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Egyptian Goddess v. Swisa: *En Banc* Federal Circuit Court Searches For The Rosetta Stone For Design Patent Jurisprudence

*By Christopher V. Carani of
McAndrews Held & Malloy, Ltd.*



Egyptian Goddess v. Swisa: *En Banc* Federal Circuit Court Searches For The Rosetta Stone For Design Patent Jurisprudence

BY CHRISTOPHER V. CARANI¹

The Rosetta Stone, by leading the way to the decipherment of the principles of hieroglyphic writing, unlocked many of the most perplexing mysteries of ancient Egypt. Patent practitioners and design patent holders alike are anxiously awaiting to see whether the forthcoming *en banc* Federal Circuit decision in *Egyptian Goddess, Inc. v. Swisa, Inc. et al.* will have the same demystifying effect on the perplexing questions facing design patent jurisprudence. *Egyptian Goddess* represents the most important design patent case since 1871 when the U.S. Supreme Court in *Gorham v. White* first set forth the test for design patent infringement. Indeed, *Egyptian Goddess* marks the first time that the Federal Circuit has agreed to hear a design patent case *en banc*.² As further evidence of the case's magnitude, scores of *amici curiae* filed briefs, including some of the U.S.'s largest corporations (e.g. Apple, Ford, Nike, etc.), national, international and regional bar associations (e.g. AIPLA, FICPI, FCBA, CBA, HIPLA, etc.), trade associations (e.g. IDSA, IPO, etc.) and even academia (e.g. Prof. Fryer, University of Baltimore). The case has caused such a stir because the *en banc* Federal Circuit will attempt to decipher two cryptic, yet critically fundamental, issues of design patent jurisprudence: (1) does claim construction apply to design patents? and (2) what should be the test for design patent infringement?

SYNOPSIS OF THE FACTS, PROCEDURAL HISTORY, AND ISSUES PRESENTED IN EGYPTIAN GODDESS

Egyptian Goddess, Inc. (“*Egyptian Goddess*”) sued *Swisa, Inc.* (“*Swisa*”), claiming that U.S. Design Patent 467,389 (“*D’389 patent*”) was infringed by certain *Swisa* fingernail buffers. *Swisa* moved for summary judgment of non-infringement and invalidity. In support of its infringement claim, *Egyptian Goddess* asserted that the

point of novelty of *D’389* was the unique combination of four design elements, which were all individually known in the prior art. The district court granted summary judgment of non-infringement, holding that *Egyptian Goddess* failed to satisfy its burden under the point of novelty test, one of the two required tests for design patent infringement under current Federal Circuit law. *Egyptian Goddess* appealed the district court’s decision. It is critical to note at this juncture that the only issue on appeal was non-infringement. The district court did not rule on the summary judgment motion for invalidity, and thus issues of validity are not before the Federal Circuit.

On appeal, the Federal Circuit Panel majority, made up of Judge Moore (writing the opinion for the majority) and Senior Judge Archer, affirmed the district court’s summary judgment of non-infringement, agreeing that *Egyptian Goddess* had failed to satisfy its burden under the point of novelty test, albeit for different reasons as explained below.³ (“*Egyptian Goddess I*”).

In reaching its decision, the Panel majority recited its precedent requiring two distinct tests for establishing design patent infringement, the ordinary observer test and the point of novelty test.⁴ However, when analyzing *Egyptian Goddess*’s asserted combination point of novelty (comprised of four known design elements), the Panel majority came up with a new requirement: “[f]or a combination of individually known elements to constitute a point of novelty, the combination must be a *non-trivial advance over the prior art*.”⁵ Using this newly fashioned requirement (a requirement neither found in precedent, used by the district court, nor briefed by the parties), the Panel majority affirmed the summary judgment of non-infringement reasoning that *Egyptian Goddess*’s asserted point of novelty was not a “non-trivial advance” over the prior art. (“In light of the prior art, no reasonable juror could conclude that *EGI*’s asserted point of novelty constituted a non-trivial advance over the prior art.”) Judge Dyk

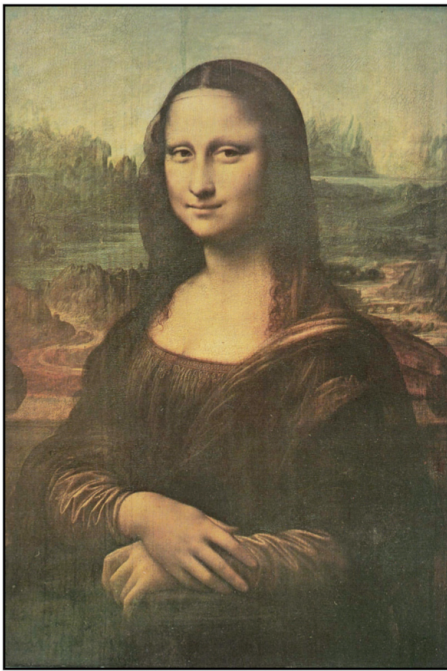
wrote a lengthy dissenting opinion criticizing the Panel majority’s new Non-Triviality Requirement.

Egyptian Goddess filed a Petition for Rehearing and Rehearing *En Banc* arguing against the new Non-Triviality Requirement. On November 26, 2007, the *en banc* Federal Circuit vacated *Egyptian Goddess I*, reinstated the appeal, and granted the Petition for Rehearing *En Banc*. What is remarkable about the *en banc* Order is that the Federal Circuit requested briefing far beyond the controversial Non-Triviality Requirement, asking two cryptic, but fundamental, questions: (1) does claim construction apply to design patents? and (2) what should be the test for design patent infringement? While the decision to take on these two questions was a resounding signal that the Federal Circuit is poised to commence its search for the Rosetta Stone for design patent jurisprudence, whether it will find the coveted talisman remains unclear.

DOES CLAIM CONSTRUCTION APPLY TO DESIGN PATENTS?

In *Markman v. Westview Instruments, Inc.*, the Supreme Court ruled that the construction of “patent” claims is a responsibility for courts, not juries.⁶ However, the *Markman* Court did not specify the types of “patents” to which claim construction applies; *Markman* involved a utility patent, not a design patent.⁷ Thus, the Federal Circuit has been left to decide whether and how to apply claim construction to design patents.

Historically speaking, the Federal Circuit first applied claim construction to a design patent in *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995). *Elmer* provided no discussion on whether or why claim construction applied to design patents; the *Elmer* court simply applied it. Since *Elmer*, courts have taken vastly different approaches to design patent claim construction. Some have simply relied on the design patent drawings,⁸ while others have translated the design patent drawings into long recitations of words.⁹ This confusing set of approaches has begged for further guidance from the Federal Circuit. While most all of the parties and *amici* in *Egyptian Goddess* agree that claim construction applies to design patents (in some



form or another), there is sharp disagreement on whether a court should attempt to translate claim drawings into words as part of its claim construction. By way of example, if a design patent in question depicts a ceiling fan, should a court, as a matter of law and as part of claim construction, describe the ceiling fan in words or should it simply let the design patent drawings speak for themselves.¹⁰ For the reasons set forth herein, courts should not endeavor to verbalize design patents as part of claim construction.

Any discussion of design should be placed against the backdrop that words are most often futile in describing the appearance of a design. For example, if one were asked to describe the overall appearance of the *Mona Lisa*, which would be more efficient – words or the image itself?

Whether an art aficionado or an ordinary observer, the answer is clear: the image of the *Mona Lisa* itself is the most effective means for communicating its overall appearance. The same is true for design patents.

Unlike Utility Patents, The Claims Of Design Patents Are The Drawings

Utility patents present claims in words; design patents present claims in drawings.¹¹ In other words, the drawings in a design patent are the claim; every solid line forms part of the claim.¹² Design patents do not contain,

and are required to have, verbalizations of the claimed design.

Words are not used to communicate designs because they are ill-suited for the task. Verbal descriptions are almost always too broad or too narrow. While, yes, words are capable of *listing* some, or even all, of the individual *features* of the drawings, they are simply ill-suited for communicating the *overall appearance* of all of the elements, including the relative and spatial relationships of each and every solid line in the claim. Moreover, when verbalizations are employed to capture the entire claim and a list of features is set forth, verbalizations may inaccurately convey that the listed features all have an equivalent effect on the eye. Further, if a court were to include words to emphasize the relative predominance of certain aspects of the design (i.e., major, minor, etc.), here again, these terms are unlikely to communicate the overall appearance. In reality, depending on the observer, the eye may very well focus on certain aspects of the drawings and minimize others. Thus, inasmuch as design patents are claimed with drawings, the only effective means by which to communicate each and every aspect of the claimed design are the drawings. In short, the best description of the drawings is the drawings themselves.¹³

Gorham Makes Clear That The Ordinary Observer's Perception Of The Drawings Should Control Claim Construction

In *Gorham v. White*, 81 U.S. 511 (1871), the Supreme Court explained that, for design patent infringement, the “controlling consideration is the resultant effect” of the overall design on the “eye of the ordinary observer”.¹⁴ Thus, it is the perception of the eye of the ordinary observer, not the court, which should control claim construction. As *Gorham* makes clear, the design patent infringement test seeks the ordinary observer’s perception and comparison of two designs: (1) the accused design, and (2) *the claimed design*.¹⁵ By attempting to translate the claimed design into words, a court improperly usurps half of the ordinary observer’s mandate.

Even if verbalizations are provided, they are unneeded because they have no role in the design patent infringement or invalidity analyses. Both analyses compare images to images, not words to images. Simply put,

because the tests are visual, there is no need for verbalized claim constructions to decide issues of design patent infringement or invalidity.

Attempts to completely verbalize design patent claims have great potential to confuse jurors. For example, if the juror is charged with conducting the visual infringement test mandated by *Gorham*, but then given a written claim construction from the court, which should control? A juror’s perception of the overall appearance of the claimed design may very well differ from the court’s expressed verbalization (and for that matter the court’s perception). It is also possible that a juror’s perception may change after reading the court’s construction. Even if the court only provides the written instruction as a guide, the same problems of undue influence or changed perception persist. Such a predicament is bound to yield inconsistent and compromised results. When the drawings are the “controlling consideration,” however, the jury’s task is much simpler and straightforward: look at the two designs and determine whether the overall appearances of the claimed and the accused designs are substantially similar.

Giving primacy to the drawings is not to say that a court cannot provide instruction to the fact-finder on *how* to conduct the visual comparison.¹⁶ Further, a court is not hamstrung from providing appropriate guidance that will assist the fact-finder in better understanding the claim. For example, a court may instruct the jury on the specific meaning of drafting conventions that may appear in the drawing, such as, phantom lines, indeterminate break lines, stippling, oblique lines, surface shading, color markings, and multiple embodiments. Furthermore, in appropriate circumstances (e.g., prosecution history estoppel, terminal disclaimers, characteristic features statements, etc.), a court may also explain individual elements of the design.¹⁷ But courts should not, as a matter of law, verbalize, or even attempt to verbalize, the overall visual appearance of the claimed design.¹⁸

WHAT SHOULD BE THE TEST FOR DESIGN PATENT INFRINGEMENT?

Current design patent jurisprudence requires the satisfaction of two distinct tests to establish design patent infringement,

namely, the ordinary observer test and the point of novelty test.¹⁹ Given the considerably confusion regarding the latter test, the Federal Circuit, in its *en banc* Order, bluntly asked whether the point of novelty test should be part of the design patent infringement test, at all.

The Point of Novelty Test Is Not Needed

An analysis of the test’s evolution reveals that while the purpose of the “point of novelty” inquiry addresses the valid concern of preventing infringement findings where the accused design simply reads on the prior art, the creation of a separate and distinct test is unnecessary because *Gorham’s* ordinary observer test, when properly performed, fully accommodates the concerns of that the point of novelty test seeks to address. Accordingly, and as explained further herein, the point of novelty test should be abrogated.

In *Gorham*, the Supreme Court set forth the test that alone has governed design patent infringement for more than 100 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.

Under this straightforward test, the trier of fact must find that “the patented design as a whole is substantially similar in appearance to the accused design.”²⁰

In *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), however, the Federal Circuit augmented the venerable *Gorham* test requiring a second inquiry:

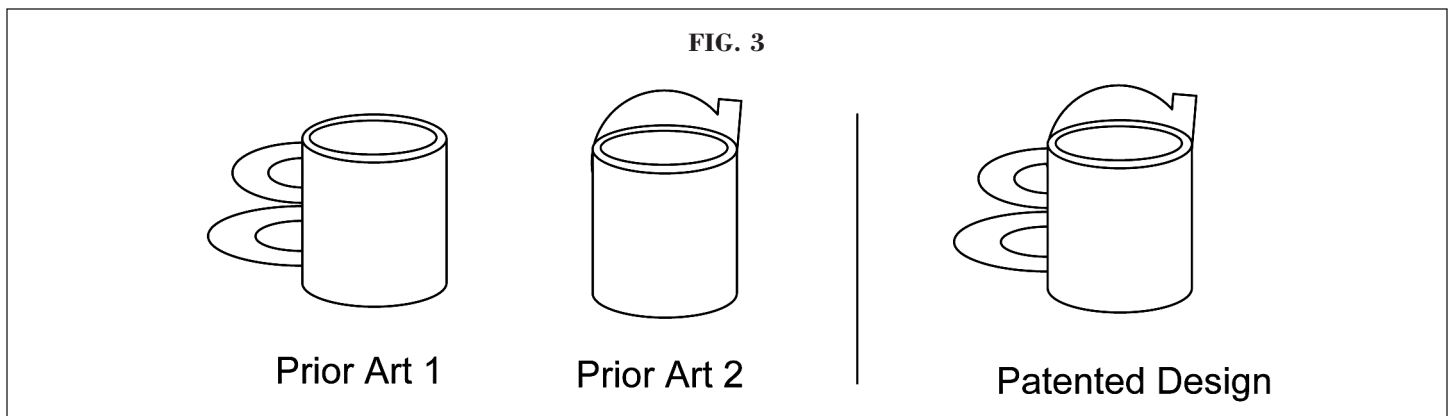
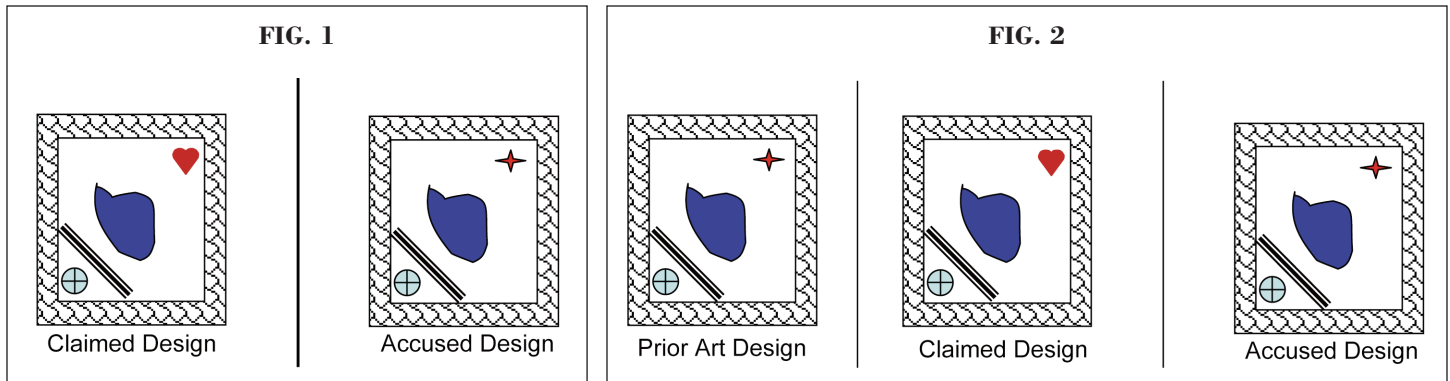
For a design patent to be infringed, however, no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.²¹

Based on this language from *Litton*, subsequent opinions of the Federal Circuit have transformed a concern regarding infringement findings where the accused design was merely practicing the prior art into a separate and distinct “point of novelty test” for design patent infringement. The test requires an identification of the point of novelty and then a determination as to whether the accused design has appropriated that point of novelty.

The primary purpose of the point of novelty test has been to prevent infringement where the accused design is substantially similar to both the claimed design **and** the prior art. For example, consider the following example wherein a Claimed Design is on the left and an Accused Design on the right (see Fig. 1).

Simply applying the ordinary observer test *in a vacuum* (without considering the prior art), a fact-finder might reasonably conclude that the overall visual appearances of the claimed and accused designs are “substantially similar,” and thus find infringement. However, if we conduct this same analysis in view of the Prior Art (as shown below), this outcome appears unjust; it is seen that the Accused Design is merely practicing the Prior Art (see Fig. 2).

To confront this issue, the Federal Circuit implemented the point of novelty inquiry. However, the need for this test is founded upon the false notion that the prior art is not considered when conducting the *Gorham* ordinary observer test. Simply put, the *Gorham* ordinary observer test is not applied in a vacuum, like Fig. 1. Rather, the *Gorham* test takes into account the (1) accused design, (2) claimed design, and (3) prior art, like Fig. 2. In evaluating whether



two designs are “substantially similar,” the fact-finder must conduct the analysis in view of the prior art.²² When placed in this proper context, *Gorham*’s ordinary observer test also yields a finding of non-infringement without the need for an additional point of novelty test. What may have appeared similar in a vacuum (devoid of prior art), appears very different when assessed in view of the prior art.

The Supreme Court’s decision in *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893) accords with this understanding. In *Whitman Saddle*, the Supreme Court reversed the lower court’s findings that: 1) the patented saddle design was valid; and 2) the accused design infringed. With respect to infringement, the Supreme Court, employed its *Gorham* ordinary observer test, and concluded that the accused design was not substantially similar to the patented design because it lacked a “prominent feature” of the patented design, in light of the prior art. *Id.* at 682 (“the difference was so marked that in our judgment the defendants’ saddle could not be mistaken for the saddle of the complainant.”). While the Supreme Court’s decision in *Whitman Saddle* analyzed the patented design in view of the prior art, it did not apply a “point of novelty” analysis of the type developed by the Federal Circuit. Rather, the Court (properly) applied *Gorham* and its substantial similarity determination in light of the prior art.

As a Separate Test for Infringement, The Point of Novelty Test Is Unworkable

Applied as a separate and distinct test for infringement, the point of novelty test is unworkable because there are fundamental flaws with both identifying the point of novelty and determining whether the point of novelty has been appropriated.

The point of novelty test is fatally flawed in that there no principled way to determine the “correct” point of novelty, which often is case determinative. The simple example below illustrates this irreconcilable dilemma (see Fig. 3).

When the Patented Design is compared to Prior Art 1, the point of novelty is the appearance of the lid. However, when the Patented Design is compared to Prior Art 2, the point of novelty is the appearance of the handle. The point of novelty in this

example could also be said to reside in the appearance of either of the following novel *combinations* of elements: (1) the lid and the handle, or (2) the lid, handle and cup. After all, each of these combinations is novel in view of the prior art. In this simple example, there are 4 possible points of novelty, but there is no principled reason upon which a fact-finder can conclude which is the “correct” point of novelty. Forced to choose one, the infringement decision becomes arbitrary.

The point of novelty test is also unworkable in that it improperly seeks to identify only *new portions* of the design, whereas the novelty of a design is found in the overall effect of all combined elements, irrespective of whether such elements are new or old. “A *design is a unitary thing* and all of its portions are material in that they contribute to the appearance which constitutes the design.”²³ Indeed, design patents are granted on the basis of a novel *overall appearance*, not novel individual subparts. Returning to the *Mona Lisa* for a moment, asking for a design’s point of novelty is like asking what one features of DaVinci’s masterpiece sets it apart from the works of his predecessors. In short, it is wholly unrealistic to expect fact-finders to identify and dissect subparts of an overall visual design.

Yet another unworkable flaw of the point of novelty test is that it has been used as a “watered-down” back-door validity attack.²⁴ Once the patentee has identified the point of novelty, an alleged infringer can render a design patent effectively unenforceable (or more accurately, “uninfringeable”) by showing by a mere preponderance of the evidence, that the point of novelty is found in the prior art, thereby bypassing the rigors of an invalidity challenge (*e.g.* *In re Rosen* reference requirement, §282 presumption of validity and clear and convincing standard, etc.) An accused infringer could achieve this goal simply by showing that only a *portion* of the overall design (*i.e.* the alleged point of novelty, not the entire claimed design) was found in the prior art.²⁵ If there are legitimate concerns regarding a design patent’s validity, then any such concerns should be brought through a validity challenge, not through the infringement analysis.

Another problem with the point of novelty test occurs when there is no prior art or the closest prior art is very far from the claimed design. Such circumstances set up an undesirable paradox: the larger the design patent’s leap beyond the prior art (*e.g.*, a pioneering design), the more difficult it is for a design patentee to prove infringement. Under such circumstances, the patent claim is effectively narrowed because the point of novelty will include all or almost all of the elements of the design. Thus, when it comes time to determine if the point of novelty was appropriated, the accused design will have to appropriate all of these features in order to infringe. This inescapable paradox is yet another unworkable consequence of the point of novelty test.

The point of novelty test present not only irreconcilable dilemmas, but also many fundamental, but unanswered, questions. Due to space constraints, I can not go into all of them. However, in bullet point fashion, here are some outstanding issues:

- Can a combination of old elements serve as a point of novelty? This was the main question at issue on petition for rehearing or rehearing *en banc* in *Lawman Armor Corp. v. Winner Int’l, LLC*, 449 F.3d 1190, 1192 (Fed. Cir. 2006), but the issue was never fully resolved. In the *Lawman* clarification opinion, the Court stated only that in “appropriate circumstances a combination of design elements itself may constitute a ‘point of novelty.’” *Id.* (*emphasis added*). The *Lawman* court did not rule on whether a combination of old design elements can constitute a design patent’s point of novelty.
- In identifying the point of novelty is the claimed design compared to the cited prior art or any prior art?
- Can the point of novelty change during the course of a litigation as the prior art pool is augmented?
- To satisfy the point of novelty test must there be an appropriation of “all” or “substantially all” of the individual points of novelty, or will an appropriation of “any” of the novelty suffice? See *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir.

1995) (“A patentee cannot invoke the doctrine [of equivalents] to evade scrutiny of the point of novelty.”); *but see*, *Goodyear Tire v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998) (“The accused design must also contain *substantially the same points of novelty* that distinguished the patented design from the prior art.”)(*emphasis added*).

- If the point of novelty is articulated as a *combination*, must every element of the combination be appropriated, or will either appropriation of “substantially all” of the constituent elements of the combination, or substantially all of the overall appearance of the combination suffice?
- If anticipation is simply the infringement test in “reverse,” does the point of novelty test apply to anticipation? *See Doormaster Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1312 (Fed. Cir. 2001) (“Because ‘[t]hat which infringes, if later, would anticipate, if earlier,’ the design patent infringement test also applies to design patent anticipation.”) (*quoting Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889)).

While it is true that most, if not all, areas of the law have uncertainties, this partial list illustrates the extent of the point of novelty’s current state of disarray. The Federal Circuit can obviate the need to address all of these questions by simply returning the design patent infringement test to its *Gorham* roots. After all, the *Gorham* infringement test, when conducted in view of the prior art, fully accommodates all of the concerns that the point of novelty seeks to address.

CONCLUSION

By inviting briefing on questions far beyond those presented in the Petition for Rehearing *En Banc*, the Federal Circuit appears poised to search for the Rosetta Stone for design patent jurisprudence. While much is uncertain, one thing is for sure: the outcome of *Egyptian Goddess* will

shape the future of U.S. design patent rights for many years to come. **IP**

ENDNOTES

1. Christopher Carani, Esq. is a shareholder at the intellectual property firm of McAndrews, Held & Malloy, Ltd. based in Chicago. Mr. Carani possesses particular and extensive experience in the area of design law (design patents, trade dress, copyrighted design), having litigated numerous disputes and served as a consultant and expert in this specialized area of IP law. Mr. Carani also has published and lectured extensively on the topic of design law. He currently chairs the Industrial Design Committee of the American Intellectual Property Law Association (“AIPLA”). In *Egyptian Goddess*, he authored *amicus* briefs for the AIPLA at both the petition and *en banc* stages.
2. Oral argument took place on June 2, 2008. As of the submission date of this article, the *en banc* Federal Circuit has yet to render an opinion.
3. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F.3d 1354 (Fed. Cir. 2007)
4. The first test, called the ordinary observer test, requires that in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the two designs are substantially the same. The second test, called the point of novelty test, requires that no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.
5. *Id.* at 5 (*emphasis added*)
6. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).
7. In the U.S., the protection afforded designs is referred to as “design patents,” emphasis on the word “patent.” Design patents have their statutory roots in 35 U.S.C. § 171, which authorizes “patents” in ornamental designs.
8. *See, e.g., Black & Decker (U.S.), Inc. v. Pro-Tech Power Inc.*, No. 97-1123-A, 1998 U.S. Dist. LEXIS 9162 * 6-7, (E.D. Va. June 2, 1998) (“the scope of the ‘173 design patent is its ‘overall ornamental visual impression’ as shown in the six orthogonal drawings.”); *see also Colgate-Palmolive Co. v. Ranir, L.L.C.*, No. 06-417-GMS, 2007 U.S. Dist. LEXIS 55258 (D. Del. July 31, 2007); *see also Nike, Inc. v. Meitac Int’l Ent. Co.*, No. 2:06-CV-0934, 2006 U.S. Dist. LEXIS 94662 * 6 (D. Nev. Oct. 11, 2006).
9. *See, e.g., Soffpool, LLC, v. Intex Recreation Corp.*, No. 02:07-CV-0972007 U.S. Dist. LEXIS 3057 (E.D. Tex. Dec. 19, 2007); *Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, No. 3-00-CV-0888-G, 2002 U.S. Dist. LEXIS 8693 (N.D. Tex. May 15, 2002), *aff’d* 2004 U.S. App. LEXIS 770 (Fed. Cir. 2004).
10. By way of example, in *Minka.*, 2002 U.S. Dist. LEXIS 8693, *aff’d* 2004 U.S. App. LEXIS 770 (Fed. Cir. 2004), the district court attempted to provide a verbalization of a relatively straightforward ceiling fan. The court waxed on for over 400 words employing words and phrases such as: “fin-shaped”, “sweeps”, “partial sphere”, “‘running’ pointed star”, “generally football shaped”, and “sharply angle rounded corner.” *Id.*
11. *See Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1464 (Fed. Cir. 1997) (“the drawing themselves are the claims to the patented subject matter”).
12. *See, Elmer*, 67 F.3d at 1577 (holding that every solid line forms part of the claim).
13. Indeed, the Manual of Patent Examining Procedure explains that “[a]s a rule, the illustration in the drawing views is its own best description.” Manual of Patent Examining Procedure §1503.01.
14. *Gorham v. White*, 81 U.S. 511, 526 (1871). (*emphasis added*)
15. The *Gorham* Court quoted Lord Westbury’s statement in *Holdsworth v. McCrea*, 2 Appeal Cases, House of Lords, 388 that “the eye alone is the judge of the *identity of the two things.*” *Id.* (*emphasis added*).
16. *See, e.g., Black & Decker*, 1998 U.S. Dist. LEXIS 9162 *6-7 (providing guidance on how to conduct design patent infringement analysis).
17. Contrary to assertions in some of the *amicus* briefs, determinations regarding whether aspects of a patented design are functional or ornamental is a question for the fact-finder, not the court. *See, e.g., PHG Techs., LLC v. St. John Cos., Inc.*, 469 F.3d 1361, 1365 (Fed. Cir. 2006); *see also, Hupp*, 122 F.3d at 1467.
18. To be sure, cautioning district courts against attempting to completely verbalize the overall appearance of a design during claim construction does not mean that a court cannot use words to explain its *factual findings* in a written or oral opinion (*e.g.*, summary judgment opinions, bench trials, *etc.*).
19. *See, e.g., Contessa Food Prods. Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002) (“Comparison to the accused product includes two distinct tests, both of which must be satisfied in order to find infringement: (a) the ‘ordinary observer’ test, and (b) the ‘point of novelty test.’”)
20. *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997).
21. *Litton Sys.*, 728 F.2d at 1444. (internal cites omitted)
22. *See Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933) (“Yet 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.”). Apple’s *amicus* brief, authored by design law “guru” Perry Saidman, Esq., includes illustrative examples whereby the so-called “3-way” test, which compares the prior art, accused and patented designs in one purview, is applied to several actual cases.
23. *In re Blum*, 374 F.2d 904, 907 (CCPA 1967) (*emphasis added*)
24. *See, e.g., Lawman Armor Corp. v. Winner Int’l LLC*, No. 02-4595, 2005 U.S. Dist. LEXIS 2078 (E.D. Pa. Feb. 15, 2005); *aff’d*, *Lawman Armor Corp. v. Winner Int’l LLC*, 437 F.3d 1383 (Fed. Cir. 2006).
25. *See Sharper Image Corp. v. Target Corp.*, 425 F. Supp. 2d 1056, 1070 (N.D. Cal. 2006) (granting motion for summary judgment of non-infringement where point of novelty was found to be “non-novel,” despite that fact that no validity challenge was mounted) (*citing Lawman.*)