

# New Matter

New Matter is a trademark of the Minnesota Intellectual Property Law Association.

## December 2008

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PROPERTY LAW  
ASSOCIATION

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# President's Letter

Dear Colleagues,

First and foremost, I would like to thank Jeff Cameron for his superior service in 2007-2008 as the MIPLA President. Jeff did an excellent job of finishing the redesign of the MIPLA website and updating the newsletter. Additionally, Jeff presided over the launch of the MIPLA Cup, which provides an opportunity for the very talented moot court competitors we have locally to not only practice their moot court skills, but also compete for a generous check to help defray the costs in the ultimate competition.

In these challenging economic times, I encourage all the MIPLA members to take advantage of the Roundtables, the CLE's and the social events. Many of these events are included in your dues, and are an excellent way to stay in touch with our colleagues in the local patent bar. I encourage all of our members to visit the MIPLA website at [www.mipla.net](http://www.mipla.net) to stay on top of the committee meetings and roundtable discussions. Please contact me or a committee chair if you would like to take on a leadership role to any committee or MIPLA itself.

I wish everybody a happy holiday season, and a successful and prosperous 2009.

Sincerely,

Andy Sorensen  
2008-2009 MIPLA President

# Even Intellectual Property Law Has Fictional Characters

by Laurie Young of Nikolai & Mersereau PA

I recently attended a meeting of intellectual property attorneys where we discussed recent cases involving patents and trademarks. We discussed many cases that had been decided by the Federal Circuit and some of the other Circuit courts. One such case was the Egyptian Goddess case. This case sparked an intense discussion of the way infringement of design patents is now to be determined. During the discussion, I began wondering how this “new” test differs from the test to determine whether a trade dress has been infringed; for both the Egyptian Goddess test and that for trademarks/trade dress involves an examination conducted through the eyes of a fictitious person, otherwise known as the “ordinary observer.”

To start, design patent and trade dress protection must be defined; otherwise the differences in how to prove infringement will be fruitless. A design patent applies to “the design for an article, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods.” Manual of Patent Examining Procedure (citing In re Zahn, 617 F.2d 261, 204 USPQ 988 (CCPA 1980)). Trade dress applies to the design of or packaging for a product, including identifying characteristics or decorations which make the source of the product distinguishable from another. See Traffix Devices, Inc. v Mktg. Displays, Inc., 532 U.S. 23, 28, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001). The subject of a design patent receives pro-

tection for fourteen years starting from the time the patent issues. The subject of a trade dress receives protection under the Lanham Act if the owner of the product proves that first the product design/packaging has been placed in the stream of commerce and then that the product design/packaging is (1) not functional and (2) has acquired secondary meaning. *Id.* It is important to remember that at its heart, trade dress protection relates to source identification of a product and design patent protection relates to an inventive concept.

The Federal Circuit handed down the decision in Egyptian Goddess, Inc. v Swisa, Inc. on September 22, 2008. This case involved Egyptian Goddess’ design patent number 467,389 - a design for a nail buffer “consisting of a rectangular hollow tube having a generally square cross-section and featuring buffer surfaces on three of its four sides.” Egyptian Goddess, Inc. v Swisa, Inc., --- F.3d --- (Fed. Cir. 2008). The allegedly infringing product of Swisa consisted of “a rectangular, hollow tube having a square cross-section, but featuring buffer surfaces on all four of its sides.” *Id.* The Federal Circuit took this case as an opportunity to clarify how infringement of a design patent is to be determined. The Court was not satisfied with the previous methods of determining infringement.

Prior to the Egyptian Goddess decision there were two elements which had to be established to prove

infringement of a design patent. The first was the “ordinary observer test” established by the Supreme Court in Gorham Co. v White in 1871. This test states: “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 supposed it to be the other, the first one patented is infringed by the other.” Gorham Co. v White, 81 US 511, 518 (1871).

Subsequent to Gorham, the Federal Circuit held that a determination of design patent infringement required more than an evaluation of the “ordinary observer test.” The Federal Circuit in Litton Systems, Inc. held that the accused design must also “appropriate the novelty of the claimed design in order to be deemed infringing.” See Litton Systems, Inc. v Whirlpool Corp., 728 F.2d 1423 (Fed. Cir. 1984). The Federal Circuit believed the similarity must be attributed to “the novelty which distinguishes the patented device from the prior art.” Litton Systems, 728 F.2d at 1444. Therefore, since 1984, the standard for determining design patent infringement has been whether an accused design meets the “Ordinary Observer” test and the “Point of Novelty” test in view of the patented design.

However, while the Federal courts have been using this two-part test, the Court in Egyptian Goddess pointed out that requiring an application of the point of novelty test is inconsistent with the test set out by the Supreme Court in Gorham. The Egyptian Goddess decision states “the point of novelty test ... is

not needed to protect against unduly broad assertions of design patent rights.” Egyptian Goddess -- F.3d at --. Therefore, the only applicable test now for determining design patent infringement is the “Ordinary Observer” test. Which leads to the question, who is this “ordinary observer” in this “ordinary observer” test?

The test originally set out in Gorham states: “If in the eye of an ordinary observer, giving such attention as a purchaser usually gives ...” This test is extraordinarily similar to the test of infringement for trade dress. A determination of trade dress infringement, being part of trademark law and being able to invoke §43(a) of the Lanham Act, is decided based upon a likelihood of confusion analysis. See Wal-Mart Stores v Samara Brothers, 529 U.S. 205, 120 S. Ct. 1339, 146 L.Ed 182 (2000). “To demonstrate trademark infringement, the plaintiff must show that the use of the allegedly infringing trademark ‘is likely to cause confusion among the consumers regarding the origin of the goods...’” General Motors Corp. v Lanard Toys, Inc., 468 F.3d 405, 412 (6th Cir. 2006) (*citing* Daddy’s Junky Music Stores, Inc. v Big Daddy’s Family Music Center, 109 F.3d 275, 280 (6th Cir. 1997)). This analysis of likelihood of confusion must come after the product design/packaging is proven to be (1) non-functional and (2) has secondary meaning. Wal-Mart, 529 U.S. at 210. After the owner of the allegedly infringed trade dress has established these two elements, a likelihood of confusion analysis must be performed from the view point of the consumers regarding the product design/packaging.

Therefore, if the Federal Circuit returns to its design patent infringement roots from the Gorham decision and the courts use the analysis for trade dress infringement explained in Wal-Mart, then the ordinary observer is essentially the same for the infringement test of both design patents and trade dress namely, the consumer – or public. The only element which would differentiate the infringement test for trade dress and design patents is the secondary meaning analysis. While it is possible for trade dress to be initially protected by a design patent (so that the owner has some protection during the time the product acquires distinctiveness), using the ordinary consumer analysis could potentially lead to overlap and confusion between trademarks and patents infringement analysis.

However, the Federal Circuit, potentially recognizing the problem (or at least that is my hope) or recognizing the value of some consideration for the point of novelty evaluation, clarified the analysis that must be conducted under the Gorham ordinary observer test. As stated previously, Gorham defined the ordinary observer as an observer who “giv[es] such attention as a purchaser usually gives...” Gorham 81 US at 518. The Federal Circuit in Egyptian Goddess stated that the test to be applied is “an ordinary observer *with knowledge of the prior art designs.*” Egyptian Goddess --- F. 3d at --- (emphasis added). In Egyptian Goddess, the Federal Circuit explained that the “ordinary observer” test involves a consideration of the facts in view of an analysis common to patents, that of a person familiar with the art.

Utility patents already incorporate the perspective of “one of ordinary skill in the art” when determining obviousness. It only makes sense that design patents, which are still protected under the patent laws, would be viewed by “one of ordinary skill in the art” or “one with knowledge of the prior art;” for these two individuals are essentially the same. A person of ordinary skill in art is the fictitious person who understands the technology, science and general background of the patented subject matter. Just as a person with knowledge of the prior art is the fictitious person who understands and knows of similar designs and products which have been patented or are in the public domain.

It makes sense that the fictitious ordinary observer used for design patent infringement purposes is not the same as the ordinary purchaser used for trade dress likelihood of confusion infringement purposes. For trade dress to be federally protected, it must be in the stream of commerce subject to control by the Commerce Clause of the United States Constitution. Therefore, the subject of the trade dress must be in commerce, and hence used in public. There is no such use requirement for patents. For an article protected by a design patent, the patented subject matter may enter into the public domain only upon issuance. If the patentee never actually makes the patented article, it is possible that the actual patented matter may never enter into the stream of commerce where a purchaser, at any level, would have an opportunity to view such subject matter. Since it is possible that the patented matter would not enter into the public domain as a product,

where an ordinary purchaser would be aware of it, it would be fruitless for the purchaser to be the “ordinary observer” for which infringement of design patents is determined. In design patent infringement matters, infringement of a design patent should be considered by a person who has knowledge of similar design patents in the prior art.

The Federal Circuit did state in Egyptian Goddess that “[the point of novelty test] can be equally well served, however, by applying the ordinary observer test through the eyes of an observer familiar with the prior art.” Egyptian Goddess, -- F.3d at --. The ordinary observer, familiar with the prior art, is able to view the embodiments of the prior art as well as “any colorable imitation thereof.” Id. Therefore, the “new” ordinary observer is able to ascertain the novel features of the patented design without a separate test – such discernment is a part of the ordinary observer standard itself.

The ordinary observer, in trade dress infringement litigation, is the ordinary purchaser who may be subject to a likelihood of confusion. The ordinary observer, in design patent infringement, is an observer with knowledge of the prior art. This distinction clarifies how to prove infringement on many levels. One example would be: to establish design patent infringement, an expert’s testimony in the field of the design patent is probably enough to establish infringement of the design patent; while trade dress infringement probably still requires survey evidence as well as expert testimony. Expert testimony and survey evidence bring real people into the picture for both design patent infringement and trade dress infringement. But in every case, just as in most areas of law, the courts must put themselves in the shoes of a fictitious person and look through that fictitious person’s eyes to determine what that fictitious person would see.

## Minnesota Inventors Hall Of Fame

*by James Young of Westman Champlin & Kelly PA*

### **HONORS for the MN Creative!**

As IP attorneys, where would we be without our Minnesota inventors? Looking for work somewhere else, no doubt. That is not the case, however, thanks to the abundance of intellectual creativity found right here in Minnesota.

There are many ways to honor those creative individuals, ranging from a mere “thank you”, to a com-

pany bonus, to the pride of being named on an issued patent, and even to a MIPLA-acquired proclamation from the governor of the great State of Minnesota. Another way, for the most very special inventor/scientist, is a nomination in the Minnesota Inventors Hall of Fame (MIHF).

I am currently serving as president of the board member of the MIHF, and we are seeking nominations for candidates for election to the MIHF.

Please read on, and perhaps take a few moments to consider whom you might nominate. Call me with any questions about the process.

The Minnesota Inventors Hall of Fame is a Minnesota non-profit corporation. Its volunteer Board of Directors includes inventors, patent lawyers and members of the scientific community or the public.

The Minnesota Inventors Hall of Fame was established in 1976 for the purpose of honoring inventors generally and bringing to the attention of the public the economic and social importance of their contributions to society. This is done by identifying those Minnesota inventors who have made significant contributions to our society through their inventions.

The Minnesota Inventors Hall of Fame inductees are honored in an exhibit at the Redwood Area Community Center in Redwood Falls, MN. Each inductee is identified with a photograph and a bronze plaque summarizing their accomplishments. In addition, up to ten inductees are highlighted in the exhibit each year with more information about their accomplishments, and with photographs, patents, artifacts and examples of their work.

The most recent inductee into the MIHF is Rose Totino, the inventor of the first pizza dough suitable for freezing and subsequent baking. She co-founded Totino's Finer Foods with her husband (Totino's Finer Foods and the Totino's brand was later acquired by Pillsbury), and was an innovator

and entrepreneur who helped to introduce frozen pizza to America.

To be eligible for induction into the MIHF:

- A candidate is one who is an innovator, a creator, a solver of problems.

- A candidate is one who has made a significant contribution to the betterment of life - especially here in Minnesota.

- The impact of the candidate's contribution in the general economic sphere in terms of capital injected, business generated or jobs created.

- The impact in the social sphere in terms of improved quality of life through greater convenience, saving of time, better health, safety, superior products, etc.

- Most likely, the candidate's inventions will have had a significant impact in both economic and social areas.

- A candidate's contributions may be measured in terms of patents, but the number of patents, if any, is secondary to considerations of economic and social impact.

- A candidate regards himself/herself as a Minnesotan and is so recognized by others.

- A candidate has strong Minnesota ties through any

one or more of birth, education, long residence, employment, family relationships, or the like, but contributions for which he/she is honored need not be made in Minnesota.

More information about the MIHF can be found at its website: [www.minnesotainventors.org](http://www.minnesotainventors.org). The names of all the inductees are listed there, along with stories about many of them. In addition, you can fill out an electronic nomination form for the very special inventor of your choice. What could be easier?

For those who insist on making it more difficult, a nomination form follows this article. Please print it out, complete it and send it in. As for the March 31 deadline noted on the form, if you're lucky, we'll

grant you a retroactive extension of time (or your nominee will simply be considered next year, and you'll be one of the first to nominate someone). Either way, don't miss out on this opportunity to assist us in bestowing a great honor on those individuals who truly are "hall-of-fame" material.

Again – any questions? Please give me a call.

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# Rose Totino

## 2008 Minnesota Inventors Hall of Fame Inductee

Born Rosenella Cruciani, Rose Totino (1915 - 1994) was the uncontested queen of frozen pizza. She was the inventor of the first pizza dough suitable for freezing and subsequent baking. She was an innovator and entrepreneur who helped to introduce frozen pizza to America, and later improved the product. Her pizza, like Rose, was born and developed in Minnesota.



Rose was the fourth among seven in an Italian family in ethnic "Northeast" Minneapolis. Her mother made a small Italian pie made with sausage, cheese and a variety of sauces. Word spread that Rose was also skillful at making this small Italian pie, which we now call pizza.

She dropped out of school at age 16 and helped support her family by cleaning houses for \$2.50 a week. At age 19 she married Jim Totino, a baker. They dreamed of opening a restaurant, but needed \$1,500. Demonstrating the ingenuity that would make her famous, Rose baked a pizza and took it to a banker. Impressed, he loaned the couple the money they needed. In 1951, they opened one of the first pizzerias in Minneapolis and began selling pre-baked and ready-to-eat pizza as a take-out business. The recipe for the dough and topping were original.

The small pizza shop was successful from the first day. Rose and Jim originally intended to offer take-out pizzas only. But customers wanted a place to sit and eat the pizza on site, so the Totinos added tables and chairs and opened a restaurant, Totino's Italian Kitchen. Jim baked the crusts and Rose applied the sauce, making as many as 400 to 500 pizzas a day.

A decade later, in 1962, they started a separate business, Totino's Finer Foods, selling frozen pizza that could be baked at home. With a loan from the Small Business Administration, they bought an abandoned factory in St. Louis Park and began mass producing frozen pizza. They bought frozen crusts from Chicago and added the special topping in Minnesota. Rose insisted the crusts tasted like cardboard and called it "the industry standard cardboard crust." Nevertheless, Totino's became the first big name in the frozen pizza industry and a national phenomenon.

Not satisfied with the crust, Rose continuously strived to make it better. She experimented with processes for freezing her pizza products, but found it difficult to freeze the crust so that it would be crisp after home baking.

The business grew so much that in 1971 they built a \$2.5 million dollar plant in Fridley. Despite two plant expansions, Totino's Finer Foods could not meet the demand for frozen pizza. Jim's health failing, the Totinos analyzed the needs of their company, weighed their options and sold the company to the Minneapolis based-Pillsbury Company for \$22 million. Rose then became Pillsbury's first female corporate vice president.



Rose worked with Pillsbury scientists to perfect the crust. She and her colleagues devised a way to prepare pizza crust that is fried, rather than pre-baked. The crust was fried at the factory, making it more resistant to the ravages of freezing and thawing. The concept of frying the crust came from the pizzas Rose's mother had made at home. The result was a 1979 patent for a dough product specially designed for freezing and subsequent baking - a delamination resistant fried dough crust.

Jim died in 1981. Rose continued as a valued advisor and ambassador for Totino's products, and helped Pillsbury abandon the cardboard crusts and introduce Totino's "Crisp Crust" Pizza to the nation. The Totino's brand became part of General Mills with its acquisition of Pillsbury in 2001. Over 300 million Totino's pizzas are sold each year - more than 10 every second.

Over the years, the Totinos gave millions of dollars to charities and educational institutions in Minnesota. Because of their generosity, a high school now bears the Totino name. Grace High School in Fridley - named for a Catholic bishop - became Totino-Grace in 1980. The Totinos helped to finance a fine-arts center at Northwestern College in Roseville. They donated money to the Sharing and Caring Hands homeless shelter in Minneapolis, to a mental health center for adolescents in Fridley, and to others. They also paid for church repairs and a new school in the impoverished village of Scopoli, Italy, the birthplace of Rose's mother.

Rose died on June 21, 1994, at age 79. Her selection as only the third woman to be inducted into the Minnesota Inventors Hall of Fame recognizes her lifelong research, product improvement and extraordinary entrepreneurship.

NOTE: This biography has been compiled from information accompanying the nomination form submitted to the Minnesota Inventors Hall of Fame, information available on the Internet and from a variety of other sources.

# Minnesota Inventors Hall of Fame Nomination Form

You can send us information on someone you feel deserves to be an inductee of the Minnesota Inventor's Hall of Fame.

Name of Inventor: \_\_\_\_\_

Living?      Yes \_\_\_\_\_      No \_\_\_\_\_

If living, present address:

\_\_\_\_\_

If deceased, closest survivor's address or last known address of inventor:

\_\_\_\_\_

Approximate date of death: \_\_\_\_\_

Please list patents and/or description of invention(s):

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

To the extent applicable, and known, list any articles or books, or excerpts from same, written by or about the inventors with respect to his/her invention(s), any honors or awards received because of the invention(s), or any other pertinent information showing recognition and acceptance of the invention(s):

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

Please describe:

What contributions of this inventor you feel make him/her outstanding as a Minnesota inventor:

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Why do you believe this inventor should be inducted into the Minnesota Inventors Hall of Fame?

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Your Name: \_\_\_\_\_

Company or affiliation: \_\_\_\_\_

Address: \_\_\_\_\_

Phone: \_\_\_\_\_

Email: \_\_\_\_\_

Deadline is March 31st of each year. Mail to:

Minnesota Inventors Hall of Fame

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