

In The
United States Court of Appeals
For The Federal Circuit

DAVID A. RICHARDSON,

Plaintiff – Appellant,

v.

STANLEY WORKS, INC.,

Defendant – Appellee.

**APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA
IN CASE NO. 08-CV-1040, JUDGE NEIL V. WAKE.**

PETITION FOR REHEARING *EN BANC*

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Dated: April 8, 2010

CERTIFICATE OF INTEREST

Counsel for Appellant David A. Richardson certifies the following:

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

David A. Richardson

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

N/A

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:


None

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

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Signature of counsel

Geoffrey S Kerksmar
Printed name of counsel

Please Note: All questions must be answered

cc: _____

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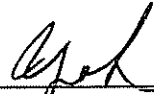
STATEMENT OF COUNSEL UNDER RULE 35(b)

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States or the precedents of this court: *Gorham Manufacturing Company v. White*, 81 U.S. 511 (1871); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993); *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365 (Fed. Cir. 2006); and *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995).

Based on my professional judgment, I also believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. May a court properly factor out the “functional elements” of a design patent in its claim construction before determining infringement?
2. If a court may factor out the “functional elements” of a patented design in its claim construction, is an element of a design “functional” merely because it has a utilitarian purpose, even if an alternative design can achieve that same utilitarian purpose?

Consideration by the full court is therefore necessary to secure and maintain uniformity of the court’s decisions.



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**POINTS OF LAW OR FACT OVERLOOKED BY THE
PANEL OF THE COURT**

A. The Court violates both *Egyptian Goddess* and *Gorham* by grafting onto *Gorham* a “points-of-ornamentation” or “points-of-functionality” test, requiring a court to factor out the “functional elements” of a patented design as part of claim construction. The “ordinary observer” test should be the sole test for determining whether a design patent has been infringed.

B. The Court misapprehends the meaning of “functional” in design patent law and inconsistently and improperly parses out functional features prior to the infringement analysis.

INTRODUCTION

The Supreme Court set forth the standard for the infringement of a design patent in *Gorham Co. v. White*, 81 U.S. 511, 528 (1871):

[I]n 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.

For over 100 years, *Gorham* stood as the sole standard for design patent infringement. Then, in *Litton Systems, Inc. v. Whirlpool Corp.*, the Federal Circuit created the “point of novelty test,” which—in addition to the test set out in *Gorham*—required that the accused design appropriate the “novelty” of the claimed design. 728 F.2d 1423 (Fed. Cir. 1984). In *Egyptian Goddess*, an en banc

panel of this Court abrogated the point-of-novelty test, holding that “in accordance with *Gorham* ... the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed.” 543 F.3d 665, 677 (Fed. Cir. 2008) (en banc).

Despite the Federal Circuit’s plain directive in *Egyptian Goddess*, the Court has once again grafted a secondary test onto *Gorham*. During claim construction, the district court in the instant case factored out what it called “functional elements” from the patented design. *Richardson v. Stanley Works, Inc.*, 610 F. Supp. 2d 1046, 1049-51 (D. Ariz. 2009). With the “functional elements” of the patented design eliminated during claim construction, the district court then applied the *Gorham* test by comparing only the remaining trivial features of the patented design to corresponding trivial features of the accused design and found the patent not infringed. *See id.* at 1051-53.

On appeal, relying almost exclusively on two decisions that preceded *Egyptian Goddess* (*Oddzon Prods. Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) and *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988)), this Court affirmed the trial court’s claim construction. *Richardson v. Stanley Works, Inc.*, ____ F.3d ____, 2010 WL 774334, *2-3 (Fed. Cir. March 9, 2010). In that ruling, the Court explicitly held that the district court “properly

factored out the functional aspects of Richardson’s design as part of its claim construction.” *Id.* at *2.

Rehearing en banc is necessary to reaffirm that the *Gorham* ordinary observer test is the sole test for determining whether a design patent has been infringed. *Gorham* applies equally to all patented designs, including those designs that have elements that are “functional,” as virtually all design patents do. *See* 35 U.S.C. § 171. In applying the *Gorham* test, a patented design must be considered as a whole; functional features cannot be factored out of the infringement analysis in any case where the function can be achieved by alternate designs. *See L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993); *see also Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365 (Fed. Cir. 2006); *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995). To the extent this Court’s pre-*Egyptian Goddess* precedent suggests a different result, this Court must overturn that precedent.

Upholding the *Gorham* ordinary observer test as the sole test for infringement of a design patent, regardless of whether the design contains allegedly “functional” features, is of great importance to the public, including the Appellant, and has been the subject of extensive discussion among scholars,

commentators, and members of the bar.¹ The public's right to protect novel designs will be permanently impaired if the Court cannot provide clarity to the questions raised by this case.

ARGUMENT IN SUPPORT OF REHEARING EN BANC

I. The panel decision improperly removes “functional” elements of the patented design prior to infringement analysis, effectively creating a “points-of-ornamentation” test that is contrary to *Gorham*.

The standard for determining infringement of a design patent was set out in the U.S. Supreme Court decision *Gorham Manufacturing Company v. White*, 81 U.S. 511 (1871). Recently, the test announced in *Gorham*, referred to as the “ordinary observer” test, was reaffirmed by this Court as the “*sole*” test for design patent infringement. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (emphasis added). Despite this Court's holding in *Egyptian Goddess*, the Court has now created a new test, which might be

¹ This case has been discussed extensively in journals and periodicals. See Perry J. Saidman, *The Ornamental/Functional Dichotomy in Design Patent Law is Akin to the Idea/Expression Dichotomy in Copyright Law*, 78 PAT., TRADEMARK & COPYRIGHT J. 199 (June 12, 2009); Tony Dutra, *Patents/Design Patents: District Court Discounts Functional Elements in Design Patent Ordinary Observer Test*, 77 PAT., TRADEMARK & COPYRIGHT J. 670 (April 17, 2009); 4 ANNOTATED PAT. DIG. § 29:45 *Comparison limited to ornamental features of the claimed design* (West 2010); Fredrick L. Medlin, *Recent Decision Reads Egyptian Goddess Correctly: Functionality is Critical to Design Patent Analysis*, PAT. TRADEMARK & COPYRIGHT LAW DAILY HIGHLIGHTS (May 1, 2009); Perry J. Saidman, *The Dysfunctional Read Test: Missing the Mark(man) Regarding the Test for Design Patent Infringement*, J. PAT. & TRADEMARK OFF. SOC'Y (July 2008). The focus of these articles has been whether it is proper to factor out the “functional elements” of a patented design in claim construction.

succinctly termed the “points-of-ornamentation test,” because it effectively forces a patentee to identify the strictly ornamental (or strictly non-functional) aspects of the patented design prior to the application of the *Gorham* test.²

By grafting a points-of-ornamentation test onto *Gorham*, the Court improperly factors out elements of designs that have already been awarded patents and are presumed patentable. The origins of the points-of-ornamentation test can be traced to *Read Corporation v. Portec, Inc.*, 970 F.2d 816, 825-26 (Fed. Cir. 1992). In *Read*, the Court explained that although *Gorham* established the standard for infringement of an ornamental design, *Gorham* did not have a “preliminary issue” of what the ornamental features of the design were. *Id.* at 825. The *Read* Court determined that a patent owner must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs *that are ornamental*. *Id.* The Court’s sole support for this standard was *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988). But *Lee* never suggested that parsing functional features from ornamental features was necessary during claim construction. Instead, *Lee* properly discussed functionality in terms of the affirmative defense of invalidity—not claim

² This test might also be properly termed the “points-of-functionality test.” Even after the Court’s opinion, it is unclear whether it is the patent holder’s burden to provide the “ornamental features” of the patent (the points-of-ornamentation test) or the accused infringer’s burden to come forth with “functional features” of the patent (the points-of-functionality test). Under *Gorham*, neither test is appropriate.

construction—and, in that context, simply clarified that a design patent cannot protect the concept or general function embodied by the design. *Id.* at 1188-89.

Read's error was compounded in *OddzOn*, when the Court stated that “[w]here a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.” *See OddzOn*, 122 F.2d at 1405. In requiring that functional elements not be considered in construing the claim of the patent, *OddzOn* led the district court in the instant case to factor out “functional elements” of the Richardson design during its claim construction. *Richardson*, 610 F. Supp. 2d at 1049-51. Indeed, in affirming the district court’s claim construction, this Court held that *OddzOn* compelled this result. *Richardson*, 2010 WL at *2.

If *OddzOn* compelled the result below, it must be overturned. First, this application of *OddzOn* is directly contrary to this Court’s pronouncement in *Egyptian Goddess* that *Gorham* is the sole test for design patent infringement. 543 F.3d at 677. *Egyptian Goddess* rejected the point of novelty test as improper under *Gorham*. *Id.* at 676. The Court determined that “unlike the point of novelty test, the ordinary observer test does not present the risk of assigning exaggerated importance to small differences” between the designs. *Id.*

The reasons *Egyptian Goddess* eliminated the separate point of novelty test apply equally to the newly created “points-of-ornamentation” test. The points-of-

ornamentation test would serve to eliminate any feature or element of a patented design that has any utilitarian purpose. But removing utilitarian features prior to an infringement analysis poses the same risk noted by the Court in *Egyptian Goddess*, namely, that small differences will be given exaggerated importance during the subsequent infringement analysis. Further, this test effectively destroys the value of design patents because the only designs that qualify for design patent protection are “ornamental designs *for an article of manufacture*”; unlike paintings, sculptures or other purely ornamental creations, all “articles of manufacture” will inherently have utilitarian aspects. *See* 35 U.S.C. § 171 (emphasis added). *Gorham* properly sets forth the standard for design patent infringement, without reference to functionality. That precedent must be followed here. The *Gorham* ordinary observer must not factor out any functional elements of the patented design.

In addition, this reading of *OddzOn* is contrary to well-settled principles of patent law. Functionality has a defined role in design patent infringement. Invalidity due to functionality is an affirmative defense, which must be shown by clear and convincing evidence. *See L.A. Gear Inc.*, 988 F.2d at 1125. In the invalidity context, functionality is important because a design is not patentable if the design is dictated by function alone. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989). But once a finding is made that a design is not

“dictated by function alone” and a patent is issued, the entire patented design is protected. *See L.A. Gear Inc.*, 988 F.2d at 1125. To the extent any “functional” aspects are included in a patented design, the functional elements of the patented design are protectable; they are themselves ornamental. *See Perry Saidman, The Dysfunctional Read Test: Missing the Mark(man) Regarding the Test for Design Patent Infringement*, J. PAT. & TRADEMARK OFF. SOC’Y (July 2008).

Finally, this reading of *OddzOn*—creating a points-of-ornamentation test—is contrary to this Court’s precedent. In *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995), this Court recognized that functional features must be included in applying the ordinary observer test. In *Elmer*, the Court refused to factor out functional features from the design patent claim. The Court stated that the patentee could have omitted the functional features from the drawing of the patent, but since the patentee chose to include them, the scope of the claim was limited by those features. *Id.* at 1577. The Federal Circuit in *Elmer* clearly found that design patent claims properly include all features shown in the drawings, whether or not they are functional.

Also contrary to *OddzOn*, in *L.A. Gear*, the Court explicitly refused to factor out the alleged functional aspects of a patented design because “each of the functions identified as performed by the [patented] design elements was achieved [by alternate designs] in a way other than by the design of the [patent].” *See L.A.*

Gear, 988 F.2d at 1123. And in *Amini*, the Court found reversible error when the trial court “discount[ed] functional elements ... convert[ing] the overall infringement test to an element-by-element comparison.” See *Amini*, 439 F.3d at 1372.

The dichotomy between *OddzOn* and *Read* on the one hand, and *Elmer*, *L.A. Gear* and *Amini* on the other, leads to uncertainty and inconsistency. In one camp, *Elmer*, *Amini* and *L.A. Gear* may be relied on to effect a finding of infringement. In the other camp, as in the present case, *Lee* and *OddzOn* may be relied on to effect a finding of non-infringement. Rehearing en banc is necessary to resolve this inconsistency and to provide guidance to trial courts and the public.

The proper test for design patent infringement requires that the overall appearance of the accused design be substantially the same as the patented design in the eye of an ordinary observer. See *Egyptian Goddess*, 543 F.3d at 670. In the instant case, with the proper test applied and the functional elements of the Richardson design considered, the district court has concluded that “none of the prior art designs are as similar to Richardson’s design as is Stanley’s.” *Richardson*, 610 F. Supp. 2d at 1051. The Court should grant en banc rehearing here to clarify that functionality is not relevant to either claim construction or infringement analysis. If, in order to reach this result, it is necessary for the Court

to overturn *OddzOn*, *OddzOn* should be overturned. After recently abolishing the point-of-novelty test, this Court should not create a points-of-ornamentation test.

II. Even if the points-of-ornamentation test is proper, the panel decision improperly applies it here by failing to define “functional” and improperly concluding that the Richardson design includes “functional elements.”

As explained above, the Court should grant rehearing to reaffirm that *Gorham* is the sole test for determining design patent infringement. To the extent that this Court embraces the “points-or-ornamentation” test, en banc rehearing is necessary to determine the proper definition for “functional.” Although both the district court and this Court held that it was proper to factor out “functional elements” of the Richardson design, neither court defined “functional.”

“Functional” in the validity context has a well-defined meaning. “The proper inquiry for determining functionality of a design is whether the overall appearance of the design is dictated by a utilitarian or ornamental purpose.” *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 215 F.3d 1351 (Fed. Cir. 1999). Such a distinction makes it possible to obtain both a utility patent and a design patent on the same article. *See Carman Indus. v. Wahl*, 724 F.2d 932, 938-39 (Fed. Cir. 1983). “When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.” *L.A. Gear*, 988 F.2d at 1123. Accordingly, when there are

multiple designs that can accomplish the same function as the patented design, the patented design is not “functional.” *Id.*

In the instant case, it was undisputed that the functions that the Richardson design is capable of performing could be accomplished by an alternative design. (See Joint Appendix at 333-35, 381, 391, 399, 405, 407, 420.) Accordingly, applying *L.A. Gear*, no aspect of the Richardson design was functional. Nonetheless, relying solely on *OddzOn* and *Lee*, the district court and this Court factored out “functional elements” of the Richardson design. But neither *OddzOn* nor *Lee* defines functional in the claim construction context. Accordingly, it remains unclear what standard the district court and this Court applied. Guidance from this Court is necessary. Without it, district courts will consistently factor out functional elements of patented designs simply because those elements have a “purpose” or “use” or because, as here, the design “works.” This cannot be the law because the only designs that qualify for design patent protection are “ornamental designs *for an article of manufacture*,” which inherently must have utilitarian aspects. See 35 U.S.C. § 171 (emphasis added).


CONCLUSION

The panel’s decision in this case should be overturned because it severely undermines the enforceability of design patents, which are entitled to the presumption of validity. Mere months after this Court rejected a supplemental test

beyond *Gorham*'s ordinary observer test, a panel of this Court has now established a "points-of-ornamentation" test. Now, before the ordinary observer test can be applied, a design patentee must prove that each element of the patented design is purely ornamental. Any element that has "functional aspects"—whatever that might mean—will not be considered during subsequent infringement analysis. As with the point-of-novelty test, to escape liability, would-be infringers need only identify similarities between the patented design and infringing product and argue the "functionality" of those similarities. *Egyptian Goddess* rejected a similar test, reaffirming the United States Supreme Court's original and precedential *Gorham* test. The Court should do the same here.

Even if the Court adopts a supplemental test to *Gorham*, the term "functional," as used in claim construction, should be defined by the en banc court. There presently is no such definition because "functional" was previously only an aspect of invalidity analysis. En banc rehearing is necessary to clarify this term.

Respectfully submitted,



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ADDENDUM

United States Court of Appeals for the Federal Circuit

2009-1354

DAVID A. RICHARDSON,

Plaintiff-Appellant,

v.

STANLEY WORKS, INC.,

Defendant-Appellee.

Geoffrey S. Kercksmar, Kercksmar & Feltus, PLLC, of Scottsdale, Arizona, argued for plaintiff-appellant.

Bryan P. Collins, Pillsbury Winthrop Shaw Pittman LLP, of McLean, Virginia, argued for defendant-appellee. With him on the brief were Robert M. Fuhrer, and Kathy Peng.

Appealed from: United States District Court for the District of Arizona

Judge Neil V. Wake

United States Court of Appeals for the Federal Circuit

2009-1354

DAVID A. RICHARDSON,

Plaintiff-Appellant,

v.

STANLEY WORKS, INC.,

Defendants-Appellee.

Appeal from the United States District Court for the District of Arizona in
Case No. 08-CV-1040, Judge Neil V. Wake.

DECIDED: March 9, 2010

Before LOURIE and DYK, Circuit Judges, and KENDALL, District Judge.^{*}

LOURIE, Circuit Judge.

David Richardson appeals from a final decision of the United States District Court for the District of Arizona. Richardson v. Stanley Works, Inc., 610 F. Supp. 2d 1046 (D. Ariz. 2009). After a bench trial, the district court found that Stanley Works, Inc. ("Stanley") did not infringe U.S. Patent D507,167 ("the '167 patent"). Because the court correctly construed the claim at issue and correctly determined that the patent was not infringed, we affirm.

^{*} Honorable Virginia M. Kendall, District Judge, United States District Court for the Northern District of Illinois, sitting by designation.

BACKGROUND

Richardson owns the '167 patent, a design patent that claims the design for a multi-function carpentry tool that combines a conventional hammer with a stud climbing tool and a crowbar. The tool is known as the "Stepclaw." The only claim of the '167 patent claims the ornamental design of the tool as depicted in figures 1 and 2 of the patent:

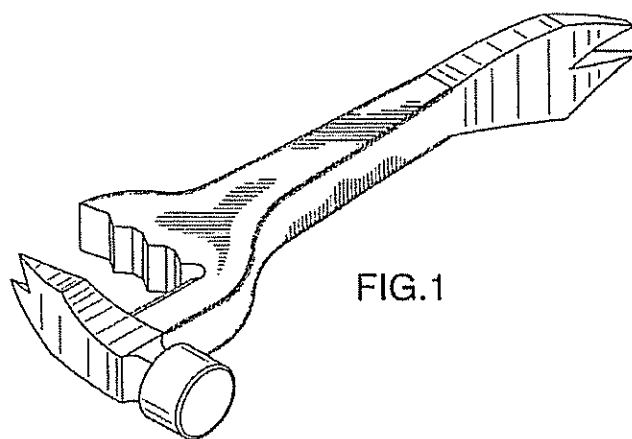


FIG. 1

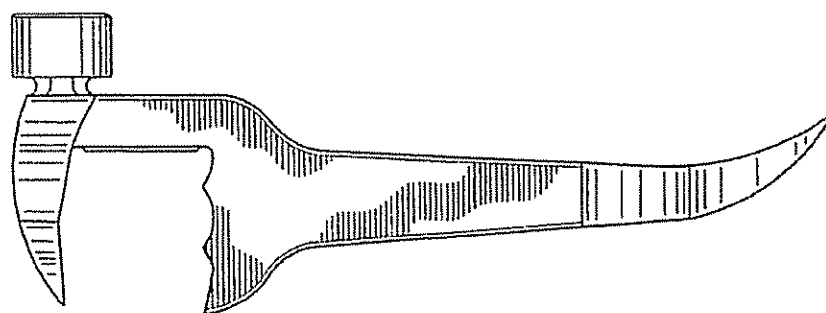


FIG. 2

Stanley manufactures and sells construction tools. In 2005, Stanley introduced into the U.S. market a product line of tools by the series name "Fubar." The Fubar is

sold in five different versions and is useful in carpentry, demolition, and construction work. Stanley successfully applied for and obtained U.S. Patent D562,101 ("the '101 patent") on the basic Fubar design. All five versions of the tool are built around that same basic Fubar design. Figures 1 and 5 of the '101 patent are illustrative of the Fubar design:

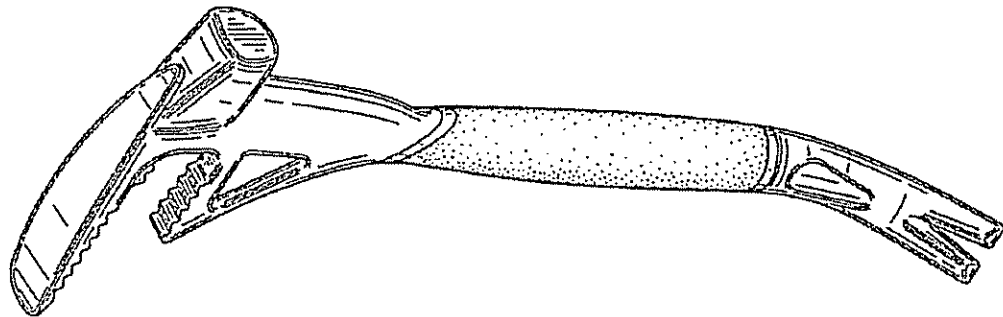


Figure 1

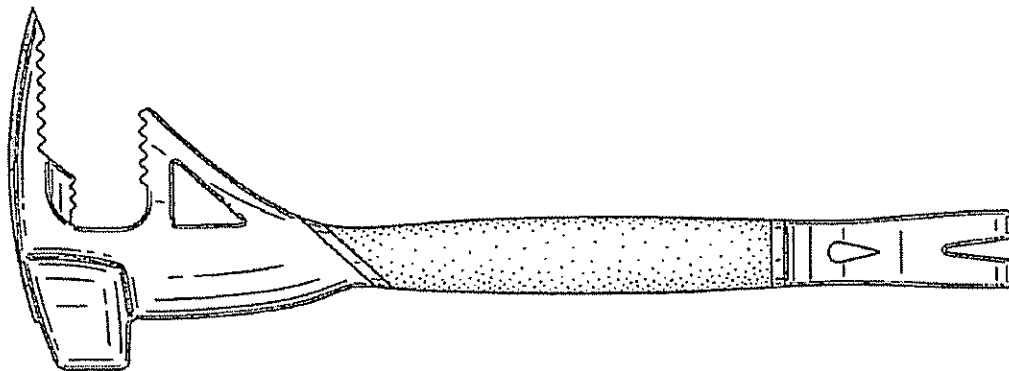


Figure 5

On June 3, 2008, Richardson filed a complaint against Stanley in the district court for the District of Arizona alleging that the Fubar tools infringed his '167 patent. In addition, Richardson alleged that Stanley was unfairly competing with him in the U.S. market. In response to Richardson's complaint, Stanley first filed a motion to dismiss on September 10, 2008 and later filed an answer to the complaint on September 22, 2008.

On October 22, 2008, Richardson filed his request for a jury trial, which Stanley moved to strike as untimely under Federal Rule of Civil Procedure 38(b). In response, Richardson requested that a jury trial be granted under Rule 39(b). The district court granted Stanley's motion to strike and denied Richardson's Rule 39(b) motion. Richardson v. Stanley Works, Inc., No. CV-08-1040-PHX-NVW, 2009 WL 383554 (D. Ariz. Feb. 13, 2009). The court also granted Stanley's motion to dismiss Richardson's unfair competition claim. Richardson v. Stanley Works, Inc., No. CV-08-1040-PHX-NVW, 2008 WL 4838708 (D. Ariz. Nov. 06, 2008). On April 2, 2009, the court conducted a bench trial on Richardson's patent infringement claim and entered judgment of noninfringement in favor of Stanley. Richardson, 610 F. Supp. 2d at 1053. In its order, the court first distinguished, as part of its claim construction, the ornamental aspects from the functional aspects of Richardson's design and then determined that an ordinary observer, after discounting the functional elements of Richardson's design, would not be deceived into thinking that any of the Fubar tools were the same as Richardson's Stepclaw. Id. at 1050–1052. The court therefore concluded that the overall visual effect of the Fubar was not substantially similar to that of the Stepclaw, and that the '167 patent had not been infringed. Id. at 1053. Richardson timely appealed the court's rulings. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

DISCUSSION

A. Claim Construction

Richardson argues that the district court's approach to evaluating infringement of a design patent was incorrect. Richardson primarily argues that the district court erred in its claim construction by separating the functional aspects of the design from the

ornamental ones, rather than considering the design as a whole. Richardson argues that our Egyptian Goddess decision requires that the patented design be compared in its entirety with the accused design, and that the comparison be made from the perspective of an ordinary observer. See Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) (en banc). A claim construction such as the one performed by the district court, Richardson argues, is necessary only for designs that contain “purely functional” elements. According to Richardson, a design element is purely functional only when the function encompassed by that element cannot be performed by any other design. Richardson contends that the overall design of the '167 patent is not dictated by the useful elements found in the tool, and that the functional parts of its design remain relevant to the scope of the patented claim.

We review claim construction de novo on appeal. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc). We disagree with Richardson that the district court erred in its claim construction by separating the functional and ornamental aspects of the '167 patent design. In OddzOn, we affirmed a district court’s claim construction wherein the court had carefully distinguished the ornamental features of the patented design from the overall “rocket-like” appearance of the design of a football-shaped foam ball with a tail and fin structure. OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997). We held that “[w]here a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.” Id.

The issue before us is not very different from that in OddzOn, and we are not persuaded by Richardson’s argument that our holding in Egyptian Goddess mandates a

different result here. In Egyptian Goddess, we abandoned the point of novelty test for design patent infringement and held that the ordinary observer test should serve as the sole test for infringement. 543 F.3d at 679. Although we proposed that the preferable course ordinarily will be for a district court not to attempt to construe a design patent claim, id., we also emphasized that there are a number of claim scope issues on which a court's guidance would be useful to the fact finder. Id. at 680. Among them, we specifically noted, is the distinction between the functional and ornamental aspects of a design. Id. (citing OddzOn, 122 F.3d at 1405).

The district court here properly factored out the functional aspects of Richardson's design as part of its claim construction. By definition, the patented design is for a multi-function tool that has several functional components, and we have made clear that a design patent, unlike a utility patent, limits protection to the ornamental design of the article. Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed. Cir. 1988) (citing 35 U.S.C. § 171). If the patented design is primarily functional rather than ornamental, the patent is invalid. Id. However, when the design also contains ornamental aspects, it is entitled to a design patent whose scope is limited to those aspects alone and does not extend to any functional elements of the claimed article. See L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) ("The elements of the design may indeed serve a utilitarian purpose, but it is the ornamental aspect that is the basis of the design patent.").

Richardson's multi-function tool comprises several elements that are driven purely by utility. As the district court noted, elements such as the handle, the hammer-head, the jaw, and the crowbar are dictated by their functional purpose. The jaw, for

example, has to be located on the opposite end of the hammer head such that the tool can be used as a step. The crowbar, by definition, needs to be on the end of the longer handle such that it can reach into narrow spaces. The handle has to be the longest arm of the tool to allow for maximum leverage. The hammer-head has to be flat on its end to effectively deliver force to the object being struck. As demonstrated by the prior art, those are purely functional elements whose utility has been known and used in the art for well over a century.

Richardson's argument that the court erred in separating out functional aspects of his design essentially is an argument for a claim scope that includes the utilitarian elements of his multi-function tool. We agree with the district court that it would indeed be improper to allow Richardson to do so. The '167 patent specifically claims "the ornamental design" for the multi-function tool shown in the drawings. See '167 patent, Cl. 1. A claim to a design containing numerous functional elements, such as here, necessarily mandates a narrow construction. Nothing in our en banc Egyptian Goddess opinion compels a different outcome.

We also reject Richardson's argument that the court did not include drawings from the patent in its claim construction. Richardson argues that it is the ordinary observer's perception of those drawings that is the controlling consideration under the Supreme Court's opinion in Gorham Manufacturing Company v. White, 81 U.S. 511 (1871). We agree with Richardson on the decisive importance of drawings in a design patent. We have recently stated that design patents are typically claimed according to their drawings, and claim construction must be adapted to a pictorial setting. Crocs, Inc. v. Int'l Trade Comm'n, No. 2008-1596, slip op. at 10 (Fed. Cir. Feb. 24, 2010).

However, we do not agree that the district court's claim construction necessarily excluded drawings of the '167 patent. The court's entire construction was based on what was "shown and described in the '167 patent." Richardson, 610 F. Supp. 2d at 1050. The court concluded its discussion by noting that the purpose of the claim construction was simply to highlight the ornamental aspects of Richardson's design. Id. Richardson fails to explain how a court could effectively construe design claims, where necessary, in a way other than by describing the features shown in the drawings. Richardson's proposition that the claim construction should comprise nothing more than the drawings is simply another way of arguing that the court erred by identifying the functional elements of the patented article, and is therefore unavailing. We find no error in the court's claim construction.

B. Infringement

Richardson argues that the district court failed to analyze infringement of the '167 patent by Stanley's tools under an ordinary observer test. According to Richardson, had the court conducted a three-way comparison between the prior art, the patented design and the accused products, it would have found the accused product design to be substantially the same as the patented one.

Stanley responds that, having identified the ornamental aspects of Richardson's patented design, the court properly found that the only similarities between the patented Stepclaw and the accused Fubar tools were those of unprotectable functional elements. Stanley argues that when those utilitarian aspects are ignored, none of the accused Fubar products looks even remotely like Richardson's patented design.

We agree with the court's finding of noninfringement. Design patent infringement is a question of fact, which a patentee must prove by a preponderance of the evidence. L.A. Gear, 988 F.2d at 1124. In Egyptian Goddess, we held that "the 'ordinary observer' test should be the sole test for determining whether a design patent has been infringed." 543 F.3d at 678. The patentee must establish that an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design. See id. at 681. In our recent Crocs decision, we set out in detail how an ordinary observer analysis could be conducted to determine infringement. See Crocs, slip op. at 11–15. In analyzing whether a design patent on footwear was infringed, noting the various differences that could be found between the two pieces of footwear in question, we compared their overall effect on the designs. Id. at 15. We looked to ornamental elements such as the curves in the design, the strap assembly, and the base portion of the footwear. Id. We concluded that both the claimed design and the accused designs contained those overall ornamental effects, thereby allowing for market confusion. Id.

The ordinary observer test similarly applies in cases where the patented design incorporates numerous functional elements. See Amini Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1372 (Fed. Cir. 2006) (holding that while it is proper to factor out the functional aspects of various design elements, that discounting of functional elements must not convert the overall infringement test to an element-by-element comparison). In evaluating infringement, we determine whether "the deception that arises is a result of the similarities in the overall design, not of similarities in ornamental features in isolation." Amini Innovation, 439 F.3d at 1371.

We do not agree with Richardson that the district court failed to apply the ordinary observer test in finding no infringement. The court specifically concluded that “[f]rom the perspective of an ordinary observer familiar with the prior art, the overall visual effect of the Fubar is significantly different from the Stepclaw.” Richardson, 610 F. Supp. 2d at 1052. It recited the significant differences between the ornamental features of the two designs but, in determining infringement, it mainly focused on whether an ordinary observer would be deceived into thinking that any of the Fubar designs were the same as Richardson’s patented design. Id. We therefore find no error in the district court’s approach. See Egyptian Goddess, 543 F.3d at 681 (“An ordinary observer, comparing the claimed and accused designs in light of the prior art, will attach importance to differences between the claimed design and the prior art depending on the overall effect of those differences on the design.”); see also Int’l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1243 (Fed. Cir. 2009) (“The mandated overall comparison is a comparison taking into account significant differences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another.”).

We also agree that, ignoring the functional elements of the tools, the two designs are indeed different. Each of the Fubar tools has a streamlined visual theme that runs throughout the design including elements such as a tapered hammer-head, a streamlined crow-bar, a triangular neck with rounded surfaces, and a smoothly contoured handle. In a side-by-side comparison with the ’167 patent design, the overall effect of this streamlined theme makes the Fubar tools significantly different from Richardson’s design. Overall, the accused products clearly have a more rounded

appearance and fewer blunt edges than the patented design. The court therefore was not clearly erroneous in concluding that the accused products embody an overall effect that cannot be found in the '167 patent design and hence cannot cause market confusion. See Egyptian Goddess, 543 F.3d at 681 (infringement cannot be found unless the accused product creates an appearance deceptively similar to the claimed design).

C. Jury Demand

We lastly address Richardson's argument that the district court improperly denied Richardson's jury demand as untimely. The court found that at the time Richardson filed his jury demand, the pleadings were closed. Richardson, 2009 WL 383554, at *1. However, Richardson argues that at the time he filed his jury demand, a motion to dismiss was pending, and the Rule 38(b) clock did not start until the motion had been ruled upon by the court. Moreover, Richardson argues, the court had ample discretion to grant his jury demand under Rule 39(b), but refused to do so, improperly concluding that Richardson's inadvertence foreclosed any further analysis of the merits of his motion. Richardson contends that, under Ninth Circuit law, failure to file a jury demand based on a pending motion to dismiss does not bar the court from employing its discretion to allow a jury trial.

Stanley responds that its motion to dismiss was not a pleading and hence did not toll the 10-day deadline for Richardson to file a jury demand. Moreover, Stanley argues, the motion to dismiss was limited to state law claims and did not in any way affect Richardson's deadline for filing a jury demand for the patent infringement claims.

We agree with Stanley that the district court permissibly denied Richardson's motion for a jury trial. We apply regional circuit law to a trial court's procedural decisions that relate to issues not unique to our exclusive jurisdiction, including motions for a jury trial. See Transmatic, Inc. v. Gulton Indus., Inc., 53 F.3d 1270, 1278 (Fed. Cir. 1995). Under Ninth Circuit law, a trial court's determination of the timeliness of a demand for jury trial under Rule 38(b) is reviewed de novo. See Kulas v. Flores, 255 F.3d 780, 783 (9th Cir. 2001).

In examining that question, we "indulge every reasonable presumption against waiver" of the jury trial right. Cal. Scents v. Surco Prods., Inc., 406 F.3d 1102, 1108 (9th Cir. 2005). Rule 38(b) states that "a party may demand a jury trial by . . . serving the other parties with a written demand – which may be included in a pleading – no later than 10 days after the last pleading directed to the issue is served." Fed. R. Civ. P. 38(b).¹ The district court noted that Stanley's answer was the last pleading directed to any issue triable of right by a jury in this case. Richardson, 2009 WL 383554, at *1. Accordingly, the court concluded that Richardson's jury demand was untimely because he served it more than ten days after Stanley filed its answer. Id. The court held that the fact that a motion to dismiss was pending did not toll the time for Richardson to file a jury demand. Id.

Rule 7(a) lists the types of pleadings permissible in federal cases. Fed. R. Civ. P. 7(a). A motion to dismiss is not one of them. It is not a pleading directed to issues of fact triable by the jury. United States v. Anderson, 584 F.2d 369, 372 n.4 (10th Cir. 1978) (stating that a motion to dismiss is not a pleading within the federal rules).

¹ Effective December 1, 2009, Rule 38(b) has been amended to provide the parties fourteen days to make a demand for a jury trial.

Richardson cites no authority suggesting that such a motion could be considered otherwise in the application of Rule 38.² Richardson's proposed interpretation of the rule would indefinitely extend a party's deadline to make a jury demand until the court rules on all such pending motions. We see nothing in the federal rules that allows such a reading. We agree with the district court that Richardson's jury demand was untimely regardless of Stanley's pending motion.

The Ninth Circuit reviews a district court's decision to deny relief under Rule 39(b) for an abuse of discretion. See Las Vegas Sun, Inc. v. Summa Corp., 610 F.2d 614, 621 (9th Cir. 1979). A district court's discretion in granting an untimely demand for a jury trial under rule 39(b) is narrow, and does not permit a court to grant relief when the failure to make a timely demand results from oversight or inadvertence. See Pacific Fisheries Corp. v. HIH Cas. & General Ins., Ltd., 239 F.3d 1000, 1002 (9th Cir. 2001) (citing Lewis v. Time Inc., 710 F.2d 549, 556–57 (9th Cir. 1983)). The Ninth Circuit mandates denial of an untimely request for a jury trial unless some cause beyond mere inadvertence is shown. Id.

Richardson argues that it presented more reason than mere inadvertence for its untimely motion. Once again, he contends that Stanley's motion to dismiss and subsequently filed answer in response to his complaint put him in a difficult position of determining when his jury demand was due, and eventually miscalculating his deadline for making the demand. Richardson therefore appears to argue that his delay was not

² Richardson cites Anderson to support his proposition that where a motion attacking the pleadings is filed, the last pleading for the purposes of starting the Rule 38(b) clock is not deemed filed until after the motion attacking the pleadings is decided. Anderson, 584 F.2d 369. Anderson does not address the situation presented here, wherein the defendant first filed a motion to dismiss and then filed an answer.

due to mere inadvertence, but rather due to a good faith mistake in determining the deadline under the federal rules.

We find Richardson's argument unpersuasive. Even if Richardson's failure to timely file a jury demand were considered to be a result of his good faith mistake as to the deadline in light of Stanley's motion to dismiss, such a mistake establishes no more than inadvertence under Ninth Circuit law. Zivkovic v. S. Cal. Edison Co., 302 F.3d 1080, 1087 (9th Cir. 2002) ("[G]ood faith mistake as to the deadline for demanding a jury trial establishes no more than inadvertence, which is not a sufficient basis to grant relief from an untimely jury demand."). The district court properly refused to exercise its discretion in rejecting Richardson's Rule 39(b) request.

CONCLUSION

We have considered Richardson's remaining arguments and do not find them persuasive. Accordingly, the judgment of the district court is

AFFIRMED

CERTIFICATE OF FILING AND SERVICE

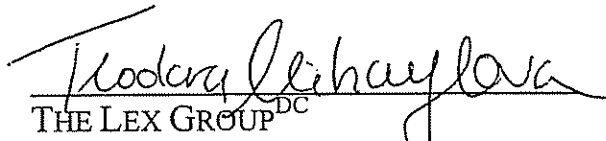
I hereby certify that that on this 8th day of April, 2010, two copies of the foregoing Petition for Rehearing *En Banc* were sent, via UPS Ground Transportation, to the following:

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I further certify that on this 8th day of April, 2010, the required number of copies of said Petition were hand filed at the Office of the Clerk, United States Court of Appeals for the Federal Circuit.

The necessary filing and service were performed in accordance with the instructions given me by counsel in this case.


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