

## Perry J. Saidman

SAIDMAN DesignLaw Group  
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### EMPLOYMENT HISTORY:

- 1990 - Present: Founder, SAIDMAN DesignLaw Group, intellectual property law firm specializing in legal issues involving designs and product configurations.
- 1980 - 1990: Founding partner; Saidman, Sterne, Kessler & Goldstein, Washington, D.C., intellectual property law firm; 1980-1986, Managing Partner; 1987-1990, head of Industrial Design Group.
- 1976 - 1979: Of Counsel; Berman, Aisenberg & Platt, Washington, D.C.
- 1974 - 1975: Patent Attorney, sole practice; Washington, D.C.
- 1973 - 1974: Associate; Oblon, Fisher, Spivak, McClelland & Maier; Arlington, VA
- 1969 - 1973: Patent Advisor; Harry Diamond Laboratories - U.S. Army Materiel Command, Washington, D.C.
- 1967 - 1969: Electronics Engineer; Harry Diamond Laboratories - U.S. Army Materiel Command, Washington, D.C.

### EDUCATION:

- 1973 - J.D. (with honors), National Law Center, The George Washington University, Washington, D.C.
- 1968 - M.S.E., The Moore School of Electrical Engineering, University of Pennsylvania, Philadelphia, PA (Ford Foundation Fellowship).
- 1967 - B.S.E.E., School of Engineering and Applied Science, The George Washington University, Washington, D.C. (four year Trustee Scholarship).

### ACCOMPLISHMENTS:

- Represented successful plaintiff/patentee at trial level and on appeal in *Avia Group International v. L.A. Gear California, Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988) - The Court of Appeals for the Federal Circuit affirmed the lower court's findings of validity, willful infringement and attorney fees based upon two design patents, all on a motion for summary judgment.
- First Chair of the Industrial Design Committee (established in 1988) of the American Intellectual Property Law Association; directed sub-committees working in education, international design laws, industrial design legislation, PTO liaison, trade dress, copyright, and design patent statistical analyses.
- Served as a patent law lecturer on the topics of novelty, non-obviousness, inequitable conduct and ethics, as well as a patent claim drafting instructor at semi-annual patent bar review course sponsored by the Patent Resources Group.

- Keynote speaker and panel discussion leader at the First National Conference on Industrial Design Law & Practice held March, 1989 in Baltimore, Maryland.
- Chaired Judicial Developments and Foreign Developments Subcommittees of the Industrial Design Committee of the Intellectual Property Law Section of the American Bar Association.
- Speaker at All Ohio Annual Institute on Intellectual Property (1994, 1995, 1998, 2000, 2004, 2006); spoken before Intellectual Property Section of Michigan State Bar Association, Intellectual Property Section of Texas State Bar, New York Intellectual Property Law Association, and New York State Bar Association, Intellectual Property Law Section.
- Visited Tokyo, Japan, to give full day seminars on U.S. Design Law at invitation of the Japan Design Protection Association and officials of the Japan Patent Office.
- Founder and Co-Chair, Design Protection Section, Industrial Designers Society of America.
- Founder and Executive Director of the Design Registration League, a coalition of companies, associations and individuals, formed in 2007, whose goal is to get Congress to pass a sui generis design registration law.
- Member, Special Subcommittee of AIPLA Industrial Designs Committee studying the Fashion Bill legislation and drafting resolution for the AIPLA Board of Directors, which was passed.
- Authored *Amicus Curiae* brief on behalf of Apple Inc. in *en banc* rehearing of Egyptian Goddess v. Swisa before U.S. Court of Appeals for the Federal Circuit, a case that goes to the very heart of design patent enforcement.

#### PUBLICATIONS:

1. "Copyrights: Novelty or Originality?", *Journal of the Patent Office Society*, Vol. 55, No. 5, pp. 314-319 (1973).
2. "Patent Law for General Practitioners and Business Lawyers", *Maryland Institute for Continuing Professional Education of Lawyers (MICPEL)*, Baltimore, MD, April, 1980.
3. "Trademarking Software Packages", *BYTE*, March, 1984.
4. "Copying Mass Marketed Software", *BYTE*, February, 1985.
5. "The Sale of Computer Products", *BYTE*, May, 1985.
6. "Patents: There is Something New Under the Sun", *Barrister*, Winter, 1987.
7. "Avia Wins Major Design Patent Suit: How the Design Patent Slam Dunked the Knock-off", *Design Perspectives*, Feb. 1989 (IDSA).
8. "Sneakers, Design Patents & Summary Judgments: Opening A New Era in the Protection of Consumer Product Designs", *71 Journal of The Patent and Trademark Office Society (JPTOS)* 524, July, 1989.
9. "Design Patent Suits Can be Won", *FDM*, July, 1989, p. 114.
10. "How Design Patents Defeat Product Piracy", *Seminar Papers on Design Management*, Industrial Design Department, University of the Arts, Phila., Pa., March, 1990.
11. "The Ten Commandments of Design Patent Protection", *innovation* (Industrial Designers Society of American quarterly journal) Fall, 1990, p. 21.

12. "The Doctrine of Functionality in Design Patent Cases", 19 *U. Balt. L. Rev.* 352 (Fall 89-Winter 90).
13. "The Glass Slipper Approach to Protecting Industrial Designs or When the Shoe Fits, Wear It", 19 *U. Balt. L. Rev.* 167 (Fall 89-Winter 90).
14. "Design Protection Tools - A Primer", *The Design Management Institute News*, Vol. III, Issue 4, July/August, 1991.
15. "The Basic Tools of Design Protection", SAIDMAN DesignLaw Group, (pamphlet), Fall, 1991.
16. "How to Protect Product Design", *Design Management Journal*, Vol. 2, No. 4, p. 32 (Fall, 1991).
17. "Design Patents - the Whipping Boy Bites Back", 73 *Journal of The Patent and Trademark Office Society (JPTOS)* 859, November, 1991.
18. "Who Owns What? / Design Protection Tools", *innovation*, Winter, 1992, p. 21.
19. "Trade Dress: The Emperor Gets Some Real Clothes", *innovation*, Spring/Summer, 1995, p. 65.
20. "The Valuable Yet Elusive Trademark: All Dressed Up", *innovation*, Summer/Fall, 1995, p. 51.
21. "Design Patentees: Don't Get Unglued by Elmer or **The Single Most Important Thing to Know About The Preparation of Design Patent Applications**" 78 *Journal of The Patent and Trademark Office Society (JPTOS)* 311, May, 1996.
22. "Supreme Court Decides In Favor of Knock-Offs: Wal-Mart Case Makes Trade Dress Protection for Product Design More Difficult", *innovation*, Summer 2000, p. 24.
23. "Kan Traffix Kops Katch the Karavan Kopy Kats? -or- Beyond Functionality: Design Patents are the Key to Unlocking the Trade Dress/Patent Conundrum", 82 *Journal of The Patent and Trademark Office Society (JPTOS)* 839, December, 2000.
24. "Protecting Proprietary Product Designs in the USA", Chapter Nineteen, *Industrial Design Rights - An International Perspective*, co-author with David Brinkman, Kluwer Law International and International Bar Association, 2001, pp. 325-359.
25. "When Patents Expire: The Supreme Court Gives Traffix a Green Light to Copy", *innovation*, Winter 2001, p. 28.
26. "The Death of *Gorham Co. v. White*: Killing It Softly with Markman", 86 *Journal of The Patent and Trademark Office Society (JPTOS)* 792, October, 2004.
27. "The Right to Copy Doctrine", 89 *Journal of The Patent and Trademark Office Society (JPTOS)* 204, March, 2007.
28. "The Crisis in the Law of Designs", 89 *Journal of The Patent and Trademark Office Society (JPTOS)* 301, April, 2007.

#### SPEECHES:

1. "Sneakers, Design Patents and Summary Judgments", Government Patent Lawyers Association, Washington, D.C., October 14, 1987.
2. "Trademark and Patent Protection: The Nuts and Bolts for Sports Products and Companies" Super Show "Quest for Excellence" Seminar Series at the Georgia World Congress Center, Atlanta, Georgia, February 22, 1988.

3. *"The Glass Slipper Approach to Protecting Industrial Designs or When the Shoe Fits, Wear It"*, National Conference on Industrial Design Law and Practice, University of Baltimore School of Law, Baltimore, Maryland, March 10 & 11, 1989.

4. Seminars on U.S. Design Law at invitation of the Japan Design Protection Association and officials of the Japan Patent Office, Tokyo, Japan, March 1990.

5. *"How Design Patents Help Defeat Product Piracy"*, Seminar Series on Design Management for Small Companies, Industrial Design Department of the University of the Arts, Philadelphia, Pennsylvania, March 20, 1990.

6. *"Legal Aspects & Implications of Identity Elements (or Ten "Bite-Size" Legal Tidbits)"*, Third Annual Corporate Identity Conference, The Design Management Institute, Montreal, Quebec, June 28, 1991.

7. *"How to Use Design Patents as a Meaningful Part of Your Proprietary Protection"*, All Ohio Annual Institute on Intellectual Property, Cleveland and Cincinnati, Ohio, September 22-23, 1994; The District of Columbia Bar, Intellectual Property Section, June 15, 1995.

8. *"Recent Developments (1994-95) in Design Protection"*, All Ohio Annual Institute on Intellectual Property, Cleveland and Cincinnati, Ohio, September 14 - 15, 1995.

9. *"Trade Dress and Product Configuration - Chain Brands: Likelihood of Confusion?"*, New York Bar State Bar Association, Intellectual Property Law Section, Fall Meeting, Lake George, New York, October 14, 1995.

10. *"Protection of Designs: Building Your Arsenal Using Trade Dress and Design Patent"*, New York State Bar Association, Intellectual Property Law Section, New York, New York, February 26, 1997.

11. *"Prosecuting and Litigating Design Patents - What the Trademark and Patent Lawyer Should Know"*, New York Intellectual Property Law Association, New York, New York, April 25, 1997.

12. *"The Product Configuration Conundrum - Exploring the Seemingly Contradictory Interface Between Trade Dress Protection and Design Patent Protection"*, The Intellectual Property Law Section, State Bar of Michigan, Mackinac Island, Michigan, August 2, 1997; George Washington University - National Law Center, Washington, D.C., November 4, 1997.

13. *"Trade Dress: Common Constructs or Complete Confusion: Exploring the Interface Between Trade Dress Protection and Patent Protection"*, The United States Patent and Trademark Office, Arlington, Virginia, February 12, 1998.

14. *"The Basic Tools of Design Protection"*, Industrial Designers Society of America, Philadelphia Chapter, Philadelphia College of Textiles and Science, Philadelphia, Pennsylvania, August 10, 1998.

15. *"Product Configurations: How to Register Them as Trademarks and How They are Affected by Patent Law"*, All Ohio Annual Institute on Intellectual Property, Cleveland and Cincinnati, Ohio, October 8-9, 1998.

16. *"The Dirty Dozen Design Law Cases"*, American Intellectual Property Lawyers Association, Industrial Design Committee, Washington, D.C., October 15, 1998.

17. *"Design Protection in the U.S.A."* , FICPI 4<sup>th</sup> Open Forum, Session entitled "Lost Property" , Florence, Italy, October 22, 1998.
18. *"Hot Tips for Preparing and Prosecuting Design Patent Applications"*, American Intellectual Property Law Association, Industrial Design Committee, Chicago, Illinois, April 23, 1999.
19. *"What the Supreme Court Giveth, The Supreme Court Taketh Away or The Conundrum Continues . . . The Conflict Between Trade Dress and Design Patent Protection"*, American Intellectual Property Law Association, Industrial Design Committee, Pittsburgh, Pennsylvania, May 17, 2000.
20. *"Design Patents: Prosecution and Enforcement in a Region of Chaos"*, All Ohio Annual Institute on Intellectual Property, Cleveland and Cincinnati, Ohio, September 21 - 22, 2000.
21. *"How to Determine the Meaning and Scope of a Design Patent Claim Under "Markman" for Infringement Purposes and Drafting and Crafting Tips for Design Patent Claims"*, United States Patent and Trademark Office, Open House, Design Patent Session, Arlington, Virginia, October 18, 2000.
22. *"I'll See Your Two Pesos and Raise You . . . Two Pesos, Wal-Mart and Traffix: Where is the U.S. Supreme Court Heading and How Will it Affect Trademark Practitioners?"*, The Trademark Law Committee of the New York State Bar Association and The Fordham Intellectual Property, Media & Entertainment Law Journal, Fordham University School of Law, New York, New York, April 2, 2001.
23. *"The Effect of Wal-Mart and Traffix on Trade Dress Protection for Product Configurations and Future Trends"*, The Texas State Bar Annual Meeting, Intellectual Property Section CLE Program, Austin, Texas, June 15, 2001.
24. *"Traffix Cops Arrest Trade Dress - Set Free Design Patents!"*, New York Intellectual Property Law Association, CLE Program, Cornell Club, New York, New York, June 22, 2001.
25. *"How to Protect Client Ideas When You Can't Get a Utility Patent - The Latest Skinny on Trade Dress and Design Patent Protection For Product Designs in the Wake of the Supreme Court's Wal-Mart and Traffix Decisions"*, The 27<sup>th</sup> Annual Intellectual Property Law Seminar, Intellectual Property Law Section of the State Bar of Michigan, Grand Hotel, Mackinac Island, Michigan, July 14, 2001.
26. *"Trade Dress v. Patent Protection: The Traffix Debate"*, New York State Bar Association, Intellectual Property Law Section, Fall Meeting at Lake George, The Sagamore, Bolton Landing, NY, October 13, 2001.
27. *"Preparing to File Suit on a Design Patent - How to Get Design Patents That Will Maximize Your Chances Against Knock-Offs"*, 15<sup>th</sup> Annual Intellectual Property Law Institute, Intellectual Property Law Section of the State Bar of Texas, Texas Bar CLE, San Antonio, Texas, March 15, 2002.
28. *"Design Patents - The Inside Skinny - How To Get Design Patents That Will Maximize Your Chances Against Knock-Offs"*, Eighteenth Annual Institute on Intellectual Property Law, Houston Intellectual Property Law Assn, University of Houston Law Center, Institute for Intellectual Property & Information Law, Galveston, Texas, September 27, 2002.
29. *"Industrial Designs and Design Patents"*, 18th Annual Intellectual Property Law Conference, American Bar Association - Section of Intellectual Property Law, Washington, D.C., April 3, 2003.
30. *"Current Design Protection in the U.S. - U.S. View"*, 10th Summer IPL Conference, American Bar Association - Section of Intellectual Property Law, San Diego, CA, June 18, 2003.

31. *"The Death of Gorham v. White - Killing It Softly With Markman"*, 17<sup>th</sup> Annual Intellectual Property Law Institute, Intellectual Property Law Section of the State Bar of Texas, Texas Bar CLE, San Antonio, Texas, March 5, 2004.
32. *"The Death of Gorham v. White - Killing It Softly With Markman"*, All Ohio Annual Institute on Intellectual Property, Cleveland and Cincinnati, Ohio, September 9-10, 2004.
33. *"The Overlap Between Marks and Designs"*, INTA/WIPO Worldwide Forum on Marks & Designs, Vancouver, B.C. Canada, September 8-9, 2005.
34. *"Design Patents"*, Japanese Intellectual Property Association, 2005 Seminar, Washington, DC, October, 2005.
35. *"Enforcement Issues for Designs"*, Intellectual Property Owners Association Annual Meeting, Chicago, Illinois, September 12, 2006.
36. *"The Crisis in the Law of Designs"*, All Ohio Annual Institute on Intellectual Property, Cleveland and Cincinnati, Ohio, September 14-15, 2006.
37. *"Current Issues in Design Protection and Enforcement"*, San Francisco Intellectual Property Law Association Luncheon, San Francisco, California, October 26, 2006.
38. *"Design Patents, Trade Dress, EU Community Design Registrations - Compared & Contrasted"*, Corporate Counsel Seminar, Hilton Head, South Carolina, November 14, 2006.
39. *"The Crisis in the Law of Designs"*, 2007 Microsoft/IDSA Spotlight Speaker Series, Webcast, March 21, 2007.
40. *"What Happens After a Design Patent Issues"*, USPTO Design Day, Alexandria, Virginia, April 16, 2007.
41. *"Design Protection: Has the Time Come for a Copyright-Based Design Registration Law in the U.S.? History of U.S. Efforts Regarding Sui Generis Design Protection Law"*, Intellectual Property Owners Association Annual Meeting, New York, New York, September 11, 2007.
42. *"The Time Has Come for a U.S. Design Registration System"*, American Intellectual Property Law Association Annual Meeting, Washington, DC, October 18, 2007.
43. *"Design Patents"*, Japanese Intellectual Property Association, 2007 Seminar, Washington, DC, November 1, 2007.
44. *"Design Law: The Neglected Branch of IP"*, The George Washington University - National Law Center, Washington, DC, November 1, 2007.
45. *"Design Law: 2008 and Beyond"*, BNA's Patent, Trademark & Copyright Journal Advisory Board, Arlington, Virginia, January 31, 2008.
46. *"Nail Buffers, Saddles & Silverware"*, The Michigan IP Law Association, Dearborn, Michigan, April 8, 2008.
47. *"Practical Tips on Obtaining U.S. Design Patents"*, American Bar Association, Section of IP Law, Young Lawyers Committee, Arlington, Virginia, April 9, 2008.

**AMICUS CURIAE BRIEFS FILED:**

1. "Brief for *Amicus Curiae* Industrial Designers Society of America in Support of Combined Petition for Panel Rehearing and Rehearing En Banc", *Lawman Armor Corporation v. Winner International, LLC and Winner Holding LLC*, in the United States Court of Appeals for the Federal Circuit, March 27, 2006.

2. "Brief for *Amicus Curiae* Industrial Designers Society of America in Support of Combined Petition for Panel Rehearing and Rehearing En Banc", *PHG Technologies, LLC v. St. John Companies, Inc.*, in the United States Court of Appeals for the Federal Circuit, December 28, 2006.

3. "Brief for *Amicus Curiae* Industrial Designers Society of America in Support of Combined Petition for Panel Rehearing and Rehearing En Banc", *Arminak & Associates, Inc. et al v. Saint-Gobain Calmar, Inc.*, in the United States Court of Appeals for the Federal Circuit, October 31, 2007.

4. "Brief for *Amicus Curiae* Apple Inc. in Support of Neither Party (Supporting Reversal)", *Egyptian Goddess, Inc., et al v. Swisa, Inc., et al.* in the United States Court of Appeals for the Federal Circuit, February 5, 2008.

**MISCELLANEOUS:**

- Trained mediator for use in alternative dispute resolution; member, World Intellectual Property Organization (WIPO) Arbitration and Mediation Center List of Neutrals
- Member, Washington Ethical Society.
- Registered to practice before U.S. Patent and Trademark Office.
- Member of: Intellectual Property Owners (Vice-Chair, Industrial Designs Committee); American Intellectual Property Law Association; Industrial Designers Society of America (Co-chair, Design Protection Committee); The American Bar Association; International Association for the Protection of Industrial Property, the International Trademark Association.

**PARTIAL LIST OF CASES IN WHICH I HAVE TESTIFIED AS AN EXPERT WITNESS ON DESIGN PATENT AND/OR TRADE DRESS LAWS:**

*The Hoover Company v. White Consolidated Industries, Inc.* (No. 1:96 CV 600), United States District Court, Northern District of Ohio, Eastern Division

*Adobe Systems Incorporated v. Southern Software Inc. et al.* (No. C-95 20710 RMW (PVT)), United States District Court, Northern District of California (San Jose Division)

*Cardinal American Corporation v. Jack-Post Corporation* (No. 1:97CV00310), United States District Court, Northern District of Ohio, Eastern Division

*Qualcomm, Incorporated v. Motorola, Inc.* (No. 97-CV-0372J (RBB)), United States District Court,  
Southern District of California

*The Hoover Company v. Bissell Inc.*, (No. 5:98 CV 1089), United States District Court for the Northern  
District of Ohio, Eastern Division

*Specialty Equipment Companies, Inc., Beverage-Air Division v. True Manufacturing Co., Inc.*, (No.  
4:97-CV-1969 CAS) United States District Court, Eastern District of Missouri, Eastern Division

*Designs by Skaffles, Inc. v. The New L&N Sales & Marketing, Inc.*, (No. 99 CIV 1056 (DAB)) United  
States District Court, Southern District of New York

*Goody Products, Inc. v. The New L&N Sales & Marketing, Inc.*, (No. 99C-0724) United States District  
Court, Northern District of Illinois, Eastern Division

*The New L&N Sales & Marketing, Inc. and Rommy Hunt Revson v. Mattel, Inc. and Toys "R" Us, Inc.*,  
(No. 99-CV-590), United States District Court, Eastern District of Pennsylvania

*Second Circuits Corporation and Circle Sales Corporation v. American Circuit Breaker Corporation*,  
(No. CV98-1623 LO), United States District Court, Western District of Louisiana, Lafayette Division

*Black & Decker (U.S.) Inc. et al., v. Atlas Copco AB, et al.*, (No. 00-961-A), United States District  
Court, Eastern District of Virginia (Alexandria Division)

*Plastics Research Corp., Inc. v. Brite Millwork, Inc.* (No. 97-40497), United States District Court,  
Eastern District of Michigan, Southern Division

*Plastics Research Corp., Inc. v. Weyerhaeuser USA, Inc.* (No. 99-71923), United States District Court, Eastern District of Michigan, Southern Division

*Jack Schwartz Shoes, Inc. v. Skechers USA, Inc.*, (No. 00 CIV 7721 (RMB)) United States District Court, Southern District of New York

*John Mezzalingua Inc., d/b/a PPC v. Antec Corporation, n/k/a Arris International, Inc.*, (No. 3:01-CV-482-J-25 HTS) United States District Court, Middle District of Florida, Jacksonville Division

*Reflexions Automotive Products LLC v. Goodmark Industries, Inc.* (No. CV 00-2663 (MIBRE)) United States District Court, Western District of Tennessee, Western Division

*John Mezzalingua Associates, Inc., d/b/a PPC v. Gilbert Engineering, Inc.*, (No. CIV 01-1566 PHX SRB) United States District Court, District of Arizona

*Tropicana Products, Inc. v. Land O'Lakes, Inc.* (No. 02-358 (JJF)) United States District Court, District of Delaware

*Gilbert R. Sada and Victor L. Hernandez v. Jack in the Box, Inc.*, (No. SA-04-CA0541-OG) United States District Court, Western District of Texas, San Antonio Division

*Louis T. Spell v. Frijouf, Rust & Pyle, P.A. and Robert F. Frijouf, Esq.*, (No. 01003067) Circuit Court of the Thirteenth Judicial Circuit, State of Florida, Hillsborough County, Civil Division

*Panelite, Inc. v. Vehicle Safety Manufacturing, Inc. et al.*, (No. 04-CV-2077-B) United States District Court, Southern District of California

*Nichia Corporation v. Seoul Semiconductor Co., Ltd. and Seoul Semiconductor, Inc.*, (No. 3-06-CV-00162-MMC (JCS) United States District Court, Northern District of California, San Francisco Division

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