

Texas Intellectual Property Law Journal
Spring 2011

Article

**THE PROPER ROLE OF FUNCTIONALITY IN DESIGN PATENT INFRINGEMENT ANALYSIS: A CRITICISM
OF THE FEDERAL CIRCUIT DECISION IN RICHARDSON V. STANLEY WORKS, INC.**

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***310 I. Introduction**

Design patents, those that are granted on the ornamental design of an article of manufacture, are a close relative of utility patents.¹ In both utility and design patent infringement litigation, courts first construe the claims and then the fact-finder compares the accused infringing product to the construed claims.² However, due to design patents' morphed nature and their history of ambiguous case law, the test for determining design patent infringement remains problematic. At first blush, the en banc decision in *Egyptian Goddess, Inc. v. Swisa, Inc.* by the Court of Appeals for the Federal Circuit clarified the test for determining design patent infringement.³ Yet, only two years after the *Egyptian Goddess* decision, the Federal Circuit decision in *Richardson v. Stanley Works, Inc.* shed light on the numerous inconsistencies and fallacies of the current design

patent infringement test once courts attempted to account for functionality issues in their infringement analysis.⁴

The Federal Circuit in Richardson affirmed a district court's claim construction, where the district court "filtered out" the functional aspects from the ornamental aspects of the patented design.⁵ The Federal Circuit also affirmed the district court's application of the ordinary observer test, which discounted and ignored individual functional elements of the claimed design.⁶ After the Federal Circuit panel decision, Richardson filed a petition for rehearing en banc, arguing that it is improper to make functionality determinations as a question of law during claim construction and equally improper for the fact-finder to filter out individual functional elements of a claimed design when comparing the accused device to the patented design.⁷ This petition was supported by amicus briefs from the American Intellectual Property Law Association (AIPLA)⁸ and from Apple, Inc.⁹ The AIPLA brief argued that functionality is not a question of law for the court to decide during *311 claim construction, but is a question of fact best left for the fact-finder to assess.¹⁰ The AIPLA amicus brief also argued that the Federal Circuit erroneously created a "points of ornamental" type of claim construction, similar to the recently rejected "point of novelty" test and counter to the idea that a design patent protects a design's overall appearance.¹¹ The petitioners argued that the ordinary observer test announced by the Supreme Court in Gorham Co. v. White¹² should apply to the patented design as a whole, even when the design has individual functional elements.¹³ The Federal Circuit subsequently denied the petition for rehearing en banc,¹⁴ therefore, the issue remains an open topic for debate.

This note investigates the current debate surrounding the role of functionality in the design patent infringement analysis. The first section discusses the Federal Circuit's en banc decision in Egyptian Goddess and the test for design patent infringement after the court's decision.¹⁵ The note then discusses the recent decision in Richardson and the current debate over the role of functionality in infringement analysis.¹⁶ Finally this note argues that, contrary to the holding in Richardson, functionality issues should not play a role in claim construction. Moreover, the fact-finder should not filter individual functional elements of a claimed design when comparing the accused design to the construed claim for substantial similarity.¹⁷ This note then concludes by delineating the proper role of functionality in the design patent infringement analysis and recommends that the Federal Circuit finds an opportunity to clarify the role of functionality in the infringement analysis of design patents and reverse case law to the extent that it conflicts with this proper role.

II. Design Patent Infringement Analysis After the Egyptian Goddess En Banc Decision

The analysis for design patent infringement is similar to the analysis for utility patent infringement. The analysis is two-fold: first, a court must construe the patented design claim and second, the fact-finder must compare the accused design to the construed claim to determine if there is substantial similarity.¹⁸ The Federal *312 Circuit granted rehearing en banc in Egyptian Goddess in order to settle the debate on the proper standard for design patent infringement.¹⁹ The court addressed several key questions apropos of this two-part analysis including whether a district court should perform formal claim construction in design patent cases and what the standard should be for determining substantial similarity between an accused design and a construed claim.²⁰ These two issues are discussed separately in the following sections.

A. Design Patent Claim Construction After Egyptian Goddess

By granting rehearing en banc in Egyptian Goddess, the Federal Circuit considered whether district courts should continue formal claim construction with design patent claims similar to the claim construction analysis associated with utility patents.²¹ Design patents frequently claim the designs as shown in the patent drawings, which courts then adapt for trial.²² For example, in Contessa Food Products, Inc. v. Conagra, Inc., the Federal Circuit affirmed the district court's claim construction of the design claim--"the ornamental design for a serving tray with shrimp, as shown and described"²³--to mean "a tray of a certain design, as shown in Figures 4-5, containing shrimp arranged in a particular fashion, as shown in Figures 1-3."²⁴ On the other hand, some courts attempt to provide a detailed verbal description of a claimed design, similar to what would normally occur with a utility patent.²⁵ For example, the district court in Egyptian Goddess construed the design claim--"[t]he ornamental design for a nail buffer, as shown and described"²⁶--to mean:

A hollow tubular frame of generally square cross section, where the square has sides of length S, the frame has a length of approximately 3S, and the frame has a thickness of approximately T = 0.1S; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately 1.25T, and the inner corner of the cross section rounded on a 90 degree radius of approximately 0.25T; *313 and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with

the fourth side of the frame bare.²⁷

There are clear differences between the two styles of claim construction. The first example references the design patent figures while the second example is a detailed verbal description of the design patent figures. In light of the major differences in design patent claim construction, the Federal Circuit sitting en banc in Egyptian Goddess sought to provide guidance on whether district courts should provide detailed verbal descriptions of the claimed design similar to the claim construction in utility patent cases, or whether district courts should adopt the claim as phrased in the design patent which references the design patent's figures.²⁸

The en banc court held that preferably, district courts should refrain from attempting to construe a design patent claim by providing a detailed verbal description of the patented design;²⁹ however, a detailed verbal claim construction is still within the trial court's discretion because verbal claim construction can be a useful tool for the trial court to "guide the finder of fact by addressing a number of . . . issues that bear on the scope of the claim."³⁰ Furthermore, the court stated, "[t]hose include such [issues] as . . . distinguishing between those features of the claimed design that are ornamental and those that are purely functional."³¹ For this proposition, the court relied on the Federal Circuit's decision in OddzOn Prods., Inc. v. Just Toys, Inc.: "[w]here a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent."³² Thus according to the en banc Egyptian Goddess decision, for the first step of the infringement analysis, district courts have discretion to conduct a detailed verbal claim construction that distinguishes functional features from ornamental features of a claimed design.³³

B. The Standard for Comparing a Construed Claim to an Alleged Infringing Product for Substantial Similarity after Egyptian Goddess

The en banc Egyptian Goddess court also addressed the standard for comparing a construed claim to an alleged infringing design.³⁴ This part of the test asks ***314** whether there is substantial similarity between the accused design and the claimed design.³⁵ In 1871, the Supreme Court in Gorham set forth the test to determine whether two designs are substantially the same.³⁶ In that case, the plaintiff, Gorham, had secured a design patent in 1861 for a specific handle design for silverware.³⁷ In 1867 and 1868, White, the defendant, secured design patents bearing some resemblance to the Gorham patent.³⁸ Figure 1 shows the Gorham and White designs.³⁹

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After Gorham brought suit against White for design patent infringement, the sole question for the Court was whether White's designs were substantially the same as the Gorham design.⁴⁰ The Court held, "if, in the eye of the ordinary observer, giving ***315** 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 . . ."⁴¹ This test has since been referred to as the "ordinary observer" test,⁴² and had remained the sole test for determining whether two designs are substantially the same for over one hundred years until the 1984 Federal Circuit opinion in Litton Systems, Inc. v. Whirlpool Corp.⁴³

Litton Systems is cited for the Federal Circuit's adoption of the "point of novelty" test.⁴⁴ According to the Litton Systems court, in order for a design to be infringed, 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."⁴⁵ The court adopted this separate test to limit a design patent's scope of protection when the design field is crowded with prior art references.⁴⁶ The Federal Circuit granted rehearing en banc in Egyptian Goddess to decide whether, in order to prove infringement, the patentee must satisfy the point of novelty test in addition to the ordinary observer test.⁴⁷

In Egyptian Goddess, the court rejected the point of novelty test, which required the patentee to point out the novel aspects of the claimed design and identify them in the alleged infringing product.⁴⁸ Instead the court held that "in accordance with Gorham . . . the 'ordinary observer' test should be the sole test for determining whether a design patent has been infringed."⁴⁹ The court found that the point of novelty test could be problematic when there are several points of novelty, because in using the point of novelty test, the court might shift its focus from whether the accused design appropriated the patented design as a whole to whether the accused design had appropriated a single feature of the patented design.⁵⁰ In addition, the court noted that when several points of novelty exist in a claimed design, an accused infringer can argue that the accused design does not copy all points of novelty and thus does not infringe, even though the accused design incorporates most points of novelty and

has an overall appearance substantially similar to the patented *316 design.⁵¹ The Egyptian Goddess Court noted that the underlying rationale for the point of novelty test can still be served by applying the ordinary observer test “through the eyes of an observer familiar with the prior art.”⁵² Therefore, after the en banc decision in Egyptian Goddess, the second part of the design patent infringement analysis requires “an ordinary observer, familiar with the prior art designs, . . . be deceived into believing that the accused product is the same as the patented design.”⁵³

The Federal Circuit’s en banc Egyptian Goddess decision appears to have clarified issues regarding the design patent infringement analysis for future litigants. According to Egyptian Goddess, (1) a district court may distinguish functional aspects from ornamental aspects during claim construction, and (2) the ordinary observer test is the sole test for determining substantial similarity.⁵⁴ Unfortunately, less than two years later, the problematic Richardson v. Stanley Works, Inc. decision highlighted the serious flaws in such an analysis when courts attempt to address functionality issues.⁵⁵ Furthermore, the Richardson decision raises questions as to the extent Egyptian Goddess overturned prior Federal Circuit case law.⁵⁶ The next section discusses the Richardson case, the district court’s application of the infringement analysis, and the Federal Circuit’s opinion on appeal.

III. The Background of Richardson v. Stanley Works Inc.

David Richardson sued Stanley Works claiming infringement of his design patent (‘167 patent) by certain tools that Stanley Works manufactured and sold (Stanley FUBAR).⁵⁷ Figures 2 and 3 are representative of the figures in the ‘167 patent.⁵⁸

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*317 Figures 4 and 5 show representative figures of the accused product, the Stanley FUBAR.⁵⁹

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During a bench trial, the district court first construed the ‘167 patent claim and then compared the accused device to the construed claim in order to determine substantial similarity.⁶⁰

A. The District Court’s Claim Construction

The claim in Richardson’s design patent read: “[t]he ornamental design for a multi function stud climbing and carpentry tool, as shown and described.”⁶¹ Rather than adopting the design claim language to mean the ornamental design shown in the patent figures, the district court decided to distinguish between the functional *318 elements and the non-functional elements of the design according to the decisions in Egyptian Goddess and OddzOn.⁶²

The district court ultimately held: (1) the overall configuration of the handle, hammer-head, jaw and crow-bar was dictated by function, and (2) the design of the jaw element was also primarily influenced by function and was thus not protected by the ‘167 patent.⁶³ The court determined that the overall configuration was functional because a designer would naturally and inevitably configure these elements in the same manner and because there was prior art combining similar elements that used the exact same configuration.⁶⁴ The jaw design was functional because marketing for the tool promoted the tool’s ability to be used as a step “by slotting the jaw over exposed wood framework and then stepping up onto the handle.”⁶⁵ Thus the design required “two straight sides that could slot over a wooden board at a right angle to the handle.”⁶⁶

Therefore, the court held that the ‘167 patent did not protect the overall configuration or the jaw design.⁶⁷ However, the court held that the ‘167 patent did protect “the standard shape of the hammer-head, the diamond-shaped flare of the crow-bar and the top of the jaw, the rounded neck, the orientation of the crow-bar relative to the head of the tool, . . . the plain, undecorated handle [and] the [jaw’s] particular number and size of teeth.”⁶⁸ The judge then proceeded to the second part of the infringement analysis by comparing the construed claim to the accused products.⁶⁹

B. The District Court’s Comparison of the Accused Device and the Construed Claim

In the second step of the infringement analysis, the district court judge found that the Stanley FUBAR was not substantially similar to the ‘167 patent design.⁷⁰ In making this determination, the court applied the ordinary observer test and noted that

the “appearance of a design as a whole . . . is controlling in determining infringement.” *319 ⁷¹ However, the court also quoted language from *Amini Innovation Corp. v. Anthony California, Inc.*, that “the trial court is correct to factor out the functional aspects of various design elements,” but that discounting of functional elements “must not convert the overall infringement test to an element-by-element comparison.”⁷²

In applying the test, the district court found that the similarity between the Richardson design and the Stanley FUBAR was limited to the overall configuration of elements and the design of the jaw element.⁷³ However, the court held earlier in the claim construction that the ‘167 patent did not protect the overall configuration or the jaw.⁷⁴ Thus, the similarities in the overall configuration and the jaw element did not weigh in favor of infringement.⁷⁵ The court then found little similarity between the rest of the Richardson design and the Stanley FUBAR.⁷⁶

Richardson argued that the functional elements of his design should be included when comparing it to the Stanley tools.⁷⁷ The court rejected this argument, responding, “Richardson’s argument distorts functionality beyond all recognition.”⁷⁸ The court reasserted that “[t]he trial court is correct to factor out the functional aspects of various design elements.”⁷⁹ The court quoted language from *OddzOn* that “[t]he patentee must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental”⁸⁰ and language from *Lee v. Dayton-Hudson Corp.*, that “it is the non-functional, design aspects that are pertinent to determinations of infringement.”⁸¹ Therefore, with the finding of noninfringement, Richardson appealed to the Federal Circuit.⁸²

***320 C. The Appeal to the Federal Circuit**

On appeal, the Federal Circuit panel affirmed the district court decision. The Federal Circuit expressly held that the district court “properly factored out the functional aspects of Richardson’s design as part of its claim construction.”⁸³ The panel held that ornamental designs containing functional aspects are entitled to a design patent whose scope is limited to the ornamental aspects and does not extend to any functional elements of the claimed article.⁸⁴ For the second step of the infringement analysis, the court held that the ordinary observer test applies even in cases where the patented design has numerous functional elements.⁸⁵ The question, the court stated, is whether the deception is a result of the similarities in the overall design, not whether it is a result of similarities in ornamental features in isolation.⁸⁶ The court then affirmed the district court’s finding of noninfringement, stating that “ignoring the functional elements of the tools, the two designs are indeed different.”⁸⁷

Accordingly, the Federal Circuit affirmed both the district court’s claim construction and its finding of noninfringement.⁸⁸ The district court construed the claim in accordance with the recent *en banc* decision in *Egyptian Goddess*, which held that it was proper to distinguish between functional and ornamental aspects of the claimed design.⁸⁹ The district court’s comparison of the accused design to the construed claim, however, seems very much at odds with the *Egyptian Goddess* decision. Both the district court and Federal Circuit panel agreed that it was the overall design that was essential in the second step of the infringement analysis, yet both courts also discussed factoring out functional elements or ignoring functional elements when conducting the ordinary observer test.⁹⁰ Nevertheless, this note argues *321 that upon closer inspection, both steps of the Richardson infringement analysis are seriously flawed.

IV. The Proper Role of Functionality in the Design Patent Infringement Analysis

The errors in the infringement analysis for design patents have evolved over time due to the ambiguous language within a series of Federal Circuit opinions. In Richardson, the district court’s infringement conclusion may have ultimately been a correct conclusion as to infringement, but nevertheless portions of the court’s infringement analysis are seriously flawed. Since the Federal Circuit panel affirmed both the claim construction methodology and the finding of noninfringement,⁹¹ there is a potential that district courts will continue to follow Richardson’s flawed analysis.

The infringement analysis for design patents is comprised of two parts: (1) claim construction, a question of law, and (2) a comparison of the accused design to the construed claim, a question of fact.⁹² First, contrary to the decision in *Egyptian Goddess*, a court should not consider functionality issues during the claim construction analysis. Second, while functionality has a role in the second step of the analysis, it is improper to filter out or ignore individual functional elements from the patented design when comparing it to the alleged infringing design.

A. Functionality Should Not Play a Role in Claim Construction.

First, functionality is a question of fact, whereas claim construction is a question of law. Functionality has consistently been held as a question of fact in the design patent invalidity context.⁹³ Furthermore, claim construction is a question of law to be determined by the trial court judge.⁹⁴ Therefore, it would make little sense to reserve questions of functionality in the invalidity context to the fact-finder, but allow a judge to answer questions of functionality during the claim construction process. Second, the Richardson court relied on Egyptian Goddess and OddzOn when distinguishing the functional features from the ornamental features during claim construction.⁹⁵ However, this proposition evolved from the OddzOn court's error in interpreting Lee v. Dayton-Hudson Corp.⁹⁶

*322 The current proposition that claim construction requires a district court to distinguish functional features from ornamental features owes its origins to an error in interpreting the Federal Circuit's decision in Lee. In Lee, the patentee was appealing the district court decision of noninfringement of his design patent which covered a massage device.⁹⁷ Figures 6 and 7 show Lee's patented design and the accused product, respectively.⁹⁸

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Lee argued his design patent that covered a massage device, consisting of an elongated handle with two opposing balls at one end, was infringed by a device with the same configuration.⁹⁹ He argued that the design patent protected the basic configuration rather than the surface details identified by the district court.¹⁰⁰ The Federal Circuit rejected Lee's argument by distinguishing design patent claims from utility patent claims,¹⁰¹ holding that “[d]esign patents do not and cannot include claims to the structural or functional aspects of the article.”¹⁰² In addition, 37 C.F.R. § 1.153(a) states that a design patent claim “shall be in formal terms to the ornamental design for the article . . . as shown, or as shown and described.”¹⁰³ The *323 Federal Circuit in OddzOn interpreted the language in Lee to mean that “the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”¹⁰⁴ However, the Lee court never distinguished functional elements from the claimed design during claim construction.¹⁰⁵ Rather, the Lee court was merely countering the patentee's argument that the design patent covered his overall configuration--a “device wherein an elongated handle has two opposing balls at one end.”¹⁰⁶ The court was emphasizing that design patent claims use formal terms claiming the ornamental design rather than the formal terms found in utility patents, claiming structural or functional aspects of the device.¹⁰⁷ Importantly, when the Lee court held that “it is the non-functional, design aspects that are pertinent to determination of infringement,” the court was affirming the district court's application of the ordinary observer test, which is the second part of the infringement analysis.¹⁰⁸ Thus, the Lee court reserved issues of functionality for the comparison step rather than the claim construction step of the infringement analysis.¹⁰⁹ By relying on OddzOn's misinterpretation of Lee, the Egyptian Goddess court created dicta that further complicated the correct application of the infringement analysis when functionality issues are present.¹¹⁰ Therefore, the Egyptian Goddess Court should not have relied on OddzOn for the proposition that a district court should distinguish between features of the claimed design that are ornamental and those that are functional during claim construction.¹¹¹

Furthermore, the Richardson district court and Federal Circuit panel erroneously considered functionality issues during claim construction.¹¹² Functionality should have no role in claim construction. A practical problem emerges when functionality is presented as a question of law during claim construction, but shifts to a question of fact in an invalidity analysis. Additionally, the mistaken interpretation of Lee by the court in OddzOn, and the Egyptian Goddess court's reliance on OddzOn, further implicate the proposition that including functionality in claim construction *324 is erroneous. Rather, as the Lee court suggested, any functionality inquiries are factual questions that should be left for the comparison step of the infringement analysis.¹¹³

B. Individual Functional Elements Should Not be Filtered Out or Ignored When Comparing the Accused Device to the Construed Claim

In the second step of the infringement analysis, the fact-finder compares the accused design to the construed claim with the ordinary observer test.¹¹⁴ In the proper application of the ordinary observer test, the fact-finder should only consider functionality to the extent that the patented design's overall configuration is functional.¹¹⁵ Therefore, the fact-finder should not make functionality findings regarding individual elements of the claimed design. Furthermore, filtering or ignoring individual functional elements from the claimed design undermines the proper application of the ordinary observer test.¹¹⁶ Thus, the district court in Richardson erred by first determining that the jaw element was functional and then filtering it from

the patented design when applying the ordinary observer test.¹¹⁷

The critical issue with functionality in design patent infringement is whether the overall configuration is dictated by function, not whether individual elements of the claimed design are functional.¹¹⁸ The Federal Circuit in Lee recognized that functionality should only be a consideration in the ordinary observer test when the design's overall configuration is dictated solely by function.¹¹⁹ The court recognized that "it has long been settled that when a configuration is the result of functional considerations only, the resulting design is not patentable as an ornamental design."¹²⁰ Further, "[t]o hold that general configuration made necessary by function must give to the patented design such breadth as to include everything of similar *325 configuration, would be to subvert the purpose of the law."¹²¹ The Lee court, in recognizing the role of functionality in the infringement analysis, did not suggest that a district court should filter or ignore individual functional elements during the comparison of the accused design to the claimed design. Rather, only when the overall configuration is functional, that is, not part of the design, the accused device must also copy the ornamental aspects of the patented design "such that the overall resemblance is such as to deceive."¹²² Thus, the Federal Circuit in L.A. Gear, Inc. v. Thom McAn Shoe Co. held:

[T]he utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. In determining whether a design is primarily functional or primarily ornamental 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.¹²³

Moreover, filtering or ignoring functional elements runs counter to the proper application of the ordinary observer test. The Federal Circuit case law has consistently held that, in comparing the accused design to the construed design claim, the ordinary observer test applies to a design's overall appearance.¹²⁴ The Supreme Court in Gorham held that the test for substantial similarity is "identity of appearance, or sameness of effect upon the eye" from the perspective of the ordinary observer.¹²⁵ In addition, the Egyptian Goddess en banc decision reaffirmed that the Gorham test was the sole test for determining substantial similarity.¹²⁶ Filtering or ignoring any element, let alone individual functional elements, from a construed claim before applying the ordinary observer test inevitably changes the overall appearance of the patented design. In addition, it is not hard to imagine a scenario where each and every element of a design may be considered functional. In these instances, every element would be factored from the claimed design and there would be nothing left to compare to the accused design.¹²⁷ Therefore, the Egyptian *326 Goddess decision should overturn previous case law suggesting that filtering or ignoring individual functional elements is a proper part of the ordinary observer test.

Unfortunately, the district court and the Federal Circuit in Richardson failed to limit the functionality inquiry to the overall configuration. The district court first determined that the overall configuration of the '167 patent was dictated solely by function, but continued its inquiry.¹²⁸ The district court then determined that the jaw element of the '167 patent was also functional and held that the '167 patent did not protect this part of the design.¹²⁹ The Federal Circuit should have reversed the district court, but rather agreed that, "ignoring functional elements of the tools, the two designs are indeed different."¹³⁰ In filtering and ignoring the functional elements, the district court and Federal Circuit in Richardson both erroneously relied on ambiguous and unsupported dicta in Amini Innovation Corp. v. Anthony Cal., Inc.¹³¹ The Richardson district court also erroneously interpreted OddzOn and Lee as support for Amini's proposition that filtering individual functional elements is proper.¹³² Thus the Federal Circuit in Richardson should have reversed the district court for filtering and ignoring individual functional elements while applying the ordinary observer test.

The Federal Circuit in Amini held that "[t]he trial court is correct to factor out the functional aspects of various design elements, but that discounting of functional elements must not convert the overall infringement test to an element-by-element comparison."¹³³ Unfortunately, the panel court did not provide further explanation or reasoning for this proposition and thus the meaning and rationale for this proposition are unclear.¹³⁴ In addition, the Amini Court failed to cite any source for this proposition and used the terms "aspects" and "elements" interchangeably, aggrandizing the ambiguity of the court's meaning.¹³⁵ Upon further analysis of the district court decision in Amini, it becomes clear that the district court never attempted to "factor out the functional aspects of various design elements."¹³⁶ Since this Federal *327 Circuit language in Amini is irrelevant to the district court decision, the language--"[t]he trial court is correct to factor out the functional aspects of various design elements, but that discounting of functional elements must not convert the overall infringement test to an element-by-element comparison"--is merely ambiguous and unsupported dicta.¹³⁷ Thus, the district court and the Federal Circuit panel in Richardson should not have relied on the language for the proposition that filtering individual functional elements is a proper part of applying the ordinary observer test.¹³⁸

The Richardson district court also relied on language from Lee and OddzOn in rejecting Richardson's argument that functional elements must be included when comparing it to the Stanley FUBAR.¹³⁹ The Richardson district court quoted Lee--“[t]hus it is the non-functional, design aspects that are pertinent to determinations of infringement”--to support the dicta in Amini.¹⁴⁰ However, the Lee court used this language to reject the patentee's argument that his overall configuration was protected as his design.¹⁴¹ The Lee court made clear that when only the overall configuration of a design is considered functional, that configuration is no longer considered part of the design and thus held, “it is the non-functional, design aspects that are pertinent to determinations of infringement.”¹⁴² The Lee court did not suggest that filtering individual functional elements from the design was proper. Therefore, the district court's reliance on Lee to support the language in Amini was misplaced.¹⁴³

The district court's reliance on OddzOn was also misplaced.¹⁴⁴ OddzOn involved a design patent infringement suit brought by a toy manufacturer against a competing toy company.¹⁴⁵ Figures 8 and 9 show the patentee's patented design and product, respectively.¹⁴⁶

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*328 Figure 10 shows the accused infringing design.¹⁴⁷

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In the second part of the infringement analysis, the OddzOn court quoted the language in Read, that a patentee “must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental.”¹⁴⁸ In applying this language, the OddzOn court recognized that the tail and fins on the patentee's design added stability when the football was thrown, similar to the tails and fins on darts or rockets.¹⁴⁹ Thus, the overall configuration of the football, tail, and fins was functional.¹⁵⁰ Therefore, the court held that such a design patent could not be infringed solely because the accused design copied the same configuration, but the patentee would need to submit evidence establishing that the ornamental aspects accounted for the similarity perceived by the *329 ordinary observer, similar to the decision in Lee.¹⁵¹ The OddzOn court properly recognized that the functional configuration of the overall article did not invalidate a design patent, but merely limited the scope of the protected subject matter.¹⁵² Although the OddzOn court misinterpreted Lee as to design patent claim construction as discussed earlier, the court nevertheless recognized that the issue of functionality in design patent infringement only plays a role in the comparison of the accused product to the construed claim when the overall configuration of a design is considered functional.¹⁵³ Thus, the Richardson district court similarly misinterpreted the OddzOn decision as support for Amini's proposition that filtering functional elements was proper when applying the ordinary observer test.¹⁵⁴

Accordingly, the fact-finder should only consider functionality to the extent that the patented design's overall configuration is functional.¹⁵⁵ Filtering or ignoring individual functional elements from the claimed design subverts the proper application of the ordinary observer test. Thus, the district court in Richardson should have relied on Lee and recognized that functionality should only play a role in the ordinary observer test when the overall configuration of the patented design is found to be purely functional.¹⁵⁶ The patentee must then show that any substantial similarity between the accused design and the patented design is not a result of the overall configurations, but rather the overall appearance of the design.¹⁵⁷

V. Conclusion

Currently, unresolved issues in design patent infringement analysis may have devastating consequences for design patent owners. After the Federal Circuit's decision in Richardson, a district court may decide functionality issues during claim construction as a question of law, even when functionality has consistently been a question of fact. Moreover, the decision has undermined the proper application of the ordinary observer test. The ordinary observer test applies to the overall appearance of design, but when the fact-finder filters individual elements from the patented design, the overall appearance is inevitably altered. In extreme instances, it is possible for all individual elements to be considered functional and thus filtered or ignored during the comparison, leaving nothing left to compare. Rather, the court should limit the scope of the fact-finder's functionality inquiry to whether the *330 design's overall configuration is functional. Limiting the functionality inquiry to the overall configuration helps prevent design patent protection from overlapping with utility patent protection while not undermining the ordinary observer test. This can properly be done through jury instructions. For example:

1. First, determine whether or not the overall configurations of the patented design and accused design are purely functional.
2. If the overall configurations are not purely functional, then determine whether or not the patented design is substantially similar to the accused design.
3. If the overall configurations of the patented design and accused design are purely functional, then--without taking into account the similarity between the overall configurations--determine whether or not the patented design is substantially similar to the accused design.

There is a proper role for functionality in the design patent infringement analysis. However, the morphed nature of design patents has led to erroneous and ambiguous Federal Circuit case law. Once again, the Federal Circuit should take an opportunity to clarify the infringement analysis and overturn case law that conflicts with the proper infringement analysis.

Footnotes

¹ J.D., Chicago-Kent College of Law 2011; USPTO registered agent; B.S., Biology and M.S., Biomedical Engineering, University of Texas at Arlington. I would like to thank Richard Stockton from Banner & Witcoff, Christopher Carani from McAndrews, Held & Malloy, and Professor David Schwartz from Chicago-Kent College of Law, for their support and contributions to this note.

² See 35 U.S.C. § 171 (2006) (stating that generally the provisions relating to patents for inventions also apply to patents for designs).

³ See Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 683 (Fed. Cir. 2008) (en banc) (addressing the appropriate legal standards in claims of design patent infringement).

⁴ See Richardson v. Stanley Works, Inc., 597 F.3d 1288, 1295 (Fed. Cir. 2010) (discussing the infringement analysis for design patents), reh'g en banc denied, (May 24, 2010).

⁵ *Id.* at 1296.

⁶ *Id.*

⁷ Petition for Rehearing En Banc at 6, Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010), reh'g en banc denied, (May 24, 2010) (No. 2009-1354).

⁸ Brief of Amicus Curiae American Intellectual Property Law Ass'n in Support of the Petition for Rehearing En Banc, Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010), reh'g en banc denied, (May 24, 2010) (No. 2009-1354).

⁹ Brief of Amicus Curiae Apple Inc. in Support of Plaintiff-Appellant's Petition for Rehearing En Banc, Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010), reh'g en banc denied, (May 24, 2010) (No. 2009-1354).

¹⁰ Brief of Amicus Curiae American Intellectual Property Law Association in Support of the Petition for Rehearing En Banc, supra note 8, at 9.

¹¹ Brief of Amicus Curiae American Intellectual Property Law Association in Support of the Petition for Rehearing En Banc, supra note 8, at 2.

¹² Gorham Co. v. White, 81 U.S. 511, 528 (1871).

¹³ Petition for Rehearing En Banc, *supra* note 7, at 8; Brief of Amicus Curiae Apple Inc. in Support of Plaintiff-Appellant's Petition for Rehearing En Banc, *supra* note 9, at 2.

¹⁴ Richardson v. Stanley Works, Inc., 597 F.3d 1288, 1288 (Fed. Cir. 2010), *reh'g en banc* denied, (May 24, 2010).

¹⁵ Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 668 (Fed. Cir. 2008) (en banc).

¹⁶ Richardson, 597 F.3d at 1294-96.

¹⁷ See *id.* at 1293-96 (discussing analysis of functionality).

¹⁸ See Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed. Cir. 1995) (citations omitted) (discussing design patent infringement analysis).

¹⁹ Egyptian Goddess, 543 F.3d at 670.

²⁰ *Id.*

²¹ *Id.* at 679.

²² *Id.* at 679; see also 37 C.F.R. § 1.153(a) (2011) ("No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article ... as shown, or as shown and described. More than one claim is neither required nor permitted."); U.S. Patent and Trademark Office, Manual of Patent Examining Procedure § 1503.01 (8th ed., Rev. 8, July 2010) ("[A]s a rule the illustration in the drawing views is its own best description.").

²³ U.S. Patent No. D404,612 at [57] (filed Mar. 3, 1998) (issued Jan. 26, 1999).

²⁴ Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1377 (Fed. Cir. 2002), abrogated by Egyptian Goddess, 543 F.3d 665 (Fed. Cir. 2008).

²⁵ See, e.g., Egyptian Goddess, Inc. v. Swisa, Inc., No. 3:03-CV-0594-N, 2005 WL 5873510, at *1 (N.D. Tex. Dec. 14, 2005), aff'd, 543 F.3d 665 (Fed. Cir. 2008) (providing a verbal description of the design).

²⁶ U.S. Patent No. D467,389 at [57] (filed Feb. 13, 2002) (issued Dec. 17, 2002).

²⁷ Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 668 (Fed. Cir. 2008).

²⁸ *Id.* at 679.

²⁹ *Id.* at 679-80 ("[A]s a general matter, [district] courts should not treat the process of claim construction as requiring a detailed

verbal description of the claimed design, as would typically be true in the case of utility patents.”).

³⁰ Id. at 680.

³¹ Id.

³² Id. (citing *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)) (internal quotation marks omitted).

³³ *Egyptian Goddess*, 543 F.3d at 680.

³⁴ Id. at 672-79.

³⁵ Id. at 672.

³⁶ *Gorham v. White*, 81 U.S. 511, 528 (1871).

³⁷ Id. at 512.

³⁸ Id.

³⁹ Id. at 521.

⁴⁰ Id. at 513.

⁴¹ Id. at 528.

⁴² See, e.g., *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (referring to the standard as the “ordinary observer” test).

⁴³ See *id.* at 670 (discussing the use of the other test in *Litton Systems*); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (applying a separate test in addition to the ordinary observer test).

⁴⁴ *Egyptian Goddess*, 543 F.3d at 670-71.

⁴⁵ *Litton Systems*, 728 F.2d at 1444 (emphasis added).

⁴⁶ Id.

⁴⁷ *Egyptian Goddess*, 543 F.3d at 668.

⁴⁸ Id. at 672.

⁴⁹ Id. at 678.

⁵⁰ Id. at 677.

⁵¹ Id.

⁵² Id.

⁵³ Crocs, Inc. v. Int'l Trade Comm'n, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (citing Egyptian Goddess, 543 F.3d at 678-81), reh'g en banc denied, (May 20, 2010).

⁵⁴ Egyptian Goddess, 543 F.3d at 678.

⁵⁵ Richardson v. Stanley Works, Inc., 597 F.3d 1288, 1290-92 (Fed. Cir. 2010), reh'g en banc denied, (May 24, 2010).

⁵⁶ Id.

⁵⁷ Richardson, 597 F.3d at 1295-96; Richardson v. Stanley Works, Inc., 610 F. Supp. 2d 1046, 1048-49 (D. Ariz. 2009), aff'd, 597 F.3d 1288 (Fed. Cir. 2010).

⁵⁸ U.S. Patent No. D507,167, fig.1, fig. 2 (filed Jan. 9, 2004) (issued July 12, 2005).

⁵⁹ U.S. Patent No. D562,101, fig.1, fig.5 (filed Mar. 29, 2006) (issued Feb. 19, 2008).

⁶⁰ Richardson, 610 F. Supp. 2d at 1049-53.

⁶¹ '167 Patent, at [57].

⁶² Richardson, 610 F. Supp. 2d at 1049 ("Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.") (quoting Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 680 (Fed. Cir. 2008)) (internal quotation marks omitted).

⁶³ Id. at 1050 ("The '167 patent does not protect the configuration of the handle, hammer-head, jaw, and crow-bar" and the "basic, wrench-like design is functional and therefore not protected by the '167 patent.").

⁶⁴ Id.

⁶⁵ Id.

⁶⁶ Id.

67 Id.

68 Richardson, 610 F. Supp. 2d at 1049.

69 Id. at 1051-52.

70 Id. at 1052.

71 Id. at 1051.

72 Id. at 1052 (quoting *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006)) (emphasis added).

73 Id. at 1051.

74 Richardson, 610 F. Supp. 2d at 1051.

75 Id. at 1052.

76 Id.

77 Id.

78 Id.

79 Id. (quoting *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006)).

80 Richardson, 610 F. Supp. 2d at 1052 (quoting *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)) (emphasis in original) (internal quotation marks omitted).

81 Id. (quoting *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1186 (Fed. Cir. 1988)).

82 *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1290 (Fed. Cir. 2010), reh'g en banc denied, (May 24, 2010).

83 Id. at 1293.

84 Id. at 1294 (“The elements of the design may indeed serve a utilitarian purpose, but it is the ornamental aspect that is the basis of the design patent.” (citing *L.A. Gear, Inc. v. Tom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993))).

85 Id. at 1295 (citing *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006)).

86 Id. (quoting *Amini Innovation*, 439 F.3d at 1371).

87 Id. at 1296 (emphasis added).

88 Richardson, 597 F.3d at 1298.

89 Id. at 1293 (“Although we proposed that the preferable course ordinarily will be for a district court not to attempt to construe a design patent claim, we also emphasized that there are a number of claim scope issues on which a court’s guidance would be useful to the fact finder. Among them ... is the distinction between the functional and ornamental aspects of a design.” (citing Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679 (Fed. Cir. 2008))).

90 Richardson, 597 F.3d at 1295-96 (holding that “[i]n evaluating infringement, we determine whether the deception that arises is a result of the similarities in the overall design,” yet the panel also found that “ignoring the functional elements of the tools, the two designs are indeed different.”) (internal quotation marks omitted); Richardson v. Stanley Works, Inc. 610 F. Supp. 2d 1046, 1051-52 (D. Ariz. 2009), aff’d, 597 F.3d 1288 (Fed. Cir. 2010) (holding that “it is the appearance of a design as a whole which is controlling in determining infringement[,]” yet the court also stated “[t]he trial court is correct to factor out functional aspects of various design elements” and “[i]n discounting the functional elements, the trial court must not convert the overall infringement test to an element-by-element comparison”) (internal quotation marks omitted).

91 Richardson, 597 F.3d at 1293, 1296.

92 Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1574 (Fed. Cir. 1995).

93 PHG Techs., LLC v. St. John Cos., 469 F.3d 1361, 1365 (Fed. Cir. 2006).

94 Elmer, 67 F.3d at 1574.

95 Richardson, 610 F. Supp. 2d at 1049.

96 838 F.2d 1186 (Fed. Cir. 1988).

97 Id. at 1187.

98 U.S. Patent No. D259,142 fig.2 (filed Nov. 24, 1978) (issued May 5, 1981) (Lee’s patented design); U.S. Patent No. D274,555 fig.2 (filed Mar. 11, 1982) (issued July, 3 1984) (the accused product).

99 Lee, 838 F.2d at 1188.

100 Id. (emphasis added).

101 Id.

102 Id. (emphasis added).

¹⁰³ 37 C.F.R. § 1.153(a) (2011) (emphasis added).

¹⁰⁴ OddzOn Prods, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997).

¹⁰⁵ See Lee, 838 F.2d at 1187 (omitting any discussion about distinguishing functional elements from the claimed design during claim construction).

¹⁰⁶ *Id.* at 1188.

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ See *id.* (discussing functionality in the context of design elements).

¹¹⁰ Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc) (“[A] trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those include such matters as ... distinguishing between those features of the claimed design that are ornamental and those that are purely functional.” (citing OddzOn Prods, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997))).

¹¹¹ *Id.*

¹¹² Richardson v. Stanley, Inc., 597 F.3d 1288, 1293 (Fed. Cir. 2010), *reh’g en banc denied*, (May 24, 2010); Richardson v. Stanley, Inc., 610 F. Supp. 2d 1046, 1049 (D. Ariz. 2009), *aff’d*, 597 F.3d 1288 (Fed. Cir. 2010).

¹¹³ See Lee, 838 F.2d at 1188 (affirming the district court’s comparison of the accused design to the patented design and stating that “it is the non-functional, design aspects that are pertinent to determinations of infringement”).

¹¹⁴ Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed. Cir. 1995).

¹¹⁵ Gorham Co. v. White, 81 U.S. 511, 528 (1871) (describing the test as “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”); L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) (“In determining whether a design is primarily functional or primarily ornamental 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.”) (emphasis added).

¹¹⁶ See Gorham, 81 U.S. at 528 (articulating the ordinary observer test).

¹¹⁷ Richardson, 610 F. Supp. 2d at 1051-52.

¹¹⁸ See Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed. Cir. 1988) (describing the relationship between general configuration and utility).

¹¹⁹ *Id.*

¹²⁰ Id. (quoting *In re Carletti*, 328 F.2d 1020, 1022 (C.C.P.A. 1964)).

¹²¹ Id. (quoting *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933)).

¹²² Id. at 1189 (“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.” (quoting *Gorham Co. v. White*, 81 U.S. 511, 528 (1871))).

¹²³ *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (citations omitted).

¹²⁴ See, e.g., *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1578 (Fed. Cir. 1995) (“Under Gorham, the focus is on the overall ornamental appearance of the claimed design”).

¹²⁵ *Gorham*, 81 U.S. at 527-28.

¹²⁶ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc).

¹²⁷ Christopher Carani, the author of AIPLA’s amicus brief in support of Richardson’s petition for rehearing en banc, posed a hypothetical where a design’s overall configuration is arbitrary but each individual element is potentially purely “functional.” The hypothetical highlights the dangers to design patent owners when courts allow individual functional features to be filtered out or ignored, as the overall appearance is distorted or there is nothing left to compare to the accused device. Brief of Amicus Curiae American Intellectual Property Law Association in Support of the Petition for Rehearing En Banc, *supra* note 8, at 6-9.

¹²⁸ Id.

¹²⁹ Id. at 1052.

¹³⁰ *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010), reh’g en banc denied, (May 24, 2010).

¹³¹ *Id.*; *Richardson*, 610 F. Supp. 2d at 1052.

¹³² *Richardson*, 610 F. Supp. 2d at 1052 (quoting *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)); *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1186 (Fed. Cir. 1988).

¹³³ *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006).

¹³⁴ Id.

¹³⁵ Id.

¹³⁶ *Amini Innovation Corp. v. Anthony Cal., Inc.*, No. CV 03-849, 2004 WL 5545445, at *5, *9 (C.D. Cal Dec. 3, 2004).

¹³⁷ Amini, 439 F.3d at 1372.

¹³⁸ Richardson v. Stanley Works, Inc., 597 F.3d 1288, 1295 (Fed. Cir. 2010), reh'^g en banc denied, (May 24, 2010); Richardson v. Stanley Works, Inc., 610 F. Supp. 2d 1046, 1052 (D. Ariz. 2009), aff'd, 597 F.3d 1288 (Fed. Cir. 2010).

¹³⁹ Richardson, 610 F. Supp. 2d at 1052.

¹⁴⁰ Id. (quoting Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed. Cir. 1988)) (internal quotation marks omitted).

¹⁴¹ Lee, 838 F.2d at 1188.

¹⁴² Id. (emphasis added).

¹⁴³ Richardson, 610 F. Supp. 2d at 1052 (quoting Lee, 838 F.2d at 1188).

¹⁴⁴ Id. (quoting OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997)).

¹⁴⁵ OddzOn, 122 F.3d at 1400.

¹⁴⁶ Id. at 1399-1400.

¹⁴⁷ Id. at 1400.

¹⁴⁸ Id. at 1405 (quoting Read Corp. v. Portec, Inc., 970 F.2d 816, 825 (Fed. Cir. 1992)) (internal quotation marks omitted).

¹⁴⁹ Id. at 1406.

¹⁵⁰ Id.

¹⁵¹ OddzOn, 122 F.3d at 1406.

¹⁵² Id.

¹⁵³ Id.

¹⁵⁴ Richardson v. Stanley Works, Inc., 610 F. Supp. 2d 1046, 1052 (D. Ariz. 2009), aff'd, 597 F.3d 1288 (Fed. Cir. 2010) (quoting OddzOn, 122 F.3d at 1405).

¹⁵⁵ OddzOn, 122 F.3d at 1406; Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed. Cir. 1988) (citations omitted).

¹⁵⁶ Lee, 838 F.2d at 1188.

¹⁵⁷ OddzOn, 122 F.3d at 1406; Lee, 838 F.2d at 1188.