Design Patent Judicial Decisions
A Year In Review

~ USPTO Design Day 2012 ~

Alan N. Herda
haynesboone
Setting precedent.

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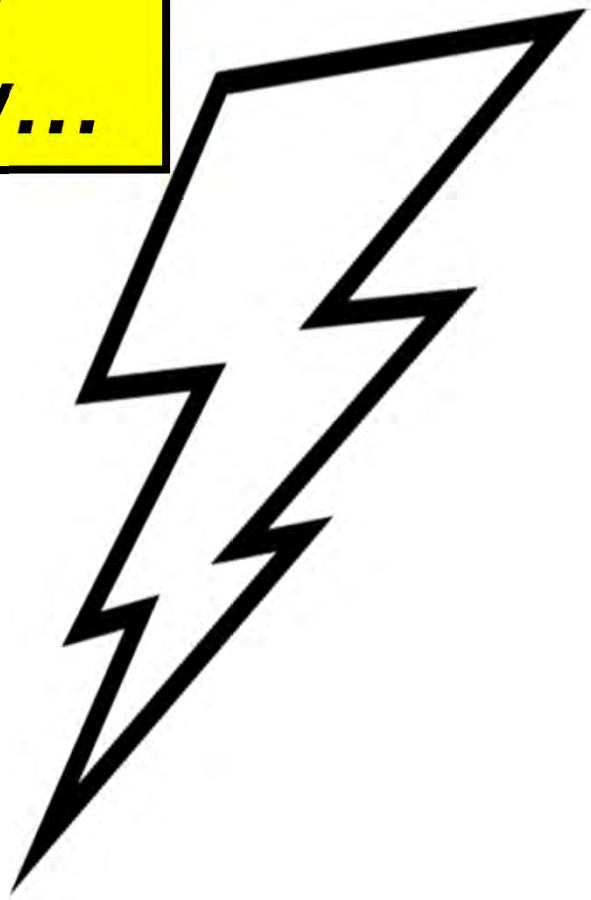
***Lightning* Fast Review of Current Design Patent Law…**



- ***Design patent infringement***
  - Claim Construction
  - Comparison of Construed Claim to Accused Design
- ***Design patent invalidity***
  - Functionality
  - Anticipation
  - Obviousness

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Lightning Review Design Patent Infringement:
Claim *CONSTRUCTION*

- "[A] design is better represented by an **illustration** 'than it could be by any description and a description would probably not be intelligible without the illustration.'"
- "[T]he **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 "decision to issue a relatively detailed claim construction will **not** be reversible error.")
- "A court may find it helpful to point out … various features of the claimed design as they relate to the accused design and the prior art."
- "[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 [including:]

  - **distinguishing** between those features of the claimed design that are ornamental and those that are purely functional, *see Oddzon Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) ("**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.**")."

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

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Lightning Review Design Patent Infringement:
COMPARISON of Claimed and Accused Designs!!

- The **ordinary observer test** is the sole test for determining whether a design patent has been infringed. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).

- The **O.O.T.**: "[I]f, 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." *Gorham Co. v. White*, 81 U.S. 511 (1871).

- Back to *Egyptian Goddess*:
  - "In other instances, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from **a comparison of the claimed and accused designs with the prior art**, as in many of the cases discussed above and in the case at bar."

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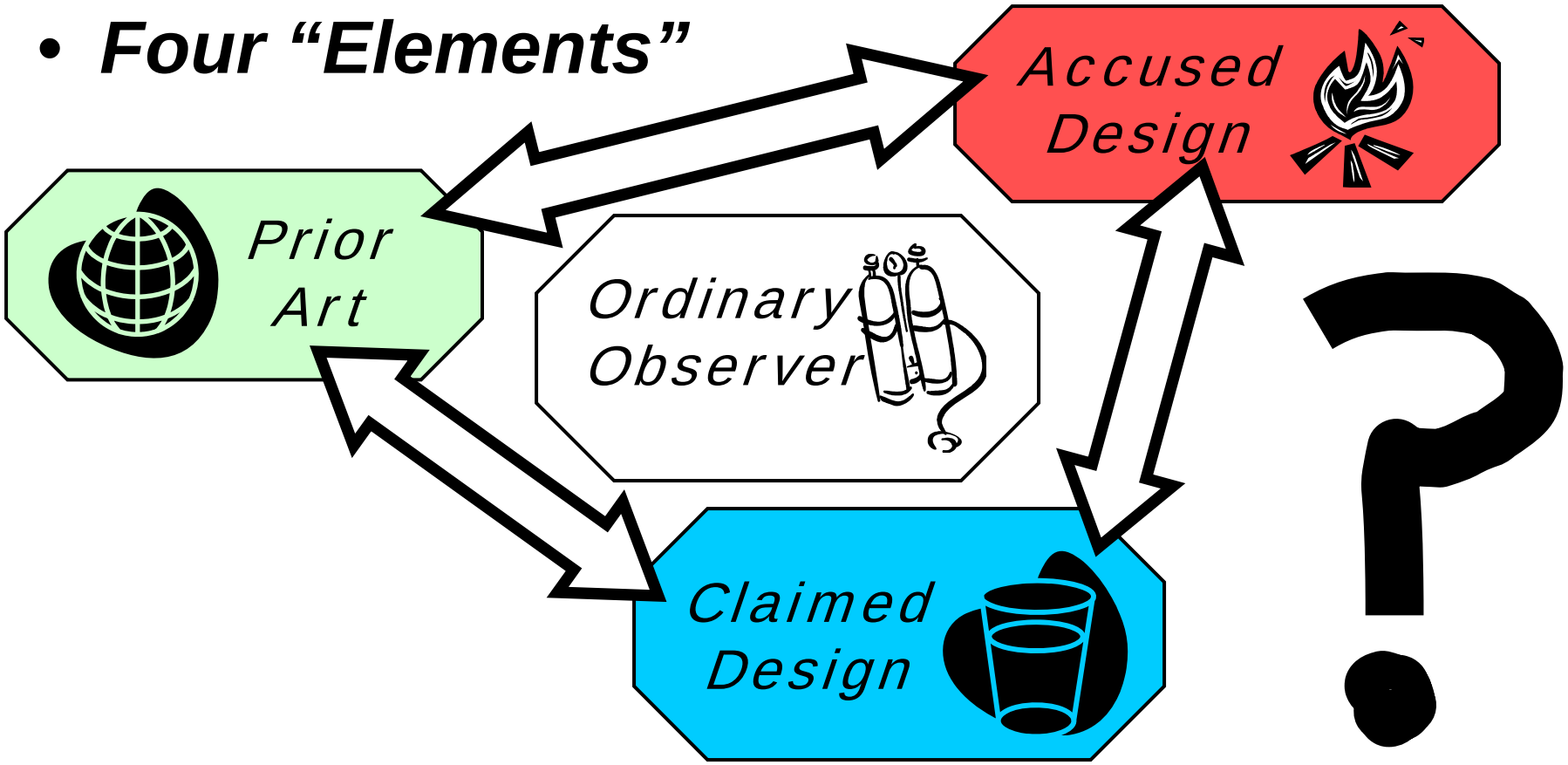
"[W]hen the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art."

- ***Four "Elements"***



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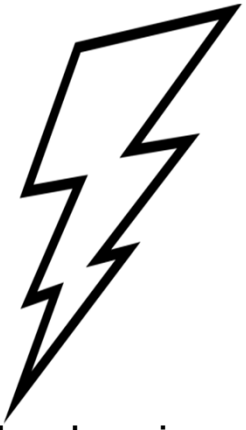
Lightning Review Design Patent Invalidity



- Invalidity based on **functionality:**
  - "To qualify for protection, a design must present an aesthetically pleasing appearance that is **not dictated by function alone**." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 148 (1989).*
- Invalidity based on **anticipation:**
  - "[D]esign patent anticipation requires a showing that a single prior art reference is '**identical in all material respects**' to the claimed invention." *Door-Master Corp. v. Yorktowne Inc., 256 F.3d 1308, 1312 (Fed. Cir. 2001)*.
  - But what about: "[T]he **ordinary observer** test must logically be the sole test for anticipation." *Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009).*
  - "identical in all material respects" = "substantially the same" ???

See Saidman, 83 PTCJ 278, 12/23/2011.

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Lightning Review Design Patent Invalidity

- Invalidity based on **obviousness**:
- ***In re Rosen, 673 F.2d 388 (C.C.P.A. 1982)***
  - "If this inquiry is to be made under 35 USC 103, it has recently been held by this court that the proper standard is whether the design would have been obvious to **a designer of ordinary skill of the articles involved**."
  - "In considering patentability of a proposed design the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings, and **compared with something in existence -- not with something that might be brought into existence by selecting individual features from prior art and combining them**."
  - "Thus there must be **a** reference, a something in existence, the design characteristics of which are **basically the same** as the claimed design in order to support a holding of obviousness.
  - "While a § 103 rejection of a claimed design need not be based on a single reference, … the long-standing test for the proper combination of references has been 'whether they are **so related** that the appearance of certain ornamental features in one would suggest the application of those features to the other.'"
- ***But what about: Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009)***
  - "For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references **to arrive at a single piece of art** for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been **constructed**, obviousness, like anticipation, requires application of the **ordinary observer** test, not the view of one skilled in the art."

See Saidman, 83 PTCJ 278, 12/23/2011.

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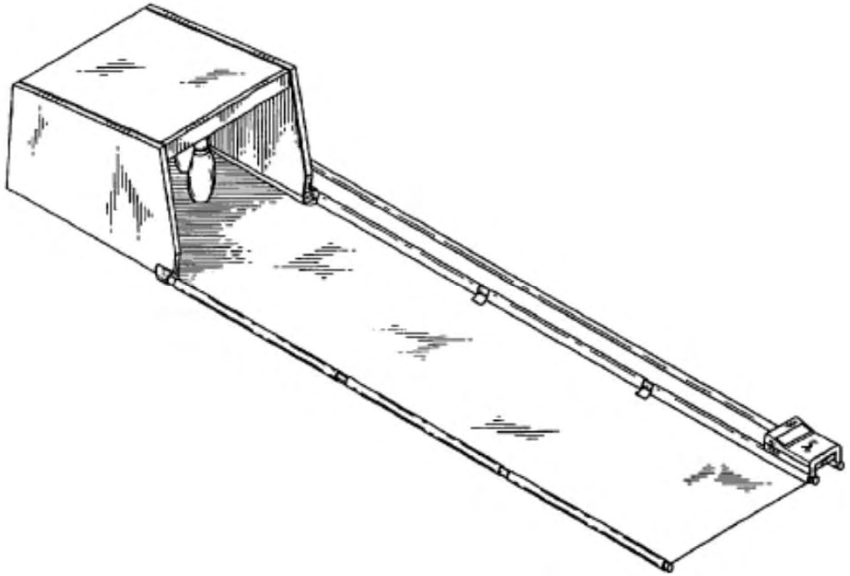
The year in review begins...

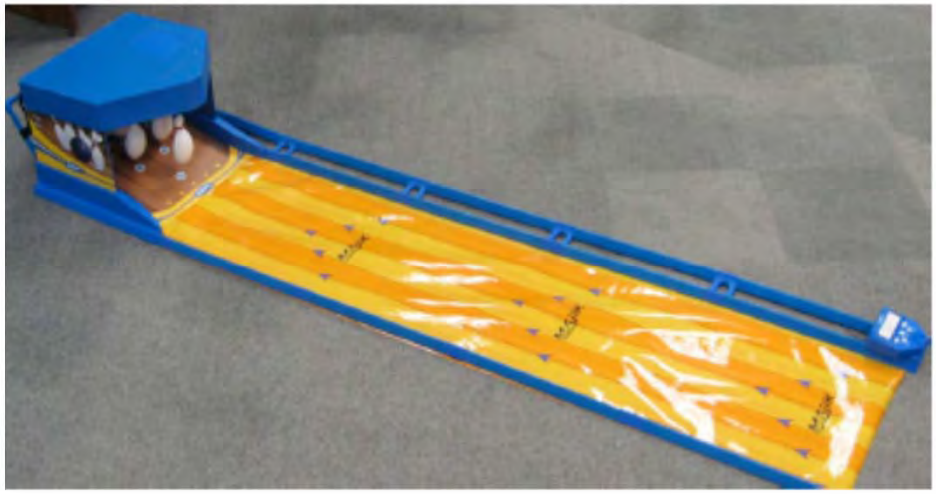
Moose Mountain Toymakers Ltd. v. Majik Ltd., LLC

No. 10-4934 (D. N.J. Aug. 12, 2011)

Claimed Design

Accused Design





Infringement?

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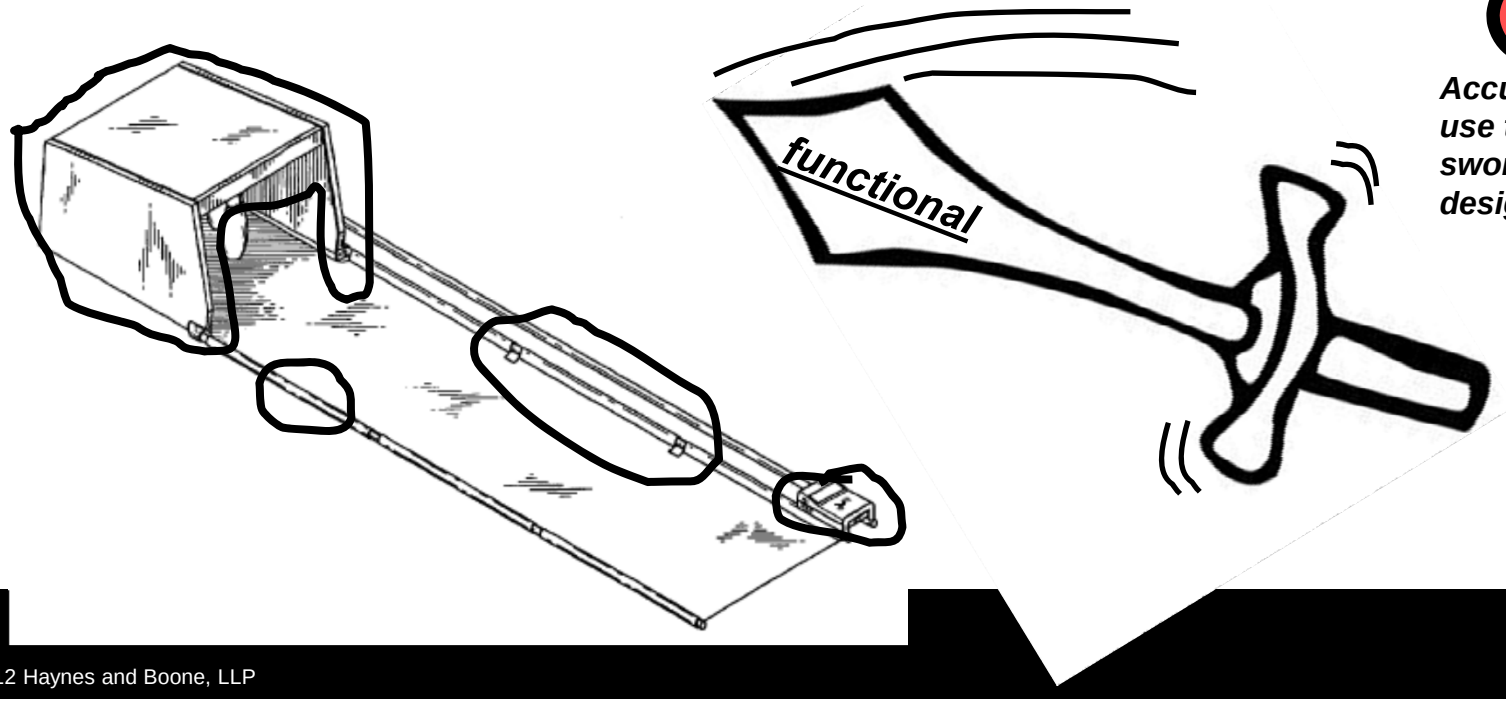
Claim Construction

•*"Accordingly, each of the Patents will be reviewed and the Court will* ***distinguish*** *the functional elements from those that are ornamental."*

•"**Functional aspects**" include: alley apron, alley side rails, sleeves, pins, enclosure, ball return track and game controller or console.

•*"Once these functional elements are* ***discounted****, the* ***remaining ornamental features*** *are: (1) the rectangular shape of the enclosure (2) the rounded alley side rails; and (3) the intermittent spacing of the sleeves of the alley apron within which the rounded alley side rails are received; and (4) the particular rectangular shape of the game console."*



Accused infringers: use the "functional" sword to divide the design!

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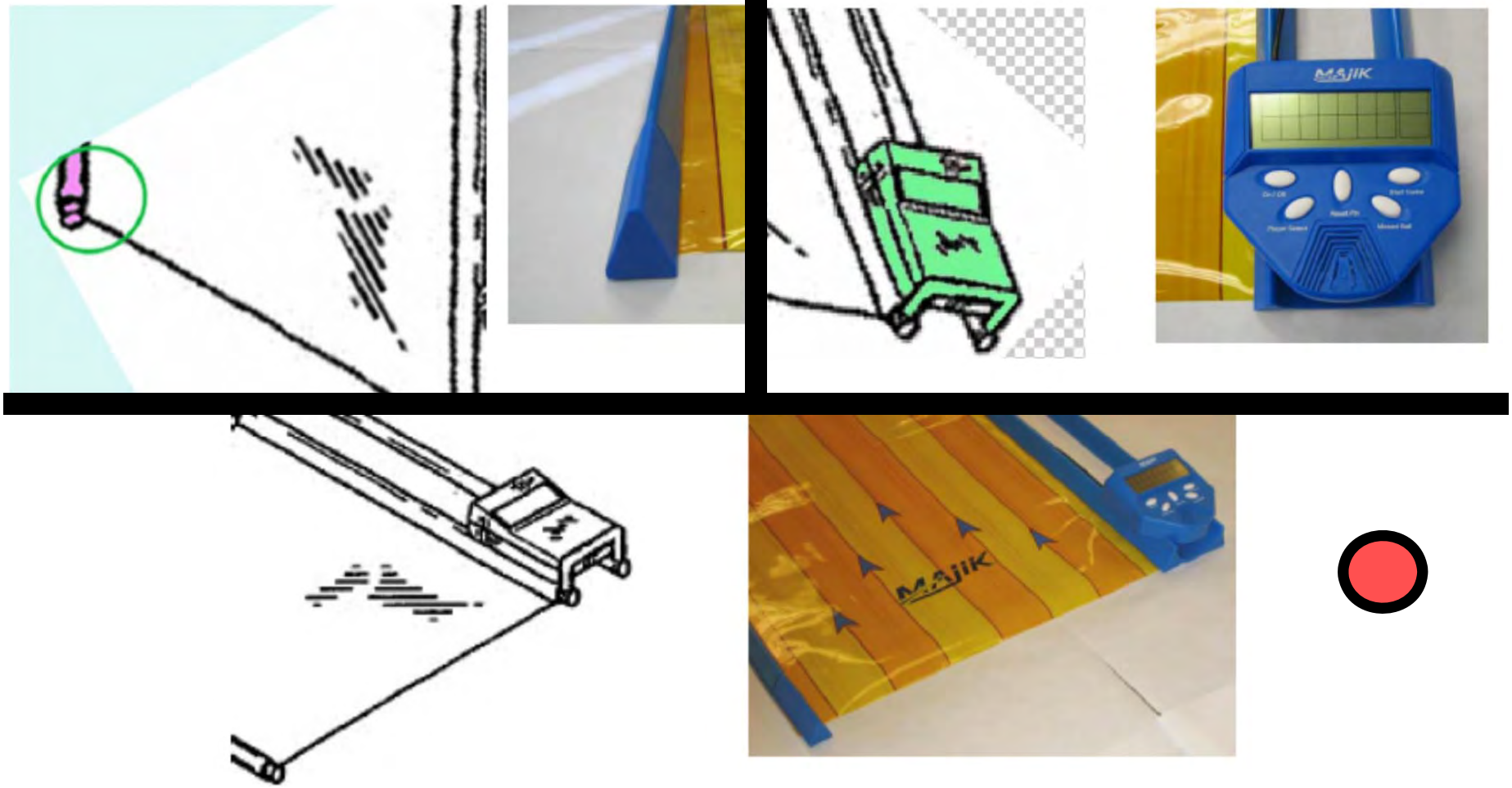
Moose Mountain Toymakers Ltd. v. Majik Ltd., LLC
No. 10-4934 (D. N.J. Aug. 12, 2011)

Images from Accused Infringer's Motion for Judgment on the Pleadings
What about prior art?

Comparison: NO infringement!

Motion for Judgment on the Pleadings granted – no design patent infringement



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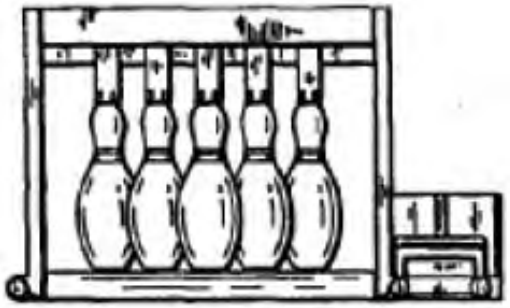
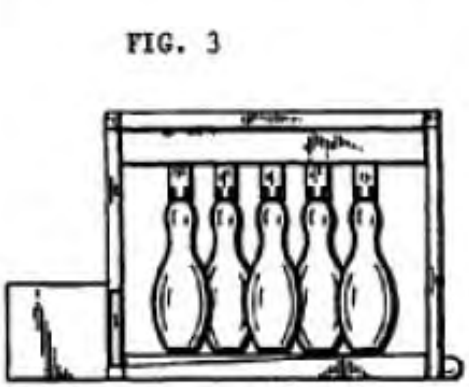
Moose Mountain Toymakers Ltd. v. Majik Ltd., LLC
No. 10-4934 (D. N.J. Aug. 12, 2011)

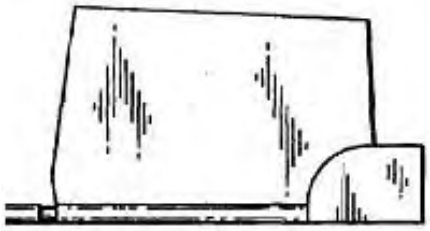
Comparison: NO infringement!

Motion for Judgment on the Pleadings granted – no design patent infringement

Additional Images from Accused Infringer's Motion for Judgment on the Pleadings







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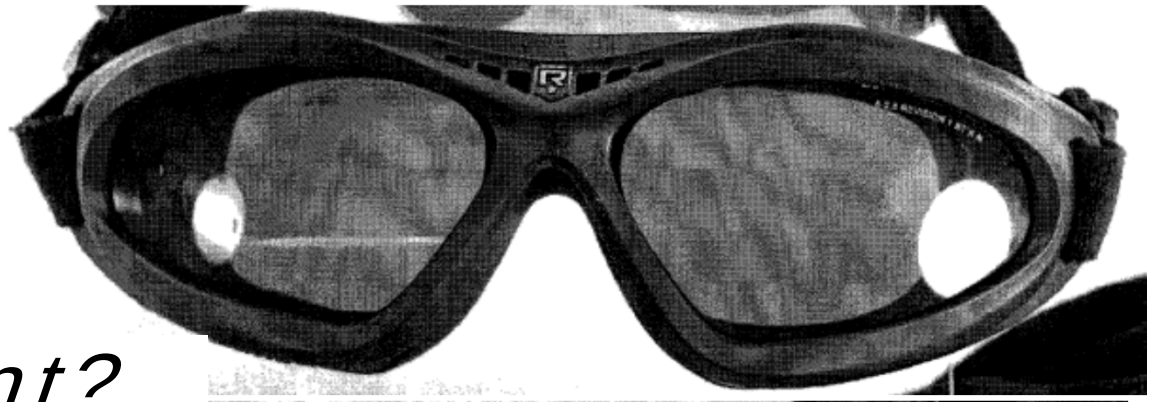
Revision Military, Inc. v. Balboa Mfg. Co.

2011 U.S. Dist. Lexis 98801 (D. Vt. Aug. 31, 2011)

Claimed Design



Infringement?

Accused Design

Claim Construction: *the "patent describes goggles depicted in the six drawings contained in the … patent."* ***unite the design?***

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Revision Military, Inc. v. Balboa Mfg. Co.
2011 U.S. Dist. Lexis 98801 (D. Vt. Aug. 31, 2011)

Not likely to prove design patent infringement!

Burden for proffering clear and convincing evidence not met – motion for preliminary injunction denied.

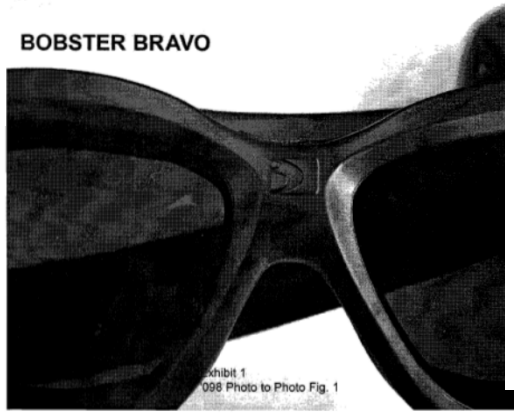
Comparison: *"Patented design and the design of the article sold by the patentee are substantially the same, it is not error to compare the patentee's and the accused articles directly."*

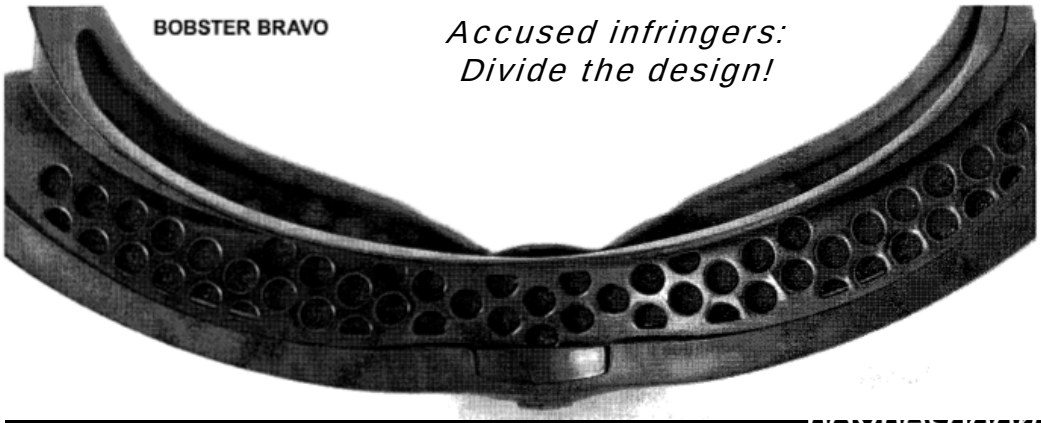
"Although the court reaches this conclusion by examining the overall design of the goggles and not on an element-by-element basis, it notes that ***several design features stand out as dissimilar*** *" namely:* ***Shapes of the lenses*** *(could not fit);* ***Bridges****; and* ***shapes of vents and quantities of rows of vents.***

Prior art "decidedly scant"

"Not a particularly close case"

The "court does not need prior art."





Accused infringers: Divide the design!

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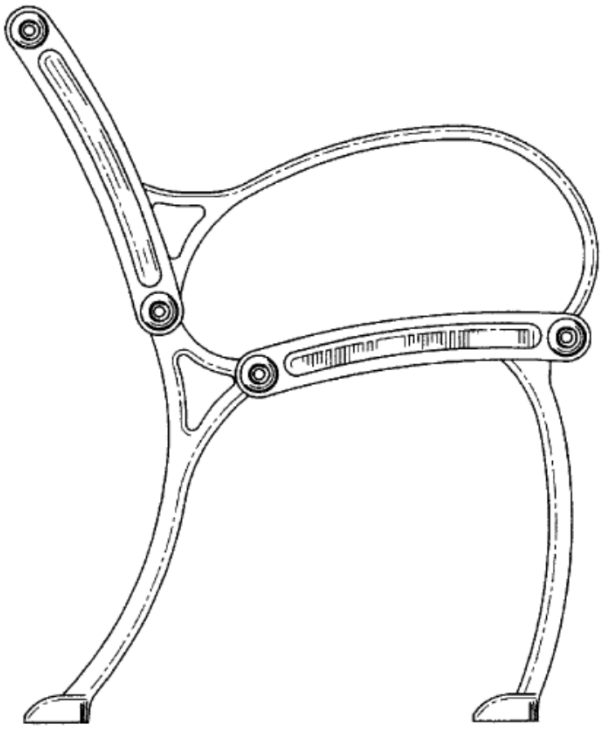
Victor Stanley, Inc. v. Creative Pipe, Inc.

2011 U.S. Dist. Lexis 112846 (D. Md. Sept. 30, 2011)

Claimed Design



1st Accused Design

Infringement?

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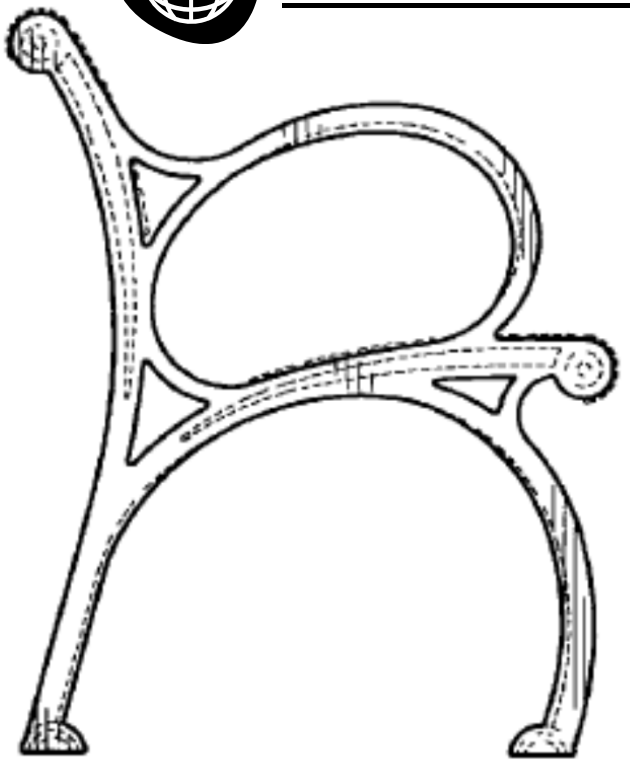
Victor Stanley, Inc. v. Creative Pipe, Inc.

2011 U.S. Dist. Lexis 112846 (D. Md. Sept. 30, 2011)

Claim Construction: *"As suggested by the Federal Circuit, the Court construed the design patent claim by* ***examining the illustrations in the patent and the accused products****. The Court also considered, for background purposes, testimony from [the inventor of the claimed design], who had experience with the site furnishings marketplace, including bench end frames and prior art, and with purchasers of site furnishings."*

Prior Art



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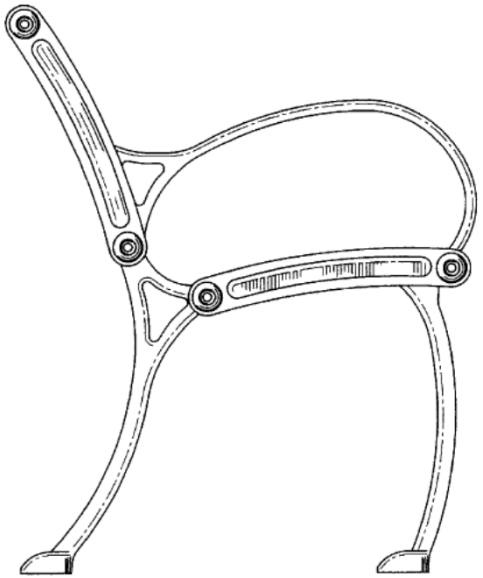
Victor Stanley, Inc. v. Creative Pipe, Inc.
2011 U.S. Dist. Lexis 112846 (D. Md. Sept. 30, 2011)

Comparison: Infringement!

Bench trial – finding of design patent infringement.

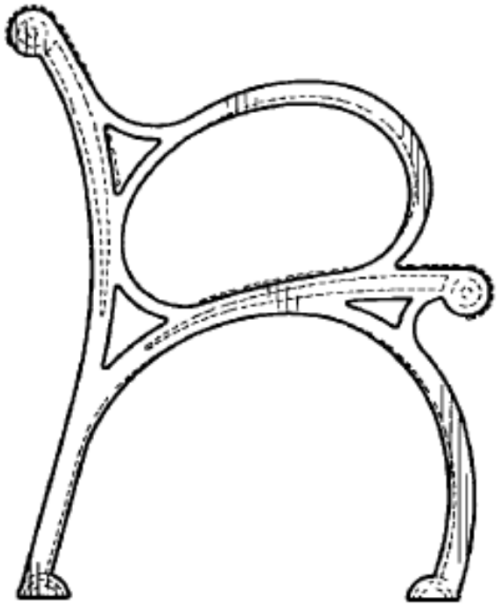
*"The **overall design impression and effect** of the [prior art] is distinctly different from that … claimed in the Patent." "There are minor differences … [b]ut the [1st accused design] so nearly resembles that of the [claimed design] that an ordinary observer, familiar with prior art designs, would be unable to easily distinguish them in a **side-by-side comparison** without unusually careful effort." (**Design patentees: unite the design!)***

Claimed Design



1st Accused Design

Prior Art



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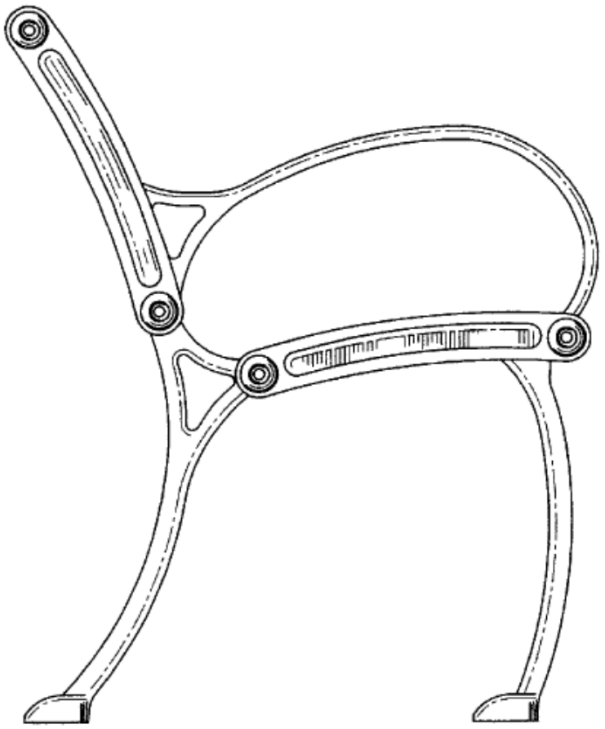
Victor Stanley, Inc. v. Creative Pipe, Inc.

2011 U.S. Dist. Lexis 112846 (D. Md. Sept. 30, 2011)

Claimed Design



2nd Accused Design

Infringement?

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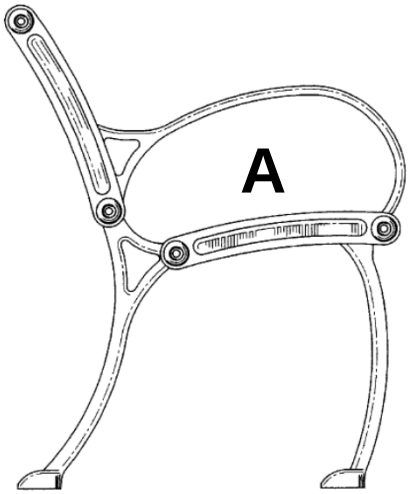
Victor Stanley, Inc. v. Creative Pipe, Inc.
2011 U.S. Dist. Lexis 112846 (D. Md. Sept. 30, 2011)

Comparison: NO infringement!

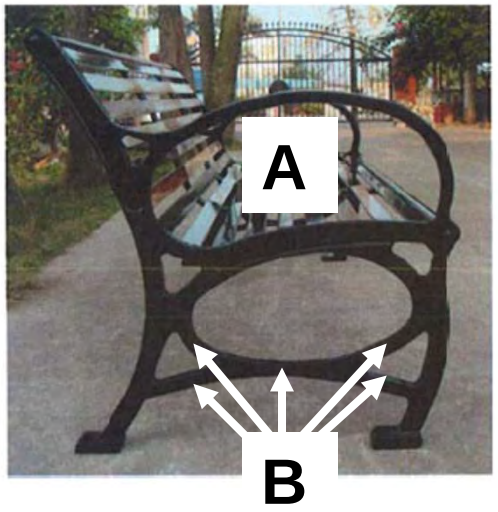
Bench trial – no finding of design patent infringement.

A infringes A, but A+B does not infringe A

Claimed Design



2nd Accused Design



*"The [2nd accused design] has an **added** second brace and an oval below the arm rest. … The **overall effect** of the design with the oval below the seat, while certainly taking advantage of the graceful curves designed into the [claimed design], creates a different and distinctive look that would not confuse the ordinary observer. Each of the individual ornamental elements may be almost identical in isolation, but the **overall impression** is aesthetically different."*

Prior Art? Design Patent covering 2nd Accused Design? *"relevant but not dispositive"*

Accused infringers: add to the design! And apply for patents on your own designs!

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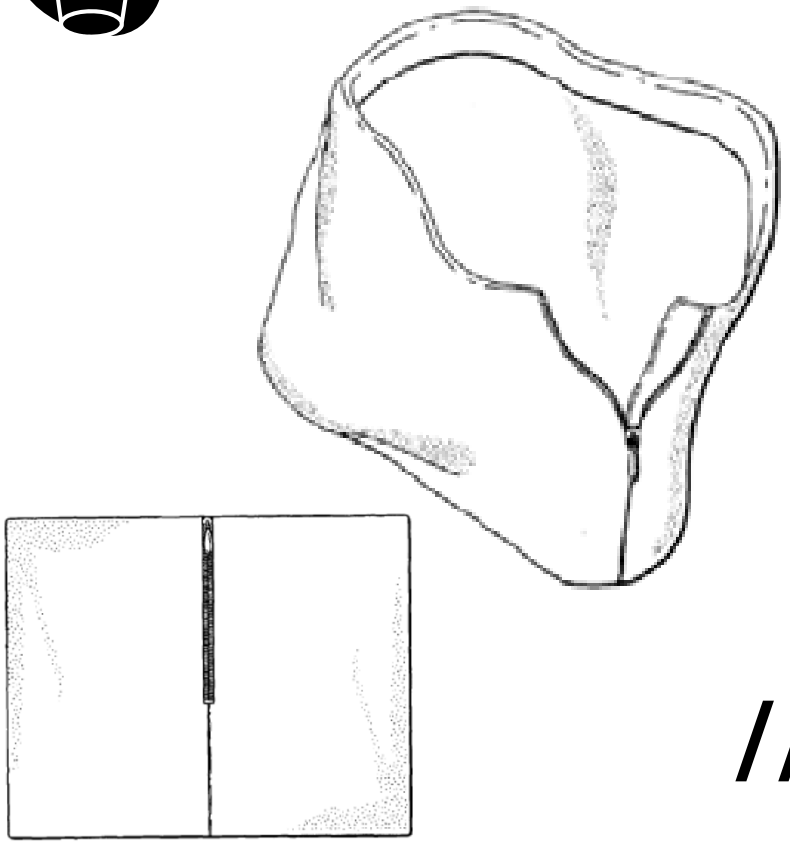
Seirus Innovative Accessories, Inc. v. Cabela's, Inc.

2011 U.S. Dist. Lexis 123697 (S.D. Cal. Oct. 25, 2011)

Claimed Design



Accused Design

Infringement?

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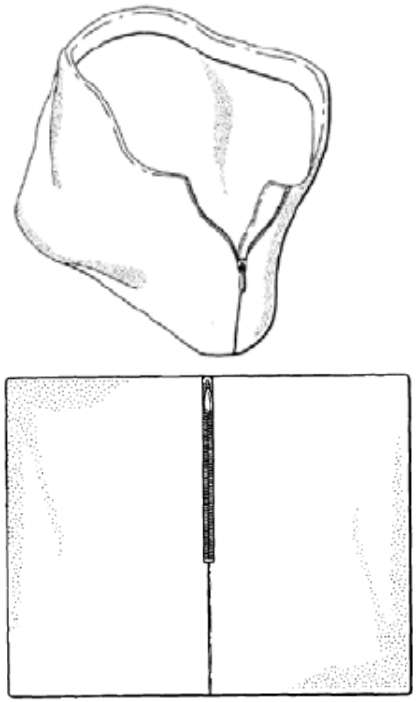
Seirus Innovative Accessories, Inc. v. Cabela's, Inc.

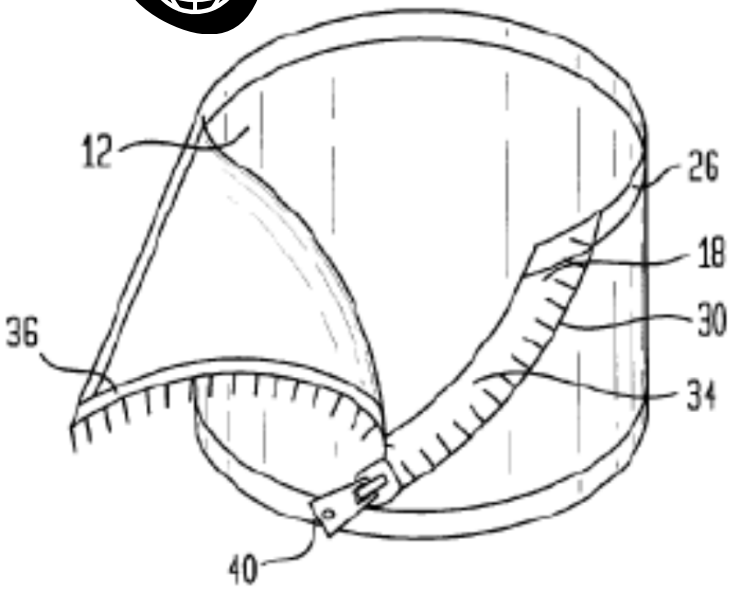
2011 U.S. Dist. Lexis 123697 (S.D. Cal. Oct. 25, 2011)

Claim Construction: *the "ornamental design for a neck protector as reflected in Figures 1-8, depicting a vertical zipper." (in part because prior art discloses angled zipper)*

Claimed Design



Prior Art



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Seirus Innovative Accessories, Inc. v. Cabela's, Inc.

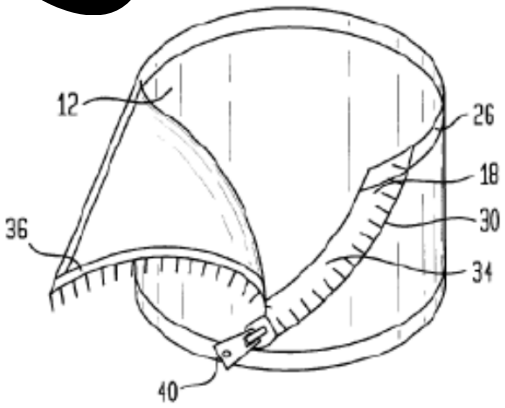
2011 U.S. Dist. Lexis 123697 (S.D. Cal. Oct. 25, 2011)

Comparison: No Infringement!

Claimed Design

Accused Design

Prior Art



"Both the [accused design] and the [prior art] have a diagonal zipper. In contrast, the [claimed design] is limited to a design with a vertical zipper."

Motion for summary judgment on noninfringement granted.

(Accused infringers: divide the design (at claim construction, at comparison))!

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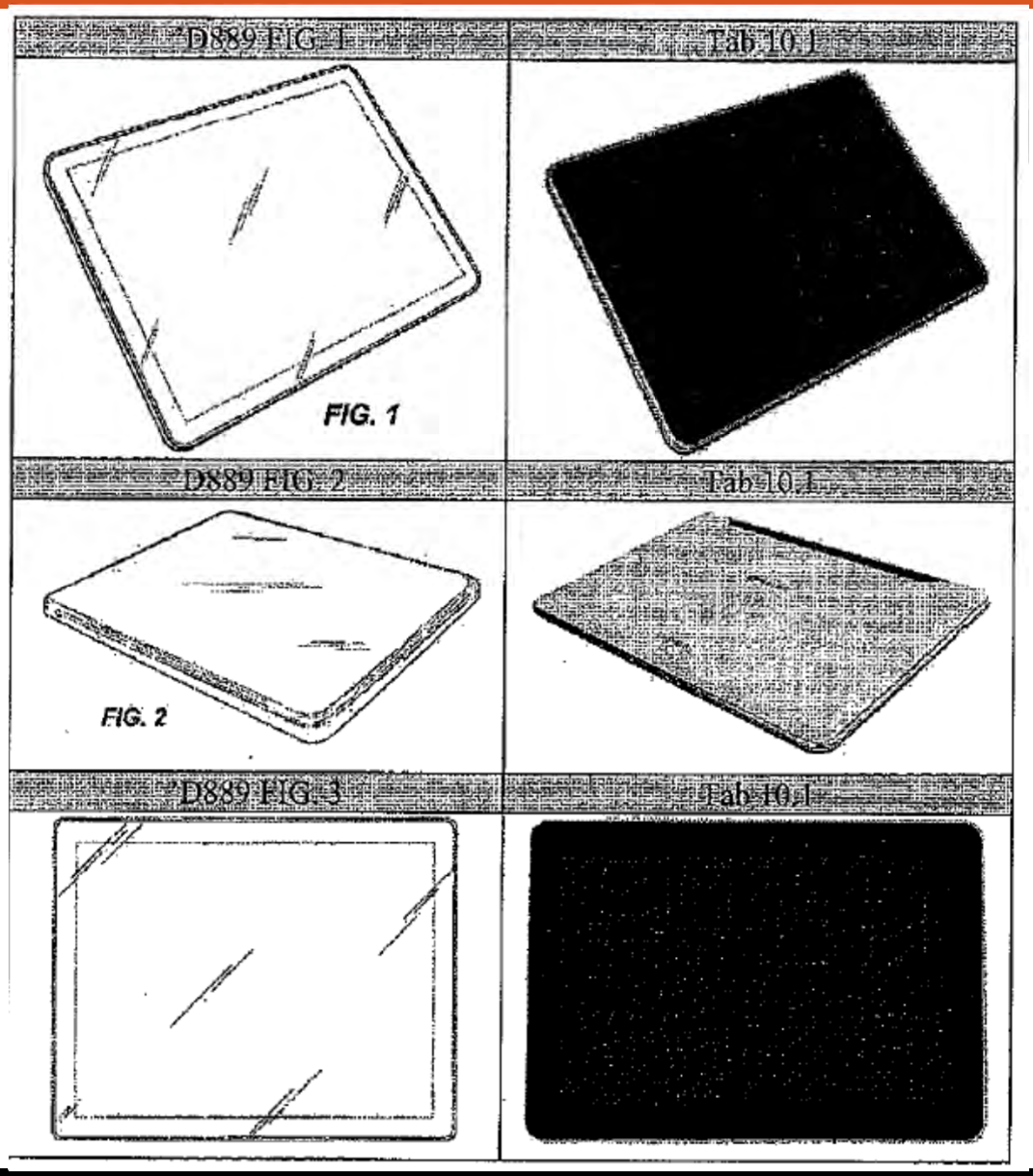
Apple, Inc. v. Samsung Electronics Co., Ltd., *2011 U.S. Dist. Lexis 139049 (N.D. Cal. Dec. 2, 2011)*



Claimed Design

Accused Design

Infringement?

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Design patent infringement likely, but substantial question regarding validity!

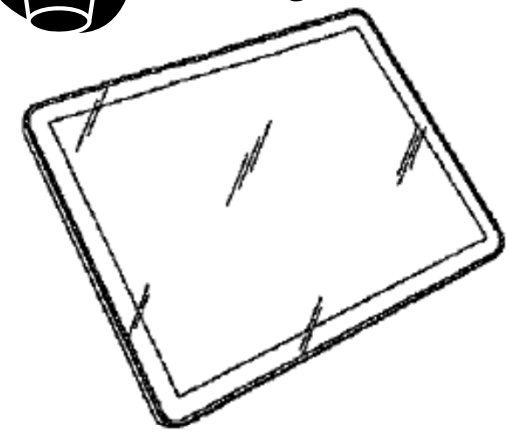
Motion for preliminary injunction denied.

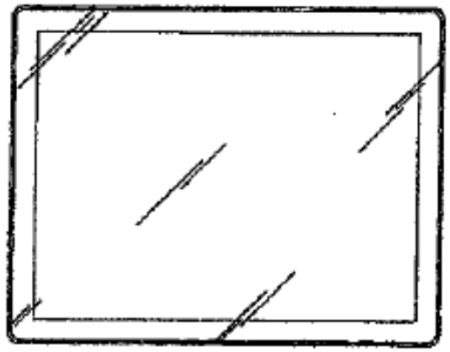
"[T]he Court finds that Apple is likely to establish at trial that the [accused design] is substantially similar to the [claimed design] in the eyes of an ordinary observer."

*"Samsung has raised a substantial question regarding the validity of the [claimed design] on **obviousness** grounds."*

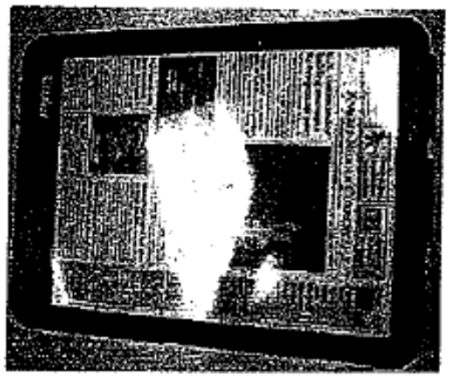
*"[Prior art] creates **basically the same visual impression** as the [claimed design]."*
(flat glass surface absent, but disclosed in other art)

Claimed Design





Prior Art



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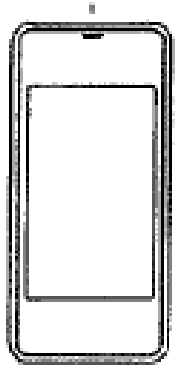
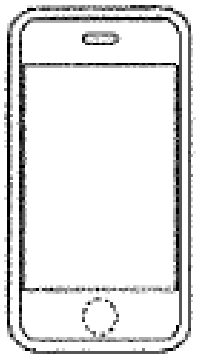
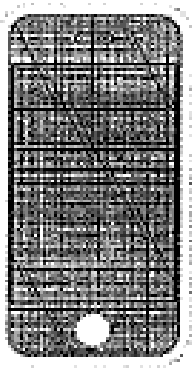
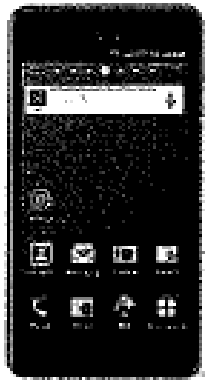
Apple, Inc. v. Samsung Electronics Co., Ltd., *2011 U.S. Dist. Lexis 139049 (N.D. Cal. Dec. 2, 2011)*

Prior Art	*Claimed Design*	*Claimed Design*	*Accused Design*	*Accused Design*
Sharp JPN No. 1241638	D'087 – Front View	D'677 – Front View	Samsung Infuse 4	Samsung Galaxy S 4G
				
	6 embodiments	*1 embodiment*		

Likelihood of infringement?

Substantial question regarding validity?

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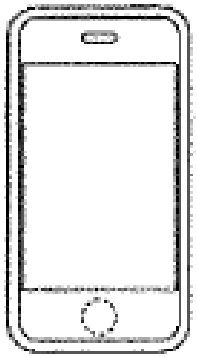
Apple, Inc. v. Samsung Electronics Co., Ltd., 2011 U.S. Dist. Lexis 139049 (N.D. Cal. Dec. 2, 2011)

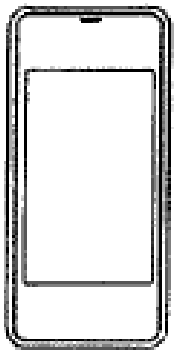
Samsung Galaxy S 4G

Samsung Infuse 4

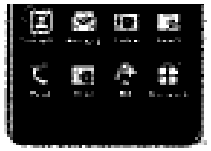
D'087 – Front View



Sharp JPN No. 1241638

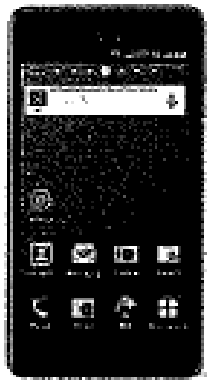


No infringement findings because ***may be anticipated by*** .

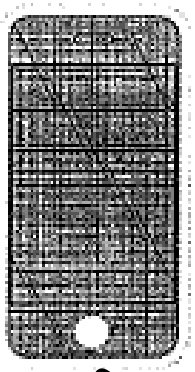


Samsung Galaxy S 4G

Samsung Infuse 4



D'677 – Front View



Each of ***and*** ***most likely infringes*** .

Design patentees: apply for multiple design patents having claims of varying scope!

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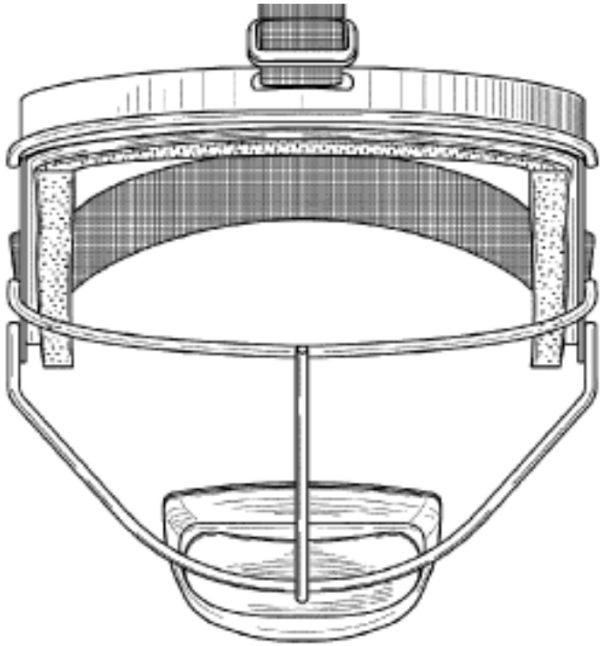
Setting precedent.

Rip-It Holdings, LLC v. Wilson Hunt Int'l
2012 U.S. Dist. Lexis 4490 (M.D. Fla. Jan. 13, 2012)

Claimed Design



Accused Design

Infringement?

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Rip-It Holdings, LLC v. Wilson Hunt Int'l
2012 U.S. Dist. Lexis 4490 (M.D. Fla. Jan. 13, 2012)

Claim Construction? Infringement?

Substantial question of invalidity due to functionality!

Motion for preliminary injunction denied because of substantial question of invalidity and lack of proof that question lacks substantial merit.

"To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone." Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 148 (1989).

Rip-It :

- *"However, the Federal Circuit has also recognized that '[i]n determining whether a design is primarily functional, the purposes of the **particular elements** of the design necessarily must be considered.'"*
- *"The mere fact that **each element** of a design serves some functional purpose does not necessarily mean that the overall design is dictated by function, … but when the function of **each element** cannot be **separated** from the overall design, it indicates that the entire design is dictated by function."*

Invalidate by functionality by DIVIDING the design.

Accused infringers: divide the design to blow it up!

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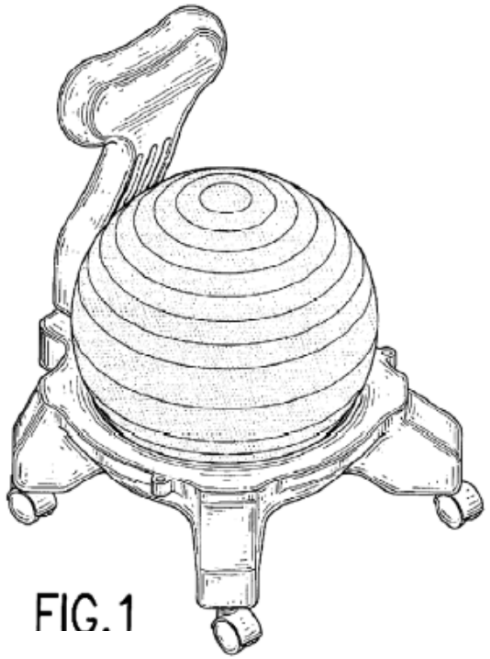
Famosa Corp. v. Gaiam Inc.

No. 11-cv-05703 (S.D.N.Y. Feb. 22, 2012)

Claimed Design



Accused Design

Infringement?

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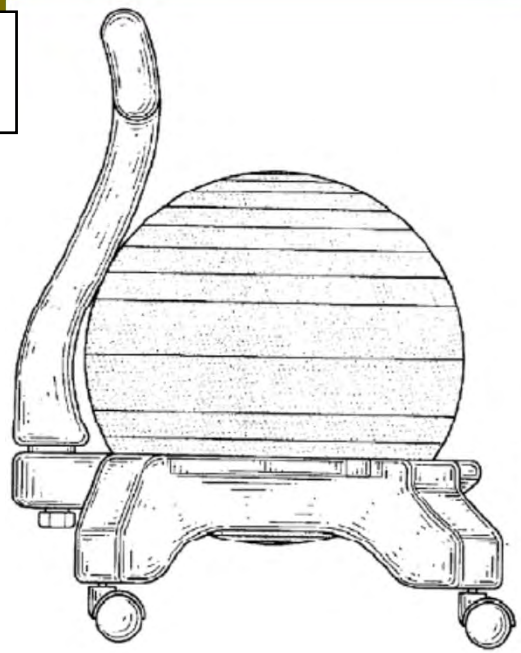
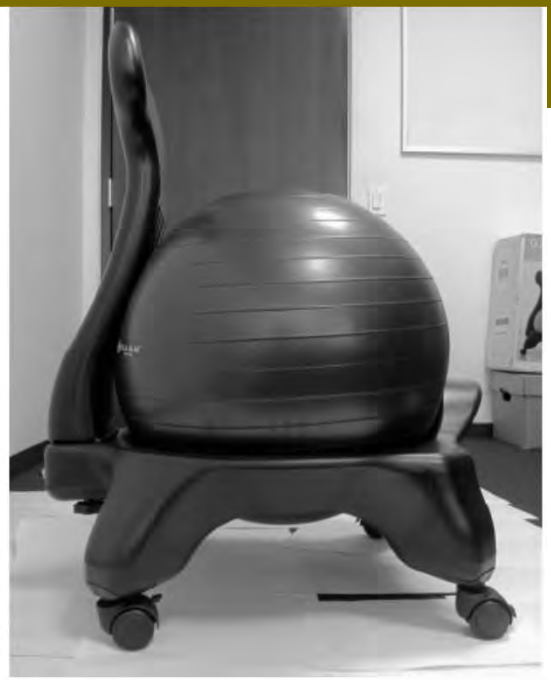
Famosa Corp. v. Gaiam Inc.
No. 11-cv-05703 (S.D.N.Y. Feb. 22, 2012)

Comparison: Infringement!

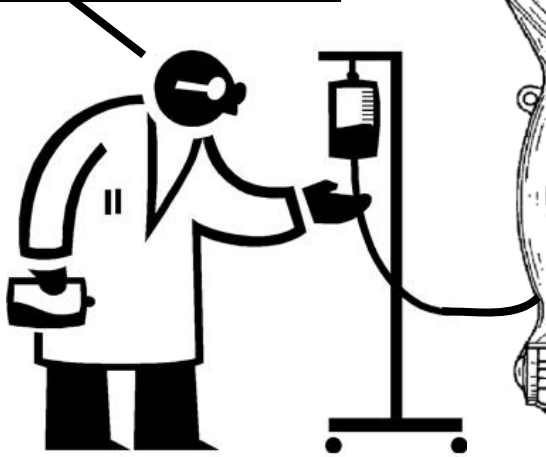
Partial summary judgment as to infringement of claimed design granted.

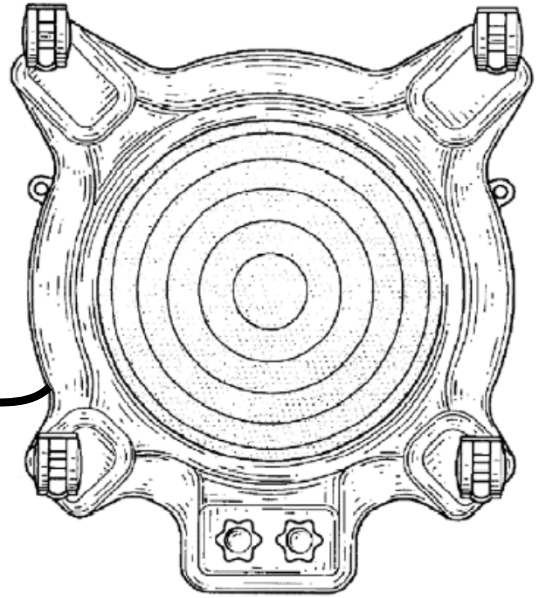
Comparison: *"[N]ot only are the designs substantially similar, they are nearly identical."*





There's hope!





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...the year in review ends.

Design Patentees

- ***UNITE*** to enforce design patent!
  - ***UNITE*** at claim construction!
  - ***UNITE*** at comparison!
- File multiple design patent applications having claims of varying scope!
- (*But maybe divide when arguing against anticipation or obviousness.)*

Accused Infringers

- ***DIVIDE*** to avoid design patent infringement!
  - ***DIVIDE*** at claim construction!
  - ***DIVIDE*** at comparison!
- ADD to the claimed design!
- File for design patents!
- (*But maybe unite when asserting anticipation or obviousness.*)

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Thank you!!!

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