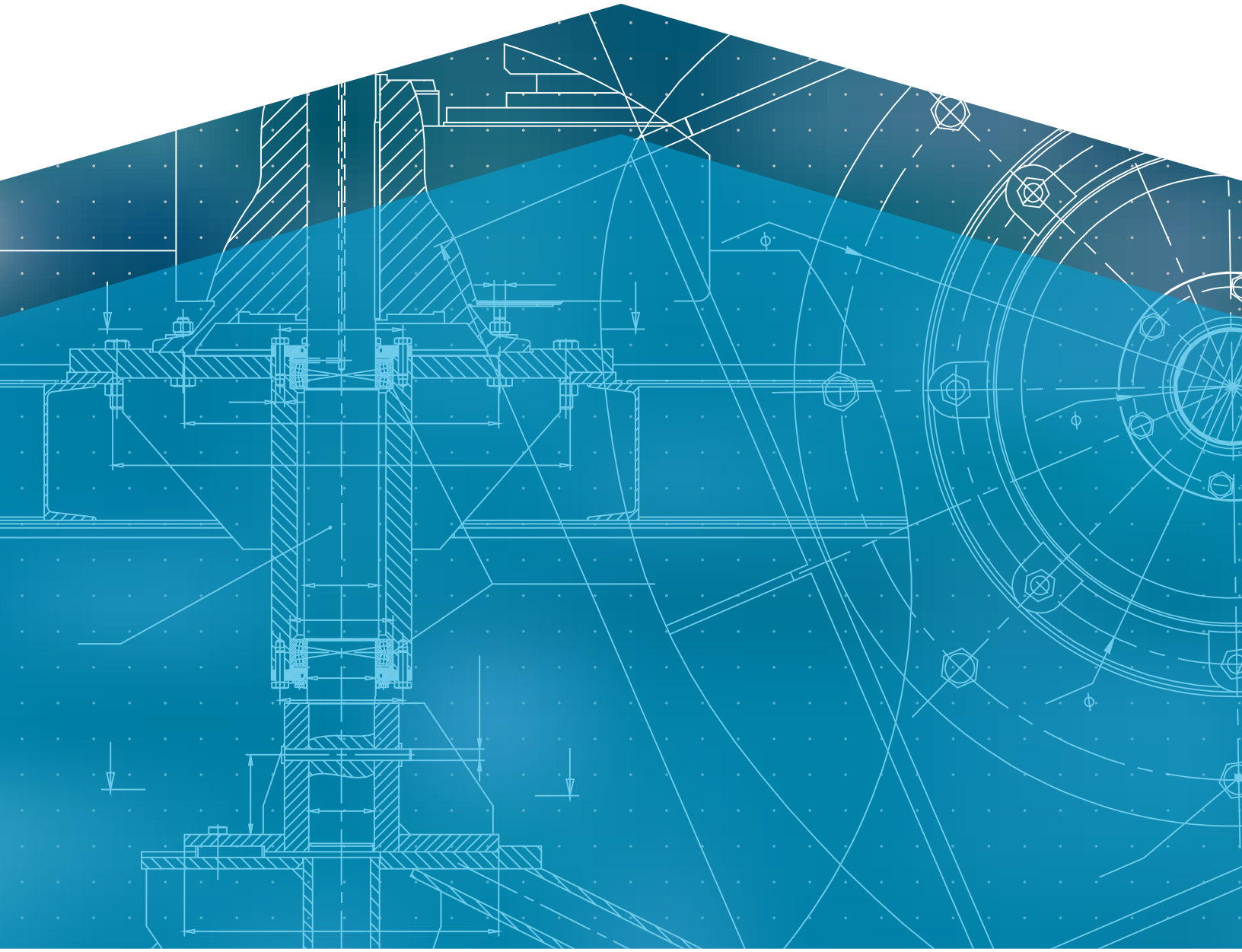
Design Patent Law

Year In Review

2016



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HUNTON& WILLIAMS

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EXECUTIVE SUMMARY

Perhaps the biggest design patent law story of 2016 was the United States Supreme Court opinion in *Samsung Electronics Co., Ltd. v. Apple Inc.* In this opinion, the Court took the position that the term "article of manufacture," as used in 35 U.S.C. § 289 (which allows a patent owner to recover an infringer's total profits for infringement) need not be the entire article sold to a consumer (for a multicomponent article), but can be a subset or component of that article. The Court remanded the case to the Federal Circuit for further consideration and to determine the proper test to be used in determining the article for damages. The Court also granted certiorari and remanded *Systems Inc. v. Nordock, Inc.* (another design patent damages case) to the Federal Circuit for further consideration in view of the *Apple* decision. The Federal Circuit in turn remanded the case back to the district court for further proceedings in February 2017.

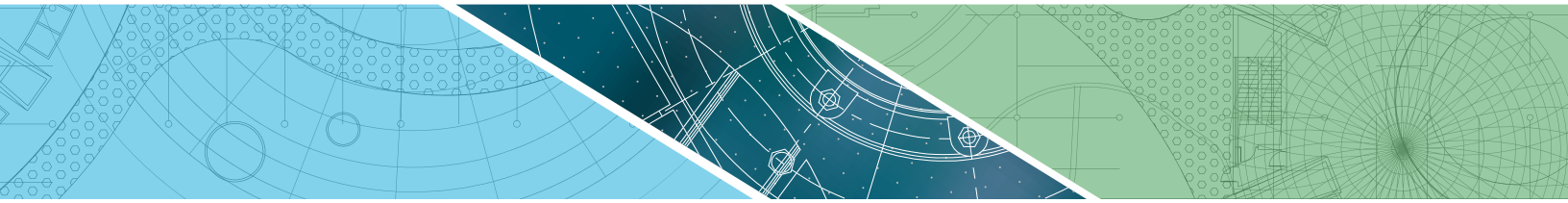
From the Federal Circuit, there were two decisions from this past year that focused on design patents. *Sports Dimension Inc. v. Coleman Co.* considered the role of functional elements in design patent claim construction and *Wallace v. Ideavillage Products Corp.* highlighted the analysis for design patent infringement.

At the district court level, the number of design patent litigation cases remained in line with past years. Several of these district court decisions are worth noting. First, two district court decisions highlighted the application of the test for design patent infringement: *Columbia Sportswear North America, Inc. v. Serius Innovative Accessories* (D. Or.) and *Weber-Stephen Products LLC v. Sears Holding Corp.* (N.D. Ill.). In *Top-Co Inc. v. Summit Energy Services, Inc.*, the District Court for the Southern District of Texas applied the test for ornamentality versus functionality. And finally, in *Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co.*, the District Court for the Central District of California applied the principles of prosecution history estoppel, from the *Malibu Boats* case, and found the patent owner disclaimed a particular embodiment in prosecution.

An interesting decision came out of the Supreme Court of the United Kingdom involving infringement analysis of a European Community Design based on a set of CAD drawings: *PMS v. Magmatic.*

At the USPTO, *inter partes* review (IPR) petitions for design patents continued to be popular as petitions have increased each year since the implementation of the America Invents Act in 2012. Three Patent Trial and Appeal Board (PTAB) IPR decisions involved invalidity based on obviousness: *Premier Gem Corp. v. Wing Yee Gems & Jewellery Ltd.*; *Lowe's Home Centers, LLC v. Reddy*; and *Caterpillar, Inc. v. Miller International, Ltd.* These decisions are important given that the obviousness test for design patents differs from that for utility patents. Also, the IPR decision in *Skechers U.S.A., Inc. v. Nike, Inc.*, involved an analysis of written description support in determining whether a priority claim is supported.

Finally, the first post grant review (PGR) decision involving a design patent was released: *Galaxia Electronics Co., Ltd. v. Revolution Display, LLC*. Here, the PTAB denied institution of the requested PGR. The denial provides a useful analysis regarding the standard and level of evidence required by a petitioner, to prove improper inventorship and lack of ornamentality.



INTRODUCTION

The past year was another eventful one in the world of design patent law.

Worldwide the number of design application filings was down, but application filings under the Hague system increased. In the United States, the number of design patent litigation cases at the district court level has remained fairly steady since 2008 and several district court decisions are worth noting from this past year as summarized herein. However, post-issuance proceeding filings for design patents continued to be popular with *inter partes* review (IPR) petitions for design patents increasing over 2015 levels and continuing the trend of increasing each year since the implementation of the America Invents Act in 2012.

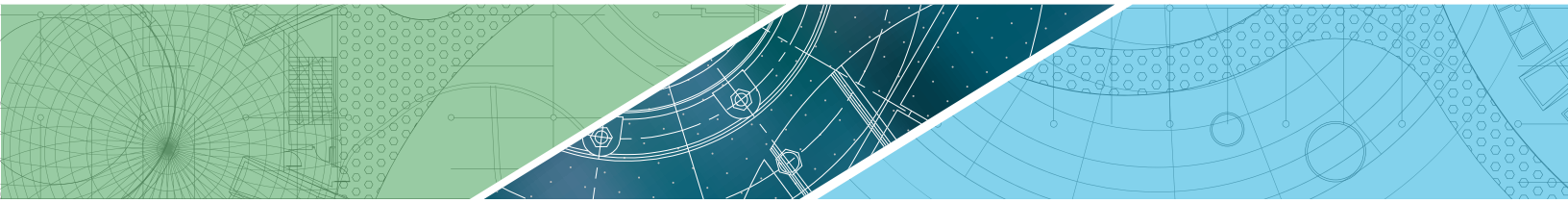
In a significant opinion regarding design patent damages, the Supreme Court altered the common interpretation of the design patent damages statute (35 U.S.C. § 289) in its opinion in *Samsung Electronics Co., Ltd. v. Apple Inc.*, which was remanded to the Federal Circuit. On February 7, 2017, the Federal Circuit remanded the case back to the Northern District of California for further proceedings and to potentially develop a new test to determine the requisite article of manufacture. On the heels of that decision, the Court granted cert and remanded the *Systems Inc. v. Nordock, Inc.*, case (another design patent damages case) to the Federal Circuit for further consideration in view of its decision in *Apple*.

Next, in *Sports Dimension Inc. v. Coleman Co.* the Federal Circuit highlighted the role of functional elements in claim construction. Likewise, *Top-Co Inc. v. Summit Energy Services, Inc.*, from the Southern District of Texas applied the test for ornamentality versus functionality to find the patent at issue invalid. Additionally, the Patent Trial and Appeal Board (PTAB) decision in *Galaxia Electronics Co., Ltd. v. Revolution Display, LLC* (the first post grant review (PGR) decision involving a design patent) provides guidance on the level of evidence required in demonstrating a design is primarily functional rather than ornamental.

Three PTAB decisions demonstrate the application of the obviousness analysis for design patents: *Premier Gem Corp. v. Wing Yee Gems & Jewelry Ltd.*; *Lowe's Home Centers, LLC v. Reddy*; and *Caterpillar, Inc. v. Miller International, Ltd.* These decisions provide further insight into the PTAB's application of the obviousness test for design patents, which differs from the obviousness test for utility patents.

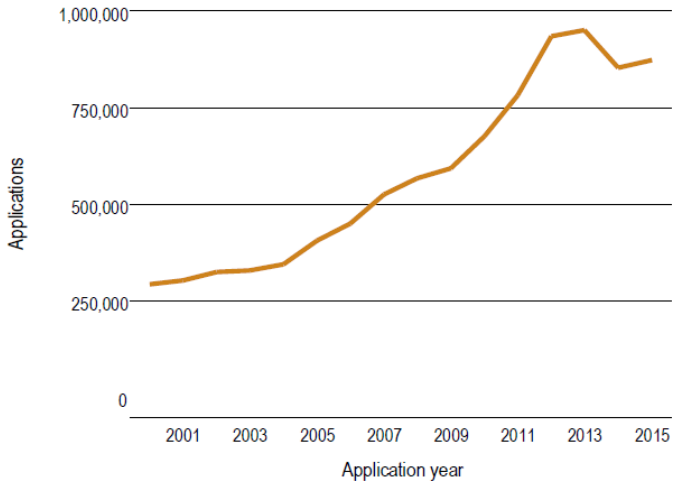
The Federal Circuit issued an opinion applying the ordinary observer test for infringement in *Wallace v. Ideavillage Products Corp*. Two district court decisions also highlight the application of this test: *Weber-Stephen Prods. LLC v. Sears Holding Corp.* (N.D. Ill.) and *Columbia Sportswear North America, Inc. v. Serius Innovative Accessories* (D. Or.). Additionally, a court in the United Kingdom presented a potentially relevant infringement analysis involving a European Community Design based on a set of CAD drawings (*PMS v. Magmatic*). This is notable because CAD drawings are appearing more often in US design patents, particularly with the US membership in the Hague System.

Finally, several decisions address design patent prosecution issues. The IPR decision in Skechers U.S.A., Inc. v. Nike, Inc. provides an analysis of written description support in determining whether a priority claim is supported and the Weber case addresses definiteness and enablement (interestingly, as a combined single issue). The PGR decision in Galaxia Electronics Co., Ltd. v. Revolution Display, LLC, also provides a useful analysis regarding the standard to prove inventorship. And finally Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co. from the Central District of California applied the principles of prosecution history estoppel, finding the patent owner had disclaimed a particular embodiment.



DESIGN PATENT STATISTICS

After dropping 10.2% in 2014, the first decrease in 20 years, the number of industrial design application filings worldwide rose 2.3% in 2015 with an estimated 872,800 applications filed.[1]



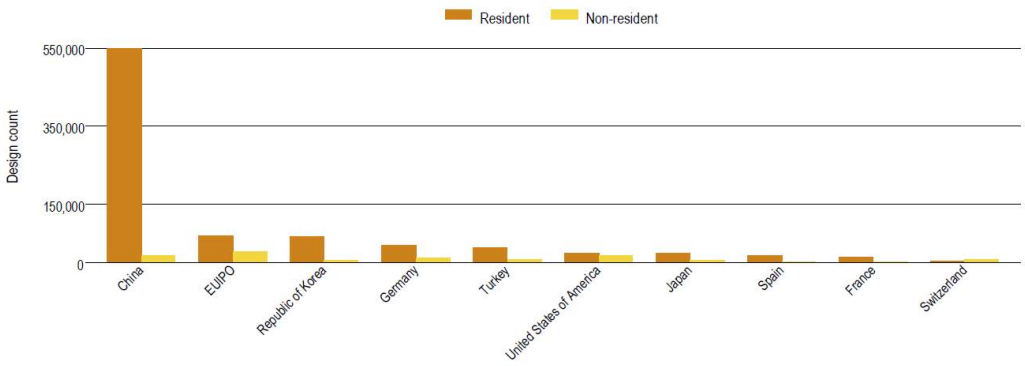
Industrial design applications worldwide

Source: Standard figure C1.

According to WIPO, the 2014 decrease in design application filings was due primarily to a decrease of filings at the State Intellectual Property Office of the People's Republic of China (SIPO).[2] Likewise, the 2015 increase in filings was also attributed to an uptick in SIPO filings.

Looking more closely at individual country filings in 2015, SIPO, with half of all applications filed there, received the most filings in the world. In terms of filings, the European Union Intellectual Property Office (EUIPO) and South Korea's Intellectual Property Office (KIPO) follow behind SIPO.[3] It is important to note that with respect to the EUIPO, which is a multimember union, the number of filings is equivalent to the number of applications filed multiplied by the corresponding number of member states. Overall, the USPTO has the sixth-greatest number of application filings, as illustrated below.[4]

Fig. 17 Application design counts for the top 10 offices, 2015



Application design counts for the top 10 offices, 2015

Source: Standard figure C10.

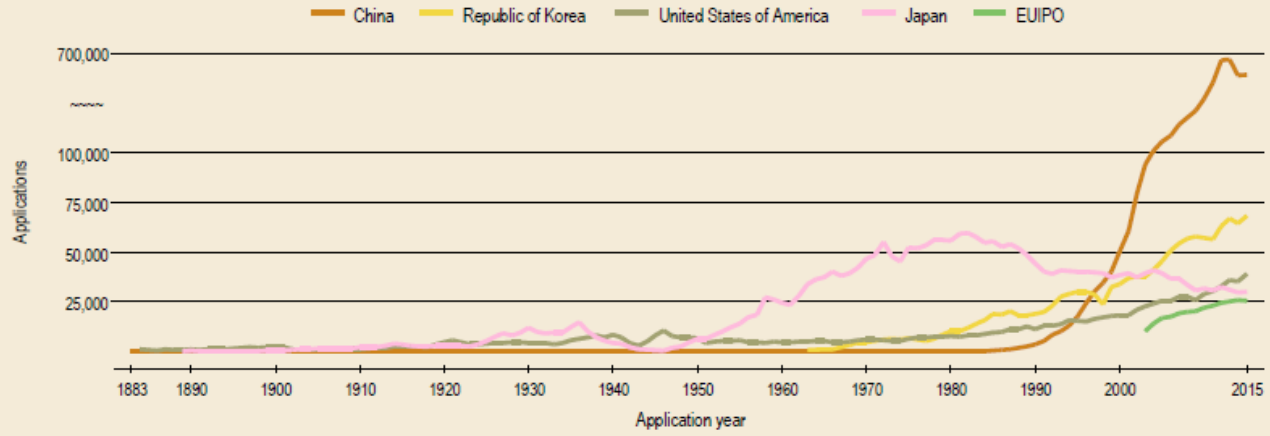
[1] WIPO Pub. No. 941, available at http://www.wipo.int/ipstats/en/wipi/ (provides statistics from the WIPO statistics database on worldwide industrial design application filings).
[2] *Id.*, p. 111.
[3] *Id.*, pp. 111–112, Fig. 17.
[4] *Id.*

Looking strictly at applications filed (and not taking into consideration the multiplication of applications by member states), the USPTO ranks third after surpassing the Japanese Patent Office (JPO) in 2012.[5]

Industrial design applications filed since 1883

Between 1883 and the early 1950s, the Japan Patent Office (JPO) and the USPTO averaged similar numbers of applications, rarely exceeding 10,000. The JPO received the largest number of applications from the 1950s to the late 1990s, reaching about 50,000 annual filings at its peak. SIPO began receiving applications in 1985 and saw unprecedented growth, from 640 in 1985 to 660,000 in 2013. It experienced its first drop in 2014. KIPO surpassed the JPO in 2004, and has remained the second-largest office since then. In 2012, the USPTO moved ahead of the JPO to become the third largest. The fifth-largest office is the EUIPO, which began receiving applications in 2003 and reached a plateau in its number of filings, at around 25,000, in 2013. Unlike the other four offices, the EUIPO has a multiple design system. Applications filed at the EUIPO contained 98,162 designs in 2015.

Trend in industrial design applications for the top five offices



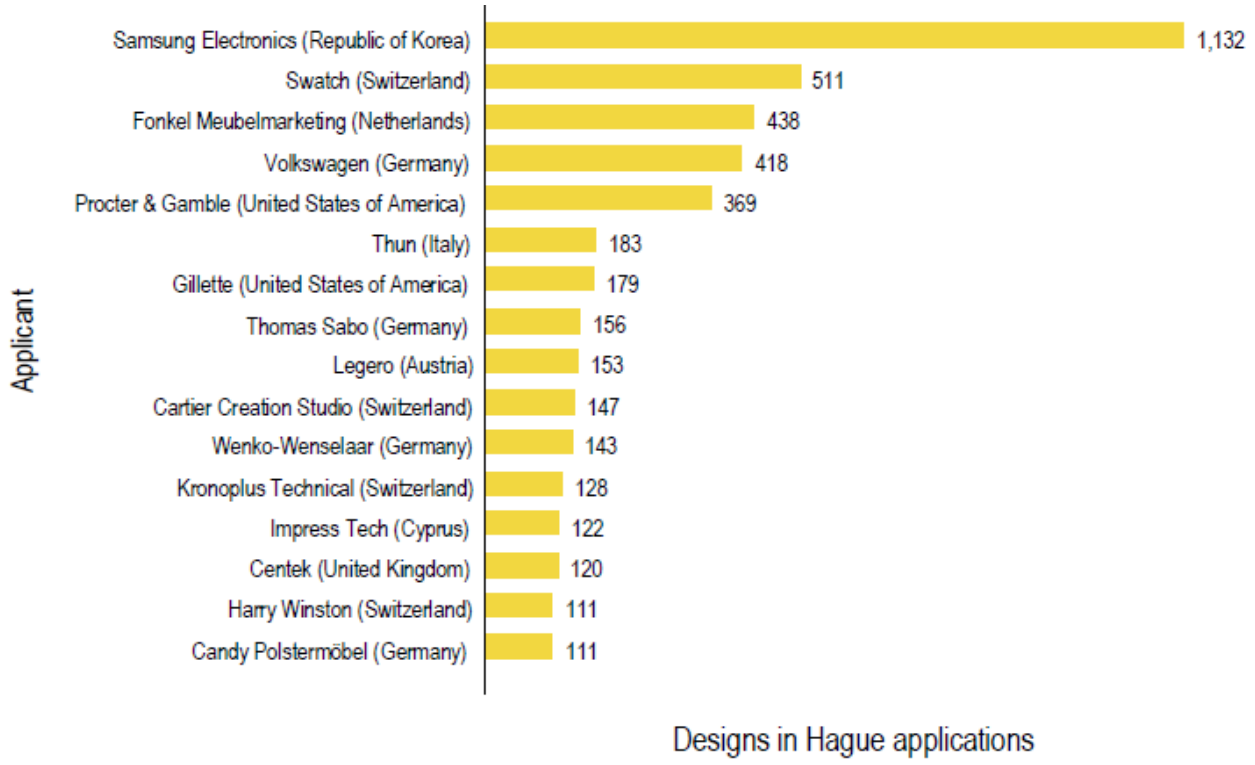
Source: Standard figure C9.

[5] *Id.*, p. 114.

THE HAGUE SYSTEM

Interestingly, although filings increased worldwide by only 2.3%, application filings under the Hague System increased by more than 40% in 2015.[6] WIPO attributes this increase, at least in part, to the Republic of Korea's joining the Hague System in 2014 and the United States' and Japan's joining in 2015.[7] The largest applicant filer of 2015 was Samsung Electronics with 1,132 design applications.[8] However, by member country, Germany was the top origin country for filings under the Hague System in 2015 with 3,453 designs in applications.[9] The largest share of registrations under the Hague System is for designs relating to recording and communication equipment.[10]

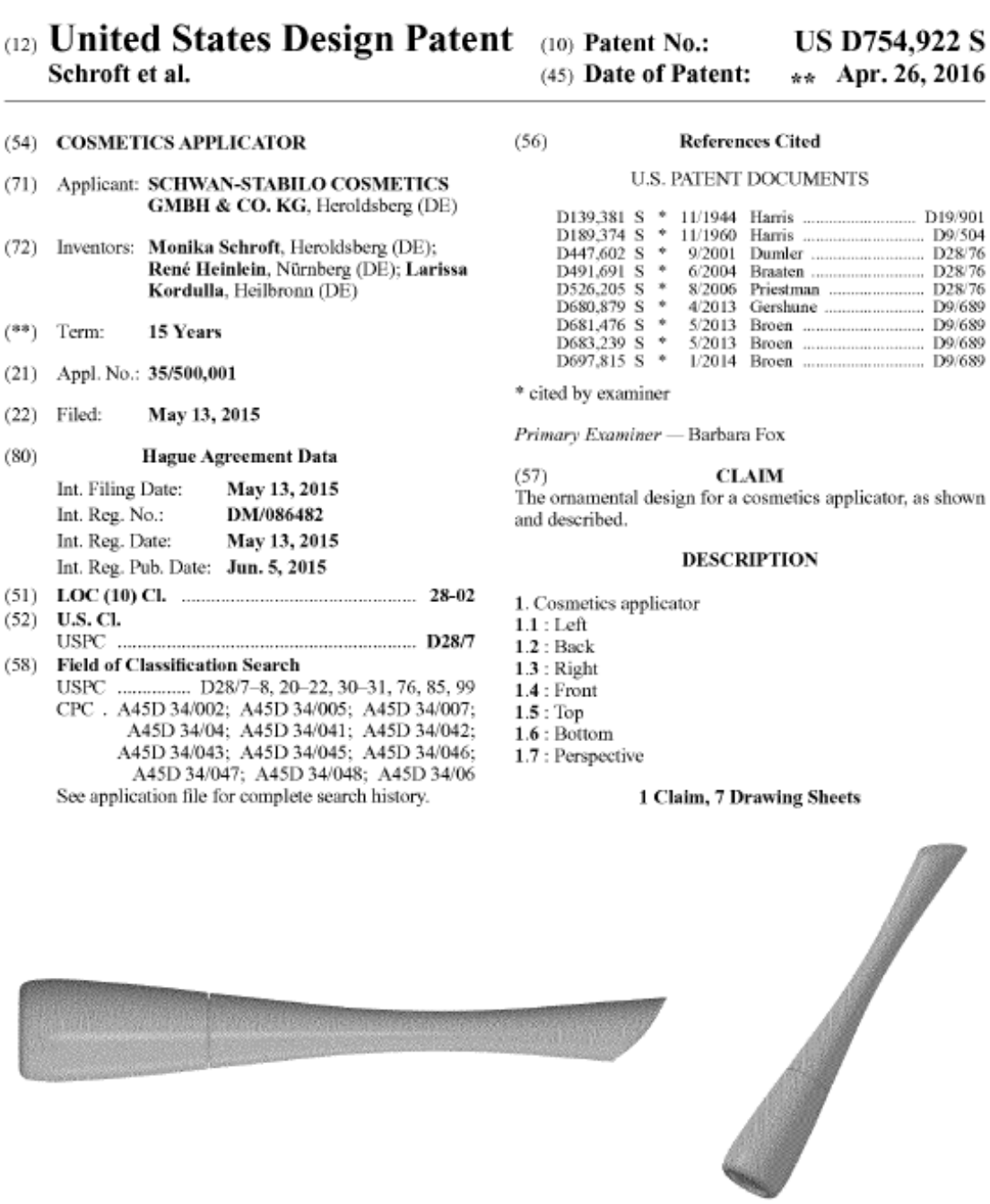
C32 Top Hague applicants based on number of designs, 2015



Source: WIPO Statistics Database, October 2016.

This past year saw the first US design patent to issue from a Hague application. This patent, D754,922, is for a "Cosmetics Applicator" and it issued on April 26, 2016. The front page of this patent is reproduced on the next page. It is worth noting that for a Hague application, the filing date in the United States is the International Registration Date.[11] In addition to demarcating Hague applications with the "Hague Agreement Data," the USPTO differentiates Hague applications by assigning them an application number of "35/nnn,nnn."[12]

[6] *Id.*, at 116.
[7] Hague Yearly Review, 2016 (WIPO Pub. No. 9 30), p. 5.
[8] *Id.*
[9] *Id.*
[10] *Id.*
[11] 35 U.S.C. § 384; 37 C.F.R. § 1.1023.
[12] "PAIR: The Hague Agreement," available at: https://www.uspto.gov/sites/default/files/patents/process/status/private_pair/PAIR-Hague-1pager.pdf.



(12) **United States Design Patent**
Schroft et al.

(10) **Patent No.: US D754,922 S**
(45) **Date of Patent: ** Apr. 26, 2016**

(54) **COSMETICS APPLICATOR**

(71) Applicant: **SCHWAN-STABILO COSMETICS GMBH & CO. KG**, Heroldsberg (DE)

(72) Inventors: **Monika Schroft**, Heroldsberg (DE); **René Heinlein**, Nürnberg (DE); **Larissa Kordulla**, Heilbronn (DE)

(**) Term: **15 Years**

(21) Appl. No.: **35/500,001**

(22) Filed: **May 13, 2015**

(80) **Hague Agreement Data**

Int. Filing Date: **May 13, 2015**
Int. Reg. No.: **DM/086482**
Int. Reg. Date: **May 13, 2015**
Int. Reg. Pub. Date: **Jun. 5, 2015**

(51) **LOC (10) Cl.** **28-02**
(52) **U.S. Cl.**
USPC **D28/7**
(58) **Field of Classification Search**
USPC D28/7–8, 20–22, 30–31, 76, 85, 99
CPC . A45D 34/002; A45D 34/005; A45D 34/007; A45D 34/04; A45D 34/041; A45D 34/042; A45D 34/043; A45D 34/045; A45D 34/046; A45D 34/047; A45D 34/048; A45D 34/06
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

D139,381	S	*	11/1944	Harris	D19/901
D189,374	S	*	11/1960	Harris	D9/504
D447,602	S	*	9/2001	Dumler	D28/76
D491,691	S	*	6/2004	Braaten	D28/76
D526,205	S	*	8/2006	Priestman	D28/76
D680,879	S	*	4/2013	Gershune	D9/689
D681,476	S	*	5/2013	Broen	D9/689
D683,239	S	*	5/2013	Broen	D9/689
D697,815	S	*	1/2014	Broen	D9/689

* cited by examiner

Primary Examiner — Barbara Fox

(57) **CLAIM**

The ornamental design for a cosmetics applicator, as shown and described.

DESCRIPTION

1. Cosmetics applicator
1.1 : Left
1.2 : Back
1.3 : Right
1.4 : Front
1.5 : Top
1.6 : Bottom
1.7 : Perspective

1 Claim, 7 Drawing Sheets

Benefits of the Hague System include filing a single, standardized design application in a single language for which protection then can be sought in the various contracting parties to the agreement.[13] There are presently 66 contracting parties to the Hague System.[14] China, Canada, Mexico and Australia are not presently members of the Hague System.[15] Thus, when filing a design application, it is worth considering the Hague System as an option, but it is important to understand the pros and cons of the Hague System versus direct national filings.

[13] See Hague Yearly Review, 2016 (WIPO Pub. No. 930), available at http://www.wipo.int/publications/en/details.jsp?id=4072, pp. 9–11.
[14] See Listing of Hague Contracting Parties as of Nov. 26, 2016, available at http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf.
[15] Id.

JAPAN AND SOUTH KOREA UPDATE COMPUTER-BASED GRAPHIC IMAGE GUIDELINES

This past year both Japan and South Korea released revised design examination guidelines to address computer screen graphic images. This demonstrates the increasing focus on this type of design protection in today's computer-driven world.

In March 2016, the Japanese Design Examination Guidelines were revised to allow for "wider protection for designs including a graphic image on a screen."[16] These guidelines apply to applications filed after April 1, 2016.[17] The revised Design Examination Guidelines refer to "graphic image on a screen" (GIOS) which is (i) recorded by installing software in an article after the article is put on the market and (ii) recorded by installing software in a computer so that the computer can work as a special machine with a special function.[18] These revised guidelines provide an update to the existing guidelines by allowing for registration of images that are either recorded in advance or after purchase (of a computer device).[19] Also, it is worth noting that the guidelines contain specific requirements regarding the title, the description and the drawings.[20]

These revised guidelines provide the following example of a registerable design under the new guidelines:[21]

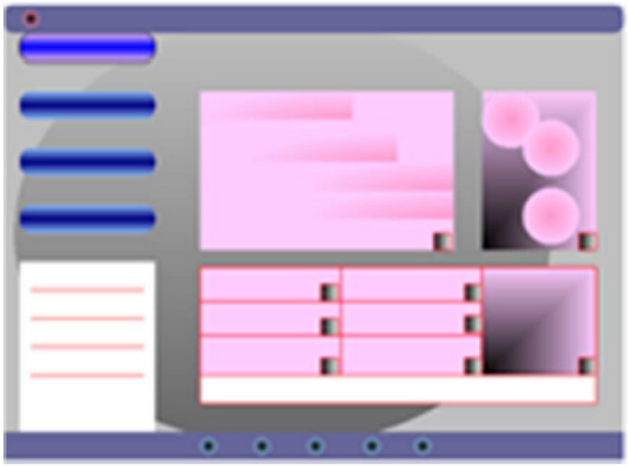
[This example illustrates a graphic design on a screen that is found to constitute a design of the computer with additional function]

"Computer with a pedometer function"

Graphic Image displaying step count data

*For the sake of convenience of explanation, the matter, described in the application and other drawings were omitted.

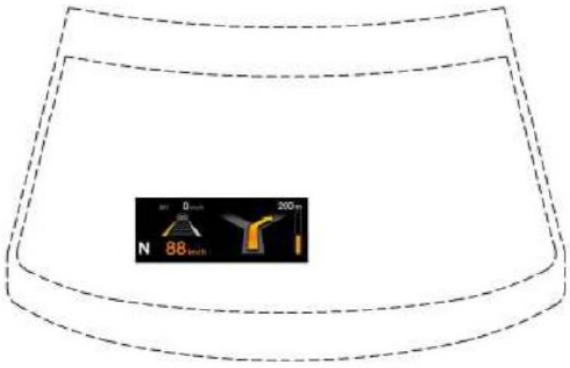
The Guidelines provide the following example of an unregisterable design:[22]



[This is an example of a graphic image on a screen that is not found to constitute a design]

(Graphic image of a website)

Similarly, KIPO published revised examination guidelines regarding the registration of screen image designs, including GUIs, graphic images and icons.[23] In South Korea, a design is required to be an actual product or a portion of a product.[24] The new guidelines allow for protection of screen images even if the design is only temporarily displayed as long as a portion the article where the design is displayed is specified.[25]



Protectable Screen Image

[16] *See* http://www.seiwapat.jp/en/IP/pdf/en00028_Revised_Design_Examination_Guidelines.pdf.
[17] *Id.*
[18] *Id.*
[19] *Id.*
[20] *Id.*
[21] Examination Guidelines for Design, Chapter IV Design Including a Graphic Image on a Screen, English version, available at: https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/design_es/0704.pdf, p. 185.

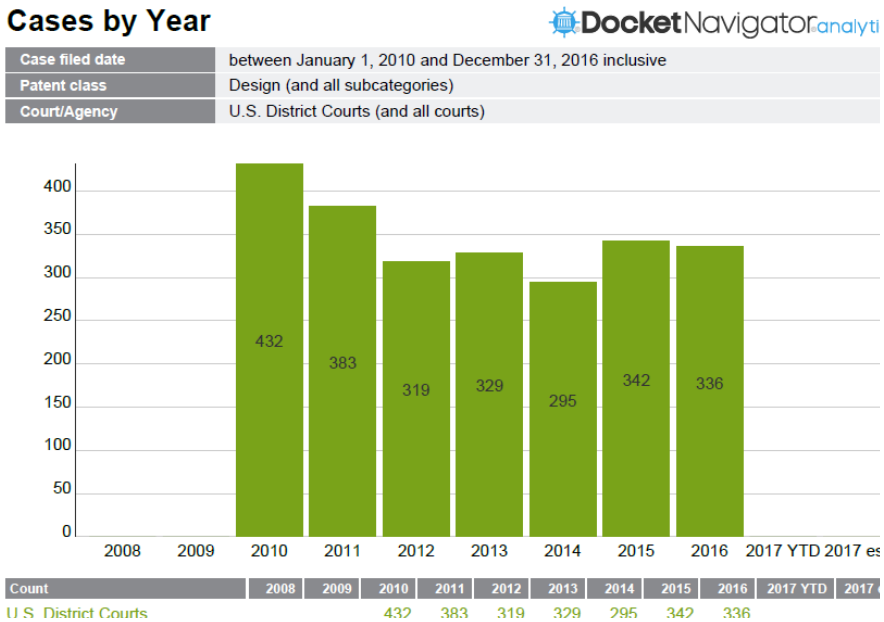
[22] Id., p. 182.
[23] *See* http://www.kimchang.com/newsletter/201604/en/newsletter_ip_en_spring2016_article09.html.
[24] *Id.*
[25] *Id.*

Unprotectable Screen Images

The revised guidelines also address animated designs (requiring applicants to submit two drawings for the design—before and after the animation is complete), as well as priority claims (addressing issues with jurisdictions, like China, that lack a partial design registration system), and similarity of screen image designs (by not allowing further applications on the same screen image).[26]

DESIGN PATENT STATISTICS

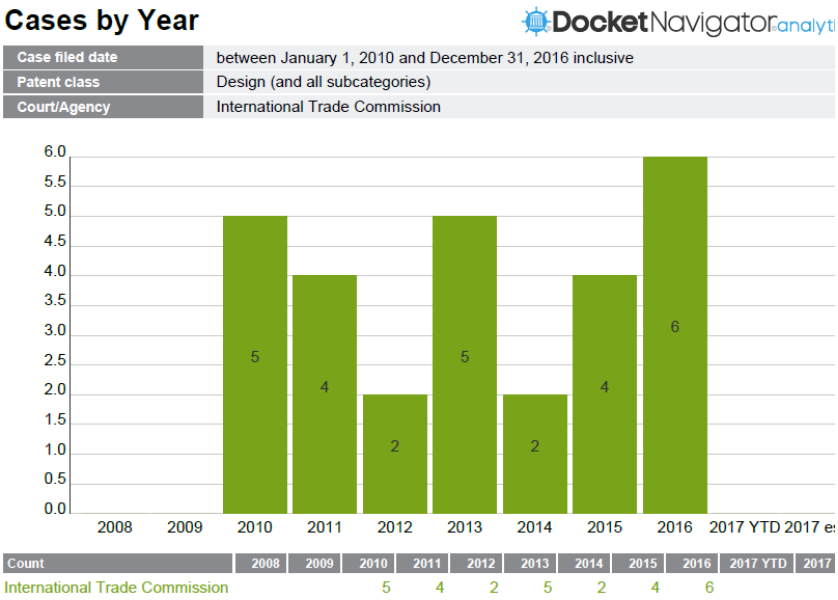
Below is a chart illustrating the number of design patent complaints filed in district courts since 2010, as of December 31, 2016, produced using Docket Navigator's analytics. As can be seen, the number of design patents asserted in district courts has remained relatively steady over the past few years (with a slight jump from 2014 to 2015, and a slight decrease in 2016).



Source: Docket Navigator Analytics, www.docketnavigator.com.

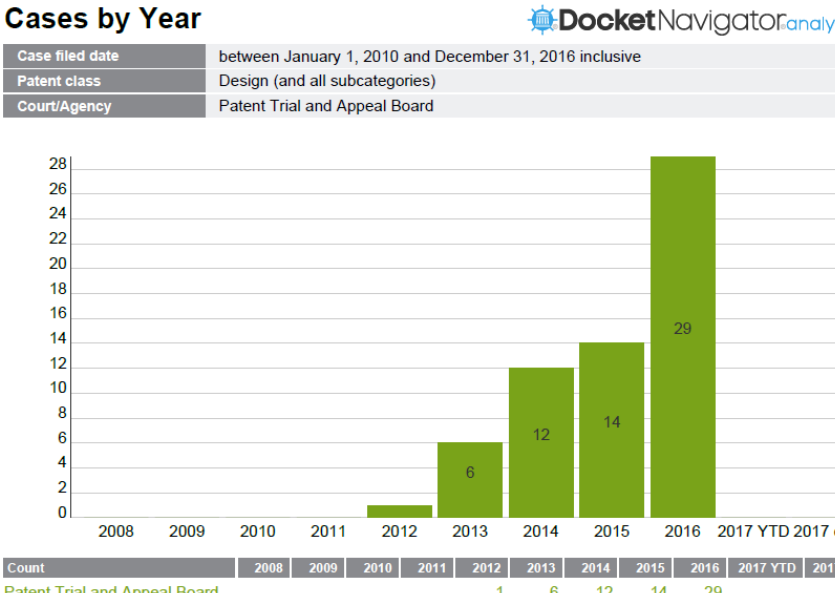
[26] *Id.*

Below is a chart of the number of design patent complaints filed at the International Trade Commission (ITC) since 2010, as of December 31, 2016.



Source: Docket Navigator Analytics, www.docketnavigator.com.

Several post-issuance proceedings became available to invalidate patents with the implementation of the America Invents Act on September 16, 2012. These proceedings include IPRs and PGRs.[27] These post-issuance proceedings have proved to be a valuable tool for invalidating patents. Below is a chart of the number of IPR petitions involving design patents filed with the PTAB as of December 31, 2016. Since 2012, design patent IPR petitions have increased each year, including a substantial jump in 2016. This substantial jump indicates a heavier reliance on the USPTO for design patent dispute resolution, as petitioners take advantage of this PTAB proceeding to challenge the validity of these patents.



Source: Docket Navigator Analytics, www.docketnavigator.com.

[27] The first PGR decision involving a design patent was issued in 2016 and is analyzed herein (*Galaxia Electronics Co., Ltd. v. Revolution Display, LLC*).

DESIGN PATENT DAMAGES

The determination of damages for design patent infringement received significant attention last year with two Federal Circuit opinions: *Apple Inc. v. Samsung Electronics Co., Ltd.*, and *Nordock, Inc. v. Systems Inc.* Petitions for certiorari for both were made to the Supreme Court. In December, the Supreme Court issued an opinion in the *Apple* case and remanded it to the Federal Circuit for further consideration in view of the opinion. Soon after, the Court granted certiorari and then remanded the *Nordock* case for consideration in view of the *Apple* opinion, given that similar issues were involved regarding the scope of the design patent damages provision (35 U.S.C. § 289).

In its opinion, the Supreme Court specified that an "article of manufacture" under § 289 may be an entire device or simply components of that device. Section 289, which is titled "Additional remedy for infringement of design patent," provides the following:

> Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

The Federal Circuit in its *Apple* decision had held that the article of manufacture is the entire device. The Supreme Court however took a broader view of the term.

It is important to note that § 289 is not the only available remedy for design patent infringement. The *Nordock* case demonstrated that a patent owner can seek relief in the form of traditional damages available under either § 284 or § 289.

As detailed below, this latest Supreme Court decision related to design patents leaves much to be determined On February 7, 2017, the Federal Circuit remanded the *Apple* case back to the District Court for the Northern District of California for further proceedings, including a new damages trial if necessary, to set forth a test for identifying the relevant article of manufacture.[28] The Federal Circuit deemed the district court to be in the best position to evaluate the evidence on record. Perhaps 2017 will be another big year in the world of design patent damages with the emergence of a new test for design patent damages.

SAMSUNG ELECTRONICS CO. LTD. V. APPLE INC., NO. 15-777 (DEC. 6, 2016)

The Supreme Court's long-awaited decision in the *Samsung v. Apple* case held that "[i]n the case of a multicomponent product, the relevant 'article of manufacture' for arriving at a § 289 damages award need not be the end product sold to the consumer but may be only a component of that product."[29]

The designs at issue here included three design patents related to the first-generation Apple iPhone released in 2007, such as those covering the rectangular front face with rounded corners (e.g., as depicted below is Figure 1 from US Patent D593,087, one of the three design patents at issue) as well as the grid of icons on the screen.[30]

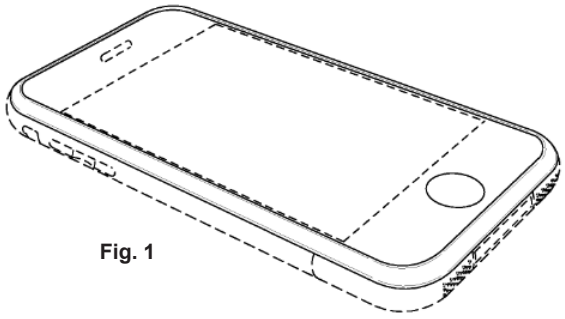


Fig. 1

At trial, a jury found that various Samsung smartphones infringed Apple's design patents.[31] Apple was awarded $399 million in damages.[32] The damages were calculated based on the total profit Samsung made from the sales of the infringing smartphones.[33] The Federal Circuit affirmed the damages because limiting the damages to merely a component (the shell) would be inappropriate as the "innards of Samsung's smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers."[34]

[28] *Apple Inc. v. Samsung Elecs. Co. Ltd*, No. 2014-1335, slip op. at 4-5 (Fed. Cir. Feb. 7, 2017).
[29] *Samsung Elecs. Co. Ltd v. Apple Inc., No. 15-777, slip op. at 1 (Dec. 6, 2016).*
[30] *Id.* at 3.
[31] *Id.* at 4.
[32] *Id.*
[33] *Id.*
[34] *Id.* (citing 786 F.3d 983, 1002 (2015)).

The Supreme Court, however, found differently. First, the Court noted that:

> Arriving at a damages award under §289 thus involves two steps. First, identify the "article of manufacture" to which the infringed design has been applied. Second, calculate the infringer's total profit made on that article of manufacture.[35]

The Court, in focusing on the first step of this inquiry, asked "whether, in the case of a multicomponent product, the relevant 'article of manufacture' must always be the end product sold to the consumer or whether it can also be a component of that product."[36] In essence, the Court found that the text of the statute resolved this case, as § 289 uses the term "article of manufacture" to "encompass[] both a product sold to a consumer and a component of that product."[37] This reading, according to the Court, is consistent with §§ 171(a) and 101, which the Patent Office and courts have understood to extend to "a component of a multicomponent product."[38] The Court held that the Federal Circuit's "narrower reading" of the term "cannot be squared with the text" of the statute.[39]

The Supreme Court did not set out a test to determine what the relevant "article of manufacture" would be in this case because it was "not necessary to resolve the question presented in this case, and the Federal Circuit can address any remaining issues on remand."[40]

Further, following this decision, the Supreme Court granted certiorari and remanded *Systems Inc. v. Nordock, Inc.*,[41] to the Federal Circuit for consideration in view of the *Apple* decision. Notably for the *Nordock* case, the *Apple* decision used the Federal Circuit's *Nordock* opinion as an example of a too-narrow interpretation of "article of manufacture" under § 289.[42]

Thus, the Supreme Court passed the ball back to the Federal Circuit to reconsider its holdings in *Apple* and *Nordock*. As previously noted, the Federal Circuit remanded the *Apple* case based to the district court. The opinions on remand should hopefully explore how to calculate an infringer's total profit made on a determined "article of manufacture" based on the new understanding of § 289 and also provide a test for litigants to apply.

FUNCTIONALITY VERSUS ORNAMENTALITY

In addition to the uncertainty surrounding design patent damages, 2016 also brought forth confusion regarding the debate over the functionality and ornamentality aspects of design patents. Design patents are intended to protect only the nonfunctional, ornamental aspects of an object. The extent to which functionality of a design patent should be included in the scope of a design patent claim is highly debated, with no certain outcome as it involves a subjective assessment. This key issue is typically determined during claim construction, as it has ramifications for both invalidity and infringement analyses. Asserting that a design is primarily functional versus ornamental in nature is an invalidity tool unique to design patents that provides a way to achieve invalidity beyond more "traditional" invalidity paths (e.g., anticipation and obviousness).

The Federal Circuit laid out the test to determine ornamentality versus functionality in 2015 in *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*[43] As stated in 35 U.S.C. § 171,[44] design patents cover only "ornamental" designs. Thus, if a design is "primarily functional rather than ornamental, the patent is invalid."[45] However, "[t]he function of the article itself must not be confused with 'functionality' of the design of the article."[46] The proper inquiry in functionality versus ornamentality must assess "the overall appearance of the article—the claimed design viewed in its entirety," "not the functionality of elements of the claimed design viewed in isolation."[47] A key part of the inquiry is the availability of alternative designs, which is "an important—if not dispositive factor in evaluating the legal functionality of a claimed design."[48] If "there are several ways to achieve the function of an article of

[35] *Id.* at 5.
[36] *Id.*
[37] *Id.* at 6.
[38] *Id.* at 6–7.
[39] *Id.* at 7.
[40] *Id.* at 8.
[41] *Systems Inc. v. Nordock, Inc.*, No. 15-978 (Dec. 12, 2016).
[42] *Apple*, slip op. at 8 (noting that the case declined "to limit a §289 award to a design for a lip and hinge plate because it was welded together with a leveler and there was no evidence it was sold separate[ly] from the leveler as a complete unit.") (quotations omitted).
[43] 796 F.3d 1312 (Fed. Cir. 2015).
[44] "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title."
[45] *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.3d 234, 238–39 (Fed. Cir. 1986).
[46] *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997).
[47] *Ethicon Endo-Surgery*, 796 F.3d at 1329 (Fed. Cir. 2015); *see also Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1455 (Fed. Cir. 1997) ("[T]he determination of whether [a] patented design is dictated by the function of the article of manufacture must ultimately rest on an analysis of its overall appearance.").
[48] *Ethicon Endo-Surgery*, 796 F.3d at 1329–1330.

manufacture, the design of the article is more likely to serve a primarily ornamental purpose."[49]

There are five factors, from the *PHG Technologies* case, that are applied to determine whether a claimed design is dictated by functional considerations:

> [1] whether the protected design represents the best design; [2] whether alternative designs would adversely affect the utility of the specified article; [3] whether there are any concomitant utility patents; [4] whether the advertising touts particular features of the design as having specific utility; and [5] whether there are any elements in the design or an overall appearance clearly not dictated by function.[50]

This year, the Federal Circuit considered the extent to which functional elements play a role in claim construction in *Sport Dimension*. Both the Southern District of Texas and PTAB examined functionality and ornamentality issues in *Top-Co* and *Galaxia*, respectively. Interestingly, as explained below, the Southern District of Texas invalidated a patent due to functionality, while the PTAB declined to institute a PGR due to a lack of evidence illustrating functionality.

SPORTS DIMENSION INC. V. COLEMAN CO., NO. 2015-1553, 2016 U.S. APP. LEXIS 6992 (FED. CIR. APRIL 19, 2016)

In *Sports Dimension Inc. v. Coleman Co.*,[51] the Federal Circuit vacated the judgment of noninfringement awarded to Sports Dimension Inc. (Sports Dimension) and remanded to the District Court for the Central District of California, holding that the claim construction was improper because functional elements of a design patent could also contribute to the overall ornamentation of the device.[52] But, the court still emphasized that the scope of the claims should be limited so that only the appearance of those functional elements is included in the design patent, not the functional aspects themselves.

The court's decision on claim construction is noteworthy because it further demonstrates how and when to delineate ornamental features, which are patentable in design patents, from functional features, which are not.[53] Here, sufficient evidence illustrated that even though certain elements were undeniably functional, this did not preclude their appearance from being a part of the overall ornamentation of the item.

This opinion also illustrates the flexibility and creativity that is expected of trial judges in interpreting the scope of a design patent claim. Specifically, this case was remanded because the trial court did not consider that an element of a design patent with functional use could also serve as part of the overall ornamental design. The court expanded on previous case law establishing that intention of claim construction is neither to be overly broad by allowing functional uses to become part of a design patent, nor to be overly constrictive by rejecting outright the limited patenting of an element with functional purposes for its ornamental aspects alone.

This dispute began when Coleman initiated an infringement action against Sports Dimension for allegedly infringing US Patent No. D623,714 (the '714 Patent). This patent claims "the ornamental design for a personal flotation device," as shown below in Figure 1 and Figure 2.[54]

Fig. 1

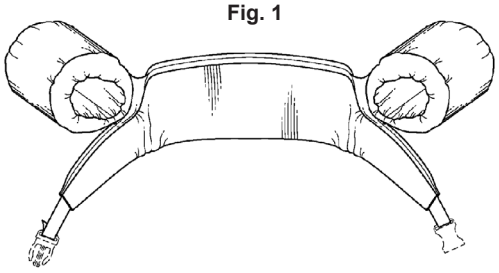
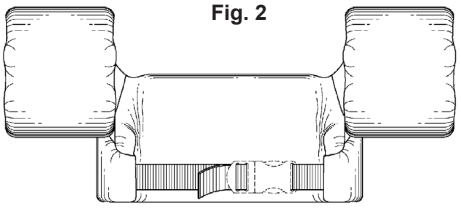


Fig. 2



[49] *Id.* at 1330 (citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

[50] *PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1366 (Fed. Cir. 2006) (quoting *Berry Sterling Corp v. Pescor Plastics, Inc.,* 122 F.3d 1452, 1455 (Fed. Cir. 1997)).

[51] No. 2015-1553, 2016 U.S. App. LEXIS 6992 (Fed. Cir. April 19, 2016).

[52] Coleman Company (Coleman) also appealed the district court's decision to exclude the testimony of an expert witness, but this was upheld because the court found no abuse of discretion by the trial judge. No. 2015-1553, 2016 U.S. App. LEXIS 6992 at *13–14 (Fed. Cir. April 19, 2016).

[53] *Id.* at *5 (citing *Egyptian Goddess, Inc. v. Swisa*, Inc., 543 F.3d 665, 668 (Fed. Cir. 2008)) ("A design patent is invalid if its overall appearance is 'dictated by' function."); *but see Ethicon Endo-Surgery*, 796 F.3d 1312, 1333 (Fed. Cir. 2015) (citing *Richardson v. Stanley Works*, Inc., 597 F.3d 1288, 1293-94 (Fed. Cir. 2010)) (holding that if the patent is not primarily functional, "the design claim is not invalid, even if certain elements have functional purposes.").

[54] *Sports Dimension,* 2016 U.S. App. LEXIS 6992, at *2.

The ’714 Patent claims a personal flotation device with two arm bands connected to a flat torso piece, which tapers to connection straps on either side. Sports Dimension sells a personal flotation device known as the “Body Glove® Model 325,” which is depicted below.[55]

Sports Dimension argued at the trial court that the two items did not infringe the ’712 Patent because they were sufficiently distinct. Specifically, Sports Dimension asserted that the arm tubes, straps and buckle in the patent served functional purposes, and were therefore not protected by a design patent. The district court agreed and ruled in their favor. On appeal, Coleman argues that these features are not functional in nature and are instead part of the overall ornamentation.

The Federal Circuit fully agreed with neither the decision of the district court on claim construction nor the argument laid out by Coleman in the appeal. Rather, the court morphed aspects of both arguments to reach its final ruling, finding that certain aspects of the device were certainly functional (contrary to Coleman’s position), but that this finding did not automatically mean those features served no ornamental purpose (contrary to the district court’s position).[56]

In rejecting the district court’s complete preclusion of functional elements, the Federal Circuit pointed to prior cases where it had found that functional features could certainly play a dual role in adding to the ornament of the device, and could thus be patented under a design patent.[57] The court also asserted that because these design patents ultimately protected items that held “utilitarian purpose,” ornamental design patent elements would inevitably overlap with functional purposes.[58]

But, the Federal Circuit still rejected Coleman’s argument that the features identified did not actually serve a functional purpose.[59] To the contrary, it ruled that substantial evidence existed that these were functional features, perhaps even primarily so.[60]

The court, citing *PHG Technologies,* analyzed the facts of this case to determine if the design was dictated by primarily functional considerations.[61] In doing so, the court found that the armbands and side torso tapering in the ’714 Patent serve a “functional purpose” based largely on the same information that convinced the trial judge.[62]

Yet this finding that these were functional features did not preclude the court from considering that these features might also be a part of the ornamentation of the device.[63] The trial court never considered this possibility, ruling for noninfringement as soon as it found the features to hold functional value. However, the Federal Circuit believes the law calls for greater judicial creativity than that sort of hard-line rule.[64] The court held that “[b]y eliminating structural elements from the claim, the district court improperly converted the claim scope of the design patent from one that covers the overall ornamentation to one that covers individual elements,” which was improper because it disregarded the whole design.[65]

The court further noted that although the armbands and side torso tapering served functional purposes, “so the fact finder should not focus on the particular designs of these elements when determining infringement, but rather focus on what these elements contribute to the design’s overall ornamentation.”[66] The court then concluded that

[55] *Id.*
[56] *Id.* at *11–12.
[57] *Id.* at *5–8 (citing *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997); *Ethicon Endo-Surgery Inc., v. Covidien, Inc.,* 796 F.3d at 1333; *Richardson v. Stanley Works, Inc.*, 610 F. Supp. 2d 1046, 1050 (D. Ariz. 2009)).
[58] *Id.* at *5 (citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993)).
[59] *Id.* at *9 (“While we agree with Coleman that the court’s ultimate construction was improper under our law, we disagree with Coleman’s assertion that the armbands and side torso tapering do not serve a functional purpose.”).
[60] *Id.*
[61] *Id.* at *9–10 (citing *PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1366 (Fed. Cir. 2006) (quoting *Berry Sterling Corp v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1455 (Fed. Cir. 1997)).
[62] *Id.* at *10 (Finding that this design was the best available, there was a co-pending utility patent heavily based on the function of these features, and Coleman’s advertising promoted the functional advantage of their design).
[63] *Id.* at *11.
[64] *Id.*
[65] *Id.* at *11–12.
[66] *Id.* at *12.

because of the many functional elements, the claim scope was narrow.[67]

Because of the court's demand for broader, more flexible interpretation of design patents, it vacated the noninfringement judgment and remanded the case to the district court for reconsideration.[68]

This decision reinforces the difficulty in construing the scope of design patents, particularly in the case of functional elements. As the Federal Circuit noted, "words cannot easily describe ornamental designs."[69] This case illustrates why.

TOP-CO INC. V. SUMMIT ENERGY SERVICES, INC., NO. 4:13-CV-00445 (S.D. TEX. MAR. 8, 2016)

The court found the asserted design patent invalid due to the patented design being primarily functional and thus, there was no infringement.[70] The court's order was issued following the *Markman* hearing.[71]

The asserted design patent, D664,568 (the '568 Patent), claims the design for a "casing centralizer" used in the oil industry. Figure 1 of the '568 Patent is reproduced below:

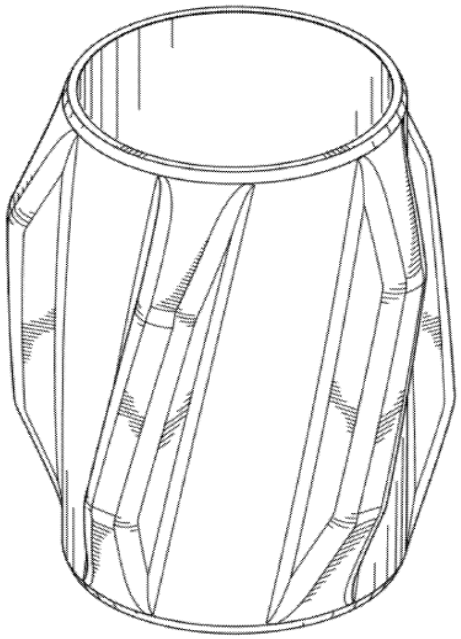


Fig. 1

[67] *Id.* (citing *Ethicon Endo-Surgery Inc., v. Covidien, Inc.*, 796 F.3d at 1334 (endorsing a "limited" claim scope for a design with functional elements).
[68] *Id.*
[69] *Id.* at *4.
[70] *Top-Co Inc. v. Summit Energy Servs., Inc.*, No. 4:13-CV-00445, slip op. at 8 (S.D. Tex. Mar. 8, 2016) (Dkt. No. 91).
[71] *Id.* at 1.

The court walked through the applicable law for construction, focusing on the protection of ornamental instead of functional aspects of a design.[72] The court, citing *L.A. Gear*, noted that functional elements can have ornamentality and that the ultimate question is "whether the article is driven by functional or ornamental considerations."[73] The court further noted that a judgment of invalidity is proper during claim construction when it is found that the article is driven primarily by functional considerations.[74]

The court noted the relevant factors from *PHG Technologies* and assessed whether the claimed design is dictated by functional or ornamental considerations.[75] Importantly, the court noted that these factors are not mandatory.[76]

The plaintiff maintained that the design was predominantly ornamental and the defendant contented that is was primarily functional.[77] The plaintiff contended that its design was meant to look smoother but did not address drag problems encountered in the industry—the court noted that this position was not supported by the evidence.[78] Accordingly, the court noted that its review of the evidence led to a determination that the centralizer in the asserted patent was "not designed with a primarily ornamental purpose."[79]

The court walked through the evidence at issue from marketing materials to deposition evidence from the named inventors (of which two named inventors took differing positions on the design features).[80] Lastly, in a short paragraph, the court addressed the *PHG Technologies* factors, noting that its decision was correct based on even "cursory review."[81] The court held that the evidence was clear and convincing that the design was primarily driven by functional considerations.[82] As result, this case illustrates the power of functionality versus ornamentality arguments in invalidating a design patent.

[72] *Id.* at 2–3.
[73] *Id.* at 3 (citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993)).
[74] *Id.* (citing *Richardson v. Stanley Works*, 597 F.3d 1288, 1293–94 (Fed. Cir. 2010)).
[75] *Id.* (citing *PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1365–66 (Fed. Cir. 2006)).
[76] *Id.*
[77] *Id.* at 4.
[78] *Id.*
[79] *Id.*
[80] *Id.* at 4–6.
[81] *Id.* at 7.
[82] *Id.*

GALAXIA ELECTRONICS CO., LTD. V. REVOLUTION DISPLAY, LLC, CASE NO. PGR2016-00021 (PTAB NOVEMBER 2, 2016)

The PTAB denied institution of a PGR of US Patent No. D736,750 (the '750 Patent).[83] One issue presented by the petitioner was that the design lacked ornamentality under 35 U.S.C. § 171.[84] The PTAB found that the petitioner did not provide enough evidence to support its assertion that the design was primarily functional.[85]

The '750 Patent is titled "Modular Video Support Frame Member." Figures 1 and 2 from the patent are reproduced below.[86]

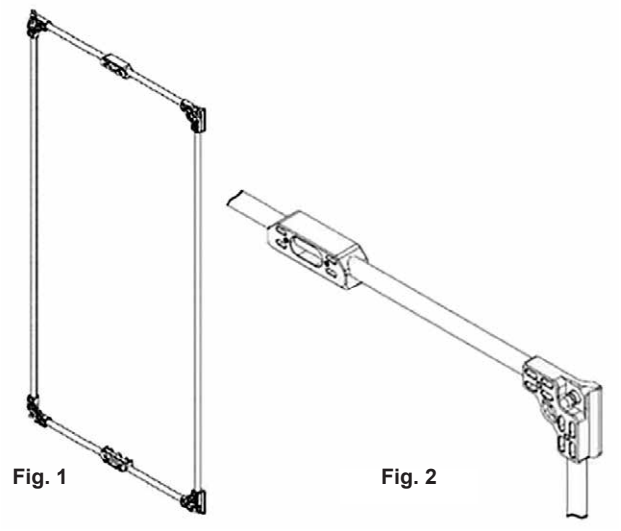


Fig. 1 Fig. 2

The petitioner's argument that the '750 Patent is invalid because the claimed design is primarily functional failed for lack of evidence. The petitioner relied upon the same evidence for this ground of rejection as it relied upon for its inventorship arguments (which is a second ground presented by the petitioner and discussed below).[87] Arguing that "[n]othing about the overall shape or the design and placement of individual elements … was motivated by an ornamental purpose,"[88] the petitioner walked through the various elements of the claimed object and alleged each had a functional purpose.[89]

The evidence indicated that a number of ornamental designs would all perform the same function. Accordingly, the PTAB specified that, on its face, the evidence supported a finding that the designs were purely ornamental. To the extent the petitioner was arguing that the differences in each design were dictated by various functions, the PTAB noted that petitioner did not explain or provide evidence to support this theory. In contrast, the patent owner argued that the evidence actually demonstrated the ornamentality of the claimed design since the evidence showed multiple different designs that performed the same function as the claimed design.[90]

The PTAB agreed with the patent owner "that the record does not support a finding that the '750 patent design is primarily functional."[91] Citing *Power Controls*, the PTAB noted that if "the patent design is primarily functional rather than ornamental, the patent is invalid."[92] Importantly, the PTAB noted that "[t]he function of the article itself must not be confused with 'functionality' of the design of the article."[93] Then, the PTAB noted that the inquiry into functionality begins by assessing the availability of alternative designs, which can be "an important—if not dispositive factor" in the inquiry and that the inquiry must focus on the overall appearance rather than the functionality of the elements in isolation.[94]

The PTAB noted that the petitioner performed the incorrect inquiry by focusing on the functionality of each element (i.e., the corner block, the rectangular shape and the midframe portions) and failed to address the availability of alternative designs, which were raised by its own declarant.[95] Further, the petitioner failed to "explain how each and every aspect of the claimed design is dictated by function."[96] Thus, the petitioner failed to meet its burden on this ground of invalidity.[97] Accordingly, the petition for PGR was denied.[98]

This decision is informative as it applies the test for functionality laid from last year's *Covidien* opinion. It is important to remember the points of this test when challenging functionality in a claimed design and to focus arguments accordingly.

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[83] *Galaxia Elects. Co., Ltd. v. Revolution Display, LLC*, Case No. PGR2016-00021, Paper 11, at 14 (Nov. 2, 2016) (Decision denying institution of PGR).
[84] *Id.* at 2.
[85] *Id.*
[86] *Id.* at 3.
[87] *Id.* at 10.
[88] *Id.*
[89] *Id.* at 10–11.
[90] *Id.* at 11.
[91] *Id.*
[92] *Id.* (citing *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.3d 234, 238–39 (Fed. Cir. 1986)).
[93] *Id.* (citing *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997)).
[94] *Id.* (citing *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1329–30 (Fed. Cir. 2015)).
[95] *Id.* at 12.
[96] *Id.* at 13.
[97] *Id.* at 14.
[98] *Id.* at 14.

INVALIDITY AND INFRINGEMENT

Understanding the scope of a claim is pivotal in determining infringement and invalidity of a design patent. Several decisions from the PTAB illustrate the application of obviousness analysis to design patents. As may be gleaned from the obviousness analyses below, including an expert declaration to support conclusions of obviousness is not only helpful, it may be a relevant factor in obtaining a successful outcome from an IPR or PGR trial. Further, even though a patent owner does not submit an expert declaration, or even a response, in an IPR, or other post-issuance proceeding, the PTAB still evaluates the evidence on its merits and determines whether the petitioner has met its burden of proving invalidity.

This past year also introduced several interesting infringement analyses. The *Wallace* case illustrates a great example of a complete infringement analysis applying *Egyptian Goddess*, while the *Weber* case provides contrasting outcomes for noninfringement at the summary judgment stage. The *Columbia Sportswear* case presents a unique discussion regarding the use of utility patents as prior art in an infringement analysis. And finally, the *PMS* case, although from the United Kingdom, provides insight into analyzing Computer Aided Design (CAD) drawings. Further, it is important to understand how a European Community Design is interpreted and how the infringement analysis is performed.

OBVIOUSNESS

The obviousness analysis for design patents differs from that used for utility patents. For the obviousness analysis of design patents, the question "is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved."[99] The obviousness test consists of two steps.[100] In the first step, a primary reference (sometimes referred to as a "Rosen reference") must be found, "the design characteristics of which are basically the same as the claimed design."[101] This first step consists of two-part inquiry under which "a court must both '(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates "basically the same" visual impression.' "[102] The second step consists of modifying the primary reference with secondary references "to create a design that has the same overall visual appearance as the claimed design."[103] However, the "secondary references may only be used to modify the primary reference if they are 'so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.' "[104] It is important to note that "a designer of ordinary skill" is a different individual than the "ordinary observer" of the design patent infringement test. Typically, an expert is used to define this designer of ordinary skill, just as one would define a person of ordinary skill in the art.

LOWE'S HOME CENTERS, LLC V. REDDY, IPR2015-00306 (PTAB MARCH 30, 2016)

Stemming from a design patent infringement case in the District of Massachusetts last year,[105] Lowe's Home Centers, LLC (Lowe's) filed a petition for IPR against US Patent No. D677,423 (the '423 Patent), which was instituted on April 28, 2015.[106,107] The '423 Patent discloses a design for an ornamental vanity light fixture.[108] US Patent No. 7,156,537 (Cohrs) was cited for both anticipatory and obviousness grounds.[109] Cohrs is a utility patent for a light shade with a design description similar to that of the '423 Patent.[110]

Lowe's argued that the '423 Patent was anticipated by Cohrs because both designs would be substantially similar to an ordinary observer.[111] The patent owner responded that the '423 Patent could not be anticipated by Cohrs because it was nonenabling and indefinite.[112] Lowe's further argued that the '423 Patent was obvious over Cohrs because both designs disclosed the same visual impression to an ordinarily skilled designer.[113] The

[99] *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1335 (Fed. Cir. 2013); *see also Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)).
[100] *Apple*, 678 F.3d at 1329.
[101] *Id.* (quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)).
[102] *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d at 1311–12 (quoting *Durling*, 101 F.3d at 103).
[103] *Id.* at 1311.
[104] *Durling*, 101 F.3d at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).
[105] *Reddy v. Lowe's Cos.*, 2015 U.S. Dist. LEXIS 128420 (D. Mass. Sept. 24, 2015) (holding that no design patent infringement occurred because the substantial differences in the shape and sizes of the accused models created a "distinct overall impression" from the '423 Patent).
[106] *Lowe's Home Centers, LLC v. Reddy*, IPR2015-00306, Paper No. 7 (Institution Decision).
[107] Hunton & Williams LLP served as counsel for Lowe's in both the district court case and before the PTAB in the IPR proceeding.
[108] *Lowe's*, IPR2015-00306, Paper No. 21, at 2 (March 30, 2016) (Final Written Decision).
[109] *Lowe's*, IPR2015-00306, Paper No. 1, at 10–11 (Petition).
[110] *Id.* at 5.
[111] *Id.* at 15.
[112] *Lowe's*, IPR2015-00306, Paper No. 10, at 6–8 (Corrected Response of Patent Owner).
[113] *Lowe's*, IPR2015-00306, Paper No. 1, at 22.

patent owner responded that secondary considerations supported a determination of nonobviousness over Cohrs.[114] The PTAB held that the '423 Patent was obvious only over Cohrs, and invalidated the '423 Patent based solely on that claim.[115]

The '423 Patent claims an "ornamental fixture consisting of a rectangular, metal rod skeleton, wrapped in fabric on three sides (front side, left side, right side), with a stationary acrylic diffuser bottom."[116] Lowe's argued that these descriptive features were similar to the ones contained in Cohrs.[117] Cohrs describes "a light shade designed to fit over a strip of light and be attached to a wall."[118] Cohrs also discloses decorative features of the bathroom vanity strip light shade.[119] It states that materials such as "cloth, paper, wood products, rattan, and other similar features" could be attached to the frame of the open rectangular box for a finished shade.[120] A comparison of the '423 Patent (Figure 5) and Cohrs (Figure 6) is reproduced below.[121]

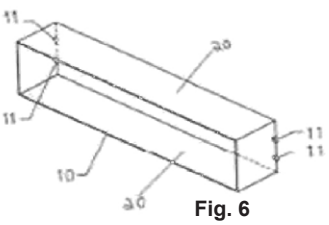


Fig. 6

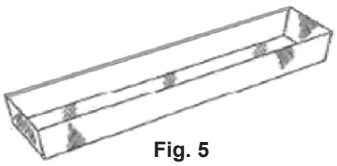


Fig. 5

First, the PTAB held that the sole claim of the '423 Patent was not anticipated under 35 U.S.C. § 102(b).[122] The PTAB analyzed Lowe's anticipation claim under the ordinary observer test.[123] A design patent can be anticipated and invalidated by a prior patent only if "in the eye of an ordinary observer … two designs are substantially the same … inducing him to purchase one supposing it to be the other."[124] Under case law, courts generally exclude functional design elements from consideration in the ordinary observer test.[125]

The patent owner asserted that a utility patent is inherently functional, which excluded Cohrs from the prior art definition.[126] Lowe's noted that the patent owner did not cite any case law supporting her argument.[127] The PTAB sided with Petitioner, stating that it is well-settled law "that teachings of a prior art utility patent may be considered in a design context."[128] Cohrs also discloses relevant design features, qualifying it as § 102(b) prior art to the '423 Patent.[129]

The patent owner also claimed that Cohrs was indefinite because it did not enable a reader to recreate the invention by its description alone.[130] The PTAB held that the patent owner confused the requirement that an asserted anticipatory reference be sufficiently enabling to an ordinarily skilled designer with the definiteness requirement under 35 U.S.C. § 112.[131] Definiteness under § 112 relates only to patent claims under scrutiny, not to claims in a prior art disclosure.[132] Recognizing that prior art is "presumed to be enabling," the PTAB found that the patent owner did not present enough evidence to overcome that presumption.[133]

Lowe's argued that Cohrs' design is substantially the same as the ornamental design claimed in the '423 Patent.[134] The similarities in the rectangular shape, proportionally thin surfaces and plain interiors would make the two designs indistinguishable to an ordinary observer.[135] While the PTAB acknowledged that design similarities existed between the two patents, they also noted an important difference on Cohrs' surface.[136] Many materials, like wood, paper and rattan, could be used as a finished shade on the surface of Cohrs' design.[137] The '423 Patent describes only a translucent plastic surface.[138] Due to Cohrs' allowance of surface design modifications, the PTAB reasoned that ordinary observers could easily separate the two vanity light shades.[139] Since Lowe's could not meet their burden of proof, the PTAB held that Cohrs did not anticipate the '423 Patent.[140]

[114] *Lowe's*, IPR2015-00306, Paper No. 10, at 34.
[115] *Lowe's*, IPR2015-00306, Paper No. 21, at 30.
[116] *Id*. at 3-4.
[117] *Lowe's*, IPR2015-00306, Paper No. 1, at 15.
[118] *Lowe's*, IPR2015-00306, Paper No. 21, at 6.
[119] *Id*.
[120] *Id*. at 7.
[121] *Id*. at 13.
[122] *Id*. at 16.
[123] *Id*. at 8 (citing *Int'l Seaway Trading Corp. v. Walgreens Corp*., 589 F.3d 1233, 1240 (Fed. Cir. 2009)).
[124] *Id*. (citing *Int'l Seaway*, 598 F.3d at 1239 (quoting *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871))).
[125] *Reddy*, 2015 U.S. Dist. LEXIS at *6 (citing *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1336 (Fed. Cir. 2015)).
[126] *Lowe's*, IPR2015-00306, Paper No. 10, at 6.
[127] *Lowe's*, IPR2015-00306, Paper No. 11, at 6 (Petitioner's Reply).
[128] *Lowe's*, IPR2015-00306, Paper No. 21, at 9 (citing *In re Aslanian*, 590 F.2d 911, 913 (C.C.P.A. 1979)).
[129] *Id*.
[130] *Lowe's*, IPR2015-00306, Paper No. 10, at 8.
[131] *Lowe's*, IPR2015-00306, Paper No. 21, at 10.
[132] *Id*. at 10–11.
[133] *Id*.
[134] *Lowe's*, IPR2015-00306, Paper No. 1, at 15.
[135] *Lowe's*, IPR2015-00306, Paper No. 21, at 14.
[136] *Id*.
[137] *Id*. at 15.
[138] *Id*. at 16 .
[139] *Id*.
[140] *Id*.

Next, the PTAB held the ’423 Patent to be obvious over Cohrs under 35 U.S.C. § 103.[141]

Lowe’s argued that Cohrs “readily suggests to a designer of ordinary skill the ‘minor modifications’ necessary to render the claimed design unpatentable as obvious over Cohrs.”[142] Lowe’s pointed to multiple similarities, backed up by both the patent owner’s deposition and expert witness testimony.[143] The main similarities included a rectangular frame made of metal rods, opaque vertical surfaces, an open top and a translucent diffuser bottom.[144]

The patent owner refuted the similarities by pointing out the allowance for “substantial modifications” in Cohrs.[145] A designer could use alternative surface materials, making Cohrs’ design ambiguous to an ordinarily skilled designer.[146] The patent owner argued that these design modifications in Cohrs did not disclose the same vanity strip light shade claimed in the ’423 Patent.[147] The PTAB stated that these minor modifications served little relevance to the overall design impression.[148] Additionally, the patent owner did not make such counter-statements in her deposition.[149]

The PTAB held the ’423 Patent obvious over Cohrs because of the design similarities and the limited relevance alternative design modifications in Cohrs.[150] The PTAB agreed with Lowe’s over the similarities, and believed that “such straightforward design features are adequately described … so as to suggest a finite number of known design alternatives” to an ordinarily skilled designer.[151] Even with minor design changes, an ordinarily skilled designer would still imagine the same basic light fixture under Cohrs and the ’423 Patent.[152] The PTAB relied heavily on Lowe’s expert witness testimony in its holding.[153]

Finally, the PTAB held the patent owner’s secondary consideration claims to be insufficient.[154] Secondary considerations may include “long-felt but unmet needs, failure of others, unexpected results, commercial success, copying, licensing, and praise.”[155] Ultimately, each secondary consideration asserted by the patent owner “must establish a nexus” between the evidence and the patented design.[156]

The patent owner asserted multiple secondary considerations, including the success of the ’423 Patent, the recognized problem of dated “Hollywood” strip light fixtures and the failure of others to address this problem.[157] The patent owner pointed to similar light fixtures, including Cohrs, and argued that these designs did not meet the same commercial success as the ’423 Patent.[158] The PTAB was unpersuaded by this evidence.[159] The PTAB reasoned that admitting the existence of design similarities between the two patents undercut the patent owner’s own argument.[160] Additionally, the patent owner tried to give evidence of copying by using the Lowe’s designs in the previous district court case as examples.[161] However, the district court held those designs were dissimilar to the ’423 Patent.[162] Since the district court found the Lowe’s designs to be dissimilar, this could not be evidence of copying.[163] Based on the lack of evidence, the PTAB held the ’423 Patent obvious over Cohrs.[164]

In summary, the PTAB held the ’423 Patent obvious over Cohrs under 35 U.S.C. § 103.[165] Relying heavily on Lowe’s expert witness testimony, the PTAB reasoned that the minor design modifications allowable in Cohrs did not change its overall visual impression.[166] An ordinarily skilled designer of lampshades could imagine the same light fixture as described in both Cohrs and the ’423 Patent.[167] The PTAB further held that Cohrs did not anticipate the ’423 Patent under 35 U.S.C. § 102(b).[168] Based on the design modifications in Cohrs, the PTAB reasoned that Cohrs and the ’423 Patent would not be substantially similar to an ordinary observer.[169] As a

[141] *Id*. at 26.
[142] *Lowe’s*, IPR2015-00306, Paper No. 1, at 22–23.
[143] *Lowe’s*, IPR2015-00306, Paper No. 21, at 21–26.
[144] *Id*.
[145] *Lowe’s*, IPR2015-00306, Paper No. 10, at 21.
[146] *Id*.
[147] *Id*.
[148] *Lowe’s*, IPR2015-00306, Paper No. 21, at 21.
[149] *Id*. at 20.
[150] *Id*. at 26.
[151] *Id*. at 24.
[152] *Id*. at 21 (citing *In re Rosen*, 673 F.2d 388, 390 (Fed. Cir. 1982)).
[153] *Id*. at 22.
[154] *Lowe’s*, IPR2015-00306, Paper No. 10, at 34–40.
[155] *Lowe’s*, IPR2015-00306, Paper No. 21, at 27 (citing *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007)).
[156] *Id*. (citing *In re GPAC Inc*., 57 F.3d 1573, 1580 (Fed. Cir. 1998)).
[157] *Lowe’s*, IPR2015-00306, Paper No. 10, at 34–40.
[158] *Id*. at 35-36.
[159] *Lowe’s*, IPR2015-00306, Paper No. 21, at 28.
[160] *Id*.
[161] *Lowe’s*, IPR2015-00306, Paper No. 10, at 36–38.
[162] *Reddy*, 2015 U.S. Dist. LEXIS at *14.
[163] *Lowe’s*, IPR2015-00306, Paper No. 21, at 30.
[164] *Id*.
[165] *Id*.
[166] *Id*. at 26.
[167] *Id*.
[168] *Id*. at 30.
[169] *Id*. at 16.

result, the PTAB invalidated the ’423 Patent based solely on the Petitioner’s obvious claim.[170]

CATERPILLAR, INC. V. MILLER INTERNATIONAL, LTD., IPR2015-00416 (PTAB JUNE 14, 2016)

The PTAB issued a final written decision in this IPR.[171] Interestingly, in this IPR the patent owner did not file a preliminary response or a patent owner response.[172] Indeed, no counsel for the patent owner even entered an appearance in the IPR.[173] The PTAB conducted a conference call with counsel for Caterpillar (the Petitioner) and counsel for Miller (from other proceedings involving unrelated Miller utility patents) and Miller’s counsel indicated that no counsel would enter an appearance.[174] The PTAB decided to proceed on the merits of the case, based on the unrebutted petition.[175] The PTAB noted that regardless of the patent owner’s not replying or even entering an appearance, the petitioner’s burden remained to show, “by a preponderance of the evidence, that the challenged claims are unpatentable.”[176] Being a design patent, there was of course only one claim at issue. The petitioner originally challenged the claim as being unpatentable as obvious based on eight grounds.[177] The PTAB instituted trial on only two of these proposed grounds (obvious over the Coupler Manual[178] and Hub[179] and obvious over the Coupler Manual, Hub and Teo[180]).[181]

The challenged patent is US Patent No. D673,982 (the ’982 Patent).[182] The patent claims a design for a warning symbol that is affixed to an earth-moving machine’s coupler mechanism. Figures 1 and 3 of the ’982 Patent are reproduced below:[183]

Fig. 1

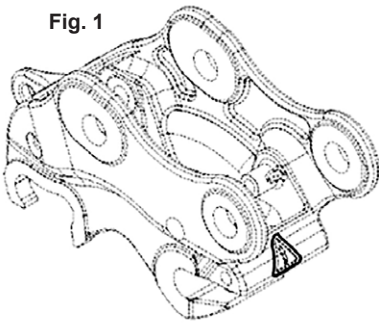


Figure 1 is a “perspective view of an operator visible warning symbol on a coupler.” id. (Figure Description).

Fig. 3

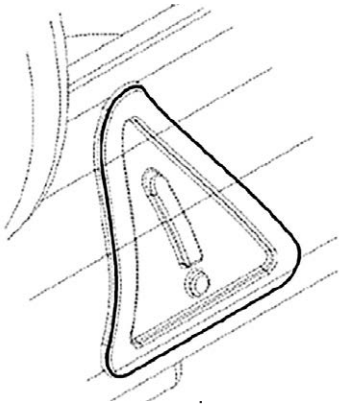


Figure 3 is “an enlarged perspective view” of the operator visible warning symbol on a coupler. id. (Figure Description).

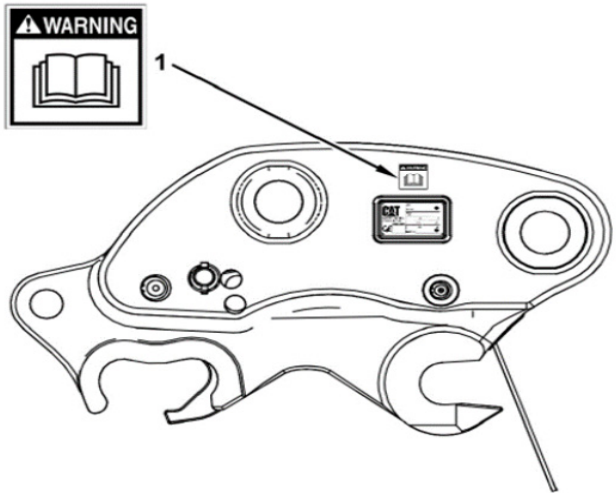
was applied by the PTAB:

…e operator visible
…d in Figures 1–7,
…form no part of the
…rnamental design
…ngle with rounded corners and a horizontal base that is shaped as if projected onto a laterally extruded “S”-shaped surface, as shown in the solid lines in Figs. 1–7 of the ’982 patent.[184]

Analysis then proceeded to the instituted obviousness grounds, including noting the definition of a designer of ordinary skill in the art that was based on the testimony of Petitioner’s expert (which, of course, was unrebutted).[185]

[170] *Id.* at 30.
[171] *Caterpillar, Inc. v. Miller Int’l, Ltd.*, IPR2015-00416, Paper 7 (June 14, 2016) (Final Written Decision).
[172] *Id.* at 2.
[173] *Id.*
[174] *Id.* at 2-3.
[175] *Id.* at 3.
[176] *Id.*
[177] *Caterpillar*, IPR2015-00416, Paper 4, at 3-4. (June 14, 2016) (Institution Decision).
[178] Caterpillar Operation and Maintenance Manual: Cast Manual Pin Grabber Coupler (“Coupler Manual”).
[179] Coupler Confusion: Why the changes and what are the facts? Hub (Nov. 9, 2009), http://www.hub-4.com/news/s1/2014/coupler-confusion-why-thechanges-and-what-are-the-facts. (“Hub”).
[180] WIPO PCT Application, WO 02/090144 to Teo (Teo).
[181] *Id.* at 13.
[182] *Caterpillar*, IPR2015-00416, Paper 7, at 1 (June 14, 2016).
[183] *Id.* at 4.
[184] *Id.* at 5.
[185] *Id.* at 7–8.

First, the combination of Coupler Manual and Hub was considered.[186] The Coupler Manual is the primary, or *Rosen*, reference. The relied upon figure from the Coupler Manual is shown below:[187]



The key feature relied upon is the triangular warning symbol in the upper left corner of the "Warning" label. The petitioner argued that the "only difference" between the claimed design and the Coupler Manual warning symbol is that the claimed design is on a curved surface and the prior art's design is on a flat surface.[188] The below images from the written decision provide a comparison between the claimed design and the Coupler Manual.[189]

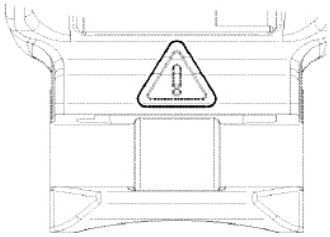


Fig. 7

Above as Figure 7 of the '982 patent illustrating the claimed operator visible warning symbol.

Above is the triangular warning symbol shown in the Coupler Manual

Based on this comparison, the PTAB accepted the Coupler Manual as "a suitable primary reference" because the reference "gives the same overall visual impression when compared to the claimed warning symbol design as a whole.[190] The PTAB further noted that "any apparent minor differences in the designs are of little, if any significance to the ordinary observer" because the warning symbol is "well-known" and an international standard that would have been understood by a person skilled in the art.[191] The PTAB included an example of a general warning sign (provided by the petitioner) as support for this premise and noted that "[t]he requirement that the design characteristics of the proposed primary reference be the same as the claimed design does not imply that the appearance of the prior art article must be identical to the claimed design."[192]

Next, the PTAB analyzed the Hub reference. The Hub reference depicts a coupler having a curved surface above the open attachment jaw and facing out of the page.[193]

The Hub reference was deemed a suitable secondary reference because it disclosed a coupler for an earth-moving machine like the primary reference. The PTAB held, based on the petitioner's arguments and expert, "that one of ordinary skill in the art would look to the curved portion of Hub's coupler facing the operator 'as the reasonable location for moving the warning symbol disclosed in the Coupler Manual' because, in this location on the coupler, the symbol would be 'readily visible to the

[186] *Id.* at 8.
[187] *Id.* at 8.
[188] *Id.* at 9.
[189] *Id.*
[190] *Id.*
[191] *Id.* at 9–10.
[192] *Id.* at 10 (citing *In re Lamb*, 286 F.2d 610, 611 (C.C.P.A. 1961) ("[T]he mere fact that there are differences over the prior art structures is not alone sufficient to justify a holding that the design is patentable.").
[193] *Id.* at 11.

operator of the earth-moving equipment.' "[194] The PTAB, adopting petitioner's analysis, held that the single claim was obvious based on this evidence.[195]

Second, the combination of Coupler Manual, Hub and Teo was considered.[196] In this combination, Teo was relied upon as disclosing affixing a warning symbol to a curved surface. Teo is a PCT application that disclosed "in many parts of the world, a warning symbol of a road hazard, 'commonly being of a triangular shape,' is well known to drivers.[] Moreover, Teo discloses how this well-known warning symbol could be affixed in such a way as to be 'mould[ed]' to the "curved surface" of a vehicle, such as the trunk of a car."[197]

The PTAB agreed with the petitioner that Teo was a valid secondary reference and it "discloses a warning symbol affixed or supported on a curved vehicle component, is so related to the Coupler Manual that the appearance of features in Teo would suggest the application of those features to the Coupler Manual."[198] The PTAB adopted petitioner's reasoning and held that the single claim was obvious based on this evidence.[199]

This case is important for its application of obviousness in a design context, demonstrating the standards for determining proper primary and secondary references as well as the combination thereof.

PREMIER GEM CORP. V. WING YEE GEMS & JEWELLERY LTD., IPR2016-00434 (PTAB JULY 5, 2016)

The PTAB denied institution of this IPR.[200] The challenged patent is US Patent No. D618,132 (the '132 Patent).[201] The '132 Patent claims the "ornamental design for a diamond jewellery" and has two figures:[202]

Fig. 1

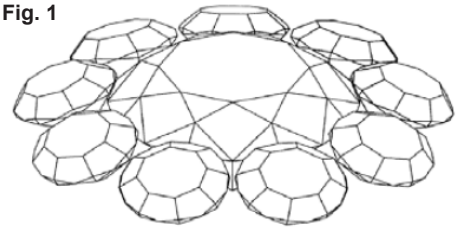
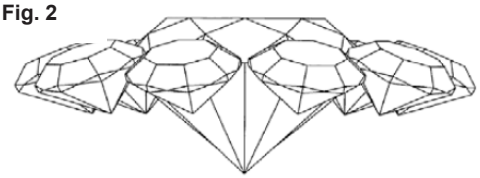


Fig. 2



First, in addressing claim construction, the PTAB noted that while it is not preferable to provide a verbal description of the design, it may sometimes to be helpful to note features of the claimed design as they related to the prior art.[203] The parties took opposite positions on claim construction, with the petitioner stressing that no written or verbal construction is needed and the patent owner noting, that while the figures provide a complete construction, verbally describing certain features may be helpful.[204] The patent owner noted that the district court provided a verbal description of certain aspects of the claim (based on the parties' submissions) in an opinion in a related district court proceeding (but declining to construe the claim).[205] The PTAB declined to construe the claim in words, noting that while the district court's description was helpful, it was focused on certain aspects of the claim.[206]

Next, the PTAB turned to considering the asserted grounds of unpatentability. The petitioner asserted a specific jewelry design—the Lotus Carat—that appeared in three separate references as combined under 35 U.S.C. §103 with the teachings of the Auction House Catalogs.[207]

The PTAB noted that "[i]n applying a claim of obviousness in a design patent, the ultimate inquiry is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved."[208] The obviousness analysis is a two-step process of (1) finding a single reference that has the design characteristics that are basically the same as the claimed design and (2) using other references to modify the primary reference to create a design with the same overall visual appearance as the claimed design.[209]

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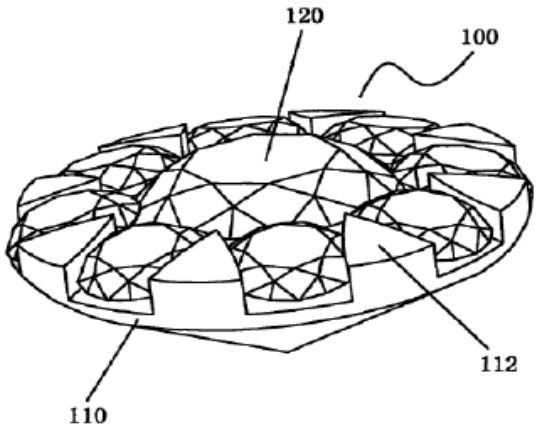
[194] *Id.*
[195] *Id.* at 12.
[196] *Id.*
[197] *Caterpillar*, IPR2015-00416, Paper 2, at 48 (December 22, 2014) (Petition for IPR).
[198] *Caterpillar*, IPR2015-00416, Paper 7, at 12 (June 14, 2016).
[199] *Id.* at 13.
[200] *Premier Gem Corp. v. Wing Yee Gems & Jewellery Ltd.*, IPR2016-00434, Paper 9, at 2 (July 5, 2016) (Decision denying institution of IPR).
[201] *Id.* at 2.
[202] *Id.* at 3.
[203] *Id.* at 3 (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679–80 (Fed. Cir. 2008)).
[204] *Id.* at 4.
[205] *Id.* at 4–5.
[206] *Id.* at 5.
[207] *Id.* at 5–6.
[208] *Id.* at 7 (citing *Apple, Inc. v. Samsung Elec. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012)).
[209] *Id.* at 8 (citing *High Point Design, LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311 (Fed. Cir. 2013)).

The primary reference (the Lotus Carat) was then analyzed. A figure from one of the primary references (the Lin Publication) is shown below:[210]



The petitioner alleged the only differences between the claimed design of the '132 Patent and the Lotus Carat was the smaller diamonds on the periphery of the claimed design were single-cut, while the Lotus Carat design has diamonds that are full-cut on the periphery.[211] The PTAB disagreed that the only relevant difference was "mixing diamonds of different cuts."[212] The PTAB noted that even a "cursory examination" showed other differences.[213] However, the PTAB stated that it did not need to consider whether the Lotus Carat design qualified as a primary reference because the modifications proposed by the petitioner did not result in the same overall visual appearance as the claimed design.[214]

With that segue, the analysis shifted to the secondary references (the Auction House Catalogs). The petitioner relied upon six jewelry designs from five different catalogs as secondary references.[215] These six designs are reproduced on the right:

Secondary Reference Designs

[210] *Id.* at 9.
[211] *Id.*
[212] *Id.* at 10.
[213] *Id.*
[214] *Id.*
[215] *Id.* at 11.

The PTAB provided a brief description of each design.[216] Following these descriptions, the PTAB considered the obviousness arguments, starting with the definition of the relevant designer of ordinary skill.[217] The petitioner provided a definition of the relevant designer, which the patent owner did not dispute.[218] The petitioner asserted that this designer would take each jewelry design in the Auction House Catalogs and modify the Lotus Carat design to "create a design having the same overall visual appearance as the '132 Patent's claimed design."[219] Each of the secondary references was asserted to teach mixing of a central full-cut diamond with smaller peripheral single-cut diamonds and this mixing makes sense because the "prior art teaches it and [] the cost of making single-cut diamonds is ordinarily less (due to labor savings) than the cost to manufacture full-cut diamonds."[220] The petitioner asserted that a designer of ordinary skill would have been motivated to use the teachings of the secondary references to modify the primary reference for these reasons.[221] However, the PTAB noted that the petitioner failed to cite to any evidence supporting its conclusions.[222] The patent owner asserted that the "looks" of the secondary references and the primary were different, none of the proposed combinations would result in the claimed design, and the knowledge of a designer of ordinary skill was ignored by the petitioner.[223] The PTAB agreed with the patent owner.[224]

Next, the PTAB presented analysis as to why the petitioner's grounds of rejection were flawed.[225] One reason cited was that the details of the secondary references were not "clearly discernable based on the evidence in the record."[226] The images and the "very brief descriptions" with the photos did not provide enough information to assess the full appearance and characteristics of each design.[227] The petitioner was faulted for focusing on design concepts rather than overall visual appearance.[228] Finally, the petitioner was faulted for "deliberately ignoring other design features of those references."[229] The PTAB noted that this selective reliance on certain features of the prior art was a "hindsight reconstruction of the invention."[230]

Accordingly, the PTAB denied institution of the IPR due to a lack of evidence on the record to support the petitioner's allegations "aside from Petitioner's conclusory attorney argument."[231] The petitioner requested a rehearing, which was denied as the petitioner did not focus on the flaws in the obviousness grounds addressed by the PTAB in its decision.[232]

This decision is instructive from a number of different aspects. First, it provides an illustrative example of applying obviousness in the context of a design patent (albeit an unsuccessful set of obviousness rejections in contrast to the *Lowe's* and *Caterpillar* decisions above). Second, it shows the importance of focusing on the overall visual appearance instead of piecemeal focusing on particular features of the prior art. Finally, it demonstrates the importance of providing sufficient evidence and support for the grounds of rejection, particularly in providing a full depiction of the prior art designs and perhaps including expert testimony to support obviousness positions.

INFRINGEMENT

The sole test for design patent infringement analysis is the ordinary observer test that originates from *Egyptian Goddess*.[233] This test involves two steps. In the first step, the patented design and the accused design are compared to determine if they appear "substantially the same," such that an ordinary observer would confuse one product for the other.[234] If after the first step, the factfinder determines that the designs are not "plainly dissimilar," the factfinder moves onto the second step.[235] In the second step, the patented and accused designs are compared with art from prior patents to allow the factfinder to attach importance to differences between the claimed design and the prior patent depending on the overall effect of those differences on the design.[236]

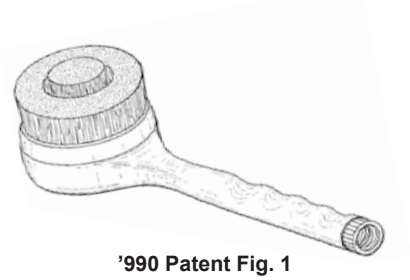
The Federal Circuit considered a district court's application of the ordinary observer test in the *Wallace* case. The

[216] *Id.* at 11–13.
[217] *Id.* at 13.
[218] *Id.*
[219] *Id.* at 13–14.
[220] *Id.* at 14.
[221] *Id.*
[222] *Id.*
[223] *Id.*
[224] *Id.* at 14–15.
[225] *Id.* at 15–16.
[226] *Id.* at 15.
[227] *Id.*
[228] *Id.* at 16.
[229] *Id.*
[230] *Id.*
[231] *Id.* at 17.
[232] *Premier Gem*, IPR2016-00434, Paper 11, at 2 (September 26, 2016) (Decision denying request for rehearing).
[233] *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc).
[234] *Id.* at 678.
[235] *Id.*
[236] *Id.*

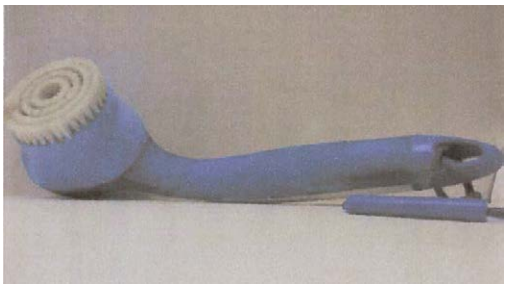
Weber and *Columbia* cases from the Northern District of Illinois and the District of Oregon illustrate applications of this test. Finally, the *Magmatic* case from the United Kingdom provides an example of infringement analysis based on a European Community Design that consisted of a series of CAD drawings. This case is interesting for its analysis of the drawings and their scope, as well as illustrating an infringement analysis from the United Kingdom based on a European Community Design.

WALLACE V. IDEAVILLAGE PRODUCTS CORP., 2015-1077 (FED. CIR. MAR. 3, 2016)

Ms. Allyson Wallace, proceeding pro se, brought suit on November 27, 2006, in the District of New Jersey alleging patent infringement of US Patent No. D485,990 (the '990 Patent) for an ornamental design for a body-washing brush.[237] The accused product was a handheld bath brush marketed by Ideavillage as the "Spin Spa."[238]



'990 Patent Fig. 1



Ideavillage's Accused Product

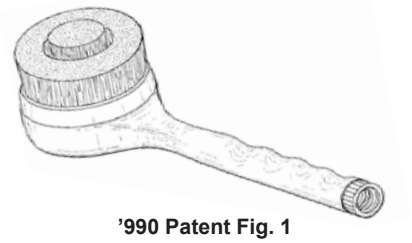
The case was delayed over three years while the court sought pro bono counsel for Ms. Wallace. Failing to secure counsel for Ms. Wallace after contacting 11 firms, the court rescinded the order for pro bono counsel in March 2010 and proceeded with the case. But the case was further delayed by errors in the pleading (the incorrect defendant was named in the complaint), and repeated requests for delay from Ms. Wallace. Pro bono counsel was finally secured and appointed for Ms. Wallace in June 2011 and the case went through several settlement conferences before Ideavillage filed a motion for summary judgment in December 2013. The district court eventually granted Ideavillage's motion for summary judgment in September 2014. Ms. Wallace appealed.

On appeal, the Federal Circuit approved the district court's application of both steps of the "ordinary observer" test from *Egyptian Goddess*.[239] In the first step, the patented design and the accused design are compared to determine if they appear "substantially the same," such that an ordinary observer would confuse one product for the other.[240] If after the first step, the factfinder determines that the designs are not "plainly dissimilar," the factfinder moves on to the second step. In the second step, the patented and accused designs are compared with art from prior patents to allow the factfinder to "attach importance to differences between the claimed design and the prior [patent] depending on the overall effect of those differences on the design."[241]

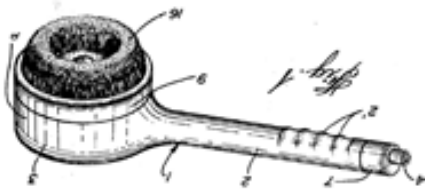
In the first step, the product was compared from multiple angles to highlight six differences between the accused Ideavillage design and the '990 Patent. From this comparison, the district court "acknowledge[d] manifest differences in the overall appearance" of the '990 Patent and the accused product, including:[242] (1) the '990 Patent has a straight handle, while the Ideavillage product has a curved handle; (2) the '990 Patent has a "hill and valley" finger grip while the Ideavillage product does not; (3) the '990 Patent has a threaded edge at the end of the handle, while the Ideavillage product has a pointed end with an opening for a rope to be attached; (4) the '990 Patent has a round head while the Ideavillage product has an oblong head; (5) the '990 Patent has a protrusion on the back of the head, while the Ideavillage product has a smooth back; and (6) the '990 Patent has no decoration on the back of the handle, while the Ideavillage product has two ovals on the back of the handle. It was held that the designs were "sufficiently distinct," such that Wallace could not prove as a matter of law that the designs appeared substantially the same.[243]

[237] *Wallace v. Ideavillage Prods. Corp.*, No. 06-CV-5673, 2014 U.S. Dist. LEXIS 129020, at *2 (D.N.J. Sept. 15, 2014).
[238] *Id.* at *2.
[239] *Egyptian Goddess, Inc.*, 543 F.3d at 665 (Fed. Cir. 2008) (en banc).
[240] *Wallace v. Ideavillage Prods. Corp.*, No. 2015-1077, 2016 U.S. App. LEXIS 3975, at *5 (Fed. Cir. Mar. 3, 2016).
[241] *Egyptian Goddess*, 543 F.3d. at 677.
[242] *Wallace*, 2016 U.S. App. LEXIS 3975, at *4 (quoting *Wallace*, 2014 U.S. Dist. LEXIS 129020, at *10–11).
[243] *Id.*

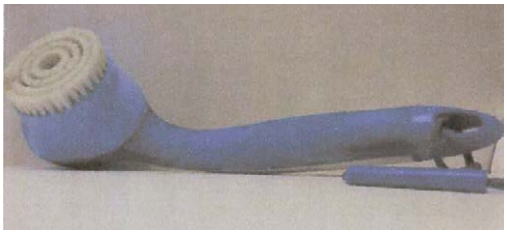
Despite finding against Wallace on the first step, the district court proceeded to the second step of the ordinary observer test "[i]n an effort to assure a fair and complete decision on this record."[244] In the second step, art from prior patents for similar products provided a frame of reference in which to compare the accused product and the patent design. A comparison of the '990 Patent to US Patent No. 4,417,826 (the '826 Patent) was performed.[245] "[S]ignificant similarities" were found between the design of the '990 Patent and the '826 Patent.[246] In fact, the similarities described between the '990 Patent and the '826 Patent were some of the differences that the court had highlighted between the accused product and the '990 Patent.[247] For example, the accused product has a bent handle, but both the '990 Patent and the '826 Patent have straight handles and the accused product has no finger grip (see images below).



'990 Patent Fig. 1

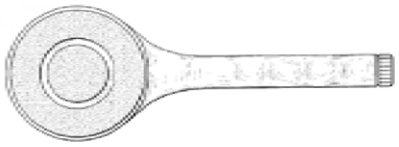


'826 Patent, Fig. 1

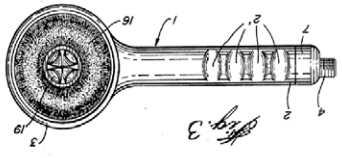


Ideavillage's Accused Product

The '990 Patent and '826 Patent also each have "hill and valley" finger grips (see images below).



'990 Patent Fig. 5



'826 Patent, Fig. 3

Ideavillage's Accused Product

The Federal Circuit held that the comparison between the claimed design and the prior art "reinforces the district court's findings under the first stage of the test."[248]

This comparison to prior art allowed the district court to attach significance to "differences between the claimed and accused designs that might not be noticeable in the abstract."[249] The Federal Circuit upheld that "no reasonable observer, familiar with the prior art, would be deceived into believing the [Ideavillage] [p]roduct is the same as the design depicted in the '990 patent."[250]

This case is instructive in illustrating how the two steps of the ordinary observer test are applied, and, in particular, how the second step is used to reinforce findings from the first step.

[244] *Id.* at *5 (quoting *Wallace*, 2014 U.S. Dist. LEXIS 129020, at *11).
[245] *Id.*
[246] *Id.*
[247] *See id.* at *3–4, *5.
[248] *Id.* at *5.
[249] *Id.* at *5–6 (quoting *Egyptian Goddess*, 543 F.3d at 678).
[250] *Id.* at *5 (quoting *Wallace*, 2014 U.S. Dist. LEXIS 129020, at *14) (brackets in original).

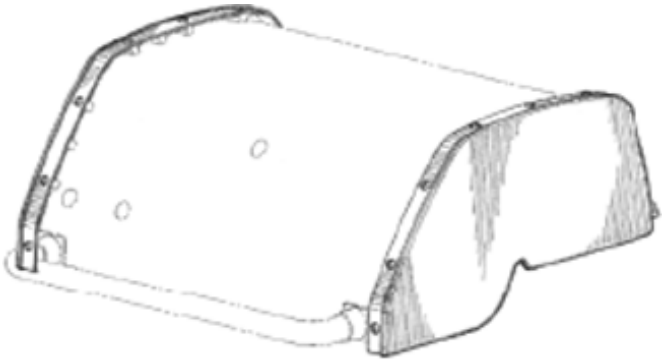
WEBER-STEPHEN PRODS. LLC V. SEARS HOLDING CORP., NO. 13 C 01686, 2015 WL 9304343 (N.D. ILL. DEC. 22, 2015)

As part of an ongoing litigation regarding barbecue grill patents,[251] Weber sued Sears for infringement of three patents, including two design patents: US Patent No. D609,045 (the ’045 Patent) and US Patent No. D564,834 (the ’834 Patent).[252] The ’045 Patent claims “the ornamental design for a grill”[253] and the ’834 Patent claims “the ornamental design for a shroud for a barbecue grill.”[254]

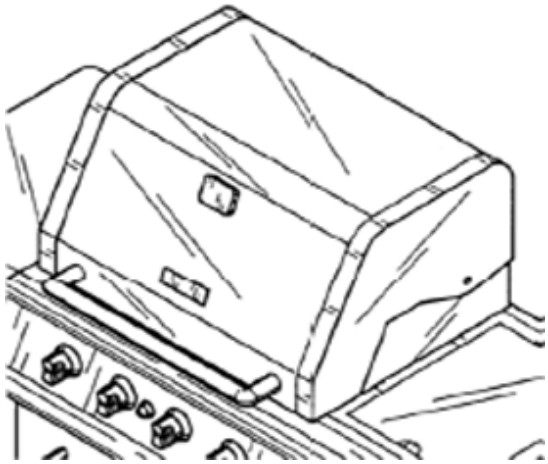
After Weber claimed that Kenmore Elite grills from Sears infringed its patents, Sears countersued, seeking declarations of invalidity and noninfringement as to each patent.[255] On summary judgment, the District Court for the Northern District of Illinois denied Sears’ claims for invalidity, denied Sears’ claim of noninfringement as to the ’045 Patent, and granted Sears’ claim of noninfringement as to the ’834 Patent.[256] Additionally, the court ruled on summary judgment motions regarding a utility patent, denying Sears’ motion as to noninfringement, but granting its motion as to invalidity.[257]

The court granted summary judgment in favor of Sears, finding noninfringement as a matter of law on the ’834 Patent.[258] In coming to its holding, the court relied on a “crucial principle” from *Egyptian Goddess*:[259] when the claimed design is close to prior art, small differences between the accused design and the claimed design are important to the hypothetical ordinary observer.[260] The court used a two-step analysis, comparing the claimed design with prior art, and then looking for differences between the claimed and accused designs.

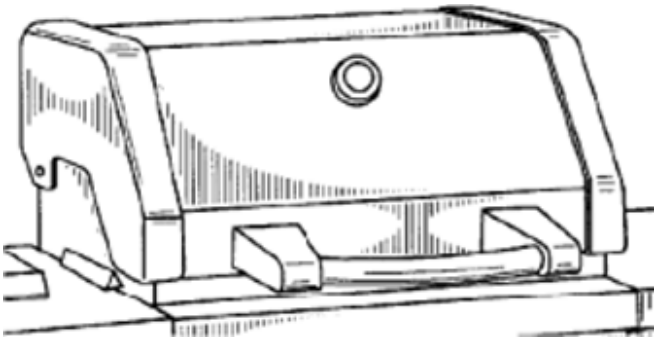
First, comparing the claimed Weber design with four prior art designs (pictured below), the court found the prior art “shares the same basic shape” (as well as other features, including rivets) with the Weber design.[261]



Weber’s ’834 Patent Design



Prior Art: ’357 Design



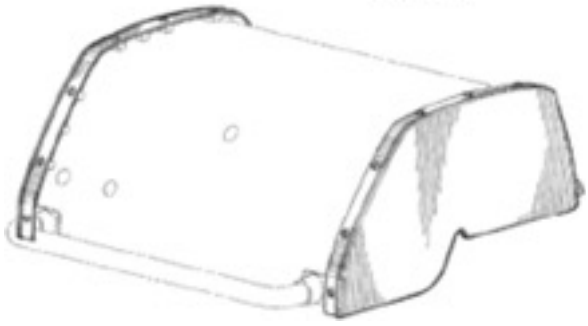
Prior Art: ’359 Design

[251] There were seven prior written opinions in the case. *Weber-Stephen Prods. LLC v. Sears Holding Corp.*, No. 13 C 01686, 2015 WL 9304343, at *1, 21 n.3 (N.D. Ill. Dec. 22, 2015). After this ruling, Weber had three remaining claims and Sears had six remaining counterclaims to be resolved. *See id.* at *21.
[252] *Id.* at *1.
[253] *Id.* at *2.
[254] *Id.*
[255] *Id.* at *1.
[256] *Id.* at *21.
[257] *Id.*
[258] *Id.* at *12.
[259] *Egyptian Goddess, Inc.*, 543 F.3d at 676 (Fed. Cir. 2008).
[260] *Weber*, 2015 WL 9304343 at *12.
[261] *Id.*

Prior Art: ’983 Design

Prior Art: Hu Dec. P 2, Ex. A

Then, the court described several “small differences” between Weber’s design and the accused product.[262] These differences included: a) indented side panels versus flat side panels, b) different slope to the shape of the grill shroud, c) differences in the rear hinges of each design and d) the shapes of the rotisserie notches, all pictured below:

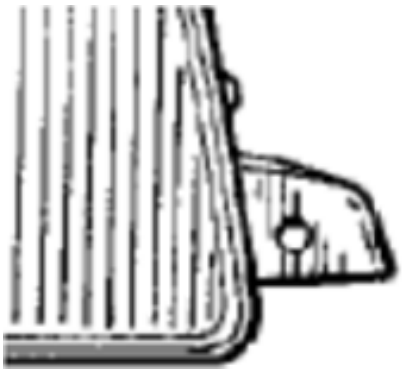


Weber’s Side Panels

Sears’ Side Panels

Weber’s Design’s Profile

Sears’ Design’s Profile

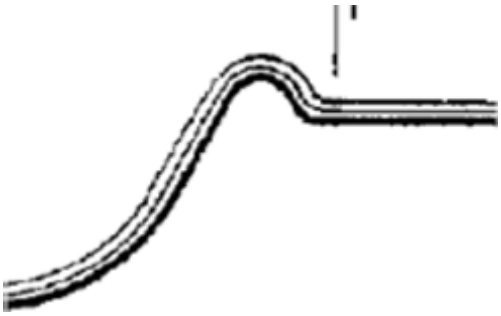


Weber’s Rear Hinge

[262] *Id.*

Sears' 700 Series Rear Hinge
Rear Hinge

Sears' 500/550 Series
Rear Hinge



Weber's Design's Notch

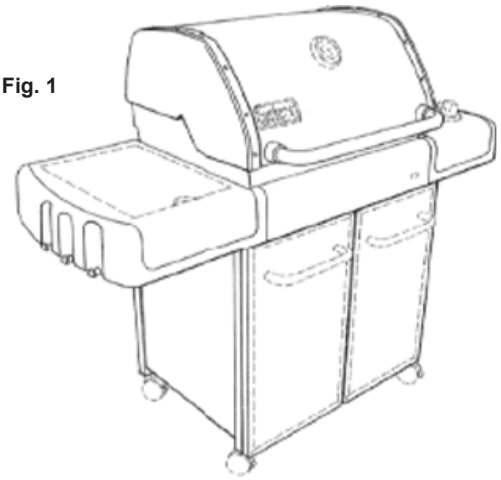
Sears' Design's Notch

Even though comparing the Weber and Sears grills "in isolation" could lead a reasonable jury to find substantial similarity, "once the prior art informs the comparison" as required by *Egyptian Goddess*, "the differences [between the Weber and Sears designs] stand out inescapably."[263]

Weber relied upon three counterarguments: (1) the court used impermissible "element-by-element" comparison; (2) expert testimony created a jury question on infringement; and (3) it contested the inclusion of one prior art design. The court rejected each of these arguments in turn. First, the court's determination that no reasonable jury could find the two designs substantially similar was not based on "impermissible 'element-by-element' " comparison; instead, it was based on the overall appearances of the designs, which are "not large" and comprised of only a few features.[264] Next, Weber attempted to rely on expert testimony "to create a jury question on infringement," but the court excluded the expert's testimony,[265] and held "he cannot help Weber" explain away the differences between the two designs.[266] Finally, there was no jury issue over whether a "grill shroud with rivets" like Weber's and Sears' was among the prior art.[267] Sears introduced evidence of prior art using similar riveted bands.[268] Weber presented contrary evidence: two knowledgeable industry experts testifying they were not aware of other grills using such a design.[269] The court found "it would not be reasonable for a jury to infer" that the prior art using rivets was invalid based on Weber's evidence.[270]

Regarding the '045 Patent, the court denied Sears' summary judgment motion, because "a reasonable jury could find a substantial similarity" between the Weber patent and the Kenmore grill "based on their overall ornamental visual impressions."[271] To reach this conclusion, the court compared the Weber patent drawing with images of the accused grills, as well as prior art.[272] Figure 1 from the '045 Patent and the accused product are shown on next page.

[263] *Id.* at *13.
[264] *Id.*
[265] *Id.* at *5.
[266] *Id.* at *13.
[267] *Id.* at *14.
[268] *Id.* at *12 (image marked R.334-6, Hu Dec. P 2, Ex. A).
[269] *Id.* at *14.
[270] *Id.*
[271] *Id.* at *15.
[272] *Id.* at *15–16.



Weber's Claimed '045 Design

Prior Art: Chung '057 Patent

Sears' Accused Kenmore Elite Design

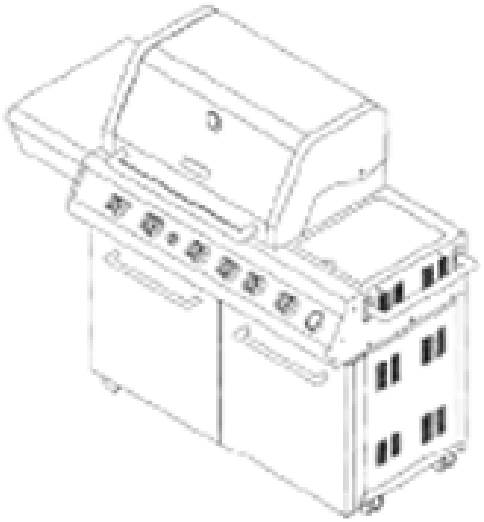
Prior Art: Coleman '359 Patent

Applying the *Egyptian Goddess* rule, the court found that "prior art … actually heightens the impression of similarity."[273] The court compared five prior art designs with the Weber design and the accused Sears grill.[274]

Prior Art: Tseng '308 Patent

[273] *Id.* at *15.
[274] *Id.* at *16.

Prior Art: UniFlame Design



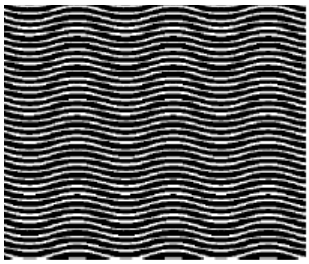
Prior Art: Kenmore 141.16680 Design

The designs "are all fairly similar … But where the Weber design departs from the prior art, the Kenmore Elite grills follow."[275] Sears' counterarguments alleging plain dissimilarity did not persuade the court, "largely because they require the observer to give more attention to detail than is appropriate" for the ordinary observer, in violation of *Egyptian Goddess*.[276]

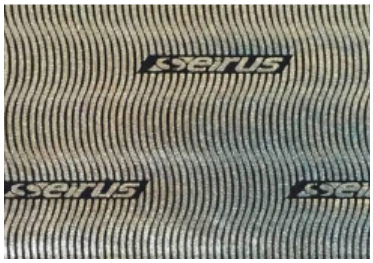
This opinion illustrates the burden of proof for success, and warnings against failure, for defendants at the summary judgment stage with regards to design patent infringement. To demonstrate noninfringement of a design on summary judgment, a defendant must present prior art that is close to the claimed design, and noticeable (even if small) differences between the claimed and the accused designs. But, where prior art heightens the impression of similarity to the ordinary observer between the claimed and the accused designs, summary judgment cannot be granted.

COLUMBIA SPORTSWEAR NORTH AMERICA, INC. V. SEIRUS INNOVATIVE ACCESSORIES, NO. 3:15-CV-00064-HZ (D. OR. AUG. 10, 2016)

The court granted Columbia's motion for summary judgment of design patent infringement.[277] Before this order and opinion, the court issued a claim construction opinion where it declined to give textual construction to the patented design, instead choosing to address the issues in the instant opinion.[278] The asserted design patent, D657,093 (the '093 Patent), covers Columbia's "Omni-Heat" technology.[279] Seirus's "HeatWave" material is the accused product.[280] A comparison between the '093 Patent's design and the accused product is shown below:



Columbia's D·093 patent



Seirus's Heat\Wave

[275] *Id.*
[276] *Id.* (citing *Egyptian Goddess*, 543 F.3d at 670).
[277] *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, No. 3:15-cv-00064, Slip Op. at 3 (D. Or. Aug. 10, 2016) (Dkt. No. 105).
[278] *Id.*
[279] *Id.* at 2.
[280] *Id.*

The court provided an overview of design patent infringement.[281] However, the court proceeded directly to the second step of comparing the patented design and the accused product and inquiring "whether an ordinary observer, familiar with the prior art … would be deceived into believing" the accused design (Seirus's product) is the same as the patented design (Columbia's patented one).[282] The court did this after noting it did not provide a textual construction because it is "preferred" for a district court to not attempt such a construction.[283]

First, the court defined the identity of the ordinary observer, as "a retail customer who buys and uses the articles of manufacture Seirus sells—gloves, socks, hats and other gear—that incorporate the patented design."[284] Seirus proposed that the ordinary observer should be a "commercial purchaser" instead of an individual consumer.[285] However, the court noted that the cases relied upon by Seirus were distinguishable because they involved products not intended for sale to individual consumers.[286] Seirus offered a second argument that its products were "specialty products" and therefore an ordinary observer would have to be more "discriminating about design differences."[287] However, the court also rejected this argument and noted that "even the most discerning customer would be hard pressed to notice the differences between Seirus's HeatWave design and Columbia's patented design (and included the comparison figure reproduced above for emphasis).[288]

The court next noted that the overall visual impression of the designs was "strikingly similar" because of "a nearly identical wave pattern with contrasting colors, and the waves have approximately the same wave length and amplitude."[289] Seirus argued the design of its product was distinguishable because of the Seirus logo and the wave pattern was vertically oriented and slightly irregular.[290] The court dismissed these differences as minor ones that did not change the conclusion of substantial similarity.[291]

However, the court provided an analysis of each of Seirus's offered differences regarding: (1) the logo; (2) the vertical orientation; and (3) difference in line width.[292]

First, regarding the logo, the court cited case law noting that labeling and logos are not enough to defeat patent infringement, unless the logo placement and appearance were a part of the claimed design.[293] Testimony from Seirus was cited noting that the logo only served a branding purpose and as a source identifier as opposed to any design purpose.[294] Further, Columbia had provided Seirus marketing materials in which the logo did not appear on the fabric.[295]

Second, regarding the vertical orientation of the Seirus fabric, the court noted that the '093 Patent was not limited to a particular orientation, since the figures showed multiple orientations.[296] Again, Seirus's own argument was undermined by the evidence. Columbia had produced pictures of the products with the wavy lines in a horizontal orientation and Seirus's president testified that the orientation depended on how the product was held.[297] Finally, the court noted that the *Apple* court rejected a similar argument.[298]

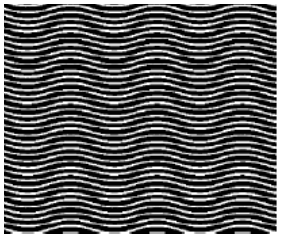
Lastly, regarding the difference in line width, the court noted that this limitation was not claimed in the patent and was not relevant to the analysis.[299]

After that analysis, the court conducted an analysis of the prior art applying the analysis from *Egyptian Goddess*.[300] From *Egyptian Goddess*, the burden of production of the prior art is on the accused infringer.[301] In contrast to the obviousness analyses described above in other cases, the court here, in its infringement analysis, noted that the prior art produced by Serius was primarily utility patents disclosing functional rather than aesthetic features, where these functional features pertained to differing subject matter than the claimed design (e.g., skid-resistant footwear and latex glove grips).[302] The court emphasized that the '093 Patent covered an ornamental

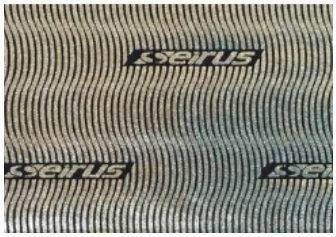
[281] *Id*. at 4–5 (citing *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1319–20 (Fed. Cir. 2007, abrogated on other grounds by *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008)).
[282] *Id*. at 6.
[283] *Id*. (citing *Egyptian Goddess*, 543 F.3d at 679).
[284] *Id*. (citing *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871) (noting that ordinary observers include those who buy and use the products at issue)).
[285] *Id*.
[286] *Id*. at 6–7.
[287] *Id*. at 7.
[288] *Id*. at 8.
[289] *Id*.
[290] *Id*.
[291] *Id*. (citing *Payless Shoesource, Inc. v. Reebok Int'l Ltd.*, 998 F.2d 985, 990–91 (Fed. Cir. 1993)).
[292] *Id*. at 9–13.
[293] *Id*. at 10 (citing, *inter alia*, *Apple Inc. v. Samsung Elecs. Co.*, No. 11-CV-01846-LHK, 2011 WL 7036077, at *16 (N.D. Cal. Dec. 2, 2011)).
[294] *Id*. at 11.
[295] *Id*. at 11.
[296] *Id*. at 11–12.
[297] *Id*. at 12.
[298] *Id*. (citing *Apple, Inc. v. Samsung Elecs. Co.*, 932 F. Supp. 2d 1076, 1085 (N.D. Cal. 2013)).
[299] *Id*. at 13 (citing *Unique Functional Prods., Inc. v. Mastercraft Boat Co.*, 82 F. App'x 683, 690 (Fed. Cir. 2003)).
[300] *Id*. at 13 (citing *Egyptian Goddess*, 543 F.3d at 676).
[301] *Id*. (citing *Egyptian Goddess*, 543 F.3d at 678).
[302] *Id*. at 14.

design for heat reflective material and cited to 35 U.S.C. § 171, observing that design patents protect ornamental designs only, "meaning the utility patents are of little, if any relevance."[303] The prior art, according the court, included products that were not in the field of "heat management materials," and thus, was not germane.[304]

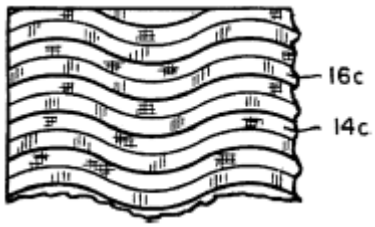
However, the court did focus on a pair of utility patents it deemed relevant that disclosed a "waterproof breathable lining and outerwear constructed therefrom" and a "breathable shell for outwear."[305] There was a similarity of a figure of a fabric pattern to Columbia's patented design, but the court stated that neither of these patents were design patents and neither claims the particular pattern or any relevant aesthetic features.[306] Finally, the court noted the even if the prior art patents were relevant prior art, Seirus's design was still "substantially closer to the contrasting wave design" of the '093 Patent.[307] The court provided the following set of comparison figures:[308]



Columbia's D·093 patent



Seirus's Heat\Wave



'949 patent

This opinion provides a good overview of the application of the ordinary observer test along with a comparison to the prior art. Perhaps the most interesting part about this opinion is the court's discussion on utility patents as they pertain to prior art in an infringement analysis. This discussion is somewhat in contrast to the PTAB decisions regarding utility patents as prior art in an invalidity analysis such as the *Lowe's* IPR decision discussed above. This decision also illustrates the importance of offering arguments not countered by the evidence—arguments regarding differences between the claimed design and an accused product carry no weight if deposition testimony and documentary evidence are to the contrary.

PMS INTERNATIONAL GROUP PLC V. MAGMATIC LTD ([2016] UKSC 12 (9 MARCH 2016))

Although from the United Kingdom and involving a Community Registered Design (CRD) (or, as often referred to, a European Community Design), this case is instructive from a number of aspects. The CRD in this case is a series of computer aided design (CAD) monochrome, shaded images.[309] CAD images are an acceptable image format in both designs filed under the Hague system as well as direct US filings, so an understanding of issues arising from these types of design drawings is instructive. However, as this case illustrates, CAD images have some pitfalls. Next, it is interesting to contrast the infringement analysis applied with that applied in the United States (e.g., as illustrated by the *Ideavillage* and *Columbia Sportswear* cases described above).

The CRD at issue (Community Registered Design No 43427-0001) claimed a children's ride-on suitcase designed to resemble an animal.[310]

[303] *Id*.
[304] *Id*.
[305] *Id*. at 15.
[306] *Id*.
[307] *Id*. at 15–16.
[308] *Id*. at 16.

[309] *PMS Int'l Grp Plc v. Magmatic Ltd* ([2016] UKSC 12 (9 March 2016)) at ¶1 (appeal taken from [2014] EWCA Civ 181).
[310] *Id*.

In describing the claimed design, the United Kingdom Supreme Court noted that even though the horns and the front/rear clasps are differently shaded than the body, the images, viewed collectively, indicated that these features are the same light gray shade as the remainder of the body.[311] It noted however that the wheels, spokes, strap on top and front/rear strips are shaded black.[312]

The CRD is owned by Magmatic, which markets the product under the trade name Trunki.[313] Magmatic has additional CRDs covering subsequent Trunki models.[314] Two examples of these subsequent CRDs are depicted below.

Magmatic filed a suit seeking damages and an injunction against PMS International Group plc for importing and selling, in the United Kingdom and Germany, the "Kiddee Case," which is depicted below.[315]

CRD rights are governed by European Council Regulation (EC) No. 6/2002 (the Principal Regulation).[316] Germane to this proceeding are the following articles of the principle regulation, reproduced below as summarized in the opinion by the Supreme Court:

Article 4(1) of the Principal Regulation explains that a design "shall be protected … to the extent that it is new and has individual character". The word "design" is defined in article 3(a) as "the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation". Article 6 explains that a design has individual character "if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public." Article 10(1) states that "[t]he scope of the protection … shall include any design which does not produce on the informed user a different overall impression." Article 10(2) states that, when "assessing the scope of protection", "the degree of freedom of the designer in developing his design" is to be "taken into consideration".

Article 36(1) of the Principal Regulation sets out the requirements of a valid application for registration of a design, which include "a representation of the design suitable for reproduction". Article 36(2) also requires an application to "contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied". Article 36(3) states that an application "may contain" various things, including "(d) the classification of the products in which the design is intended to be incorporated or to which it is intended to be applied". Article 36(6) states that "[t]he information contained in the elements mentioned in paragraph 2 and in paragraph 3(a) and (d) shall not affect the scope of protection of the design".

Commission Regulation (EC) No 2245/2002 ("the Implementing Regulation") implements the Principal Regulation. Article 4(1) of the Implementing Regulation states that the "representation of the design shall consist in a graphic or photographic reproduction of the design, either in black and white or in colour". Up to seven different views of the design are permitted. Reflecting article 36 of the Principal

[311] *Id.*
[312] *Id.*
[313] *Id.* at ¶¶2–3.
[314] *Id.* at ¶3.
[315] *Id.* at ¶4.
[316] *Id.* at ¶6.

> Regulation, article 4(1)(c) of the Implementing Regulation states that "no explanatory text, wording or symbols, other than the indication 'top' … may be displayed". And article 4(1)(e) provides that the images accompanying an application to register a design "shall be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished … for entry in the Register of Community Designs".[317]

There are three proceedings at play in this decision. This first is the opinion of the lower court, the second is the opinion of the appeals court and the third is the Supreme Court's decision (the one cited herein), which was a result of Magmatic's appeal of the Court of Appeals' decision. The opinions from the preceding courts are summarized below.

First, the lower court found that the CRD was not invalid over the closest prior art and that the Kiddee Case infringed the CRD (as well as United Kingdom unregistered design rights).[318] The closest prior art (the Rodeo) was important in that it determined how the lower court viewed the scope of the CRD and led the lower court to hold that the CRD was entitled to "a broad scope of … protection."[319]

The lower court questioned whether, as part of the comparison of the accused product to the CRD, that the graphical designs on the surface of the case should be considered.[320] The court determined however they should be ignored because the CRD is for the shape of the case and that the proper comparison is of the shapes.[321] The court went on to identify 11 similarities and four differences and noted that an informed user would notice both.[322] It is worth noting that the court identified the informed user as a "parent, carer or relative of a three to six-year-old child."[323] In conclusion, the lower court held:

> Despite the differences between the Kiddee Case and the CRD, the overall impression the Kiddee Case creates shares the slimmer, sculpted, sophisticated, modern appearance, prominent ridge and horn-like handles and clasps looking like the nose and tail of an animal which are present in the CRD, but which are absent from the Rodeo. Moreover, neither the Kiddee Case nor the CRD have anything like the handle which is a prominent feature of the Rodeo.[324]

Next, the Court of Appeal considered the issue of infringement on an appeal by PMS.[325] This court said it considered the lower court as having made two errors: first, it failed to appreciate the three-dimensional nature of the CRD images as well as the overall impression the design gave—that of a "horned animal"[326]; the second error was the failure to account for "the colour contrast between the wheels and the body of the CRD."[327] The opinion though noted that in reality there are three errors (the first two described above) and the third "that the judge failed to take into account the effect of the lack of ornamentation on the surface of the CRD."[328] The appeal was successful because the Court of Appeal held that "the overall impression created by the two designs is very different," and therefore decided that the Kiddee Case did not infringe the CRD.[329]

The Supreme Court characterized the Court of Appeal as having three "criticisms" of the lower court decision:

> The first concerns the impression created by the shape of the CRD as against the Kiddee Case. The second criticism concerns the effect on that impression of the respective presence and absence of decoration on the body of the Kiddee Case and of the CRD. The third concerns the effect of the allegedly contrasting colours of the CRD.[330]

After noting the proper role of the Court of Appeal and the proper issue before the Supreme Court(which was whether the Court of Appeal's criticisms of the lower court were correct),[331] the Supreme Court began its analysis.

First, the analysis reviewed the "proper approach" to images in a CRD, since it deemed that as bearing on the three criticisms raised by the Court of Appeals. The images included in the CRD are important to the extent

[317] *Id*. at ¶¶7–9.
[318] *Id*. at ¶11.
[319] *Id*. at ¶13.
[320] *Id*. at ¶14.
[321] *Id*.
[322] *Id*.
[323] *Id*. at ¶13.
[324] *Id*. at ¶15.
[325] *Id*. at ¶16.
[326] *Id*. at ¶17.
[327] *Id*. at ¶20.
[328] *Id*. at ¶21.
[329] *Id*. at ¶22.
[330] *Id*. at ¶29.
[331] *Id*. at ¶26.

of protection offered the CRD.[332] In sum, the applicant can use whatever images he/she desires, which is akin to drafting claims in a patent application.[333] Regarding the use of color versus black-and-white drawings, the Supreme Court noted that if color is used, then the colors are claimed whereas black and white covers all colors.[334] The Supreme Court noted disagreement between the lower court and the Court of Appeal regarding the effect of the monochromatic nature and shading of the CAD images, which are addressed in the second and third criticisms.[335]

Regarding the "horned animal appearance" criticism, the Supreme Court held that "judgment that the overall impression given by the CRD is that of a horned animal is clearly right" and the focus on "the overall impression" was the correct approach.[336]

Next, regarding "the decoration of the Kiddee Case" criticism, the Supreme Court noted that "absence of ornamentation" can be a feature of a registered design.[337] The Supreme Court concluded that the second criticism was correct but was actually a "relatively minor point" that reinforced the first criticism.[338]

Finally, the Supreme Court addressed "the two-tone coloring of the CRD." The Supreme Court held that the Court of Appeals was correct in holding that the CRD was "not merely a specific shape, but a shape in two contrasting colours—one represented as grey and the other as black on the images."[339] Because of this, considering the coloring of an allegedly infringing article is proper.[340]

The Supreme Court held that the Court of Appeal was correct in its judgment regarding infringement.[341]

Thus, while this is a foreign case, the issues presented are relevant for US design law, particularly in the manner the United Kingdom courts analyzed the CRD vis-à-vis the accused product. Further, the CRD relied upon CAD drawings, which are allowed in US design applications. Additionally, color drawings are now permitted (without a petition) in the United States under the post-Hague convention rules. Design patent applicants may want to consider the ramifications of using CAD drawings with particular shading and/or coloring as well as how the scope of the design covered by those drawings may be interpreted in both the United States and Europe.

[332] *Id.* at ¶30.
[333] *Id.* at ¶31.
[334] *Id.* at ¶34.
[335] *Id.* at ¶35.
[336] *Id.* at ¶37.
[337] *Id.* at ¶¶45–48.
[338] *Id.* at ¶49.
[339] *Id.* at ¶53.
[340] *Id.*
[341] *Id.* at ¶¶55–57.

DESIGN PATENT PROSECUTION

WRITTEN DESCRIPTION SUPPORT

An applicant may claim the benefit of a previously filed application that names an inventor or joint inventor in common with a previously filed application if the application is "disclosed in the manner provided by section 112(a)."[342] This section (which is commonly referred to as § 112, first paragraph) provides the standard for the written description requirement.

The test for sufficiency of written description is as follows:

> Although [the applicant] does not have to describe exactly the subject matter claimed … the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed…. [T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.[343]

This requirement applies to both design patents and utility patents as the test for sufficiency of the written description.[344]

For design patents, the drawings provide the sole written description. In 2016, two cases illustrated issues regarding the definiteness of the drawings. In the *Sketchers* IPR, "an issue of priority arises under § 120 in the context of design patent prosecution, [requiring] one [to] look[] to the drawings of the earlier application for disclosure of the subject matter claimed in the later application."[345] As is generally understood, there is no specific disclosure

[342] 35 U.S.C. § 120.
[343] *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) (internal quotations and citations omitted).
[344] *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013) (quoting Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)).
[345] *Owens*, 710 F.3d at 1366 (citations omitted).

requirement, but the description must allow those of ordinary skill to recognize that the applicant invented what is claimed.[346] In the *Weber* case (which is also addressed above in the section on infringement), the drawings were examined per the definiteness and enablement requirements in order to determine whether there were material inconsistencies to warrant summary judgment on the matter.

SKECHERS U.S.A., INC. V. NIKE, INC., IPR2016-00874 (PTAB SEPTEMBER 29, 2016)

In this PTAB decision, institution of the requested IPR was denied because the petitioner failed to establish a reasonable likelihood of prevailing on the claim challenged in the petition.[347] What makes this case interesting is that this denial focused on whether there was written description support in the priority chain for the challenged design patent—US Patent No. D723,781 (the '781 Patent).

Nike owns the '781 Patent, entitled "Shoe Sole."[348] This patent claims a design for a section of a sole of an athletic shoe, as shown below in Figs. 1 and 2.

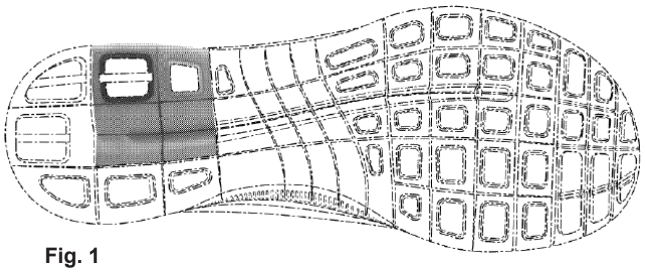


Fig. 1

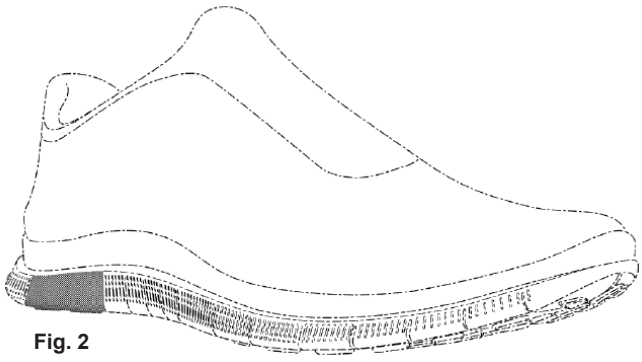


Fig. 2

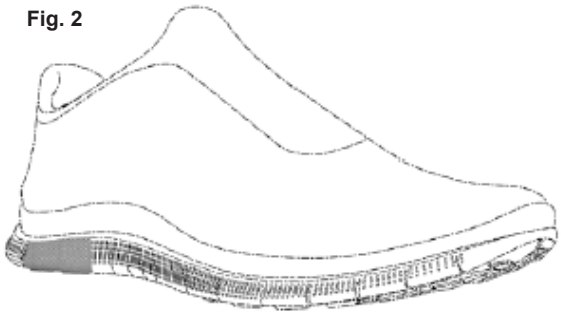
The design is for the bottom of the sole and the side of the sole. As can be seen in the figures, the majority of the bottom surface of the sole is disclaimed, except for a smaller space near the heel of the sole, in addition to an inner area of the claimed sole surface being disclaimed. Petitioner Skechers asserted that the '781 Patent cannot claim priority to its ultimate parent patent application, US Patent Application No. 29/414,576 (the '576 Application), because the '576 Application does not comply with the written description requirement of 35 U.S.C. § 112, first paragraph, and thus is obvious in view of a European Community Design filed on the same day as the '576 Application.[349] The decision provides a helpful depiction of the priority chain to understand the relationship between the applications:[350]

[346] *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998).
[347] *Skechers U.S.A., Inc. v. Nike, Inc.*, IPR2016-00874, Paper 11 (Sept. 29, 2016) (Decision denying institution of IPR).
[348] *Id.* at 2.
[349] *Id.* at 4–5.
[350] *Id.* at 6.

Nike used photographs of the shoe in the majority of the applications in this priority chain up to the filing of the '572 Application and then used more customary black-and-white line drawings.[351] Below is a comparison of a figure from the '576 Application with that of the '781 Patent.[352]

Fig. 1

Fig. 2



First, the PTAB analyzed the prosecution history of the '781 Patent.[353] During the prosecution of the application that led to the '781 Patent, the priority chain was explained in detail by Nike and considered by the examiner, who entered comments on the record indicating agreement that the priority claim was intact and proper.[354]

Then, Skechers' claim that the '781 Patent was not entitled to its priority claim to the '576 Application was addressed.[355] Ultimately, the PTAB agreed that there was written description support and criticized Skechers for its "micro-analysis" of the line drawings.[356]

Skechers' main argument was that the photographs of the earlier application did not provide written description support.[357] Skechers attempted to focus on three features it deemed as new matter.[358] These features were focused on the "piston surface" of the shoe.[359] The PTAB walked through a detailed analysis of each feature and whether it had written description support.[360] Skechers presented three arguments as to why a person of ordinary skill in the art would not find the features supported: claiming a sole portion was a design not claimed in the earlier application, elements of the design were improperly disclaimed and broken lines introduced new matter.[361] The PTAB considered each in turn and ultimately held that Skechers failed to present a persuasive case that the '781 Patent was not entitled to its priority claim.[362]

This decision is interesting from two aspects. First, the decision was based on an analysis of § 112, first paragraph (written description) which is not a ground that can be raised in an IPR. However, here the analysis of the written description issue was necessary to determine the validity of a priority claim. Second, the decision affirms that drawing types can be changed between applications in a priority chain (i.e., photographs to line drawings) and priority can be preserved, if the drawings are based on the photographs.

WEBER-STEPHEN PRODS. LLC V. SEARS HOLDING CORP., NO. 13 C 01686, 2015 WL 9304343 (N.D. ILL. DEC. 22, 2015)

As described above, Weber sued Sears for infringement of three patents, including two design patents: US Patent No. D609,045 (the '045 Patent) and US Patent No. D564,834 (the '834 Patent).[363] After denying both of Sears' motions as to invalidity,[364] the court then addressed Sears' arguments on definiteness and enablement (as a "single argument for purposes of this case") and new matter in turn.

The definiteness and enablement requirements were considered interchangeable in this case: "If the drawings are so muddled that a skilled artisan cannot reasonably decipher what design is claimed, then the patent is indefinite, and similarly, if the skilled artisan cannot copy the design, then the patent is not enabling."[365] Because the parties made no separate arguments regarding enablement, the court decided this question under definiteness, "with the understanding that a

[351] *Id.* at 7.
[352] *Id.*
[353] *Id.* at 7–9.
[354] *Id.* at 9.
[355] *Id.*
[356] *Id.*
[357] *Id.* at 11.
[358] *Id.*
[359] *Id.* at 13.
[360] *Id.* at 13–22.
[361] *Id.* at 22–27.
[362] *Id.* at 28.
[363] *Weber-Stephen Prods. LLC v. Sears Holding Corp.*, No. 13 C 01686, 2015 WL 9304343, at *1 (N.D. Ill. Dec. 22, 2015).
[364] *Id.* at *21.
[365] *Id.* at *17.

finding of indefiniteness would equal a finding of lack of enablement."[366] The court used the indefiniteness standard from *Nautilus*: a patent is invalid for indefiniteness only if its claims fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.[367] For both design patents, Sears argued that Weber failed to satisfy this reasonable-certainty standard, making their patents invalid. And for both patents, the court ruled against Sears, finding a reasonable jury could declare the patents valid.

Regarding the '834 Patent, Sears alleged inconsistencies between the drawings detailing the hinges of the grill shroud.[368] The court discounted this argument, finding "Sears has not provided clear and convincing evidence that there are inconsistencies, much less material ones, that would entitle Sears to summary judgment."[369] The court emphasized that it "cannot follow Sears's reading of the images" alleging the inconsistencies, and that even if it could, issues remained for a reasonable jury.[370]

Regarding the '045 Patent, Sears alleged three inconsistencies in the patent drawings.[371] Despite the court's previous finding that one of the alleged differences was "clearly inconsistent,"[372] and even assuming a reasonable juror could find the other inconsistencies, Sears' motion did not prevail.[373] The court refused to rule in favor of Sears on summary judgment for three reasons: 1) the court could not resolve conflicts of testimony from the parties' "battle of the experts"; 2) Sears relied on cases that could be distinguished from its own, because they invalidated patents based on inconsistencies of *prominent* features but not "relatively minor" ones; and 3) the presumption of validity and Sears' clear and convincing burden "tip the scales in Weber's favor."[374]

Ultimately, Sears' invalidity motions were denied based on definiteness/enablement "because a reasonable juror could find that the inconsistencies identified by Sears are not 'of such magnitude' as to render the patents invalid."[375] The court similarly rejected Sears' invalidity arguments based on "new matter" in Weber's drawings that was not present in their original disclosures.[376]

This opinion illustrates the burden of proof for success, and warnings against failure, for defendants at the summary judgment stage. For invalidity claims, it is not enough for a defendant to show clear inconsistencies in the claimed patent drawings—a defendant must also show that the demonstrated indefiniteness is "of such magnitude that the overall appearance of the design is unclear."[377] Otherwise, these inconsistencies will fail to carry the day on summary judgment.

INVENTORSHIP

Design patent invalidity based on improper inventorship is properly addressed by 35 U.S.C. § 171 (as noted by the PTAB in the *Galaxia* PGR institution decision, discussed herein), which provides: "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title." A comparison with 35 U.S.C. § 101 shows the parallels between the two statutes.[378] Inventorship is determined based on conception, which has been referred to as the "touchstone" of invention.[379] "Conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice."[380] If there are multiple inventors, to establish joint inventorship: "the critical question for joint conception is who conceived, as that term is used in the patent law, the subject matter of the claims at issue."[381] Therefore, in an inventorship challenge, evidence presented must establish the conception of the subject matter. The *Galaxia* PGR decision illustrates a case where insufficient evidence was presented by the petitioner.

[366] *Id.*
[367] *Id.* (citing *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014)).
[368] *Id.*
[369] *Id.*
[370] *Id.* at *18.
[371] *Id.*
[372] *Id.* at *19.
[373] *Id.*
[374] *Id.* at *19–20.
[375] *Id.* at *17.
[376] *Id.* at *20–21.
[377] *Id.* at *17 (citing *Times Three Clothier, LLC v. Spanx, Inc.*, 2014 WL 1688130, at *7 (S.D.N.Y. Apr. 29, 2014)).
[378] "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."
[379] *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998).
[380] *Id.* (citing *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986)) (internal quotations omitted).
[381] *Id.*

GALAXIA ELECTRONICS CO., LTD. V. REVOLUTION DISPLAY, LLC, CASE NO. PGR2016-00021 (PTAB NOVEMBER 2, 2016)

As described above in the section on functionality versus ornamentality, the PTAB denied institution of PGR on US Patent No. D736,750 (the '750 Patent).[382] A second issue presented by the petitioner (in addition to the lack of ornamentality discussed above) was that the patent was invalid under 35 U.S.C. § 101 for failing to name the correct inventors.[383] The PTAB found that the petitioner did not provide enough evidence to support this theory.[384]

The '750 Patent lists two inventors: Hochman and Ambrose.[385] The petitioner argued that at least several of its employees should also be listed and provided evidence of collaboration including emails.[386] The petitioner argued, citing MPEP § 2157, that a patent is invalid under § 101 for not naming the correct inventors.[387] In an interesting footnote, the PTAB noted that § 101 was not the correct statute to rely upon for this challenge (instead § 171 is the correct statute), stating:

> Petitioner correctly points out (Prelim. Resp. 23) that 35 U.S.C. § 101 does not apply to design patents. For purposes of this Decision, we assume that Petitioner meant to rely on § 171, which applies to design patents and includes the same wording regarding inventorship as § 101—"[w]hoever invents …." *See* 35 U.S.C. § 171.[388]

The patent owner countered that the evidence presented did not demonstrate that it is more likely than not that inventorship is improper.[389] The patent owner presented four reasons why the petitioner's inventorship challenge was deficient:

> [t]he inventorship challenge is deficient at least because Petitioner has (1) *not* presented any testimonial evidence from any alleged inventor claiming conception; (2) *not* specifically identified exactly who allegedly conceived of one or more features of the claim; (3) *not* identified one or more claim features allegedly conceived by an omitted inventor; and (4) *not* provided sufficient corroborating evidence of any alleged conception.[390]

Finally, the patent owner alleged that the evidence shows mere possession rather than conception of the invention and that the petitioner may have played a role in commercializing the design.[391]

The PTAB agreed with the patent owner and found that the petitioner's allegations were not supported by "sufficient evidence."[392] The PTAB noted numerous deficiencies in the evidence presented by the petitioner and found that the statements made between Galaxia employees and the listed inventors were "at best general agreements to cooperate," but did not "provide any insight into who actually conceived the claimed invention."[393] The PTAB cited several Federal Circuit cases in supporting its position.[394] Accordingly, the PTAB found that the petitioner did not provide sufficient evidence to show that the '750 Patent omits any actual inventors.

This decision is informative from two aspects. First, it clarifies that § 171 is the correct statute to challenge inventorship for design patents. Second, it demonstrates the level of evidence required to challenge inventorship, as well as the necessary points to be addressed.

[382] *Galaxia Electronics Co., Ltd. v. Revolution Display, LLC*, Case No. PGR2016-00021, Paper 11, at 14 (November 2, 2016) (Decision denying institution of PGR).
[383] *Id.* at 2.
[384] *Id.*
[385] *Id.* at 6.
[386] *Id.* at 4–5.
[387] *Id.* at 7.
[388] *Id.* at 7 n.1.
[389] *Id.*
[390] *Id.* (citing Patent Owner's Preliminary Response) (emphasis in original).
[391] *Id.*
[392] *Id.*
[393] *Id.* at 8–9.
[394] *Id.* at 9 (citing *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998)) ("[O]ne does not qualify as a joint inventor by merely assisting the actual inventor after conception of the claimed invention."); *Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 981 (Fed. Cir. 1997) (quoting *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985)) ("An inventor 'may use the services, ideas, and aid of others in the process of perfecting his invention without losing his right to a patent.' "); *Hoop v. Hoop*, 279 F.3d 1004, 1006–08 (Fed. Cir. 2002) (affirming a district court's finding that the Hoop brothers remain the true inventors of a design patent even though other individuals created detailed drawings and three-dimensional models of the design for the patent application).

RESTRICTION ELECTIONS AND PROSECUTION HISTORY ESTOPPEL

In 2014, the Federal Circuit issued the *Pacific Coast Marine Windshields v. Malibu Boats LLC* opinion.[395] This case was significant because the Federal Circuit held that principles of prosecution history estoppel apply to design patents. Prosecution history estoppel affects the scope of a patent's claims based on actions taken during prosecution (e.g., claim scope can be surrendered). *Malibu Boats* laid out a three-factor test to determine success under the doctrine of prosecution history estoppel: "(1) whether there was a surrender; (2) whether it was for reasons of patentability; and (3) whether the accused design is within the scope of surrender."[396] Importantly, when a design is cancelled in response to a restriction requirement, "the applicant surrendered such designs and conceded that the claim was limited to what the remaining figure[s] show[] … and colorable imitations thereof."[397]

A district court case from the Central District of California applied these principles and determined a design was surrendered during prosecution.

ADVANTEK MARKETING, INC. V. SHANGHAI WALK-LONG TOOLS CO., NO. 2:16-CV-03061 (C.D. CAL. NOV. 3, 2016)

In this case, the court granted the defendant's motion for judgment on the pleadings.[398] In the order granting the defendant's motion, the court took judicial notice of the prosecution history of the application that lead to US Patent No. D715,006 (the '006 Patent).[399] The court first noted that "it is generally accepted that records from the United States Patent and Trademark Office [] may be judicially noticed" and that courts may rely upon judicially noticed information in deciding a motion under Rule 12.[400] This judicial notice of the prosecution history was necessary to consider the impact of prosecution history estoppel. The court noted there were three factors from *Malibu Boats* to consider as described above.[401]

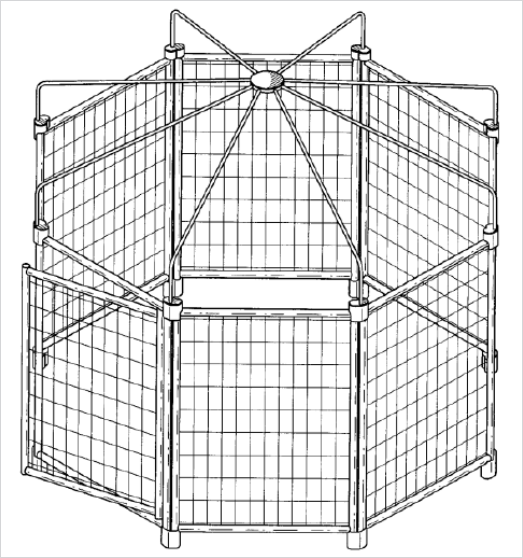
During prosecution of the '006 Patent, the plaintiff (as applicant before the USPTO) replied to a restriction requirement, choosing between two designs for a dog kennel (i.e., one having a cover and the other not having a cover), and choosing to cancel the unelected design (i.e., cancelling the figures to the kennel with a cover).[402] The court stated that the cancellation surrendered that design and limited the claim only to what was shown in the remaining design.[403] The defendant argued that the surrender was made for reasons of patentability and the accused product was within the scope of the unelected design.[404] The plaintiff argued that the cancellation of the one design was made in response to the restriction requirement and was required since design patents can contain only a single claim; in other words, the cancellation of the figures was not made for patentability.[405] The court disagreed and held that "[t]here was no reason to surrender the proposed kennel with a cover other than to secure a patent."[406]

Finally, the court held that the cancellation was a narrowing amendment and surrendered the kennel with a cover design.[407] The court then noted that the defendant's accused product was exactly that—a kennel with a cover.[408] The court based its decision on the plaintiff's providing the description and image of the defendant's product and that the plaintiff did not dispute the contents of the file history, specifically the diagrams and descriptions.[409]

[395] 739 F.3d 694 (Fed. Cir. 2014).
[396] *Id.* at 702.
[397] *Id.* at 703.
[398] *Advantek Mktg., Inc. v. Shanghai Walk-Long Tools Co.*, No. 2:16-cv-030601, Slip Op. at 1 (C.D. Cal. Nov. 3, 2016) (Dkt. No. 36).
[399] *Id.* at 2.
[400] *Id.* (citing *Anderson v. Kimberly-Clark Co.*, 5700 Fed. App'x 927, 932 n.3 (9th Cir. 2014).
[401] *Id.* at 2–3 (citing *Pacific Coast Marine Windshields v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014)).
[402] *Id.* at 3.
[403] *Id.* (citing *Malibu Boats*, 739 F.3d at 703).
[404] *Id.*
[405] *Id.*
[406] *Id.*
[407] *Id.* (citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabuishiki Co., Ltd.*, 535 U.S. 722, 737 (2002)).
[408] *Id.* at 4.
[409] *Id.*

Below, from the original complaint in the case, is a comparison figure provided by the plaintiff:[410]

Comparison of '006 patent and defendants product



The '006 Patent,

Defendants' Pet Companion Product

A figure representing the cancelled design is shown below (from the defendant's memorandum in support of its motion).[411]

The court noted that the case differed from *Malibu Boats* because there the accused design fell within an unclaimed range of the surrendered designs and here, the defendant's product was not within the unclaimed range, but was "the exact same as the design surrendered by the Plaintiff."[412]

This case illustrates an application of *Malibu Boats* in consideration of the application of prosecution history estoppel in the context of design patents. The case clearly illustrates the impact of a restriction election in a design application. Design patent applicants need to be aware of the impact of electing a particular group and surrender of the subject matter for that design. Because of this, it is important to file divisional application(s) to cover unelected group(s), otherwise the subject matter of unelected groups is surrendered, potentially limiting future enforcement options for the design patent. A second important lesson for patent owners is to understand the scope of the design patent before it is asserted—considering the prosecution history is a critical part of this assessment that should not be overlooked.

[410] Dkt. 1 (Complaint) at 5.

[411] Dkt. 25 (Memorandum) at 5.
[412] Dkt. No. 36 (Order) at 14.

CONCLUSION

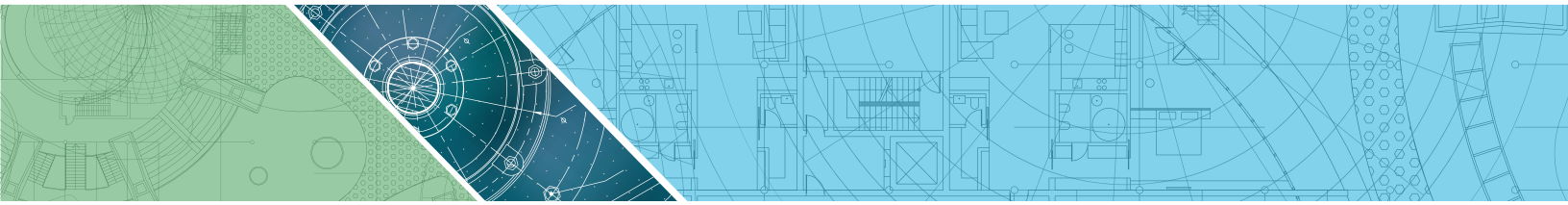
Just like 2015, this past year was notable in the world of design patent law. Concepts, both contemporary and commonplace in design law, were examined by courts at all levels, providing additional guidance on these concepts.

For example, 2016 reminded us of the importance of proper prosecution practices. From keeping proper records during conception/reduction to practice in order to clearly establish inventorship to preparing drawings based on figures from earlier applications in a priority chain (including drawings stemming from photographs), various decisions illustrated that attention to details in the preparation phase can be very relevant through the life of the patent. Additionally, decisions highlighted potential consequences arising from decisions made during prosecution when, for example, prior art is cited or embodiments are restricted. These lessons, while seemingly familiar, exhibit some of the many issues that may arise during or as a result of design patent preparation and prosecution.

Furthermore, 2016 showcased a number of lessons from litigation regarding invalidity and infringement. In discussing the topic of obviousness, the PTAB provided various illustrations of both successful and unsuccessful combinations of prior art references and the importance of an expert declaration to support an obviousness analysis. In examining infringement, the courts further elaborated on the ordinary observer test and presented new views on the use of utility patents as prior art in an infringement analysis for design patents.

And, when discussing the ornamental and functional features of a design, the courts once again examined invalidity allegations based on the argument that a design is primarily functional. In doing so, the courts reiterated the concepts that the overall appearance rather than isolated elements should be examined and functional features can play a dual role in adding to the ornamentality of the device. Thus, to best support a finding of functionality, one should focus on the *PHG* factors and emphasize the functionality of not only the individual elements, but also the overall design.

Finally, and most notably, changes in design patent damages law, based on the Supreme Court's *Apple* decision, may have the most impact on design patent litigation moving forward. Oftentimes, the "total profits" reward may be viewed as a driving factor in initiating a design patent infringement allegation. Due to the potential impact that *Apple* may have on calculation of these "total profits," the upcoming year will reveal just how much of a driving factor this reward is.



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Alison's practice focuses on protection of client IP assets through patent litigation and prosecution.

Alison is involved with all aspects of patent practice, focusing on patent prosecution and litigation. She works closely with clients to protect intellectual property rights, with particular emphasis on software, business method and electromechanical and computer related technologies. In addition to her patent experience, Alison also prepares and files trademark applications and performs and analyzes trademark and service mark searches for use and clearance purposes.

As a former business methods patent examiner at the United States Patent & Trademark Office, Alison leverages her background to provide informed advice and strategies to companies and organizations, guiding them through patent issues such as litigation, patent prosecution, and licensing.

RELEVANT EXPERIENCE

- Drafts and files patent applications in business methods, mechanical, and computer-related arts.
- Prosecutes and handles infringement opinion work for design patents.
- Reviews Office Actions from the U.S. Patent and Trademark Office and provides recommended courses of action for clients, composes amendments and arguments in response, and interviews Patent Examiners in response.
- Formulates claim chart analyses.
- Drafts and files complaints with the World Intellectual Property Organization concerning domain name disputes.
- Researches and drafts infringement analyses.
- Interviews Patent Examiners in order to further patent prosecution.
- Represented Japanese companies in patent matters, including patent prosecution, patent litigation support and rendering opinions concerning patent infringement, validity, and enforceability.
- As an analyst for a leading consulting group, developed and maintained the e-Procurement web application for the State of Florida, diagnosed application software component problems, designed modification to code and created alternate processes to address any identified problems.

MEMBERSHIPS

- Member, New York City Bar, Patent Committee

PUBLICATIONS

- Editor, 2015 Eastern District of Virginia Intellectual Property Year in Review, February 2016
- Co-author, *Inter Partes* Review Year In Review, 2014
- Co-author, Eastern District of Virginia Intellectual Property Year In Review, 2014

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Steve's practice focuses on all aspects of intellectual property law including patent prosecution, patent litigation and counseling related to mechanical devices, electronics, software, e-commerce, and financial services. Steve also frequently provides advice on claim construction, infringement, and validity issues in patent litigation.

Prior to joining Hunton & Williams, Steve served as a Surface Warfare Officer in the US Navy from 1992 to 2004. From 2004 to 2007, he worked at Strategic Insight, Ltd as a general associate. He joined the firm as a patent clerk in 2007, while earning his law degree from George Washington University Law School.

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- Participates in all aspects of patent litigation across a diverse set of technologies such as medical devices, computer and software technology, encryption, security systems, telecommunications systems, and e-commerce technology. Experience includes litigation preparation, motions practice, including motions for summary judgment on validity and infringement issues, claim construction, expert report preparation, expert and fact witness deposition preparation, and pre-trial preparation.
- Prepares and prosecutes design and utility patent applications in the mechanical, electrical, and computer-based arts including inventions relating to agricultural devices, radar, mobile electronic devices, telecommunications systems, and financial services.
- Participates in all aspects of post-grant proceedings relating to mechanical and electrical devices, including ex parte reexamination and *inter partes* review.

MEMBERSHIPS

- Member, American Intellectual Property Law Association
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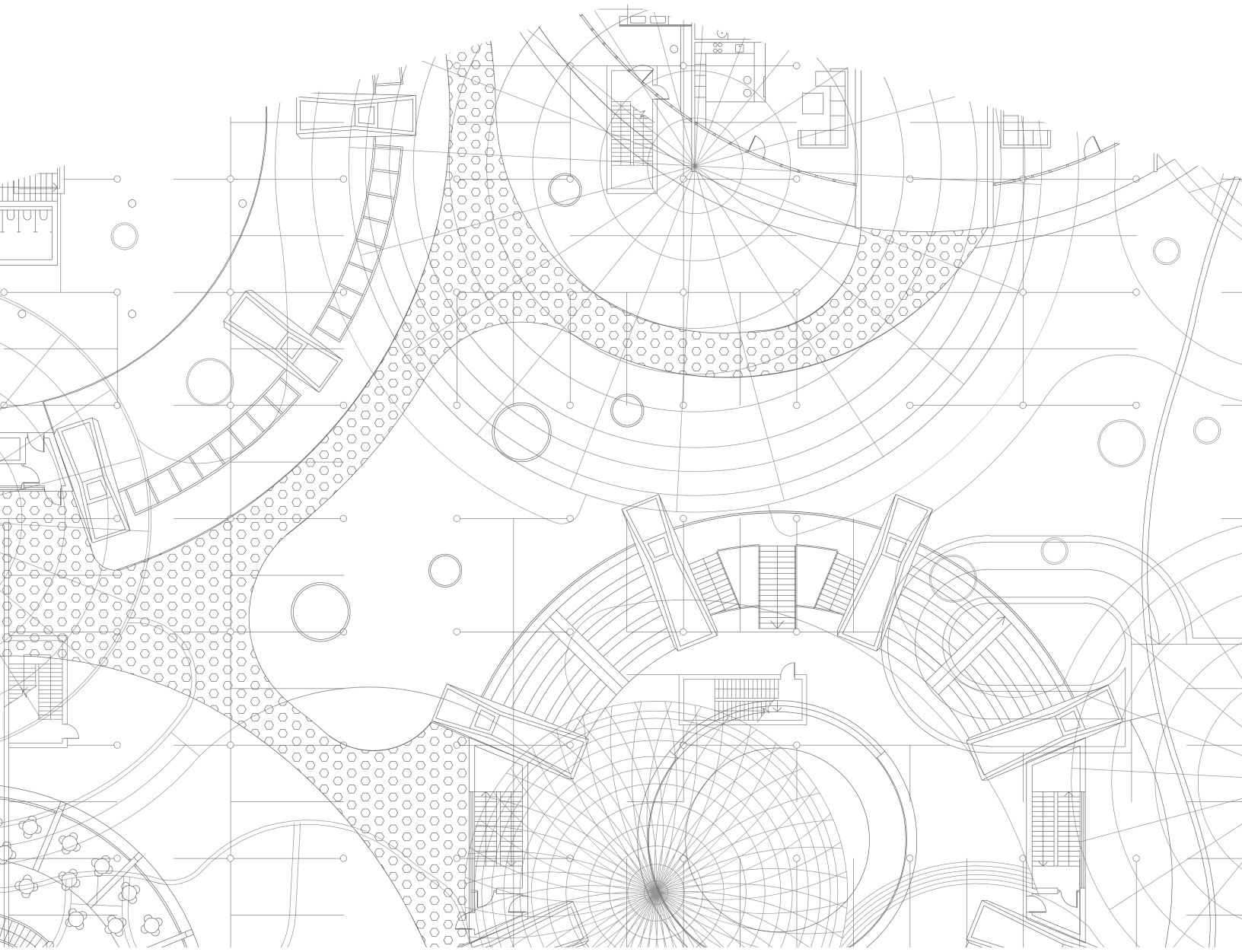
PUBLICATIONS

- Co-author, Why design patents should not be overlooked, *Intellectual Property Magazine,* April 2016
- Co-author, *2015 Design Patents Year in Review*, February 11, 2016



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