

What Is the Point of the Point of Novelty Test for Design Patent Infringement?

Nail Buffers and Saddles: An Analysis fit for an Egyptian Goddess

Perry J. Saidman*

- I. Introduction402
- II. The Point of Novelty Test403
 - A. From Whence Doth It Cometh?403
 - 1. *Whitman Saddle*403
 - 2. *Kruttschnitt*404
 - 3. *Litton*405
 - B. Recent Developments405
 - 1. *Lawman*405
 - 2. *Egyptian Goddess*407
- III. Systemic Problems with the Point of Novelty Test.....408
 - A. It Creates An Illogical Super-Standard for Design Patent Infringement408

* Principal, SAIDMAN DesignLaw Group, LLC, a law firm in Silver Spring, Maryland that specializes in legal issues involving designs and product configurations. The author appreciates the invaluable legal research assistance of George Raynal, Esq., an associate at the firm. The opinions expressed herein are those of the author only and do not necessarily represent those of any client of the firm. © 2008 Perry J. Saidman.

B. It Encourages Back Door Attacks on Validity	410
C. Modern Design Patent Claim Drafting Obviates The Need For Point of Novelty Analysis	411
IV. The Prior Art can be Taken into Account Without Analyzing the Point of Novelty: the 3-way Visual Comparison	411
V. Dismounting <i>Whitman Saddle</i>	416
A. Material Facts Not Apparent From The Reported Decision	416
B. The Fly in the Accused Infringer's Ointment	419
C. The Point of Novelty Test Simply Doesn't Work	421
D. Conclusion	422
VI. What About <i>Egyptian Goddess</i> ?	422

I. Introduction

The rule governing design patent infringement comprises two distinct tests: the "ordinary observer" test, and the "point of novelty" test. The former was laid down in the Supreme Court's venerable 137-year old decision of *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871):

We hold therefore, that 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:

The point of novelty test was adopted from earlier case law into Federal Circuit jurisprudence in *Litton Sys., Inc. v.*

Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984):

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

The point of novelty test was unquestioned until the Federal Circuit granted *en banc* rehearing in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 256 Fed. Appx. 357 (Fed. Cir. 2007), vacating its earlier decision at 498 F.3d 1354 (Fed. Cir. 2007). In its *en banc* order, the court *sua sponte* brought into play an issue that no court had previously considered:

Should "point of novelty" be a test for infringement of design patent? (sic)

This paper will explore this question in depth, with the conclusion that the point of novelty test has outlived its usefulness and should no longer apply as a test for design patent infringement.

II. The Point of Novelty Test

A. From Whence Doth It Cometh?

1. *Whitman Saddle*

In establishing the venerable "substantially the same" test for design patent infringement in *Gorham*, the U.S. Supreme Court made no comparison of the claimed design to the prior art, no determination of novel elements and no analysis to see if novel elements were present in the accused designs.¹

In a case that many attribute as the genesis of the modern day point of novelty test, the Court undertook a different analysis in deciding infringement when a claimed design incorporated a great deal of the prior art. In *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893), the patented design was a saddle (D10,844, see below), and in its discussion of the design patent's validity, the Court determined that the claimed design combined the front half "B" of one well-known saddle, the Granger, and the rear half "D" of another, the Jenifer cantle.

The Court did not agree with the lower court that the combination of the Granger-Jenifer alone was patentable.² Stopping short of holding the design patent invalid, it proceeded to identify a feature of the patented design as a "sharp drop of the pommel at the rear" *Id.* at 681 (indicated by "b" in FIG. 1). It then found the "sharp drop" to be missing from the accused design. It concluded: "...the design of the patent had two features of difference as compared with the Granger saddle, - one the cantle, the other the drop; and unless there was infringement as to the latter there was none at all, since the saddle design of the patent does not otherwise differ from the old saddle with the old cantle added, - an addition frequently made." *Id.* at 682. Through the years, other courts adopted similar reasoning, the logic seemingly based on the public's right to practice the prior art.³

After reviewing the considerable vagaries of the point of novelty test, this paper will conclude with a more detailed analysis of *Whitman Saddle*, as it appears to be the lynchpin of modern day point of novelty analysis. That is, if the Supreme Court's logic in *Whitman Saddle* cannot be rationalized in terms of modern design patent jurisprudence, then the point of novelty test will likely survive the *Egyptian Goddess en banc* rehearing.

1 The Court did not discuss the patentability, or novelty, of *Gorham's* patented design, save to mention the lower court's observation that the design was "the most successful plain [silverware] pattern, indeed, that had been in the market for many years" *Gorham*, 81 U.S. at 512.

2 "The experienced judge by whom this case was decided conceded that the design of the patent in question did show prominent features of the Granger and Jenifer saddles, and united two halves of old trees, but he said: 'A mechanic may take the legs of one stove, and the cap of another, and the door of another, and make a new design which had no element of invention; but it does not follow that the result of the thought of a mechanic who has fused together two diverse shapes; which were made upon different principles, so that new lines and curves and a harmonious and novel whole are produced, which possesses a new grace, and which has a utility resultant from the new shape, exhibits no invention.' And he held that this was effected by the patentee, and that the shape that he produced was, therefore, patentable. But we cannot concur in this view." *Whitman Saddle*, 148 U.S. at 680-81.

3 See *Jennings v. Kibbe*, 24 F. 697 (S.D.N.Y. 1885), *Byram v. Friedberger*, 87 F. 559 (E.D. Pa. 1897), *Bevin Bros. Mfg. v. Starr Bros. Bell Co.*, 114 F. 362, 364 (C.C. Conn. 1902), *Zidell v. Dexter*, 262 Fed. 145 (9th Cir. 1920), *Cola Co. v. Whistle Co. of America*, 20 F.2d 955 (D.C. Del. 1927), *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933), *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395 (8th Cir. 1944).

UNITED STATES PATENT OFFICE.

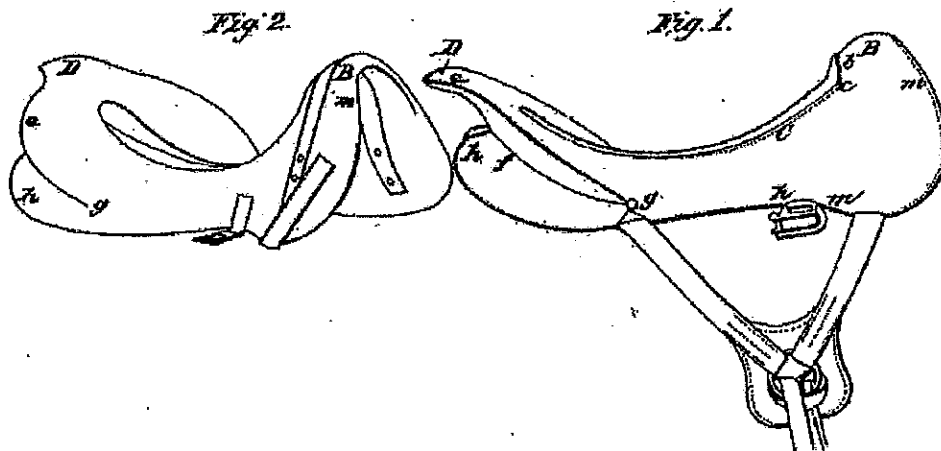
DESIGN.

R. E. WHITMAN.

Saddle.

No. 10,844.

Patented Sept. 24, 1878.



2. *Kruttschnitt*

In another early case, which did not rely on the *Whitman Saddle* logic, a district court also invoked a point of novelty formulation. In *Kruttschnitt v. Simmons*, 118 F. 851 (S.D.N.Y. 1902), the patentee essentially attempted to wield its design patent as a utility patent, *i.e.*, to halt sales of products that incorporated the *idea* expressed in the design patent but without incorporating the design itself. The design patent depicted a particular ornamental border on an aluminum sign plate; bordered aluminum sign plates were *per se* new. The defendant made an aluminum sign plate with a different ornamental border, and because bordered aluminum sign plates were new, there was some evidence of confusion among the purchasing public. But the court properly found no infringe-

ment, since the particular ornamentation claimed in plaintiff's design patent was not appropriated by the defendant. Without citing any precedent, the court indicated that *Gorham's* ordinary observer test "...cannot be applied without doing violence to the fundamental law of infringement - that in order to constitute infringement there must be an appropriation of the novel elements of the patented design." *Id.* at 852.⁴

However, straight-forward reliance on *Gorham's* "substantially the same" infringement test, without resorting to point of novelty analysis, has been sufficient to rein in design patentees trying to enforce against those who use the idea behind the design, rather than the claimed design itself. For example, in *Lee v. Dayton-Hudson*, 838 F.2d 1186 (Fed. Cir.

⁴ See also *Ashley v. Samuel C. Tatum, Co.*, 186 Fed. 339 (2nd Cir. 1911); *N.Y. Belting & P. Co. v. N.J. Car Spring & R. Co.*, 53 F. 810 (2nd Cir. 1892).

1988), the patentee, ignoring the specific design illustrated in its patent, argued that its design patent covered a massage device having an elongated handle with two opposing balls at one end, and that a massage device with the same general configuration, but which looked quite different, was infringing, *id.* at 1189. Relying only upon *Gorham Co. v. White*, the court quite properly found:

[A] design patent is not a substitute for a utility patent. A device that copies the utilitarian or functional features of a patented design is not an infringement unless the ornamental aspects are also copied, such that the overall "resemblance is such as to deceive".

Id. at 1190.

3. *Litton*

Litton, as noted previously, was the first Federal Circuit case adopting the "point of novelty" approach for deciding design patent infringement.⁵ Under present day point of novelty analysis, a court looks at which of the elements of the patented design exist in the prior art. Whatever elements are visually found in the prior art are, by definition, not novel, and the remaining elements comprise the "point of novelty." Those new elements must be visually present in the accused design in order for the *Litton* infringement test to be met.⁶

What is interesting about *Litton* is that the court first analyzed an obviousness defense, identifying the differences between the prior art and the claim in issue per *Graham v. John Deere*,⁷ and then used those differences as the novel elements in its subsequent point of novelty analysis. While this sounds logical, and has been used in other cases,⁸ it tended to define the validity/infringement tests as opposite sides of the same coin, thereby opening the door to a defendant to attack the validity of the design patent in the infringement phase by alleging that those differences were not novel.⁹

B. Recent Developments

1. *Lawman*

*Lawman Armor v. Winner*¹⁰ involved a design patent covering a steering wheel locking device, popularly used to prevent auto theft. To meet its burden in the lower court, the patentee proffered 8 "points of novelty" that it said were not in the prior art but which were present in the accused design.¹¹ The defendant, instead of taking the usual tack of denying that the accused product contains one or more of the novel elements, or submitting its own point of novelty formulation, introduced prior art which it said rendered the 8 alleged "points of novelty" not, in fact, novel. The district court agreed, and granted summary judgment of non-infringement to the defendant.¹²

5 The court cited *Sears Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944) and *Horwitt v. Longines Wittnauer Watch Co.*, 388 F.Supp. 1257, 1263 (S.D.N.Y. 1975) as precedent for the point of novelty test.

6 See discussion *infra* note 36.

7 *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

8 See, e.g., *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.*, 162 F.3d 1113, 1118-22 (Fed. Cir. 1998).

9 See discussion *infra* §III.B.

10 *Lawman Armor Corp. v. Winner Int'l, LLC*, 2005 WL 354103 (E.D. Pa. 2005).

11 *Id.* at *5

12 *Id.* See also discussion *infra* note 36.

On appeal to the Federal Circuit, the plaintiff, in addition to contesting the argument that the 8 points of novelty were present in the prior art, suggested that the Court should additionally look at the combination of these 8 elements which the plaintiff argued was itself novel.¹³ The Court rejected this argument, saying since all 8 of these elements were not themselves novel, the plaintiff could not rely on a combination of non-novel elements to constitute a "9th point of novelty." The Federal Circuit feared that such a holding would somehow undermine the *Litton* test.¹⁴

The Court's decision overlooked the fact that nearly all designs are combination of elements from previous designs.¹⁵ If a plaintiff relied on a combination of design elements to define the point of novelty, then the scope of her design patent would be somewhat narrow. This would not "undermine" *Litton* since the accused design would still need to contain this narrow point of novelty in order to infringe. In addition, it presumably would not take much effort to 'design around' such a narrow claim, so no one is damaged by allowing a narrow design claim, consisting of a 'combination' of known elements, over close prior art.

This Federal Circuit decision that a combination of design elements cannot serve as a point of a novelty also directly contradicted previous Federal Circuit holdings and a variety of district court decisions. For example, in 1988, the

Federal Circuit held that the point of novelty for a shoe upper was "the combination of saddle, eyestay and perforations," and explicitly rejected the argument that the existence of individual features in the prior art prevented their combination from being a point of novelty.¹⁶ Again in 1993, the Federal Circuit affirmed that infringement could be found when the point of novelty existed in an "overall appearance of the combination" of the design patent's major design elements even though individual elements of the design were found in prior art.¹⁷

The patentee, Lawman, petitioned the Federal Circuit for rehearing and rehearing *en banc*. While denying the petition, the Court did issue a "clarification" which, unfortunately, did little to clarify.¹⁸

In its "clarification," the Federal Circuit affirmed its earlier decision (that a combination of non-novel elements may not itself be the point of novelty), but said in addition that "in appropriate circumstances a combination of design elements itself may constitute the point of novelty." The Court provided no guidance of what would be considered "appropriate circumstances" beyond noting that "although a combination of design elements can be a point of novelty this is a different concept than the overall appearance of a design which ... our cases have recognized cannot be a point of novelty."¹⁹

One of the cases relied upon in the "clarification" to support the proposition that the point of novelty may not reside in

13 *Lawman Armor Corp. v. Winner*, 437 F.3d 1383 (Fed. Cir. 2006).

14 *Id.* at 1385.

15 See *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) ("Virtually all inventions are combinations and virtually all are combinations of old elements.").

16 *Avia Group Int'l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988).

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

18 *Lawman Armor Corp. v. Winner Int'l*, 449 F.3d 1190 (Fed. Cir. 2006).

19 *Id.* at 1192.

the overall design, *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.*²⁰, was in reaction to the lower court's failure to even attempt to identify any novel elements at all – it had characterized the point of novelty as “the ornamental gestalt”, *Id.* at 1197. However, failure to define the point of novelty is not a solid basis for concluding that the point of novelty cannot comprise the overall design.

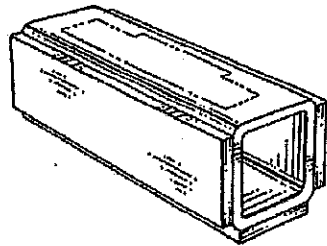
Judge Newman dissented from the denial of the petition for rehearing *en banc*, saying there was nothing wrong with finding that the point of novelty constitutes the overall appearance of a product.²¹ Judge Newman in her opinion (which can only be characterized as providing more clarity than the majority's “clarification”) said that failure to grant rehearing on this issue could place design patent holders in a “state of limbo.” Of

course, Judge Newman was correct, in that many designs are so simple,²² or so broadly claimed,²³ that the point of novelty can hardly be anything other than the overall appearance of the claimed design.

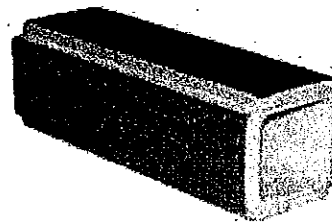
2. Egyptian Goddess

In August, 2007, the Federal Circuit handed down *Egyptian Goddess v. Swisa*²⁴, a case involving a design patent on nail buffers. Below is illustrated the patented and accused designs. Also shown is Egyptian Goddess' closest prior art, a solid, square block.

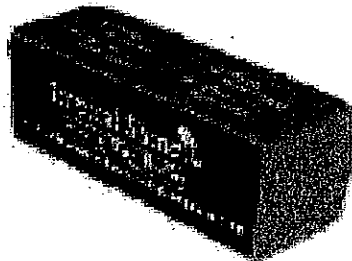
So, as is typical with patentees, Egyptian Goddess submitted a point of novelty consisting of 4 features it believed distinguished over that prior art – they also happened to be found in the accused Swisa design, namely: (1) an open and hollow body; (2) a square cross-section;



PATENTED DESIGN



ACCUSED DESIGN



EGYPTIAN GODDESS' PRIOR ART

20 48 F3d 1193 (Fed. Cir. 1995). See also *Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F2d 375 (Fed. Cir. 1990).

21 *Lawman Armor Corp. v. Winner Int'l*, 449 F3d 1192, 1194 (Fed. Cir. 2006) (J. Newman dissenting).

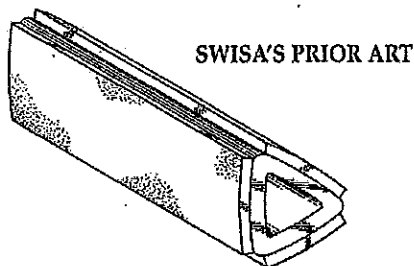
22 See, e.g., U.S. Pat. No. D557,606 (filed: May 23, 2003).

23 See, e.g., U.S. Pat. No. D351,310 (filed Dec. 24, 1992) and U.S. Patent No. D446,702 (filed June 6, 2001).

24 *Egyptian Goddess, Inc. v. Swisa, Inc.*, 498 F3d 1354 (Fed. Cir. 2007).

(3) raised rectangular pads; and (4) exposed corners.

As is typical with accused infringers, Swisa had a different view of the closest prior art:



Swisa alleged that everything in Egyptian Goddess' point of novelty was found in this prior art but for the square cross-section, which was in Egyptian Goddess' prior art. While Swisa's prior art is structurally similar to the patented design, it is a stretch to say that a triangular nail buffer looks like a square nail buffer.²⁵

The Federal Circuit agreed that square nail buffers were old. Then, out of the clear blue sky, they said that Egyptian Goddess' point of novelty did not rise to the level of being a "non-trivial advance" over the prior art, and thus was not sufficient to actually be a point of novelty.²⁶ No court has ever before mentioned the words "non-trivial advance" when discussing the point of novelty.

Then the court said: "... only if the point of novelty included a fourth side without

a raised pad could it even arguably be a non-trivial advance over the prior art."²⁷

The court concluded that since the Swisa buffer has pads on all 4 sides, there is no appropriation of the point of novelty, and thus no infringement.

Three months later, the Federal Circuit granted an *en banc* rehearing, vacating its earlier decision.²⁸ This is the first design patent case ever to be granted an *en banc* rehearing.²⁹ The court posed several questions for the parties to brief, one of which had never before been addressed in any court decision: should the "point of novelty" be a test for infringement of a design patent? The case has inspired the filing of a substantial number of *Amicus Curiae* briefs, and the writing of this paper.

III. Systemic Problems with the Point of Novelty Test

A. It Creates An Illogical Super-Standard for Design Patent Infringement

Point of novelty analysis creates an unnecessary and illogical super-standard for design patent infringement: not only must the accused design be substantially the same overall as the patented design (*Gorham's* doctrine of equivalents)³⁰, but a sub-combination point of novelty, consisting of one or more novel features extracted from the overall claimed design, which

²⁵ See discussion *infra* note 36.

²⁶ *Egyptian Goddess*, 498 F.3d at 1357-58.

²⁷ *Id.* at 1358.

²⁸ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 256 Fed. Appx. 357 (Fed. Cir., 2007).

²⁹ Controversial design patent decisions that have recently had petitions for rehearing denied include *Lawman Armor Corp. v. Winner Intern., LLC*, 449 F.3d 1190 (Fed. Cir. 2006), *rel'g denied* (unpub.); *PHG Technologies, LLC v. St. John Companies, Inc.*, 469 F.3d 1361, 81 U.S.P.Q.2d 1088 (Fed. Cir. 2006), *rel'g denied* (unpub.); and *Armınak and Associates, Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 84 U.S.P.Q.2d 1258 (Fed. Cir.) *rel'g denied, petition for cert. filed* (unpub.).

³⁰ *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189-90 (Fed. Cir. 1988).

was neither claimed nor examined individually, must be literally found in the accused design.

The so-called point of novelty is undefined during design patent prosecution. The job of the design patent examiner is to consider the overall appearance of the claimed design, search the prior art accordingly, and make a determination as to whether such overall claimed appearance is novel, unobvious and ornamental under 35 U.S.C. §§102, 103 and 171.³¹ The examiner does not identify individual novel elements during prosecution, and no determination of patentability is made of the individual design features that make up the overall claimed design; otherwise, the examiner would be put to the onerous task of determining patentability of each such design feature. Since only one claim is allowed in a design patent application, and since that claim is drawn to the overall design as shown and described in the design patent drawings,³² it matters not whether each individual element, or each possible combination of elements (technically, a sub-combination of the overall claimed design), is novel. What matters is whether the overall claimed design, the combination of all individual elements, is novel and non-obvious over the prior art.

During litigation, however, suddenly the design patent owner is put to the task of defining an unclaimed and unexamined sub-combination point of novelty. The patentee will inevitably take the position that its formulation of the point of

novelty is found in the accused design, while the accused infringer quite naturally is likely to formulate its own point of novelty that is nowhere to be found in the accused design. This is standard design patent gamesmanship during litigation.³³

By breaking down a claimed design into component novel elements, an infringement defendant can attempt to avoid one or more novel elements individually and thereby assert that the point of novelty has not been appropriated. This is far easier than avoiding the overall design, and relegates *Gorham's* overall "substantially the same" test to the background. Thus, an infringement finding can be avoided by a defendant drafting its point of novelty to include elements from the claimed design not present in the accused design, despite the fact that the overall appearance is substantially the same.

Further, because of the sequence in which the point of novelty test is traditionally applied, you have the illogical scenario of first applying *Gorham's* doctrine of equivalents (are the two designs overall "substantially the same"?), and thereafter a test for literal infringement. And, the literal infringement test is not applied to the same claim as was the doctrine of equivalents, but to a much broader claim containing individual design elements, either alone or in combination, that were neither claimed nor examined. The sole claim allowed by the PTO to the overall design is thus dissected, picked apart by the parties and molded, like a nose of

31 U.S.P.T.O. Manual of Patent Examining Procedure §§1504.02, 1504.03, 1504.01(c) (8th ed. 2001, rev. Sept. 2007).

32 37 C.F.R. § 1.153. See also U.S.P.T.O. Manual of Patent Examining Procedure §1503.01(III) (8th ed. 2001, rev. Sept. 2007) ("A design patent application may only include a single claim. The single claim should normally be in formal terms to the ornamental design (for the article which embodies the design or to which it is applied) as shown.")

33 *Bush Industries, Inc. v. O'Sullivan Industries, Inc.*, 772 F.Supp. 1442 (D. Del. 1991) ("Bush has adopted a definition of point of novelty that can never be pinned down.... [This is] the shopping list approach, since a shopping list will be rewritten for each trip depending on what the shopper needs at the time [i.e., what he finds in the accused design].").

wax, by each party in order to make their best case, to win the point of novelty test.³⁴

The point of novelty test thus creates a super-standard for design patent infringement, an unfair burden on the patentee, that simply makes no sense. It is another way for an accused infringer to avoid liability in spite of his design being overall substantially the same as the patented design.

B. It Encourages Back Door Attacks on Validity

Issued design patents enjoy a presumption of validity, 35 U.S.C. §282, having been examined and found novel and non-obvious over the prior art, 35 U.S.C. §§102, 103. Thus, the alleged infringer has a high burden to show invalidity: he must show the design lacks novelty, or would have been obvious, by clear and convincing evidence. *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1379 (Fed. Cir. 2004). Point of novelty analysis unfairly moves the burden to the patentee, who in her infringement case in chief must prove the patented design has one or more novel elements.³⁵ The accused infringer can attack the proffered novel elements under the significantly lower preponderance of evidence standard, as occurred in *Lawman Armor*

Corp. v. Winner Int'l, LLC, thereby undermining the patent's presumption of validity. 437 F.3d 1383, 1386 (Fed. Cir. 2006).

What occurred in *Lawman* is instructive. Instead of taking the usual tack of offering a counter-point of novelty, or of proving that the proffered point of novelty was not found in the accused design, the defendant Winner argued that each novel feature proffered by Lawman was not in fact novel. Winner introduced prior art alleged to negate the novelty of each of the 8 design elements listed by Lawman as its points of novelty. The lower court found that the prior art taught each and every proffered point of novelty,³⁶ and granted summary judgment of non-infringement on that basis, which was affirmed by the Federal Circuit.³⁷ Thus, Lawman's patent was found to be devoid of novelty, and thus effectively invalid. But proof of the prior art containing the alleged novel features was advanced under the preponderance of the evidence standard that governs infringement determinations, rather than the clear and convincing evidence standard that governs invalidity determinations.³⁸ Thus, Winner managed to effectively prove Lawman's patent invalid under a lower standard that would otherwise have applied, under the guise of the point of novelty test.³⁹

³⁴ There is no analog to the point of novelty test in utility patent jurisprudence. It is well settled that there is no legally recognizable "essential" element, gist or "heart" of the invention test in determining infringement of a utility patent claim. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961). Rather, a utility patent claim is viewed as a whole in determining infringement. *Gen. Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1274 (Fed. Cir. 1992).

³⁵ See *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567 (Fed. Cir. 1983) (To ignore the presumption of novelty will "place on the patentee a non-statutory burden of proving validity:").

³⁶ *Lawman*, *supra* note 10. The district court made an all-too-common error of analyzing the prior art in terms of its structural features rather than its visual features. That is, the prior art must look like a point of novelty in order to negate it. Much of the prior art relied upon in *Lawman* didn't look like the points of novelty.

³⁷ *Lawman*, *supra* note 13.

³⁸ *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1379 (Fed. Cir. 2004).

³⁹ On appeal, Lawman apparently realized that its initial formulation of a list of 8 individual features as comprising the "points" of novelty was a poor strategic move, and argued the existence of a ninth point of novelty that consisted of a combination of all 8 non-novel elements. *Lawman*, *supra* note 37, at 1385-86. As pointed out elsewhere in this paper, a well-advised patentee would couch the point of novelty as a combination of elements, since it insulates the point of novelty from just the sort of element-by-element attack that occurred in this case.

C. Modern Design Patent Claim Drafting Obviates the Need For Point of Novelty Analysis

Modern claim drafting for design patents, in which the scope of a claim is clearly shown by presenting design features in either solid or broken lines, further minimizes the rationale for point of novelty analysis.

A sea change occurred design patent claim drafting in *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (C.C.P.A. 1980), in which a court first held that an entire design need not be claimed, as in the days of *Whitman Saddle*, *supra*, but rather claimed features could be shown in solid lines, and unclaimed ones in broken lines. In *Whitman Saddle*, presented with a narrow design patent claim (all features in solid lines), consisting mostly of prior art design features, the Court perhaps felt compelled to determine what was novel, in order to allow the defendant to practice the prior art, as was her right.

Modern claim drafting practice comports with the statute -- 35 U.S.C. §112, para. 2 requires: "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." This not only allows an applicant leeway in what to claim, but also imposes a requirement for distinct claiming.⁴⁰ Moreover, modern claim drafting practice provides flexibility, allowing a design patentee, like his

utility patentee brethren, to obtain the broadest claim possible in view of the prior art by using solid lines to claim only novel, ornamental features and broken lines to disclaim old features, minor features, boundaries, environmental subject matter, etc.⁴¹ If a patentee nevertheless chooses to draft a narrow claim, using all solid lines, as in *Elmer*, she then suffers the natural consequences of a claim that is easy to design around.⁴² Parsing of the novel elements during litigation is unnecessary. If the claim consists mostly of old elements, it will either be easy to design around, or vulnerable to a properly pled invalidity defense.

IV. The Prior Art can be Taken Into Account Without Analyzing the Point of Novelty: The 3-way Visual Comparison

Many will ask, quite appropriately, if the point of novelty test is dispensed with, how can a court take the prior art into account? If the accused design is substantially the same as the patented design, how can a court avoid an unjust result when the patented design or accused design is close to the prior art, as occurred in *Whitman Saddle*?

In applying the *Gorham* test, many courts have well considered the prior art without undertaking point of novelty analysis, by making a 3-way visual comparison between the patented design, the

40 "...[The patentee] could have omitted ... features from its patent application drawings...[but] did not do so, however, and thus effectively limited the scope of its patent claim by including those features in it." *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

41 U.S.P.T.O. Manual of Patent Examining Procedure §1503.02 (8th ed. 2001, rev. Sept. 2007).

42 See *Whiting Mfg. Corp. v. Alvin Silver Co.*, 283 F.75, 81 (2nd Cir. 1922) ("...he must be deemed to have patented all that is exhibited in the drawing..."); *Horwitt v. Longines Wittnauer Watch Co., Inc.*, 388 F.Supp. 1257, 1263 (S.D.N.Y. 1975).

accused design, and the closest prior art. For example, in *Bevin Bros. Mfg. Co., supra* note 3, the court concluded:

The shape of defendants' bell differs from plaintiff's more widely than plaintiff's differs from the [prior art] door knob, and therefore defendants' construction does not infringe the patent.

In *Sidney Blumenthal & Co. v. Salt's Textile Mfg. Co.*, 21 F.2d 470 (D. Conn. 1927), the court found no infringement, stating:

There are more features of similarity between [the patented design] and the prior patents cited than there are between Salt's Company's fabric and the patented design. Therefore to view this design in such light as to find infringement would be to bring the patented design within the prior art and thereby render the patent invalid.

In *Applied Arts Corp., supra* note 3, in finding no infringement the court observed:

[I]t appears to us that while there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art.

Finally, the Federal Circuit, in affirming a jury finding of infringement under *Gorham*, has said:

[I]n contrast to pre-existing hand held blenders [i.e., the prior art], which had a utilitarian, mechanical appearance, both Waring's blender and Braun's blender share a fluid, ornamental, aerodynamic overall design.

Braun Inc. v. Dynamics Corp. of America, 975 F.2d 815, 820 (Fed. Cir. 1992).

Thus, if the patented or accused designs appear to be visually closer to the prior art than they are to each other, then the trier of fact will more likely conclude that the designs are not substantially the same. This makes sense in that if the patented design is closer to the prior art than to the accused design, to enlarge the scope of the patented design to encompass the accused design will likely cause the patented design to run afoul of the prior art. In other words, the accused design is simply beyond the scope of the patented design. If the accused design is closer to the prior art than to the patented design, the same situation obtains. In both cases, the principle is that the accused infringer is entitled to practice the prior art.

However, if the patented and accused designs appear to be visually closer to each other than either is to the closest prior art, then the trier of fact is more likely to conclude that the designs are substantially the same.⁴³ This also makes sense in that the accused infringer, having all the prior art available to him, chose instead to produce a design that was visually closer to the patented design, and therefore at higher risk of being held to be substantially the same.

This 3-way test, which visually compares the patented design, the accused

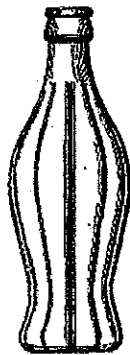
⁴³ See *Bergstrom v. Sears, Roebuck and Co.*, 496 F.Supp. 476, 492 (8th Cir. 1980); *Unette Corp. v. Unit Pack Co., Inc.*, 226 USPQ 715, 717 n.4 (D.N.J. 1985), *aff'd*, 228 USPQ 933 (Fed. Cir. 1986); *Unique Functional Products, Inc. v. Mastercraft Boat Co., Inc.*, 82 Fed.Appx. 683, 690 (unpub., Fed. Cir. 1993).

design and the prior art, is on its face subjective, but so is the appearance of ornamental designs, making it an appropriate alternative to the purportedly objective and outmoded point of novelty analy-

sis.⁴⁴ Several examples of this 3-way visual comparison between the patented design, accused design and prior art appear below:

Coca-Cola Co. v. Whistle Co. of Am., 20 F.2d 955 (D. Del. 1927):

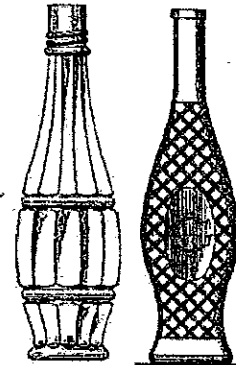
PATENTED DESIGN



ACCUSED DESIGN



PRIOR ART

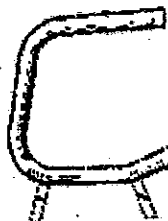


Save for such similarity as results from the common use of the ogee curve [found in the prior art], the most casual observer would find no difficulty in distinguishing [the patented] bottle from the [accused bottle]. *Id.* at 957.

HOLDING: NO INFRINGEMENT.

Bergstrom v. Sears, Roebuck and Co., 496 F.Supp. 476 (D. Minn. 1980):

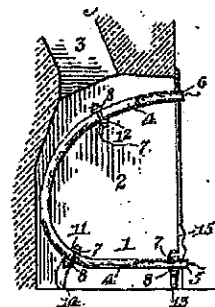
PATENTED DESIGN



ACCUSED DESIGN



PRIOR ART



The [accused device] bore the closest resemblance to the [patented design] out of all the prior art. *Id.* at 492.

HOLDING: INFRINGEMENT

⁴⁴ As with *Markman* construction of design patent claims, the point of novelty test necessarily results in a verbalization of the point of novelty – with all the uncertainty and inaccuracies inherent in verbalization of design patent claims. See Saidman & Singh, *The Death of Gorham v. White: Killing It Softly with Markman*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 792 (October 2004).

Unette Corp. v. Unit Pack Co., Inc., 1985 WL 5989 (D.N.J. 1985):

PATENTED DESIGN



ACCUSED DESIGN



PRIOR ART

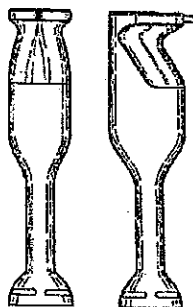


Moreover, to the extent that defendant's design is derived not from plaintiff's, but from the prior art, infringement cannot be said to have occurred. *Id.* at *3 n.4.

HOLDING: NO INFRINGEMENT.

Braun Inc. v. Dynamics Corp., 975 F.2d 815 (Fed. Cir. 1992):

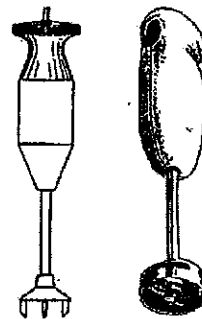
PATENTED DESIGN



ACCUSED DESIGN



PRIOR ART

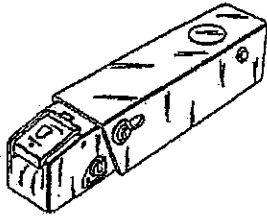


[I]n contrast to pre-existing hand held blenders [i.e., the prior art], which had a utilitarian, mechanical appearance, both [defendant's] blender and Braun's blender share a fluid, ornamental, aerodynamic overall design. *Id.* at 820.

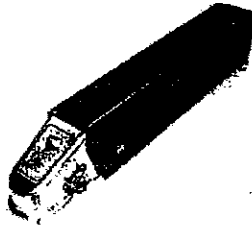
HOLDING: INFRINGEMENT.

Unique Functional Products, Inc. v. Mastercraft Boat Co., Inc., Fed. Appx. 683 (unpub., Fed. Cir. 1993):

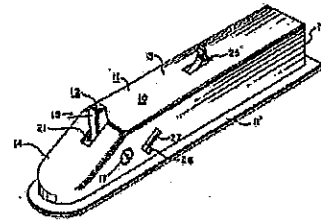
PATENTED DESIGN



ACCUSED DESIGN



PRIOR ART

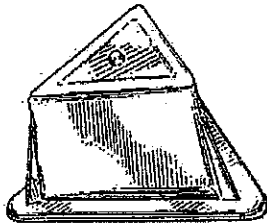


We also agree with [defendant] that the [accused] coupler is dissimilar from the design shown in the [patented design] and, indeed, much more closely resembles the design disclosed in the prior art... *Id.* at 689.

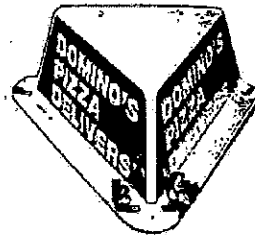
HOLDING: NO INFRINGEMENT.

Elmer v. ICC Fabricating, 67 F.3d 1571 (Fed. Cir. 1995):

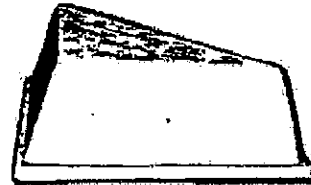
PATENTED DESIGN



ACCUSED DESIGN



PRIOR ART



...the... patented design differs from the prior art sign... and ICC's own sign... in two respects: the protrusion that extends above the upper surface... and the triangular vertical ribs... *Id.* at 1576.

HOLDING: NO INFRINGEMENT.

V. Dismounting *Whitman Saddle*

If *Whitman Saddle* were litigated today, based on the current amorphous point of novelty test, it could go either way. A more just and predictable result, however, could only come by using the 3-way visual comparison test advocated above as a replacement for the point of novelty test.

A. Material Facts Not Apparent From The Reported Decision

A review of the actual record before the Supreme Court in *Whitman Saddle* reveals material facts not apparent from the reported decision.

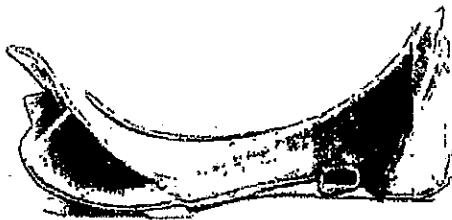
The most important material fact revealed by the briefs and exhibits before the Supreme Court is the *appearance* of the accused design and the prior art. Without knowing what the accused design and prior art looks like, one is left with inter-

preting the words in the Court's decision. The illustrations of the patented design, the accused design and the prior art give life and meaning to those words.

The patented design (D10,844) was a combination of the front half of a well known saddle, the Granger, with the rear portion of a well known cantle, the Jenifer. Illustrations of the Jenifer and Granger prior art, taken from Supreme Court exhibits, are shown below.⁴⁵

The record before the Supreme Court confirms that the Granger/Jenifer combination was legally novel, despite the fact that the Jenifer cantle had been combined with numerous other saddles in the prior art.⁴⁷ The Patent Office issued Whitman's design patent (D10,844, shown below) which consisted entirely of a full solid line illustration of his saddle: a combination of the front portion of the Granger with the rear portion of the Jenifer. In

JENIFER PRIOR ART



GRANGER PRIOR ART⁴⁶



⁴⁵ Brief of Defendant - Appellant, Smith between 28 and 29, *Smith v. Whitman Saddle Co.*, No. 13,780.

⁴⁶ While Appellant and Appellee dispute whether the particular saddle represented in this photograph was in fact prior art, there is no question that Granger saddles having the front (right) half illustrated above existed in the prior art. See discussion *infra* note 47 and note 61.

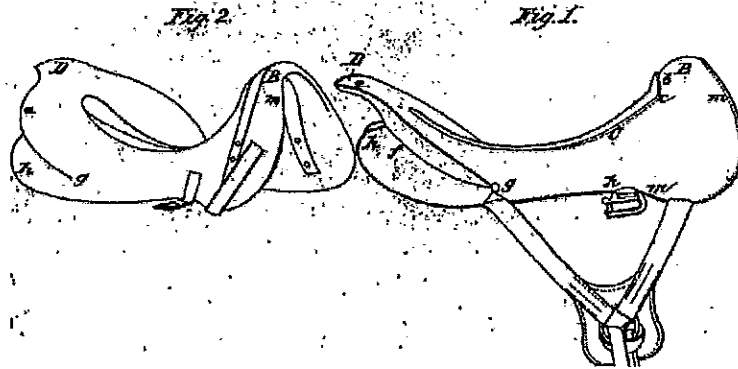
⁴⁷ Although the record demonstrates, and Whitman admitted, that various Granger and Jenifer saddles existed as prior art to Whitman's patent, defendant-appellant Smith introduced only vague testimonial evidence from a saddle maker that a Granger/Jenifer combination like Whitman's (including an open slot) existed in the prior art, and Whitman refuted that testimony with testimony from a co-worker of the saddle maker. See Brief of Defendant - Appellant Smith, *supra* note 45, at 14; Brief of Plaintiff - Appellee Whitman Saddle Co. at 24, *Smith v. Whitman Saddle Co.*, No. 13,780.

addition, Whitman's saddle included what appears to be a relatively minor visual feature in the drawings – a drop in the pommel "b".

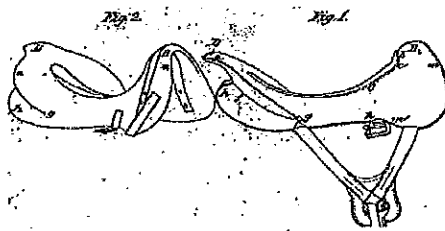
The accused infringer, Smith, made a saddle that also combined the front of the Granger with the rear of the Jenifer.⁴⁸ From the illustration of the accused design,

it appears that it also had a slight drop in the pommel, but not as pronounced as that of the patented design. The fact that the respective drops in both pommels are visually insignificant, compared to the overall designs, was not apparent from the Supreme Court's decision.

PATENTED DESIGN



PATENTED DESIGN



ACCUSED DESIGN⁴⁹



⁴⁸ Photograph of Complainant's Exhibit C, *Smith v. Whitman Saddle*, 148 U.S. 674 (1893) (No. 13,780).

⁴⁹ Although the similarity in outline of the patented and accused saddles is apparent, even the most clear representation of the accused design available, in these photographs of Complainant's Exhibit C, fails to isolate the accused saddle from extraneous three dimensional accoutrement, e.g. what appears to be a flap directly above the Fig. 2 label and the structure on which the saddle rests.

Having an illustration of the accused saddle makes it clear that the patented and accused saddles are extremely close visually – clearly substantially the same overall so as to easily meet the *Gorham* test. Yet, the Court found no infringement, because Smith successfully argued three things: that, contrary to the lower court's holding, the combination Granger/Jenifer was not patentable, that the pronounced pommel drop "b" was essentially the reason the patent was granted in the first place, and that since Whitman's pommel drop was not found in the accused design, there could be no infringement.⁵⁰ The Supreme Court agreed with Smith's argument in its

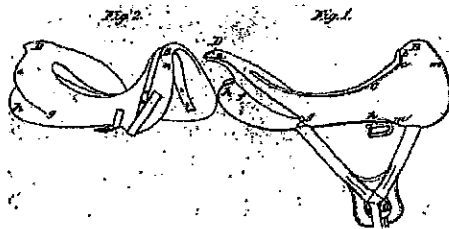
entirety, finding no infringement because Whitman's pommel drop was not in the accused design.

Below is illustrated a 3-way visual comparison of the patented design, the accused design, and the closest prior art.

The Court's conclusion of no infringement would run counter to the proposed 3-way test since the accused design appears much closer to the patented design than either are to the prior art, indicating a likely finding of infringement.

In *Egyptian Goddess*, Swisa very forcefully argued that exact point to try and convince the Federal Circuit that the 3-way test does not work and only a point of novelty analysis would prevent the

PATENTED DESIGN

ACCUSED DESIGN⁵¹

PRIOR ART

JENIFER

GRANGER⁵²

⁵⁰ Brief of Defendant – Appellant, Smith, *supra* note 45, at 30-31.

⁵¹ See description *supra* note 49.

⁵² See description *supra* note 46.

injustice of having an unpatentable (or obvious) combination found to be an infringement of Whitman's patent.⁵³ They also argued that *Whitman Saddle* supported the "non-trivial advance" test⁵⁴ from *Egyptian Goddess*, since, under patentability standards then prevalent,⁵⁵ the Supreme Court found the combination of the Granger/Jenifer to be unpatentable, i.e., trivial, or obvious.⁵⁶

B. The Fly in the Accused Infringer's Ointment

As previously noted, the underpinning of the Supreme Court's holding in *Whitman Saddle* was its conclusion that the combination Granger/Jenifer was not patentable, which focused its attention on Whitman's drop in the pommel: "If, therefore, this drop were material to the design, and rendered it patentable as a complete and integral Whole, there was no infringement." *Id.* at 682.

The flaw in Swisa's reasoning is that under today's standard of non-obviousness for designs, the combination Granger/Jenifer would not likely be held obvious to a designer of ordinary skill, i.e., the combination Granger/Jenifer would today be patentable.

In order for a design to be held obvious, there must be a so-called *Rosen* reference: "a something in existence, the design characteristics of which are basically the same as the claimed design."⁵⁷ As a practical matter, this means that the primary prior art or *Rosen* reference in a §103 design case needs to illustrate perhaps 75-80% of the patented design. Then, the examiner is allowed to look for the other 20-25% of the features in secondary, analogous art. It's very difficult, usually, to invalidate a design patent based on obviousness.⁵⁸

In *Whitman Saddle*, as apparent from the illustrated prior art, there is no *Rosen* reference. The Granger is only 50% of the patented design, as is the Jenifer. Absent a valid *Rosen* reference, there is no legitimate ground for holding the combination obvious.⁵⁹ Thus, Whitman's design, consisting of a novel and non-obvious combination, would today likely be held patentable.

Additionally, it is fairly clear from the record before the Supreme Court that the open slot in the bottom of the claimed design (seen clearly in Whitman's design patent drawings) was a significant design feature that had not previously

⁵³ Brief of Defendants/Third Party Plaintiffs - Appellees Swisa, Inc. and DROR Swisa at 8, 18, *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 2006-152 (Fed. Cir., Mar. 7, 2008) ("The modified version of the ordinary observer test would be at best an imprecise and unreliable replacement for the point of novelty test.") and ("Thus, under this less precise test - which would not identify what element was novel in the patented design and determine if it were present in the accused design - infringement could be found.")

⁵⁴ *Id.* at 8-9, 34 ("The [non-trivial advance] test reflects the principle that when such combinations are obvious in light of the prior art, they cannot be points of novelty for purposes of infringement without expanding the scope of design patents to embrace uninventive aspects of the design. This principle is solidly rooted in *Whitman Saddle*." and ("This non-trivial advance test applies the requirement that to infringe an accused design must appropriate what is inventive in the patented design, and the rest reflects the reasoning and holding in *Whitman Saddle*."))

⁵⁵ "There must be something akin to genius, an effort of the brain as well as the hand." *Whitman Saddle*, 148 U.S. at 679 quoting *Northrup v. Adams*, 12 O.G. 430, 2 Ban. & A. 567 (E.D. Mich. 1877).

⁵⁶ *Whitman Saddle*, 148 U.S. 682 ("...we not think that the addition of a known cantle to a known saddle, in view of the fact that such use of the cantle was common, in itself involved genius or invention, or produced a patentable design..")

⁵⁷ *In re Rosen*, 673 F.2d 388, 390 (C.C.P.A. 1982).

⁵⁸ See *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996); *In re Cho*, 813 F.2d 378 (Fed. Cir. 1987); *In re Harvey*, 12 F.3d 1061 (Fed. Cir. 1993).

⁵⁹ *Durling*, 101 F.3d at 104.

been combined with a Granger saddle.⁶⁰ Thus, there were actually 3 elements to the novel combination: the Jenifer cantle, the Granger saddle, and the open slot. Although open slots existed in the prior art in other saddles, and the Jenifer cantle existed in combination with other saddles, the weight of the evidence before the Court supports the conclusion that the combination of the Granger front half, the Jenifer rear half, and the open slot in the bottom, was a novel combination.

The Appellant Smith argued in its brief that the open-slotted Granger was prior art, but the evidence they relied on (vague testimony from one witness) was less than convincing.⁶¹ They then argued:

Whether or not the slot was left open in the Granger saddles is an immaterial matter. The patent in suit is not so limited; we could not avoid infringement simply by covering the slot. The *profile* is what Whitman states to be the material thing. (emphasis in original). Brief of Defendant-Appellant, *supra* note 43 at 26-27.

Using today's jurisprudence, the Appellant couldn't be more wrong. The Whitman patent states: "I am aware that portions of the curves employed by me have been used in the designing of saddles; but *when combined with a longitudinally-slotted tree*, the lines I employ to give

the profile form a new design for saddles..." (U.S. Pat. No. D10,844, col. 2, lines 8-12, emphasis added), clearly manifesting an intent to claim the combination. Looking at Whitman's patent drawings, the open slot is clearly material and claimed,⁶² and today must be reckoned with for patentability and infringement.⁶³ Concerning infringement, the open slot was clearly in the accused design, and Smith may well have avoided infringement by covering it up, but they did not. Concerning patentability, there surely is no *Rosen* reference for the combination of the Granger saddle, the Jenifer cantle, and the open slot.

The Supreme Court agreed with the Appellant's argument about the open slot: "The presence or the absence of the central open slot was not material..." 148 U.S. at 770, dismissing it entirely as a factor in patentability and infringement. This would not be the case today.⁶⁴

Thus, if the case were decided using present day standards for patentability, the drop in the pommel would not alone render "... the design... patentable as a complete and integral Whole". Rather, the overall design, including the Granger front half, Jenifer rear half, and longitudinal slot, would be material elements rendering the design patentable.

Thus, had these facts been presented today, the design patent of Whitman would be found valid and infringed

⁶⁰ See Brief of Plaintiff - Appellee, *supra* note 47, at 21-26.

⁶¹ Brief of Defendant - Appellant, *supra* note 45, at 20 ("Int. 97. As regards the Granger saddles which you testify that you knew of prior to 1875, were they or were they not made up with the central slot left open? Ans. My impression is that they were left open.") Relying only on this testimony, i.e., in the absence of any other evidence in the record, Smith contended that the Granger saddle made up with an slot open was in the prior art. *Id.* at 24.

⁶² U.S. Pat. No. D10,844 col.2 L5-7 (filed Sept. 2, 1878) ("A plan view of the saddle shows a center longitudinal slot extending from pommel to cantle.")

⁶³ See discussion *supra* note 40.

⁶⁴ *Contessa Food Products, Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1378 (Fed. Cir. 2002.) ("Our precedent makes clear that all of the ornamental features illustrated in the figures must be considered in evaluating design patent infringement.")

using the 3-way test, an outcome which would not at all be certain using the point of novelty test.

C. The Point of Novelty Test Simply Doesn't Work

The arguments advanced by *Swisa & Egyptian Goddess* concerning *Whitman Saddle* demonstrate exactly why the point of novelty test does not work, because the outcome depends on the uncertain formulation of the point of novelty.

A classic point of novelty analysis applied to the *Whitman Saddle* facts might today result in a finding of no infringement in spite of the fact that 90% of the novel and unobvious patented design was found in the accused design, as is apparent from comparing the visual appearance of the patented and accused designs. Smith's accused design altered a visually insignificant feature of the patented design, the pommel drop – one that Smith's lawyers focused on (probably because it was mentioned in Whitman's specification, and perhaps that's all they had to argue), and escaped liability. This is the unjust result of the point of novelty test that the 3-way test would remedy. Under the 3-way test, as mentioned previously, infringement would likely be found because the accused design and patented design are much closer to each other than either is to the prior art.

If the point of novelty test had been established in 1893, Smith would have argued exactly like *Swisa* and *Winner*: the Granger half is old, the Jenifer half is old, the open slot is old, and the only thing that's new is the pronounced pom-

mel drop. Thus, the pronounced pommel drop is the point of novelty and since it's not found in the accused design, there can be no infringement.⁶⁵

Just looking at the Supreme Court's words in its *Whitman Saddle* decision makes that argument facially very attractive because each design feature (the Granger half, the Jenifer half, the open slot, the pommel drop) is given equal weight in words. But that is not the case when the appearance of these features is viewed, since it then becomes apparent that the pommel drop is a visually insignificant feature in view of the overall designs, and that 90% of the patented design is found in the accused design. And after all, this is a case about the visual appearance of products, so words alone are a relatively poor substitute for how the designs look.⁶⁶

In contrast to Smith, Whitman would have argued (like *Lawman* and *Egyptian Goddess*) that the combination of the Granger saddle with the Jenifer cantle and the open slot was in fact novel, and the point of novelty consisted of that combination, which was not in the prior art. Thus, they'd argue, since this point of novelty was found in the accused design, infringement is made out. Looking at the overall designs, Whitman might characterize the pommel drop as an insignificant visual feature, as *Egyptian Goddess* might characterize the absence of a pad on the 4th side of their patented nail buffer, in formulating its point of novelty.

So, as occurs today in many design patent litigations, the winner of the battle as to whose point of novelty is the "cor-

⁶⁵ This conclusion springs from a listing of the 3 individual features as points of novelty, to be knocked down like bowling pins by an accused infringer armed with individual pieces of prior art. See discussion *supra* note 39.

⁶⁶ See *Dobson v. Dornan*, 118 U.S. 10, 14 (1886) ("[The design] is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration.") (emphasis added).

rect" point of novelty would likely win the case. As noted previously, an informed plaintiff likely presents the point of novelty as a combination of elements (which is inherently more difficult to attack as not being novel), while the defendant presents a list of the individual "points" of novelty (which are inherently easier to attack and avoid).⁶⁷ There is no case law on the "correct" way to formulate the point(s) of novelty.

D. Conclusion

The 3-way visual comparison of the patented design, the accused design and the prior art⁶⁸ makes all the difference to the fact finder: it is clear from the illustrations gleaned from Court records in

Whitman Saddle that the accused design and patented design are much closer to each other than either is to the prior art, that 90% of the claimed design is visually found in the accused design, and that the pommel drop "b" is so visually insignificant as to be barely noticeable.

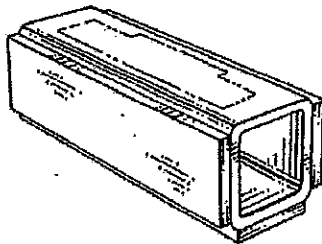
The inherent uncertainty in modern day *Whitman Saddle* situations by controverted formulations of the point of novelty can be avoided by using the 3-way test.

VI. What About Egyptian Goddess?

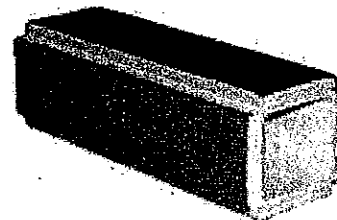
Are the accused design and the patented design *visually* closer to each other, or closer to the prior art?

You be the judge.

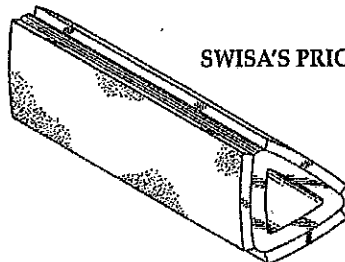
PATENTED DESIGN



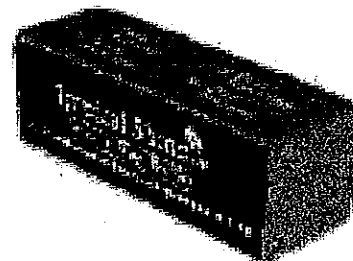
ACCUSED DESIGN



SWISA'S PRIOR ART



EGYPTIAN GODDESS' PRIOR ART



⁶⁷ See discussion *supra* note 39.

⁶⁸ See discussion *supra* §V. A.