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Points of Novelty, Lawman Armor, and the Destruction of Design Patents

Aaron Cook

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POINTS OF NOVELTY, *LAWMAN ARMOR*, AND THE DESTRUCTION OF DESIGN PATENTS!

*Aaron Cook**

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I. INTRODUCTION

If the *Lawman Armor Corp. v. Winner International, LLC & Winner Holding, LLC* decision is not overturned, it will greatly weaken design patent protection. In March and May of 2006, the Court of Appeals for the Federal Circuit (CAFC) handed down two decisions that sent shockwaves through the design patent community.¹ These decisions are *Lawman Armor I* and *II*,² in which the CAFC held that the overall design of an object is not considered a point of novelty in determining if a design patent has been infringed.³ The CAFC upheld the U.S. District Court for the Eastern District of Pennsylvania decision, that Lawman Armor patent D357621⁴

1. See *Lawman Armor Corp. v. Winner Int'l, LLC & Winner Holding, LLC*, 437 F.3d 1383 (Fed. Cir. 2006). See *Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1190 (Fed. Cir. 2006).

2. See *Lawman Armor*, 437 F.3d at 1384 (declaring that a combination of previously known design elements cannot serve as a point of novelty); see *Lawman Armor*, 449 F.3d at 1190 (denying a rehearing en banc and issuing a supplemental opinion to clarify the CAFC's previous *Lawman Armor* opinion).

3. *Lawman Armor*, 437 F.3d at 1386.

4. The D357621 Patent claims:

does not contain a point of novelty.⁵ At the CAFC, Lawman argued for an interpretation that a combination of design features known in the prior art can serve as a point of novelty.⁶ The CAFC was unconvinced and determined such an interpretation would turn design patent infringement on its head.⁷

This opinion led intellectual property practitioners and members of the design industry to submit briefs to petition the CAFC for a rehearing or rehearing en banc.⁸ These professionals argued that not only does the CAFC decision fly in the face of current precedent,⁹ but the decision creates a disparity in the novelty required to receive a design patent and the novelty required to prove design patent infringement.¹⁰ Even judges on the CAFC disagreed with their colleagues' interpretation and strongly urge the DCA to revisit the *Lawman Armor* decision.¹¹

The author will examine what a design patent is,¹² the standards and rules governing the grant of a design patent, and the court-created tests for design patent infringement. Next, the author will examine how the *Lawman Armor* opinion affects design patent infringement analysis. The author will then compare the *Lawman Armor* decision with prior CAFC design patent cases. Lastly, the author will propose a new rule for

U.S. Patent No. D357621 (issued Apr. 25, 1995).

5. See *Lawman Armor Corp. v. Winner Int'l*, No. 2078, 2005 WL 354103, at *6 (E.D. Pa. Feb. 15, 2005).

6. *Lawman Armor*, 437 F.3d at 1385.

7. *Id.* at 1386.

8. Brief of Amicus Curiae American Intellectual Property Law Association in Support of the Combined Petition for Rehearing and Rehearing En Banc, *Lawman Armor*, 449 F.3d at 1190; *Lawman Armor*, 449 F.3d at 1192 (No. 05-1253), 2006 WL 1287642 (Fed. Cir.). Brief for Amicus Curiae Indus. Designers Soc'y of Am. in Support of Appellant's Combined Petition for Panel Rehearing and Rehearing En Banc, *Lawman Armor*, 449 F.3d at 1190; *Lawman Armor*, 449 F.3d at 1192 (No. 05-1253), 2006 WL 1032974 (Fed. Cir.).

9. See *infra* Part V.A (examining opinions by the CAFC, in which the CAFC found that the point of novelty was a combination of known design elements).

10. See *generally* Brief for Amicus Curiae Indus. Designers Soc'y of Am. in Support of Appellant's Combined Petition for Panel Rehearing and Rehearing En Banc, (No. 05-1253), 2006 WL 1032974 (Fed. Cir.) (Arguing that the CAFC should reconsider the case for five reasons: (1) designs are mostly combinations of old elements, (2) that the CAFC's fear that a combination of elements could undermine the point-of-novelty test is unfounded, (3) the CAFC's decision allows patent invalidity to be found using a preponderance of evidence standard, (4) there is no precedent for the CAFC's decision, and (5) not all 8 points of the 0357621 patent were disclosed in the prior art.).

11. See *Lawman Armor*, 449 F.3d at 1193-95 (Newman, J., dissenting).

12. A design patent protects the "ornamental design for an article of manufacture." 35 U.S.C. § 171 (1952).

determining the point of novelty, utilizing the standards in design patent prosecution, case law, and problems *Lawman Armor* made apparent.

II. BACKGROUND

In order to fully understand the ramifications of the *Lawman Armor* holding and the proposed rule, one must understand what a design patent is and the requirements to receive a design patent. The requirements for the proposed rule are most strengthened by the novelty and obviousness requirements for receiving a design patent. Below, the author briefly describes what a design patent is and what designs are eligible for patent protection. Also, the author more closely examines novelty and non-obviousness.

A. Design Patent

Design patents are a creation of a federal statute.¹³ 35 U.S.C. 171 states “[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor [sic], subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”¹⁴ *Ex parte Cady* declared a patentable design to be the design embodied in or applied to an article of manufacture and not the article itself.¹⁵ In *In re Zahn*, the list of designs eligible for patenting was expanded to include eleven kinds of surface ornamentation as well as configuration of goods.¹⁶ The Manual of Patent Examination Procedure distilled designs eligible for patenting as:

The design for an article consists of the visual characteristics embodied in or applied to an article.

13. 35 U.S.C. § 171 (1952).

14. *Id.*

15. U.S. PATENT AND TRADEMARK OFFICE, MANUAL OF PATENT EXAMINATION PROCEDURE 1500-02 (8th ed. 5th rev. 2006) [hereinafter MPEP] (citing *Ex parte Cady*, 1916 C.D. 62).

16. See *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980). The Court of Customs and Patent Appeals (CCPA) held that the U.S. Trademark and Patent Office (USPTO) improperly rejected a design patent for the shank of the drill bit for two reasons. First, the USPTO made an improper indefiniteness rejection and second, the claimant had disclaimed the cutting portion of the drill bit. *Id.* at 267.

Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.

Design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method.¹⁷

In short, a design patent gives the inventor a statutory right to a fourteen year monopoly on the aesthetic nonfunctional features, the design, of an article.¹⁸ To receive a design patent the inventor, through a patent attorney, must file an application with the U.S. Patent and Trademark Office and meet the specified requirements.¹⁹

B. Receiving a Design Patent

To receive a design patent from the U.S. Patent and Trademark office, the design must meet three requirements; the design must be patentable subject matter, novel, and non-obvious.²⁰

1. Patentable Subject Matter

Patentable subject matter pertaining to designs is governed by 35 U.S.C. § 171 and case law. The three categories in which a design must fall in order to qualify for patentability are (1) “design[s] for . . . ornaments, impression[s], print[s], or picture[s] applied to or embodied in . . . article[s] of manufacture . . . ; (2) . . . design for the shape or configuration of an article of manufacture; and (3) a combination of the first two categories.”²¹ Under these requirements a photograph not applied to or embodied in an article of manufacture is not entitled to design patent protection.²² However, the pattern on a floor tile or wallpaper would be

17. MPEP, *supra* note 15, at 1500-02.

18. ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT 71 (Harmon 6th ed. 2003).

19. 35 U.S.C.A. § 171 (West 2006).

20. 35 U.S.C. §§ 102, 103, & 171 (1952). *See also* MPEP, *supra* note 15, at 1500-12, 1500-21, & 1500-28.

21. MPEP, *supra* note 15, at 1500-13. *See also In re Schnell*, 46 F.2d 203, 205-06 (C.C.P.A. 1931) (The CCPA upheld a U.S. Trademark and Patent Office rejection for the design of an automobile handle or similar article because the claim was not specific enough).

22. *See* 35 U.S.C. § 171 (1952). *See also* MPEP, *supra* note 15, at 1500-13.

entitled to such protection.²³ Lastly, the design for which a patent is sought can be comprised of many parts within a single article of manufacture.²⁴

A second aspect of patentable subject matter is that the design must be ornamental and not functional²⁵ and the design must be visible in the end use of the article of manufacture.²⁶ Lastly, if the design incorporates matter that may be offensive to any race, sex, ethnic group, including depictions and caricatures, the design cannot be patented.²⁷

2. Novelty

It is not enough for a design to be patentable subject matter; it must also be novel. Novelty is set forth in 35 U.S.C. § 102.²⁸ To supplement the statutory requirements for design patents, the CCPA created a test first announced in *In re Johnson*²⁹ and later strengthened in *In re Bartlett*.³⁰ In *In re Johnson*, the court stated that the test to obtain a design patent is that an average observer must take the design in question as something different and not as "a modified already-existing, design."³¹ The court in *In re Bartlett*, clarified the test in *In re Johnson* to be applicable only in determining the novelty of a design, not patentability as a whole.³²

23. See Application of Bartlett, 300 F.2d 942, 972-73 (C.C.P.A. 1962) (The CCPA held that a tile design utilizing an unidirectional blob smearing pattern was patentable over a single reference showing a "marbled" pattern).

24. See *infra* Part V.A.

25. See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (discussing this case and that "the ultimate question is not the functional or decorative aspect of each feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article."); see *infra* Part V.A.3. See also MPEP, *supra* note 15, at 1500-16.

26. *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997) (The CAFC remanded a decision by a district court claiming that a design patent for a bi-level cup was invalid in that the design was functional. The decision was remanded for two main reasons: (1) design specifications cannot be used to determine functionality and (2) courts must consider the entire design to determine functionality). See also *Moore v. Stewart*, 600 F. Supp. 655, 661 (W.D. Ark. 1985) (the district court found a design patent for a whistle valid even though some of the elements may have been dictated by functionality reasons; the whistle appearance has much aesthetic appeal). See also MPEP, *supra* note 15, at 1500-18.

27. MPEP, *supra* note 15, at 1500-20.

28. 35 U.S.C. § 102 (1952).

29. Application of Johnson, 175 F.2d 791 (C.C.P.A. 1949) (The CCPA found a design patent for a pair of pliers invalid in that it was obvious to a designer skilled in the art).

30. Application of Bartlett, 300 F.2d 942 (C.C.P.A. 1962).

31. Application of Johnson, 175 F.2d at 792.

32. Application of Bartlett, 300 F.2d at 943.

If a patent applicant's design utilizes an already existing design, the existing design must "show the same subject matter as that of the patent, and must be identical in all material respects" for it to bar the patentability of the applicant's design.³³ However, a design for which a patent is sought cannot be distinguished from previously known designs by relying on aspects of the new design that are hidden in the normal use of the article of manufacture or aspects that are functional.³⁴ The average observer mentioned in *In re Johnson*, is not restricted to comparing the design for which a patent is sought only to designs in similar disciplines.³⁵

One exception traditionally available for utility patents that is rarely available for design patents is that of experimental use.³⁶ The only time the experimental use exception has been successfully invoked in favor of a design patent is when the experimental use was conducted to develop the functional traits of an article of manufacture and the ornamental design was not subject to the experimentation.³⁷

3. Non-Obviousness

Closely related to novelty is the concept of non-obviousness. The standard for non-obviousness is the same as that for a utility patent³⁸ and

33. *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1461 (Fed. Cir. 1997) (The CAFC overturned a district court's decision finding a design patent for a mold to make a simulated stone pathway invalid).

34. *Application of Cornwall*, 230 F.2d 457, 459 (C.C.P.A. 1956) (The CCPA found a design patent for the design of a moisture vent tube invalid, since the design elements viewable to the public resembled a patented closure cap).

35. *Application of Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956) (The CCPA reversed the Patent Board of Appeals decision denying a patent for the design of a swimmer float. The CCPA reasoned that even though the design features were known in the prior art, there was no suggestion to combine them).

36. *See In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988) (The CAFC found that displaying the design for a wrought iron table at a trade show more than one year before filing for a design patent, created a bar to receiving a design patent. Additionally, the CAFC rejected the idea that the creator of a design could engage in experimental use). *Compare City of Elizabeth v. Am. Nicholson Pavement Co.*, 97 U.S. 126 (1877) (constructing a road using a new process, as part of a toll way belonging to the city of Boston. The court found that this was experimental use since it allowed Nicholson to observe the effects of heavy wagons, the new road's durability, and the road's liability to decay).

37. *See Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1199-1200 (Fed. Cir. 1994) (The CAFC held that experimentation of functional features of a spice container containing design elements, was not a public use barring design patent protection.).

38. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1441 (Fed. Cir. 1984) (discussing the case and finding Litton's utility patent invalid in that a commercial embodiment of the patented invention was on sale for more than a year before Litton filed for a utility patent. The court found

is statutorily defined in 35 U.S.C. § 103.³⁹ Unlike the novelty test that looks to the ordinary observer, the test for non-obviousness is judged from the eyes of an ordinary designer.⁴⁰ To put it simply, a design to be patented is non-obvious when, in the eyes of an ordinary designer, the design to be patented is not an apparent derivation of a prior design.⁴¹ The test for non-obviousness, as set forth by the U.S. Supreme Court in *Graham v. John Deere Co. of Kansas City*, is “the scope and content of the prior art are to be determined; differences between the prior art and the claims[, or design] at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.”⁴²

Though the *Graham* test was originally developed for utility patents, later court decisions applied the *Graham* test to design patents.

In re Glavas set forth the considerations specific for design patents to determine the scope and content of the prior art.⁴³ The considerations unique to determining obviousness in design patent cases ask “whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.”⁴⁴ Thus, under this rule, it is obvious to use ornamental design elements of cars in the design of boats.⁴⁵ Determining the differences between the prior art and the design at issue requires looking at the design as a whole.⁴⁶ For an obviousness evaluation, there is an additional consideration of “whether the references are so related that the appearance of certain ornamental features in one would suggest the application of

Litton’s design patent valid and since the whirlpool products did not incorporate the point of novelty contained in Litton’s design patent at issue); *see infra* Part V.A.1.

39. 35 U.S.C. § 103 (1952).

40. *Sidewinder Marine, Inc. v. Starbuck Kustom Boats & Prods., Inc.*, 597 F.2d 201, 208 (10th Cir. 1979) (The circuit court set forth that the standard for obviousness was that of an ordinary designer in the art, not the average person. As a result the circuit court found a design patent for the design of a boat obvious since it incorporated known design elements found in automobiles).

41. JEFFREY G. SHELDON, *HOW TO WRITE A PATENT APPLICATION* 9-24 (1992). *See Litton Sys.*, 728 F.2d at 1423.

42. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17 (1966).

43. *Application of Glavas*, 230 F.2d 447 (C.C.P.A. 1956).

44. *Id.* at 450.

45. *See generally Sidewinder Marine*, 597 F.2d at 201 (finding *Sidewinder*’s design patent non-obvious and invalid since the patented design was obvious in comparison to automobile designs).

46. *Application of Leslie*, 547 F.2d 116, 120 (C.C.P.A. 1977) (The CCPA found it proper to use a utility patent as a reference to reject a design patent for a golf club shaft).

those features to the other.”⁴⁷ The level of skill in the art is difficult to define.

The case in *In re Nalbandian* helped to shed light on how to determine the level of skill necessary for a design.⁴⁸ The CCPA in *In re Nalbandian* opined that the level of skill required is that of a “designer of ordinary capability who designs articles of the type presented in the application.”⁴⁹ The CCPA further defined the “designer of ordinary capability” as “one who brings certain background and training to the problems of developing designs in a particular field. . . .”⁵⁰

The non-obviousness requirement allows for a combination of past designs to render a design seeking patentability obvious.⁵¹ The way to deem a design obvious by a combination of references is best set forth in the CAFC opinion of *In re Harvey*.⁵² In *In re Harvey*, the CAFC listed two factors to assess.⁵³ First, there must exist a primary reference that incorporates a design with a nearly identical visual appearance.⁵⁴ The primary reference cannot be a design concept.⁵⁵ Second, there must be a suggestion to combine all of the previous design elements with the primary design reference.⁵⁶ This combination must incorporate the visual impression of the design to be patented.⁵⁷ However, if the combination of the prior designs only suggests elements of the design to be patented and the primary design would require major modifications, the design to be patented is not obvious.⁵⁸

In *Graham*, the U.S. Supreme Court listed several secondary considerations that assist in deciding non-obviousness. These secondary considerations, including “commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the

47. *Id.*

48. *In re Nalbandian*, 661 F.2d 1214 (C.C.P.A. 1981) (The CCPA found the design patent for an illuminable tweezers obvious in view of the prior art).

49. *Id.* at 1216.

50. *Id.*

51. See 35 U.S.C. § 103 (1952).

52. *In re Harvey*, 12 F.3d 1061, 1066 (Fed. Cir. 1993) (The CAFC reversed the final rejection of a design patent application claiming an ornamental design for a vase for three reasons: (1) the rejection relied on prior art references showing a design concept, not the actual design, (2) even if proper, there was no suggestion to combine, and (3) findings that the differences were minimal was erroneous).

53. *Id.* at 1063-64.

54. *Id.* at 1063.

55. *Id.*

56. *Id.* at 1064.

57. *In re Harvey*, 12 F.3d at 1063.

58. *Id.*

circumstances surrounding the origin of the subject matter sought to be patented.”⁵⁹ A positive factual finding for any of these considerations can help prove that the design was non-obvious.⁶⁰

III. STANDARDS FOR DESIGN PATENT INFRINGEMENT BEFORE *LAWMAN ARMOR*

Infringement for a design patent is set forth in the Patent Act under 35 U.S.C. § 289 as the unauthorized selling, the unauthorized manufacturing, or the intention to sell an article of manufacture that incorporates or is a “colorable imitation” of a patented design.⁶¹ To prove infringement of a design, the courts have developed two tests; the ordinary observer test and the point-of-novelty test.⁶²

A. *The Ordinary Observer Test*

The ordinary observer test was first explained by the U.S. Supreme Court in *Gorham Manufacturing Co.*⁶³ The test is “if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”⁶⁴ Over time, courts have clarified this test, emphasizing key elements in the test’s application as well as updating the test to account for new developments within patent law.⁶⁵

The design must be viewed as claimed in the patent.⁶⁶ It is not sufficient that a potential infringer incorporated only one element of the

59. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17-18 (1966).

60. *Id.*

61. 35 U.S.C. § 289 (1952).

62. HARMON, *supra* note 18, at 74-75.

63. *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871) (The U.S. Supreme Court found the design patent claiming a cottage pattern for the handles of spoons and forks infringed by handles that in the eye of an ordinary observer are substantially the same).

64. *Id.* at 525.

65. See *infra* text accompanying note 73. See generally Perry J. Saidman & Allison Singh, *The Death of Gorham Co. v. White: Killing it Softly with Markman*, 86 J. PAT. TRADEMARK OFF. SOC’Y 792 (2004) (examining the impact of *Markman* on the ordinary observer test).

66. *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988) (The CAFC found that a design patent for a massage device using fuzzy tennis balls was not infringed by a device using smooth wooden wheels, since a design must be equivalent in the design aspects not functional aspects to find design patent infringement).

patented design if the two designs are dissimilar.⁶⁷ In *Contessa Food Products*,⁶⁸ the reviewing court determined the lower court erred in only considering the design of the top of the tray for infringement analysis while ignoring the bottom design elements as shown in the Contessa patent. When comparing a potential infringer's overall appearance to the appearance of the patented design, courts must compare the potentially infringing design to that of the claims in the design patent and not the commercial embodiment of that patent.⁶⁹ By only comparing the design elements claimed in the patent, courts are prevented from mistakenly finding infringement based on unclaimed elements contained in the commercial embodiment.⁷⁰

Similar to utility patents, both the doctrine of equivalents⁷¹ and patent prosecution history estoppel play a role in determining infringement.⁷² The doctrine of equivalents prevents an infringer from avoiding infringement by making trivial changes to a design.⁷³ The doctrine of equivalents only applies to the ordinary observer test.⁷⁴ When a court exercises the doctrine of equivalents, the equivalent must be in a design feature that satisfies the original test in *Gorham*, that an ordinary observer will confuse the

67. *KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993) (finding that features of the ornamental block design were not substantially similar to the accused blocks even though the two blocks appear similar when placed in a retaining wall. The design patent infringement of this case was remanded on an issue of fact relating to whether the blocks were on sale a year prior to filing a design patent).

68. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1378-79, 1382 (Fed. Cir. 2002) (The CAFC vacated a decision of partial summary judgment for the plaintiff, since the district court only applied the ordinary observer test at the time of sale for a shrimp tray and not during its normal and intended use). *See id.* at 1378-79.

69. *Payless Shoesource, Inc. v. Reebok Int'l, Ltd.*, 998 F.2d 985, 990 (Fed. Cir. 1993) (The CAFC vacated and remanded a district court denial of a preliminary injunction since the district court failed to compare the accused infringing shoes to the embodiments contained in the design patent).

70. *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1196 (Fed. Cir. 1995) (discussing infringement of unclaimed features of a design patent); *see infra* Part V.B.2.

71. *See Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1190 (Fed. Cir. 1988). Doctrine of equivalents is "a judicially created theory for finding patent infringement when the accused process or product falls outside the literal scope of the patent claims. The doctrine evolved to present parties from evading liability for patent infringement by making trivial changes to avoid the literal language of the patent claims." BLACK'S LAW DICTIONARY (8th ed. 2004).

72. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993).

73. *See Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (U.S. 1950) (The U.S. Supreme Court upheld the decision that four of Linde Air flux claims were infringed by the doctrine of equivalents).

74. *See Sun Hill Indus.*, 48 F.3d at 1196.

infringing design for the patented design.⁷⁵ As an example of an equivalent for a design patent, a massager utilizing smooth wooden balls would be an equivalent for a patented design utilizing smooth rubber balls having the appearance of wood.⁷⁶

B. Point-of-Novelty Test

If the ordinary observer test is met, a court will then apply the point-of-novelty test. The point-of-novelty test was first proposed in *Kruttschnitt v. Simmons*, in which the district court stated, "in order to constitute infringement there must be an appropriation of the novel elements of the patented design" by the alleged infringing design.⁷⁷ The test was adopted by the DCA in *Litton Systems*.⁷⁸ A point of novelty is an element or elements of the patented design that distinguishes the patented design from previous designs.⁷⁹ For example the U.S. Design Patent No. D-226,990 at issue in *Litton Systems*⁸⁰ had the following point of novelty: "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."⁸¹ This test is not used to determine if the design is obvious, but only if the patented design has been infringed.⁸²

After *Litton Systems*, the federal courts have continually altered the points of novelty test. The court in *Winner International Corp. v. Wolo Manufacturing Corp.* narrowed the point-of-novelty test by precluding the overall appearance of a design as a point of novelty.⁸³ In *Rubbermaid*

75. *L.A. Gear*, 988 F.2d at 1125.

76. *Cf. Lee*, 838 F.2d at 1189 (The CAFC found that a massager using smooth wooden balls was not an equivalent for a massager utilizing fuzzy tennis balls).

77. *Kruttschnitt v. Simmons*, 118 F. 851, 852 (S.D.N.Y. 1902) (Upheld the decision that a design patent for a scroll figure within a borderline was infringed).

78. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984).

79. *Id.*

80. U.S. Patent No. D226,990 (issued May 22, 1973).

81. *Litton Sys.*, 728 F.2d at 1444 (In this instance, the accused infringing device, did not contain the point of novelty.)

82. *Id.* (Though it is arguable that if a design was non-obvious it must have a point of novelty).

83. *Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990) (refusing to consider the overall design as a point of novelty, but stating that aspects of the design patent which distinguished it from the prior art were so numerous and substantial for any reasonable jury to find infringement. The court reversed the patent invalidity holding with a very cursory analysis.); see *infra* Part V.B.1.

Commercial Products, Inc. v. Contico International, Inc.,⁸⁴ the Western District of Virginia expanded the point-of-novelty test. The district court, in responding to Contico's argument about narrowing the available points of novelty solely to the individual design elements, stated

there is nothing, however, in the Winner holding that suggests that the overall appearance of the design must be disregarded. Indeed, the "ordinary observer" test would preclude such a rule. While the point of novelty approach does command an inquiry into specific elements in the prior art as an initial matter, it does not preclude an analysis of how those elements are combined and integrated into an overall design, and of whether that design has been anticipated.⁸⁵

In 1998, the DCA further expanded the point-of-novelty test by declaring that a potentially infringing design needed to only incorporate points of novelty that were substantially similar to the patented design's points of novelty, not the identical points of novelty.⁸⁶

C. Applying the Two Tests

The standard to find infringement is by a preponderance of the evidence.⁸⁷ It is improper and a legal error for a court to combine the ordinary observer test and the point-of-novelty test.⁸⁸ It is improper when applying the ordinary observer test to focus on the point of novelty.⁸⁹ When determining if a potentially infringing design incorporates the point

84. *Rubbermaid Commercial Prods., Inc. v. Contico Int'l, Inc.*, 836 F. Supp. 1247 (W.D. Va. 1993) (Rubbermaid was successful in receiving a preliminary injunction against Contico for selling trash bins that were substantially similar to a design patent held by Rubbermaid).

85. *Id.* at 1259.

86. *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998) (The CAFC affirmed a district court decision that a Goodyear design patent was not infringed since the accused infringing tire did not incorporate several important points of novelty. The CAFC did hold that the Goodyear design patent was not only applicable to truck tires.). *See also* *Hosley Int'l Trading Corp. v. K Mart Corp.*, 237 F. Supp. 2d 907, 911 (N.D. Ill. 2002) (The district court did not find infringement of a design patent claiming a cauldron shape votive holder since the accused's product did not contain a ring on top of the cauldron or a raised pattern on the handle).

87. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993).

88. *Unidynamics Corp. v. Automatic Prods. Int'l, Ltd.*, 157 F.3d 1311, 1324 (Fed. Cir. 1998) (The CAFC remanded the district court grant of summary judgment regarding non-infringement of the design patent for the design of a vending machine, since the lower court merged the ordinary observer and point-of-novelty test). *See also* HARMON, *supra* note 18, at 75.

89. *Unidynamics*, 157 F.3d at 1324.

of novelty, it is improper for the courts not to engage in a point-of-novelty test, by relying on the claimed overall design as the point of novelty.⁹⁰

When applying the two tests for infringement, a court may not consider two other legal concepts: consumer behavior⁹¹ and unfair competition.⁹² If the infringing and protected designs are not in the same market, infringement can still exist.⁹³ Lastly, design patent infringement does not require that consumers are actually confused as to the source of the article of manufacture.⁹⁴

IV. *LAWMAN ARMOR CASE*

A. *Facts*

Lawman Armor received design patent 357,621 ('621 patent)⁹⁵ for a design in a sliding lock mechanism for the steering wheel of a car.⁹⁶ The patent claimed "the ornamental design for a sliding hook portion of a vehicle steering wheel lock assembly, as shown and described."⁹⁷ Lawman Armor sued Winner International LLC for infringing Lawman Armor '621 design Patent.⁹⁸ Winner International then filed a motion for summary judgment for non-infringement.⁹⁹

90. Sun Hill Indus., Inc. v. Easter Unlimited, Inc., 48 F.3d 1193, 1197 (Fed. Cir. 1995).

91. Braun, Inc. v. Dynamics Corp. of Am., 975 F.2d 815, 820 (Fed. Cir. 1992) (The CAFC affirmed the willful infringement of Braun design patent for hand-held kitchen blenders).

92. *L.A. Gear*, 988 F.2d at 1126.

93. Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc., 853 F.2d 1557, 1565 (Fed. Cir. 1988) (finding that shoes made for children can infringe a design patent for shoes made for tennis players); *see infra* Part V.A.2.

94. Unette Corp. v. Unit Pack Co., Inc., 785 F.2d 1026, 1029 (Fed. Cir. 1986) (affirming a district court decision that a design patent for a dispensing container was not infringed).

95. U.S. Patent No. D357621 (issued Apr. 25, 1995). *See supra* note 4 (showing picture of the design patent at issue in Lawman Armor Corp. v. Winner Int'l, LLC & Winner Holding, LLC, 437 F.3d 1383 (Fed. Cir. 2006)).

96. Lawman Armor Corp. v. Winner Int'l, No. 2078, 2005 WL 354103, at *1 (E.D. Pa. Feb. 15, 2005).

97. U.S. Patent No. D357621; *see supra* note 4 (depicting patent requested).

98. *Lawman Armor*, 2005 WL 354103, at *1.

99. *Id.*

B. District Court Opinion

After construing the claims¹⁰⁰ by developing a written description that “evoke[s] a visual image constant with the claimed design rather than merely represent[ing] the general design concept.”¹⁰¹ Then, the district court applied the ordinary observer test and the point-of-novelty test.¹⁰² Under the ordinary observer test, the district court determined that there were material issues of fact between the ‘621 Patent and the accused infringing device, thus warranting a trial.¹⁰³ Under the point-of-novelty test, the district court did not find a material issue of fact.¹⁰⁴ Lawman Armor asserted eight points of novelty in its claim design.¹⁰⁵ The district

100. *Id.* at *3. The ‘621 Patent was construed as follows:

The 621 patent is directed to the sliding hook portion of a vehicle steering wheel lock assembly. The patent depicts two hooks, a shaft and the intersection between the shaft and the hooks. The shaft has four different sections. The shaft section furthest from the hooks is cylindrical and smooth. The next shaft section contains notches or grooves in a particular pattern and dimensions as shown, which completely encircle the shaft. Figures 6 and 7 show that the notches or grooves are what would generally be considered a trapezoidal shape. The third shaft section is again cylindrical and smooth and roughly the same diameter as the first shaft section. The fourth and final shaft section is cylindrical and smooth but has a larger diameter than the first and third shaft sections.

The 621 patent also depicts two hooks. The hooks hang from the shaft and face outward away from the shaft. The hooks have the same profile as shown in Figures 4 and 5 which resembles a C-shape. The ends of the hooks are not parallel to each other as shown in Figures 6 and 7. There is a connective segment between the two hooks that is semi-circular, appearing to resemble a U as shown in Figure 6. The overall ornamental appearance of the hooks portion, from the perspective in Figure 6 is like an M with a curved middle section.

The intersection of the hooks and the shaft is a circle on top of and centered on a relatively straight portion when viewed in Figures 2 and 3. When viewed in Figures 6 and 7, the shaft intersects the connective hooks segment at its center. The shaft extends past the connective hook segment as shown in Figures 6 and 7.

Id. at *3 (quoting *Lawman Armor Corp. v. Master Lock Co.*, No. CIV.A. 02-6605, 2004 WL 440177, at 4-5 (E.D. Pa. Mar. 11, 2004)).

101. *Lawman Armor*, No. CIV.A. 02-6605, 2004 WL 440177, at *2.

102. *Lawman Armor Corp. v. Winner Int’l*, No. 2078, 2005 WL 354103, at *3 (E.D. Pa. Feb. 15, 2005).

103. *Id.* at *4.

104. *Id.* at *6.

105. *Id.* at *5. The eight points of novelty asserted were:

court, however, found that all of the points of novelty enumerated by Lawman Armor were already contained in known designs.¹⁰⁶ Next, the district court determined since Lawman Armor failed to show a point of novelty and therefore did not create an issue of fact, no issue of fact existed.¹⁰⁷ Without an issue of fact under the point-of-novelty test, the district court granted the defendant's motion for summary judgment.¹⁰⁸

C. *The First Federal Circuit Opinion*

The CAFC agreed with the district court that the eight points of novelty claimed by Lawman Armor were disclosed in previous designs.¹⁰⁹ The Federal Circuit further stated that there need not be a suggestion to combine multiple references when conducting a point-of-novelty test.¹¹⁰ Lastly, the Federal Circuit addressed Lawman Armor's argument that there was a ninth point of novelty in its design, which was the combination of the eight points of novelty in one design.¹¹¹

The Federal Circuit rejected this ninth point of novelty, because they thought it would undermine the point-of-novelty test.¹¹² Senior Circuit Judge Friedman, explained the undermining as follows:

-
1. A sliding arm of a steering wheel locking device that includes a shaft with 2 hooks attached at approximately one end of the shaft.
 2. The hooks are curved, have the same profile, are symmetrical to one another, and are generally shaped like the letter "C."
 3. The open ends of the hooks face outward from the shaft.
 4. The shaft attaches to the hooks at or about the top portions of the hooks, approximately midway between the two hooks.
 5. The shaft includes a pattern of ridges.
 6. The shaft increases in diameter at the end of the shaft attached to the hooks, with the diameter increasing at a point just prior to the point of attachment of the hooks to the shaft.
 7. The shaft is generally circular at the point where it attaches to the hooks.
 8. The hooks are approximately 20-25% of the length of the shaft.

Id. at *5.

106. *Id.* at *5-6.

107. *Lawman Armor*, No. 2078, 2005 WL 354103, at *6.

108. *Id.* at *6.

109. *Lawman Armor Corp. v. Winner Int'l, LLC & Winner Holding, LLC*, 437 F.3d 1383, 1385 (Fed. Cir. 2006).

110. *Id.*

111. *Id.*

112. *Id.*

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. The practical effect of Lawman’s theory would be virtually to eliminate the significance of the “points of novelty” test in determining infringement of design patents, and to provide patent protection for designs that in fact involve no significant changes from the prior art.¹¹³

The Federal Circuit declared a point of novelty in new designs to be changes in shape, size, placement, or color of elements in old designs.¹¹⁴ The Federal Circuit further stated in an effort to strengthen their position that the proposition by Lawman Armor would result in all designs having a point of novelty and would undermine the point-of-novelty test.¹¹⁵ The Federal Circuit ultimately upheld the District Court opinion.

D. Federal Circuit Supplemental Opinion and Statement Denying a Rehearing and a Rehearing En Banc

After the *Lawman Armor* decision was handed down, Lawman Armor filed a petition for a rehearing and a rehearing en banc.¹¹⁶ Additionally, multiple amicus curiae filed briefs with the CAFC, claiming that the CAFC made statements with its own precedent in the *Lawman Armor* decision.¹¹⁷ In response to the public outcry that the CAFC deflated the protection granted by design patents, the Federal Circuit issued a supplemental opinion and a denial for the rehearing and the rehearing en banc.¹¹⁸

In the Federal Circuit supplemental opinion, the Federal Circuit first stated that Lawman Armor did not challenge the district court’s ruling on Lawman’s eight points of novelty.¹¹⁹ Lawman Armor instead challenged the breadth and content of the prior designs and that there were factual issues concerning the points of novelty.¹²⁰ Lastly, Lawman Armor argued that the patent contained a point of novelty in the design’s overall

113. *Id.*

114. *Lawman Armor*, 437 F.3d at 1386.

115. *Id.*

116. *Lawman Armor Corp. v. Winner Int’l, LLC*, 449 F.3d 1190, 1192 (Fed. Cir. 2006).

117. *Id.* at 1191.

118. *See id.* at 1191-92.

119. *Id.* at 1192.

120. *Id.*

appearance.¹²¹ The court then narrowed its holding by asserting that its opinion should relate only to the validity of an additional point of novelty consisting of the combination of eight points of novelty that had already been asserted and recognized in the case,¹²² not overruling decisions that declared under appropriate circumstances a combination of design elements may constitute a point of novelty.¹²³ In the Federal Circuit's statement, the court denied the rehearing and rehearing en banc,¹²⁴ resulting in allowing the original *Lawman Armor* opinion to stand.

E. Federal Circuit Dissent

In a dissent to the majority opinion denying a rehearing and an en banc rehearing, Judge Rader joined the dissent, arguing the CAFC's position is detrimental to design patent protection.¹²⁵ The dissent pointed out inconsistencies in the Federal Circuit's decision concerning what may constitute a point of novelty for the point-of-novelty test.¹²⁶ In addition to the conflicting case law concerning the point of novelty by the Federal Circuit, the dissent argued that the test used by the CAFC ignores an element on which design patents are granted,¹²⁷ which could have disastrous results for design patents.¹²⁸ However, the dissent falls short of truly advocating this interpretation by stating in closing, "we should take the case en banc and issue a consistent statement of law, overruling whatever body of precedent is negated."¹²⁹

121. *Lawman Armor*, 449 F.3d at 1192.

122. *Id.*

123. *Id.*

124. *Id.* at 1193.

125. *Id.* at 1194.

126. *Lawman Armor*, 449 F.3d at 1194.

127. *Id.* *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1423 (Fed. Cir. 1984); *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1557 (Fed. Cir. 1988); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1117 (Fed. Cir. 1993) (finding the point of novelty of the patent to comprise multiple elements). *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1193 (Fed. Cir. 1995); *Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375, 375 (Fed. Cir. 1990) (rejecting the idea that a point of novelty can comprise more than one element). 35 U.S.C. §§ 102-103 (requiring a design to be both novel and non-obvious in order to receive a patent).

128. *Lawman Armor*, 449 F.3d at 1194.

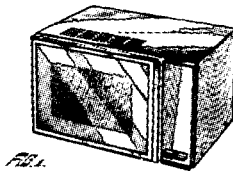
129. *Id.* at 1195.

V. CONFLICTING FEDERAL CIRCUIT DEFINITION FOR POINT OF NOVELTY

The dissent in the *Lawman* rehearing denial listed five CAFC opinions, three allowing for a combination of design elements as a point of novelty and two declaring that a combination cannot be a point of novelty.¹³⁰ Each of these opinions are examined in more detail below.

A. Cases For Lawman Armor's Interpretation

1. *Litton Systems*¹³¹



In *Litton Systems*, Litton sued Whirlpool on numerous counts, one of which was design patent infringement for the design of a microwave oven,¹³² Design Patent D-226,990 ('990 Patent).¹³³ The CAFC affirmed the validity of Litton's patent but found that Whirlpool did not infringe the '990 Patent.¹³⁴ To prove invalidity, Whirlpool admitted as evidence seven pieces of prior art that showed all the elements of the '990 Patent.¹³⁵ However, the CAFC noted that Whirlpool could not rely on an element-by-element approach to prove design patent invalidity and the CAFC did find enough differences to hold the patent valid.¹³⁶ Under the infringement analysis, the CAFC stated, "[t]he 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."¹³⁷ The Federal Circuit did not find Whirlpool infringed the '990 Patent since Whirlpool's design did not contain any of these three

130. *See id.* at 1194.

131. *Litton Sys.*, 728 F.2d at 1423.

132. U.S. Patent No. D226,990 (issued May 22, 1973) (pictured in text).

133. *Litton Sys.*, 728 F.2d at 1427.

134. *Id.* at 1426.

135. *Id.* at 1441-43.

136. *Id.* at 1443.

137. *Id.* at 1444 (emphasis added).

features.¹³⁸ In closing, the Federal Circuit noted that the '990 Patent had a limited range of protection, covering "the three stripe effect around a door with no handle and a latch release mounted on the control panel."¹³⁹

2. *Avia Group Int'l*¹⁴⁰



Avia sued L.A. Gear for infringement of design patents D-284,420¹⁴¹ and D-287,301¹⁴² ('420 Patent and '301 Patent, respectively, pictured above).¹⁴³ L.A. Gear counterclaimed stating that both patents were invalid for obviousness and functionality, and thus, could not be infringed.¹⁴⁴ Avia then moved for partial summary judgment on the issues of patent validity, infringement, and attorney's fees.¹⁴⁵ The CAFC found both the '420 Patent and the '301 Patent nonfunctional¹⁴⁶ and non-obvious.¹⁴⁷ The CAFC upheld the lower court's finding of infringement.¹⁴⁸ When performing the infringement analysis, the CAFC determined the points of novelty for each patent to be the following: "[f]or the '420 patent, those features included the swirl effect and the pivot point; for the '301 patent, the novelty consists, in light of the court's analysis of validity, of the combination of saddle, eyestay [sic], and perforations."¹⁴⁹

138. *Litton Sys.*, 728 F.2d at 1444.

139. *Id.*

140. *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557 (Fed. Cir. 1988).

141. U.S. Patent No. D284420 (issued July 1, 1986) (pictured in text).

142. U.S. Patent No. D287301 (issued Dec. 23, 1986) (pictured in text).

143. *Avia Group Int'l*, 853 F.2d at 1559.

144. *Id.*

145. *Id.*

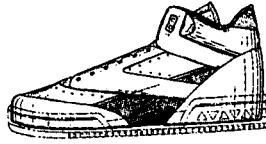
146. *Id.* at 1563.

147. *Id.* at 1564.

148. *Avia Group Int'l*, 853 F.2d at 1565-66.

149. *Id.* at 1565 (emphasis added).

3. *L.A. Gear*¹⁵⁰



L.A. Gear brought suit against Thom McAn Shoe Company for infringement of design patent D-299,081¹⁵¹ ('081 Patent) owned by L.A. Gear (pictured above).¹⁵² L.A. Gear sold girls' and women's shoes covered by the patent to department stores, sporting good stores, and athletic shoe retailers.¹⁵³ Thom McAn bought pairs of shoes protected by the '081 Patent to use as models to create shoes to sell in discount stores, such as K-Mart®.¹⁵⁴ Thom McAn attempted to show the design patent invalid by stating that the claimed design elements had a utilitarian function.¹⁵⁵ This argument was unpersuasive at the district court level and the CAFC found no reason to reverse the district court's holding,¹⁵⁶ and thus affirmed the finding that the '081 Patent was not obvious.¹⁵⁷ In the infringement analysis, the CAFC noted that the infringing shoes were almost a direct copy of those shoes protected by the '081 Patent¹⁵⁸ and found "that the novelty resided in the overall appearance of the combination."¹⁵⁹ The CAFC upheld the district court's finding of infringement.¹⁶⁰

150. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993).

151. U.S. Patent No. D299081 (issued Dec. 27, 1988) (pictured in text).

152. *L.A. Gear*, 988 F.2d at 1120.

153. *Id.* at 1122.

154. *Id.*

155. *Id.* at 1123.

156. *Id.* at 1124.

157. *L.A. Gear*, 988 F.2d at 1124.

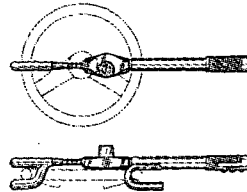
158. *Id.* at 1125.

159. *Id.* at 1126.

160. *Id.*

B. Cases Against Lawman Armor's Interpretation

1. *Winner International Corp.*¹⁶¹



Winner International sued Wolo Manufacturing for infringing design patent D-289,491¹⁶² ('491 Patent, pictured above).¹⁶³ The district court granted Wolo Manufacturing's motion for summary judgment on invalidity and non-infringement of the '491 Patent.¹⁶⁴ The CAFC affirmed the district court's grant of summary judgment for non-infringement.¹⁶⁵ The CAFC refused to acknowledge Winner's analysis that the district court erred in applying the point-of-novelty test by not considering the overall configuration and appearance of the patented design as a point of novelty.¹⁶⁶

In response, the CAFC stated that "[t]o consider the overall appearance of a design *without regard to the prior art* would eviscerate the purpose of the 'point of novelty' approach, which is to focus on those aspects of a design which render the design different from prior art designs."¹⁶⁷ The CAFC acknowledged that the district court below found the '491 Patent to contain points of novelty.¹⁶⁸ However, the CAFC did not answer the question of whether the alleged infringing design contained these points of novelty, but stated that the appearance of the infringing article and the patented design were very different, "rendering the appearance of the devices substantially different."¹⁶⁹ After the CAFC found no infringement,

161. *Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375 (Fed. Cir. 1990).

162. U.S. Patent No. D289491 (issued Apr. 28, 1987) (pictured in text).

163. *Winner Int'l*, 905 F.2d at 375-76.

164. *Id.* at 376.

165. *Id.*

166. *Id.*

167. *Id.* (emphasis added).

168. *Winner Int'l*, 905 F.2d at 376.

169. *Id.*

it then turned to the district court's grant of patent invalidity by vacating that portion of the decision.¹⁷⁰

2. *Sun Hill Industries*¹⁷¹



Sun Hill Industries, Inc. sued Easter Unlimited, Inc. for infringing Sun Hill design patent D-310,023¹⁷² ('023 Patent, pictured above).¹⁷³ The '023 Patent claimed a shiny plastic bag with a happy jack-o-lantern face on one side, a scary jack-o-lantern face on the opposite side of the bag, and vertical stripes.¹⁷⁴ Produced by Sun Hill, the bag, when stuffed with yard waste, would resemble a giant jack-o-lantern.¹⁷⁵ The prior art cited against the '023 Patent was a plastic trick-or-treat bag with the same jack-o-lantern face on both sides.¹⁷⁶ The prior art bag had instructions printed on it that explained how to turn the bag into a decorative jack-o-lantern by stuffing the prior art bag with paper.¹⁷⁷ The bag manufactured by Easter Unlimited, Inc. would also resemble a giant jack-o-lantern when stuffed with either paper or yard waste, but Easter Unlimited bags only contained a jack-o-lantern face on one side without vertical stripes.¹⁷⁸

The CAFC noted that the infringing bag had a nearly identical appearance to the designed covered by the '023 Patent.¹⁷⁹ The CAFC found that the district court did not apply the infringement test properly.¹⁸⁰ The district court did not consider both the overall appearance and the

170. *Id.* at 377.

171. *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193 (Fed. Cir. 1995).

172. U.S. Patent No. D310023 (issued Aug. 21, 1990) (pictured in text).

173. *Sun Hill Indus.*, 48 F.3d at 1194.

174. *Id.* at 1195-96.

175. *Id.* at 1195.

176. *Id.*

177. *Id.*

178. *Sun Hill Indus.*, 48 F.3d at 1195.

179. *Id.* at 1196.

180. *Id.* at 1197.

point-of-novelty test and incorrectly relied upon the claimed overall design as the point of novelty.¹⁸¹ The CAFC held that Easter Unlimited, Inc. did not infringe the '023 Patent.¹⁸²

The CAFC determined the point of novelty to be the contrasting jack-o-lantern faces, the bottom closure, the specific features of the jack-o-lantern faces, and the shiny surface,¹⁸³ implying that the point of novelty was the combination of these four features. The opinion went on to say that the claimed design has at most four points of novelty.¹⁸⁴ In holding that Easter Unlimited, Inc. did not infringe, the CAFC stated that Easter Unlimited, Inc. did not appropriate any of the features that make up the point of novelty of the Sun Hill claimed design.¹⁸⁵

VI. ANALYSIS

Lawman Armor shows a hole in design patent law. The hole resulted when Judge Rader, who authored the opinion in *Sun Hill Industries*, which the court relied on for its *Lawman Armor* decision, joined the dissent in the CAFC denying *Lawman Armor*'s petition for rehearing and a rehearing en banc.¹⁸⁶ The dissent argued that the confusion in design patent law created by *Lawman Armor* must be cleared up.¹⁸⁷ Below, the author will explore a possible split in precedent, an author-proposed rule, reasons why the U.S. Supreme Court should grant certiorari, and how *Lawman Armor* would be decided under the proposed rule.

A. *Is There a Divergence?*

When looking at the above CAFC decisions, the exclusion of the overall design as a point of novelty is not a chronological development.¹⁸⁸ The *L.A. Gear* case was decided after the *Winner International* case.¹⁸⁹ This rules out the CAFC constructively overruling their prior decisions. Before comparing the cases setting forth the two standards, the similarities of the cases should be stated. In all five cases, the courts found each

181. *Id.*

182. *Id.* at 1199.

183. *Sun Hill Indus.*, 48 F.3d at 1198.

184. *Id.*

185. *Id.*

186. *Lawman Armor Corp. v. Winner Int'l, LLC*, 449 F.3d 1192, 1194 (Fed. Cir. 2006).

187. See *supra* Part IV.E and *supra* text accompanying note 169.

188. See *supra* Part V.A-B.

189. See *supra* text accompanying notes 148 & 159.

patented design had a point of novelty in addition to the overall appearance.¹⁹⁰ The design patents in all five cases were ultimately determined valid.¹⁹¹ The design patents at issue were either in relatively crowded markets or had close prior art cited against them during prosecution.¹⁹²

1. Cases That Allowed the Overall Design as a Point of Novelty

Only the *L.A. Gear* case held that the overall appearance of a shoe design could be a point of novelty.¹⁹³ In that case, the defendant Thom McAn purchased pairs of the shoes incorporating the design and copied them.¹⁹⁴ Even though the district court made a broad statement,¹⁹⁵ later affirmed by the CAFC, in this case, one can assume that all the points of novelty would have been copied and incorporated into the infringing shoe as a result of Thom McAn's behavior. In *Avia* and *Litton Systems*, the court did not make a broad proposition that the overall appearance could be a point of novelty.¹⁹⁶ In those cases, the CAFC took a slightly narrower view of what could be a point of novelty than it did in its *L.A. Gear* decision.

In *Litton Systems* and *Avia*, the CAFC held that a combination of known elements could be a point of novelty.¹⁹⁷ In *Litton Systems*, Whirlpool found all elements of Litton's design in the prior art.¹⁹⁸ However, the CAFC held the combination of three elements to be the point of novelty not found in the prior art.¹⁹⁹ The *Avia* decision also allowed a combination of known elements to be the point of novelty, not the overall design as a whole.²⁰⁰ In two of the three cases, the point of novelty was not claimed as the overall appearance, but as a combination of known elements.²⁰¹ In the other case, the defendant purposefully copied the articles incorporating the patented design.²⁰² In *L.A. Gear*, even if the

190. See *supra* Part V.A.

191. See *supra* Part V.A.

192. See *supra* Part V.A.

193. See *supra* Part V.A.3.

194. See *supra* Part V.A.3.

195. See *supra* text accompanying note 159.

196. See *supra* Part V.A.1-2.

197. See *supra* Part V.A.1-2.

198. See *supra* Part II.A.1.

199. See *supra* Part II.A.1.

200. See *supra* Part V.2.

201. See *supra* Part V.A.1-2.

202. See *supra* Part V.A.3.

point-of-novelty test was used, direct copying would obviously incorporate the points of novelty and thus infringe the design patent.

2. Cases Denying That the Overall Appearance Could Be a Point of Novelty

The law cited by the CAFC in the *Lawman Armor* decision came primarily from two cases.²⁰³ In *Winner International*, the CAFC addressed the issue by announcing that the overall look and feel of a device could not be a point of novelty. The CAFC in *Winner International* should have addressed the validity issue on appeal instead of the infringement issue. In the opinion, the CAFC vacated the design patent validity issue.²⁰⁴ Even though the CAFC in *Lawman* made the statement that an overall design could not be a point of novelty relying on *Winner International*, the *Lawman* decision broadened the context. The Federal Circuit in the *Winner International* opinion did not say that the overall appearance or a combination of known elements could not serve as a point of novelty, but rather an individual should not depend on the overall appearance of the design without first consulting the prior art to determine the point of novelty and, ultimately, infringement.²⁰⁵ This was an overstatement by the CAFC in *Lawman Armor*, since the design patent in *Winner International* did contain at least one point of novelty.²⁰⁶

The case more heavily relied upon by the CAFC in *Lawman Armor* was *Sun Hill Industries*. Even the decision in *Sun Hill Industries* does not state that a combination of known elements could not serve as a point of novelty. The court in *Sun Hill Industries* is not clear on this point. In the opinion itself, the court flipped-flopped on whether there was a single point of novelty comprised of four elements or if there were four points of novelty comprised of one element each.²⁰⁷ In *Sun Hill Industries*, the CAFC made three statements declaring what the point or points of novelty were.²⁰⁸ Two of three made it appear as though the patent at issue had only one point of novelty by using the phrase “point of novelty” and listing four

203. See generally *Lawman Armor Corp. v. Winner Int'l, LLC & Winner Holding LLC*, 437 F.3d 1383 (Fed. Cir. 2006) (relying on *Sun Hill Industries* and *Winner International*). The CAFC also cited *Litton Systems*, but the CAFC arguably misconstrued the decision.)

204. See *supra* Part V.B.1.

205. See *supra* Part V.B.1.

206. *Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990). See *Rubbermaid Commercial Prods., Inc. v. Contico Int'l, Inc.*, 836 F. Supp. 1247, 1259 (W.D. Va. 1993).

207. See *supra* Part V.B.2.

208. See *supra* Part V.B.2.

distinct features connected by an “and.”²⁰⁹ The other statement stated the patent contained at least four points of novelty.²¹⁰ Therefore, this opinion could not refute Lawman Armor’s ninth point of novelty, the combination of those eight elements.

These two cases stressed an idea that the purpose of the point-of-novelty test was to find those elements that differentiated the design patent from the prior art to prevent what happened in *Sun Hill Industries*. In *Sun Hill Industries*, the district court found infringement on elements not claimed in the patent but on already known design elements.²¹¹ In these two cases, the courts at both levels consistently found at least one point of novelty in each valid patent.²¹²

3. Is there a Divergence in the Precedent?

By looking at all five of these cases, only one differentiates itself from the others as setting forth a different standard. That case is *L.A. Gear*, but again, that case had a set of unique facts, as there was evidence that Thom McAn had the shoes incorporating the protected design elements copied.²¹³ With evidence of actual deliberate copying of the *L.A. Gear* design patent, Thom McAn’s product would naturally incorporate the design’s points of novelty.²¹⁴ Beside this case, the other four cases are in agreement that the point-of-novelty test must be carried out, with the courts looking at the prior art to determine the point or points of novelty contained in the designs.²¹⁵ The novelty may be one or a combination of any number of design elements. With this stated, the Federal Circuit in *Lawman Armor* misconstrued the case law by excluding Lawman Armor’s ninth point of novelty, the specific combination of eight previously known design elements.²¹⁶ In all of the discussed cases, the point of novelty was a combination of multiple elements.²¹⁷

209. See *supra* text accompanying notes 183 & 185.

210. See *supra* text accompanying note 184.

211. The lower court in *Sun Hill Industries*, relied on color, size, and material—features not shown in the patent to find infringement. See *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1196 (Fed. Cir. 1995).

212. See *supra* Part V.B.

213. See *supra* Part V.A.3.

214. See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993).

215. See *supra* Part III.B.

216. See *supra* text accompanying notes 109-10.

217. See *supra* Part V.A-B.

B. *What Should the New Rule Be?*

The prior cases dictate half of the new rule that a point of novelty may be an element or a combination of elements, with the scope of protection being narrower for a combination of elements. However, the decision in *Lawman Armor* adds a dangerous outcome to the analysis. The dangerous outcome is a valid design patent lacking a point of novelty and not being enforceable.²¹⁸ This element goes against the tenets of patent law.²¹⁹

Design patent law was designed to give designers an incentive to add to the design field by granting them a limited monopoly by disclosing the elements of their design.²²⁰ The design patent grants the right to exclude others from using the protected design. Thus, the value in a design patent is the ability to exclude others.

The result of *Lawman Armor* is further opposed to the process of granting a design patent. To achieve a design patent, the design must be novel and non-obvious.²²¹ The novelty requirement for receiving a design patent is a small hurdle.²²² The test is that an ordinary observer views the design as being something different and new.²²³ A current patentability requirement related to the point-of-novelty test is the non-obvious requirement. Under this requirement, the design seeking protection must not be disclosed in the prior art by a single reference or in a proper combination of references.²²⁴ This is the most difficult burden to satisfy in receiving a patent. By satisfying this requirement the applicant has shown that his or her design contains novel elements not already in the prior art.²²⁵

A valid design patent must then have points of novelty that distinguish it from the prior art via the process of receiving a design patent. Thus, as a second prong to the point-of-novelty test, a valid design patent must have at least one point of novelty and it is up to the judge in a *Markman*

218. *See supra* Part III. Without a point of novelty, the patent lacks all enforceability because an accused design could not appropriate the point of novelty if no point of novelty exists. Since a design to infringe a patented design must appropriate the point of novelty, the patent holder will never be successful on this prong of proving infringement. *See supra* Part III.

219. *See supra* Part II.A.

220. *See supra* note 18 and accompanying text.

221. *See supra* Part II.B.2-3.

222. *See supra* Part II.B.1.

223. *See supra* text accompanying note 31.

224. *See supra* Part II.B.3.

225. *See supra* Part II.B.3.

hearing²²⁶ to find the point of novelty, just as he or she must construe the claims for an utility patent. Both of these functions are necessary for the finding of infringement.

Placing this new requirement upon the courts will prevent the absurd result that occurred in *Lawman Armor*: a valid patent with no enforceability. The second prong will not be very difficult on the courts, since the prosecution history of the design patent will help narrow what the novelty in the design was, especially if there was an office action containing a 35 U.S.C. § 103 rejection.²²⁷ Like the CAFC stated in *Litton Systems*, “the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.”²²⁸ From this quote it is apparent that a valid design patent includes at least one point of novelty, since a design covered by a design patent is distinguishable from the world of prior art.

When applying this new test, requiring a court to find the point(s) of novelty for a valid design patent, to the facts in *Lawman Armor*, the Federal Circuit would ultimately have to remand the case. First, the district court in *Lawman Armor* did not find the design patent invalid, nor did the court question the patent’s validity. Second, the district court stated there was not a single point of novelty in the design.²²⁹ At the narrowest, the point of novelty was the combination of those eight design elements, but it easily could have been much broader.²³⁰ By examining the prosecution history, the patent in question did not have a single office action and was granted by the U.S. Patent and Trademark Office on the as-filed application.²³¹

C. Why the Supreme Court Should Grant Certiorari

The U.S. Supreme Court should grant certiorari for many reasons. The reasoning relied upon in *Lawman Armor* is not settled among the justices

226. A *Markman* hearing is “[a] hearing at which the court receives evidence and argument concerning the construction to be given to terms in a patent claim.” BLACK’S LAW DICTIONARY (8th ed. 2004).

227. See *supra* II.B.3. A 35 U.S.C. § 103 rejection would claim that the design was obvious, thus in response the inventor would need to state what was novel in the design.

228. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (quoting *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944)).

229. See *supra* text accompanying note 105.

230. See *supra* text accompanying note 109.

231. See *Public Pair*, U.S. Patent & Trademark Office, at <http://portal.uspto.gov/external/portal/pair> (last visited Nov. 13, 2006) (search for patent number D357621 and select Transaction History).

sitting on the CAFC and the precedents can be interpreted very differently.²³² There appear at first glance, to be two schools of thought of what can constitute a point of novelty. As this Note showed, the five cases discussed share a common reasoning that a point of novelty can be a combination of elements.²³³ This should be explained by the U.S. Supreme Court as the proper rule since it requires the court to not rely only on the overall appearance, but to ensure that the infringer is incorporating the novel elements that allowed the patent to be granted. In addition to the Amicus Curiae Briefs showing a split in the Federal Circuit's reasoning,²³⁴ Judge Rader, who authored the opinion in *Sun Hill Industries* in which the CAFC heavily relied upon in the *Lawman Armor* decision, argued for a rehearing since he saw possible conflicting opinions in the court's prior decisions.²³⁵ Further, the CAFC, in deciding *Lawman Armor* clearly went against precedent by stating that a combination of elements could not serve as a point of novelty by disregarding *Lawman Armor's* proposed ninth point of novelty.

Additionally, the U.S. Supreme Court should grant certiorari to announce a second prong for the point-of-novelty test, so as not to circumvent the incentives patents provide for their owners. The second prong or additional requirement should be that every valid design patent has at least one point of novelty. As the CAFC opinion in *Lawman Armor* showed for the first time, with the current design patent infringement requirements, a patent holder could have a valid patent with no enforceability. The decision in *Lawman Armor* goes beyond not finding infringement, because without a point of novelty, the owner of a design patent cannot bring a successful infringement suit against anyone. This decision allows courts to essentially donate a design patent to the public domain without a trial. This result is feasible under the current point-of-novelty test since there is no deference that a patent must contain a point of novelty.²³⁶ Without requiring courts to find at least one point of novelty for a valid design patent, the courts can invalidate design patents under a lesser standard.

The *Lawman Armor* decision is a case that needs to be addressed by the U.S. Supreme Court. The Federal Circuit has not only created two different standards in the eyes of practicing attorneys and judges on the CAFC, but also has muddied the water and misinterpreted its precedent.

232. See *supra* Part V.

233. See *supra* Part V.

234. See *supra* text accompanying note 8.

235. See *supra* Part IV.E.

236. See *supra* Part IV.B-C.

More importantly, the decision in *Lawman Armor* shows how the current design patent infringement tests allow for a valid patent to have no enforceability. This undermines the U.S. patent system,²³⁷ for a patentee should reasonably expect that a valid patent gives him or her the power to stop someone from using what the patent claims.

VII. CONCLUSION

The CAFC got the decision in *Lawman Armor* wrong. It misconstrued its own precedent by stating that a combination of elements cannot serve as a point of novelty. Furthermore, by saying that *Lawman Armor*'s ninth point of novelty would undermine the point-of-novelty test by rendering all designs a point of novelty, the CAFC went overboard. The CAFC would render only patented designs a point of novelty, which a patented design should be, because to receive a patent the design must be novel and non-obvious. The Federal Circuit unwittingly destroyed the incentive to seek a design patent by rendering these patents nearly valueless by upholding a decision that found a valid design patent merited no protection. This point was not raised nor considered by the Federal Circuit. Even with the Federal Circuit not acknowledging this, the decision has a disastrous effect. Therefore, the U.S. Supreme Court should grant certiorari on *Lawman Armor* to clarify the point-of-novelty test. The point-of-novelty test should be clarified to contain a statement that all patented designs have at least one point of novelty and that a point of novelty can include a combination of design features.

237. See *supra* Part II.A.

