are intended to be part of products sold in the marketplace, whether they relate to product shape, configuration, or surface ornamentation. The United States Patent and Trademark Office has issued patents for a variety of designs, including golf carts,<sup>1</sup> razor and umbrella handles,<sup>2</sup> automobile grilles,<sup>3</sup> computer icons,<sup>4</sup> and even the Statue of Liberty.<sup>5</sup> Some of those designs—like handles and automobile grilles—while themselves separate articles are generally intended by their inventors to be inseparable from or sold as parts of larger, more complex products.

This Court first considered design patent infringement in 1871, when it set forth a straightforward test—the “ordinary observer” test—that predicated infringement upon substantial or deceptive similarities between designs as seen by non-expert, layman purchasers and users of products including the designs. Since then, the Court of Appeals for the

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<sup>1</sup> *See, e.g.*, U.S. Design Patent No. D437,097 S (filed Mar. 22, 2000).

<sup>2</sup> *See, e.g.*, U.S. Design Patent Nos. D541,477 S (filed June 8, 2006) and D551,845 S (filed Oct. 5, 2006).

<sup>3</sup> *See, e.g.*, U.S. Design Patent Nos. 283,019 (filed June 17, 1985) and D519,066 S (filed Feb. 10, 2005).

<sup>4</sup> *See, e.g.*, U.S. Design Patent Nos. 405,775 (filed Aug. 18, 1997) and 445,426 S (filed Mar. 17, 2000).

<sup>5</sup> U.S. Design Patent No. D11,023 (filed Jan. 2, 1879).

Federal Circuit has significantly curtailed the scope of protection afforded owners of design patents by changing the identity of the ordinary observer. Resolution of the questions presented here will allow this Court to restore value to design patents by reasserting the test for infringement it created more than 130 years ago.

The identity of the ordinary observer now depends upon the stream of commerce in which the first product including the patented design travels. For example, the present case involves a design patent on a trigger sprayer shroud, intended to be part of a standard sprayer that can be attached to a bottle and used to dispense household cleaners and other liquids. The trigger sprayer with shroud was first sold to manufacturers and marketers of the household cleaners who are very discerning and experts at distinguishing one sprayer and shroud from another, and thus less likely to be deceived by any similarities in design. Those experts then ultimately sell to a mainstream consumer who is unlikely to distinguish between sprayers and shrouds, and thus more likely to be deceived by similarities.

As a result, the ordinary observer, instead of a non-expert everyman faced with possible deception between similar designs in the marketplace, may now be only sophisticated middlemen tasked with distinguishing between those designs as part of their everyday work. Selecting that viewpoint for infringement contravenes this Court's express precedent and all but guarantees a factual finding of no infringement, since many products' first buyer is such an expert middleman that would not be deceived.

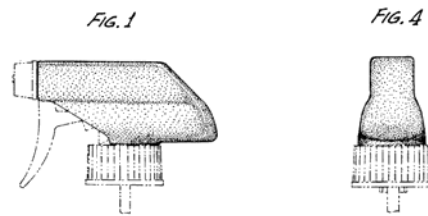
To find design patent infringement the Federal Circuit also requires passing a separate points of novelty test, which generally dissects the patented design into those features that make it novel and non-obvious over prior art designs and rigidly scrutinizes the accused design for the presence of those novel features. Originally intended only to ensure that any deceptive similarities seen by the ordinary observer were attributable to the novel features of the patented design, now this test may consider the entire design, muddling its own purpose and conflicting with the focus on the entirety of the designs only appropriate under the ordinary observer test.

The transformation of the design patent infringement test squarely conflicts with this Court's century-old precedent and threatens to interfere with patent owners' ability to fairly protect their novel designs. As a practical matter, thousands of valid, enforceable patents for designs are undermined simply because the first products to incorporate them are sold to a sophisticated middleman or are otherwise combined into a larger product—rendering a finding of no infringement under the current ordinary observer test a virtual certainty. And all design patents suffer from the additional hurdle of a point of novelty test that considers the entire design, like the ordinary observer test, but under a wholly different standard. The current disarray in infringement standards undermines the value of current design patents and the potential investment in new, innovative designs for future products.

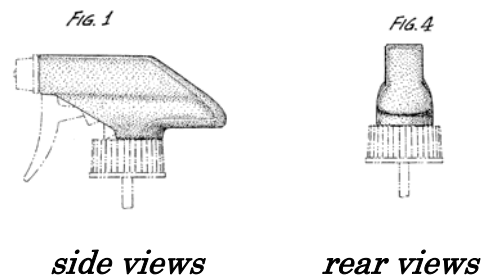
## I. The Patents-in-Suit

This is a patent infringement action in which Saint-Gobain Calmar, Inc. (now known as MeadWestvaco Calmar, Inc.) (“Calmar”) seeks to enforce U.S. Design Patent Nos. 381,581 (the “581 Patent”) and 377,602 (the “602 Patent”), both entitled “Sprayer Shroud.” A sprayer shroud covers the trigger pumping mechanism commonly found on bottles of household cleaner, such as Windex® and 409®.<sup>6</sup> As is the case with any design patent, the protected invention is described and claimed not with words but with pictures. Figures 1 and 4 of the ’581 and ’602 Patents reveal in large part Calmar’s claimed designs:

### The ‘581 Patent



### The ‘602 Patent




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<sup>6</sup> The shrouds do not include the nozzles, triggers, screw caps, or dip tubes shown in dashed lines; those features form no part of the claimed design and are depicted for illustrative purposes only.

Calmar sells an embodiment of the '581 Patent called the ERGO® shroud. Calmar has not sold any product with the design depicted by the '602 Patent.

## II. Factual Background and the Infringement

Calmar is one of the largest manufacturers of liquid dispensers, such as pump sprayers and trigger sprayers, which are used in countless industrial, pharmaceutical, and household applications. It sells the TS800® trigger sprayer—the best selling trigger sprayer in the world—which may be covered with a variety of shrouds, including the ERGO® shroud claimed by the '581 Patent. A variety of companies that manufacture liquid products purchase Calmar's trigger sprayers to integrate into their retail packaging. Those companies' final products then travel through a variety of chains of commerce for eventual sale to retail purchasers in a variety of locations, like grocery stores and Wal-Mart®.

Respondents Arminak & Associates, Inc., Helga Arminak, and Armin Arminak (collectively "Arminak") also sell trigger sprayers to companies and individuals selling liquid products on the retail market. One of its trigger sprayers is known as the "AA Shroud," which is shown in the following pictures:



In the fall of 2004, Calmar sent a cease-and-desist letter to an Arminak customer engaged in the packaging and sale of retail products including the AA Shroud, believing that the shroud infringed the '581 and '602 Patents. Arminak filed suit in the Central District of California for a declaratory judgment of non-infringement. Calmar counterclaimed for patent infringement. Arminak later amended its complaint to allege patent invalidity and also add several non-patent causes of action, including unfair competition, intentional interference with prospective economic advantage, and trade libel.

### III. The Decision of the Trial Court

Before the close of fact discovery, Arminak moved for partial summary judgment under Fed. R. Civ. P. 54 on the issue of non-infringement. Calmar opposed, alleging the existence of genuine issues of material fact that precluded entry of summary judgment. In March 2006, after briefing and oral argument, the district court (Carney, J.) granted Arminak's motion. Specifically, the court held both the '581 and '602 Patents not infringed on the grounds that neither the ordinary observer test nor the points of novelty test were met by Arminak's AA Shroud.

As an initial matter, and in accordance with Federal Circuit and this Court's precedent, the district court construed the claims of the '581 and '602 Patents. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996); *see OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1404-05 (Fed. Cir. 1997) (construing the claim of a design patent before determining

infringement).<sup>7</sup> The district court issued a lengthy construction of the figures from the '581 and '602 Patents, precisely detailing in words its understanding of those drawings. App. 32a-36a.

The district court then proceeded to the infringement analysis under both the ordinary observer and the points of novelty tests. App. 38a. In determining the identity of the ordinary observer, the court noted that “the focus of the ‘ordinary observer’ test ‘is on the actual product that is presented for purchase, and the ordinary purchaser of that product’” (*id.* (quoting *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998))) and recognized that no one purchases the patented shroud by itself—it is only sold as part of a larger assembled trigger sprayer.

Then, “[t]he question is whether, where a patented article is only sold to consumers as incorporated into a larger product, the ‘ordinary observer’ is the consumer or the upstream purchaser of the patented item.” App. 39a. After reviewing two Federal Circuit decisions, and two unpublished, non-precedential decisions from other districts, the court declared that ordinary

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<sup>7</sup> Applicant notes that, after rendering its decision in this case, the Federal Circuit granted rehearing *en banc* of its decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 2006-1562 (Fed. Cir. Aug. 29, 2007), in part to address the following question: “Should claim construction apply to design patents and, if so, what role should that construction play in the infringement analysis? See *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).” While Applicant argued below that the district court and the Federal Circuit improperly construed the claims of the '581 and '602 Patents, Applicant does not seek certiorari on the precise question of whether any construction of those design patents was *per se* improper before assessing infringement.



observers must be corporate buyers of trigger sprayers and excluded any retail consumers of trigger sprayer products: “Although an end user necessarily obtains the shrouds when she buys the complete household product, she is not the ‘ordinary observer’ because she purchases a product into which the patented item is incorporated.” App. 43a-44a. The court also set forth its reasoning to distinguish *Gorham*:

*Gorham’s* statement that experts should not be the ordinary observer where they are not the buyers of the relevant product does not preclude sophisticated buyers from being the ordinary observer where they are the only ones who purchase the patented product directly.

App. 46a-47a. With that determination, the district court did not consider Calmar’s evidence showing that retail consumers and less sophisticated corporate purchasers would be confused between Arminak’s AA Shroud and the claimed designs, relying instead only on evidence showing that certain expert purchasers of trigger sprayers would not be confused. App. 47a-56a. Thus, the court found that there was no infringement under the ordinary observer test.

Next, the court addressed the point of novelty test.<sup>8</sup> Arminak did not contest, and the court adopted, Calmar's asserted two points of novelty in the '581 and '602 Patents: the prominent horizontal line on each side of the shroud and the "bulbous" rear of the shroud. App. 56a. But the court found those two features "do not create an overall impression of similarity" (*id.*), as the horizontal lines and bulbous rears present in Arminak's AA Shroud were "significantly dissimilar" from Calmar's designs (App. 57a).

Because the evidence did not create genuine issues of material fact under the court's understanding and application of both the ordinary observer test and the points of novelty test, the district court granted summary judgment of non-infringement.

#### **IV. The Decision of the Federal Circuit**

On appeal, the Federal Circuit panel affirmed the district court's grant of summary judgment. First, the panel found no error in the district court's multi-page recitation of the patented designs' individual features as part of the required claim construction: "Our case law does not prohibit detailed claim construction of design patent drawings." App. 9a.

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<sup>8</sup> The Federal Circuit's *en banc* review of the *Egyptian Goddess* case (*supra*, n.7) also addresses the point of novelty test, including whether that test should be extinguished and, if not, whether the overall appearance of a design should be permitted as a point of novelty. Applicant does not request certiorari on any direct questions regarding the point of novelty test, but only as it may impact the ordinary observer analysis. The *Egyptian Goddess* review does not address the ordinary observer test.

The Federal Circuit then turned to the “central” question of the identity of the ordinary observer. App. 10a. The court recognized that finding the non-expert, retail purchaser of end-products (like cleaning solutions) as the ordinary observer would enhance Calmar’s infringement position:

If the ordinary observer is found to be the retail consumer that purchases the shroud of the trigger sprayer device as it is incorporated into a retail product, then it is much more likely that the ordinary observer would find substantial similarities between the patented and accused designs sufficient to be deceived into thinking that Arminak’s AA Trigger shroud is one of the patented designs.

App. 10a. But the court also recognized that finding the sophisticated, corporate purchaser of intermediate products (like trigger sprayers) to be the ordinary observer supported a finding of non-infringement:

If the ordinary observer is the contract buyer or industrial purchaser of trigger sprayers, then the undisputed material facts in the record establish that such a purchaser would not find substantial similarity between the patented and accused shrouds,<sup>9</sup> and therefore would not be deceived into thinking that

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<sup>9</sup> Calmar does not agree that all facts support this conclusion, at least because of uncredited evidence showing possible deception of less sophisticated corporate purchasers. *See, supra*, at 9.

Arminak's AA Trigger shroud is one of the patented designs.

App 11a. After reviewing this Court's *Gorham* decision, the Federal Circuit found an "unanswered question:" whether ordinary observers "can be commercial or industrial buyers of designed items that are used as component parts assembled into a retail product." App. 12a. Citing its own precedent, as well as a prior regional circuit case and two unreported district court decisions, the Federal Circuit held that the ordinary observer must be only the commercial or industrial buyer (App. 16a), even though it never acknowledged that those buyers were experts whose job is to distinguish between shroud designs. Thus, the court agreed with the district court's decision that Arminak's AA Shroud did not pass the ordinary observer test. App. 17a-18a.

The Federal Circuit also agreed with the district court's application of the points of novelty test. First, the appeals court found that the Arminak AA Shroud's horizontal line resulted "in a different overall design appearance than Calmar's." App. 20a. The court also found that "no reasonable jury could find that the back of Arminak's AA Trigger shroud . . . appropriates Calmar's second point of novelty" (App. 22a), the bulbous rear. Summary judgment was affirmed.

### **REASONS FOR GRANTING THE PETITION**

This Court set forth the definitive test for design patent infringement more than one hundred years ago in *Gorham Co. v. White*, 81 U.S. 511 (1871). That case provided a single, objective test based on whether an ordinary observer—a non-expert, everyman retail

purchaser and user of products—would be deceived into buying one product while thinking she was buying another based upon substantial similarities in the designs. This Court specifically found expert opinions not probative of infringement, since their trained eyes could easily perceive and distinguish between even minor differences in designs, while ignoring potential confusion seen by the public at large when viewing the entirety of the designs.

Since that time, Congress has made no substantive amendment to any provision regarding the scope or infringement of design patents and this Court has not revisited any question regarding the scope of design patents or the ordinary observer test. *Gorham's* standard should remain as complete and effective today as it did under the patent laws of 1871.

Yet the current test is significantly different. The Federal Circuit has modified and added to the ordinary observer test, without any endorsement by this Court, making it increasingly and unnecessarily difficult to infringe valid and enforceable design patents.

The ordinary observer still survives but, as most tellingly shown by this case, the Federal Circuit has allowed experts—the very persons whose viewpoints were flatly rejected in *Gorham*—to represent the “ordinary observer.” That basis for infringement is as incorrect today as it was when this Court reversed that same holding by a district court in 1871.

The Federal Circuit's improper changes over time to the ordinary observer test foretold the erroneous and problematic holding in this case. The ordinary observer in *Gorham* represented the public at large,

who encounter designs in the marketplace and perhaps use them to distinguish between products. But infringement hinges now on an attempt to identify the ordinary observer as a particular person or class of people—a purchaser only of truck tires, a purchaser only of wall stones, a purchaser only of trigger sprayers. Specifying an exact ordinary observer begs the very expertise this Court rejected in *Gorham*.

The ordinary observer as a particular person also incorrectly excludes others who may purchase, view, or use products and be deceived by substantial similarities in their designs, as well as purchasers and users of more complex products incorporating an original product bearing the claimed design. Design patents fairly cover the ornamental nature of a spectrum of products and the test for infringement should not unfairly penalize a patent depending upon the type of product or its usual purchaser.<sup>10</sup>

The ordinary observer test is further confounded by the current application of the points of novelty test, a

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<sup>10</sup>The trademark “likelihood of confusion” test is dependent upon, *inter alia*, the type of mark, the stream of commerce, and the sophistication of consumers purchasing the products. *See, e.g., Payless Shoesource, Inc. v. Reebok Int’l Ltd.*, 998 F.2d 985 (Fed. Cir. 1993) (discussing and applying Tenth Circuit standards for trademark infringement). The ordinary observer test is not dependent upon those factors and the Federal Circuit has recognized that design patents and trademarks are governed by different infringement tests. *See Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986) (“Concluding that a purchaser is unlikely to be confused by a similarity in a competitor’s product only serves to blur the otherwise clear line that exists between the test for infringement of a design patent and the ‘likelihood of confusion’ test for infringement of a trademark.”).

separate requirement for design patent infringement. Under this inquiry, courts analyze the claimed design for those individual attributes that make it novel over the prior art, and then analyze the accused design for the presence or absence of those attributes. By allowing this test to consider “overall impressions of similarity” and “overall design appearances,” the Federal Circuit has endorsed an application that is fundamentally at odds with the ordinary observer’s focus on the entirety of the designs.

This Court should grant Applicant’s petition for a writ of certiorari to correct any one or all of those inappropriate changes to the *Gorham* test for design patent infringement.

## **I. The Federal Circuit Misconstrued *Gorham***

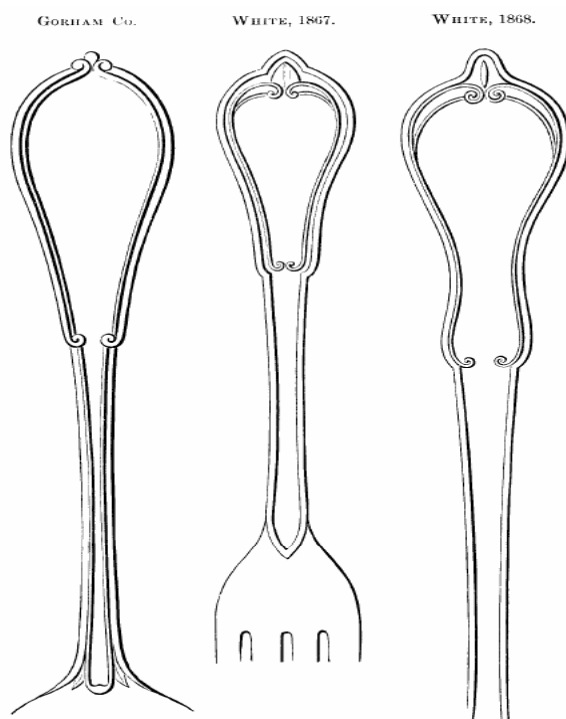
In *Gorham*, this Court ruled that only the viewpoint of an “ordinary observer”—and not an expert in the design field at issue—was relevant in determining design patent infringement. The Federal Circuit in this case expressly held that the ordinary observer was the expert, industrial purchaser of trigger sprayers including the patented shroud design. This Court should reverse the Federal Circuit’s disregard for *Gorham*’s express holding against predicating non-infringement on the opinion of experts.

### **A. *Gorham* Rejected Point-by-Point Comparisons and Expert Viewpoints**

This Court’s decision in *Gorham Co. v. White*, 81 U.S. 511 (1871), is short and simple. Yet its

undeniable pertinence and striking comparison in both facts and law to this case warrants a brief summary.

Gorham filed suit in the Circuit Court for the Southern District of New York alleging infringement of its Design Patent No. 1,440 entitled “Spoon and Fork Handle” by “spoons and other articles” bearing two of White’s handle designs. *Gorham Mfg. Co. v. White*, 10 F. Cas. 827, 828 (C.C.S.D.N.Y. 1870) (No. 5,627). This figure depicts the Gorham design on the left and the two allegedly infringing White designs on the right:



*Gorham*, 81 U.S. at 521. The district court heard evidence from both parties regarding the similarity of the designs. The defendant presented testimony from tradesmen and others that the products were



“substantially different, both in shape and design.” *Id.* at 518 (quotation omitted). The plaintiff presented evidence that retail consumers would be deceived, in sum: “A large number of witnesses, familiar with designs, and most of them engaged in the trade, testified that, in their opinion, there is no substantial difference in the three designs, and that ordinary purchasers would be likely to mistake the White designs for the ‘cottage’ (viz., that of the plaintiffs).” *Id.* at 530; *see also id.* at 513-519 (recounting witnesses’ direct testimony, including Mr. C.L. Tiffany, head of Tiffany & Company).

Finding it “impossible to assent to the view, that the test in regard to a patent for a design is the eye of an ordinary observer,” the district court held that infringement had to be judged from the viewpoint of:

a person versed in the business of designs in the particular trade in question . . . a person engaged in the manufacture or sale of articles containing such designs . . . a person accustomed to compare such designs with another, and who sees and examines the articles containing them side by side.

*Id.* at 523. With the expert viewpoint focused only on specific differences, the district court credited only White’s evidence showing no substantial similarities between the designs at issue and entered judgment of non-infringement.

This Court disagreed entirely. After recognizing design patent law “contemplates that giving certain new and original appearances to a manufactured

article may enhance its salable value” (*id.* at 525), *Gorham* explained that the entire design, and not individual differences, should control the inquiry:

Plainly, [the true test of identity of design] must be sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if sufficient to change the effect upon the eye, will not destroy the substantial identity.

*Id.* at 526-27. In determining in whose “eye” the identity of appearance was to be analyzed, this Court rejected the district judge’s reliance on experts:

With this we cannot concur. Such a test would destroy all the protection which the act of Congress intended to give. There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them. . . . Experts, therefore, are not the persons to be deceived.

*Id.* at 527-28. Instead, the proper viewpoint was to be that of “observers of ordinary acuteness” (*id.* at 528), leading to a succinct conclusion:

We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if

the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

*Id.* at 528. As the evidence below overwhelmingly showed that those ordinary observers would be deceived by substantial similarities between the Gorham and White designs, this Court reversed and directed the district court to enter judgment of infringement.

**B. The Federal Circuit Improperly Based Infringement upon Experts' Viewpoints**

This Court ruled in *Gorham* that only the viewpoint of an “ordinary observer,” and not an expert in the design field at issue, was relevant in determining design patent infringement. 81 U.S. at 528. Indeed, *Gorham* rejected a description of the ordinary observer strikingly similar to that adopted by the Federal Circuit in this case. The proper infringement viewpoint was found to be from “ordinary observers,” i.e., those unskilled, casual, “customers who buy silverware” from dealers, even though the products of interest were made and first sold to wholesalers, retailers, and other middlemen. *Id.* at 528, 530.

In short, the Court predicated infringement on the viewpoint of ordinary observers—the customers of Tiffany & Company and not Mr. Tiffany himself. *See id.* at 514, 530. The ordinary observer was the end purchaser from the retailer, not the retailer purchasing from the manufacturer or a middleman.

The Federal Circuit missed that critical distinction and improperly concluded that “[t]he unanswered question remaining after *Gorham* is whether these ‘ordinary observers’ of which the Supreme Court spoke can be commercial or industrial buyers of designed items that are used as component parts assembled into a retail product.” App. 12a. But *Gorham* did, in fact, answer that question long ago—holding that such expert buyers cannot be the basis for design patent infringement.

Far from answering a question left open by *Gorham*, the Federal Circuit’s holding directly contravenes this Court’s express admonition against reliance on experts’ viewpoints and should be reversed.

The Federal Circuit admitted that *Gorham* “expressly excluded experts from the category of persons who are ordinary observers.” App. 11a. But the court never acknowledged that the commercial or professional buyers it chose as “ordinary” observers are undeniably experts in their fields. *See* 16a-18a (“[t]here is essentially no question that a corporate buyer purchasing these trigger sprayers with these specific shrouds would be able to tell the difference easily”) (quotation omitted). Indeed, they are exactly the individuals “versed in the business of designs in the particular trade in question” or “engaged in the manufacture or sale of articles containing such designs,” who *Gorham* cautioned should not be considered ordinary observers. 81 U.S. at 527. And the court’s use of those experts as ordinary observers has, as this Court envisioned, “would destroy all the protection which the act of Congress intended to give.” *Id.*

Even Arminak admits that the typical corporate shroud buyer who purchases from Calmar is “a sophisticated professional” (Br. of Appellees to the Federal Circuit dated Jan. 22, 2007, at 21) who is “discerning” and able to recognize even “an insignificant visual difference in different shrouds” (*id.* at 23n.7). Moreover, they are members of the trade engaged in the manufacture or sale of articles containing the claimed design. *Id.* at 8. They are largely accustomed to seeing sprayer shrouds side-by-side and comparing shroud designs with one another; indeed, their purchases are carefully researched and may take months to secure and finalize. *Id.* at 47. With their skills and position, those professional buyers are never in danger of being deceived by substantial similarities between designs. They are experts well-versed in the designs of their trade and engaged in the manufacture or sale of articles containing the designs.

By improperly adopting experts as “ordinary” observers in this case, however, the Federal Circuit easily found no infringement. *See* App. 16a-18a. The Federal Circuit thus confirmed this Court’s prediction in *Gorham* that, when expert viewpoints are used to determine infringement, “[t]here never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them.” 81 U.S. at 527. That Calmar’s sophisticated, expert customers may recognize a difference between Calmar’s patented designs and the Arminak AA Shroud should be legally irrelevant, just as Mr. Tiffany’s and his tradesmens’ expert opinions that they would not be deceived were considered irrelevant to

the *Gorham* Court. Experts are not “ordinary” observers.

Under *Gorham*, the Federal Circuit should not have chosen the expert professional purchasers whose viewpoints erroneously supported non-infringement under the ordinary observer test. The focus on ordinary observers—unsophisticated end users and purchasers of goods incorporating the patented design—is as valid today as it was in 1871. Otherwise, nothing less than complete identity between patented and accused designs would be required for infringement. That is simply not a workable test.

## **II. The Ordinary Observer Should Not Be Only the First Purchaser of a Product Including the Patented Design**

The Federal Circuit’s conclusion that only the first purchaser of a product including the patented design can be considered the ordinary observer compelled the court to select expert purchasers despite *Gorham*’s admonition. App. 16a. That decision not only violates *Gorham*, but also conflicts with prior holdings of the Federal Circuit.

### **A. Selection of the First Purchaser Conflicts with *Gorham***

The facts of *Gorham* reflect the basic stream of commerce in which most goods travel. *Gorham* sold its silverware including the patented handle designs to various middlemen, like Tiffany and Company and others, who eventually resold the silverware to end consumers and purchasers. The first purchasers of the products, the buyers for Tiffany and Company, were

not the ordinary observers, as they were “engaged in the manufacture or sale of articles containing such designs” and “versed in the business of designs in the particular trade in question.” *Gorham*, 81 U.S. at 527 (emphasis added). Instead, the less sophisticated end consumers were the proper ordinary observers.

Trigger sprayers follow a similar path. Calmar sells its trigger sprayers including the patented shroud designs to various middlemen, like Proctor and Gamble and others, who eventually resell the trigger sprayers as key parts of their products to end consumers and purchasers. The first purchasers of the products, the buyers for Proctor and Gamble, should not be the ordinary observers, as they are “engaged in the manufacture or sale of articles containing such designs” and “versed in the business of designs in the particular trade in question.” *Gorham*, 81 U.S. at 527 (emphasis added). Instead, the end consumers should properly be the ordinary observers.

The parallel between the facts of *Gorham* and this case highlights the danger of picking as the ordinary observer the technical “first purchaser” of a product including the patented design. Often, that first purchaser will be a sophisticated middleman or other buyer who is an expert in the field of the designs. Experts cannot be “ordinary” observers, as they will most always be able to distinguish between designs and never deceived into buying one item for another.

**B. Selecting the First Purchaser Also  
Conflicts with Federal Circuit  
Precedent**

The Federal Circuit’s opinion in this case also conflicts with its own precedent. The Court of Customs and Patent Appeals<sup>11</sup> has clearly held that a design patent can be for only a portion of a product and need not cover the entire product. *In re Zahn*, 617 F.2d 261, 267 (C.C.P.A. 1980) (“a design for an article of manufacture may be embodied in less than all of an article of manufacture”). Whether the design patent is for an entire product or for only a component product should be of no consequence to the infringement analysis. Indeed, this Court in *Gorham* did not consider fork tines or spoon bowls when analyzing the patented designs for silverware handles. Differences in those additional features could easily extinguish any deceptive similarities between the overall products, but were irrelevant to any infringement determination since they were not part of the patented design.

In *Contessa Food Prods., Inc. v. Conagra, Inc.*, the Federal Circuit vacated a district court’s holding applying the ordinary observer analysis to only the product available at the point of first sale, and held that the ordinary observer analysis must extend to all ornamental features visible during normal use of the product, from completion of manufacture through first sale, use, and final destruction, loss, or disappearance of the article. 282 F.2d 1370, 1380-81 (Fed. Cir. 2002).

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<sup>11</sup> The Federal Circuit has adopted precedents of the Court of Customs and Patent Appeals as binding on the court. *See South Corp. v. U.S.*, 690 F.2d 1368, 1369-70 (Fed. Cir. 1982) (en banc).



In this case, the Federal Circuit attempted to distinguish *Contessa* as referencing the design features that must be considered during the ordinary observer analysis, and not the identity of the ordinary observer. App. 15a. But *Contessa* clearly held the ordinary observer analysis is not limited to only the point of first sale (*id.* at 1381), as would be required for identifying only the first purchaser as the ordinary observer. *Contessa* also specified that the ordinary observer analysis must include an analysis of all features of the patented design. To appreciate all design features, ordinary observers may include those far removed from the initial purchase and point of sale, including subsequent buyers and users.

Likewise, the Federal Circuit's infringement inquiry in *Braun Inc. v. Dynamics Corp. of America* focused on the perception and purchasing habits of retail consumers of hand blenders, not on the perception of corporate department store buyers and resellers of the patented and accused product. 975 F.2d 815, 820 (Fed. Cir. 1992). The *Braun* court expressly recognized that the jury represented a "sampling of ordinary observers." *Id.* at 821. As in *Braun*, there is no dispute here that Calmar designed the claimed shrouds for the intended use and benefit of the end retail purchasers and user. A jury of those "ordinary observers" would have been appropriate in this case, instead of entering summary judgment based upon evidence of improper expert viewpoints.

In *Goodyear*, the Federal Circuit found the proper ordinary observers to be truck drivers and fleet operators who were the end purchasers and users of the tires that incorporated the patented tread design. 162 F.3d at 1117. Tellingly, the *Goodyear* court did

not select tire buyers for truck manufacturers, who first included tires on their trucks, or the buyers for a national tire chain who first buy tires for resale to the public. *Goodyear* made clear that “the focus is on the actual product that is presented for purchase, and the ordinary purchaser of that product” (*id.*), even when the product being purchased by the consumer merely incorporates the design (i.e., the tread) as a subpart of the commercial product (i.e., the complete tire with sidewalls, lettering, etc.).

*Goodyear* reveals the Federal Circuit’s inclination to define ordinary observers as a particular class of people—truck drivers—while *Contessa* and *Braun* indicate that the proper ordinary observer is simply a member of the general public or an ordinary juror. That the Federal Circuit relied on *Goodyear* in this case to select only first purchasers as ordinary observers is no surprise. App. 12a-13a (also relying on *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993), which found the ordinary observer to be only “a purchaser of the patented block”). Restricting the ordinary observer to only a specific class of observers begs the improper use of expertise this Court rejected in *Gorham*, and excludes others who may purchase and use the products and be deceived by substantial similarities between designs. This conflict should be resolved in favor of a more general ordinary observer, a member of the public at large who may purchase and use the designs to distinguish between products, the standard set forth in *Gorham*.

Neither *Gorham* nor the Federal Circuit’s own precedent supports the selection of only the first purchaser of a product including the patented design.

### **III. The “First Purchaser” Requirement Fosters Arbitrary and Inappropriate Infringement Findings**

In departing from the standards set forth in *Gorham* and those applied in its cases like *Contessa*, *Braun*, and *Goodyear*, the Federal Circuit has shifted the infringement inquiry away from the end consumer and created a rule that alters the infringement analysis based on the vagaries of who owns the patent, the patented subject matter, and the stream of commerce.

#### **A. The Infringement Test Should Not Change Depending on the Patent**

Ownership of the patent, or the patentee’s place within the stream of commerce, should have no effect on the infringement analysis. As an example, if one of Calmar’s customers (such as Procter & Gamble) owned a design patent directed to trigger sprayer shrouds, it could contract with Calmar to manufacture and supply trigger sprayers with the patented shroud. The customer would then attach the sprayer to a bottle of cleaning fluid and sell or supply it to an eventual end consumer. The “first purchaser” and ordinary observer in that case would be the end consumer, who may be deceived by substantial similarities between the patented shroud and Arminak’s AA Shroud (as the evidence showed in this case). The Federal Circuit would endorse the finding of infringement under the ordinary observer test merely because Procter & Gamble, and not Calmar, owns the patents. The patent laws should not support wholly different infringement tests and findings based merely upon who owns the patents at issue.

Nor should the infringement analysis be any different for patents covering different types of designs. As noted earlier, design patents properly cover not only entire products, like golf carts and statues, but also component parts, like umbrella handles and automobile grilles. The statutory provisions for infringement—35 U.S.C. § 271 (App. E) and § 289 (App. F)—do not depend at all on the type of design patented, or on the type of product to which the patented design is applied. Design patents to component parts and to whole products were, thus, intended by Congress to be adjudged by the same standards. Yet the Federal Circuit has carved out designs on component parts for a separate test, effectively ending patent protection for component design except against wholly identical copies.

Finally, the Federal Circuit's holding creates a potentially dangerous problem based on the stream of commerce. Manufacturers and assemblers could with impunity purchase and incorporate cheaper infringing components in their assembled products knowing that ordinary retail purchasers and users will be deceived by the similarities in the design and be undeterred from purchasing the cheaper alternative. Such a rule would encourage consumer deception and significantly undermine the protection afforded patent holders. Indeed, manufacturers of infringing goods would need only to ensure that their knock-offs passed through a sophisticated, discerning middleman before entering the retail marketplace to avoid infringement.

An ordinary observer test that changes based on the design, its product, and the market erodes patent protection and discourages investment in new designs. One uniform test should apply to all design patents.

**B. A Specific Ordinary Observer Creates Further Problems with the Separate Point of Novelty Test**

*Gorham*, *Contessa*, and other cases also highlight the requirement for the ordinary observer to consider the patented design's features as a whole when addressing infringement. The first purchaser, often a professional buyer or other expert, may not consider the entire design, instead focusing solely on minute differences. As a result, any consideration of the whole design need not and should not be present during the secondary infringement test, which focuses on the "Points of Novelty."

This separate test may have its roots in *Smith v. Whitman Saddle Co.*, in which this Court compared a patented saddle design to the prior art and found that, unless the accused product incorporated a pommel drop feature that made the patented design different over the prior art, there would be no infringement "since the saddle design of the patent does not otherwise differ from the old saddle with the old cantle added—an addition frequently made." 148 U.S. 674, 682 (1893); see *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.3d 1557, 1565 (Fed. Cir. 1998); *Lawman Armor Corp. v. Winner Int'l, LLC*, 437 F.3d 1383, 1385-86 (Fed. Cir. 2006). A point of novelty analysis focuses on the presence or absence of individual design elements, and not the entire design or the similarity of design elements. Selection of the ordinary observer as the first purchaser—in many cases, as here, an expert who examines individual details—would undoubtedly lead to the improper merger of these two independent tests, which the Federal Circuit has previously indicated is legal error. See *Contessa*, 282 F.3d at 1377.

Indeed, the Federal Circuit in this case improperly considered the “overall design appearance” when analyzing the point of novelty test. App. 20a. By interjecting consideration of similar overall appearance onto the point of novelty test, which should focus exclusively on whether the asserted point of novelty is or is not present in the accused design, the Federal Circuit intruded into the domain of the ordinary observer test. As already mentioned, selection of a specific ordinary observer, here the first purchaser, foretells of that improper blending of the tests, since experts as ordinary observers would be accustomed to the point-by-point analysis in the points of novelty test. Yet this Court specifically rejected a side-by-side comparison by the ordinary observer in *Gorham*. See 81 U.S. at 528.

Nothing in the patent laws, this Court’s precedent, or even the Federal Circuit’s own precedent suggests that only design patents to component parts be subjected to a “first purchaser” requirement during the ordinary observer analysis. That test undermines the protection afforded by design patents and forecloses any finding of infringement, even where ordinary consumers may find the accused designs deceptively similar to patented designs, simply because a sophisticated expert first purchased a product incorporating the design.

The ordinary observer test and the points of novelty test started as objective, uniform standards that disregarded expert viewpoint, credited originality, and gave value to inventive designs. The Federal Circuit’s current tests have confounded those basic policies and should be corrected to restore consistency and value to the design patent system.

**CONCLUSION**

For the reasons stated, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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**APPENDIX A  
DECISION OF THE  
UNITED STATES COURT OF APPEALS FOR THE  
FEDERAL CIRCUIT**

**United States Court of Appeals for the  
Federal Circuit**

2006-1561

**ARMINAK AND ASSOCIATES, INC.  
and HELGA ARMINAK,**

**Plaintiffs/Counterclaim  
Defendants-Appellees,**

**and**

**ARMIN ARMINAK,**

**Counterclaim Defendant-  
Appellee,**

**v.**

**SAINT-GOBAIN CALMAR, INC.  
(now known as MeadWestvaco Calmar, Inc.),**

**Defendant/Counterclaimant-  
Appellant.**

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**DECIDED: September 12, 2007**

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Before MICHEL, Chief Judge, GAJARSA, Circuit Judge, and HOLDERMAN, \* Chief District Judge.

HOLDERMAN, Chief District Judge.

Appellant Saint-Gobain Calmar, Inc. (“Calmar”) appeals from the district court's order granting summary judgment in favor of Arminak & Associates, Inc. (“Arminak”), finding that the design of Arminak's “AA Trigger” shroud did not infringe Calmar's two design patents, U.S. Patents Nos. Des. 381,581 (“the '581 patent”) and Des. 377,602 (“the '602 patent”). Arminak & Assoc., Inc. v. Saint-Gobain Calmar, Inc., 424 F. Supp. 2d 1188 (C.D. Cal. 2006). We affirm.

I. Background

Calmar and Arminak are both in the business of selling trigger sprayers to producers of liquid household products. A trigger sprayer is a device that is attached atop the cap of a bottle containing liquid, with a tube extending from the trigger sprayer device into the liquid. When the trigger of the sprayer device is manually pulled back, liquid is drawn up the tube into the sprayer device and is dispersed as a spray or mist out of the device's nozzle. The outside cover of the top portion of the sprayer device behind the nozzle and above the trigger mechanism is called the shroud, which is typically made of a molded plastic design.

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\* Honorable James F. Holderman, Chief Judge, United States District Court for the Northern District of Illinois, sitting by designation.

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In 1997, the U.S. Patent and Trademark Office (“PTO”) granted Calmar two design patents—the '581 and '602 patents—on two trigger sprayer shroud designs. Calmar thereafter produced a commercial embodiment of the '581 patent called the “ERGO” shroud. No commercial embodiment of the shroud design set forth in the '602 patent has been produced.

In 2004, Arminak began selling its “AA Trigger” sprayer with the accused shroud design. In October 2004, Calmar informed one of Arminak's customers that Calmar believed the shroud design of Arminak's AA Trigger sprayer infringed Calmar's '581 and '602 design patents. On November 16, 2004, Arminak filed a declaratory judgment action against Calmar in the United States District Court for the Central District of California seeking a declaratory judgment of noninfringement. Calmar counterclaimed, alleging infringement of its '581 and '602 design patents. Arminak filed an amended complaint adding allegations of patent invalidity and certain state law claims against Calmar. After a period of pretrial discovery, Arminak moved for summary judgment on its declaratory judgment claim, asserting that Arminak's AA Trigger shroud's design does not infringe Calmar's patents. On March 20, 2006, the district court in a detailed opinion determined that the shroud of Arminak's AA Trigger does not infringe Calmar's '581 and '602 design patents. Arminak, 424 F. Supp. 2d at 1189-90. On May 9, 2006, the district court dismissed Calmar's patent infringement counterclaims, stayed the litigation as to Arminak's patent invalidity and state law claims, and entered

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judgment in Arminak's favor pursuant to Federal Rule of Civil Procedure 54(b).

In granting Arminak's motion for summary judgment of noninfringement on Arminak's declaratory judgment claim and dismissing Calmar's counterclaims, the district court initially construed the claims of Calmar's '581 and '602 design patents. The district court then found that the ordinary observer of the trigger sprayer shroud designs in question was not the retail consumer or purchaser of retail products sold in containers with trigger sprayer devices, but the buyer of trigger sprayers for a contract filler or an industrial purchaser up the stream of commerce from the retail purchaser. The district court further found that the ordinary observer of trigger sprayers would not be deceived by the similarities between Arminak's AA Trigger shroud's design and Calmar's patented shroud designs. Additionally, the district court found that the similarities between Arminak's AA Trigger shroud and the design of Calmar's patented shrouds do not stem from Calmar's two asserted points of design novelty over the prior art in the sprayer shroud field.

## II. Jurisdiction and Standard of Review

The district court's subject matter jurisdiction over Arminak's declaratory judgment action for patent noninfringement was granted by 28 U.S.C. § 1338(a). We have jurisdiction over Calmar's appeal of the district court's partial summary judgment pursuant to 28 U.S.C. § 1292(c)(2) and § 1295(a)(1).

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We review a grant of summary judgment de novo, reviewing the record and drawing all reasonable inferences in the nonmovant's favor to determine whether there is a genuine issue as to any material fact. Johns Hopkins Univ. v. CellPro, Inc., 152 F.3d 1342, 1353 (Fed. Cir. 1998).

III. Calmar's Contentions of Error

Calmar asserts four primary bases for its appeal: (1) the district court erred by construing the claims of Calmar's patents too narrowly; (2) the district court erred in its identification of the industrial buyer, not the retail consumer, as the ordinary observer; (3) the district court erred in holding that no reasonable jury could find that the ordinary observer would be deceived by the similarities of the trigger sprayers' shroud designs in question; (4) the district court erred in holding that no reasonable jury could find the points of novelty of the patented designs to be present in Arminak's AA Trigger shroud's design. Each of Calmar's arguments supporting its contentions of error is discussed below, after a brief overview of the law governing design patents.

IV. Overview of Design Patent Law

“A design patent protects the nonfunctional aspects of an ornamental design as shown in the patent.” Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed. Cir. 1995) (citing KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc., 997 F.2d 1444, 1450 (Fed. Cir. 1993)). The chief limitation on the patentability of

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designs is that they must be primarily ornamental in character. If the design is dictated by performance of the article, then it is judged to be functional and ineligible for design patent protection. Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563, 1566 (Fed. Cir. 1996).

The elements of design patent infringement are set forth at 35 U.S.C. § 289:

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction over the parties.

35 U.S.C. § 289 (emphases added). Accordingly, a design patent is infringed by the “unauthorized manufacture, use, or sale of the article embodying the patented design or any colorable imitation thereof.” Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1116-17 (Fed. Cir. 1998).

Similar to the infringement analysis of a utility patent, infringement of a design patent is evaluated in a two-step process. First, the court must construe the claims of the design patent to determine their meaning

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and scope. OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1404-05 (Fed. Cir. 1997). Design patents typically are claimed as shown in drawings. Claim construction by a court is adapted accordingly. Goodyear, 162 F.3d at 1116. The scope of the claim of a patented design “encompasses ‘its visual appearance as a whole,’ and in particular ‘the visual impression it creates.’” Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1376 (Fed. Cir. 2002) (quoting Durling v. Spectrum Furniture Co., 101 F.3d 100, 104-05 (Fed. Cir. 1996)).

Second, after construction of the patent's claims, the court is to compare the construed claims to the accused design. Elmer, 67 F.3d at 1577. Infringement of a design patent occurs if “the designs have the same general visual appearance, such that it is likely that the purchaser [(or the ordinary observer)] would be deceived into confusing the design of the accused article with the patented design.” Goodyear, 162 F.3d at 1118. The patented and accused designs do not have to be identical in order for design patent infringement to be found. Contessa, 282 F.3d at 1376. In determining infringement of a design patent, the court “is not limited to the ornamental features of a subset of the drawings, but instead must encompass the claimed ornamental features of all figures of a design patent.” Id. at 1379 (emphasis added).

The comparison of the patented and accused designs involves two separate tests, both of which must be satisfied to find infringement: the “ordinary observer” test and the “point of novelty” test. Bernhardt, L.L.C. v. Collezione Europa USA, Inc., 386

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F.3d 1371, 1383 (Fed. Cir. 2004). The “ordinary observer” test was first enunciated by the United States Supreme Court in Gorham Manufacturing Co. v. White, 81 U.S. 511 (1871), which held that:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Id. at 528. In a separate and distinct inquiry, the “point of novelty” test requires proof that the accused design appropriated the novelty which distinguishes the patented design from the prior art. Egyptian Goddess, Inc. v. Swisa, Inc., No. 2006-152, 2007 WL 2439541, at \*2 (Fed. Cir. Aug. 29, 2007) (citing Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984)). Both the ordinary observer test and point of novelty test are factual inquiries. Bernhardt, 386 F.3d at 1383.

V. Discussion of Calmar's Arguments

A. **The District Court's Detailed Claim Construction**

Calmar argues that the district court erred by construing the claims of the patents-in-suit too narrowly, improperly focusing on and describing in minute detail the ornamental features of Calmar's patent rather than simply describing in words what is

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shown in their drawings. Based on the allegedly “too narrow” claim construction, the district court, according to Calmar, then improperly engaged in a “side-by-side, element-by-element comparison of the minute details of and differences between the patented designs and the AA Shroud.” Appellant's Br. at 67.

The district court in this case performed the requisite task of claim construction by describing each of the drawings of Figures 1 through 5 in each of the two Calmar patents-in-suit. In doing so, the district court was careful to point out that the patented design did not include the nozzle, trigger, or closure cap. The district court also carefully noted that, to overcome the PTO's earlier rejection of the '581 patent application as not patentably distinct from the preceding Calmar '602 patent and to obtain the PTO's issuance of the '581 patent on July 29, 1997, Calmar filed a terminal disclaimer under 37 C.F.R. § 1.321(b). Calmar's disagreement with the district court's claim construction is essentially that it was too detailed. Our case law does not prohibit detailed claim construction of design patent drawings. It merely disapproves claim construction that goes beyond the novel, nonfunctional ornamental features visually represented by the claimed drawings, Elmer, 67 F.3d at 1577, or that fails to encompass the claimed ornamental features of the design as a whole. Amini Innovation Corp. v. Anthony California, Inc., 439 F.3d 1365, 1371 (Fed. Cir. 2006). The district court's meticulous and accurate description of Figures 1 through 5 of each of Calmar's patents-in-suit did not constitute error. The district court's claim analysis demonstrated the proper consideration of the claimed designs as a whole.



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**B. The District Court's Identification of the Ordinary Observer**

A question that is central to this case, and every design patent case, is the identity of the “ordinary observer” of the design at issue, which in this case is the design of trigger sprayer shrouds. This test requires an objective evaluation of the question of whether a hypothetical person called the “ordinary observer” would find substantial similarities between the patented design and the accused design, so as to be deceived into purchasing the accused design believing it is the patented design. Gorham, 81 U.S. at 528.

Calmar argues that the appropriate “ordinary observer” in this case is the retail consumer who purchases the retail product that incorporates the sprayer shroud, such as the retail purchaser of a bottle of liquid window cleaner with a trigger sprayer device attached to the bottle's cap and a tube extending into the liquid to extract the liquid from the bottle as a spray during retail use. If the ordinary observer is found to be the retail consumer that purchases the shroud of the trigger sprayer device as it is incorporated into a retail product, then it is much more likely that the ordinary observer would find substantial similarities between the patented and accused designs sufficient to be deceived into thinking that Arminak's AA Trigger shroud is one of the patented designs.

The district court disagreed with Calmar and found that the “ordinary observer” of trigger sprayer shrouds is not the retail consumer, but the purchaser of trigger

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sprayer mechanisms for assembly and incorporation into the product that is sold to retail consumers. The record clearly shows that Calmar never sold any of its patented shrouds directly to retail consumers. Arminak, 424 F.Supp.2d at 1198. If the ordinary observer is the contract buyer or industrial purchaser of trigger sprayers, then the undisputed material facts in the record establish that such a purchaser would not find substantial similarity between the patented and accused shrouds, and therefore would not be deceived into thinking that Arminak's AA Trigger shroud is one of the patented designs. Id. at 1201-02.

The Supreme Court's Gorham opinion, which dealt with an accused design's infringement of a design patent on silverware handle designs, expressly excluded experts from the category of persons who are ordinary observers. Under the facts of Gorham, it was “the observation of a person versed in designs in the particular trade in question—of a person engaged in the manufacturer or sale of articles containing such designs—of a person accustomed to compare such designs one with another, who sees and examines the articles containing them side by side,” id. at 527, that was explicitly rejected by the Supreme Court.

The Supreme Court in Gorham contrasted this group of expert examiners, whose observations it rejected, with “ordinary observers,” who it described as people possessing “ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give.” Id. at 528. The Court emphasized that “[i]t is persons of this latter class who

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are the principle purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be ... the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed.” Id. To be effective, design patent protection must focus upon observations “by ordinary observers, by those who buy and use” the article bearing the design in question. Id.

The unanswered question remaining after Gorham is whether these “ordinary observers” of which the Supreme Court spoke can be commercial or industrial buyers of designed items that are used as component parts assembled into a retail product. Although we have not squarely addressed that question until now, in the Goodyear case (which dealt with patented tire tread designs commercially embodied on Goodyear's truck tires) we stated that the focus of the ordinary observer test is “on the actual product that is presented for purchase, and the ordinary purchaser of that product.” 162 F.3d at 1117 (emphasis added). There we found that the ordinary observer of the patented tread designs was a truck driver and a truck fleet operator because the products containing the patented and accused designs were tires used on trucks, even though the design patent at issue was not limited to truck tires.

In KeyStone, we found that the ordinary observers of patented wall blocks were “visitors to trade shows.” 997 F.2d at 1451. We made that finding even though the accused wall blocks, when stacked to form a wall, were substantially similar to a wall of patented wall

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blocks. We held that the visual observation of the ordinary observer should focus only on the unassembled “patented design” of the individual block, not the blocks that were stacked together as “an assembled wall.” Id. at 1451. Accordingly, we concluded in KeyStone that “the ‘ordinary purchaser’ for the purpose of the block design patent is a purchaser of the patented block,” not a purchaser of an assembled wall. Id.

In 1933, when the regional United States Courts of Appeals still had jurisdiction over patent law issues, the Sixth Circuit noted the substantial number of prior art design patents in the field of automobile electric cigar lighters and ashtrays. Adhering to the precedent of Gorham v. White, the court held:

The ordinary observer is not any observer, but one who, with less than the trained facilities of the expert, is “a purchaser of things of similar design,” or “one interested in the subject” ... one who, though not an expert, has reasonable familiarity with such objects [as an automobile ash tray and cigar lighter], and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it.

Applied Arts Corp. v. Grand Rapids Metalcraft Corp.,  
67 F.2d 428, 430 (6th Cir. 1933).

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More recently, two district court opinions found that institutional purchasers, not end-user consumers, were the appropriate persons to be considered ordinary observers when the design-patented item is a component of the product that is sold. E.g. Spotless Enters., Inc. v. A & E Prods. Group, L.P., 294 F. Supp. 2d 322, 347 (E.D.N.Y. 2003) (design patent for lingerie hangers; “ordinary observer” was not the general public, but the commercial buyer for garment manufacturers, who then resold garments on the hangers to retail stores); Puritan-Bennett Corp. v. Penox Techs., Inc., No. IP02-0762-C-M/S, 2004 WL 866618, at \*26 (S.D. Ind. Mar. 2, 2004) (design patent for portable liquid oxygen tanks; “ordinary observer” “must include medical equipment distributors, at the least, and possibly, hospitals and physicians” who provide the tanks by prescription to patients), aff’d 121 Fed.Appx. 397 (Fed. Cir. 2005).

Calmar cites to our Contessa opinion in support of its contention that in this case the ordinary observer must be the retail consumer. In Contessa, we stated:

for purposes of design patent infringement, the “ordinary observer” analysis is not limited to those features visible during only one phase or portion of the normal use lifetime of an accused product. Instead, the comparison must extend to all ornamental features visible during normal use of the product, i.e., “beginning after completion of manufacture or assembly and ending

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with the ultimate destruction, loss, or disappearance of the article.”

282 F.3d at 1380 (citations omitted) (emphases added). We disagree with Calmar that the quoted language from Contessa supports Calmar's contention that the retail consumer must be the ordinary observer of trigger sprayer shrouds. This quoted language does not describe who the ordinary observer is. Rather, it explains what “features” of the patented design must be included as “observed” in the ordinary observer test or in other words, what features of the patented design the ordinary observer is to examine in determining if there is substantial similarity with an accused design.

Calmar also argues that the purchasers of the shrouds themselves (who Calmar repeatedly refers to as “the sophisticated purchaser who is well-versed in the trade”) do not “use” the shrouds and therefore cannot be the ordinary observer. Appellant's Br. at 30-31. Again, we disagree with Calmar. The industrial purchaser of the trigger sprayer shrouds for manufacturing assembly does indeed “use” the shrouds to cover trigger sprayer mechanisms that are assembled with the bottle, the bottle's cap, the liquid contained in the bottle, and the label on the bottle, all of which assembled together create the retail product. Consequently, the purchaser of the patented and accused designs in this case is the purchaser of one of a retail product's component parts that is thereafter assembled with other parts to make the retail product. To hold that such a purchaser is the appropriate hypothetical ordinary observer fits squarely with our precedent that the ordinary observer is a person who is

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either a purchaser of, or sufficiently interested in, the item that displays the patented designs and who has the capability of making a reasonably discerning decision when observing the accused item's design whether the accused item is substantially the same as the item claimed in the design patent.

We agree, therefore, with the district court that the ordinary observer of the sprayer shroud designs at issue in this case is the industrial purchaser or contract buyer of sprayer shrouds for businesses that assemble the retail product from the component parts of the retail product bottle, the cap, the sprayer tube, the liquid, the label, and the trigger sprayer device atop the cap, so as to create a single product sold to the retail consumer. Here, the patented design is only the shroud of the sprayer device. The three physical exhibits submitted for examination on appeal are trigger sprayer devices attached to bottle caps with plastic tubes for insertion into contained liquid, not the bottles, not the liquid into which the sprayer tube is inserted during normal use, and not the label of the retail product. Accordingly, we hold that the ordinary observer of the trigger sprayer shrouds in this case is, as the district court found, the contract or industrial buyer for companies that purchase the stand-alone trigger sprayer devices, not the retail purchasers of the finished product.

**C. The District Court's Application of the Ordinary Observer Test**

In applying the ordinary observer test, a court is to compare the construed claims to the accused design to

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determine whether “the designs have the same general visual appearance, such that it is likely that the purchaser [(or the ordinary observer)] would be deceived into confusing the design of the accused article with the patented design.” Goodyear, 162 F.3d at 1118. Specifically, the question to be addressed in applying the ordinary observer test is whether the ordinary observer would be deceived by the accused design because it is substantially similar to the patented design. Gorham, 81 U.S. at 528. Under our case law, the ordinary observer test requires, as the district court recognized, the comparing of the accused and patented designs from all views included in the design patent, not simply those views a retail customer seeking to buy would likely see when viewing the product at the point of sale. Contessa, 282 F.3d at 1379.

The record establishes that the ordinary observer would not be deceived by the similarities between Arminak's AA Trigger shroud and Calmar's patented sprayer shroud designs. Indeed, Calmar's own expert conceded that “[i]t would be a significant exception for a corporate buyer purchasing the Arminak trigger sprayer to confuse the Calmar ERGO Shroud and the Arminak AA shroud” and that “[t]here is essentially no question that a corporate buyer purchasing these trigger sprayers with these specific shrouds would be able to tell the difference easily.” Arminak, 424 F. Supp. 2d at 1201-02. A former Calmar customer service manager also testified that most of Calmar's customers “wouldn't be fooled for a second.” Id. at 1201. We agree with the district court that the undisputed material facts establish that the ordinary



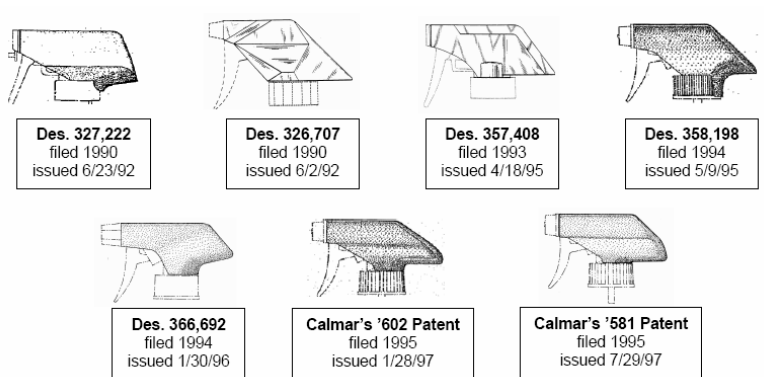
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observer would not be deceived by the similarities between Arminak's AA Trigger shroud and Calmar's patented sprayer shroud designs.

**D. The District Court's Application of the Point of Novelty Test**

The point of novelty test is the second test that must be satisfied for an accused design to infringe a design patent. In applying the point of novelty test, a court compares the construed claims to the accused design to determine whether the accused design has “appropriated” the points of novelty from the patented design. See Litton, 728 F.2d at 1444. Where the art in the field of a particular design is crowded, we must construe the range of equivalents narrowly. Id.

The record in this case includes a number of prior art examples of trigger sprayer shrouds' patented designs.



Calmar presented two points of novelty to the district court that Calmar asserted distinguished its

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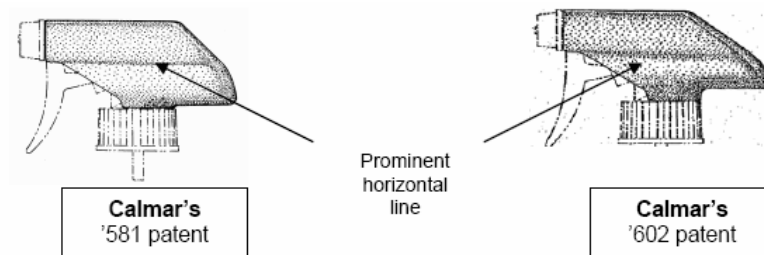
patented designs from the prior art. The district court “concur[ed] with Calmar's characterization of the [two] points of novelty in the '581 and '602 Patents”:

1. There is a prominent horizontal line extending along each side [of the shroud], parallel to the top surface of the shroud, all the way to the sloped rear surface; and
2. The sides of the shroud first go straight downwardly, and then, as viewed from the rear, at the horizontal lines on each side, bulge outwardly in a bulbous fashion, to the bottom rear of the shroud.

Arminak, 424 F. Supp. 2d at 1204. We examine each in turn.

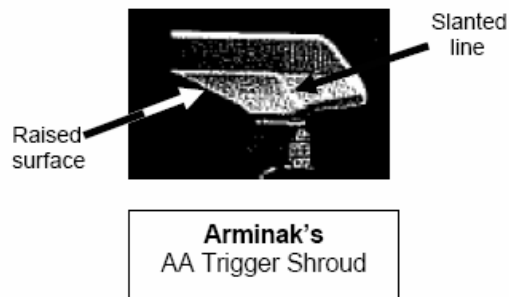
1. “A Prominent Horizontal Line”

With respect to Calmar's assertion as to the first point of novelty, “a prominent horizontal line” extending along the shroud's sides appears in both patented designs.



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The district court found that the prominent horizontal line of Calmar's patented designs was not appropriated by Arminak's AA Trigger shroud because “the [horizontal] line on the AA Trigger is intersected by a slanted line defining a raised surface,” *id.* at 1204-05, beneath the horizontal line and above the trigger mechanism.



We agree with the district court. Although the top edge of Arminak's AA Trigger shroud's raised surface is beneath a horizontal line that extends along the shroud's side to the back of the shroud, the rear edge of the raised surface is defined by a downwardly slanted line that intersects Arminak's AA Trigger shroud's horizontal line near the middle of the shroud's side. The raised surface and intersecting slanted line below Arminak's AA Trigger shroud's horizontal line results in a different overall design appearance than Calmar's asserted first point of novelty of its patented designs.

## 2. “Bulge Outwardly in a Bulbous Fashion”

With respect to Calmar's asserted second point of novelty, the sides of the shroud that “bulge outwardly

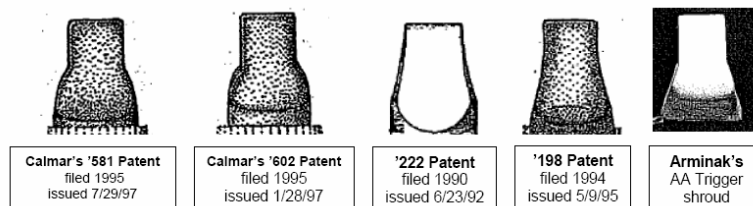
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in a bulbous fashion, to the rear of the shroud,” the district court found that Arminak's AA Trigger shroud did not appropriate this point of novelty because, similar to several prior art patents, Arminak's AA Trigger shroud's sides “instead flare out in straight lines before converging slightly inward toward the bottom of the shroud.” Id. at 1204. The district court cited to the '222 patent's drawings in support of its finding

that the AA Trigger does not contain the “bulbous sides” point of novelty Calmar claims. The AA Trigger's flared appearance, when viewed from the back, is similar to the back view disclosed in the '222 Patent.... Indeed, any similarity that might appear between the back portion of the AA Trigger and the back drawings of the patented designs is no greater than the similarity between the back views claimed in the patented designs and the back view shown in the '222 Patent.

Id. at 1204 n.14.

The similarities and differences between the back of the patented designs, the prior art, and Arminak's AA Trigger shroud are illustrated below:



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Arguably, the “bulbous” “bulge” of the sides of the patented designs are “novel” when compared to the prior art. We agree with the district court that based on the “bulbous” sides as depicted in the back views of Calmar's patents' drawings, no reasonable jury could find that the back of Arminak's AA Trigger shroud, which is almost identical to the '198 and '222 prior art patents, appropriates Calmar's second point of novelty.

Our conclusion is that Arminak's AA Trigger shroud does not appropriate the two points of novelty from the prior art as Calmar contends. We agree with the district court that no reasonable jury could find that Calmar's points of novelty exist in Arminak's AA Trigger shroud.

Calmar contends that the district court in its analysis improperly merged the point of novelty test with the ordinary observer test, which we have held is “legal error.” Contessa, 282 F.3d at 1377. We disagree with Calmar's contention. The district court's opinion is clear that its point of novelty analysis was confined to determining Calmar's points of novelty and whether Arminak's AA Trigger shroud appropriated Calmar's points of novelty. Calmar implies that the district court should have limited its discussion of the points of novelty comparison to only the exact words Calmar used to describe its two points of novelty and that the district court should not have looked at Calmar's patents' Figures. The relevant inquiry is not to analyze the words used by the patent owner to describe a particular design feature after the issuance of the patent, but whether the design feature, as it appears

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in the Figures of the patent as issued, is found in the accused design.

Calmar also implies that it was improper for the district court to do a detailed side-by-side comparison between the patented design and the accused design. Calmar cites no authority for this contention because there is none. To establish infringement in a design patent case, the district court is required to compare the patented design with the accused design. See Elmer, 67 F.3d at 1577. Without comparing the patented design with the accused design, there was no way for the district court to determine whether an ordinary observer would find the accused design deceptively similar and whether the accused design appropriated points of novelty. Therefore, based on our de novo review, we find that the district court applied both judicially articulated design patent infringement tests in the proper manner. Neither test is satisfied in this case.

VI. Conclusion

For the foregoing reasons, the district court's judgment is affirmed.

**AFFIRMED.**

No costs.

APPENDIX B  
ORDER OF THE  
UNITED STATES DISTRICT COURT FOR THE  
CENTRAL DISTRICT OF CALIFORNIA

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ARMINAK &	)	CASE NO.:
ASSOCIATES, INC.,	)	SACV 04-1455 CJC
	)	(AJWx)
Plaintiff,	)	
	)	ORDER GRANTING
v.	)	PLAINTIFF AND
	)	COUNTERCLAIM-
SAINT-GOBAIN	)	DEFENDANT'S
CALMAR, INC.,	)	MOTION FOR
	)	PARTIAL SUMMARY
Defendant.	)	JUDGMENT ON THE
	)	ISSUE OF
	)	NONINFRINGEMENT

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This patent infringement case concerns two design patents for a device known as a “trigger sprayer shroud:” a plastic cover that fits over the pump mechanism used in plastic spray bottles. (Opposition Brief, p. 1.) Defendant Saint-Gobain Calmar, Inc. (“Calmar”) asserts that Plaintiff and Counterclaim Defendant, Arminak and Associates (“Arminak”) infringed its United States Patents Nos. Des. 381,581 (the “ ’581 Patent”) and Des. 377,602 (the “ ’602 Patent”) by selling a device known as the “AA Trigger.” Arminak now moves for partial summary judgment of

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Calmar's design patent infringement claim, on the ground that no reasonable jury could find that the AA Trigger infringes the '581 or '602 Patents. Because the Court finds that Calmar has failed to present evidence that an ordinary observer would be deceived by the overall visual similarities between the patented designs and the accused device, Arminak's motion is GRANTED.

**I. Background**

Arminak has sold and distributed packaging systems for the cleaning, household and cosmetic industries since 1999. (Helga Arminak Decl., ¶ 3.) Its product mix includes, but is not limited to, bottles, spray pumps, and trigger sprayers. (*Id.*; UDF No. 4.) A trigger sprayer is the portion of a spray bottle that sits atop the container, and consists of a valve body, a trigger, a shroud or covering, a nozzle, a closure, a spring, a piston, two valves and a dip-tube. (Friedman Decl., ¶ 2.) Arminak sells trigger sprayers to manufacturers of cleaning supplies and household products, and also to “contract fillers:” companies that are hired by branded cleaning supply companies to fill containers with solution and affix trigger sprayers and labels to the finished product. (Supp. Helga Arminak Decl., ¶ 4; McKernan Depo., 90:22-91:4.) Both the manufacturers and the contract fillers purchase the trigger sprayers through “buyers,” whose regular job is to source and purchase liquid dispensing system components. (Supp. Helga Arminak Decl., ¶ 4.) These buyers have varying levels of knowledge regarding the characteristics of trigger sprayers, depending on the size and sophistication of the companies that employ



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them. (McKernan Depo., 90:1-18, 72:9-73:10; Czuprynski Depo., 82:6-84:20, Exh. 22 to Lee Decl.)

Calmar manufactures and sells trigger sprayers to brand holders of household, automotive, lawn, and garden products. (Mirocke Depo., 102:1-10, Exh. 6 to Lee Decl.) Its trigger sprayers are not sold directly to retail consumers or end users, but pass through a series of distributors before arriving on the store shelf as part of the packaging for Calmar's customers' products. (*Id.* at 210:17-21; McKernan Depo., 90:15-18.) Some of Calmar's customers are multi-national companies such as S.C. Johnson or Procter and Gamble, which have their own purchasing departments with knowledgeable in-house buyers. (UDF No. 11; DeCarlo Decl., Exh. T; Czuprynski Depo., 71:20-74:4, Exh. 22 to Lee Decl.) Others are smaller contract fillers and packaging distributors, which buy trigger sprayers through buyers who may be less discerning than buyers for large companies. (McKernan Depo., 90:1-18, 72:9-73:10; Czuprynski Depo., 82:6-84:20, Exh. 22 to Lee Decl.) The distributors either put the trigger sprayers on bottles filled with a liquid and re-sell them to retail stores, or sell them to other distributors who pass them down the stream of commerce until they are sold at retail stores to consumers. (Mirocke Depo., 210:17, 23-25; McKernan Depo., 90:15-18; Rodden Depo., 39:22-40:11.)

In 1995, Calmar invented the sprayer shroud designs that are the subject matter of the '581 and '602 Patents. Its patent applications were approved in 1997. Both patents claim only the plastic covering, or

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shroud, portion of a trigger sprayer, and do not claim the containers themselves. (UDF No. 5; DeCarlo Decl., Exhs. A and B.) Calmar subsequently produced a commercial embodiment of the '581 Patent, called the "ERGO shroud." No commercial embodiment of the '602 Patent has been produced.

In 2004, Arminak began offering for sale the accused device, a trigger sprayer known as the AA Trigger. (UDF No. 3; Armin Arminak Decl., ¶ 2.) Calmar soon became aware of the AA Trigger and, in October 2004, sent a letter to one of Arminak's customers stating, "Recently, representatives of Calmar purchased a product in the marketplace bearing a trigger sprayer that Calmar believes infringes [the '581 and '602 Patents], and which appears to originate from [you.]" (Calmar's Response to Arminak's UDF No. 6.) On November 16, 2004, Arminak sued Calmar for declaratory judgment of patent non-infringement. (Complaint). Arminak has since amended its Complaint to assert additional claims for declaratory relief of patent invalidity, federal and state law unfair competition, intentional interference with prospective economic advantage, and trade libel. (Second Amended Complaint, ¶¶ 24-53.) Calmar has counterclaimed for infringement of the '581 and '602 Patents. (Third Amended Counterclaims, ¶¶ 23-34.) Arminak now seeks partial summary judgment of Calmar's patent infringement counterclaims, on the ground that no genuine issue of material fact exists as to infringement.

## II. Summary Judgment on the Issue of Infringement

Summary judgment is proper “if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” FED. R. CIV. P. 56(C). A fact is material if it “might affect the outcome of the suit under the governing law.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A factual dispute is genuine “if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.” *Id.* In making a summary judgment determination, the Court must view the evidence presented in the light most favorable to the non-moving party, drawing “all justifiable inferences ... in his favor.” *Id.* at 255.

The moving party in a summary judgment motion bears the initial responsibility of demonstrating the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). If the moving party makes this initial showing, the nonmoving party must “designate ‘specific facts showing that there is a genuine issue for trial.’ ” *Celotex*, 477 U.S. at 324 (citation omitted). Where the non-moving party bears the burden of proof at trial on an element essential to its case, that party must make a showing sufficient to establish a genuine issue of material fact with respect to the existence of that element in order to avoid summary judgment. *Id.* at 322. To defeat a summary judgment motion, the opponent may not rely on the pleadings, but must affirmatively come forth with sufficient evidence to

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substantiate its claims or defenses. *Id.* at 324. The evidence submitted by the nonmoving party must be “believed, and all justifiable inferences are to be drawn in [its] favor.” *KeyStone Retaining Wall Systems, Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1449-50, 27 U.S.P.Q. 2d 1297 (Fed. Cir. 1993). Thus, the Court must determine whether Arminak has met its initial burden of showing the absence of any genuine issue of material fact, and whether Calmar, the non-moving party and the party with the burden of proof at trial, has presented sufficient evidence to raise a genuine issue of material fact as to whether the AA Trigger infringes the '581 and '602 Patents.

**A. The Test for Infringement of a Design Patent**

“A design patent protects the nonfunctional aspects of an ornamental design as shown in the patent.” *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 36 U.S.P.Q. 2d 1417 (Fed. Cir. 1995) (*citing KeyStone*, 997 F.2d at 1450, 27 U.S.P.Q. 2d at 1302). A design patent is infringed by the “unauthorized manufacture, use, or sale of the article embodying the patented design or any colorable imitation thereof.” *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1116-17 (Fed. Cir. 1998). 35 U.S.C. Section 289 provides in relevant part:

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of

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manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

The first step in determining whether a design patent has been infringed is to construe its claims to determine their meaning and scope. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976, 34 U.S.P.Q. 2d 1321 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed. 2d 577, 38 U.S.P.Q. 2d 1461 (1996); *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1404, 43 U.S.P.Q. 2d 1641 (Fed. Cir. 1997) (“Whether a design patent is infringed is determined by first construing the claim to the design ...”). Claim construction is a question of law for the court. *Markman*, 52 F.3d at 979, 34 U.S.P.Q. 2d at 1331 (“When, after considering the extrinsic evidence, the court finally arrives at an understanding of the language as used in the patent and prosecution history, the court must then pronounce as a matter of law the meaning of that language.”). In construing patent claims, courts consider the patent's claims, the specification, and the prosecution history. *Id.* at 979, 34 U.S.P.Q. 2d at 1329 (citing *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561, 19 U.S.P.Q. 2d 1500 (Fed. Cir. 1991); *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 396-98, 181 Ct.Cl. 55, 155 U.S.P.Q. 697, 701-03 (1967)). Courts may also consider “expert testimony, including evidence of how those skilled in the art would interpret the claims,” as well as other extrinsic evidence. *Id.* (citing *Fonar Corp. v. Johnson &*

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*Johnson*, 821 F.2d 627, 631, 3 U.S.P.Q. 2d 1109 (Fed. Cir. 1987)). As design patents typically are claimed as shown in drawings, without any written description, the court's claim construction must be adapted accordingly. *Goodyear*, 162 F.3d at 1116 (citing 37 C.F.R. § 1.153(a)).

Once the court has construed the patent's claims, it must compare the accused item to the patented design for overall visual similarity, to determine whether infringement has occurred. *Elmer*, 67 F.3d at 1577, 36 U.S.P.Q. 2d at 1420 (citing *Markman*, 52 F.3d at 976). The test for infringement has long been known as the “ordinary observer” test:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

*Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528, 20 L.Ed. 731 (1871).

Infringement of a design patent occurs if “the designs have the same general visual appearance, such that it is likely that the purchaser would be deceived into confusing the design of the accused article with the patented design.” *Goodyear*, 162 F.3d at 1118. Complete similarity is not required to find infringement, and “minor changes in a design are often

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readily made without changing its overall appearance.” *Id.* at 1117. However, if the overall impression of the designs are dissimilar, infringement cannot be found based on similarity of specific features. *OddzOn*, 122 F.3d at 1405, 43 U.S.P.Q. 2d at 1647. In applying the ordinary observer test, the court's analysis “is not limited to the ornamental features of a subset of the [design patent's] drawings, but instead must encompass the claimed ornamental features of all figures of a design patent.” *Contessa Food Products, Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1379, 62 U.S.P.Q. 2d 1065, 1069 (Fed. Cir. 2002). The court must consider the features of the design that would be visible during normal and intended use throughout the article's entire lifetime, not only those features visible at the time of sale. *Id.* The period of consideration is that “beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article.” *Id.* at 1379, (*citing In re Webb*, 916 F.2d 1553, 1557-58, 16 U.S.P.Q. 2d 1433, 1436 (Fed. Cir. 1990)).

Finally, the similarity between the accused device and the patented design must stem from the points of novelty that distinguish the patented invention from the prior art. *Bernhardt, L.L.C. v. Collezione Europa U.S.A., Inc.*, 386 F.3d 1371, 1383 (Fed. Cir. 2004); *Contessa*, 282 F.3d at 1377, 62 U.S.P.Q. 2d at 1067; *Goodyear*, 162 F.3d at 1113. This “point of novelty” test is distinct from the “ordinary observer” test, and it is legal error to merge them by, for example, taking the overall claimed design to be the point of novelty. *Bernhardt*, 386 F.3d at 1383 (“[I]n determining infringement, the ‘point of novelty’ test is distinct from

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the ‘ordinary observer’ test and requires proof that the accused design appropriates the novelty which distinguishes the patented design from the prior art.”); *Contessa*, 282 F.3d at 1377, 62 U.S.P.Q. 2d at 1067. “While it is the design as a whole that is patented ... the distinctions from prior designs inform the court's understanding of the patent.” *Goodyear*, 162 F.3d at 1118 (citation omitted). If the overall visual impression of the accused device and the patented design are dissimilar, and would not deceive the ordinary observer, there is no need to address the “point of novelty” test. *KeyStone*, 997 F.2d at 1451, 27 U.S.P.Q. 2d at 1303 (“The only issue presented in [plaintiff's] motion for summary judgment was whether a genuine issue of material fact existed as to overall similarity. Because the court properly concluded that there was no such genuine issue, and both overall similarity and appropriation of the point of novelty are required for design patent infringement, the court did not need to address point of novelty.”)

## **B. Application**

### **1. Claim Construction**

The '581 and '602 Patents are each titled “Sprayer Shroud,” and the claim of each patent is represented by five drawings showing different views of the shroud. (Exhs. A and B to DeCarlo Decl.) The drawings show, respectively, a side view (figure 1), front view (figure 2), top view (figure 3), back view (figure 4), and bottom view (figure 5). (Exhs. A and B to DeCarlo Decl.) Based on its review of the '581 and '602 Patents, the parties' proposed claim constructions, and examples of prior



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art submitted by the parties, the Court construes the Patents' claims as follows:

**a. The '581 Patent<sup>1</sup>**

The trigger sprayer shroud design is as represented in the five drawings contained in the '581 Patent. It does not include the nozzle, trigger, or closure cap. Viewed from the side, the shroud has a horizontal top

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<sup>1</sup> The '581 and '602 Patents' file histories indicate that the PTO examiner originally issued a provisional rejection of the application that resulted in the '581 Patent, based on the judicially created doctrine of obviousness type double patenting. (DeCarlo Decl. Exhs. H, I.) That doctrine is based on the public policy against prolonging a patent term by permitting claims in a second patent that are merely an obvious variation of claims in a prior patent. *In re Vogel*, 57 C.C.P.A. 920, 422 F.2d 438, 164 U.S.P.Q. 619, 621-23 (1970). *See also Sarkisian v. Winn-Proof Corp.*, 697 F.2d 1313, 1324-25, 217 U.S.P.Q. 702 (9th Cir. 1983). The obviousness type double patenting doctrine may be overcome, however, and the second patent may be issued, if the applicant files a terminal disclaimer in compliance with 37 C.F.R. 1.321(b). *Sarkisian*, 697 F.2d at 1326 (reversing the district court's finding of invalidity due to obviousness type double patenting, because “the terminal disclaimer [filed by the second patent applicant] effectively disposed with the problem of the '482 patent's extending the monopoly of the '696 patent beyond the time period permitted by statute.”) That provision allows an applicant to “disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted.” 37 C.F.R. 1.321(b). Although the patent examiner originally found the '581 Patent's claim not to be patentably distinct from that of the '602 Patent, the examiner issued the '581 Patent after Calmar filed a terminal disclaimer. (DeCarlo Decl., Exhs. H, I.) Despite the fact that the examiner found the two designs not patentably distinct, the Court construes the patents' claims separately to reflect differences in the two designs.

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surface which ends in a perpendicular line at the frontmost portion and descends, approximately two-thirds of the way to the back of the shroud, in an obtuse angle into a downwardly sloping rear portion. The rear edge extends downward from the top portion at an approximately 135 degree angle, and then curves more vertically downward to intersect with the base of the shroud very slightly above the level of the closure cap. The bottom edge of the shroud extends horizontally backward from the nozzle for a short distance, and then extends downward at an obtuse angle towards the closure cap. Shortly before it intersects with the closure cap, the bottom edge becomes almost vertical. Approximately halfway up the vertical side surface of the shroud, a line extends from the base of the nozzle horizontally across the side of the shroud, and parallel to the top edge, to the rear edge. It is apparent, on a side view, that the surface of the shroud bulges outward towards the viewer just below the horizontal line, and that the bulged surface extends to the bottom of the shroud.

Viewed from the front, the shroud's sides extend vertically downward until they are even with the base of the nozzle, and then bulge out in a curved and convex manner until they intersect with the closure cap. The back view is a mirror image of the front: the sides extend vertically down from the top edge, and then bulge outward in a curved and convex manner starting approximately halfway down the shroud, to intersect with the closure cap.

Viewed from above, the shroud has a rectangular top surface with sides approximately five times the

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length of the front and back edges. Behind the rectangular top surface, a downwardly-sloping back surface can be seen, of the same width as the top rectangular portion. The back surface slopes down to the rearmost edge of the shroud, which is rounded. Shortly before it intersects with the rearmost edge, the back portion widens significantly outward to intersect with the side edges. Below the top rectangular portion, wider sides can be seen extending down. The sides have approximately parallel edges that curve very slightly inward as they move towards the front of shroud, and curve more dramatically inward approximately two-thirds of the way to the front edge to converge with the sides of the rectangular top surface a short distance before the start of the nozzle.

Viewed from below, the shroud has a gently rounded rear edge and approximately parallel sides that curve very slightly inward until approximately two thirds of the way to the front edge, at which point they curve more dramatically inward to end a short distance before the start of the nozzle. The narrowed, parallel sides then extend straight forward for a short distance to intersect with the nozzle.

**b. The '602 Patent**

The trigger sprayer shroud design is as represented in the five drawings contained in the '602 Patent. It does not include the nozzle, trigger, or closure cap. Viewed from the side, the shroud has a horizontal top surface which ends in a perpendicular line at the frontmost portion and descends, approximately two-thirds of the way to the back of the shroud, in an

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obtuse angle into a downwardly sloping rear portion. The rear edge extends downward from the top portion in a straight line, but curves more dramatically inward shortly before intersecting with the bottom edge of the shroud at slightly above the level of the closure cap. The bottom edge of the shroud extends horizontally backward from the nozzle for a short distance, and then extends downward at an obtuse angle towards the closure cap. Shortly before it intersects with the closure cap, the bottom edge becomes almost vertical. Approximately halfway up the vertical side surface of the shroud, a line extends from the base of the nozzle horizontally across the shroud, and parallel to the top edge, to the rear edge. It is apparent, on a side view, that the surface of the shroud bulges outward towards the viewer just below the horizontal line, and that the bulged surface extends to the bottom of the shroud.

Viewed from the front, the shroud's sides extend vertically downward until they are even with the base of the nozzle, and then bulge out in a curved and convex manner until they intersect with the closure cap. The back view is a mirror image of the front: the sides extend vertically down from the top edge, and then bulge outward in a curved and convex manner starting approximately halfway down the shroud, to intersect with the closure cap. The back of the shroud shows a change in elevation due to an outwardly-protruding bulge that begins approximately one third of the way up the convexly-curving portion of the shroud.

Viewed from above, the shroud has a roughly rectangular top surface with sides approximately five

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times the length of the front and back edges. The back edge of the top surface is rounded, which prevents the shape from being perfectly rectangular. Behind the roughly rectangular top surface, a downwardly-sloping back surface can be seen, of the same width as the top rectangular portion. The back surface slopes down to the rearmost edge of the shroud, which is rounded. Shortly before it intersects with the rearmost edge, the back portion widens significantly outward to intersect with the side edges. Below the top rectangular portion, wider sides can be seen. The sides have approximately parallel edges that curve very slightly inward as they move towards the front of shroud, and curve in more dramatically a short distance before the start of the nozzle. Viewed from below, the shroud has a gently rounded rear edge and approximately parallel sides that curve very slightly inward as they move towards the front of the shroud, and curve in more dramatically a short distance before the start of the nozzle. The narrowed, parallel sides then extend straight forward for a short distance to intersect with the nozzle.

**2. The Ordinary Observer Test**

**a. Who is the “Ordinary Observer”?**

Having construed the patents' claims, the Court now considers whether the overall visual similarity between the AA Trigger and the patented designs would likely deceive an ordinary observer. As an initial matter, the parties differ as to the ordinary observer's identity. Arminak argues that the ordinary observer is a buyer for an industrial purchaser or contract filler, because only such buyers purchase trigger sprayers

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directly. Calmar counters that retail consumers are the “ordinary observer” because they purchase the end products that incorporate the shrouds.

The focus of the “ordinary observer” test “is on the actual product that is presented for purchase, and the ordinary purchaser of that product.” *Goodyear*, 162 F.3d at 1117. “[T]he ordinary observer is not any observer but one who, with less than the trained faculties of the expert, is ‘a purchaser of things of similar design,’ or ‘one interested in the subject.’ ” *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933). Such an observer is not a person who has never seen the type of item the patent describes, “but one who, though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it.” *Id.* See also *Goodyear*, 162 F.3d at 1116 (“[D]eception concerning the patented design is determined from the viewpoint of the person who is the ordinary purchaser of the article charged to be an infringement.”)

The question is whether, where a patented article is only sold to consumers as incorporated into a larger product, the “ordinary observer” is the consumer or the upstream purchaser of the patented item. The Federal Circuit addressed a similar issue in *KeyStone*, which involved a design patent for blocks used in retaining walls. *KeyStone Retaining Wall Systems, Inc. v. Westrock, Inc.*, 997 F.2d 1444, 27 U.S.P.Q. 2d 1297 (Fed. Cir. 1993). After the district court granted the

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defendant's motion for partial summary judgment on the issue of noninfringement, the patentee appealed. On appeal, the patentee argued that the district court had improperly failed to credit evidence that visitors to trade shows were confused between the patentee's blocks and the accused blocks. *Id.* at 1451. The Federal Circuit disagreed, stating that the patentee's evidence improperly focused on the blocks as incorporated into a larger product:

Even crediting [the patentee's] evidence, it did not create a genuine issue for trial on the issue of overall similarity of the accused design with the patented block design because it primarily related to the unpatented wall, not the blocks. Although the blocks when aligned in a retaining wall may create a similar wall appearance, *the patented design is of an individual block, not an assembled wall, and the 'ordinary observer' for the purpose of the block design patent is a purchaser of the patented block, not of the unpatented wall.*

*KeyStone*, 997 F.2d at 1451, 27 U.S.P.Q. 2d at 1302 (emphasis added.)

In *Goodyear*, 162 F.3d at 1113, the Federal Circuit addressed a design patent for a tire tread design used on truck tires. *Goodyear*, 162 F.3d at 1115. Following the district court's determination of noninfringement, the patentee appealed. *Id.* On appeal, it argued that the district court had erred in its claim construction by

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construing the word “tire” in the patent's claim language, “the ornamental design for a tire tread,” to mean “truck tire.” *Id.* at 1116. The patentee further argued that the district court had erred by taking the “ordinary observer” to be a purchaser of truck tires, when the patent was not so limited. *Id.* at 1117. Although the Federal Circuit agreed that the patent was not limited to truck tires, it held that the “ordinary observer” was a trucker or truck fleet operator, because “both the accused tire and the [patentee's] commercial embodiment are truck tires.” *Id.* at 1117. The Federal Circuit held that the focus must be on the “actual use of the accused infringing tread,” the “actual product that is presented for purchase, and the ordinary purchaser of that product.” *Id.* It based this holding on the fact that “the standard [announced in *Gorham*] is whether ... a purchaser [of the patented] item would be misled, by the design similarity imparted to the article by the copier, to think that it is the patentee's design that is being purchased.” *Id.*

That the “ordinary observer” is the purchaser in danger of being misled was confirmed in *Puritan-Bennett Corp. v. Penox Technologies Inc.*, 2004 WL 866618 (S.D. Ind., March 2, 2004). That case presented the issue whether, when a product is purchased by institutional entities for use by individuals, the ordinary observer is the institutional entity or the end user. The patentee, Puritan-Bennett, sued for infringement of its design patent for portable liquid oxygen tanks. *Id.* at \*23. Patients could only obtain the tanks by prescription, and typically rented them from equipment dealers, medical suppliers, or hospitals.



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*Id.* at \*7. The court granted summary judgment for the defendant, holding that there was no infringement as a matter of law because the overall visual impression of the accused device was dramatically different than that of the patented design. *Id.* at \*24-27. The court reached its holding despite Puritan-Bennett's presentation of a survey of hospital patients who used the oxygen tanks, which purported to show consumer confusion. *Id.* at \*26. The court stated that the study failed to present a genuine issue of material fact because the surveyed patients did not represent the “ordinary observer.” *Id.* The ordinary observer, the court held, was a medical equipment distributor and not a patient, because it was the distributors who actually purchased the oxygen tanks. *Id.* The court declined to hold that patients were the ordinary observers, despite the fact that the patentee presented substantial evidence that it marketed its products directly to patients and that its marketing created substantial interest and demand from those patients.<sup>2</sup> *Id.* at \*8-10.

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<sup>2</sup> For example, the patentee “promoted [the commercial embodiment of the patented design] through a national television advertising campaign ... [including] an 800 number for persons to call to obtain more information concerning [its] product ...” *Id.* at \*10. Since the introduction of the television commercial campaign, [the patentee had] received close to 50,000 telephone calls from persons seeking information about [the product]. *Id.* The patentee also presented evidence that it sent product brochures, kits, and other information to patients, launched promotional activities directed towards patients, used newspaper advertisements to promote the products to patients, and generally attempted to create “pull-through” sales of its product by creating demand among end users. *Id.* at \*7-11.

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To similar effect is *Spotless Enterprises, Inc. v. A & E Products Group, L.P.*, 294 F. Supp. 2d 322 (E.D.N.Y. 2003), which involved a design patent for lingerie hangers. Garment manufacturers purchased the hangers from the hanger manufacturer, and then resold them with the garments to stores such as Wal-Mart, Target, and Mervyns. *Spotless Enterprises*, 294 F. Supp. 2d at 329. The court held the “ordinary observer” to be “not the general public, but the sophisticated buyer for the garment manufacturer.” *Id.* at 347.<sup>3</sup>

In light of the above cases, “ordinary observers,” of sprayer shrouds must be buyers for companies that purchase trigger sprayers. It is undisputed that those buyers are the only people who buy trigger sprayers that are not already incorporated into a bottled product. Calmar's Vice President of Sales, Anthony Mirocke, testified in his deposition that Calmar had never sold a single item to a consumer directly. (Mirocke Depo., 210:18-25.) Ed Rodden, a former Calmar customer service manager, stated that it was “accurate” to say that “Calmar's customers are not consumers.” (Rodden Depo., 39:8-11, Exh. 24 to Lee Decl.) Although an end user necessarily obtains the shrouds when she buys the complete household

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<sup>3</sup> Calmar attempts to distinguish *Spotless Enterprises* on the ground that the consumers in that case did not purchase the hangers, whereas buyers of household products purchase the trigger sprayers as part of the product. However, consumers ordinarily do obtain hangers as part of garments they purchase. Moreover, the court in *Spotless Enterprises* did not indicate that it based its holding on a finding that consumers did not purchase the hangers, and gave no indication that the ordinary observer would have been different if they did purchase them.

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product, she is not the “ordinary observer” because she purchases a product into which the patented item is incorporated. *KeyStone*, 997 F.2d at 1451 (“the ‘ordinary observer’ for the purpose of the block design patent is a purchaser of the patented block, not of the unpatented wall.”) *See also Spotless Enterprises*, 294 F. Supp. 2d 322 (purchaser was buyer of hangers, not consumer of lingerie sold on the hangers).

Calmar argues that consumers must be the ordinary observers because consumers notice differences among different types of triggers sprayers and the sprayer design affects the user's physical comfort while using the product. Calmar points to deposition testimony of Mr. Mirocke, who stated that a customer may abandon a particular product if the sprayer trigger doesn't work:

[Y]ou know, if [the consumers] see a difference on the sprayer, the first thing that's going to enter their mind is, what else did they do to change the formula? Did they cheapen it up? You know, if they've changed the sprayer, if they take the sprayer home and it doesn't work just like the one they've been using, the first thing they think of is what did they do to the juice in the bottle. I mean, we've even had them-one of them, I believe it was one we did in the UK, the lady came out and said, Don't change the sprayer. They know the look, they know that's the sprayer that's supposed to be on that bottle.

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(Mirocke Depo., 122:20-123:9.) Calmar also points to testimony by Ronald Wadsworth, designer of the ERGO shroud, who stated in his deposition that the design of the sprayer shroud affects the ease and comfort of use of household products, (Wadsworth Depo., 50:25-52:1, 123:15-19, Exh. 7 to Lee Decl.), and testimony of Ronald B. Fernandez, Calmar's former product manager, who stated that consumers look for “reliability, durability, ease of function, nonleading, [and] aesthetic appeal” in trigger sprayers. (Fernandez Depo., 74:5-10, Exh. 25 to Lee Decl.)

The fact that consumers notice differences in quality between different sprayers, and may have preferences among various types of sprayers, does not establish that they are the “ordinary observer” of sprayer shrouds. The product they purchase is not a trigger sprayer or shroud, but an entire bottle of cleaning solution. *See KeyStone*, 997 F.2d at 1451 (ordinary observer is purchaser of patented block, not unpatented wall incorporating the block.) As in *Puritan-Bennett*, consumer preferences and even direct marketing to consumers do not convert those consumers into “ordinary observers.” Indeed, there is much less evidence of marketing to the end consumer in this case than there was in *Puritan-Bennett*, where the court held that consumers were not ordinary observers despite evidence that some consumers actually called the manufacturer seeking information about the tanks.<sup>4</sup>

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<sup>4</sup> Although Calmar argues that consumers are the “end user,” (Dehoff Decl., ¶ 4) the “end user” test was rejected in *Puritan-Bennett*, in which the patients, though “end users” of the oxygen tanks, were held not to be the ordinary observer.

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Calmar cites *Gorham* for the principle that the “ordinary observer” cannot be an expert, because if experts were the ordinary observer there could never be design patent infringement. It points out that the *Gorham* court criticized the district court's reference to experts as the ordinary observer, stating that “[s]uch a test would destroy all the protection which the act of Congress intended to give. There could never be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them.” *Gorham*, 81 U.S. at 527. This argument fails for several reasons. First, Calmar itself argues that purchasers of trigger sprayers do not necessarily qualify as “experts” on trigger shroud design. Several Calmar employees testified that the companies that buy trigger sprayers range from large, sophisticated entities to relatively unsophisticated operations for whom price is the primary consideration. (*See, e.g.*, Rodden Depo., 40:7-13, Exh. 25 to Lee Decl.) Mr. Rodden, for example, testified that “Calmar had a very broad range of customers, ranging from people that mixed products in bathtubs and bought 5,000 sprayers a year to multinationals like [Proctor & Gamble], who made or ... broke the company, depending on what they bought.” (*Id.*) Mr. Rodden also stated that “there is a small segment of the market that is not sophisticated.” (*Id.* at 206:24-207:1.)

Even assuming that trigger sprayer buyers are “experts,” however, they still are the proper “ordinary observers” in this case. *Gorham's* statement that experts should not be the ordinary observer where they are not the buyers of the relevant product does

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not preclude sophisticated buyers from being the ordinary observer where they are the only ones who purchase the patented product directly.<sup>5</sup> The reason *Gorham* cautioned against using experts as ordinary observers in most cases was that experts in most cases are not purchasers of the relevant items: “*It is [ordinary consumers] who are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be ... the patentees are injured.*” *Gorham*, 81 U.S. at 528, 14 Wall. 511.<sup>6</sup> Thus, *Gorham* counsels that the likelihood of deception must be judged by reference to the people who actually purchase the patented article, and who could be misled by excessive similarity.

Consumers' purchasing decisions are unlikely to hinge on the appearance of sprayer shrouds. Calmar's own evidence shows that consumers base their decisions on other factors, such as the brand and product characteristics. A survey of female users of cleaning products, submitted by Calmar, concludes that “very few women consciously took into consideration the design/shape of the bottle prior to purchasing the product.” (Exh. 16 to Lee Decl., at 226.) The survey quotes participants as saying, about the bottle design, “[i]t doesn't make a bit of difference to

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<sup>5</sup> Indeed, courts have so held. *See, e.g., Spotless Enterprises, Inc. v. A & E Products Group L.P.*, 294 F. Supp. 2d 322 (E.D.N.Y. 2003) (“The ordinary observer in this case is not the general public, but the sophisticated buyer for the garment manufacturer, who purchases the hangers.”); *Puritan-Bennett*, 2004 WL 866618.

<sup>6</sup> Indeed, the patented design in *Gorham* was used on retail items, spoons and forks, primarily purchased by consumers.

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me,” and cites participants' “indifference to container design.” (*Id.*) The survey stated that women were “most concerned with a product's efficacy, breadth of use and/or price. The bottle's design and trigger seemed of lesser interest....” (*Id.* at 216.)<sup>7</sup>

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<sup>7</sup> Under a section entitled “How Products Evaluated/Selected,” the survey stated that “[w]omen evaluated spray glass cleaners and multi-purpose cleaners primarily in terms of their efficacy.” (*Id.* at 220.) The survey concluded that the primary factors considered by buyers of household products were efficacy, breadth of use, familiarity with the product, price, and “container.” (*Id.* at 220.) As to the last factor, the survey commented “[t]he majority of women liked bottles that were clear or only slightly opaque, as these allowed the user to know how much of the product was left.” (*Id.*) Although Calmar presents another document, a “slide presentation,” purporting to represent survey findings on the effect of trigger sprayers on brand value, (Exh. 18 to Lee Decl.) and purporting to conclude that consumers consider trigger sprayer quality an important part of the brand, that study lacks any explanation of its methodology and consequently is not supported by an adequate foundation. In any event, even that study concluded that consumers consider factors unrelated to the appearance of the trigger sprayer, such as “functionality, integrity, durability, and ergonomics,” in addition to “aesthetics,” when deciding whether to buy. (Exh. 18 to Lee Decl., p. 229.) The only evidence Calmar presents that even suggests consumers consider the shroud when making a purchase is unsubstantiated and improper opinion testimony from its President and CEO, John McKernan, that consumers purchase products primarily based on the appearance of the shroud, and statements from its expert, Stephen Dehoff. (McKernan Depo., 80:18-81:4, Exh. 23 to Lee Decl.; Dehoff Decl., ¶¶ 12-23, Exh. 45 to Lee Decl.) Mr. Dehoff testifies that consumers are highly influenced in their purchases by products' overall “shape.” (*Id.*, ¶¶ 12-23.) However, Mr. Dehoff's testimony is insufficient to show that purchasers make their purchasing decisions based on shrouds, because he presents no evidence that the shape of shroud in particular is a significant factor, apart from the shape of the overall product.

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Another survey Calmar presents, entitled “Impact of Trigger Sprayers on Brand Value,” is not to the contrary. The survey is presented in video format, and shows a questioner sitting at tables with women who use household cleaning products. The women say that they would switch to a different brand of cleaner if the trigger sprayer on one brand of product didn't work, and that trigger sprayer failures cause them to think less of the product dispensed through the malfunctioning sprayer. However, none of the women in the survey said that they would consider the appearance of the sprayer shroud in deciding what product to switch to after encountering a sprayer malfunction. Nor did any of them say that they would be deterred from buying a different product if its sprayer shroud appeared similar to a sprayer shroud they recognized from a malfunctioning product. The only conclusion they drew from the poor quality sprayer was that the product itself was faulty; there was no evidence they noticed or made purchasing decisions based on how the shroud looked.

In short, consumers are not at risk of being confused into buying the wrong product by visual similarities between sprayer shrouds. The only people likely to base their purchasing decisions to a significant degree on the shrouds' appearance, or to experience confusion if shrouds are overly similar, are buyers of trigger sprayers. To effectuate *Gorham's* purpose of preventing purchasing decisions based on confusion, it is those buyers who must be taken as the ordinary observer.<sup>8</sup>

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<sup>8</sup> Calmar argues that, under *Goodyear*, the ordinary observer is the purchaser of the item into which the patented design is



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Calmar also cites *Contessa* for the proposition that the “ordinary observer” includes all people who will purchase the product throughout its lifetime, including consumers. (Opposition, p. 7.) Calmar is incorrect. *Contessa* referred to the lifespan of a product in announcing the correct standard for determining *whether deception is likely*, not in announcing the test for the ordinary observer. The Federal Circuit held the district court had erred in failing to consider all views of the patented design that the purchaser was likely to see over the product's lifespan.<sup>9</sup> *Contessa*, 282 F.3d at 1379, 62 U.S.P.Q. 2d at 1069. The Federal

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incorporated, because the truckers and fleet operators in *Goodyear* purchased tires that incorporated the patented tread. (Opposition, p. 11.); *Goodyear*, 162 F.3d at 1117. Like purchasers of tires that incorporate tread, Calmar argues, consumers purchase household products that incorporate sprayer shrouds. Calmar's analogy is inapposite, however, because the focus of the *Gorham* test must be on the purchaser who is at risk of being confused and making the wrong purchase. Whereas a purchaser of truck tires is likely to consider the tread one of the main attributes of the tire, and thus to base his purchasing decision on the tread's appearance, a purchaser of a bottle of cleaning fluid is unlikely to consider the appearance of the sprayer shroud as a major factor in the purchasing decision, as Calmar's own evidence shows. Thus, a more apt analogy to the purchaser of tires incorporating patented tread is a buyer of trigger *sprayers* incorporating a patented shroud.

<sup>9</sup> Specifically, the district court failed to consider the appearance of the underside of the patented shrimp tray, because the underside was “at least partially obscured in the accused product at the point of sale.” *Id.* at 1379. The Federal Circuit held that was error because the ordinary observer test must consider “all ornamental features visible during normal use of the product, i.e. beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article.” *Id.* at 1380.

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Circuit did not state that the product's entire lifespan must be considered to determine *who purchases* the patented item.

For the foregoing reasons, the Court concludes that the ordinary observer of trigger sprayer shrouds is the purchaser of trigger sprayers.

**b. Would the Ordinary Purchaser of Trigger Sprayer Shrouds be Deceived by the Similarities Between the AA Trigger and the Patented Designs?**

Calmar's own evidence indicates that buyers for companies that purchase sprayer shrouds are not deceived by the similarities between the AA Trigger and the patented designs. A former Calmar customer service manager, Ed Rodden, testified that most of Calmar's customers "wouldn't be fooled for a second." (Rodden Depo., 39:23-40:5, 206:17-23, 207:2-5.) Calmar's expert, Stephen Dehoff, testified that "[i]t would be a significant exception for a corporate buyer purchasing the Arminak trigger sprayer to confuse the Calmar Ergo Shroud and the Arminak AA shroud," and that "[t]here is essentially no question that a corporate buyer purchasing these trigger sprayers with these specific shrouds would be able to tell the difference easily." (Dehoff Decl., ¶¶ 3(2), 5.) The only qualification to these statements is a statement by Mr. Rodden that some of Calmar's smaller customers, whose primary consideration is price, are "not sophisticated and potentially could be fooled." (*Id.* at 206:24-207:2.) However, Calmar's Vice President of Sales, Anthony Mirocke, admits that he is not aware of

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any of Calmar's customers having expressed confusion between the AA Trigger and the ERGO shroud. (Mirocke Depo., 218:21-219:11.) The only other evidence Calmar presents supporting potential confusion by its customers is a statement by Mr. Mirocke that “Some of my customers would recognize [the difference] in a second. Others would not.” (Mirocke Depo., 121:15-19). The ones who would not, Mr. Mirocke testified, were “[t]he B and C customers, someone buying for Dollar General.” (*Id.* at 18-19.)<sup>10</sup> However, testimony that some consumers might not immediately recognize the difference is insufficient to create a triable issue of fact as to whether the ordinary buyer of trigger sprayers is likely to be deceived.

Even apart from Calmar's admission that most of its customers would not be deceived, the Court's independent comparison of the patented designs and the AA shroud convinces it that no reasonable buyer of trigger sprayers would confuse them. Calmar urges the

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<sup>10</sup> Calmar also presents deposition testimony by Odie Cernonok, a salesman for Arminak, who testified while viewing an array of unspecified trigger sprayers made by “different manufacturers.” When asked “Do they all look the same?” he replied “Pretty much.” (Cernonok Depo., 84:2-5, Lee Decl., Exh. 38.) This evidence is irrelevant, however, because there is no indication which triggers are shown in the display or even whether the similarities between them are sufficient to cause Mr. Cernonok to be deceived. Moreover, Mr. Cernonok is a salesman and not a buyer of triggers, and thus not an “ordinary observer.”

Calmar also presents evidence that Arminak's expert, Daniel Cislo, confused an example of a trigger sprayer called the Y2-8 Trigger, which Calmar considers is almost identical to the AA Trigger, with the ERGO Shroud in a deposition. (Opposition, p. 14; Lee Decl., Exh. 31.) However, this evidence also is irrelevant, as Mr. Cislo is a lawyer, not a buyer of trigger sprayers.

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Court to focus only on the side views of the accused product and the designs, because shoppers in a supermarket are most likely to view the products from the side, standing a substantial distance away, and are unlikely to look at the triggers from the front or bottom. Calmar also urges the Court to disregard aspects of the AA Trigger and patented designs that do not appropriate the “points of novelty” that Calmar asserts. Arminak counters that all views claimed in the patent are relevant, and that the Court should focus on all aspects of the design and accused article rather than simply the asserted points of novelty.

The Court's comparison takes into consideration all the views included in the design patents, not simply those views that a customer would likely see when viewing cleaning products on a store shelf at the point of sale. *Contessa*, 282 F.3d at 1379 (district court erred in considering only the views of the patented shrimp tray design that a consumer likely would see at the point of sale.) Also, at this stage the Court declines to consider only the asserted points of novelty in the patented designs, because the “point of novelty” test is separate from the ordinary observer inquiry. *Bernhardt*, 386 F.3d at 1383. Indeed, there is no need even to consider the point of novelty test if the overall visual impression of the two articles is dissimilar. *KeyStone*, 997 F.2d at 1451.

Based on all the figures disclosed in the '581 and '602 Patents, striking differences between the AA Trigger and the patented designs create an overall visual impression of dissimilarity. On a side view, one is struck by the fact that the AA Trigger, but not the

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patented designs, has an upwardly-slanting line running from the base of the shroud to the horizontal line, and a raised surface defined by the intersection of that slanted line and the horizontal one. By contrast, the patented designs show no change in elevation on the portions of the trigger sides below the horizontal line. This difference creates a significantly different visual impression: a constant, smooth surface in the patented designs, versus a varied surface in the accused shroud. Further dissimilarity appears on the back view: the patented designs slope downward in a rounded, convex, and consistent manner below the level of the horizontal side line, while the AA Trigger has straight edges below the line and a flared shape that first extends outward and then tapers in again before reaching the bottom of the shroud. (*See* Exh. 8 to Lee Decl., Photographs of AA Shroud compared to figures in '581 and '602 Patents.) The front of the AA Trigger is similarly angular and flared, in contrast to the ERGO shroud's rounded sides.<sup>11</sup> Taking a top view, the patented designs show sides generally parallel to the topmost rectangular surface so that the overall shape is roughly rectangular. The AA Trigger, by

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<sup>11</sup> In making its comparison, the Court considered both the designs in the '581 and '602 Patents and actual samples of the ERGO shroud submitted by Arminak. The Court considers the commercial embodiment of the '581 Patent because it does not differ significantly from the drawings in the patent. *See Braun, Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 820 n.8, 975 F.2d 815, 24 U.S.P.Q. 2d 1121 (Fed. Cir. 1992) (*quoting Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988)) (“Where, as here, no significant distinction in design has been shown between the patent drawing and its physical embodiment, it is not error for the court to view them both, and to compare the embodiment of the patented design with the accused devices.”)

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contrast, has sides that flare outward from the back of the shroud to the middle, flatten out for a short distance, and then converge towards the front, to give an approximately diamond-shaped appearance. The same difference in shape appears when the designs are examined from the bottom. The overall differences in shape and surface elevation create a striking degree of dissimilarity between the patented designs and the accused device, such that no reasonable jury could find that an ordinary purchaser of trigger sprayers would be deceived.

The only similarities between the AA Trigger and patented designs are the general outline of the side view and the existence of a horizontal line running from front to back. However, the similarity of side outline is no greater than that between the patented designs and similar outlines disclosed in U.S. Patent Des. No. 321,315, (the “'315 Patent”), cited as a prior art reference by Calmar, and No. 5,156,299 (the “'299 Patent”), issued on October 20, 1992. (Exh. 41 to Lee Decl., Tab 45; Exh. L to DeCarlo Decl. *See also* Exh. 33 to Lee Decl. (comparing figures in '581 Patent to figures in '315 Patent)). Thus, “while there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art.” *Applied Arts*, 67 F.2d at 430. Moreover, the rough similarity of side outline cannot overcome the AA Trigger's distinguishing upwardly-sloping diagonal line and varied surface elevation, which are absent

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from the patented designs, and the numerous differences in overall shape that appear from the top, bottom, front, and back views.

### 3. Point of Novelty

Even if an ordinary observer could be deceived by the similarities between the accused shroud and the patented designs, whatever similarities exist do not stem from the points of novelty claimed in the '581 and '602 Patents. Calmar contends that those points of novelty are:

- There is a prominent horizontal line extending along each side [of the shroud], parallel to the top surface of the shroud, all the way to the sloped rear surface; and
- The sides of the shroud first go straight downwardly, and then, as viewed from the rear, at the horizontal lines on each side, bulge outwardly in a bulbous fashion, to the bottom rear of the shroud.

(Opposition, p. 16 n. 68 (referring to Exh. 12 to Lee Decl.); Exh. 12 to Lee Decl., at 157.)

Arminak argues that neither of Calmar's asserted points of novelty are in fact novel, because both are disclosed in what Arminak characterizes as a prior art reference: U.S. Patent No. 327,222 (the “'222 Patent”), issued on June 23, 1992. (Exh. 1 to Lee Decl.)<sup>12</sup> Having viewed the '581 and '602 Patents' file histories, the examples of prior art submitted by Calmar, and

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<sup>12</sup> Calmar disputes that the '222 Patent is part of the prior art.

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Calmar's description of its asserted points of novelty, the Court concurs with Calmar's characterization of the points of novelty in the '581 and '602 Patents.

Those points of novelty, however, do not create an overall impression of similarity. The AA Trigger's sides do not “bulge outwardly in a bulbous fashion,” but instead flare out in straight lines before converging slightly inward towards the bottom of the shroud.<sup>13</sup> While the “bulbous” portion of the patented designs begins approximately halfway down the back of the shroud, the flare in the AA Trigger occurs more than halfway down. Overall, the AA Trigger and the patented designs are significantly dissimilar when viewed from the back.<sup>14</sup> The only similarity is in the

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<sup>13</sup> Calmar asserts, through the declaration of John McNulty, that the AA Trigger has convex sides. (McNulty Decl., ¶ 18.) Mr. McNulty bases his assertion on a patent application Arminak filed for the AA Trigger, No. 29/202,909, which the PTO rejected, and claims that the application's drawings show that the AA Trigger has convex sides, because the patent examiner drew convex lines next to one of the drawings. (*Id.*) However, the application does not show that the AA Trigger has convex sides. The reason the PTO rejected the application was that the front and back images of the AA Trigger in the application were incompatible and not mirror images. (Exh. 2 to Lee Decl., at 60, 65.) The drawing that showed the AA Trigger from the front showed flat sides, whereas the drawing from the back showed convex sides. (*Id.* at 65.) The samples of the AA Trigger submitted by Arminak, and the photographs of the AA Trigger that Calmar submitted as Exhibits 8 and 35 to the Lee Declaration, show that the actual article has flat, not convex, sides. (*See* Exhs. 8, 35 to Lee Decl.)

<sup>14</sup> The '222 Patent's drawings confirm that the AA Trigger does not contain the “bulbous sides” point of novelty Calmar claims. The AA Trigger's flared appearance, when viewed from the back, is similar to the back view disclosed in the '222 Patent. The '222 patent contains a drawing of a trigger sprayer viewed from



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shrouds' general outline when viewed from the side, and the horizontal line running along the side from the nozzle to the rear edge. Although the line is a point of novelty, it is insufficient to lead to an overall impression of similarity, especially since the line on the AA Trigger is intersected by a slanted line defining a raised surface. Consequently, the Court concludes that the “point of novelty” test would not be met even if overall visual similarity did exist.

### III. Conclusion

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the back, with sides that first extend almost vertically downward, and then angle out more sharply before becoming vertical lines near the bottom of the shroud. While the Court does not find that the '222 Patent contains the “bulbous sides” point of novelty claimed in the '581 or '602 Patents, the '222 Patent and others contained in the prior art submitted by Calmar establish that the field of trigger sprayers is crowded and therefore the “range of equivalents” to the '581 and '602 Patents should be construed narrowly. *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444, 221 U.S.P.Q. 97 (Fed. Cir. 1984) (*overruled in part on other grounds in Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 112 S.Ct. 2753 (1992)) (“Where ... a field is crowded with many references relating to the design of the same type of appliance, we must construe the range of equivalents very narrowly.”). This is especially so because the prior art, though not teaching the precise points of novelty disclosed in the '581 and '602 Patents, contains several references disclosing horizontal lines running along the side of the shroud (Exh. 41 to Lee Decl., Tabs 8, 23, 26, 29, 36) and back portions that widen from top to bottom (Exh. 41 to Lee Decl., Tabs 1, 5, 6, 31). Indeed, any similarity that might appear between the back portion of the AA Trigger and the back drawings of the patented designs is no greater than the similarity between the back views claimed in the patented designs and the back view shown in the '222 Patent. *See Applied Arts*, 67 F.2d at 430.



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**APPENDIX C  
ORDER DENYING COMBINED PETITION FOR  
REHEARING AND REHEARING *EN BANC***

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

2006-1561

ARMINAK AND ASSOCIATES, INC. and HELGA  
ARMINAK,

Plaintiffs/Counterclaim  
Defendants-Appellees,

and

ARMIN ARMINAK,

Counterclaim Defendant-  
Appellee,

v.

SAINT-GOBAIN CALMAR, INC.  
(now known as MeadWestvaco Calmar, Inc.),

Defendant/Counterclaimant-  
Appellant.

**O R D E R**

NOTE: This order is nonprecedential.

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

**O R D E R**

A combined petition for panel rehearing and for rehearing en banc having been filed by the Appellant,\* and a response thereto having been invited by the court and filed by the Appellees, and the petition for rehearing and response, having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same here is, DENIED, and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on December 12, 2007.

FOR THE COURT,

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\* A amicus brief filed on behalf of Industrial Designers Society of America.

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/s/  
Jan Horbaly  
Clerk

Dated: 12/05/2007

cc: Roger D. Taylor  
Daniel C. DeCarlo  
Perry J. Saidman

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

DEC -5 2007

JAN HORBALY  
CLERK

ARMINAK V SAINT-GOBAIN, 2006-1561  
(DCT - 04-CV-1455)

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**APPENDIX D**  
**35 U.S.C. § 171**

**§ 171. Patents for designs**

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. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

**APPENDIX E**  
**35 U.S.C. § 271**

**§ 271. Infringement of patent**

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his

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consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement; (4) refused to license or use any rights to the patent; or (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

(e)(1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products.

(2) It shall be an act of infringement to submit--

(A) an application under section 505(j) of the Federal Food, Drug, and Cosmetic Act or described in section 505(b)(2) of such Act for a drug claimed in a patent or the use of which is claimed in a patent, or



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(B) an application under section 512 of such Act or under the Act of March 4, 1913 (21 U.S.C. 151-158) for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent,

if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug or veterinary biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent.

(3) In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).

(4) For an act of infringement described in paragraph (2)--

(A) the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,

(B) injunctive relief may be granted against an infringer to prevent the commercial manufacture, use,

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offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product, and

(C) damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product.

The remedies prescribed by subparagraphs (A), (B), and (C) are the only remedies which may be granted by a court for an act of infringement described in paragraph (2), except that a court may award attorney fees under section 285.

(5) Where a person has filed an application described in paragraph (2) that includes a certification under subsection (b)(2)(A)(iv) or (j)(2)(A)(vii)(IV) of section 505 of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355), and neither the owner of the patent that is the subject of the certification nor the holder of the approved application under subsection (b) of such section for the drug that is claimed by the patent or a use of which is claimed by the patent brought an action for infringement of such patent before the expiration of 45 days after the date on which the notice given under subsection (b)(3) or (j)(2)(B) of such section was received, the courts of the United States shall, to the extent consistent with the Constitution, have subject matter jurisdiction in any action brought by such person under section 2201 of

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title 28 for a declaratory judgment that such patent is invalid or not infringed.

(f)(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process

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patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after--

(1) it is materially changed by subsequent processes; or

(2) it becomes a trivial and nonessential component of another product.

(h) As used in this section, the term “whoever” includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

(i) As used in this section, an “offer for sale” or an “offer to sell” by a person other than the patentee, or any designee of the patentee, is that in which the sale will occur before the expiration of the term of the patent.

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**APPENDIX F**  
**35 U.S.C. § 289**

**§ 289. Additional Remedy for Infringement of Design Patent**

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.