

No. 07-1263

**In The
Supreme Court of the United States**

SAINT-GOBAIN CALMER, INC.,
nka MEADWESTVACO CALMAR, INC.,
Petitioner,

v.

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

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

**BRIEF OF *AMICUS CURIAE* INDUSTRIAL DESIGNERS
SOCIETY OF AMERICA IN SUPPORT OF PETITIONER
AND MOTION TO FILE BRIEF *AMICUS CURIAE* IN
SUPPORT OF THE PETITION FOR WRIT OF CERTIORARI**

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May 5, 2008

**MOTION FOR LEAVE TO FILE A BRIEF AS
AMICUS CURIAE IN SUPPORT OF THE
PETITION FOR WRIT OF CERTIORARI**

Pursuant to Rule 37.2(b) of the Rules of the Supreme Court, the Industrial Designers Society of America (“IDSA”) respectfully moves this Court for leave to file the accompanying brief *amicus curiae* in support of the Petition for *Writ of Certiorari* submitted by Petitioner, Saint-Gobain Calmar, Inc. (“Calmar”). Consent of from Petitioner was requested and obtained. Respondents Arminak & Assoc., Inc, Helga Arminak, and Armin Arminak (“Arminak”), however, have not granted consent, thereby making this motion necessary.

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

Design patents, which are authorized by 35 U.S.C. § 171, are the primary means to protect industrial designs the United States. An informal survey

conducted in 2004 revealed that IDSA members, as a whole, held approximately 2,000 design patents. The laws regarding the protection and enforcement of design patents are of great concern to the IDSA, which has led it to step forward and address the threat posed to its members by the United States Court of Appeals for the Federal Circuit's holding in *Arminak & Assoc., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314 (Fed. Cir. 2007).

IDSA has no stake in any of the parties to this litigation or the result of this case other than its interest in seeking correct and consistent interpretation of the law as it relates to intellectual property issues, and particularly design patent jurisprudence.

For the above reasons, the IDSA respectfully requests that this MOTION FOR LEAVE TO FILE A BRIEF AS *AMICUS CURIAE* IN SUPPORT OF THE PETITION FOR *WRIT OF CERTIORARI* be granted.

Respectfully submitted,

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INTEREST OF AMICUS CURIAE¹

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

Design patents, which are authorized by 35 U.S.C. § 171, are the primary means to protect industrial designs the United States. An informal survey conducted in 2004 revealed that IDSA members, as a whole, held approximately 2,000 design patents. The laws regarding the protection and enforcement of design patents are of great concern to the IDSA, which has led it to step forward and address the threat posed to its members by the United States Court of Appeals

¹ Counsel of record for all parties received notice of *amicus’s* intention to file this brief at least 10 days prior to its due date. Pursuant to Rule 37.6, *amicus curiae* state that no counsel for a party authored this brief in whole or in part, and no person or entity other than *amicus curiae*, its members, or its counsel made a monetary contribution intended to fund this brief’s preparation or submission.

for the Federal Circuit's holding in *Arminak & Assoc., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314 (Fed. Cir. 2007).

IDSA has no stake in any of the parties to this litigation or the result of this case other than its interest in seeking correct and consistent interpretation of the law as it relates to intellectual property issues, and particularly design patent jurisprudence.

INTRODUCTION

Addressing the purpose of the design patent statute, this Court, in *Gorham v. White*, 81 U.S. 511 (1871), stated that:

The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that, not an abstract impression, or picture, but an aspect given to those objects mentioned in the acts. It is a new and original design for a manufacture, whether of mental or other material; a new and original design for a bust, statue, bas relief, or composition in alto or basso relievo; a new or original impression or ornament to be placed on any article of manufacture; a new and original design for the printing of woollen, silk, cotton, or other fabrics; a new and useful pattern, print, or picture, to be either worked into, or on, any article of manufacture; or a new and original shape or configuration of any article of

manufacture -- it is one or all of these that the law has in view.

Id. at 524-25. Today, over one hundred and thirty years later, with these protections in mind, American businesses are investing record amounts of resources towards the aesthetic appearances of their product designs. It is more evident now than ever that quality industrial design is needed to compete in the global market place. As the amount of resources invested in industrial design has grown, so too has the need for fair, effective and reliable means to protect and enforce such designs. While the design patent statute, 35 U.S.C. 171, provides the means to protect a design, this case addresses the means to enforce such design patents. Specifically, this case seeks resolution on the following fundamental issue: **What is the proper test for design patent infringement?**

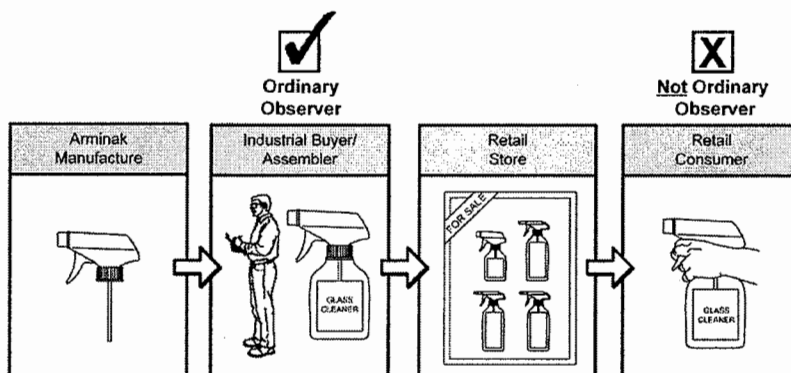
This Court has heard only two design patent cases in its history, both in the 19th century: *Gorham v. White*, 81 U.S. 511 (1871) and *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893). In 1871, the *Gorham* Court laid down the test for design patent infringement. Now, over one hundred and thirty years later, the Federal Circuit has altered and distorted this Court's *Gorham* test, divorcing the test from its original intent and purpose. It is the hope of *amicus curiae* that this Court will restore its *Gorham* test as the test for design patent infringement and thereby chart the proper course for 21st century American industrial design.

SUMMARY OF ARGUMENT

Over one hundred and thirty years ago, this Court laid down the test for design patent infringement in *Gorham v. White*, 81 U.S. 511 (1871). Neither this Court nor Congress has modified, or even addressed, the test ever since. Since 1871, the *Gorham* test has been the bedrock of design patent jurisprudence. The *Gorham* Court held that the test for design patent infringement, which compares the overall appearance of the patented design with that of the accused design, is to be judged through the “eyes of men generally,” and not through the eyes of a “person in the trade.” *Id.* 527-28. The Court reasoned that a test based on the observations of “persons in the trade” would “destroy all the protection which the act of Congress intended to give.” *Id.* This is because persons versed in the trade can readily discern subtle and inconsequential variations or differences between similarly-designed products. *Id.* As a result, these “extra-ordinary observers” will rarely, if ever, be deceived by similarly-designed products, making it virtually impossible for a design patent holder to prove design patent infringement. Indeed, under such test, the only cases in which infringement would be found are those in which the infringing party sold an exact replica of the patented design. This is not the result intended by the *Gorham* Court when it established the “ordinary observer” test, or by Congress when it passed the Patent Act.

In Arminak & Assoc., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314 (Fed. Cir. 2007), however, the Federal Circuit rejected a design patent infringement test based on the “eyes of men generally,” and instead

created a test that relies on the perceptions of “persons in the trade,” namely, Industrial Buyers (also known as “Organization Buyers”). Graphically, the *Arminak* holding can be depicted as follows:



(See Appendix A.) The *Arminak* holding must be reversed for the following two reasons.

First, the *Arminak* holding uses the perceptions of Industrial Buyers to determine infringement, which is in direct conflict with this Court’s holding in *Gorham*. *Gorham* expressly prohibits the use of the perceptions of “persons in the trade” for making design patent infringement determinations. Simply put, Industrial Buyers are “persons in the trade.” They are trained professional whose job depends on their ability to discern minor differences between products; rarely, if ever, will they be deceived by a design other than an exact copy. In a word, the perceptions of Industrial Buyers are anything but “ordinary.”

Second, *Arminak*’s new two-part test for determining the identity of the ordinary observer wrongly disqualifies everyday observers, such as retail

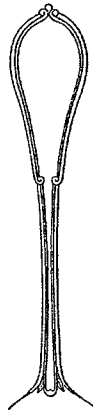
consumers and even jurors, from serving as ordinary observers, again placing it in direct conflict with this Court's holding in Gorham. *Arminak* reasons that these persons are disqualified from serving as ordinary observers because they do not possess "the capability of making a reasonably discerning decision" regarding the decision of infringement. *Id.* Yet, everyday observers, such as retail consumers and the average juror, possess precisely the everyday perceptions and sensibilities that the *Gorham* Court sought to utilize with its "ordinary observer" test. After all, jurors represent a cross section of the purchasing community and by their very nature are "ordinary." The *Arminak* court has wrongly replaced the "ordinary observer" test with an "extraordinary observer" test. Worse yet, *Arminak's* new test is not limited to the particular facts of *Arminak*, where the patented item was a component part. Rather, the *Arminak* test is laid down in broad terms, and if not reversed, will threaten the enforceability of nearly all design patents.

For the reasons stated herein, *amicus curiae* respectfully request that this Court grant the Petition for *Writ of Certiorari*, with hopes that this Court will ultimately reverse the Federal Circuit's holding in *Arminak*, and restore the "ordinary" requirement in the Court's "ordinary observer" test for design patent infringement, as set forth in *Gorham v. White*.

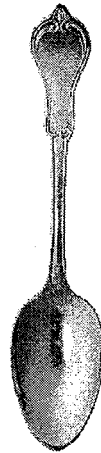
ARGUMENT**I. The Federal Circuit's Selection Of An Industrial Buyer As The "Ordinary Observer" Violates This Court's Test For Design Patent Infringement Set Forth In *Gorham v. White*.**

This Court laid down the test for design patent infringement in *Gorham v. White*, 81 U.S. 511 (1871). The test has remained the law ever since. The *Gorham* Court was confronted with the following fundamental issue: Should the test for design patent infringement, which compares the overall appearance of the patented design with that of the accused design, be judged through the "eyes of persons in the trade" or through the "eyes of men generally?"

Below is Gorham's patented handle design on the left, and White's accused handle design on the right.



Gorham's
Patented Handle Design



White's
Accused Handle Design

During the proceedings below in *Gorham*, the defendant White proffered testimony from scores of “persons in the trade” (e.g., merchants, dealers, brokers, designers, etc.) who testified that, in their opinion, the two designs were substantially different. *Id.* The plaintiff Gorham, on the other hand, introduced evidence showing that “ordinary observers” would perceive the two designs as substantially similar. *Id.* The plaintiff urged the lower court to use the perceptions of the “ordinary observer” as the proper test for determining design patent infringement. The lower court, however, disagreed with the plaintiff’s proposed test concluding:

It is impossible to assent to the view, that the test, in regard to a patent for a design, is the eye of an ordinary observer.

Gorham Mfg. Co. v. White, 10 F. Cas. 827, 830 (C.C.S.D.N.Y. 1870). Instead, the lower court held that design patent infringement must be based on the perceptions of **persons versed in the trade**:

That test can only be ... substantial identity... in view of the observation of a person versed in designs in the particular trade in question -- of a person engaged in the manufacture or sale of articles containing such designs -- of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side.

Id. Applying this test, the lower court found that the White design did not infringe Gorham’s design patent:

...comparing the designs of White with the plaintiffs' design, it is satisfactorily shown, by the clear weight of testimony, that the designs of White are not substantially the same as the plaintiffs' design. ... The substance of the evidence of the most intelligent of them, persons in the trade, is merely to the effect, that the White designs are not substantially the same as the plaintiffs' design, but were intended to appear to be the same to an ordinary purchaser, and will so appear to him, but that a person in the trade will not be deceived, by the resemblance, into purchasing an article of the one design for an article of the others.

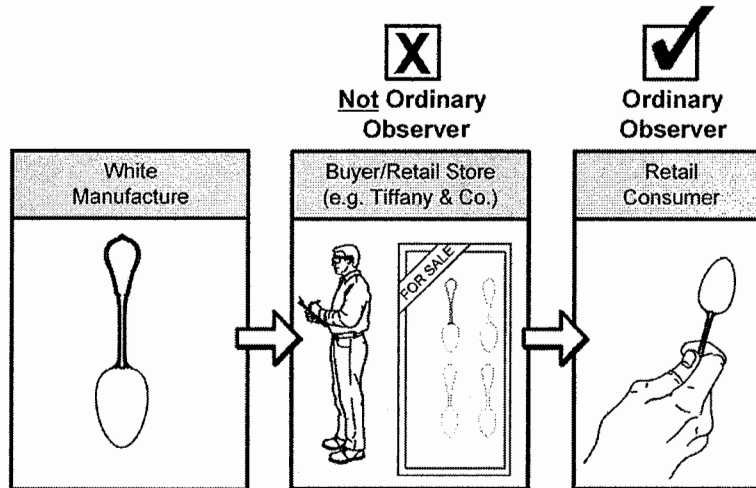
Id.

This Court reviewed the matter and flatly rejected the lower court's design patent infringement test, which relied on the perceptions of persons versed in the trade. *Gorham Mfg. Co. v. White*, 81 U.S. 511 (1871). Specifically addressing the lower court's test, the Court stated:

The learned judge thought there could be no infringement unless there was "substantial identity" "in view of the observation of a person versed in designs in the particular trade in question -- of a person engaged in the manufacture or sale of articles containing such designs -- of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side." There must, he thought, be a comparison of the features which make up the

two designs. **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. No counterfeit bank note is so identical in appearance with the true that an experienced artist cannot discern a difference. It is said an engraver distinguishes impressions made by the same plate. Experts, therefore, are not the persons to be deceived. Much less than that which would be substantial identity in their eyes would be undistinguishable in the eyes of men generally, of observers of 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 527 (*emphasis added*). Thus, the *Gorham* Court expressly prohibited infringement determinations based on the perceptions of persons versed in the trade. *Id.* The *Gorham* Court held that design patent infringement determinations must be based on the perceptions of “the eyes of men generally,” “observers of ordinary acuteness” and “men of ordinary intelligence.” *Id.* Graphically, the *Gorham* Court’s holding can be depicted as follows:



(See Appendix A.) Applying these principles, the Court laid down the following test that has governed design patent infringement for more than one hundred and thirty years:

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 (*emphasis added*). Thus, in addition to holding that design patent infringement is to be judged through the eye of the ordinary observer, the Court also expressly disqualified the observations of the following “persons in the trade” for purposes of making design patent infringement determinations:

- a person versed in 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 one with another, and who sees and examines the articles containing them side by side.

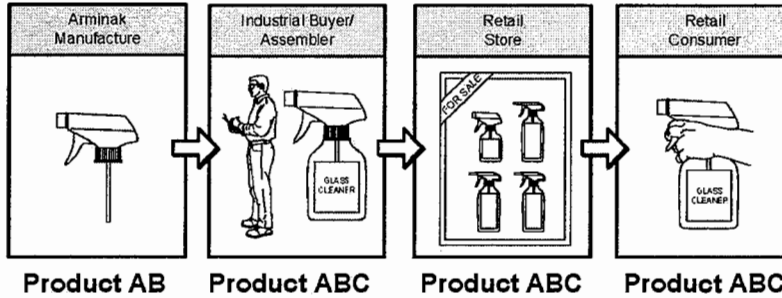
Id. at 527. Such “persons in the trade” are not ordinary observers, but instead, extraordinary observers.

In Arminak & Assoc., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314 (Fed. Cir. 2007), the Federal Circuit disregarded the “eyes of men generally,” and based a design patent infringement analysis on the perceptions of “persons in the trade” – namely, Industrial Buyers.

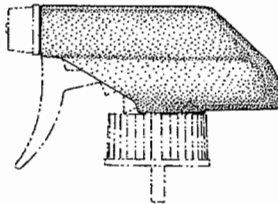
Stated generally, the facts of *Arminak* can be fairly stated as follows. Product A is combined by its manufacturer with Product B to create Product AB which is then sold by the manufacturer to an Industrial Buyer who, in turn, assembles Product AB with Product C. The resulting Product ABC is, in turn, sold by the Industrial Buyer to a retailer, who then sells Product ABC to a consumer. Applying this general framework to the specific facts in *Arminak*, Product A is a sprayer shroud for a trigger sprayer device, Product B comprises the other parts of a trigger sprayer device including the nozzle, trigger and tube, Product C is a bottle of liquid, Product AB is the combination of the sprayer shroud and the trigger sprayer purchased by an Industrial Buyer, and Product ABC is the finished product of the sprayer shroud, trigger sprayer and bottle of liquid (e.g., Mr. Clean®) that is assembled and sold by an Industrial Buyer (e.g., Procter & Gamble) to a retailer (e.g., Wal-

Mart) who resells it to a consumer. Below is a graphical representation of the stream of commerce in *Arminak*.

Arminak's Stream of Commerce



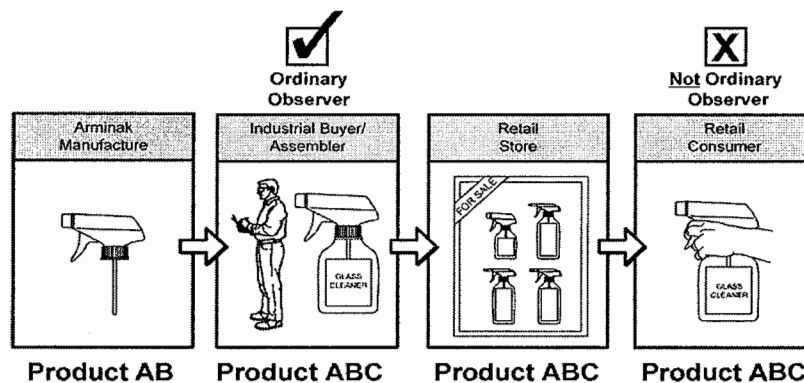
Calmar's '381 patent is directed only at a sprayer shroud, not an entire trigger sprayer or finished retail product. The other parts of the trigger sprayer (e.g. nozzle, trigger, cap and tube) are depicted in dotted lines in the patent's drawing, and thus form no part of the patented design.



Neither the Industrial Buyer, nor the Retail Consumer purchased the '381 patented item in "isolation." Rather, both parties purchased the patented item in combination with other non-patented components.

Analyzing the issue of infringement, the *Arminak* court sought to determine who should be the ordinary

observer: the Industrial Buyer who purchased Product AB, or the Retail Consumer who purchased Product ABC. The *Arminak* court concluded that the ordinary observer was the Industrial Buyer, and not the Retail Consumer. *Id.* at 1323-24. Graphically, the *Arminak* court's holding can be depicted as follows:



In short, the Federal Circuit in *Arminak* reached the same erroneous conclusion as the lower court in *Gorham*. Both courts erroneously rejected the perceptions of ordinary persons, in exchange for the perceptions of “persons in the trade.”

While the *Arminak* court acknowledged *Gorham*'s prohibition in *Gorham* on the use of the observations of “persons in the trade” for infringement determinations, it never answered, or even addressed, whether Industrial Buyers were “persons in the trade.” Indeed, Industrial Buyers fall into not just one, but all three, of the very classes of persons that this Court expressly prohibited:

- 1) “a person versed in designs in the particular trade in question”

- Industrial Buyers inspect and analyze a wide range of products incorporating the accused design during the course of making purchasing decisions.

2) “a person engaged in the manufacture or sale of articles containing such designs”

- *Industrial Buyers* are engaged in the sale of the products incorporating the accused design as they negotiate price and quantity.
- *Industrial Buyers* purchase products incorporating the accused design with full knowledge of the manufacturing and assembly processes into which such designs will be integrated

3) “a person accustomed to comparing such designs one with another, and who sees and examines the articles containing them side by side”

- Industrial Buyers inspect and analyze a wide range of products incorporating the accused design, comparing such designs with another while making purchasing decisions.

Id. at 527. Simply put, Industrial Buyers are “persons in the trade,” and thus precluded by *Gorham* from serving as ordinary observers. Accordingly, the *Arminak* holding violates this Court’s precedent and should be reversed.

As a matter of policy, the *Arminak* holding threatens the enforceability of virtually all design patents. This is because, as discussed above, the “extra-ordinary observer,” who is well-versed in the trade, can readily discern subtle variations or differences between similarly-designed products. As a result, the “extra-ordinary observer” will only rarely, if ever, be deceived by similarly-designed products, and it will be virtually impossible for a design patent holder to prove design patent infringement. Under *Arminak*, the only cases in which infringement would be found are those in which the infringing party sold an exact replica of the patented design. This is not the result intended by the Court when it established the “ordinary observer” test, or by Congress when it passed the Patent Act. Just as this Court reversed the lower court in *Gorham*, this Court should reverse the lower court in *Arminak*.

II. The Federal Circuit’s New Test For Identifying The Ordinary Observer Wrongly Excludes The Perceptions Of Everyday Observers, Such As Retail Consumers And Jurors, Violating This Court’s Test For Design Patent Infringement Set Forth In *Gorham v. White*.

Not only did the *Arminak* court fail to abide by *Gorham*’s prohibition on the use of “persons in the trade” as the basis for design patent determinations, but it also devised an ill-advised new two-part test for selecting the ordinary observer. The new test, violates *Gorham*, by taking the determination of design patent infringement out of the hands of the every day observers, such as retail consumers and jurors, and places it into the hands of “persons in the trade.” *Arminak*’s new two-part test for identifying the “ordinary observer” is as follows:

“... the ordinary purchaser is a person

(1) who is either a purchaser of, or sufficiently interested in, the item that displays the patented design, and

(2) who has the capability of making a reasonably discerning decision when observing the accused item’s design [to determine] whether the accused item is substantially the same as the item claimed in the design patent.”

Id. at 1323 (*emphasis and enumeration added*). The problematic portion of *Arminak*’s new test resides in the second prong.²

Applying the second prong of its new test, the *Arminak* court disqualified Retail Consumers from being ordinary observers because, in the court’s opinion, Retail Consumers do not possess “the capability of making a reasonably discerning decision when observing the accused item’s design [to determine] whether the accused item is substantially the same as the item claimed in the design patent.” *Id.* The new test improperly seeks to base infringement determinations on the perceptions of a specific subclass of individuals who have above-average intelligence regarding the designs in the trade, setting design patent

² With respect to the first prong, both the Industrial Buyer and the Retailer Consumer in *Arminak* were “purchasers” of items displaying the accused patent design - Product A. The Industrial Buyer purchased Product AB; the Retail Consumer purchased Product ABC.

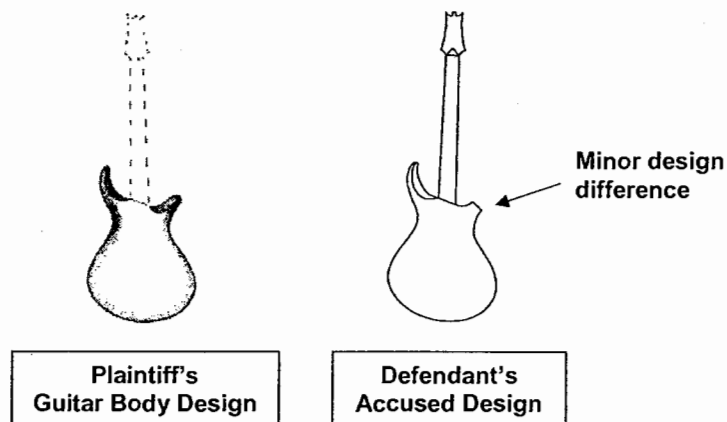
jurisprudence on a crash course with *Gorham*, which specifically calls for the perceptions of ordinary observers.

The *Arminak* court derived the second prong of its new test from the Sixth Circuit's opinion in *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933), which it quoted at length. *Arminak*, 501 F.3d at 1322. While *Applied Arts* does suggest that the ordinary observer must have sufficient knowledge to make "reasonably discerning infringement decisions," the *Arminak* court takes this statement out of context and misapplies its actual meaning. *Applied Arts* does not provide support for the position that "persons in the trade" should be the arbiter of design patent infringement disputes, a position directly contrary to *Gorham*.

Applied Arts holds that the fact-finder must have knowledge of, and thus consider, the prior art when making design patent infringement determinations. *Id.* at 429. ("it is clearly the rule that similitude of appearance is to be judged by the scope of the patent in relation to the prior art.") (*emphasis added*). *Applied Arts* cautioned that, without knowledge of the prior art, the fact-finder may improperly reach a finding of infringement when the accused infringer was merely practicing the prior art. *Id.* The issue raised in *Applied Arts* is resolved by providing the fact-finder with the relevant prior art during deliberations on infringement. Arming the fact-finder with knowledge of the prior art is very different from requiring that the ordinary observer is someone versed in the designs of the trade in question. *Applied Arts* acknowledges that the ordinary

observer test is not conducted in a vacuum, but rather *in view of the prior art. Id.*

If not reversed, the *Arminak* test (including its second prong) threatens the enforceability of nearly all design patents. The following short example below highlights the flaw in the new *Arminak* test. Assume that the Plaintiff-patentee asserts that its design patent (on the left) is infringed by the accused design (on the right), which is similar in all material respects, save for one minor and inconsequential design difference (as noted).

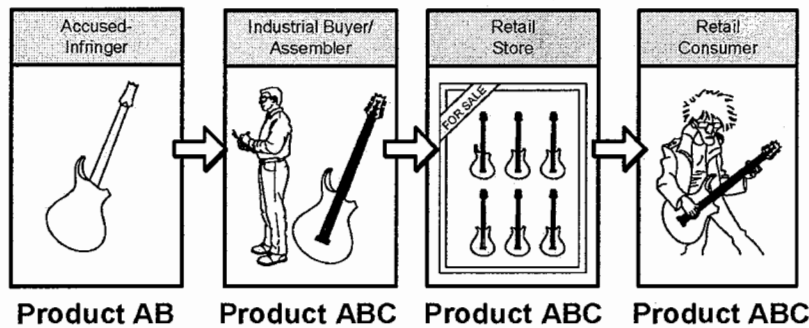


Like the asserted patents in *Gorham* and *Arminak*, the patented design does not claim the entire product; it claims only the guitar body - a portion of a finished retail product.³ Also, the *accused product* is not a final

³ A patentee is entitled to disclaim portions of its design by depicting such portions in dotted lines. *In re Zahn*, 617 F.2d 261, 267 (C.C.P.A. 1980). Here, the neck of the guitar is shown in dotted lines in the patent and thus form no part of the claimed

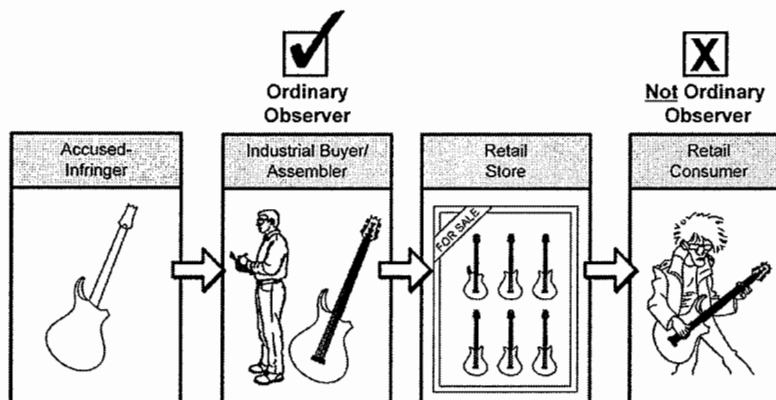
retail product in that it does not include strings, frets, tuning pegs, a bridge or electronics. As in *Arminak*, the Industrial Buyer adds these components, yielding the finished retail product. Below is an illustration of the stream of commerce in which the Defendant's product travels, beginning with the Defendant's manufacturer of the accused product, and ending with the Retail Consumer's ultimate purchase.

Defendant's Stream of Commerce



Using the erroneous test and reasoning set forth in *Arminak*, the ordinary observer would be the Industrial Buyer, and not the Retail Consumer.

design. Similarly, in Calmar's '381 patent, the nozzle, trigger, cap and tube form no part of the claimed design, as they, too, are depicted in dotted lines.



(See Appendix A.) The *Arminak* test, which bases infringement determination on the perceptions of the Industrial Buyer, yields an unjust and undesirable outcome. The Industrial Buyer would likely not be deceived by the overall appearances of the two designs. Instead, the trained Industrial Buyer would likely notice the minor and inconsequential difference in design, and find non-infringement. In contrast, the same difference would be indistinguishable to the Retail Consumer - the party who is the principal purchaser and user of the patented guitar body design. Inasmuch as the Retail Consumer is deceived, the "patentee is injured, and the advantage of a market which the patent was granted to secure is destroyed." *Gorham*, 81 U.S. at 528. However, the *Arminak* holding ignores this injury to the patentee. If not reversed, design patentees will be left without effective means to protect their patented designs in the marketplace.

The *Arminak* court's quest for identifying an "ordinary observer" should look no further than the juror in the jury box. A group of jurors possess ordinary sensibilities to make reasoned discernments regarding

the relative appearances of everyday household products that incorporate patented designs. After all, these jurors are the persons who are the “principal purchasers” and “users” of such products. *Gorham*, 81 U.S. at 528. If these persons are deceived then the patentee suffers an injury. *Id.* To be sure, industrial designers design attractive products with these everyday observers in mind, not middleman Industrial Buyers. For consumer products that incorporate the accused patented design, there is no need to identify a specialized “ordinary observer.” Rather, the “ordinary observer” is simply the juror, using his or her everyday sensibilities and perceptions. Jurors represent a cross-section of the purchasing community and by their very nature are “ordinary” observers. When the *Gorham* Court spoke of the “ordinary” perceptions, it wisely choose the observations of “the eyes of men generally,” “observers of ordinary acuteness” and “men of ordinary intelligence.” In essence, the Court intended to give effect to the word “ordinary,” which is defined as “of common quality, rank, or ability.” WEBSTER’S NEW WORLD DICTIONARY, 3rd ed. (1988).

Historically, the Federal Circuit has recognized that the focus of a design patent infringement analysis ought to be on the designs in question, not who is looking at them. The Federal Circuit has previously recognized that the ordinary observer is simply the everyday juror sitting in the jury box.

Nothing in *Gorham* suggests that, in finding design patent infringement, a trier of fact may not as a matter of law rely exclusively or primarily on a visual comparison of the patented design...and the accused device’s design. ... [I]n

Gorham, the Supreme Court did not state, or suggest, that a panel of jurors was anything other than a panel of ordinary observers capable of making a factual determination as to whether they would be deceived by an accused device's design similarity to a patented design. Simply put, a jury, comprised of a sampling of ordinary observers, does not necessarily require empirical evidence as to whether ordinary observers would be deceived by an accused device's design

Braun Inc. v. Dynamics Corp. of America, 975 F.2d 815, 821 (Fed. Cir. 1992). Accordingly, there was no need to specify an ordinary observer. The *Braun* court correctly concluded that the jurors themselves were ordinary observers.

Similarly, in *Holdsworth v. M'Crea*, (1867) 2 H.L. 380 (appeal taken from Q.B.), the only case cited by Justice Strong in the *Gorham* opinion, the House of Lords left the design patent infringement decision to the jury.⁴ In *Holdsworth*, the House of Lords affirmed a jury determination of design patent infringement. Lord Westbury, affirming the jury's design patent infringement verdict, stated that: "Whether, therefore, there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and

⁴ *Holdsworth* has been recognized as the English courts' seminal opinion regarding design patent infringement. See *Amp Inc. v. Utility PTY Ltd.*, (1970) R.P.C. 397 (High Court of Justice – Chancery Division); see also THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW, THE BRITISH EXPERIENCE 1760-1911, Sherman, Brad and Bentley, Lionel, Cambridge University Press, 1999.

the other figure, and ascertains whether they are or are not the same.” “[T]he appeal is to the eye, and the eye alone is the judge of the identity of the two things.” *Id.* Because the controlling consideration was the effect on the eye, when viewing the two designs, the decision of “whether there was any difference in the effect be left to the jury.” *M’Crea v. Holdsworth*, (1870) L.R. 6 Ch App 418, *aff’d by Holdsworth v. M’Crea*, (1867) L.R. 2 H.L. 380.

Attempts to precisely define a subclass of extraordinary observers is not only in violation of *Gorham* and unnecessary, but it also leads to arbitrary and inappropriate infringement findings. If the determination of the “ordinary observer” hinges on who is the first purchaser/user of the *accused product*, such a test produces uncertain infringement results whereby the “ordinary observer” varies depending on who the patentee sues. For example, assume patentee Calmar sued Arminak for its sales of the trigger sprayer (incorporating the accused sprayer shroud) and also Wal-Mart for its sales of the complete Windex® bottle (incorporating the same accused sprayed shroud). There, if the “ordinary observer” is selected on the basis of who is the first purchaser/user of the accused product, there will be two separate “ordinary observers” for determining infringement of the exact same accused sprayer shroud: (1) the ordinary observer for the suit against Arminak would be the Industrial Buyer, and (2) the ordinary observer for the suit against Wal-Mart would be the Retail Consumer. Simply put, such a conclusion is illogical and provides an unworkable framework for fairly resolving design patent infringement suits. The most sensible approach is to leave the question of design patent infringement to

ordinary observers – the ladies and gentleman of the jury.

CONCLUSION

Over one hundred and thirty years ago this Court laid down the “ordinary observer” test for design patent infringement in *Gorham v. White*. It has remained the test ever since. The Federal Circuit’s holding in *Arminak* replaces the ordinary observer test with an “extra-ordinary observer” test, in direct conflict with *Gorham*, and the intent of Congress as set forth in the Patent Act.

For the reasons stated herein, *amicus curiae* respectfully request that this Court grant the Petition for *Writ of Certiorari*, with hopes that this Court will ultimately reverse the Federal Circuit’s holding in *Arminak*, and restore the “ordinary” requirement in the Court’s “ordinary observer” test for design patent infringement, as set forth in *Gorham v. White*.

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