



2015

Design Patents
Year In Review

HUNTON &
WILLIAMS

TABLE OF CONTENTS

Executive Summary	3
Introduction	4
Design Patent Statistics	5
The Hague System	7
Design Patent Litigation	7
<i>Inter Partes</i> Review of Design Patents	8
Patent Damages	10
Functionality versus Ornamentality	15
Invalidity and Claim Construction	21
Design Patent Infringement	23
Infringement Liability	25
Conclusion	27
Author Bios	28

EXECUTIVE SUMMARY

In 2015, the US Court of Appeals for the Federal Circuit affirmed the decision of the Patent Trial and Appeal Board in the first *inter partes* review filed on a design patent (*Luv N' Care Ltd. v. Munchkin, Inc.*). The Federal Circuit also released the *Apple Inc. v. Samsung Electronics Co., Ltd.* decision highlighting 35 U.S.C. § 289, which allows a patent owner to recover an infringer's total profits, as well as the *Nordock, Inc. v. Systems Inc.* decision highlighting that both 35 U.S.C. §§ 284 and 289 are available as damages options for design patent infringement. Other Federal Circuit decisions of note include *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.* (highlighting analysis of ornamentality versus functionality in design patents) and *High Point Design LLC v. Buyer's Direct, Inc.* (highlighting the analysis for infringement and invalidity of design patents). Two district court decisions highlight the application of the tests for ornamentality and functionality (*Hunter's Edge, LLC v. Primos, Inc.* (M.D. Ala) and *Group-A Autosports, Inc. v. DNA Motor, Inc.* (C.D. Cal)). Finally, two other 2015 court decisions are worth noting: the *Reddy v. Lowe's Companies, Inc.* summary judgment decision from the District of Massachusetts that applied the ordinary observer test for infringement as well as highlighting the importance of shading in design patent drawings, and the Federal Circuit decision in *Milo & Gabby, LLC v. Amazon.com, Inc.* that focused on infringement issues related to selling products on the Internet, an important topic in today's world of e-commerce that is applicable to both design patents (as were asserted in the case) and utility patents.

Importantly, worldwide, design application filings continue to increase. At the postgrant review level, *inter partes* review petitions for design patents have increased each year since the implementation of the America Invents Act in 2012. However, the number of design patent litigation cases at the district court level has remained fairly steady since 2008.

Finally, the United States acceded to the Hague System for the International Registration of Industrial Designs in May 2015. The Hague System provides a system similar to the Patent Cooperation Treaty, allowing applicants to file a single design application, which serves as the basis for seeking protection in all member countries.



INTRODUCTION

The past year was eventful in the world of design patents. For example, 2015 confirmed that *inter partes* review (“IPR”) has become an increasingly popular way to challenge the validity of patents, including design patents. Indeed, petitions for IPR of design patents have increased each year since the implementation of the America Invents Act (“AIA”) in September 2012. The first design patent IPR decision from the Patent Trial and Appeal Board (“PTAB”) was appealed to the Federal Circuit, which affirmed the PTAB’s ruling. The PTAB’s written decision in *Luv N’ Care Ltd. v. Munchkin, Inc.* is instructive on the written description requirements for priority application support for a design patent (in this IPR, a design patent claimed priority to a utility patent) as well as amendment requirements for design patents in IPRs.

Federal Circuit decisions relating to design patents in 2015 focused on three main areas: damages; functionality versus ornamentality relating to invalidity and claim construction; and the tests for infringement and invalidity of design patents. Additionally, claim construction was a theme present throughout these decisions.

On damages, *Apple Inc. v. Samsung Electronics Co., Ltd.* applied 35 U.S.C. § 289, which allows a patent holder to recover an infringer’s total profits. This case was also instructive on other areas of design patent law, including sufficiency of evidence and jury instructions regarding functionality, actual deception and prior art. *Nordock, Inc. v. Systems Inc.*, although not as publicized as the *Apple* decision, is also important for design patent damages as it clarifies that either patent damages provision— 35 U.S.C. § 284 or § 289 — can be applied in design patent infringement. Thus, a design patent owner has two damages options — “traditional” patent damages under § 284 or total profits from the article of manufacture covered by the asserted design under § 289. However, a patent owner may recover damages under only one of those provisions. Indeed, in certain cases, the total profits may be less than a reasonable royalty.

On the issue of functionality versus ornamentality in design patent claims, *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.* is instructive on the requirements that

design patents cover ornamental aspects of an object and not functional aspects, as well as the role that alternative designs play in this analysis. This is a key issue when determining the scope of a design patent’s claim for infringement. In the *Ethicon* decision, the court also clarified the *Egyptian Goddess* regarding comparison to the prior art. Two district court cases are also instructive on ornamentality versus functionality and illustrate applications of the analysis: (1) *Hunter’s Edge, LLC v. Primos, Inc.*, from the Middle District of Alabama, emphasizes that claim construction should focus on the nonfunctional portions of the claimed design, as well as considering designs as a whole in the infringement analysis in the context of the application of a two-dimensional design to a three-dimensional object and (2) *Group-A Autosports, Inc. v. DNA Motor, Inc.*, from the Central District of California, tackles functional aspects of a design in the context of claim construction.

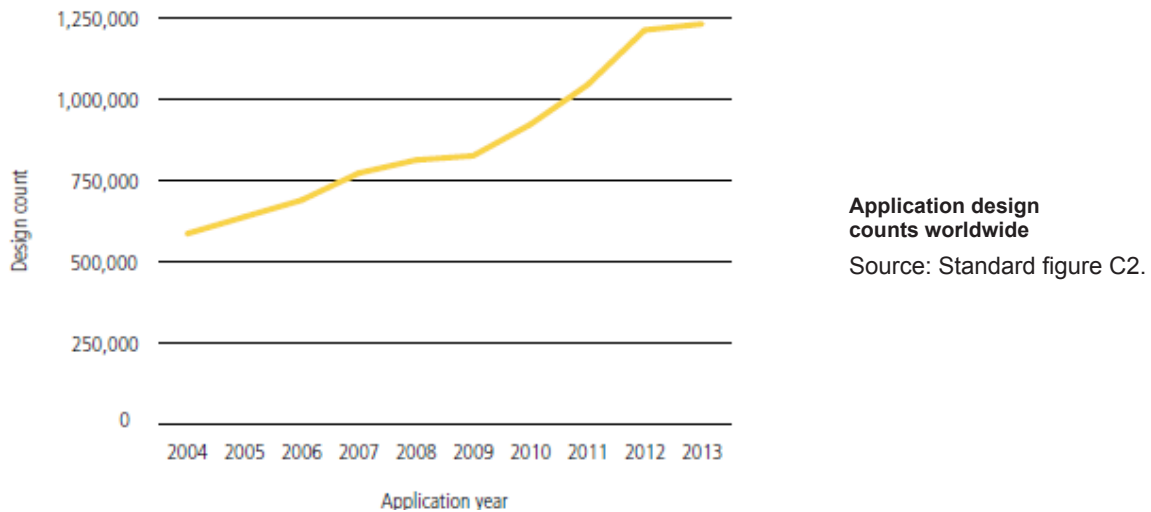
On invalidity and infringement with respect to design patents, the Federal Circuit’s decision in *High Point Design LLC v. Buyer’s Direct, Inc.*¹ clarifies the distinction between the tests for anticipation and obviousness for design patents, as well as the proper level of detail required for claim construction (the claim construction cannot be at too high of a level of abstraction).

Finally, two other design patent court decisions from 2015 are of note. First, the District of Massachusetts issued a summary judgment decision in *Reddy v. Lowe’s Companies, Inc.* regarding infringement. This decision illustrates an application of the ordinary observer test for infringement as well as the importance of shading in design patent drawings. Second, the Federal Circuit decision in *Milo & Gabby, LLC v. Amazon.com, Inc.* focuses on infringement issues related to selling products on the Internet, an important topic in today’s world of e-commerce. Design patents were asserted in the case, but the holding is applicable to both design patent and utility patent infringement.

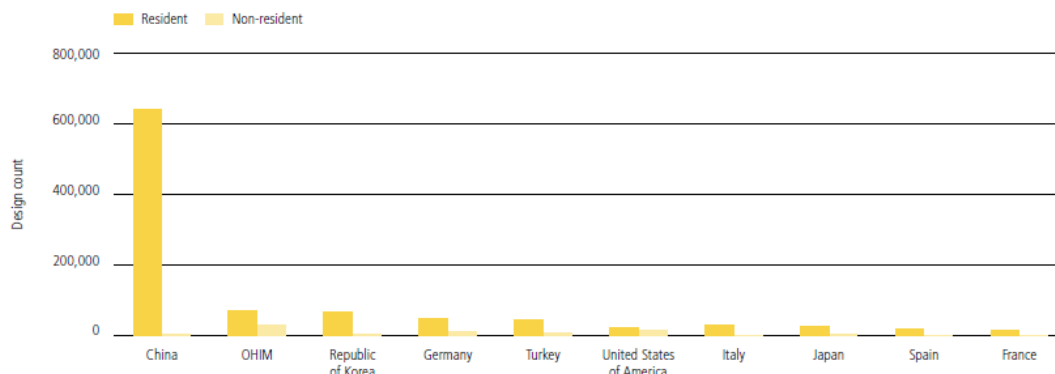
¹ This is the second Federal Circuit opinion in this case and, although nonprecedential, is included here because the opinion is instructive on several aspects of design patent infringement and invalidity.

DESIGN PATENT STATISTICS

Design patents and design registrations are increasing in popularity throughout the world. WIPO's *World Intellectual Property Indicators*, 2014,² provides statistics from the WIPO statistics database on worldwide industrial design application filings that demonstrate industrial design application filings have grown each year since 1995.³



China's SIPO (State Intellectual Property Office of the People's Republic of China) received the most application filings, followed by the European Union's OHIM (Office for Harmonization in the Internal Market) and South Korea's KIPO (Korean Intellectual Property Office).⁴ The USPTO has the sixth-greatest number of application filings.⁵



Application design counts for the top 10 offices, 2013

Source: Standard figure C10.

² WIPO Pub. No. 941, available at <http://www.wipo.int/ipstats/en/wipi/>.

³ *Id.*, p. 98, Figs. 12 and 13.

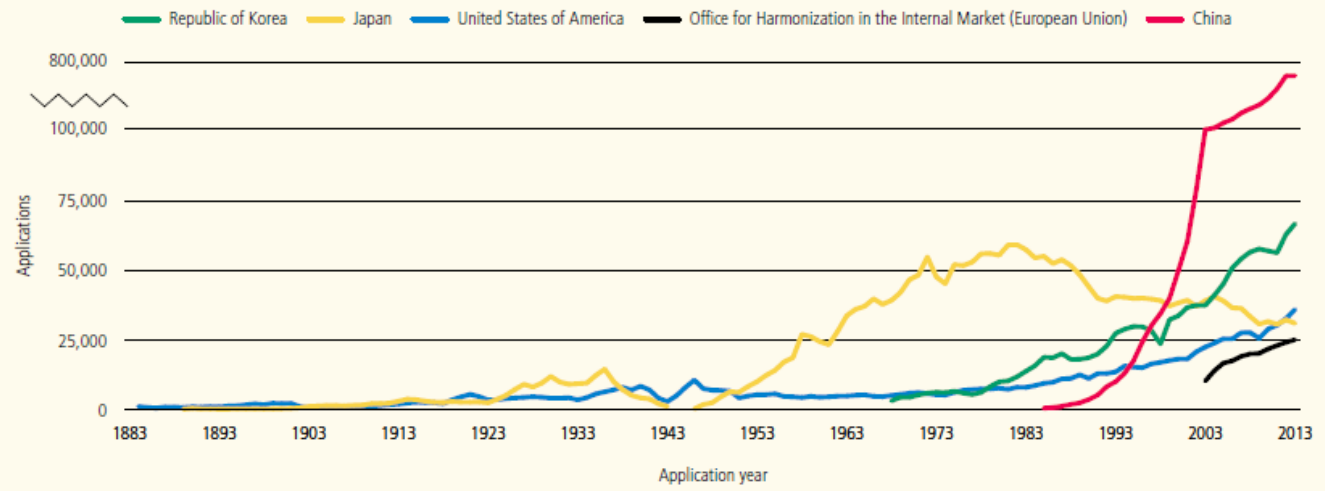
⁴ *Id.*, pp. 98-99, Fig. 14.

⁵ *Id.*

Between 1883 and the early 1950s, the Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO) averaged similar numbers of applications, rarely exceeding 10,000. The JPO began to receive the largest number of applications from the 1950s to the late 1990s, with about 50,000 annual filings at its peak. SIPO began receiving applications in 1985 and saw unprecedented growth from about 50,000

in the early 2000s to 660,000 in 2012. In 2004, KIPO surpassed the JPO and has remained the second largest office. In 2012, the USPTO moved ahead of the JPO to become the third largest. The OHIM began receiving applications in 2003 and has remained the fifth largest. Unlike for the other four offices, OHIM has a multiple design system. Applications filed with OHIM contained about 97,000 design in 2013.

Trend in industrial design applications for the top five offices



Industrial design filings since 1883; Source: Standard figure C9.

The number of design application filings each year at the USPTO has increased over the last 20 years.⁶

⁶ *Id.*, p. 101.

THE HAGUE SYSTEM

On May 13, 2015, the United States officially became a member of the Hague System for the International Registration of Industrial Designs⁷ (“Hague Agreement”) and the USPTO began accepting international design applications (“IDAs”). This system can be thought of as a PCT-like system for design patents. The Final Rules were published at 80 Fed. Reg. 17918 (April 2, 2015). The Hague Agreement allows for filing a single, standardized design application in a single language. Protection then can be sought in the various contracting parties to the agreement.⁸ There are presently 64 contracting parties to the Hague Agreement.⁹ It should be noted that China, Canada, Mexico and Australia are not members of the Hague Agreement at this point in time.¹⁰

Under the Hague Agreement, however, the USPTO continues to substantively examine design applications.¹¹ Stated differently, becoming a member of the Hague Agreement did not alter the examination process at the USPTO for design applications. In contrast, certain members of the Hague Agreement, such as the European Union (European Community Design), have design registration systems lacking a substantive examination component.

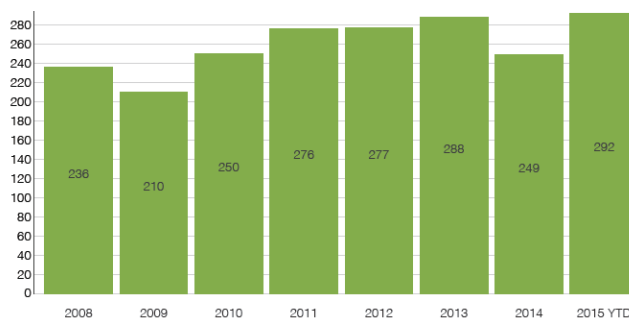
While the Hague Agreement allows for the filing of a single application that serves to provide design protection across Hague Agreement members, the design application must still comply with US requirements. For example, the Hague Agreement allows for inclusion of up to 100 designs in the same Locarno Classification but US requirements allow for claiming of only a single distinct design in a design patent.¹² Accordingly, if a Hague application is filed and contains the allowed 100 designs and enters the national phase in the United States, depending on the situation, an applicant may be required to elect a single design to proceed with for examination in the United States and be forced to file one or more divisional applications to cover the unelected designs. The divisional filings of course add cost to the

application process. Thus, it is important to understand the requirements of each member country where protection is sought when filing an application under the Hague Agreement. Further, it may be prudent, prior to filing the design application under the Hague Agreement, to retain counsel familiar with national stage requirements in the various member countries that perform substantive examination of design applications. Also, it is important to note that the filing process for a Hague Agreement application differs moderately from that of filing a “direct” US design application at the USPTO.¹³ Practitioners need to become familiar with these requirements to avoid costly mistakes.

However, a benefit of the United States’ ratification of the Hague Agreement is an increase in design patent term from 14 to 15 years, which applies to all design applications filed in the United States after May 13, 2015, (including continuing applications of earlier filed design applications).¹⁴

DESIGN PATENT LITIGATION

Below is a chart of the number of design patent complaints filed in district courts since 2008, as of December 31, 2015, produced using Docket Navigator’s analytics. As can be seen, the number of design patents asserted in district court cases has been relatively steady over the past few years, but 2015 has an increase in filings over 2014.



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

⁷ See http://www.wipo.int/hague/en/news/2015/news_0007.html (“The United States of America and Japan can now be Designated in International Design Applications”).

⁸ See Hague Yearly Review, 2015 (WIPO Pub. No. 930), available at <http://www.wipo.int/hague/en/>.

⁹ See Listing of Hague Contracting Parties as of Oct. 27, 2015, available at <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf>.

¹⁰ *Id.*

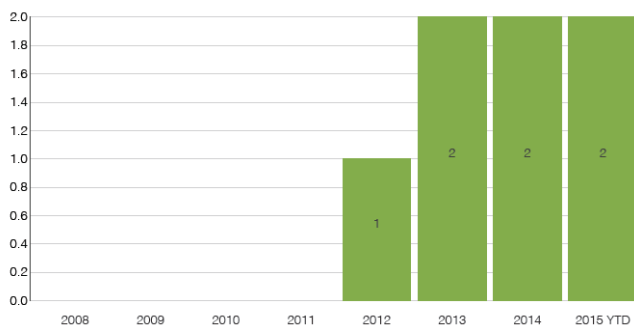
¹¹ See Frequently Asked Questions on the Hague Agreement, available at: <http://www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs#faq>.

¹² *Id.*

¹³ See EFS-Web Quick Start Guide, available at: <http://www.uspto.gov/sites/default/files/documents/Hague-QSG.pdf>.

¹⁴ *Id.*

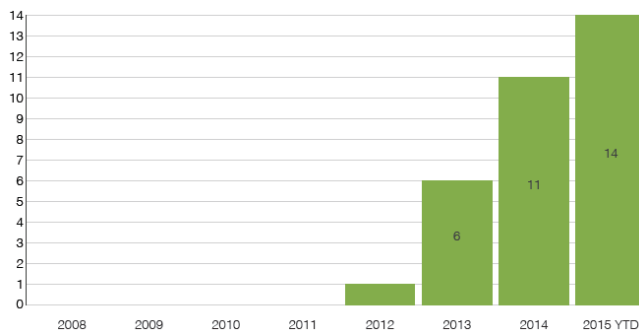
Below is a chart of the number of design patent complaints filed at the International Trade Commission (“ITC”) since 2008, as of December 31, 2015.



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

The only two investigations involving design patents that terminated at the ITC this year were based on consent order stipulations that terminated respondents from the investigations; such investigations do not result in a written opinion.¹⁵ An initial determination was issued in one investigation, 337-TA-935, Personal Transporters, Components Thereof, and Manuals Therefor, in which the complainant’s motion for summary determination was granted.¹⁶ However, the commission determined to review it in part, and so a commission opinion must issue before any part of the initial determination granting summary determination can be deemed final.¹⁷

Below is a chart of the number of *inter partes* review petitions involving design patents filed with the PTAB as of December 31, 2015, since 2012, showing that design patent IPR petitions have increased each year.



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

¹⁵ Inv. Nos. 337-TA-959, Electric Skin Care Devices, Brushes and Chargers Therefor, and Kits Containing Same, and 337-TA-948, Toy Figurines and Toy Sets Containing the Same.

¹⁶ Inv. No. 337-TA-935, Init. Det. Granting Summ. Det. (Sept. 16, 2015) (finding two design patents infringed and not invalid).

¹⁷ Inv. No. 337-TA-935, Comm’n Det. to Review in Part the Init. Det. Granting Summ. J. (Oct. 7, 2015).

INTER PARTES REVIEW OF DESIGN PATENTS

Inter partes review became available as a method of invalidating patents with the America Invents Act on September 16, 2012. This proceeding, in which a party can petition to invalidate a design patent (or a utility patent) under 35 U.S.C. §§ 102 and 103, provides a patent owner an opportunity for a response and to amend the claims at issue. In 2014 the Patent Trial and Appeal Board issued its first final written decision involving a design patent. In 2015 the Federal Circuit affirmed the PTAB’s decision. Below is a summary of the decision. This decision is interesting because the patent owner conceded that the claimed design was not distinct from the prior art and the arguments rested solely on the propriety of the priority claim.

LUV N’ CARE LTD. V. MUNCHKIN, INC., 599 FED. APP’X 958 (FED. CIR. 2015)

On April 21, 2014, the PTAB issued its first-ever final written decision that invalidated the sole claim of a design patent challenged in *inter partes* review, a proceeding created by the America Invents Act of 2012.¹⁸ Shortly thereafter, the US Court of Appeals for the Federal Circuit affirmed the PTAB’s final written decision under Rule 36, without a published opinion.¹⁹

The PTAB’s written decision is instructive on the written description requirements for support from a priority application, in this case a utility patent, as well as the requirements and bounds of amendments for design patents in IPRs.

Munchkin, Inc., and Toys “R” Us, Inc. (collectively, “Petitioner”) filed an IPR petition on December 5, 2012, seeking to invalidate the sole claim in Luv N’ Care’s (hereinafter, “Patent Owner”) US Patent D617,465 (the “’465 Patent”).²⁰ The PTAB instituted the IPR on April 25, 2013.²¹ In response, Patent Owner filed its response and a motion to amend the claim.²² The PTAB held the challenged patent obvious over US 2007/0221604 A1 (“Hakim ’604”) and over US 6,994,225 B2 (“Hakim ’225”) and further held that the Patent Owner had not met its burden of proof on the motion to amend.²³

¹⁸ See *Munchkin, Inc. v. Luv N’ Care, Ltd.*, No. IPR2013-00072 (Paper No. 28).

¹⁹ *Luv N’ Care Ltd. v. Munchkin, Inc.*, 599 Fed. App’x 958 (Fed. Cir. 2015).

²⁰ *Munchkin, Inc. v. Luv N’ Care, Ltd.*, No. IPR2013-00072 (Paper No. 3).

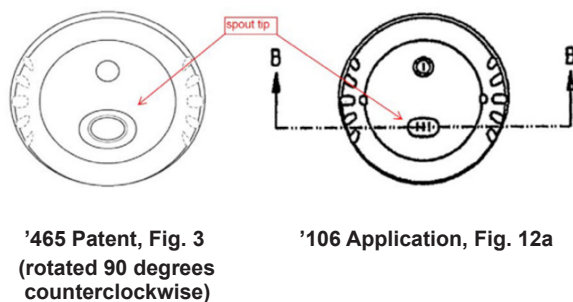
²¹ *Munchkin, Inc. v. Luv N’ Care, Ltd.*, No. IPR2013-00072 (Paper No. 8).

²² *Munchkin, Inc. v. Luv N’ Care, Ltd.*, No. IPR2013-00072 (Paper Nos. 13 and 14).

²³ *Munchkin, Inc. v. Luv N’ Care, Ltd.*, No. IPR2013-00072 (Paper No. 28) at 2.

The '465 Patent is titled "Drinking Cup" and names Nouri E. Hakim as the inventor.²⁴ After instituting trial, Patent Owner did not argue that the claim was distinct from the aforementioned references. Instead, Patent Owner argued that the references were not prior art because the '465 Patent was entitled to a priority date earlier than the prior art date. Specifically, Patent Owner argued it was entitled to its parent's (US Application serial no. 10/536,106, or the "'106 Application") effective filing date of August 5, 2003,²⁵ thereby disqualifying Hakim '225 and Hakim '604 as prior art.²⁶

The PTAB, however, agreed with Petitioner that the '106 Application fails to provide written description support for the claim of the '465 Patent as required by 35 U.S.C. § 112(a).²⁷ In a side-by-side (top-view) comparison of Figure 3 of the '465 Patent and Figure 12a of the '106 Application, reproduced below, the PTAB noted the following differences: "(1) the outer boundary of the spout tip of the claimed design is larger than that of the '106 [A]pplication; (2) the spout tip of the claimed design has a different, more rounded, oval shape than that of the racetrack shape of the spout tip in the '106 [A]pplication; and (3) the spout tip of the claimed design has three concentric rings that the '106 [A]pplication does not disclose."²⁸



Patent Owner argued that the '106 Application provided an adequate written description based on its disclosure that stated: "... the preferred embodiment of the spout ... is in the shape of an oval when viewed from the top. Alternately, another shape may be provided"²⁹ The PTAB disagreed and noted that this disclosure for the spout's shape did "not identify the specific shape of the spout claimed in the design or otherwise reasonably

²⁴ *Id.* at 3.

²⁵ *Id.* at 5-6.

²⁶ The Hakim '225 reference has a filing date of August 5, 2003, and the Hakim '604 reference is a publication of the '106 application that also has a filing date of August 5, 2003.

²⁷ *Munchkin, Inc. v. Luv N' Care, Ltd.*, No. IPR2013-00072 (Paper No. 28) at 8.

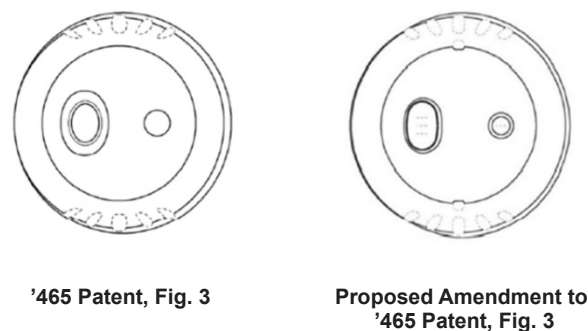
²⁸ *Id.* at 7.

²⁹ *Id.*

convey to those skilled in the art that the inventor had possession of the claimed design."³⁰ Thus, the PTAB denied Patent Owner the filing date of the '106 Application based on the aforementioned differences, which meant that Hakim '225 and Hakim '604 were indeed available as prior art.³¹

This decision by the PTAB effectively determined the outcome of the IPR because Patent Owner conceded that the claim is not patentable if it is denied the filing date of the '106 Application. The PTAB decided that Hakim '225 and Hakim '604 were "prior art to the claim of the '465 Patent, which would have been obvious over either reference."³²

Patent Owner filed its motion to amend the sole claim, pursuant to 35 U.S.C. § 316(d), in an effort to gain support by the disclosure and benefit from the '106 Application's filing date.³³ In response, Petitioner argued that Figures 1-5 of Patent Owner's proposed amendments incorrectly enlarged the scope of the claim.³⁴ At the heart of the argument was Figure 3, which Petitioner contended had "differences between spout tip of the issued claim and that of the proposed amended claim." (depicted below).³⁵



The PTAB further stated that "... the proposed amended claim is broader than the issued claim because it is broader with respect to racetrack-shaped spout tips and raised rim vents, even though it may be narrower with respect to egg-shaped spout tips and vents without raised rims."³⁶ After citing to *Thermalloy, Inc. v. Aavid Eng'g, Inc.*,³⁷ which stated that "a new claim is enlarged if it

³⁰ *Id.* at 8.

³¹ *Id.*

³² *Id.*

³³ *Id.* at 9.

³⁴ *Id.* at 12.

³⁵ *Id.* at 12-13.

³⁶ *Id.* at 14.

³⁷ 121 F.3d 691, 692 (Fed. Cir. 1997).

includes within its scope any subject matter that would not have infringed the original . . .,” the PTAB decided that the proposed claim enlarges the scope since a drinking cup with the above features “could infringe the proposed amended claim based on its overall design, yet not infringe the issued claim.”³⁸ For these reasons, the PTAB denied Patent Owner’s motion to amend, and Patent Owner could not successfully disqualify the Hakim ’225 and Hakim ’604 references.³⁹

PATENT DAMAGES

The determination of damages for design patent infringement received significant attention this year with two Federal Circuit opinions: *Apple Inc. v. Samsung Electronics Co., Ltd.*, and *Nordock, Inc. v. Systems Inc.* Both of these opinions have holdings regarding the damages available to design patent owners. Damages for infringement of a design patent can be obtained under 35 U.S.C. §§ 284 or 289. Under § 284, a patent owner can recover lost profits or a reasonable royalty. Under § 289, a patent owner can recover either total profits from the infringer’s sales of the article of manufacture incorporating the claimed design or \$250. This presents three options, of which a patent owner can be awarded one.

It remains to be seen whether Congress will respond to the *Apple* decision with any proposed amendments to the damages provision for design patents, altering the ability of a patent owner to recover total profits from an infringer. However, the *Apple* has thrust this component of patent law into the spotlight.

APPLE INC. V. SAMSUNG ELECTRONICS CO., LTD., 786 F.3D 983 (FED. CIR. 2015)

In *Apple Inc. v. Samsung Electronics Co., Ltd.*,⁴⁰ the Federal Circuit upheld jury instructions that did not exclude functional, structural or nonornamental features from the design patent infringement analysis. The court additionally held that the jury instructions accurately reflected the role of prior art and the fact that actual deception of consumers is not required to find infringement. And of particular interest in this year’s design patent law cases, the court found that there was sufficient evidence for a reasonable jury to have concluded that Samsung’s devices infringed on

Apple’s design patents and affirmed the jury’s award of Samsung’s entire profits earned from the sale of the infringing smartphones.

This opinion illustrates the power of design patents, in particular the total profits damages provision of § 289, as well as helpful guidance on jury instructions for design patent infringement.

The dispute began when Apple sued Samsung in April 2011 for patent infringement and trade dress dilution.⁴¹ Samsung countersued Apple for patent infringement,⁴² and a trial followed.⁴³ At trial, Apple claimed that three years after the iPhone’s introduction in 2007, Samsung’s smartphones began to look progressively more like the iPhone in terms of both their outward appearance and user interface.⁴⁴ Samsung countered that Android developers did not copy the iPhone’s features.⁴⁵ Samsung also questioned the validity of Apple’s patents and argued that Samsung’s smartphones did not infringe any Apple patents.⁴⁶ Both Apple and Samsung offered testimony by prominent witnesses and experts to support their positions.⁴⁷ In August 2012 a jury found that various Samsung smartphones infringed Apple’s patents and diluted Apple’s trade dresses, awarding Apple more than \$1 billion in damages.⁴⁸ Despite Samsung’s post-trial motion,⁴⁹ the district court upheld \$639 million of the awarded damages but ordered a partial retrial on the issue of damages covering a time period during which Samsung did not have notice of some of Apple’s patents.⁵⁰

After the partial retrial, a new jury awarded Apple \$290 million in damages.⁵¹ The district court upheld the damages determination against another post-trial motion

⁴¹ Complaint, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. Apr. 15, 2011).

⁴² Samsung’s Answer to Amended Complaint of Apple, Counterclaim by Samsung Against Apple, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. June 30, 2011).

⁴³ Minute Entry, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. August 25, 2011) (setting jury trial for July 30, 2012).

⁴⁴ Jon Brodtkin, “Apple’s case that Samsung copied the iPhone and iPad—in pictures,” *ARS Technica* (Aug. 8, 2012, 9:30 AM).

⁴⁵ Shara Tibken, “Apple v. Samsung patent trial recap: How it all turned out (FAQ),” *CNET* (May 7, 2014, 4:00 AM).

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ Amended Jury Verdict, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. August 24, 2012).

⁴⁹ Motion for Judgment as a Matter of Law, New Trial and/or Remittitur Pursuant to Federal Rules of Civil Procedure 50 and 59, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. Oct. 2, 2012).

⁵⁰ Order Granting in Part and Denying in Part Motion for Judgment as a Matter of Law, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. Mar. 1, 2013).

⁵¹ Jury Verdict, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. Nov. 21, 2013).

³⁸ *Id.*

³⁹ *Id.* at 15.

⁴⁰ 786 F.3d 983 (Fed. Cir. 2015).

filed by Samsung.⁵² On March 6, 2014, the district court entered a \$929 million final judgment in favor of Apple,⁵³ which Samsung immediately appealed.⁵⁴ The US Court of Appeals for the Federal Circuit issued its opinion reviewing Samsung's appeal on May 18, 2015.⁵⁵ The court provided rulings regarding Apple's trade dresses, utility patents and design patents,⁵⁶ but this summary will focus solely on the portion of the opinion dedicated to the design patents.

Three of Apple's design patents were at issue on appeal. Apple's D618,677 patent covers the front face of the iPhone (exemplary figures shown below).⁵⁷

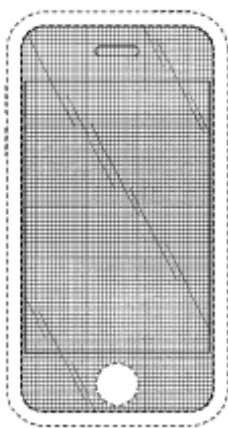


Fig. 3



Fig. 7



Fig. 8

Apple's D593,087 patent claims the iPhone's bezel-edge feature (exemplary figures shown below).⁵⁸



Fig. 19



Fig. 23



Fig. 24

And Apple's D604,305 patent focuses on the iPhone display screen's graphic user interface (exemplary figure shown below).⁵⁹



Fig. 1

Jury Instruction Not Excluding Functional Design Patent Features Was Proper

Samsung challenged the jury instructions, the sufficiency of the evidence and the district court's determination that the jury could award as damages Samsung's entire profits earned from its infringing devices.⁶⁰ First, Samsung attacked the jury instructions' articulations regarding functionality, actual deception and prior art. Samsung argued that the jury instructions should have excluded any functional or structural elements of the design patents from the infringement claim scope and that the instructions should have required that the Samsung smartphones be compared to the "overall *ornamental* appearance" rather than "the overall appearance" of the iPhone designs.⁶¹ The court found that Federal Circuit case law did not support Samsung's argument, relying on *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288 (Fed. Cir. 2010), and *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186 (Fed. Cir. 1988), to hold that there is no rule requiring that functional or structural elements of a design patent be eliminated "from the claim scope of a valid patent in analyzing infringement."⁶² Furthermore, reviewing the jury instructions as a whole, the court determined that the instructions sufficiently limited the scope of the patented designs to their "ornamental" elements.⁶³ There will likely be confusion going forward regarding design patent infringement instructions

⁵² Order Denying Apple's Motion for Judgment as a Matter of Law, Denying Samsung's Motion for Judgment as a Matter of Law, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. Feb. 7, 2014).

⁵³ Final Judgment, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. Mar. 6, 2014).

⁵⁴ Notice of Appeal to the Federal Circuit by Samsung, *Apple Inc. v. Samsung Electronics Co., Ltd.*, No. 5:11-cv-01846-LHK (N.D. Cal. Mar. 6, 2014).

⁵⁵ 786 F.3d 983 (Fed. Cir. 2015).

⁵⁶ *Id.* at 989.

⁵⁷ *Id.* at 997.

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.* at 998.

⁶¹ *Id.*

⁶² *Id.* at 998-99.

⁶³ *Id.* at 999.

because *Richardson* had formerly been interpreted by most to require that functional aspects of designs be excluded from the infringement analysis.

Jury Instruction Not Requiring Actual Deception By Consumers Was Proper

Samsung also argued that the jury instruction on infringement was erroneous because it failed to characterize actual deception of consumers as a requisite to liability and provided inadequate guidelines for considering prior art.⁶⁴ The court held that the jury instruction regarding actual deception accurately reflected the Supreme Court's analysis in *Gorham Co. v. White*, 81 U.S. 511 (1872), and that the text of the prior art instruction "did not reduce the entire prior art analysis to a mere option."⁶⁵

Secondly, Samsung asserted that the infringement verdict in favor of Apple was not supported by the evidence.⁶⁶ The court found that the testimony of Apple's witnesses was sufficient to permit the jury to account for functional aspects of the patented designs, to agree that an ordinary observer would be deceived by the Samsung smartphones' appearances, and to appreciate the differences between the patented designs and Samsung's prior art and competing products.⁶⁷ Therefore, the court found that "[t]he jury could have reasonably relied on the evidence in the record to reach its infringement verdict."⁶⁸ Additionally, the court held that the district court did not abuse its discretion in precluding rebuttal testimony regarding the "independent development of [Samsung's] F700 phone that pre-dated the iPhone," given the district court's determination that the proffered testimony would have little probative value.⁶⁹

Federal Circuit Affirmed Total Profit Damages

This particular aspect of the opinion is of prominent importance to design patent law, specifically damages. Samsung argued that the district court should have limited the damages to profits that Samsung's infringement caused rather than "allowing the jury to award Samsung's entire profits on its infringing smartphones."⁷⁰ The court rejected Samsung's arguments, finding that any causation requirement

had been foreclosed by Congress when it eliminated damages apportionment in the Act of 1887 (the damages provisions of this law, specific to design patent infringement, were later codified as § 289).⁷¹ Furthermore, the court acknowledged that the plain language of the act states that a design patent infringer "shall be liable to the owner to the extent of his *total profit*."⁷² Samsung argued in the alternative that the damages should be apportioned based on "the infringing 'article of manufacture,'" rather than "the entire infringing product."⁷³ Samsung supported its position by citing to *Bush & Lane Piano Co. v. Becker Bros.*, 222 F. 902, 903 (2d Cir. 1915), in which the Second Circuit affirmed an award of the profits from the part of a piano that an infringer had copied rather than profits from the entire piano.⁷⁴ In affirming the entire profits jury award, the court distinguished *Bush & Lane Piano Co.* by acknowledging that "[t]he innards of Samsung's smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers."⁷⁵ Additionally, the court acknowledged the *amicus* arguments that had been filed urging the court to interpret the damages provision as requiring some form of apportionment, stating that such policy arguments "should be directed to Congress" because the court is "bound by what the statute says, irrespective of policy arguments that may be made against it."⁷⁶

In December, Samsung filed a petition for *writ of certiorari* challenging the damages award and infringement holding. Samsung framed the issues as follows:

Design patents are limited to "any new, original and ornamental design for an article of manufacture." 35 U.S.C. 171. A design-patent holder may elect infringer's profits as a remedy under 35 U.S.C. 289, which provides that one who "applies the patented design ... to any article of manufacture ... shall be liable to the owner to the extent of his total profit, ... but [the owner] shall not twice recover the profit made from the infringement."

⁶⁴ *Id.*
⁶⁵ *Id.* at 999-1000.
⁶⁶ *Id.* at 1000.
⁶⁷ *Id.*
⁶⁸ *Id.*
⁶⁹ *Id.* at 1000-01.
⁷⁰ *Id.* at 1001.

⁷¹ *Id.*
⁷² *Id.* at 1001-02; *see also id.* at 1002 n.1.
⁷³ *Id.*
⁷⁴ *Id.*
⁷⁵ *Id.*
⁷⁶ *Id.*

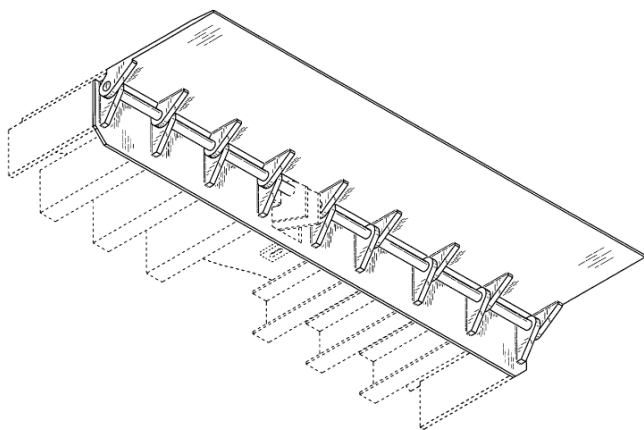
The Federal Circuit held that a district court need not exclude unprotected conceptual or functional features from a design patent's protected ornamental scope. The court also held that a design-patent holder is entitled to an infringer's entire profits from sales of any product found to contain a patented design, without any regard to the design's contribution to that product's value or sales. The combined effect of these two holdings is to reward design patents far beyond the value of any inventive contribution. The questions presented are:

1. Where a design patent includes unprotected non-ornamental features, should a district court be required to limit that patent to its protected ornamental scope?
2. Where a design patent is applied to only a component of a product, should an award of infringer's profits be limited to those profits attributable to the component?⁷⁷

It remains to be seen if the Supreme Court will grant the *writ*.

NORDOCK, INC. V. SYSTEMS INC., 2015 U.S. APP. LEXIS 17117 (FED. CIR. SEPT. 29, 2015)

Nordock sued Systems for allegedly infringing a design patent covering the ornamental design of a lip and hinge plate for a dock leveler. (US Patent No. D579,754) (Figure 1 of this patent is reproduced below.)



'754 Patent, Fig. 1

⁷⁷ Petition for Writ of Certiorari, *Samsung*, No. 15-___ (December 14, 2015).

A jury found that Systems' dock leveler infringed the patent and that the patent is not invalid.⁷⁸ Damages, in the form of a reasonable royalty, were awarded after the jury indicated that Systems' profits were \$0.⁷⁹ Nordock filed a post-trial motion to amend the judgment regarding damages or for a new trial; this motion was denied.⁸⁰ Nordock appealed. The Federal Circuit found that the district court erred in the assessment of damages and remanded the case.⁸¹

This opinion, like the *Apple* opinion discussed above, but not as publicized as *Apple*, also is instructive on design patent damages. However, the *Nordock* opinion highlights the choice in remedy that a patent owner has when asserting a design patent: a patent owner can seek relief in the form of traditional damages available under § 284 or total profits from the article of manufacture covered by the asserted design under § 289. This opinion also reiterates the test required for determining if a design patent is functional instead of ornamental.

Nordock argued that the district court erred in denying it a new trial on § 289 damages because the finding of \$0 in profits or that the profits did not need to be determined was not supported by a factual or legal basis.⁸² The Federal Circuit agreed.⁸³ The court noted that either compensatory damages (i.e., lost profits and reasonable royalty) under § 284 or the option of total profit on sales of the infringing article of manufacture or \$250, under § 289, is available for design patent infringement.⁸⁴ When pursuing damages under § 289, the court cautioned that "a design patentee can recover **one of** (1) total profits from the infringer's sales under § 289, (2) damages in the form of the patentee's lost profits or a reasonable royalty under § 284, or (3) \$250 in statutory damages under § 289, whichever is greater."⁸⁵

First, the court reviewed the district court's reliance on the "cost savings methodology" advanced by Systems' damages expert (Bero), who testified that Systems' profit on the accused dock leveler was less than \$15/unit (based on a cost savings associated with using the lip and hinge plate rather than the entire leveler unit),

⁷⁸ *Nordock, Inc. v. Systems Inc.*, 2015 U.S. App. LEXIS 17117, at *1,*9 (Fed. Cir. Sept. 29, 2015).

⁷⁹ *Id.* at *1.

⁸⁰ *Id.* at *2.

⁸¹ *Id.*

⁸² *Id.* at *12.

⁸³ *Id.*

⁸⁴ *Id.* at *12-13.

⁸⁵ *Id.* at *13 (citing *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1291 (Fed. Cir. 2002)).

which was less than the reasonable royalty rate of \$15/unit.⁸⁶ The Federal Circuit noted that reliance on this methodology was improper and instead a gross profit methodology should have been used because § 289 allows for recovery of the infringer's total profits, which are based on "gross revenue after deducting certain allowable expenses."⁸⁷ The court noted that the jury instructions were correct regarding the determination of profit but that Bero, in his cost savings methodology, ignored that total profits are based on the entire article of manufacture sold, not a portion thereof.⁸⁸ Systems argued that Nordock was entitled to only the profits attributable to the portions covered by the asserted patent; the Federal Circuit noted this was incorrect, citing to *Apple v. Samsung*.⁸⁹ Thus, the court remanded the case for a proper determination of Systems' profits based on proper methodology.⁹⁰

Next, the Federal Circuit considered the evidence that Systems' total profits were \$0 for the infringing article.⁹¹ The Federal Circuit noted differences between the parties' experts' calculations, and that the jury was entitled to believe one expert over another, but that Bero's conclusions regarding profits were incorrect because they were limited to only the lip and hinge plate portion of the article of manufacture.⁹²

Finally, the Federal Circuit considered Nordock's arguments that the district court improperly held that if there is a determination of damages under § 284, then calculation of damages under § 289 is not required.⁹³ The court noted that both the jury and the district court were "confused with respect to the interplay between §§ 284 and 289."⁹⁴ The court explained:

The district court blended its discussion of Nordock's compensatory damages with the evidence of Systems' profits. In doing so, the court overlooked a critical point: the fact that Nordock could recover only one type of damage on each sale — either (1) Nordock's lost profits or a reasonable royalty or (2) Systems' total profits — did not absolve the jury of its obligation to determine the amount of Systems' total profits

for purposes of determining damages under § 289. To the extent the district court believed that the jury could simply choose between awarding damages under § 284 or § 289, it is incorrect. As the court's jury instructions correctly stated, if the jury finds infringement, and does not find the D'754 Patent invalid, it is "to award Nordock Systems' total profit attributable to the infringement." Jury Instructions at 41. Only where § 289 damages are not sought, or are less than would be recoverable under § 284, is an award of § 284 damages appropriate.⁹⁵

The court thus remanded the case for the district court to revisit and restructure the jury instructions to provide a clearer and accurate picture of the damages requirements.⁹⁶

On Systems' cross appeal regarding validity of the asserted patent, the issue of whether the design was functional was raised.⁹⁷ After considering some procedural aspects raised by Systems regarding the issue under Fed. R. Civ. P. 50, the Federal Circuit held that there was "substantial evidence" from which a jury could conclude the design was not functional.⁹⁸ The court reiterated the factors from *Berry Sterling* that may help in determining functionality:

[W]hether the protected design represents the best design; whether alternative designs would adversely affect the utility of the specified article; whether there are any concomitant utility patents; whether the advertising touts particular features of the design as having specific utility; and whether there are any elements in the design or an overall appearance clearly not dictated by function.⁹⁹

The court specifically concluded that the testimony and evidence demonstrated that the design was "distinctive and ornamental," the "header plate was not necessary to the function of a dock leveler," "there are a wide variety of alternate designs available" and "the alternate designs achieve the same utilitarian purpose as the patented design."¹⁰⁰

⁸⁶ *Id.* at *16-17; see also *id.* at *8-9.

⁸⁷ *Id.* at *17-18 (citing *Nike Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1447-48 (Fed. Cir. 1998)).

⁸⁸ *Id.* at *18.

⁸⁹ *Id.* at *18-19 (citing 786 F.3d 983, 1001-02 (Fed. Cir. 2015)).

⁹⁰ *Id.* at *21.

⁹¹ *Id.*

⁹² *Id.* at *23.

⁹³ *Id.* at *23-24.

⁹⁴ *Id.* at *25.

⁹⁵ *Id.* at *26-27.

⁹⁶ *Id.* at *27.

⁹⁷ *Id.* at *30-31.

⁹⁸ *Id.* at *35.

⁹⁹ *Id.* at *34 (citing *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1455 (Fed. Cir. 1997)).

¹⁰⁰ *Id.* at *35.

FUNCTIONALITY VERSUS ORNAMENTALITY

The extent to which functionality of a design patent should be included in the scope of claim construction is a debated issue with no certain outcome as it involves a subjective assessment. Design patents are intended to protect only the nonfunctional, ornamental aspects of a design. This is a key issue that is often determined during claim construction, which is then applied to the invalidity and infringement analyses.

Because the scope of a design claim is limited to the ornamental aspects of the design, it is necessary to determine what aspects of a design are ornamental, and what aspects are functional. Alternative designs also are a component of the analysis because if there are alternative designs that achieve the same function for the same article to which a design is applied, then the design is likely ornamental. The test to determine ornamentality versus functionality is laid out in the cases summarized below, starting with the Federal Circuit opinion on *Ethicon*.

***ETHICON ENDO-SURGERY, INC. V. COVIDIEN, INC.*, 796 F.3D 1312 (FED. CIR. 2015)**

Ethicon sued Covidien for alleged infringement of several design and utility patents related to surgical devices.¹⁰¹ The design patents asserted were: US Patent Nos. D661,801 (the “ ’801 Patent”), D661,802 (the “ ’802 Patent”), D661,803 (the “ ’803 Patent”) and D661,804 (the “ ’804 Patent”) (collectively, the “Design Patents”).¹⁰² The district court granted summary judgment for Covidien that the design patents were invalid for lack of ornamentality (the patents were functional) and not infringed. The Federal Circuit reversed the invalidity holding but upheld the grant of no infringement.¹⁰³

A figure from the ’804 Patent is shown below.

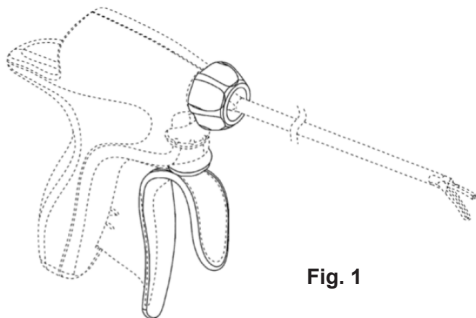


Fig. 1

¹⁰¹ *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1314 (Fed. Cir. 2015).

¹⁰² *Id.*

¹⁰³ *Id.*

This opinion highlights the analysis for ornamentality versus functionality in design patent claim construction and the role that alternative designs play in that analysis. The Federal Circuit also clarifies the *Egyptian Goddess* rule regarding comparison to the prior art in this opinion. In reviewing the district court’s grant of invalidity, the Federal Circuit reiterated that design patents cover ornamental designs and cannot be functional in nature.¹⁰⁴ A claimed design is not functional because the “primary features” of the claimed design can perform a function and the design cannot be assessed at “too a high level of abstraction.”¹⁰⁵ The Federal Circuit provided a comparison between *Hupp*, where the function of a concrete mold was separated from the particular pattern produced by the mold itself (i.e., the ornamental design), and *Best Lock*, where a design of a key blade was held invalid as functional since the key blade design is dictated by functional considerations.¹⁰⁶ The court noted that there is no definitive test for functionality of designs, however the availability of alternative designs is a factor in determining functionality of a claimed design.¹⁰⁷ For example, if there are alternative designs that achieve the same function for the same article to which it is a design, then a design is likely ornamental.¹⁰⁸

The Federal Circuit noted that the district court appeared to discount the alternative designs in its determination that the Design Patents were “primarily functional.”¹⁰⁹ The district court applied factors from *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997):¹¹⁰

Other appropriate considerations might include: whether the protected design represents the best design; whether alternative designs would adversely affect the utility of the specified article; whether there are any concomitant utility patents; whether the advertising touts particular features of the design as having specific utility; and whether there are any elements in the design or an overall appearance clearly not dictated by function.

¹⁰⁴ *Id.* at 1328.

¹⁰⁵ *Id.* at 1329 (citations omitted).

¹⁰⁶ *Id.* at 1328-29 (citing *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456 (Fed. Cir. 1997) and *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563 (Fed. Cir. 1996)).

¹⁰⁷ *Id.* at 1329-1330.

¹⁰⁸ *Id.* at 1330 (citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993); *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002); *Best Lock*, 94 F.3d at 1566; and *Hupp*, 122 F.3d at 1460).

¹⁰⁹ *Id.*

¹¹⁰ *Id.*

The court noted however that these considerations “might” be relevant into the inquiry of functionality and provide useful guidance, but the “inquiry into whether a claimed design is primarily functional should begin with an inquiry into the existence of alternative designs.”¹¹¹

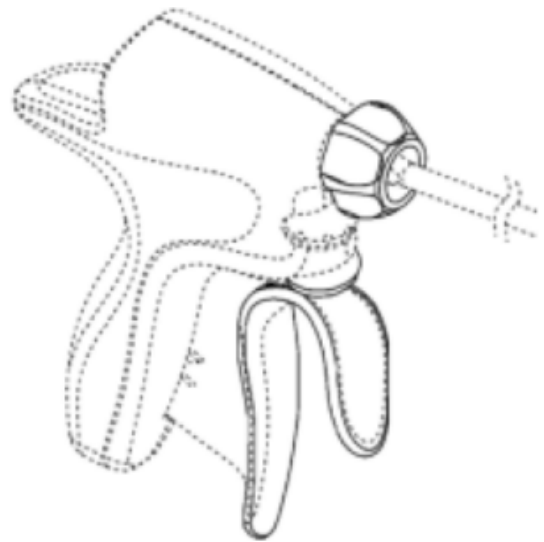
The court noted that Ethicon provided evidence, including expert testimony, of alternative ornamental designs that provide the same or similar functionality of the underlying devices.¹¹² Covidien provided evidence that other designs would work but not as well as the claimed designs; the district court agreed with this evidence.¹¹³ The Federal Circuit held the evidence did not support the finding of invalidity due to functionality for two similar reasons.¹¹⁴ First, whether the alternative designs work as well as the claimed design is a preference (here, for a surgeon) instead of a difference in functionality when the compared designs perform the same function. Second, to be considered an alternative design, the alternative only has to provide “the same or similar functional capabilities.”¹¹⁵

The Federal Circuit then criticized the district court as supporting its conclusions using too high a level of abstraction, “focusing on the general concepts of an open trigger, torque knob, and activation button rather than the ornamental designs adorning those elements.”¹¹⁶

In its review of infringement, the Federal Circuit vacated the district court’s claim construction, which it found held that the Design Patents covered “nothing” (since the Design Patents were deemed functional).¹¹⁷ The Federal Circuit clarified, with regard to claim construction, that the scope of a design claim has to be limited to the ornamental aspects of the design.¹¹⁸ The Federal Circuit offered its own claim construction based on its holding that the Design Patents were not purely functional in nature.¹¹⁹

Interestingly, the district court performed an alternative analysis for infringement based on a construction of the claimed designs that retained certain ornamental aspects.¹²⁰ The district court, after performing a side-by-side analysis between the claimed designs and the

accused products, determined that even if there was ornamental scope to the Design Patents, the accused products were not similar to the claimed designs.¹²¹ The Federal Circuit agreed.¹²²



'804 Patent, Fig. 1



Covidien's Accused Product

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Id.* at 1330-31.

¹¹⁵ *Id.* at 1331 (citations omitted).

¹¹⁶ *Id.* at 1331-32.

¹¹⁷ *Id.* at 1334.

¹¹⁸ *Id.* at 1333-34 (citing *Richardson v. Stanley Works*, 597 F.3d 1288, 1290 (Fed. Cir. 2010) and *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)).

¹¹⁹ *Id.* at 1334.

¹²⁰ *Id.* at 1335.

¹²¹ *Id.*

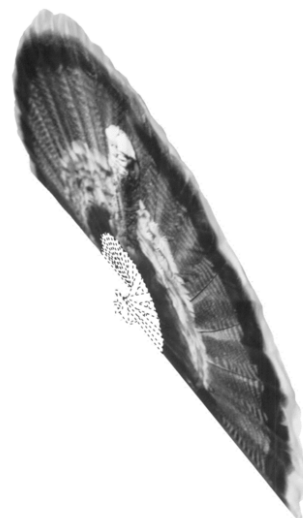
¹²² *Id.* at 1336.

The court also clarified the *Egyptian Goddess* rule regarding comparison to the prior art. Ethicon argued that its claimed designs and the accused products were not plainly dissimilar and that a comparison to the prior art is required.¹²³ The court stated that “comparing the claimed and accused designs with the prior art is beneficial only when the claimed and accused designs are not plainly dissimilar.”¹²⁴ The Federal Circuit noted that “because the district court found the nonfunctional, ornamental aspects of the claimed and accused designs to be plainly dissimilar, it did not need to compare the claimed and accused designs with the prior art, as resolution of the infringement inquiry was already clear.”¹²⁵

The court also clarified the definition of an ordinary observer; an ordinary observer is not an expert but “one of ‘ordinary acuteness’ who is a ‘principal purchaser[]’ of the underlying articles with the claimed design.”¹²⁶ Even though Ethicon argued that a surgeon using the shears is the ordinary observer, the district court found that the ordinary observer was the entity who managed the surgical device purchasing process.¹²⁷ On appeal, the Federal Circuit found that Ethicon did not provide evidence as to how the infringement analysis would differ if a surgeon were the ordinary observer, and then held that it did not need to define the ordinary observer. Thus, while defining “ordinary observer,” here the court did not apply its definition.

HUNTER’S EDGE, LLC V. PRIMOS, INC., 2015 U.S. DIST. LEXIS 131061 (M.D. ALA. SEPT. 8, 2015)

Here, Hunter’s Edge asserted US Design Patent Nos. D560,745 (the “ ’745 Patent”) and D560,746 (the “ ’746 Patent”) against Primos’ turkey hunting decoy products.¹²⁸



'745 Patent, Fig. 1



'746 Patent, Fig. 1



Accused Product

¹²³ *Id.* at 1337.

¹²⁴ *Id.* at 1337 (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008)).

¹²⁵ *Id.*

¹²⁶ *Id.* (citing *Gorham Co. v. White*, 81 U.S. 511, 528 (1872)).

¹²⁷ *Id.*

¹²⁸ *Hunter’s Edge, LLC v. Primos, Inc.*, 2015 U.S. Dist. LEXIS 131061, at *2, *8, *16 (M.D. Ala. Sept. 8, 2015).

The magistrate judge held that the accused products did not infringe and recommended granting of summary judgment for the defendant.

This case illustrates the infringement problem of asserting a two-dimensional design against a three-dimensional article of manufacture. The case also emphasizes the importance of construing claims to focus on the nonfunctional portions of the claimed design, and how designs must be considered as a whole in an infringement analysis.

The defendant moved for summary judgment on three grounds:¹²⁹

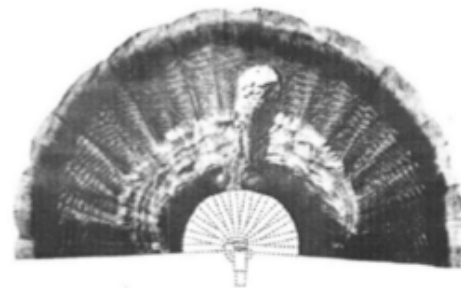
1. [T]he patents are invalid because they **do not include a new, original design**, but only photographic reproductions of actual turkey tail feather fans **already existing in nature** and widely known in the prior art[.]
2. the asserted patents are invalid as a matter of law because they are either anticipated or would have been obvious to one of ordinary skill in designing turkey decoys[.] and
3. Defendant's products do not infringe Plaintiff's design patents because Defendant's products 'are lifelike full sized, **three-dimensional turkey decoys**' which no ordinary observer would purchase thinking it to be Plaintiff's patented design.

The court articulated the ordinary observer test and the standards for claim construction, in which it emphasized that it must limit the claim construction "to identify the non-functional aspects of the design shown in the patent."¹³⁰ Stated differently, a "design patent protects only the novel, ornamental features of the patented design."¹³¹ The court adopted defendant's proposed constructions since plaintiff did not object to it and noted that the proposed constructions "are sufficiently simplistic to comport with the Federal Circuit's concern that district courts avoid overly detailed verbal descriptions of claimed designs."¹³² The adopted claim constructions were:

[T]he '746 [P]atent should be construed as designs comprising a **semi-circular shaped**

photographic reproduction of a natural turkey tail feather fan. The '745 [P]atent should be construed as designs comprising a **semi-circular shaped photographic reproduction of a natural turkey tail feather fan and turkey's head.**¹³³

Next, the court applied the ordinary observer test and performed a comparison of the accused products and the claimed designs.¹³⁴ Two exemplary side-by-side comparisons are reproduced below:¹³⁵



'745 Patent, Fig. 2



Primos' Killer B Accused Product



Primos' Dirty B Accused Product

¹²⁹ *Id.* at *3-4.

¹³⁰ *Id.* at *11-14 (internal quotations omitted).

¹³¹ *Id.* at *13-14 (internal quotations omitted).

¹³² *Id.* at *14-15.

¹³³ *Id.* at *14 (emphasis in original).

¹³⁴ *Id.* at *16-18.

¹³⁵ *Id.* at *16 n.5 ("These images are taken from Defendant's Final Non-Infringement, Invalidity, and Unenforceability Contentions, which is included in the record as Exhibit X, appended to the Supplemental Declaration of Will Primos (Doc. 48-2) at pages 3-6 and 7-9.").

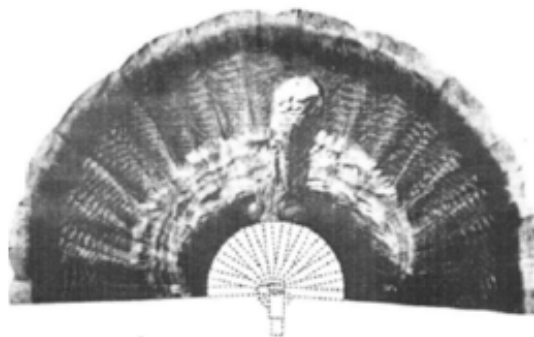
In doing so, the court held:

Upon viewing the pictorial depictions of Plaintiff's claimed designs and Defendant's accused products, the undersigned is of the conviction that no reasonable fact-finder could find that any ordinary observer could be induced to purchase one of the accused products thinking it to be Plaintiff's claimed design. Plaintiff's claimed designs are flat, two-dimensional photographic reproductions of a turkey's tail feather fan both with and without a turkey head superimposed over the fan. Defendant's accused products are lifelike three-dimensional model decoys featuring molded plastic bodies to which a component tail feather fan is attached. Simply put, no ordinary observer — that is, a turkey hunter intending to purchase a turkey decoy — would confuse the accused products with Plaintiff's designs.¹³⁶



Prior Art Real Live Turkey Design - NWTF

Plaintiff argued that no turkey hunter would purchase one of Primos' decoy products without the component fan. The court noted though that the designs must be considered "as a whole."¹³⁷ The court noted that under such an analysis, the designs were "markedly dissimilar" and recommended granting of summary judgment for the defendant and dismissing the case.¹³⁸



'745 Patent, Fig. 2

Defendant Primos used a real turkey as part of its invalidity contentions.¹³⁹ And while the court did not reach a decision on the validity of the asserted design patents, the court's claim constructions implicate that the design patents are merely reproductions of naturally occurring designs. This leaves open the question of whether design patents can be invalidated by designs found in nature.

¹³⁶ *Id.*

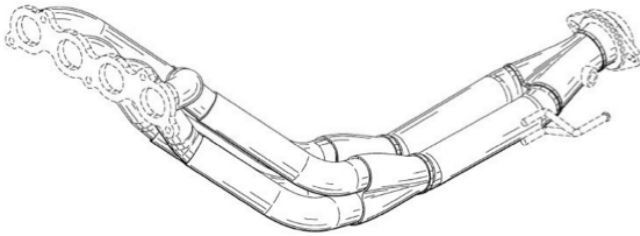
¹³⁷ *Id.* at *19 (citing *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)).

¹³⁸ *Id.* at *20.

¹³⁹ Defendant's Final Non-Infringement, Invalidity, and Unenforceability Contentions, Exhibit X, appended to the Supp. Decl. of Will Primos (Doc. 48-2) at pp. 10-16.

**GROUP-A AUTOSPORTS, INC. V. DNA MOTOR INC.,
EDCV 14-01834-JGB (C.D. CAL. 2015)**

Group-A Autosports, Inc. v. DNA Motor Inc., illustrates another application of the functionality test to a design patent, in the context of claim construction. Here, Group-A Autosports claimed DNA Motor was infringing US Patent No. D636,316 (the “ ’316 Patent”).¹⁴⁰ The asserted patent covers the design for an exhaust header.



'316 Patent, Fig. 1

Following a *Markman* hearing, the court construed the claim of the '316 Patent as covering “the overall ornamental appearance of the exhaust manifold shown in FIGS. 1-7 of the '316 Patent.”¹⁴¹ The court provided an overview of the standard for a design patent’s qualifying for protection with emphasis on the standards for functional portions of the design. The court cited to *Bonito Boats* for the proposition that designs must have an “aesthetically pleasing appearance that is not dictated

by function alone.”¹⁴² The court noted that defendant had only a single citation to case law dealing with invalidation of a design patent on functional grounds and that defendant failed to acknowledge the relevance of alternative possible designs, despite presenting two functional considerations for exhaust manifolds that it alleged drove the design of the manifold. Based on both parties’ acknowledgment of the functional aspects of exhaust manifolds and information provided by plaintiff’s declarant on exhaust manifold design, the court concluded that “because aesthetics is a basis for choosing which functional aspects of an exhaust header to optimize, the ultimate design of the exhaust header is not ‘dictated by’ functional considerations.” The court relied upon plaintiff’s declarant again when it noted that many design choices are not dictated by functional considerations. Finally, the court noted that plaintiff produced exhaust manifold designs from competitors that are aesthetically different from the claimed design to support the determination that other designs, which are ornamental, can produce similar functional capabilities.¹⁴³ The court held that defendant failed to establish that the design was primarily functional and thus found the patent not invalid.¹⁴⁴

¹⁴⁰ Complaint, *Group-A Autosports, Inc v. DNA Motor Inc.*, No. 5:14-cv-01834-JBB-SP (C.D. Cal. July 15, 2015).

¹⁴¹ Minutes of Claim Construction Hearing/Order Construing Patent Claim of U.S. Design Patent No. D636,316, *Group-A Autosports, Inc v. DNA Motor Inc.*, No. 5:14-cv-01834-JBB-SP (C.D. Cal. Aug. 6, 2015).

¹⁴² *Id.* (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989)).

¹⁴³ *Id.* (citing *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378-79 (Fed. Cir. 2012)).

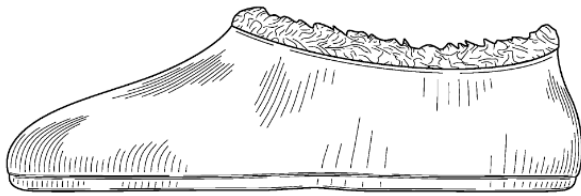
¹⁴⁴ *Id.* (citing *High Point Design LLC v. Buyer’s Direct, Inc.*, 730 F.3d 1301, 1315 (Fed. Cir. 2013)).

INVALIDITY AND CLAIM CONSTRUCTION

In 2015, design patent case law reiterated the proper analysis for invalidity and infringement of design patents. The “ordinary designer” standard should be used to determine invalidity by obviousness instead of the “ordinary observer” standard used in the anticipation invalidity analysis of design patents.

HIGH POINT DESIGN LLC V. BUYER’S DIRECT, INC., 2015 U.S. APP. LEXIS 13621 (FED. CIR. JULY 30, 2015)

The design patent at issue is US Patent No. D598,183 (the “’183 Patent”), which claims a design for a slipper.¹⁴⁵ High Point’s Fuzzy Babba slippers were accused of infringement.¹⁴⁶ Exemplary figures from the ’183 Patent and of the accused product are shown below.



’183 Patent, Fig. 4



Accused Product

This is the second Federal Circuit opinion in this case. In the first opinion, *High Point Design LLC v. Buyer’s Direct, Inc.*, 730 F.3d 1301 (Fed. Cir. Sept. 11, 2013), the court reversed the district court’s holding finding the claimed design obvious, noting that the district court applied the incorrect legal standard for obviousness.¹⁴⁷

¹⁴⁵ *Id.* at *3.

¹⁴⁶ *Id.*

¹⁴⁷ *High Point Design LLC v. Buyer’s Direct, Inc.*, 2015 U.S. App. LEXIS 13621, at *1-2 (Fed. Cir. July 30, 2015).

The obviousness analysis was flawed because an “ordinary observer” standard was used, instead of the required “ordinary designer” test for design patent obviousness.¹⁴⁸ Additionally, the district court used a verbal description of the patent at a “too high a level of abstraction” and did not focus on the “distinctive visual design” of the patent; furthermore, the district court failed to explain how the prior art created “basically the same visual impression as the claimed design.”¹⁴⁹

This opinion, although nonprecedential, highlights the proper analysis for both infringement and invalidity for design patents. The focus on the correct standard for design patent obviousness illustrates a critical distinction between design patent anticipation and obviousness by noting the difference in the ordinary observer test and the ordinary designer test. Additionally, the opinion provides helpful guidance on claim construction and what level of detail is required. A claimed design cannot be reduced to general abstractions, but instead the various features of the design must be recognized and used in the analysis.

On remand, the district court again held that the patent was invalid, but this time found that the same prior art anticipated the design. The district court also found that the patent was not infringed, and found other issues not discussed here.¹⁵⁰

This year, the Federal Circuit reversed the district court’s invalidity holding and affirmed the noninfringement holding.¹⁵¹ The Federal Circuit determined that the district court applied an incorrect invalidity analysis by again analyzing the designs from “too high a level of abstraction” and failing to focus on “the distinctive visual appearances” of both the prior art and the claimed design.¹⁵² The court pointed out differences such as the curvature of the slipper from the slide, the degree that the fuzz protruded and the sole design.¹⁵³ The district court focused only on the basic appearance of the slipper, which was that of a structured slipper having fuzzy material at the foot opening.¹⁵⁴ The Federal Circuit noted that “[a]s we stated in *Contessa Food Prods., Inc. v. Conagra, Inc.*, ‘[o]ur precedent makes clear that all of the ornamental features illustrated in the

¹⁴⁸ *Id.* at *5-6.

¹⁴⁹ *Id.* at *6.

¹⁵⁰ *Id.* at *2, *7.

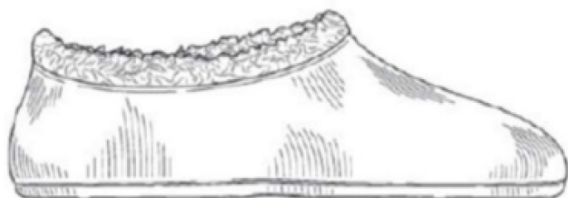
¹⁵¹ *Id.* at *2.

¹⁵² *Id.* at *11.

¹⁵³ *Id.* at *12.

¹⁵⁴ *Id.* at *11.

figures must be considered in evaluating design patent infringement.’¹⁵⁵ The Federal Circuit reversed the anticipation determination based on the district court’s failing to apply a proper analysis of the prior art reference, holding that the evidence was not clear and convincing to find anticipation.¹⁵⁶



'183 Patent, Fig. 5



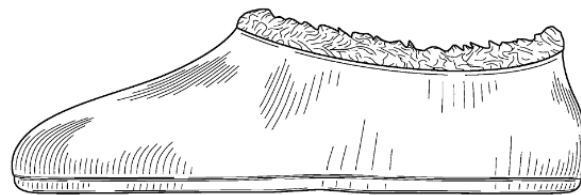
Laurel Hill Prior Art



Penta Prior Art

Regarding infringement, the Federal Circuit held that the district court correctly performed a proper side-by-side comparison of the accused product and the patented design.¹⁵⁷ It further held the district court correctly opted not to perform a comparison with the prior art under

the *Egyptian Goddess* standard.¹⁵⁸ Specifically, the court held that the accused product and the patented design “bring to mind different impressions.”¹⁵⁹ A direct comparison is below:



'183 Patent, Fig. 4



Accused Product

Buyer’s Direct (“BDI”) argued that the district court erred by not performing a comparison of the accused slipper to BDI’s alleged commercial embodiment, the Snoozie.¹⁶⁰ The Federal Circuit noted that “[w]e have long-cautioned that it is generally improper to determine infringement by comparing an accused product with the patentee’s purported commercial embodiment.”¹⁶¹ The court did, however, note that such a comparison is permissible, but not mandated, if “a patentee is able to show that there is no substantial difference between the claimed design and the purported commercial embodiment.”¹⁶²

Finally, BDI argued that the district court erred by failing to take into account how the accused products appeared when worn.¹⁶³ The Federal Circuit noted that even when the slippers were worn, differences still existed between the product and claimed design.¹⁶⁴

¹⁵⁵ *Id.* at *12 (citing 282 F.3d 1370, 1378 (Fed. Cir. 2002)).

¹⁵⁶ *Id.* at *14-15.

¹⁵⁷ *Id.* at *15.

¹⁵⁸ *Id.* at *15-16.

¹⁵⁹ *Id.* at *16.

¹⁶⁰ *Id.* at *17.

¹⁶¹ *Id.* at *17-18 (citing *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1196 (Fed. Cir. 1995)).

¹⁶² *Id.* at *18 (citing *L. A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125-26 (Fed. Cir. 1993); *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988)).

¹⁶³ *Id.*

¹⁶⁴ *Id.* at *19.

DESIGN PATENT INFRINGEMENT

This year, the case law provided us with a clear example of how the ordinary observer test can be used to prove noninfringement of accused products.

REDDY V. LOWE'S COMPANIES, INC., 13-CV-13016-IT (D. MASS. SEPT. 24, 2015)¹⁶⁵

Reddy sued Lowe's and Evolution Lighting for design patent infringement, accusing three products of infringing US Pat. No. D677,423 (the "'423 Patent").¹⁶⁶ The '423 Patent covers an ornamental design for a bathroom vanity light shade.¹⁶⁷ The accused products were vanity light refresh covers.¹⁶⁸ Figures 1, 2, 3 and 5 of the '423 Patent are reproduced to the right.

The court construed the claim to be "[t]he ornamental design for a bathroom vanity light shade, as shown and described in Figures 1-5."¹⁶⁹ Following discovery, the court granted Defendants' Motion for Summary Judgment of Non-Infringement.¹⁷⁰ The '423 Patent drawings have certain shadings on them that confines the bottom portion to being translucent or transparent and the sides to being opaque, which were noted in the court's description of the '423 Patent.¹⁷¹ These characteristics were determined based on the shading in the drawings that was added during prosecution (i.e., oblique line shading on the bottom portion and vertical line shading on the side portions) and certain admissions made by the patent owner.¹⁷²

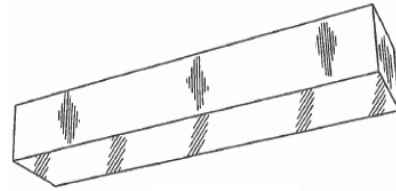


Fig. 1

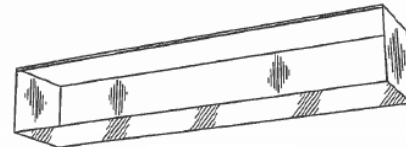


Fig. 2

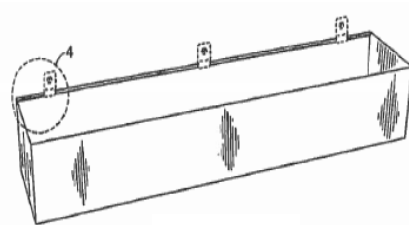


Fig. 3

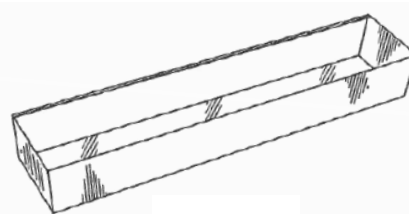


Fig. 5

¹⁶⁵ Hunton & Williams LLP represents Lowe's in this ongoing case as well as the related IPR, *Lowe's Home Centers LLC v. Maureen Reddy*, No. IPR-2015-00306 (Paper No. 7).

¹⁶⁶ Complaint, *Reddy v. Lowe's Companies, Inc.*, 1:13-cv-13016-IT, ECF No. 1 (D. Mass., Nov. 25, 2013) at ¶ 28.

¹⁶⁷ *Id.* at ¶¶ 9-10.

¹⁶⁸ *Id.* at ¶ 28.

¹⁶⁹ *Markman* Mem., *Reddy v. Lowe's Companies, Inc.*, 1:13-cv-13016-IT, ECF No. 125 (D. Mass., Nov. 18, 2014), at 24-25.

¹⁷⁰ Memorandum and Order, *Reddy v. Lowe's Companies, Inc.*, 1:13-cv-13016-IT, ECF No. 149 (D. Mass., Sept. 24, 2015) at 12.

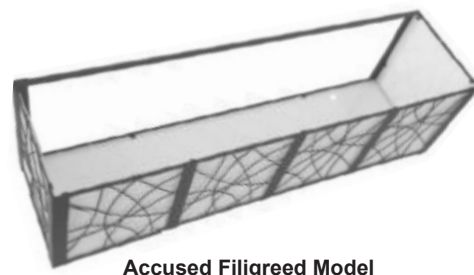
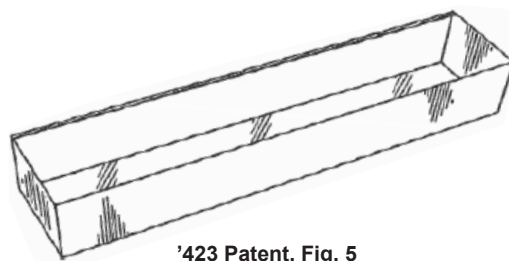
¹⁷¹ *Id.* at 3.

¹⁷² Defendant Lowe's Companies, Inc. Mem. in Support of Its Mot. for Summ. J. of Non-Infringement, *Reddy v. Lowe's Companies, Inc.*, 1:13-cv-13016-IT, ECF No. 102 (D. Mass., Oct. 22, 2014) at 12.

In its analysis, the court first excluded certain portions of the accused products as being functional rather than being ornamental, and then applied the ordinary observer test and compared the various features of each of the three accused products to the claimed design.¹⁷³ The court found the accused products and the claimed design dissimilar.¹⁷⁴ A comparison of the accused products and the '423 Patent's claimed design is to the right.

This case is instructive for a number of points regarding design patents. Particularly, the case illustrates that shading in design patents has particular meaning that impacts the scope of the claimed design. It also illustrates an application of the ordinary observer test in the noninfringement context.

There is also a co-pending *inter partes* review to determine validity of the '423 Patent, which was instituted by the PTAB on April 28, 2015.¹⁷⁵ A hearing was held on December 11, 2015, the decision of which is pending.



¹⁷³ Mem. and Order, *Reddy v. Lowe's Companies, Inc.*, 1:13-cv-13016-IT, ECF No. 149 (D. Mass., Sept. 24, 2015) at 6-11.

¹⁷⁴ *Id.* at 12.

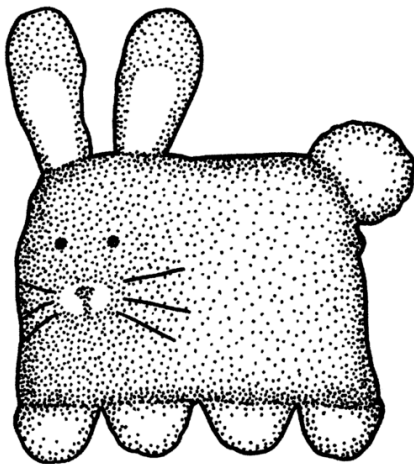
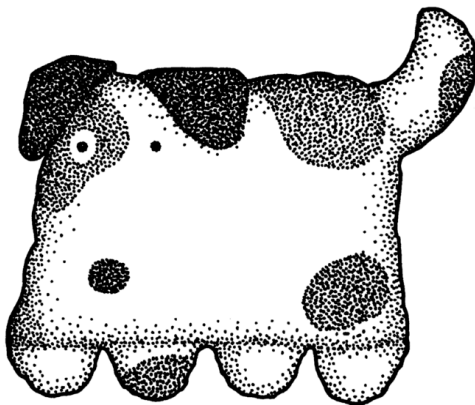
¹⁷⁵ *Lowe's Home Centers LLC v. Maureen Reddy*, No. IPR2015-00306 (Paper No. 7).

INFRINGEMENT LIABILITY

A new issue presented itself this year: whether a party can be liable for infringement because of the sale of an accused product by a third-party seller. Additionally, the facts relied upon to deny summary judgment at this time in the case below present a contrast to *Reddy*, where a similar absence of disputed facts did not deter the judge from finding summary judgment of noninfringement.

MILO & GABBY, LLC V. AMAZON.COM, INC., 2015 U.S. DIST. LEXIS 92890
(W.D. WASH. JULY 16, 2015)

In this case, plaintiffs Milo & Gaby, LLC, and Karen Keller, an individual, alleged, among other things, infringement of five design patents (US Patent Nos. D520798, D521299, D521792, D523677 and D551889) by defendant Amazon.com, Inc. The design patents claim designs for animal-shaped pillowcases. Figure 1 from each of the '798 and '199 Patents are reproduced below.



Early on in the case, allegations of induced, contributory and willful infringement were all dismissed through 12(b) (6) motion, leaving the only remaining claim that of direct infringement.¹⁷⁶ More recently, the court denied in part Amazon's motion for summary judgment of noninfringement of plaintiffs' design patents.¹⁷⁷

Interestingly, the direct infringement allegation was directed to Amazon's actions as an Internet retail service website for enabling third-party vendors to sell and distribute products to the public while Amazon fulfills the orders through its website.¹⁷⁸ Amazon itself is not the seller of record for any of the allegedly infringing pillowcases.¹⁷⁹ The content and images posted on its website were all provided by the third-party vendors.¹⁸⁰

In defendant Amazon's motion for summary judgment of no infringement, Amazon argued there is no evidence that Amazon has ever "sold" or "offered to sell" any such products within the meaning of 35 U.S.C. § 271.¹⁸¹ Plaintiffs opposed and argued that Amazon did indeed offer to sell the allegedly infringing products within the meaning of the statute. Plaintiffs filed no separate statement of facts in support of its opposition to defendant's motion for summary judgment.¹⁸² Even with no opposing statement of facts, the court found that questions of fact exist sufficient to deny summary judgment of no infringement.¹⁸³ The court agreed with plaintiffs regarding the definition of "offer to sell," and

¹⁷⁶ See *Milo & Gabby, LLC v. Amazon.com, Inc.*, No. C13-1932RSM, Order Granting Defendant's Mot. to Dismiss for Failure to State a Claim In Part (DI 13) (W.D. Wash., April 11, 2014).

¹⁷⁷ See *Milo & Gabby, LLC v. Amazon.com, Inc.*, No. C13-1932RSM, 2015 U.S. Dist. LEXIS 92890, at *37 (W.D. Wash., July 16, 2015). This case also involves allegations of copyright infringement, false designation of origin under the Lanham Act and violation of the Digital Millennium Copyright Act, but only the design patent infringement allegations are addressed here.

¹⁷⁸ *Id.*, 2015 U.S. Dist. LEXIS 92890, at *4.

¹⁷⁹ *Id.*, 2015 U.S. Dist. LEXIS 92890, at *6.

¹⁸⁰ *Id.*

¹⁸¹ *Id.*, 2015 U.S. Dist. LEXIS 92890, at *33.

¹⁸² *Id.*, 2015 U.S. Dist. LEXIS 92890, at *2, n.1.

¹⁸³ *Id.*, 2015 U.S. Dist. LEXIS 92890, at *34-35.

The screenshot shows the Amazon.com website interface. At the top, there is the Amazon Prime logo and navigation links for 'Steve's Amazon.com', 'Today's Deals', 'Gift Cards', 'Sell', and 'Help'. Below this is a search bar with 'Home & Kitchen' selected. A yellow banner at the top right says 'Instant Order Update for Steve Keller. You purchased this item on August 5, 2013. View this order.' The breadcrumb trail reads 'Home & Kitchen > Bedding > Sheets & Pillowcases > Pillowcases'. The main product title is 'Pillowcase for child toddler Cute Animal Pink Rabbit Design' by 'Cute Pillowcase'. The price is '\$26.70' with a Prime logo. It is marked 'In Stock' and 'Sold by FAC System LLC and Fulfilled by Amazon'. A list of bullet points describes the product: 'Made of 100% soft cotton fabric, 250 thread count', 'Size of 20.47*25.59inch (or 52*65cm)', 'Weight of about 300gm', 'Pillowcase is machine washable and should put in a net before washing', and 'Care Instructions: Wash on cold; dry on low or medium'. On the right side, there are social sharing icons, a quantity selector set to '1', an 'Add to Cart' button, and a 'More Buying Choices' section with a 'Sell on Amazon' link. At the bottom, there is a 'College Living' banner for dorm and apartment essentials.

Complaint, Ex. C, p. 2 of 6

relied on Exhibit B to the complaint (see below) as support that Amazon might be offering the alleged infringing product for sale.¹⁸⁴ In particular, the court relied on the facts that the item was displayed on the Amazon.com website, and can be purchased through the Amazon.com website, as an offer for sale under earlier case law interpretations of “offer for sale” under 35 U.S.C. 271. The court relied on the website including the price and allowing a buyer to choose a quantity and conclude the purchase as facts that made summary judgment inappropriate.¹⁸⁵

It remains to be seen whether Amazon’s selling of products from third-party providers can be considered direct infringement of a design patent within the meaning of 35 U.S.C. § 271. This decision also presents the interesting scenario of a court finding facts in dispute even when the nonmoving party fails to file a statement of facts in opposition to a moving party’s statement of undisputed facts.¹⁸⁶

¹⁸⁴ *Id.*

¹⁸⁵ *Id.*, 2015 U.S. Dist. LEXIS 92890, at *35.

¹⁸⁶ Unlike other jurisdictions, such as the District of Massachusetts, the Western District of Washington does not require parties to file a separate statement of undisputed, or disputed, material facts. See W.D. Wash., L.R.

CONCLUSION

This past year was notable in the world of design patent law. In May, the United States finally joined the Hague Agreement and the USPTO subsequently began accepting international design applications. This opens up a PCT-like system to US applicants for design patents, which may result in a change in the way design patent applications are drafted, as the international filing requires more consideration to be given to which embodiments are included in the drawings, as well as a greater emphasis on filing strategy (i.e., deciding whether to file a US-only design application or a Hague Application). The Federal Circuit issued a decision affirming the PTAB's final written opinion on the first appeal of a design patent-related *inter partes* review decision. Bigger news for design patents came from the Federal Circuit in decisions regarding design patent damages (the *Apple* and *Nordock* cases). The Federal Circuit also issued the *Ethicon* decision reiterating the test for functionality versus ornamentality in design patents, a key issue in determining the scope of a design patent's claim. Finally, cases at the district court level provided guidance as to how the determination of whether a design is functional or ornamental can affect its claim scope, and thus affect the validity of and whether infringement occurred. Finally, from the *Milo & Gabby* decision, it remains to be seen in future case law whether the offer to sell a product supplied by a third party is sufficient for a finding of direct infringement.



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Mandy Adams is an associate in the Washington office of Hunton & Williams, where she is a member of the Intellectual Property group. Mandy's practice focuses primarily on intellectual property litigation, intellectual property counseling involving a range of technologies, including biomedical, mechanical, electrical, and computer technologies, and has participated in litigating issues involving invalidity and non-infringement of utility and design patents.

Mandy has prior experience as a patent examiner at the US Patent & Trademark Office, where she examined medical device patent applications. Mandy also held an internship at the US International Trade Commission, Office of Unfair Import Investigations, where she conducted patent infringement research and wrote motions for investigations involving electronic and mechanical technologies.

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- 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.



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