

No. 05-1253

United States Court of Appeals
for the
Federal Circuit

LAWMAN ARMOR CORPORATION,

Plaintiff-Appellant,

v.

WINNER INTERNATIONAL, LLC,
and WINNER HOLDING LLC,

Defendants-Appellees.

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

BRIEF OF AMICUS CURIAE
AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF THE COMBINED PETITION FOR REHEARING
AND REHEARING *EN BANC*

MELVIN C. GARNER, PRESIDENT
AMERICAN INTELLECTUAL PROPERTY
LAW ASSOCIATION
2001 Jefferson Davis Hwy
Suite 203
Arlington, Virginia 22203

CHRISTOPHER V. CARANI
Counsel of Record
MCANDREWS, HELD & MALLOY, LTD
500 West Madison Street, Suite 3400
Chicago, Illinois 60661
Telephone: (312) 775 – 8000

Attorney for Amicus Curiae
American Intellectual Property
Law Association

APRIL 14, 2005

CERTIFICATE OF INTEREST

In accordance with FED. CIR. R. 47.4 and FED. R. APP. P. 26.1, counsel for the Amicus the American Intellectual Property Law Association (AIPLA) certifies the following:

1. The full name of every party represented by me is: **American Intellectual Property Law Association.**
2. The name of 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 parties represented by me are:
None.
4. The names of all law firms and the partners or associates that appeared for the party now represented by me and that are expected to appear in this court are:

Melvin C. Garner, President
AMERICAN INTELLECTUAL PROPERTY
LAW ASSOCIATION
2001 Jefferson Davis Hwy Suite 203
Arlington, Virginia 22203

Christopher V. Carani
MCANDREWS, HELD & MALLOY, LTD
500 West Madison Street, Suite 3400
Chicago, Illinois 60661

Joseph Cianfrani
Knobbe Martens Olson & Bear LLP
2040 Main Street, 14th Floor
Irvine, CA 92614-3641

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STATEMENT OF INTEREST OF AMICUS CURIAE

The American Intellectual Property Law Association (AIPLA) is a national association of nearly 16,000 members interested in all areas of intellectual property law. AIPLA's members include attorneys employed in private practice and by corporations, universities, and government. AIPLA's members represent both owners and users of intellectual property.

AIPLA 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.¹ This brief is filed with the consent of both parties.

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

¹ After reasonable investigation, AIPLA believes that (a) no member of its Board or *amicus* Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (b) no representative of any party to this litigation participated in the authorship of this brief, and (c) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

SUMMARY OF ARGUMENT

In *Lawman Armor Corp. v. Winner Int'l, LLC*, No. 05-1253, slip op. (Fed. Cir. Feb. 22, 2006), the Court stated that a novel combination of old elements is insufficient to constitute a design patent's point of novelty. Slip op. at 5-6.²

While AIPLA does not have an interest in the outcome of the present litigation, it is concerned about the potential adverse impact of this aspect of the Panel's decision on the value of design patent protection. If interpreted literally, this aspect of the decision represents a significant shift in well-settled design patent jurisprudence.³ Most significantly, this statement would be at odds with three prior opinions of this Court, which held that a design patent's point of novelty resided in the visual appearance of a novel combination of old elements. Unfortunately, these aspects of the opinions were not brought to the Panel's attention during briefing.

² Specifically, the Panel stated that it "reject[s] the patentee's contention that the combination in the patent of the many non-novel 'points of novelty' itself was an additional 'point of novelty.'" Slip op. at 1. The Panel further stated: "If the combination of old elements shown in the prior art is itself sufficient to constitute a 'point of novelty' of a new design, it would be the rare design that would not have a point of novelty." *Id.* at 5-6.

³ Indeed, one district court has recently refused to acknowledge a combination point of novelty citing as authority "the holding of *Lawman Armor* that a combination of known features cannot constitute a point of novelty." *Bernhardt L.L.C. v. Collezione Europa USA, Inc.*, 2006 U.S. Dist. LEXIS 14449 (M.D.N.C. March 27, 2006).

As a matter of policy, “[i]nvention lies in the combination of certain features to create a desirable effect.”⁴ The novel aspect of a patented design in a typical case *is* the visual appearance created by a unique combination of old forms. In *Friedley-Voshardt Co. v. Reliance Metal Spinning Co.*, 238 F. 800 (S.D.N.Y. 1916), Judge Hand eloquently explained:

It is to be remembered that ornaments resulting from the varied juxtaposition of curves and angles, like the musical combinations resulting from the sequence of notes and chords, all contain certain intervals -- ornaments intervals of space, music intervals of sound -- *which are traditional and well known. It is difficult, if not impossible, after years of development, to imagine any article of ornament or any production of music of which this is not true.* It is in the arrangement, or, to use the technical term of the patent law, the *combination, of elements*, and probably at this late day in that alone, that originality and aesthetic skill may be evidenced.

Id. at 801 (emphasis added). In light of these design truisms, if the visual appearance of a combination of old elements could not constitute a design patent’s point of novelty, most design patents will be effectively rendered unenforceable (or more accurately, “uninfringeable”) -- because a design patentee will almost never be able to establish a recognized point of novelty.⁵

⁴ *Blumcraft of Pittsburgh v. United States*, 372 F.2d 1014, 1017 (Ct. Cl. 1967) (affirming findings of design patent infringement and validity where a design’s novelty resided in a combination of old elements).

⁵ To prove infringement of a design patent, a patentee must satisfy *both* the “ordinary observer” test and the “point of novelty” test. *Catalina Lighting v. Lamps Plus*, 295 F.3d 1277, 1286-87 (Fed. Cir. 2002). Under the ordinary observer test, a patentee has the burden of proof to show that there is a substantial similarity between the visual appearances of the claimed design and the accused design. *Id.* Under the “point of novelty” test, a patentee has the burden of proof to

To remedy this potentially problematic outcome, the Court should revise the language of its *Lawman* opinion to clarify that, indeed, the novel visual appearance of a combination of old elements *can* constitute a design patent's point of novelty.⁶ Revising the language in this manner would keep the point of novelty test in accord with well-settled design patent jurisprudence holding that, for purposes of *patentability*, the novelty of a design patent *can* reside in the visual appearance of a novel combination of old elements. A revision of the Court's opinion would not require a reversal of the Court's ultimate noninfringement holding. Appellant failed to assert the visual appearance of a novel combination of old elements as a point of novelty at the district court, and thus the Court need not even address that issue in any revised opinion.

establish (1) the design patent's point of novelty, and (2) that the accused design appropriates the design patent's point of novelty. *Id.* The point of novelty test ensures that a visual similarity between accused and claimed design is based, at least partly, on the novelty of the claimed design, and not solely on gross similarities with the prior art.

⁶ To be clear, a mere listing of old elements, separate and apart from their particular arrangement, will not suffice for a point of novelty determination. Rather, under such circumstances, the point of novelty would be in reference to the *specific visual appearance* created when combining such old elements, taking into account the particular spatial relations and relative orientations of the combination's constituent elements.

ARGUMENT

I. STATEMENTS IN THE LAWMAN OPINION CONFLICT WITH THIS COURT’S PRIOR DECISIONS.

On three different occasions this Court has affirmed that the visual appearance of a novel “combination” of old elements could serve as a point of novelty in the context of an infringement analysis.⁷

In *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993), this Court affirmed a finding of infringement where the point of novelty resided in the “overall appearance of the combination” of the major design elements, despite that fact that “all of the elements of the design of the ‘081 patent were known” and “found in the prior art.” *Id.* at 1124-26. This Court affirmed the district court’s conclusion that the novelty resided in the fact that “these particular elements had not previously been combined in a single shoe design.” *Id.* at 1124. Thus, the visual appearance of a novel combination of old elements constituted the design patent’s point of novelty.

Similarly, in *Avia Group Int’l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557 (Fed. Cir. 1988), the Court affirmed a finding of infringement where the point of novelty of the patented design at issue was the visual appearance of “the combination of saddle, eyestay and perforations.” *Id.* at 1565. The Court

⁷ Although the cases cited in this section were also cited in the Appellant’s briefs, key aspects of these cases relating to combination points of novelty do not appear to have been highlighted or discussed.

specifically rejected the defendant's argument that the existence of these *individual* features in the prior art prevented the visual appearance of the *combination* of such features from being novel or non-obvious. *Id.* at 1564.

In *Litton Systems v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), this Court held that a design patent's point of novelty resided in the visual appearance of the combination of known elements:

The novelty of the '990 patent consists, in light of our analysis in the previous section on the '990 patent's validity, of the *combination* on a microwave oven's exterior of a three-stripe door frame, a door without a handle, and a latch release lever on the control panel. The district court expressly found, however, that the Whirlpool design had none of these features.

Id. at 1444. (emphasis added). While the *Litton* opinion does not expressly state whether any of the three individual features were novel on their own, an analysis of the prior art discussed in the opinion shows that at least two of these features were found in the prior art (“three stripe door frame” is found in U.S. D225,780; “a door without a handle” is found in U.S. D225,780 and U.S. 3,321,604). Accordingly, the *Litton* Court arrived at a point of novelty that was the visual appearance of a novel “combination” of design features, regardless of whether the individual elements were known or unknown. *See, Id.* at 1443 (“That all elements of an invention may have been old (the normal situation), some old and some new, or all new, is however, simply irrelevant.”)

District courts have applied a similar approach, uniformly holding that the point of novelty of a design patent can reside in the visual appearance of a novel combination of old elements. For example, in *Lakewood Eng'g & Mfg. Co. v. Lasko Metal Prods.*, 2001 U.S. Dist. LEXIS 13491, 16-17 (N.D. Ill. 2001), the district court, citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, stated:

In order to determine the '907's *points of novelty*, the court must examine prior art to determine how the '907 design differs from it. Examining the references to prior art that Lakewood has submitted, *it does not appear that the elements of the '907 patent, in themselves, are novel*. Prior fan grills, such as the one patented in U.S. Patent No. 312,124 contained vanes that curved in a counter-clockwise direction, while others, such as the one patented in U.S. Patent No. 407,478 contained vanes intersecting concentric circles in a square frame. *What is novel about Lakewood's '907 patent is its combination of all these elements to create a distinctive design. See L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993) (upholding district court's finding that the novelty of plaintiff's patent was its novel combination of prior arts' features).

Id. at 2001 U.S. Dist. LEXIS 13491, 16-17 (emphasis added) (some internal cites omitted). In *The Rockport Company, Inc. v. Deer Stags, Inc.*, 65 F.Supp. 2d 189, 195 (S.D.N.Y. 1999), the district court held: “A unique *combination of known elements* can satisfy the point of novelty requirement.” (emphasis added). Lastly, the district court in *Hosley Int'l Trading Corp. v. K Mart Corp.*, 237 F. Supp.2d 907 (N.D. Ill. 2002) held that: “In appropriate circumstances, a *combination of known elements* may constitute a point of novelty.” (emphasis added).

II. THE COURT SHOULD MAINTAIN CONSISTENCY BETWEEN THE POINT OF NOVELTY DETERMINATION IN INFRINGEMENT AND THE WELL-SETTLED NOVELTY STANDARD USED IN THE PATENTABILITY CONTEXT.

A well-settled cornerstone of design patent jurisprudence holds that, for purposes of *patentability*, the novelty of a design *can* reside in the visual appearance of a novel combination of old elements.⁸ If the *Lawman* decision is interpreted to mean that a novel combination of old elements can *never* constitute a design patent’s point of novelty in the context of an infringement analysis, there will be effectively two different standards for “novelty” – one for purposes of patentability and one for purposes of infringement. The practical result of using

⁸ See, e.g., *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 679 (1893) (“If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty and the result is in effect a new creation, the design may be patentable.”); *Litton*, 728 F.2d at 1443 (“That all elements of an invention may have been old (the normal situation), some old and some new, or all new, is however, simply irrelevant.”); *In re Johnson*, 175 F.2d 789 (CCPA 1949) (“the mere fact that all the elements of a design may be old does not prevent the design from being patentable.”); *Blumcraft*, 372 F.2d at 1018 (“[t]he mere fact that all the elements of a design may be individually old does not prevent the design from being patentable.”); see also, *Matthews & Willard Mfg. Co. v. American Lamp & Brass Co.*, 103 F. 634, 639 (3rd Cir. 1900) (“A combination of elements that are old is patentable...”); *General Gaslight Co. v. Matchless Mfg. Co.*, 129 F. 137, 138 (2nd Cir. 1904) (“The principle, as applied to design patents, is *unassailable* that whenever ingenuity is displayed in producing something new, which imparts to the eye a pleasing impression, *even though it be the result of uniting old forms and parts*, such production is meritorious and entitled to protections.”) (emphasis added.); *Protex Signal Co. v. Feniger*, 11 F.2d 43, 46 (6th Cir. 1926) (“[T]he reassembling or regrouping of familiar forms and decorations may constitute a patentable design.”); *Horwitt v. Longines Wittnauer Watch Co., Inc.*, 388 F.Supp 1257, 1261 (S.D.N.Y. 1975) (“A design is not anticipated merely because some or all of its elements are old, since the essence of design lies in its appearance as a whole.”); see also, William D. Shoemaker, PATENTS FOR DESIGNS, § 38, “New Designs of Old Features,” (1929) (compiling cases).

two different standards would result in design patents being validly issued, but effectively unenforceable. A single standard should govern both contexts.

Allowing the visual appearance of a novel combination of old elements to serve as a design patent's point of novelty would not "stand the 'points of novelty' test on its head," as the *Lawman* opinion suggests. Slip op. at 6. In fact, allowing such combinations to serve as a point of novelty would honor the express mandate of the point of novelty test:

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 distinguished it from the prior art.

Litton, 728 F.2d at 1443. Under these circumstances, the point of novelty is not the visual appearance of a single novel element, but rather the visual appearance of a novel combination of known elements. To prove infringement, the design patentee would still need to show that the accused design appropriated this novelty. Indeed, the point of novelty determination would still meet the express purpose of the rule that "focuses on those aspects of a design which render the design different from the prior art." *Winner Int'l Corp v. Wolo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990). Accordingly, allowing a combination of old elements to serve as a design patent's point of novelty would not only bring the point of novelty test in accord with the well-established patentability standard, but it would also harmonize the point of novelty test with its original intent and purpose.

III. THE LAWMAN OPINION CREATES A NEW “WATERED-DOWN” AFFIRMATIVE DEFENSE TO DESIGN PATENT INFRINGEMENT.

The *Lawman* decision effectively creates a new “watered-down” affirmative defense to design patent infringement under the point of novelty test. If a patentee is not permitted to assert the visual appearance of a novel combination of old elements as a point of novelty, an alleged infringer could render a design patent (which was granted on the novelty of combining old elements) effectively unenforceable (or more accurately, “uninfringeable”) by merely showing, by a preponderance of the evidence, that each constituent element of the novel combination is found in the prior art. An accused infringer could thus render a design patent effectively unenforceable without meeting the demanding safeguards that regularly confront validity and enforceability challenges: the “clear and convincing” evidence standard, the motivation to combine requirement, and the analogous art requirement. *See e.g., Catalina Lighting v. Lamps Plus*, 295 F.3d 1277, 1288 (Fed. Cir. 2002) (clear and convincing evidentiary standard; motivation to combine standard); *see e.g., In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (analogous art requirement). Such a new “watered down” affirmative defense would create an unintended, and undesirable, “short cut” around the statutory presumptions of 35 U.S.C. § 282.

The Court’s opinion states that the “practical effect” of allowing a combination of novel elements to serve as a point of novelty would be “to provide *protection* for designs that in fact involve no significant changes from the prior art.” Slip op. at 6 (emphasis added). The proper channel for addressing any such

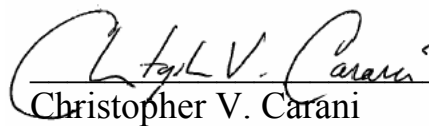
“protection” concerns regarding the novelty of a combination of old forms would be for the accused infringer to mount an invalidity defense, which is subject to the above-noted stringent safeguards. For example, a design patent will be rendered invalid if the accused infringer can show by clear and convincing evidence that a designer of “ordinary skill would have combined the teachings of the prior art to create the same overall visual appearance as the claimed design.” *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996). In sum, a validity challenge is the proper forum for lodging a lack of novelty challenge, not the point of novelty test during an infringement analysis.

CONCLUSION

New designs are almost always the result of combining old forms. After all, there are no new shapes, just new manners of arranging and combining existing shapes. The point of novelty test should reflect this reality. Accordingly, and for the reasons cited herein, this Court should grant the combined petition for rehearing and rehearing *en banc* in order to clarify the opinion to either eliminate any reference to the Appellant’s reliance on a ninth point of novelty (which was not raised below) or to state that the visual appearance of a novel combination of old elements can constitute a design patent’s point of novelty.

April 14, 2006

Respectfully submitted,



Christopher V. Carani
Attorney for *Amicus Curiae*

CERTIFICATE OF SERVICE

**United States Court of Appeals
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LAWMAN ARMOR CORPORATION,
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-----)

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

I am retained by McAndrews, Held & Malloy, Ltd., Attorney for amicus curiae.

That on the **14th day of April, 2006**, I caused 2 copies of the within **BRIEF FOR AMICUS CURIAE** in the above captioned matter to be served, overnight via **FedEx**, upon:

JOSEPH S. CIANFRANI
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
(949) 760-0404
Attorney For Amicus Curiae
American Intellectual Property Law Assoc.

ROBERTA JACOBS-MEADWAY
BALLARD SPAHR ANDREWS
& INGERSOLL
1735 Market Street, 51st Floor
Philadelphia, PA 19103-7599
(215) 665-8500
Attorney For Plaintiff-Appellant

CHRISTOPHER J. RENK
BANNER & WITCOFF, LTD.
Ten South Wacker Drive, Suite 3000
Chicago, IL 60606-7407
(312) 463-5000
Attorney for Amicus Curiae, NIKE, Inc.

DAVID P. GORDON
GORDON & JACOBSON, P.C.
60 Long Ridge Road, Suite 407
Stamford, CT 06902
(203)323-1800
Of-Counsel for Plaintiff-Appellant

PHILIP J. MOY, JR.,
FAY, SHARP, FAGAN, MINNICH
& MCKEE, LLP
1100 Superior Avenue, 7th Floor
Cleveland, OH 44114-2518
(216) 861-5582
Attorney for Defendants-Appellees

PERRY J. SAIDMAN
SAIDMAN **DesignLaw** Group
8601 Georgia Avenue, Suite 603
Silver Spring, MD 20910
(301) 585-8601
Attorney for Amicus Curiae, Industrial Designers Society of America

Unless otherwise noted, 15 copies have been sent to the Court via hand delivery on the same date.

April 14, 2006

