

In The
United States Court of Appeals
For The Federal Circuit

DAVID A. RICHARDSON,

Plaintiff – Appellant,

v.

STANLEY WORKS, INC.,

Defendant – Appellee.

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

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

Alan J. Kasper
President
AMERICAN INTELLECTUAL PROPERTY
LAW ASSOCIATION
241 18th Street, South, Suite 700
Arlington, Virginia 22202
(703) 415-0780

Counsel for Amicus Curiae

Christopher V. Carani
Counsel of Record
MCANDREWS, HELD & MALLOY, LTD
500 West Madison Street, Suite 3400
Chicago, Illinois 60661
(312) 775-8000

Counsel for Amicus Curiae

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 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:

Alan J. Kasper,
President
AMERICAN INTELLECTUAL PROPERTY
LAW ASSOCIATION
241 18th St., South, Suite 700
Arlington, Virginia 22202

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

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STATEMENT OF INTEREST OF AMICUS CURIAE

The American Intellectual Property Law Association (“AIPLA”) is a national bar association of more than 16,000 members engaged in private and corporate practice, in government service, and in the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property, including design patents.

AIPLA has no stake in any of the parties to this litigation or in the result of this case.¹ AIPLA’s only interest is in seeking correct and consistent interpretation of the law as it relates to intellectual property issues. This brief is filed with the consent of Appellant David A. Richardson and Appellee Stanley Works, Inc.

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, its members who authored this brief, and their law firms or employees, made a monetary contribution to the preparation or submission of this brief.

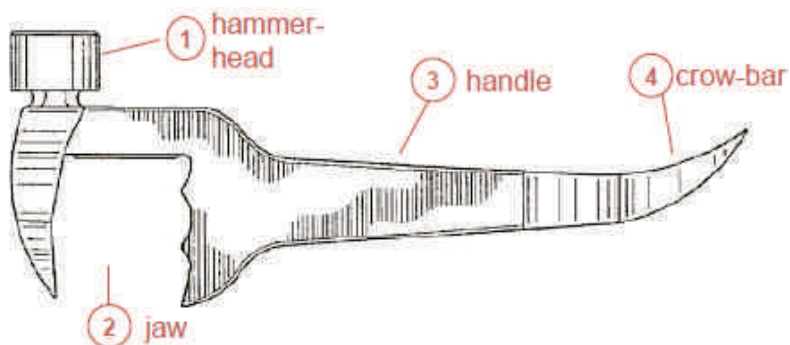
BACKGROUND

David A. Richardson (“Richardson”) sued Stanley Works, Inc. (“Stanley”), claiming that his U.S. Patent No. D507,167 (“the ’167 patent”) was infringed by certain Stanley carpentry tools. After a bench trial, the district court found that none of the Stanley accused products infringed the ’167 patent.

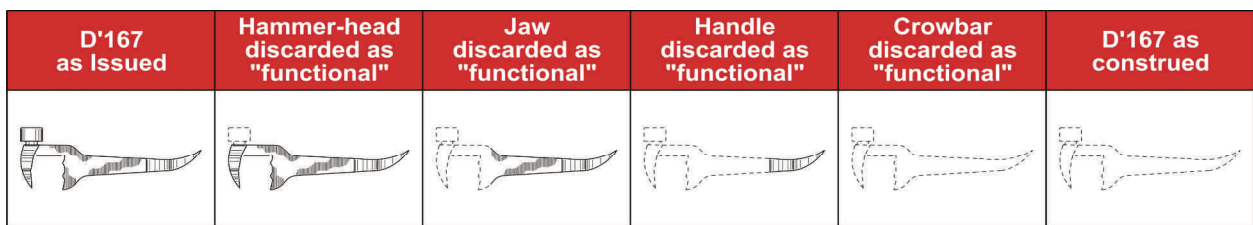
On appeal, the Federal Circuit panel affirmed the district court’s (1) claim construction, and (2) finding of non-infringement. *Richardson v. Stanley Works, Inc.*, 2010 U.S. App. LEXIS 4895 (Fed. Cir. Mar. 9, 2010). AIPLA takes no position on the panel’s affirmance of the non-infringement finding. Rather, AIPLA is concerned about the panel’s holding that claim construction for a design patent requires a court to “separate” a design patent’s overall design into “functional” elements and “ornamental” elements, and then “factor out” the former as unprotectable portions of the claimed design. (*Id.* at *6.)

Specifically, the panel, during claim construction, concluded that:

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



(*Id.* at *7.) The panel concluded that these “functional” elements were properly “factored out” from the protected design as part of claim construction. (*Id.* at *6.) Visually, and using broken lines to depict the “factored out” elements of the design, the panel’s claim construction can be fairly illustrated by the figures below (beginning with the PTO’s issued claim on the far left, and ending with the panel’s construed claim on the far right):



In short, the Court should disavow a claim construction methodology (which one might call a “Point of Ornamentality” approach) that purports to separate functional and ornamental elements of the claim design, rather than properly directing the fact-finder to the overall design, considering all of a design’s depicted elements taken together. Like the now defunct “Point of Novelty” approach (which sought to separate out new and old elements), the panel’s approach (which seeks to separate out ornamental and functional elements) conflicts with the tenet that a design patent protects the overall appearance of the claimed design, and is fraught with logistical problems. For the reasons discussed below, this Court should grant

the petition for rehearing *en banc*.¹

ARGUMENT

I. DESIGN PATENTS PROTECT THE CLAIMED OVERALL APPEARANCE OF AN ARTICLE OF MANUFACTURE, REGARDLESS OF WHETHER THE CONSTITUENT ELEMENTS OF THE DESIGN ARE FUNCTIONAL OR ORNAMENTAL

“A design is a *unitary thing* and *all of its portions are material* in that they contribute to the appearance which constitutes the design.” *In re Blum*, 374 F.2d 904, 907 (CCPA 1967) (emphasis added); *see also, Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (holding that all solid lines in design patent drawings form part of the claimed design). A design patent protects the *overall effect* of *all* of the depicted design elements, whether such elements are new or old, functional or ornamental, significant or insignificant.²

In reaching its conclusion on claim construction, the panel in this case cited and relied on *OddzOn*, which held that “a design patent *only protects the* [1] *novel*,

¹ The *Egyptian Goddess* decision, in addressing the issue of claim construction for design patents, suggested ways a trial court might assist the fact-finder on issues that bear on patent scope. One suggestion was to distinguish “between those features of the claimed design that are ornamental and those that are purely functional.” *Egyptian Goddess, Inc. v. Swisa*, 543 F. 3d 665, 680 (Fed. Cir. 2008) (*en banc*) (citing *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997)). AIPLA respectfully maintains that the current issue was not adequately presented to the Court by either the parties or *amici* in the *Egyptian Goddess* case, and requests that this Court consider the matter *en banc* here.

² See *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1245 (Fed. Cir. 2009) (CLEVINGER, J. dissenting) (criticizing the majority for its “dissection of designs into component parts,” namely “significant” and “insignificant” elements; such dissections “prohibit assessment of designs as a whole, in violation of long-standing law, starting with *Gorham*.”).

[2] *ornamental features* of the patented design.” *Id.* at 1406 (emphasis added).³

The *en banc* Court in *Egyptian Goddess*, however, eliminated the “Point of Novelty” requirement and also the notion that design patents *only protect* the *novel features* of the claimed design. *Id.* at 677-78.⁴ Similarly, the Court should now clarify that the individual “ornamental features” of an overall design are not the limit of protectable rights under the patent. Simply put, design patents protect the depicted overall appearance, regardless of whether the design’s individual constituent elements are functional or ornamental.

Moreover, any attempt to dissect an overall design into elements is unworkable. Most often, the elements of a design are fully integrated into, and inseparable from, the overall design. Factoring out and ignoring functional elements is an artificial enterprise that distorts the claim to the design’s overall appearance.

A fact-finder, as part of the infringement analysis, is permitted to identify and factor out the functional nature and purpose of the elements shared by the patented and accused designs. However, the fact-finder should be cautioned not to factor out the *appearance* of any of the depicted elements, whether functional or

³ While it is true that the design patent statute protects new, original, and ornamental “designs,” the *Oddzon* case substantially complicates claim construction in calling for the identification of separate, novel and ornamental “features” of a design.

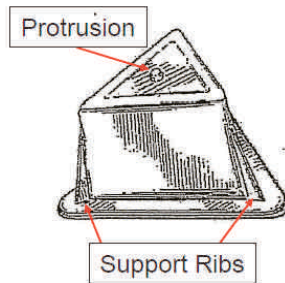
⁴ *Id.* at 677-78. (“If the claimed design consists of a *combination of old features* that creates an appearance deceptively similar to the accused design, even to an observer familiar with similar prior art designs, a *finding of infringement would be justified.*” (emphasis added)).

otherwise. Unquestionably, a design patent does not broadly protect the utilitarian purpose or function of an article of manufacture that may result from a combination of functional elements. To the contrary, a design patent only protects the particular overall *appearance* resulting from the arrangement and combination of all of the elements (both ornamental and functional) *depicted in the design patent's drawings*. Any concern about preventing a design patent from acquiring a scope that broadly encompasses the utilitarian function of the design is not properly addressed by attempting to separate the individual functional from the ornamental elements of the design.⁵ Instead, these concerns could be addressed with a simple instruction to the fact-finder that design patents only protect the *appearance* of the overall design depicted in the drawings, and not the nature or purpose of the article of manufacture.

II. THE PANEL'S APPROACH TO CLAIM CONSTRUCTION CONFLICTS WITH THIS COURT'S PRIOR PRECEDENT

In *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995), the patentee argued that two elements depicted in the design patent in suit, namely, the support ribs and the protrusion, should be ignored because the elements were “functional.”

⁵ Neither Richardson's '167 design patent nor Stanley's U.S. Patent No. D562,101 for multi-function carpentry tool protects just *any appearance* of a tool that combines a hammer, crowbar, handle and jaw. Stated another way, neither the '167 design patent nor the '101 design patent grants exclusive rights in the general nature and purpose and a tool combining a hammer, crowbar, handle and jaw. Instead, *what those design patents protect are the specific appearances of the overall designs set forth in their respective patent figures*.



The *Elmer* court noted the functionality of the two elements of the claimed design, even pointing to detailed descriptions of the elements' function in a corresponding utility patent. However, it flatly rejected the argument that the design patent claim should be construed to ignore these elements. *Id.* at 1577. The court pointed out that the depicted elements could have been omitted from the design patent's drawings but were not. The court concluded that they thus contributed to, and were part of, the claimed overall design.⁶ In *Richardson* as well, there was no attempt to omit from the design patent's drawings the elements that were factored out in claim construction. (e.g. using broken lines). As in *Elmer*, those depicted elements contributed to, and are part of, the claimed overall design. Accordingly, the *Richardson* panel's holding where functional elements were factored out is in conflict with *Elmer*.

III. THE PANEL'S APPROACH TO CLAIM CONSTRUCTION RISKS UNDERMINING THE VALIDITY AND ENFORCEABILITY OF DESIGN PATENTS

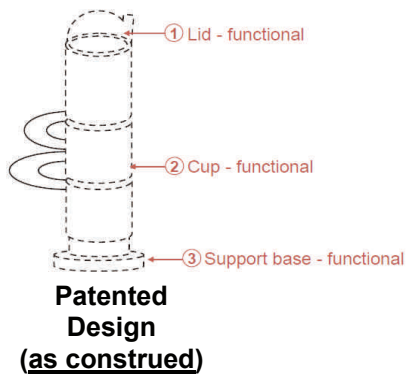
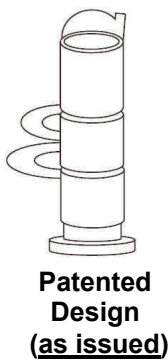
The claim construction methodology adopted by the panel, by factoring out functional elements of a claimed design, risks undermining both the validity and enforceability of design patents.

After USPTO examination, an issued design patent enjoys a presumption of validity, just like any other patent. See 35 U.S.C. § 282. At the USPTO, the

⁶ *Id.* (holding that the patentee "effectively limited the scope of its patent claim by including those [functional] features in it.").

patentability determination for a claimed design is premised solely on the *overall appearance* of the depicted design. MANUAL OF PATENT EXAMINING PROCEDURE (“M.P.E.P.”) § 1503.01(c).⁷ Yet, the presumption of validity and its underpinnings easily fall apart after *Richardson* because the judicially construed claim may be fundamentally different from the claim examined and issued by the USPTO.

This conflict can be illustrated with a simple example. Assume that the image



on the top left is the design examined during prosecution and ultimately yielding the patented design. As noted above, during prosecution, the USPTO examines *only the overall appearance* of the design. Now, during claim construction post-*Richardson*, a district court might determine that certain elements are “functional” and thus must be “factored out.” For example, those elements might be the (1) lid, (2) cup, and (3) support base. (See image on bottom left, with “functional” elements

shown in broken lines.) With only the handle remaining after claim construction,

⁷ See, M.P.E.P. § 1504.01(c) (“ornamentality must be based on the *entire design*”) (*emphasis added*); M.P.E.P. § 1504.03 (“In determining patentability under 35 U.S.C. § 103(a), it is the *overall appearance* of the design that must be considered.”) (*emphasis added*); M.P.E.P. §1503.02 (“when assessing 35 U.S.C. § 112, first and second paragraphs, it is the *overall appearance* that is controlling”) (*emphasis added*).

questions regarding the patent's validity abound. Is just the remaining handle itself novel? non-obvious? ornamental? Does the presumption of validity apply? After all, the USPTO only examined the *overall appearance* of the entire depicted design for patentability, not just the handle in isolation. This potential disparity in claim scope irreconcilably upsets the presumption of validity and its underpinnings. For this reason alone, the panel's approach should be rejected.

Worse yet, it is entirely possible that the panel's approach could yield a result where, upon claim construction, each and every individual element of the design patent is found to be "functional." (This is similar to the hypothetical conundrum discussed in *Egyptian Goddess* where all individual elements of the design were "non-novel," despite the fact that the a design's overall appearance might be novel.) For instance, and continuing with the same example, what if the district court concludes that the handle is functional as well? Under these facts, the claim is whittled away to nothing, effectively neutering the enforceability of an issued design patent *without an invalidity challenge ever having been made*. Claim construction should not be used as a disguised "validity-functionality" attack.

Unlike the piecemeal approach used in *Richardson*, a validity-functionality attack under 35 U.S.C. § 171 examines whether the design patent's *overall*

appearance is “dictated by function alone,”⁸ not whether each individual element is functional. As this Court has made clear:

the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.

L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993). Of course, such “validity-functionality” challenges, like all validity challenges, are subject to the demanding safeguards that cloak a presumptively valid design patent, including most importantly the “clear and convincing” evidence standard.⁹ The panel’s approach opens the door for piecemeal validity attacks devoid of these safeguards.

IV. CONSIDERATIONS REGARDING THE FUNCTIONAL NATURE AND PURPOSE OF DESIGN ELEMENTS ARE FOR THE FACT-FINDER TO DECIDE AS PART OF THE INFRINGEMENT ANALYSIS, NOT FOR THE COURT TO DECIDE AS PART OF CLAIM CONSTRUCTION

While a court should not identify and factor out functional elements as part of claim construction, a fact-finder, as part of its infringement analysis, may identify and discount the functional nature and purpose of elements when comparing the patented and accused designs. The fact-finder, however, should be

⁸ As explained in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989), to qualify for design patent protection, a design must have an ornamental appearance that is “not dictated by function alone.”

⁹ See e.g., *L.A. Gear*, 988 F.2d at 1123 (requiring clear and convincing evidence to invalidate design patent on grounds of functionality; further noting that 35 U.S.C. § 282 includes a presumption of ornamentality).

reminded that it can not discount or ignore the *appearance* of any depicted elements in the design patent; a design patent protects the claimed overall appearance, which is an amalgam of all of its depicted elements.

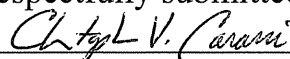
Placing the analysis of the functional nature of elements with the fact-finder is consistent with this Court's holdings on the issue of validity-functionality. This Court has consistently held that the issue of whether an overall patented design is functional or ornamental is a question of fact. *See, e.g., PHG Techs., LLC v. St. John Cos., Inc.*, 469 F.3d 1361, 1365 (Fed. Cir. 2006) (validity-functionality is a question of fact); *Hupp v. Siroflex of Am.*, 122 F.3d 1456, 1460-61 (Fed. Cir. 1997) (same); *Avia Group Int'l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988) (same). In short, all issues regarding functionality properly reside with the fact-finder, not the court as part of claim construction.

CONCLUSION

For the reasons cited herein, this Court should grant the petition for rehearing *en banc*. The solution to the Court's concern regarding runaway design patent claims is simply to remind district courts and fact-finders that design patents do not protect the general nature and purpose of an article of manufacture, but rather only protect the overall *appearance* of the design depicted in the drawings.

April 22, 2010

Respectfully submitted,



Christopher V. Carani
Attorney for *Amicus Curiae*