



INTELLECTUAL PROPERTY NEWS FROM CHAN LAW GROUP

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Lisa A. Karczewski is a member of our Patent Prosecution Practice Group. With eight years of experience in the specialty of intellectual property law, Ms. Karczewski has successfully prepared and prosecuted over one hundred patent applications in the technical areas of aerospace, biomedical, chemical, material sciences, and mechanical arts before the U.S. Patent and Trademark Office.

Federal Circuit Ruling Strengthens the Value of Design Patent Protection for Design Patent Owners

The design patent law landscape has undergone a significant change following a recent ruling by the U.S. Court of Appeals for the Federal Circuit (“CAFC”) rejecting the long-standing use of the “point of novelty” test in determining design patent infringement. This past September the CAFC ruled unanimously in Egyptian Goddess, Inc. v. Swisa, Inc. to set aside the “point of novelty” test as a “second and free-standing requirement for design patent infringement,” finding it inconsistent with the “ordinary observer” test of the U.S. Supreme Court decision Gorham v. White.

The CAFC held that the “ordinary observer” test should be the sole test for determining design patent infringement. Under the “ordinary observer” test, in which similarity is considered from the perspective of an ordinary observer

familiar with the art, the inquiry is whether there is any substantial similarity between the patented design and the accused design in the eye of an ordinary observer. In other words, “[w]hen the differences between the claimed and accused design(s) are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is close to the prior art designs, small differences between the accused design and the claimed invention are likely to be important to the eye of the hypothetical ordinary observer.” Infringement will not be found unless the accused article “embodies the patented design or any colorable limitation thereof.”

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Our Success Stories

Successfully represented East West Bank before the United States Patent and Trademark Office in cancelling the registered mark BRIDGELoAN.COM. East West Bank v. BridgeLoan Investors, Inc., Cancellation No. 92047561 (TTAB 2008). Opposing counsel: Schweitzer Cornman Gross & Bondell LLP, New York, NY.

Represented Executive Producer Randy Wooten and Orange Dot



Entertainment in the production and distribution of the documentary, The Mars Underground (2005), a Scott J. Gill film.

www.themarsunderground.com.

Successfully litigated a jewelry case against Kabana, Inc. and are very familiar with the law regarding jewelry. After first obtaining a stipulation from the plaintiff to substantially limit the number of jewelry

pieces at issue in the lawsuit, Chan Law Group obtained a settlement on favorable terms for an amount far less than what was sought in the plaintiffs' complaint, which resulted in the dismissal of all claims against the defendants. *Kabana, Inc. v. Arts Kingdom Jewelry Co., Ltd., et al.* Case No.: CIV 06-0679 JH(WDS). Opposing Counsel: Peacock Myers PC. ☑

Our Growing Team

Raymond K. Chan and Andrew D. Shupe join Chan Law Group

"We are very fortunate to have Raymond and Andrew join the firm," said Thomas Chan, Managing Partner. "Their legal experience and skills will accelerate the firm's abilities to service an increasingly international client base, particularly in the intellectual property arena. Raymond and Andrew have both shown great potential in their fields and will be a tremendous asset to the firm and its clients."



Raymond Chan's practice is focused on intellectual property litigation and patent prosecution. Raymond has successfully litigated patent, trademark and trade dress matters. He has also prepared patent applications for a wide range of inventions, including computer technology, e-commerce methods and medical devices. Raymond Chan is experienced in negotiating and preparing IP licenses. He was the General Counsel for American Products Company, Inc., a leading importer and distributor of aftermarket automotive accessories and an associate with Knobbe Martens Olsen & Bear, LLP. Raymond Chan received his B.S. in Biochemistry from the University of California, Los Angeles in 1996 and his J.D., with honors, from Fordham University School of Law in 2001.



Andrew Shupe's practice is focused on intellectual property and general business litigation. Prior to joining Chan Law Group, Andrew Shupe was an associate of Reuben, Raucher & Blum. Andrew Shupe received his B.F.A. in film from the University of Southern California in 1998 and his J.D. from University of California, Los Angeles in 2005. His publications include "Legal Malpractice: Court Must Decide for Whom Statute Tolls", (Co-Author with Stephen L. Raucher), Los Angeles Daily Journal, June 15, 2006. Andrew Shupe is also the chair-person of the Beverly Hills Bar Association's Blue Car Project, a program through which attorney volunteers teach high school students about the U.S. legal system and their legal rights. ☑

Chan Law Group Celebrates its 20TH Year Anniversary!

Imelda Flores, Manager, expresses her appreciation for the firm in observance of the firm's anniversary. "I would like to take this opportunity to express my heartfelt appreciation to you for giving me the opportunity to work for such a reputable firm. It's been 14 years since I've been with the company. On both a professional and personal level, I have only positive things to say about the firm. Chan Law Group has not only been my employer in the past 14 years, but it has also been my family.

When I began working here, I was hired as a Receptionist. Through hard work and perseverance the firm offered me the opportunity to gain knowledge and to advance within the firm. In 2004 I became an Office Adminis-

trator for the firm. We've been through difficult times but my desire has always been to strive and to take on challenges as they are presented to me for the well being of the firm. I believe that the firm has seen this and I was given the opportunity to take over all responsibilities related to the Office. I am not only the Office Administrator, but I also do the Bookkeeping, Human Resources, Payroll and have taken on many other responsibilities. My goal is to continue to be a part of the Chan Law Firm family and to always think of the welfare of the firm as well as its employees through respect and support.

I hope that you will continue to deposit the trust on me that you have until now. I want



to continue growing with the firm and hope to see another 14 years alongside the firm." ☑

Federal Circuit Ruling continued from page 1...

The CAFC pointed out that this new approach avoids "some of the problems created by the separate point of novelty test." For instance, under the former point of novelty approach, "the more novel the design, the more points of novelty that are identified, the more opportunities there are for a defendant to argue that its design does not infringe because it does not copy all of the points of novelty, even though it

may copy most of them and even though it may give the overall appearance of being identical to the claimed design." Thus, "unlike the point of novelty test, the ordinary observer test does not present the risk of assigning exaggerated importance to small differences between the claimed design and accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty."

On the issue of whether trial courts should conduct claim construction in design patent cases, the CAFC noted that while it has been held that trial courts have a duty to conduct claim construction in design patent cases, the court has not prescribed any particular form for such claim construction. The court emphasized that the trial court's decision regarding the level of detail to be used in

describing the claimed design is a matter “within the court’s discretion.”

The CAFC ruled instead of describing a patented design in words, “the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.” The CAFC pointed out that the trial court should recognize the risks entailed in a verbal description of the claimed design, “such as the risk of placing undue emphasis on particular features of the design” and the risk of focusing on each individually described feature in the verbal description rather than on the design as a whole.

Furthermore, the CAFC

acknowledged that the burden of proof as to infringement remains on the patentee. The CAFC ruled, however, if the accused infringer decides to rely on the comparison prior art as part of its defense against the infringement claim, the “burden of production of that prior art is on the accused infringer.”

The product design at issue in this case involved nail buffers. Egyptian Goddess makes a beauty supply product with raised, abrasive padding on three sides. The accused design, however, made by Swisa, has padding on all four sides. Last year the CAFC affirmed the district court ruling of non-infringement prior to granting a rehearing en banc to address the standards used to de-

termine design patent infringement. Here, the CAFC affirmed the district court ruling of non-infringement under the “ordinary observer” test in the form it has adopted as discussed above.

Prior to the Egyptian Goddess decision, many patent owners believed that the point of novelty analysis eroded design patents hence making them less valuable. This is not the case now as the court’s recent decision in Egyptian Goddess appears to only strengthen the value of design patent protection for design patent owners. Design patent owners should applaud this latest ruling as it shifts away from a controversial verbal approach to design patents to a more patentee-friendly visual approach. ☐



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About Chan Law Group LLP

Chan Law Group LLP is a highest rated business & full service intellectual property law boutique firm of highly experienced and effective attorneys assisting clients throughout the United States, China and the international community. For information regarding our firm, please visit us at

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