



PROTECTING DESIGNS

Apple v. Samsung: Apple is denied Preliminary Injunction against the 10.1N in Germany

Following our [prior post regarding Apple's request for preliminary injunction](#), [Reuters reported](#) on December 22, 2011, that Judge Johanna Brueckner-Hofmann stated that, "[a]ccording to the court's assessment, the defendant has moved away sufficiently from the legally protected design." A final verdict is expected in February.

Tags: [Apple](#), [Community Designs](#), [Injunction](#), [Samsung](#)

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PROTECTING DESIGNS

Apple v. Samsung: Apple requests Preliminary Injunction against the 10.1N in Germany

Following our [prior post regarding Samsung's new Galaxy Tab 10.1](#), [Dow Jones Newswires](#) now reports that Apple has requested a preliminary Injunction against Samsung's revised design.

A hearing is reportedly scheduled for December 22, 2011. [FOSS Patents](#) provides some Germany-specific insight on this development, and expects the hearing to not only relate to Apple's community design claims, but also Apple's unfair competition claims.

Tags: [Apple](#), [Community Designs](#), [Samsung](#), [Unfair Competition](#)

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PROTECTING DESIGNS

Apple v. Samsung: "Design Around" in Germany

On November 16, 2011, [FOSS Patents](#) reported on Samsung releasing an updated version of the Samsung Galaxy Tab 10.1 with a revised visual design. This updated version is expected to be available for sale in Germany shortly.

The revised tablet is now called the Galaxy Tab 10.1**N**. Does this **N** refer to **Non**-infringing?

[MOBIFLIP.de](#) posted the image below comparing the 10.N (top) and the 10.1 (bottom).

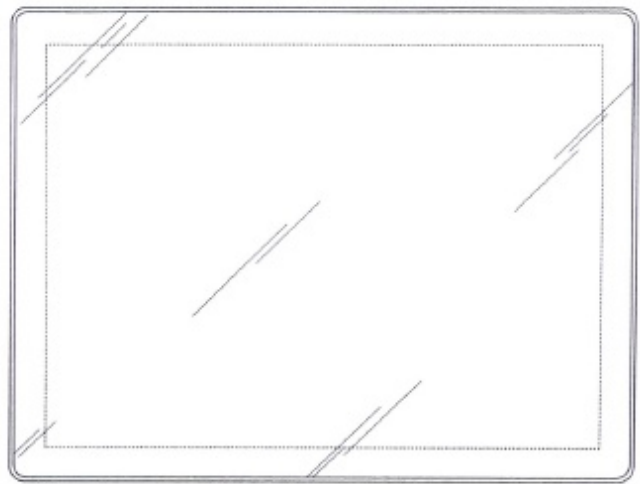
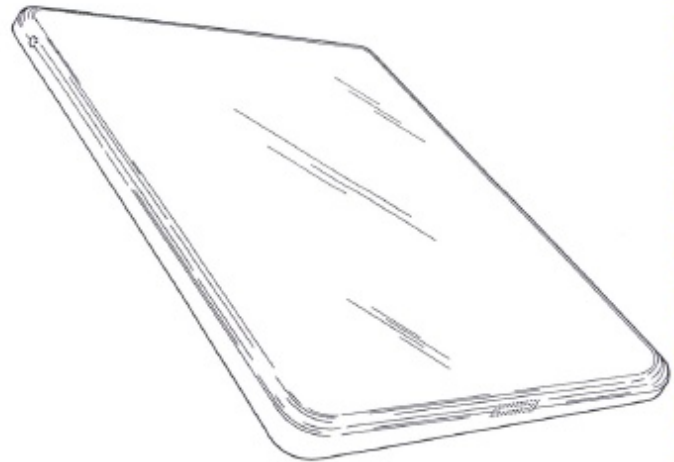
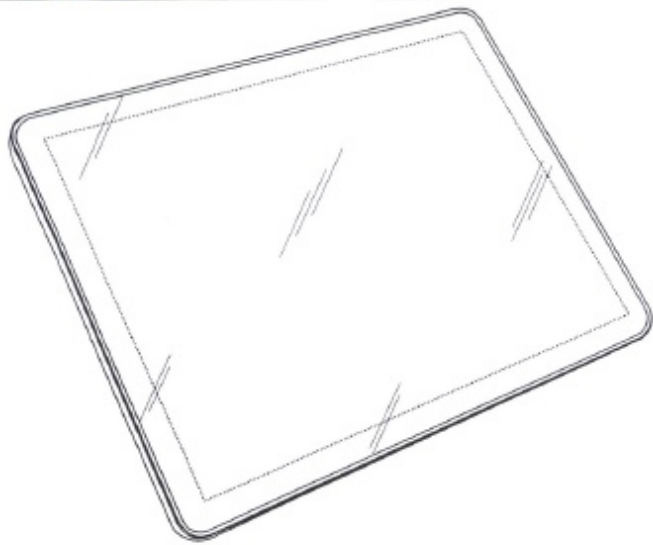


Most notable in the above images, the bezel on the N is more pronounced. The bezel on the N has relatively large left and right sides. Further, as more clearly shown in the image below reproduced from [Engadget](#), speaker ports are provided on the left and right sides of the bezel.



Will these changes be enough to overcome Apple's [European Community Design No. 000181607-0001](#)?

Representative images from the Community Design are provided below. The Community Design relates to [U.S. D504,899](#), and shows a bezel which appears to be narrower than that of the 10.1N, at least along the sides. Additionally, there does not appear to be any speaker ports provided in the side bezel.



Tags: Apple, Community Designs, Design Patents, Samsung

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PROTECTING DESIGNS

Crocs, Inc. files complaint against Walgreen Co. alleging footwear design infringement

Crocs, Inc. filed a **complaint** against Walgreen Co. in the U.S. District Court for the District of Colorado on November 11, 2011. The complaint alleges that Walgreen “manufactures, uses, offers for sale, sells, and/or imports molded footwear throughout the United States” that infringe a design patent (U.S. Patent No. **D610,784**, hereinafter “the ‘784 patent”) and a utility patent (U.S. Patent No. **6,993,858 B2**) assigned to Crocs. In particular, the complaint alleges that the “Caribbean Cartel” footwear sold by Walgreen are “obvious imitations of well-known and successful Crocs styles.” Although the specific designs of the alleged infringing footwear are unknown, images of Caribbean Cartel The Lost Pirates footwear, taken from eBay.com (last visited Nov. 16, 2011), are shown below. Figure 1 from U.S. D610,784 is shown to the right.



Crocs’ most recent complaint, against Walgreen, follows successful enforcement of similar design patents against other defendants, as we previously discussed **here** and **here**. Additionally, the ITC blog **has discussed** Crocs’ proceedings before the International Trade Commission.

Tags: [Design Patents](#), [Fashion Designs](#), [Patent Infringement](#)

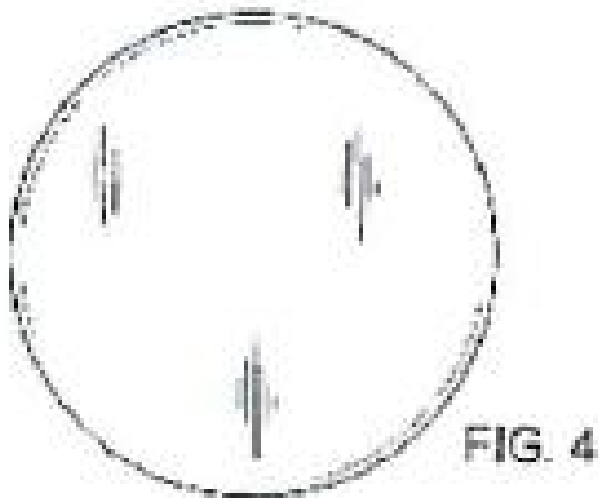
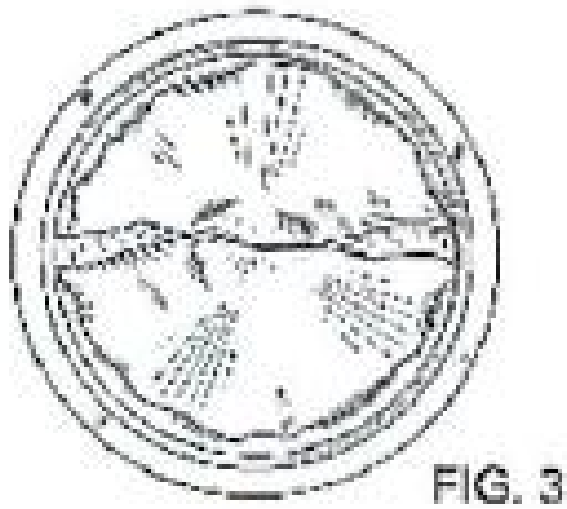
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PROTECTING DESIGNS

Keurig Sues Rogers Family Co. Over Single-Serve Coffee Container Design

Keurig has filed suit against Rogers Family Co. (“Rogers”) in the U.S. District Court for the District of Massachusetts alleging that beverage containers sold by Rogers infringe one design patent and two utility patents. The complaint states that the beverage containers sold by Rogers, such as its “OneCups,” are for use with Keurig’s single-serve brewers. The design patent in suit is U.S. Patent No. D502,362.



A copy of Fig. 1 from the '362 patent and a picture of the OneCup from Rogers's website, which was accessed via a hyperlink in the complaint, are reproduced above.

Design Patents, Patent Infringement

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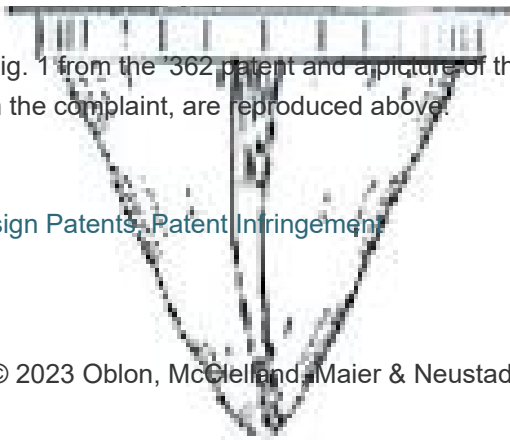


FIG. 8

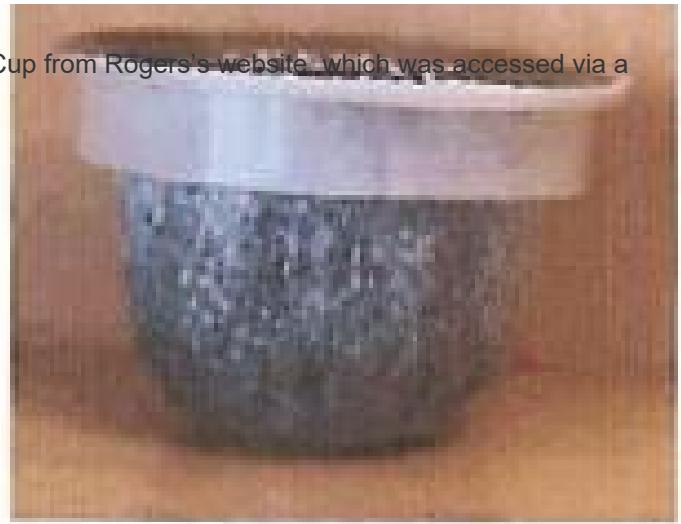


Fig. 5 - '362 patent drawings (left) and JBR cartridge (right)



PROTECTING DESIGNS

Apple v. Samsung: Update October 17, 2011

As reported by [Reuters](#), U.S. District Judge Lucy Koh has commented on the case in a court hearing on Thursday, October 13, 2011, but has not yet ruled on a pending motion for a preliminary injunction to bar some of the Samsung Galaxy products from being sold in the U.S.

Reportedly, Judge Koh frequently remarked on similarities between the Samsung Galaxy Tab 10.1 and the Apple iPad, and even questioned Samsung's attorneys as whether they could identify Samsung's tablet between the two.

Nonetheless, Judge Koh indicated the utility patent asserted by Apple would not be sufficient to support an injunction, and has not yet determined whether any of the design patents asserted by Apple would be sufficient to support an injunction. However, Judge Koh indicated a formal order would follow promptly.

Tags: [Apple](#), [Design Patents](#), [Patent Infringement](#), [Samsung](#)

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PROTECTING DESIGNS

Apple v. Samsung: Preliminary Injunction in Germany; Updated September 9, 2011

Following up on our coverage of the Apple/Samsung dispute in Germany, [FOSS Patents](#) has reported that the Regional Court of Dusseldorf (Germany) has once again upheld the preliminary injunction against Samsung's Galaxy Tab devices based on a Community Design. Although the decision can be appealed, the preliminary injunction may hold until full proceedings are conducted, which FOSS Patents indicates could take up to a year to conclude.

Tags: [Apple](#), [Community Designs](#), [Injunction](#), [Samsung](#)

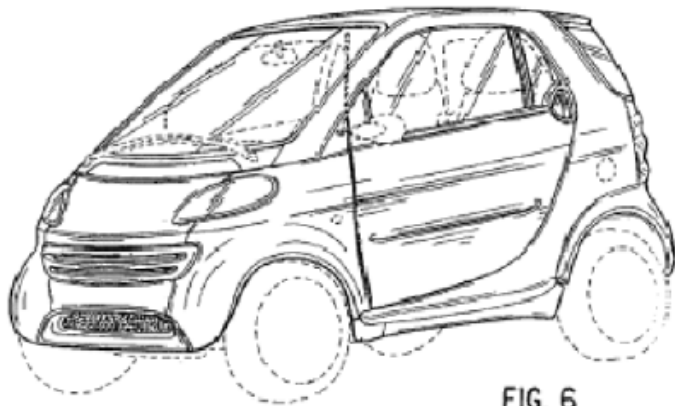
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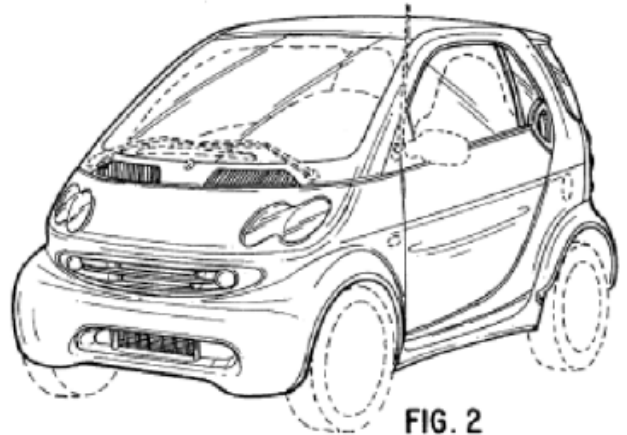
PROTECTING DESIGNS

Daimler Sues Over Alleged smart fortwo Knockoffs

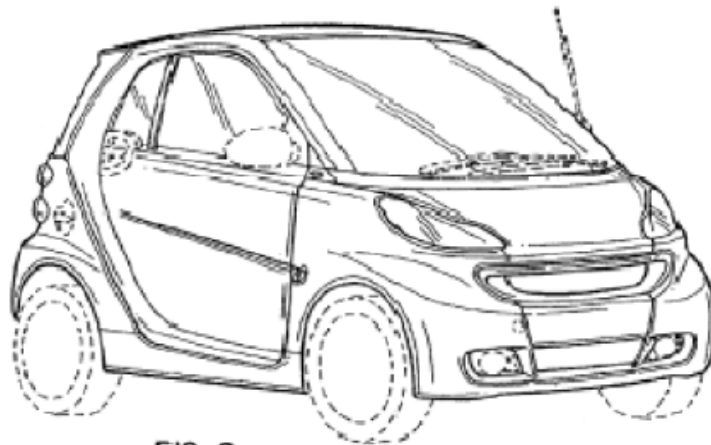
Daimler AG filed a Complaint in the Eastern District of Michigan against Shuanghuan Automobile Company, Shuanghuan Auto USA, and Wheego Electric Cars, Inc. for trademark and trade dress infringement, trademark counterfeiting, trademark dilution, and patent infringement related to Daimler's smart fortwo cars. The design patents at issue are U.S. Patent Number D389,783, U.S. Patent Number D477,250, and U.S. Patent Number D549,134.



D389,783



D477,250



D549,134

Daimler's smart fortwo	Defendant Wheego's Infringing Car
	
	

Daimler's smart fortwo	Shuanghuan Defendants' Infringing Cars
	<p data-bbox="1008 200 1268 251">➔ Noble G4</p> 
	<p data-bbox="1008 668 1268 719">➔ Noble LC</p> 

Tags: Complaint, Design Patents, Patent Infringement

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PROTECTING DESIGNS

Apple v. Samsung: Update August 26, 2011

Since [our last update](#), Apple has succeeded in obtaining a trial date of July 30, 2012, in the Northern District of California (this relates to Apple's U.S. federal claim against Samsung).

Also, a [Dutch court ordered an injunction](#) against Samsung's Galaxy smartphones (but not the tablet) based on a software-related patent. Samsung stated it would modify the software in its phones to work around the patent.

Lastly, Florian Mueller at FOSS Patents has translated [the official court statement](#) from the Regional Court of Dusseldorf (Germany) which granted Apple a preliminary injunction on August 9, 2011. As we [previously posted](#), the Regional Court of Dusseldorf scheduled a hearing for August 25, 2011. In summary, the injunction remains effective at least until a ruling scheduled for September 9, 2011.

Returning back to the design aspects at issue, Samsung has raised an interesting argument against Apple's asserted design patent. Samsung argues that "tablets" used in Stanley Kubrick's 2001: A Space Odyssey (1968) are prior art against Apple. Florian Mueller [posted](#) on this on August 23, 2011.



[Exemplary image from 2001: A Space Odyssey; Also see the corresponding [YouTube clip](#)]

Samsung argues the devices shown on the table above have "an overall rectangular shape with a dominant display screen, narrow borders, a predominately flat front surface, a flat back surface (which is evident because the tablets are lying flat on the table's surface), and a thin form factor." Samsung may be taking a bit of liberty here - this movie dates back to 1968, which means the devices are probably nothing more than a shell to look like a slim device, with CRT televisions below the table. On the other hand, the devices may have images projected thereon. Either way, it should be appreciated that the devices are not tablet-functional devices as we are accustomed to, but rather movie props.

However, while this distinction may be important when considering the teachings of a utility patent, Samsung's arguments are specifically directed to a design patent.

"The scope of the relevant prior art for purposes of evaluating obviousness under [35 U.S.C. 103\(a\)](#) extends to all "analogous arts." While the determination of whether arts are analogous is basically the same for both design and utility inventions (see [MPEP § 904.01\(c\)](#) and [§ 2141.01\(a\)](#)), *In re Glavas*, 230 F.2d 447, 450 109 USPQ 50, 52 (CCPA 1956) provides specific guidance for evaluating analogous arts in the design context, which should be used to supplement the general requirements for analogous art as follows:

The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.

...

Therefore, where the differences between the claimed design and the prior art are limited to the application of ornamentation to the surface of an article, any prior art reference which discloses substantially the same surface ornamentation would be considered analogous art. Where the differences are in the shape or form of the article, the nature of the articles involved must also be considered." [MPEP 1504.03.I.A]

Additionally, in determining whether a design is obvious (i.e. not patentable), "the proper standard is whether the design would have been obvious to a designer of ordinary skill with the claimed type of article. ... As a whole, a design must be compared with something in existence, and not something brought into existence by selecting and combining features from prior art references." [MPEP 1504.03]

Does a movie prop, which is arguably non-functional, constitute something in existence?

A design patent only protects the appearance of an article - not its structural or utilitarian features. Accordingly, it may be irrelevant that the tablets shown in *2001: A Space Odyssey* are arguably non-functional. If the court agrees with Samsung that these tablets constitute a prior art design, then it will be interesting to see whether designs from [other science fiction works](#) appear in the litigation.

Tags: [Apple](#), [Design Patents](#), [Patent Infringement](#), [Samsung](#)

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PROTECTING DESIGNS

Apple v. Samsung: Preliminary Injunction in Germany; Updated

The Regional Court of Dusseldorf (Germany) granted Apple a preliminary injunction on August 9, 2011, as reported in [FOSS Patents](#) and [The Telegraph](#). The injunction is effective for all of Europe except for the Netherlands.

In response, Kim Titus, a spokesman for Samsung, was reported in the [Washington Post](#) as stating the preliminary injunction was issued “without any hearing or presentation of evidence from Samsung.”

[Update] The response from Kim Titus may be misleading. According to [FOSS Patents](#), court documents reveal Samsung apparently unsuccessfully pleaded against the preliminary injunction.

As reported by [The Wall Street Journal](#) on August 16, 2011, the Regional Court of Dusseldorf has partly lifted the preliminary injunction, with a court spokesman stating it was disputable whether it is possible for a German court to ban a company headquartered in South Korea from selling goods outside of Germany. A hearing has also been scheduled for August 25 to hear an appeal from Samsung concerning the preliminary injunction.

One issue expected to be discussed or addressed at the August 25 hearing is the proportions of the pictures of the Galaxy Tab in Apple's complaint appear to have been altered. This issue was noted by [Webwereld.nl](#).

At issue, page 28 of Apple's complaint includes the following picture:



Reproduced below is the Galaxy Tab image from page 28 of the complaint shown together with an image of the U.S. version of the Galaxy Tab. These images have been adjusted to display a common device width.

It appears the image of the Galaxy Tab from page 28 of the complaint has been "shrunk" to have the same height of Apple's iPad2, but the effect altered the aspect ratio of the Galaxy Tab. It is unclear whether this apparent inaccuracy in the complaint affected the Court's judgment.

[Update] As reported by [PC Pro](#), the Judge for the Regional Court of Dusseldorf had a visual inspection of the devices at issue. As a result, it does not appear the apparently misleading images from the complaint misled the Judge.

Tags: Apple, Injunction, Samsung

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PROTECTING DESIGNS

Apple v. Samsung: Showdown at the ITC

As reported in [the ITC Blog](#), on August 2, 2011, the ITC instituted an investigation concerning Samsung's alleged infringement of U.S. Patent Nos. 7,479,949, RE 41,922, 7,863,533, 7,789,697, 7,912,501, D558,757 and D618,678. This investigation is the result of a complaint filed on July 5, 2011, and a supplemental letter filed on July 22, 2011, by Apple.

Figs. 1 and 2 of U.S. D558,757 (left) and D618,678 (right) are reproduced below.

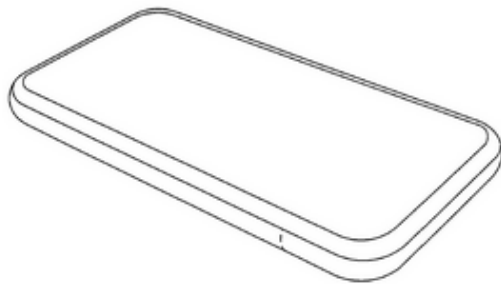


FIG. 1

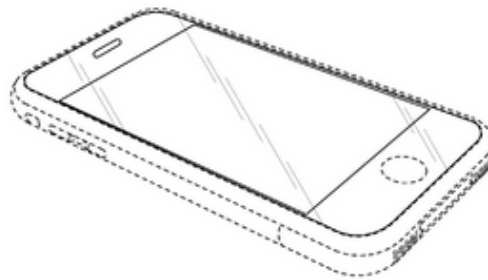


FIG. 1

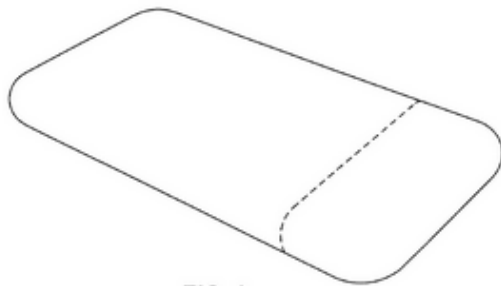


FIG. 2

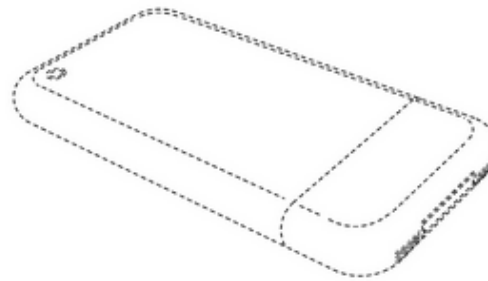


FIG. 2

This follows the ITC instituting an investigation on July 27, 2011, concerning Apple's alleged infringement of U.S. Patent Nos. 7,706,348, 7,486,644, 6,771,980, 6,879,843 and 7,450,114. This investigation is also reported in [the ITC Blog](#), and is the result of a complaint filed on June 27, 2011, and supplemental letters filed on July 7 and 15, 2011, by Samsung.

Tags: [Apple](#), [Design Patents](#), [ITC](#), [Samsung](#)



PROTECTING DESIGNS

Nike Accused of Infringing Golf Club Design Patents

The Irrevocable Trust of Anthony J. Antonious sued Nike for infringement of U.S. Patent Numbers D481,090 and D481,091, issued in October 2003, each covering a "Metalwood type golf club head." The suit, filed in the U.S. District Court of New Jersey, seeks actual damages, treble damages, interest, and attorneys' fees and costs.

The Trust alleges that Nike sold infringing golf clubs under the SQ Sumo and SQ Sasquatch names from 2008-2010.



Left: Fig. 2 of U.S. Patent No. D D481,090, showing a bottom, perspective view of the driver; Right: Nike SasQuatch SUMO SQ driver

Tags: [Design Patents](#)

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PROTECTING DESIGNS

Update on Apple v. Samsung Downunder

As reported by [Bloomberg](#), Apple has obtained an at least temporary injunction against Samsung sales of the Galaxy Tab 10.1 in Australia. Samsung has agreed to stop advertising the Galaxy Tab 10.1 and to not sell the device until it obtains court approval or the lawsuit is resolved. Apple has agreed to pay Samsung unspecified damages should Samsung win the related patent lawsuit in Australia.

Samsung has agreed to provide Apple with samples of the Australian Galaxy Tab 10.1, which Samsung states is different than the U.S. version, for Apple's review prior to distribution. A hearing is scheduled for August 29, 2011, in Sydney, Australia.

Bloomberg reports Apple will attempt to prevent Samsung from selling the Galaxy Tab 10.1 in other countries as well.

[Samsung Galaxy Tab 10.1, from www.samsung.com]

Tags: [Apple](#), [Injunction](#), [Samsung](#)

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PROTECTING DESIGNS

USPTO's Rule 56 "But For-Plus" Proposal

As we previously reported, the Court of Appeals for the Federal Circuit released in May 2011 its long-awaited decision in *Therasense, Inc. v. Becton Dickinson and Co.*, in which it raised the standard for proving inequitable conduct and rendering a patent unenforceable. The defense of inequitable conduct applies to both utility and design patents. Last year, we reported on a [design patent litigation where this defense was raised](#).

The *Therasense* decision redefined the type of information that can potentially support a defense of inequitable conduct if it is withheld, misleading, or incorrect -- i.e., what constitutes "material" information. Under the new standard, information is material only "if the PTO would not have allowed a claim had it been aware of the undisclosed prior art." The Federal Circuit refers to this as the "but for" standard.

Last week, in response to the *Therasense* decision, the USPTO [published proposed changes to the materiality standard of 37 CFR § 1.56](#), which governs Applicants' duty of disclosure during the prosecution of a design patent. The proposed rule, which defines materiality using a so-called "but for-plus" test, is shown below in its entirety.

§1.56 Duty to Disclose Information Material to Patentability

(b) Information is material to patentability if it is material under the standard set forth in *Therasense, Inc. v. Becton, Dickinson & Co.*, ___ F.3d ___ (Fed. Cir. 2011). Information is material to patentability under *Therasense* if:

- 1) The Office would not allow a claim if it were aware of the information, applying the preponderance of the evidence standard and giving the claim its broadest reasonable construction; or
- (2) The applicant engages in affirmative egregious misconduct before the Office as to the information.

Part (b)(1) above is straight forward and corresponds to the "but for" test adopted by the *Therasense* decision. Part (b)(2) raises some questions. It embodies the "plus" aspect of the proposed "but for-plus" materiality standard. While the *Therasense* decision provides support for findings of inequitable conduct in cases of affirmative egregious misconduct, the USPTO had historically treated intentional misrepresentations, false and misleading statements under a different rule than Rule 56. Affirmative egregious misconduct in the form of false statements or misrepresentations, especially in affidavits or declarations were considered to be inherently material. But such materiality was a result of a violation of the duty of candor and good faith. Whereas the duty of disclosure was confined to acts of omission and given separate treatment under Rule 56. The USPTO is soliciting comments on its proposal on or before September 19, 2011. We will keep track of this process and report on our blog so as to keep design patent applicants informed.

Tags: [Design Patents](#), [USPTO](#)

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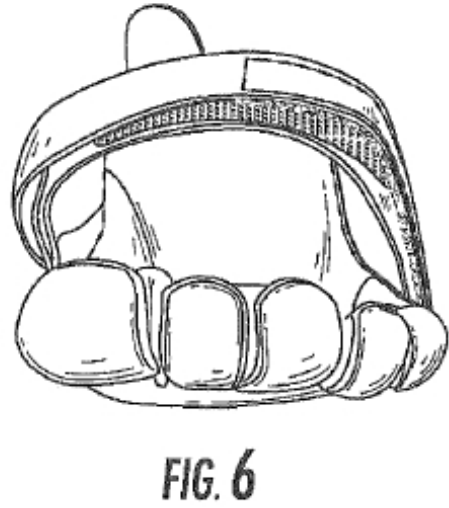
PROTECTING DESIGNS

Vibram asserts minimalist footwear patents

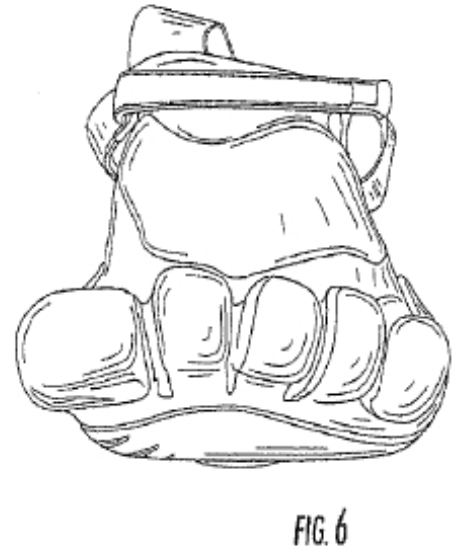
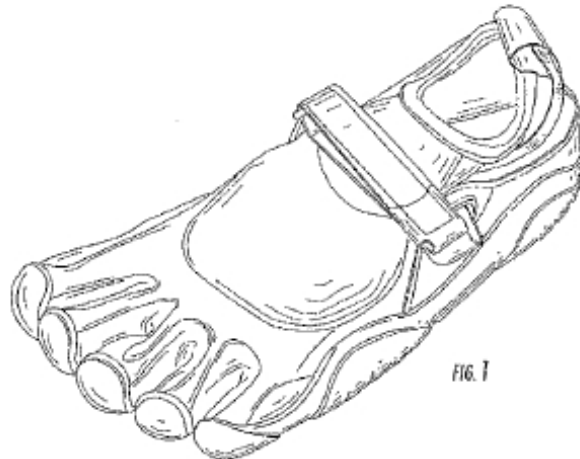
Vibram has filed a [complaint](#) against Fila USA Inc. in the District of Massachusetts alleging infringement of Design Patent Nos. D579,181 ("the '181 patent") and D582,134 ("the '134 patent"), and U.S. Utility Patent No. 7,805,860. According to the complaint, Vibram markets the popular FiveFingers footwear products, which fill the need for "footwear ... which allows independent intrinsic movement of the feet, and particularly the toes ... and yet which still provides coverage and protection to the toes... ."

Vibram alleges Fila's skele-toes products infringe the '181 and '134 patents. A copy of the comparison provided on page 7 of the complaint is reproduced below.

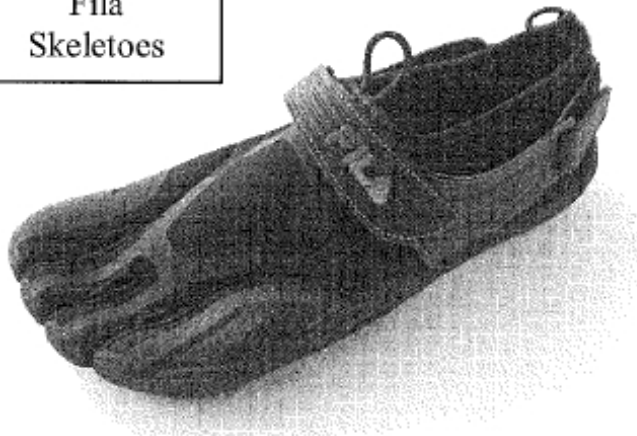
'181 Patent



'134 Patent



Fila
Skeletoes



This suit was [reported by The Boston Globe on July 18, 2011](#). The Globe quoted Fila as stating the allegations in Vibram's complaint are without merit, and quoted Vibram as stating Vibram "pioneered the minimalist footwear category," and "copyists and counterfeiters have come out of the woodwork."

[Brian R. Epstein](#) contributed to this post.

Tags: [Design Patents](#), [Fashion Designs](#)

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PROTECTING DESIGNS

Lamborghini takes on Vegas

As reported in the [Washington Post](#) (by the Associated Press), Lamborghini has filed a trademark infringement suit against a Las Vegas casino concerning logos used at the entrance of businesses (reportedly the Dal Toro Exotic Car Showroom, Dal Toro Merchandise Gallery and Dal Toro Il Ristorante Italiano) inside the Palazzo Las Vegas Resort are imitations of the Lamborghini's logos.

Below is the Dal Toro logo, as presented on their [Facebook profile page](#), next to the Lamborghini logo, as presented on their [website](#).

Tags: [Trademark](#)

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PROTECTING DESIGNS

H.R. 2511 - IDPPPA Hearing - July 15, 2011

As we previously [posted](#), the Subcommittee on Intellectual Property, Competition and the Internet held a Hearing on [H.R. 2511](#) on July 15, 2011, concerning the Innovative Design Protection and Privacy Prevention Act.

The Hearing started just after 10:00 AM, and the following witnesses provided brief testimonies:

[Lazaro Hernandez](#), Designer and Co-Founder, Proenza Schouler

Mr. Hernandez provided a passionate but scripted testimony and argued the U.S. has become a haven for copyists and piracy. He argued younger designers and smaller operations are the most vulnerable in the marketplace.

[Jeannie Suk](#), Professor of Law, Harvard Law School

Ms. Suk provided a comparative analysis between copyright law principles and reasons for fashion design protection. She also described the differences between "knock-off" designs and "inspired-by" designs. Ms. Suk argued the bill is narrowly tailored to those making "knock-off" designs, and the term is limited and does not harm the consumers. She also argued "luxury firms" are not as adversely affected by copyists as much as smaller/lower-market firms.

[Christopher Sprigman](#), Professor of Law, University of Virginia School of Law

Mr. Sprigman provided a brief history of Congress considering, but not acting on, fashion design protection in the past. He notes the fashion industry has succeeded over the past decades even though fashion design protection has been relatively limited.

Mr. Sprigman provided slides showing statistical information that only high-end original women's dresses have experienced price growth since 1998. He concluded by arguing he doesn't believe the bill is necessary since the fashion design market is highly competitive and may lead to rampant litigation.

[Kurt Courtney](#), Manager, Government Relations, American Apparel & Footwear Association

Mr. Courtney argued the bill is very limited in scope and cited several sections of the bill to support his argument, including the sections relating to infringement and pleading requirements, which he argued created a burden on plaintiffs which would stem frivolous lawsuits. His position countered that of Mr. Sprigman.

At about 10:39 AM, members began questioning the witnesses.

Mr. Sprigman was asked if technology has affected the speed of copying designs. Mr. Sprigman stated the increased access to the internet has not affected the speed of copying.

Mr. Sprigman was also asked what "mischief" could happen if the bill is passed. Mr. Sprigman provided slides comparing two bags and several wedding dresses, and stated plaintiff's lawyers would be looking for settlement money.

Mr. Sprigman appears to be the popular witness, and was further asked if there was a chance of "trolls" appearing in the market. Mr. Sprigman responded by stating he could see law firms starting business as "copyright trolls."

Ms. Suk was given a chance to counter some of Mr. Sprigman's comments and arguments. Ms. Suk argued the data Mr. Sprigman provided was not being interpreted correctly, and stated the increase in "high-end" women's dresses does not necessarily mean "healthy competition."

Mr. Hernandez was then asked on his view of creating jobs, and remarked how the copying of designs makes his designers push the envelope.

Mr. Hernandez was presented with a statement that copying churns fashion design development. Mr. Hernandez responded by emphasizing the differences between "copying stitch by stitch" and "inspired-by" designs.

Mr. Courtney provided comments the bill contains a high threshold of originality for protected fashion designs.

Ms. Suk was then requested to provide a written set of jury instructions with respect to "inspired-by" designs and "knock-off" designs. This question was provided by Congressman Watt (D-NC). Congressman Watt stated his biggest concern was the difficulty in properly instructing a jury to decide whether an allegedly infringing article is an "inspired-by" or "knock-off" design.

Tags: [Fashion Designs](#)

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PROTECTING DESIGNS

Apple files ITC complaint against Samsung

As reported in the [ITC blog](#), Apple filed an ITC complaint against Samsung on July 8, 2011, alleging certain portable electronic devices and related software infringe claims of U.S. 7,844,915, 7,469,381, 7,084,859, 7,920,129 and 6,956,564. This ITC complaint follows the ITC complaint Samsung filed against Apple on June 28, 2011. As in that complaint, this complaint also presumably relates to the ongoing dispute we have been covering between Samsung and Apple.

Tags: [Apple](#), [ITC](#), [Samsung](#)

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PROTECTING DESIGNS

Update on Apple v. Samsung

Further to our coverage of the ongoing Apple v. Samsung litigation, Apple filed a [motion for preliminary injunction](#) on July 1, 2011. Apple also filed motions for an expedited trial and for shortening the time for the briefing process in the expedited trial.

On July 12, 2011, Judge Lucy Koh denied the motion to shorten time. However, the motion for preliminary injunction and motion for an expedited trial are still pending.

From the order of July 12, 2011:

"The Court agrees that Apple has not established substantial harm or prejudice justifying a shortened briefing and hearing schedule for its Motion to Expedite."

Further, "Apple indicated at the May 12, 2011 hearing that it had been aware of its infringement claims for at least a year and engaged in negotiations with Samsung during that time.... The Court agrees with Samsung that the length of time Apple has been aware of its claims and the long history of infringement alleged in the complaint undermine Apple's claims of urgency to some extent."

Tags: [Apple](#), [Design Patents](#), [Samsung](#)

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PROTECTING DESIGNS

Innovative Design Protection and Piracy Prevention Act

The Subcommittee on Intellectual Property, Competition and the Internet has [scheduled a Hearing on H.R. 2511](#), the "Innovative Design Protection and Piracy Prevention Act," [IDPPPA] for Friday 7/15/2011 at 10:00 A.M.

We [previously posted](#) on the IDPPPA and we will post a follow-up on Friday with details of the Hearing.

UPDATE 7/14/2011

We now have a [copy of HR 2511](#), published July 13, 2011. This bill proposes an amendment to 17 USC 1301 et seq.

Of note, the bill adds the following language to 17 USC 1301:

"Fashion Design.-A fashion design is subject to protection under this chapter."

A fashion design, as defined in the bill, is the appearance as a whole of an article of apparel, including its ornamentation, and includes original elements or the original arrangement of elements as incorporated into the overall appearance of the article that:

"are the result of a designer's own creative endeavor," and

"provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles."

The term 'apparel' is given a broad meaning, and 'substantially identical' is defined as an article "which is so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial."

It should be noted, however, that the "presence or absence of a particular color or colors or of a pictorial or graphic work imprinted on fabric shall not be considered in determining the protection of a fashion design ... or in determining infringement...."

A protected fashion design continues for 3 years beginning on the date of commencement of protection under Section 1304, which states the date is the date the design was first made public. 'Registration' will not apply to fashion designs.

An "infringing article" is defined as any article which has been copied from a protected design, or from an image thereof, without consent. An article is not considered "copied" when it is not substantially identical in overall visual appearance to the original elements of the protected design or when it is the result of independent creation.

Also, it is not considered infringement to make, have made, import, sell, offer for sale, advertise, or distribute an article which was created without knowledge a design was protected and the article was copied from such design. Accordingly, unknowing retailers appear to be protected from liability, and there does not appear to be any liability for end-consumers.

Tags: Apple, ITC, Samsung

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PROTECTING DESIGNS

Samsung files ITC complaint against Apple

As reported in the [ITC blog](#), Samsung filed an ITC complaint against Apple on June 28, 2011, alleging certain electronic devices, including wireless communication devices, portable music and data processing devices, and tablet computers infringe one or more claims of U.S. 7,706,348, 7,486,644, 6,771,980, 6,879,843, and 7,450,114.

Presumably, this ITC complaint relates to the ongoing dispute we have been covering between Samsung and Apple.

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PROTECTING DESIGNS

ITC Investigates Certain Protective Cases and Components Thereof

As reported on *Oblon's ITC blog*, the U.S. International Trade Commission ("ITC") has instituted an investigation in response to a complaint filed by Otter Products, LLC alleging violation of Section 337 in the importation into the U.S. and sale of certain protective cases and components thereof that infringe certain U.S. patents and trademarks. The complaint identifies twenty-nine respondents, including Alibaba.com and other Chinese and American companies.

The asserted design patents are U.S. Design Patent Nos. D600,908, D617,784, D615,536, D617,785, D634,741, and D636,386. According to the complaint, these design patents "protect the ornamental features of Otter Products' unique protective case designs for handheld electronic devices, including smart phones, tablet computers, and other mobile devices." Some of the figures from these patents are reproduced below.

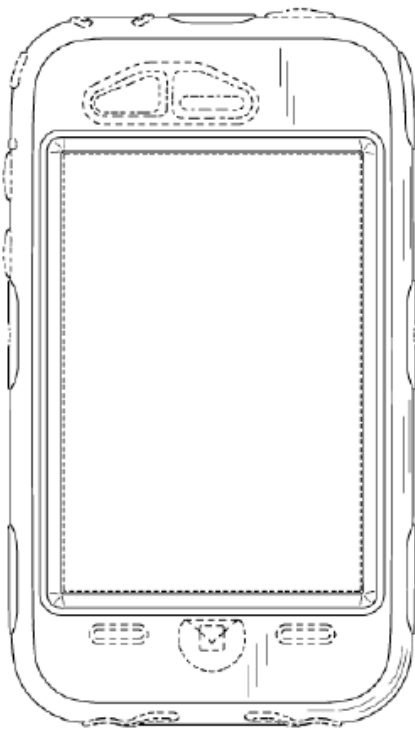


Fig. 2 of D617,784

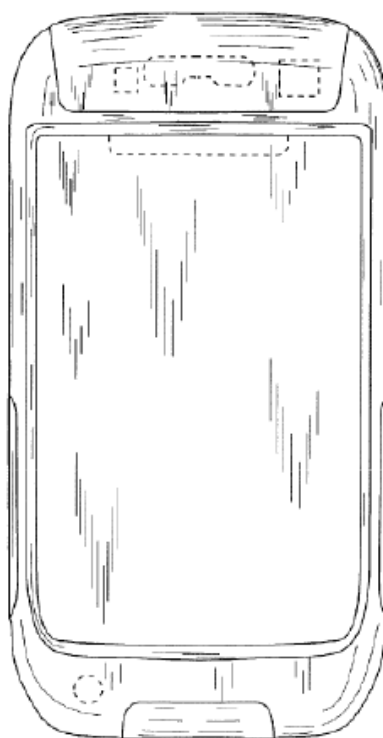


Fig. 2 of D617,785

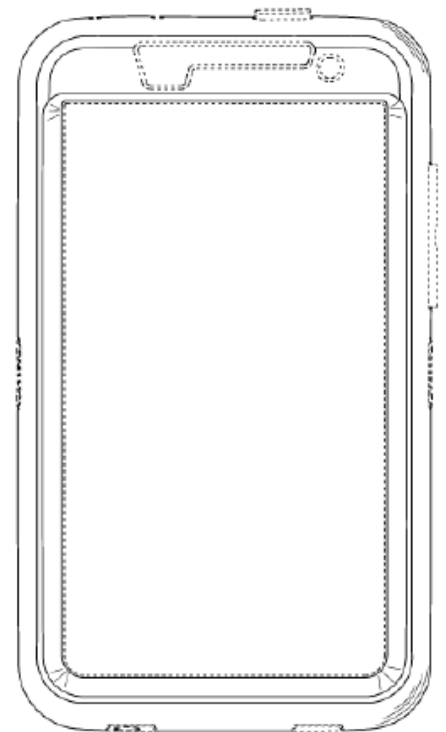
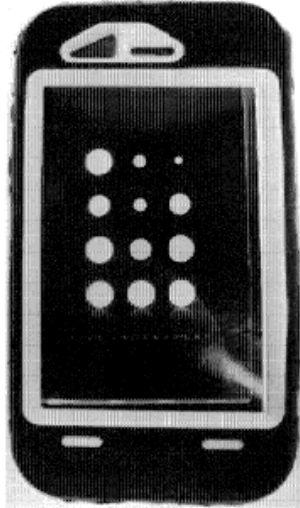
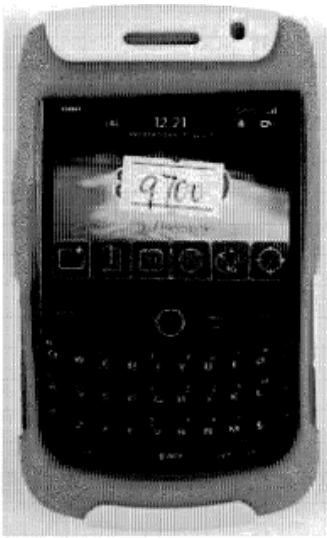


Fig. 3 of D634,741

The following were identified in the complaint as some of the respondents' protective cases and components thereof:



Tags: Design Patents, ITC

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PROTECTING DESIGNS

History of U.S. Design Protection

An interesting article on design patents has been recently written by Jason DuMont of the Max Planck Institute for Intellectual Property & Competition Law and Mark Janis of the Indiana University Maurer School of Law. The article, entitled “The Origins of American Design Protection,” traces the origins and progression of U.S. design protection, and calls for a return of design protection in the U.S. back to its roots (although the U.S. Congress is not currently contemplating any such changes).

The Abstract of the article is as follows:

Design patent protection is the oldest American form of intellectual property protection for ornamental designs, but still the most enigmatic. Congress passed the first design patent legislation in 1842, operating on the assumption that existing rules for utility patents could be incorporated en masse to protect designs. This Article questions that assumption. Drawing on new archival research and historical analysis, this Article demonstrates for the first time how the design patent system originated. We analyze the international trade aspects of the first design patent legislation, linking the legislation with a brief burst of protectionist measures associated with the Whig party. We also examine technological innovations that ushered in the first major era of American industrial design in key antebellum industries, and we analyze lobbying efforts on behalf of those industries that led to proposals for early design protection, proposals that did not assume the incorporation of patent rules. We also prove for the first time how the American design patent system originated as a knock-off of British copyright and registered design legislation, and why the American system was likely forced into a patent rubric. Finally, we conclude by offering concrete suggestions for the courts and Congress to ease the design patent system back to its original roots.

The full article is accessible [here](#).

Any opinions and conclusions expressed in the article are solely those of the authors and should not be construed as representing the *opinions* or policy of Oblon Spivak.

Tags: [Design Patents](#)

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PROTECTING DESIGNS

Apple and Nokia Agree to Settlement of All Patent Litigation

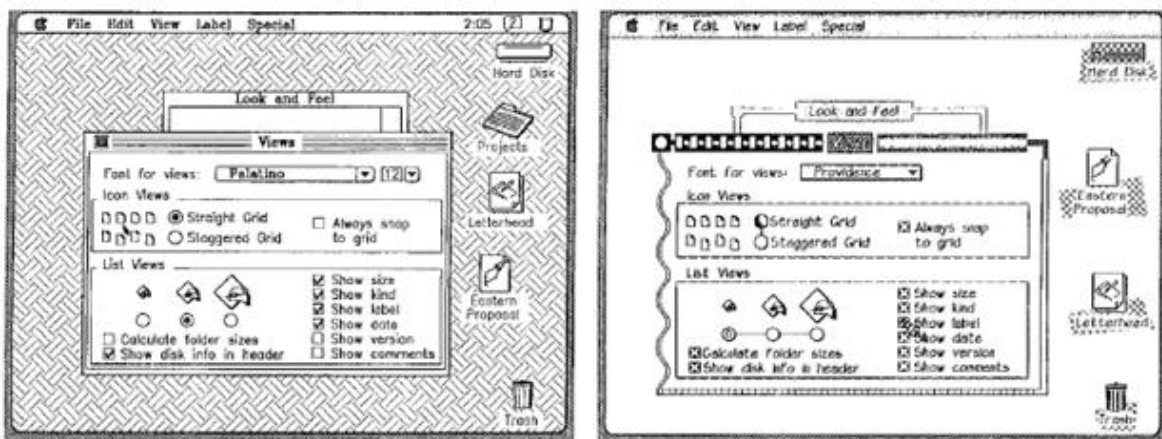
We've discussed Apple's ongoing litigation with Samsung [here](#) and [here](#) involving Apple's design patents and trade dress. This litigation is a battle being fought within a bigger international war between major technology companies, and illustrates how design rights can be a useful weapon within a well-rounded legal arsenal.

Within this context, today comes word that Apple and Nokia have agreed to a settlement of all patent litigation between the companies. The agreement includes a one-time payment and ongoing royalties to be paid by Apple. Though specific amount and length details of the settlement agreement are not disclosed, the amount of the settlement has been reported to be large enough to materially improve Nokia's quarterly earnings.

This litigation began in October 2009 when Nokia filed a patent infringement lawsuit against Apple alleging that the wireless technology used by Apple in products such as the MacBook and iPhone violate patents owned by Nokia. Apple responded with its own lawsuit against Nokia in December 2009 for allegedly violating several patents owned by Apple. Both companies also subsequently filed complaints against each other in Europe (as with Apple and Samsung) and in the ITC (detailed [here](#)).

Although no design patents appear to have been involved in the litigation between Apple and Nokia, Apple had asserted infringement claims against Nokia related to patents directed to user interface technology. See, for example, Apple's U.S. Patent No. 6,239,795 ("Pattern and color abstraction in a graphical user interface").

Figs. 2D and 2E of U.S. Patent No. 6,239,795



Tags: [Apple](#), [Samsung](#)

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PROTECTING DESIGNS

Microsoft v. i4i: Presumption of Validity Standard Affirmed

As reported in Oblon Spivak's [Patents Post-Grant blog](#), the Supreme Court of the United States recently reinforced the well established principle that clear and convincing evidence is required to establish invalidity of a U.S. Patent. *Microsoft Corp. v. i4i Ltd. Partnership et al.*, 564 U.S. ___ (June 9, 2011). See holding [here](#).

This “presumption of validity” is not limited to utility patents, but also extends to design patents. For example, as noted in *Titan Tire Corp. v. Case New Holland Inc.*, 566 F3d 1372 (Fed. Cir. 2009), a design patent case that related to the design of tractor tires, “an issued patent comes with a statutory presumption of validity under 35 U.S.C. § 282. Because of this presumption, an alleged infringer who raises invalidity as an affirmative defense has the ultimate burden of persuasion to prove invalidity by clear and convincing evidence, as well as the initial burden of going forward with evidence to support its invalidity allegation.” *Id.* at. 1376.

This is good news for design patent holders, as the presumption of validity makes it more difficult for an infringer to invalidate an issued design patent.

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PROTECTING DESIGNS

Court of Appeals Changes Standards for Inequitable Conduct

The Court of Appeals for the Federal Circuit recently released its long-awaited decision in *Therasense, Inc. v. Becton Dickinson and Co.*, in which it raised the standard for proving inequitable conduct and rendering a patent unenforceable. The decision makes it more difficult for accused infringers to prove the two elements required for inequitable conduct, namely (i) that the patent applicant withheld “material” information (i.e., important or relevant information) from the patent examiner, or the applicant submitted material information that was false or misleading, and (ii) the applicant intended to deceive the Patent Office by withholding material information or submitting the material information that was false or misleading.

The defense of inequitable conduct also applies to design patents. Last year, we reported on a ***design patent litigation where this defense was raised***.

With respect to the first element of materiality, the Court of Appeals redefined the type of information that can potentially support a defense of inequitable conduct if it is withheld, misleading, or incorrect -- i.e., what constitutes “material” information. Under the new standard, information is material only “if the PTO would not have allowed a claim had it been aware of the undisclosed prior art.” The Federal Circuit refers to this as the “but-for” standard.

With respect to the second element of intent, the Federal Circuit generally adopted the intent standard from *Star Scientific Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008), and clarified that an accused infringer must prove by clear and convincing evidence that the applicant:

- a) knew of the reference;
- b) knew that it was material; and
- c) made a deliberate decision to withhold it.

The Court’s adoption of a “but-for” standard for materiality is most noteworthy, and is consistent with the Court’s ongoing efforts to curb the “plague” of inequitable conduct allegations in patent litigation, and their negative effects on the PTO, courts, parties, and patents.

Of the eleven judges who decided this case, six supported the majority opinion, one submitted an opinion concurring-in-part and dissenting-in-part, and four dissented. Accordingly, it is possible that the U.S. Supreme Court will further address the issues raised in this case. From a practical point of view, therefore, it is not recommended to change procedures with regard to design patent prosecution. All U.S. Patent and Trademark Office rules still must be followed, including disclosing material information from domestic and foreign prosecution that is related by family or subject matter, as well as related litigation.

Please click [here](#) for a more detailed reporting on this decision.

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PROTECTING DESIGNS

Maker of Generic Products: Alleged Copying of Procter and Gamble's Scope Outlast Mouthwash Packaging

Seeking an injunction, statutory damages, and/or defendant's profits, The Procter & Gamble Company (P & G) sued Vi-Jon, Inc., a generic-products manufacturing and distribution company on May 27, 2011 in the Southern District of Ohio Western Division for patent and trademark infringement as well as unfair competition.. See Complaint [here](#).

In August of 2009, P & G introduced a new line of mouthwash products under the SCOPE® OUTLAST® brand that features a teardrop shape bottle. (U.S. Trademark Application Serial No. 77/685,052 filed March 6, 2009) along with its label. P & G also asserts U.S. design patents related to the bottle design and labeling for the SCOPE® OUTLAST® product. P & G claims to have spent millions of dollars on advertisement of the mouthwash in its SCOPE OUTLAST Bottle Design and Trade Dress shown below.



P & G alleges that Vi-Jon, Inc. introduced a new line of mouthwash products that intentionally includes packaging which infringes P & G's design rights in the SCOPE OUTLAST Bottle. Below is a picture showing the Vi-Jon product (left) and the P & G SCOPE® OUTLAST® (right).



P & G alleges that the Vi-Jon product packaging contains the following characteristics:

1. A bottle design that is virtually indistinguishable from P & G's SCOPE OUTLAST Bottle Design.
2. A "compare to" statement that uses P & G's "SCOPE OUTLAST" brand name (without attribution) on the front label in blue lettering alongside additional blue and grey text.
3. An image of splashing liquid on the front label like the splashing liquid image that is included in P & G's SCOPE OUTLAST Trade Dress.
4. A label with a shape that is confusingly similar to P & G's label.
5. A flavor identified as peppermint with the wording LONG LASTING prominently displayed near the word mouthwash further imitating P & G's SCOPE OUTLAST Trade Dress.

It is worth noting that P & G has taken legal action twice previously against Vi-Jon, Inc. to protect their intellectual property rights for oral care products.

[Kathleen Cooney-Porter](#), [David H. Aleskow](#) and [Philippe Signore](#) contributed to this post.

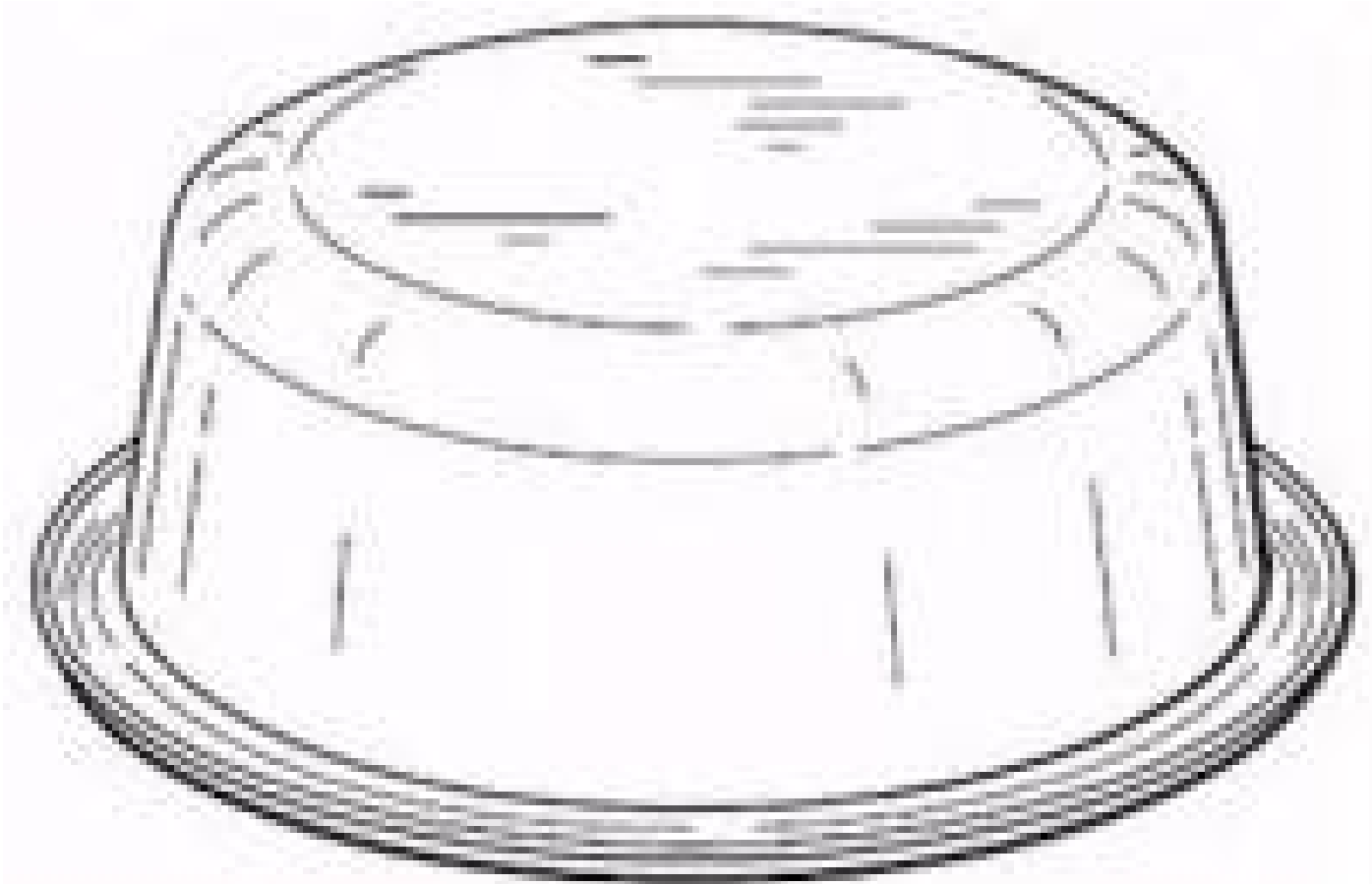
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PROTECTING DESIGNS

Trademark Trial and Appeal Board Finds Configuration of Pet Food Container Inherently Distinctive

On May 16, 2011, the Trademark Trial and Appeal Board reversed the refusal to register a mark (not precedential), filed by Mars, Inc. (U.S. Trademark Application Serial No. 77/727,119) that “consists of a three-dimensional configuration of packaging for pet food that consists of a round bowl-shaped, inverted and lacquered pet food container. The top of the container has a center circle with rounded edges tapering to the sides with a wider larger lip at the bottom with various placement lines representing a lacquered finish. The inverted nature of the container and the lacquered finish are claimed as features of the mark.” See Opinion [here](#). The mark is shown below.



The Examining Attorney refused to register the mark on the ground that the mark “consists of a non-distinctive configuration of product packaging for pet food that is not registrable without sufficient proof of acquired distinctiveness.” Further, the Examining Attorney submitted excerpts from websites displaying various pet food containers to support his argument that the mark to be registered is a common basic shape or design for pet food packaging.

The Board applied the test used in *Seabrook Foods, Inc. v. Bar-Well Foods Limited*, 568 F.2d 1342, 196 USPQ 289, 291

(CCPA 1977) to determine whether Mars, Inc.'s configuration of packaging for pet food is arbitrary or distinctive. The factors the Board considered in determining whether a design is arbitrary or inherently distinctive are:

1. Whether the subject matter sought to be registered is a "common" basic shape or design;
2. Whether the subject matter sought to be registered is unique or unusual in a particular field;
3. Whether the subject matter sought to be registered is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods; or
4. Whether the subject matter sought to be registered is capable of creating a commercial impression distinct from the accompanying words.

The Board concluded that the Examining Attorney placed too much attention on the round bowl shape and did not focus on the other elements of the bowl including the inverted nature and lacquered finish. The Board stated, "the proposed mark engenders the commercial impression of a serving platter and cover holding a gourmet meal for a pet." Further, the evidence provided by the Examining Attorney did not show that Mars, Inc.'s configuration of packaging for pet food is not an unusual container for pet food nor that it is a refinement of a well-known design or ornamentation.

In conclusion, the Board did not feel that the Examining Attorney made a *prima facie* case that Mars, Inc. configuration of packaging for pet food is not inherently distinctive and is a common design. The refusal to register was reversed.

[Kathleen Cooney-Porter](#) and [David H. Aleskow](#) contributed to this post.



PROTECTING DESIGNS

Maria Pallante appointed Register of Copyrights and director of the U.S. Copyright Office

The Library of Congress announced today that Maria Pallante was appointed as the 12th Register of Copyrights and director of the United States Copyright Office, effective June 1, 2011. The Librarian of Congress, James Billington, stressed "the increasingly important role of copyright law in the current knowledge economy and the numerous complex issues facing copyright owners as well as users of copyrighted materials. He noted the particular challenges of protecting authors' intellectual-property interests in the online environment and achieving meaningful exceptions and limitations that serve the public interest in the 21st century."

Copyright has its role in protecting designs, even if it can be difficult to meet the requirement of the Copyright Act. Under the Act, the design of a useful article is protectable "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101. The task, however, is not insurmountable. For example, last year, the U.S. Court of Appeals for the Fourth Circuit affirmed an \$11M damage award in a copyright infringement case involving furniture designs. See [opinion \(pdf\)](#). We will continue to report on new developments in design protection by copyright. In the meantime, we congratulate Ms. Pallante for her new appointment. The press release from the Library of Congress can be found [here](#).

Tags: [Copyright](#)

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PROTECTING DESIGNS

Update on Apple v. Samsung

We have been following the dispute between Apple and Samsung on our blog (see [here](#)). On April 15, 2011, Apple filed suit against Samsung for trademark, trade dress, design patent and utility patent infringement, alleging that Samsung purposely designed several of its recent Galaxy line of products after Apple's hit iPad and iPhone devices. Taking a relatively aggressive posture, Apple requested accelerated discovery in anticipation of Samsung's upcoming product launches in the U.S.

On May 18, 2011, U.S. District Court Judge Lucy H. Koh ordered (see [Order Granting Limited Expedited Discovery](#)) Samsung to produce product samples, packaging and package inserts for Samsung models Galaxy S2, Galaxy Tab 8.9, Galaxy Tab 10.1, Infuse 4G and the Droid Charge (4G LTE). The Droid Charge was recently released, but the other models have only been announced and are not yet available for sale in the U.S.

The order states the "Court understands that production of pre-release samples to a competitor can be prejudicial, but believes that this concern can be adequately addressed by a stringent protective order." The expedited discovery of these models is ordered to be produced with the designation "Outside Counsel Eyes Only." Apple and its in-house counsel are ordered to not have access to the expedited discovery.

Samsung's prior arguments concerning this issue were, according to the order, undermined by Samsung releasing images and samples of these models to the public. On May 10, 2011, Samsung gave away 5,000 samples of the Galaxy Tab 10.1 at Google I/O 2011 in San Francisco.

It appears the Court expects Apple will continue its relatively aggressive approach and pursue a preliminary injunction based on Apple's request for expedited discovery. As stated at page 3 of the order, "courts have found that expedited discovery may be justified to allow a plaintiff to determine whether to seek an early injunction." Further, at page 4, the order states "expedited discovery would allow the Court to address any request for preliminary injunctive relief at the outset of the case, thereby providing a measure of clarity to the parties early in the proceeding and facilitating effective case management."

Tags: [Apple](#), [Design Patents](#), [Injunction](#), [Samsung](#)

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PROTECTING DESIGNS

Déjà vu - Crocs sues Skechers for Design Infringement

In December of 2008, Crocs Inc. and Skechers Inc. agreed to settle patent litigation (case number 1:08-cv-01450, in the U.S. District Court for the District of Colorado) concerning U.S. D517,789, U.S. D564,208 and U.S. D564,207. That patent litigation concerned a line of slip-on foam clogs made by Skechers, which Crocs alleged infringed the patents.

On May 20, 2011, Crocs filed a complaint and initiated a new suit against Skechers, case number 1:11-cv-01330, in the U.S. District Court for the District of Colorado. Crocs alleges the Swifts line introduced in the summer of 2010 by Skechers is an “obvious imitation” of Crocs’ original shoe design for the CROCBAND™ model footwear, which is protected by U.S. D610,784. Crocs also alleges Skechers breached a settlement agreement of September 23, 2010, stemming from Crocs’ contact with Skechers’ around the time the Swifts line was introduced.

Figs. 1 and 5 of U.S.
D610,784:



Reproduced from page 7 of the complaint:



Tags: Complaint, Design Patents, Fashion Designs, Trade Dress, Unfair Competition

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PROTECTING DESIGNS

Kraft Foods Sues Van Law Food Products Over Bottle

Kraft Foods filed suit against Van Law Food Products in the U.S. District Court for the Southern District of New York on May 17, 2011. In the Complaint, Kraft Foods alleges that the bottles sold by Van Law Food Products, including those sold under the Eating Right brand (pictured below) infringe six design patents held by Kraft Foods.

Eating Right Bottles (copied from Complaint)

Kraft Bottles (Figs. 2-4 of D568,164)



The design patents in suit are U.S. Patent Numbers D568,164, D569,733, D585,746, D585,747, D611,347, and D611,820. Regarding the patented bottles, the Complaint states that “these designs are distinctive and appealing to the eye” and that “these designs are also particularly desirable and valuable when applied to plastic bottles used for containing and promoting liquid food product such as salad dressing.”

The complaint also alleges that the bottles of Van Law Food Products violate Kraft Foods’ trade dress and constitute unfair competition.

Tags: [Complaint](#), [Design Patents](#), [Trade Dress](#), [Unfair Competition](#)

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PROTECTING DESIGNS

Polo Ralph Lauren is on the Table

Brandon Judkins filed a complaint May 16, 2011, case number 1:11-cv-00661, in the U.S. District Court for the Southern District of Indiana, alleging Polo Ralph Lauren Corporation has infringed U.S. D591,090.

The following images are reproduced from pages 4-5 of the complaint, where line drawings from U.S. D591,090 are shown on the left, and the top image and the right images are photos personally taken by Mr. Judkins at stores in Indianapolis, Indiana.

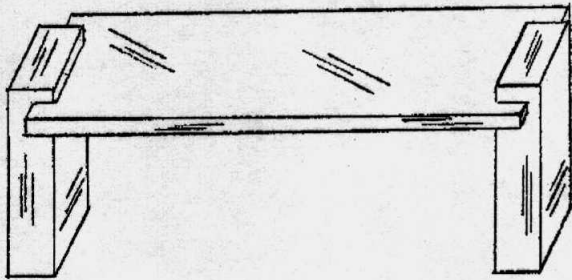


FIG. 1



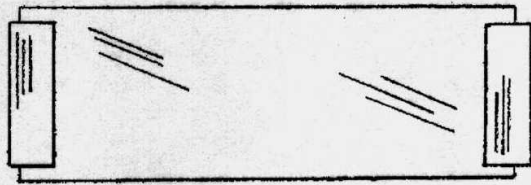


FIG. 2

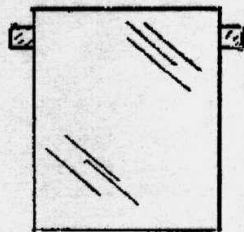
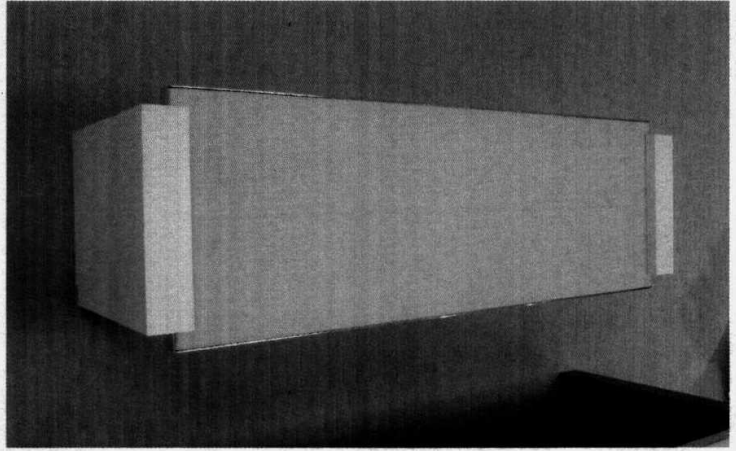


FIG. 3

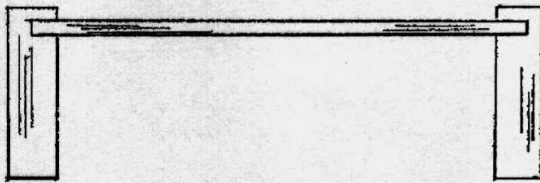
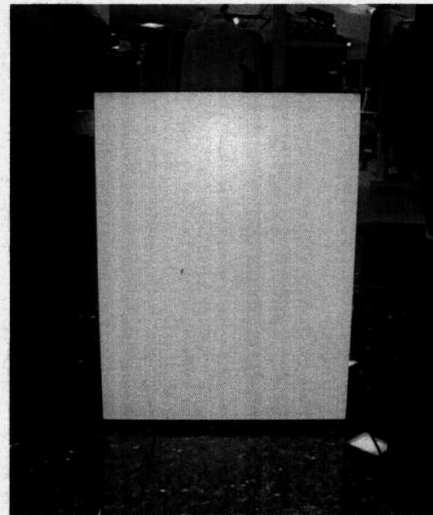


FIG. 4



Tags: Complaint, Design Patents, Fashion Designs

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PROTECTING DESIGNS

Good Sportsman Marketing and IP Holdings file lawsuit accusing Best Buy of infringing clip-on light design patent

On Friday, April 15, 2011, Good Sportsman Marketing, LLC (hereinafter “GSM”) and IP Holdings, Inc. filed a complaint in the U.S. District Court for the Eastern District of Texas (Civil Action No. 6:11-cv-00188) against Best Buy Co., Inc., BestBuy.com, LLC and Best Buy Stores, L.P. (hereinafter “Best Buy”) for patent infringement of U.S. D498,322. The complaint states IP Holdings, Inc. owns the patent and GSM is the exclusive licensee of the patent.

In the complaint, GSM requests a jury trial and alleges Best Buy makes, imports, offers to sell and/or sells the Rocketfish™ eReader Clip On LED light, which infringes the claimed design in U.S. D498,322. The following is a reproduction of Chart 1 of the complaint, which shows the claimed design to the left and the alleged infringing product sold by Best Buy to the right.

Chart 1: Images Depicting Infringement of '322 Design Patent Defendants' Rocketfish™ eReader Clip On LED	
U.S. Design Patent No. D498,322	Rocketfish™ eReader Clip On LED light
	

On September 30, 2010, GSM and IP Holdings, Inc. were announced to have settled with Toy Island (USA), LLC in another case pending in the Eastern District of Texas concerning the same patent, U.S. D498,322. In the settlement, Toy Island agreed to pay \$200,000 for past damages and future royalties of not less than \$100,000 during the next three years for use of the patented design and a running royalty afterwards. See the announcement at <http://www.bjciplaw.com/pdf/GSM093010.pdf>.

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PROTECTING DESIGNS

Apple Continues Battle Against Competitors

We've discussed previously Apple's penchant of suing manufacturers of accessories of its widely popular iPhone and iPad devices. Now Apple is upping the ante by going after alleged infringers of the actual iPhone, iPod Touch, and iPad devices.

On April 15, 2011, Apple filed suit against Samsung for trademark, trade dress and patent infringement, alleging that Samsung purposely designed several of its recent Galaxy line of products after Apple's hit iPad and iPhone devices.



Left: Apple's iPad; Right: Samsung's Galaxy Tab

'D016 Patent

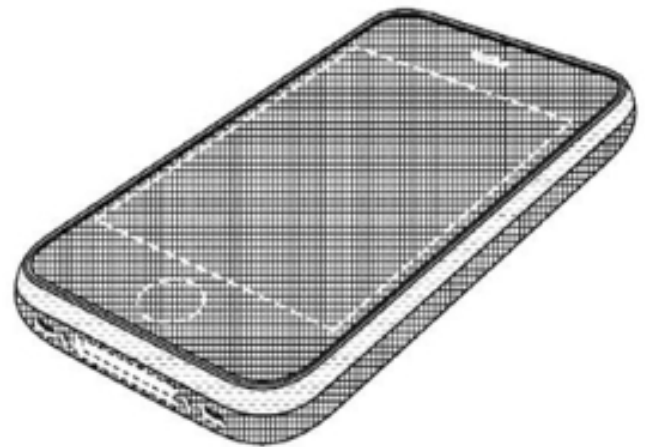


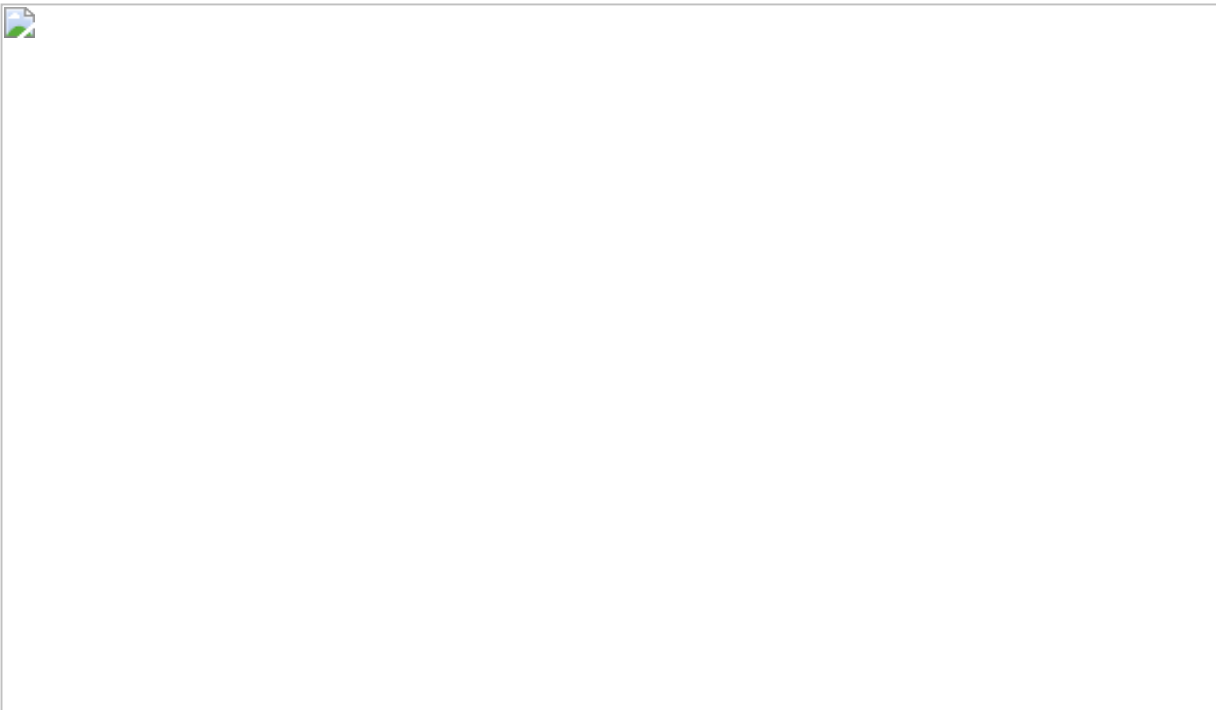
FIG. 1

In the Complaint, Apple details the worldwide popularity and critical acclaim of its devices, while asserting that Samsung has "slavishly" copied Apple's innovative technology and distinctive designs. The "slavish" copying allegedly includes the following:

- Trade Dress Infringement of U.S. Registration Nos. 3,470,983; 3,457,218; and 3,475,327.

- Trademark Infringement for the iPhone, iPod Touch, and iPad Registered Icon Trademarks.
- Unfair Business Practices based on the alleged Trade Dress Infringement.
- Patent Infringement of seven utility patents for multi-touch surfaces and scrolling operations. U.S. Patent Nos. 7,812,828; 7,669,134; 6,493,002; 7,469,381; 7,844,915; 7,853,891; and 7,863,533.
- Patent Infringement of three design patents for a graphical user interface and electronic devices. U.S. Patent Nos. D627,790; D602,016; and D618,677.

In a counter move to Apple's lawsuit, Samsung has sued Apple in South Korea, Japan and Germany alleging that Apple's iPhone and iPad infringe 10 mobile technology patents. Stay tuned...



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PROTECTING DESIGNS

Apple Sues Competitors Over Design Patents For Accessories

Apple is cracking down on companies selling accessories for its popular iPhone, iPod, and iPad devices, recently suing eForCity Corp. in the U.S. District Court for the Northern District of California for selling accessories for its devices without a license. Apple also alleged that eForCity's devices are of poor quality, noting consumer complaints about defective, battery-draining accessories.

eForCity attempted to dismiss the suit by alleging that Apple failed to identify each claim of each patent, each accused product for each asserted claim and the location where each claimed limitation is found within each accused product.

On April 5, 2011, Judge Fogel issued an Order denying eForCity's Motion to Dismiss. The judge found that this amount of specificity was not required to be in Apple's complaint, and that it was sufficient that Apple asserted ownership of the relevant patents, and identified each alleged infringer with its corresponding products that Apple believes infringe its patents.

The Order denying the Motion to Dismiss may be found at: http://amicourip.com/publications/apple_v_eforcite_order.pdf

The design patents in-suit are U.S. Patent Numbers D588,545; D596,621; and D578,110.

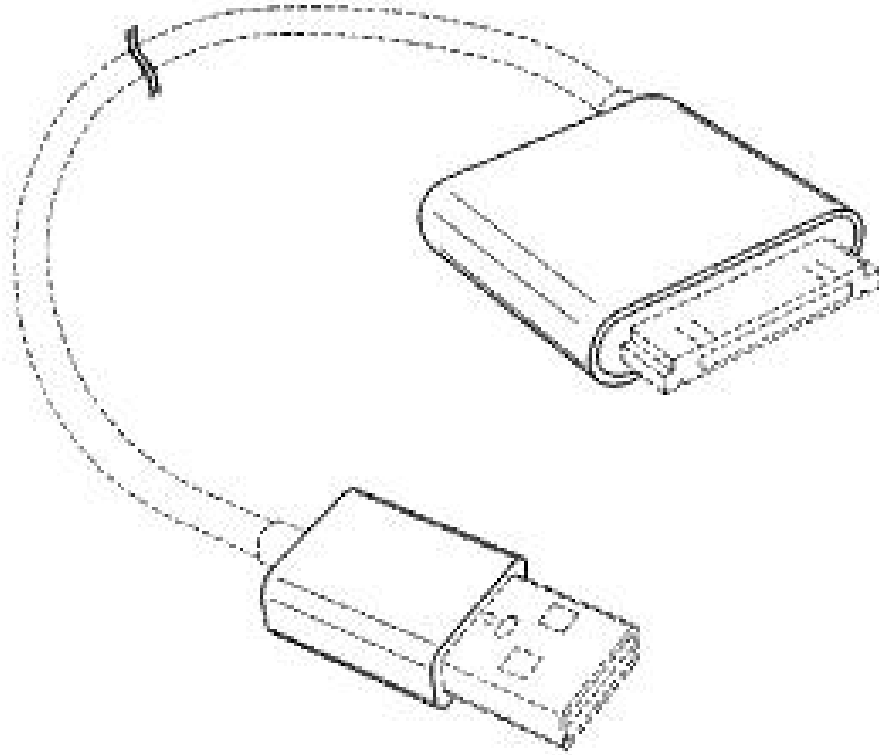


Image from Apple's U.S. Patent No. D588,545

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PROTECTING DESIGNS

Federal Circuit Rules False Marking Claims Must Be Pled With Particularity

As a follow-on to our [previous blog entry on the recent surge in the number of false marking lawsuits](#) being filed, on March 15, 2011, the Federal Circuit in *In Re BP Lubricants USA Inc.*, Misc. Doc. No. 960 (C.A.F.C., March 15, 2011) granted a petition for a writ of mandamus directing the United States District Court for the Northern District of Illinois to grant a motion to dismiss a complaint pursuant to the False Marking Statute, [35 U.S.C. § 292](#). In granting this petition, the Federal Circuit held as a matter of first impression that the complaint did not meet [Fed. R. Civ. P. Rule 9\(b\)](#)'s particularity requirement.

In the complaint, Thomas Simonian, a patent attorney, had alleged that BP Lubricants USA Inc. (BP) continued to falsely mark certain CASTROL® branded bottles with [design patent number D314,509](#) after the design patent covering the bottles had expired. Simonian claimed that: “(1) BP knew or should have known that the patent expired; (2) BP is a sophisticated company and has experience applying for, obtaining, and litigating patents; and (3) BP marked the CASTROL products with the patent numbers for the purpose of deceiving the public and its competitors into believing that something contained or embodied in the products is covered or protected by the expired patent.”

Below are images of the design patent-in-suit and the allegedly falsely marked bottles.

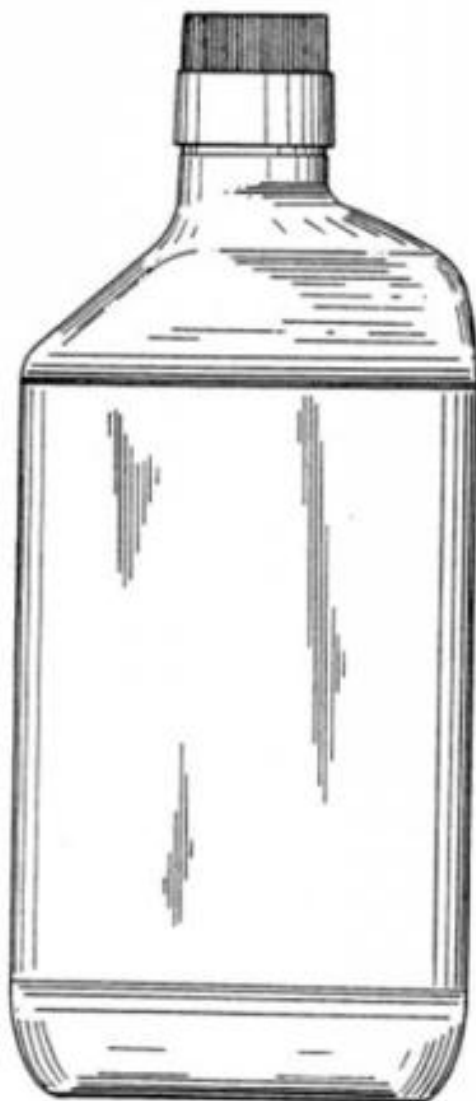


FIG. 1



Relying on *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1327 (Fed. Cir. 2009), the district court had found that the complaint met the requirements of Fed. R. Civ. P. 9(b), which provides:

In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake. Malice, intent, knowledge, and other conditions of a person's mind may be alleged generally.

"The [district] court explained that in addition to alleging that BP knew or should have known the patent expired, it was enough under Rule 9(b) for the relator to allege that BP (the "who") had deliberately and falsely marked (the "how") at least one line of its motor oil products (the "what") with an expired patent and continues to falsely mark its products (the "when") throughout the Northern District of Illinois and the rest of the United States (the "where")

with the intent to deceive its competitors and the public.”

In granting the petition, the Federal Circuit cited its power under the **All Writs Act, 28 U.S.C. § 1651(a)** to issue a writ of mandamus ‘as “necessary or appropriate in aid of our jurisdiction.”’ **Mississippi Chem. Corp. v. Swift Agr. Chem., 717 F.2d 1374, 1379 (Fed. Cir. 1983)**, and held that similar to claims under the False Claims Act, ‘Rule 9(b)’s particularity requirement applies to false marking claims and that a complaint alleging false marking is insufficient when it only asserts conclusory allegations that a defendant is a “sophisticated company” and “knew or should have known” that the patent expired.’ The Federal Circuit further determined that Rule 9(b) “acts as a safety valve to assure that only viable claims alleging fraud or mistake are allowed to proceed to discovery” and “prevents relators using discovery as a fishing expedition.”

Accordingly, the Federal Circuit granted the petition for a writ of mandamus directing the United States District Court for the Northern District of Illinois to grant BP’s motion to dismiss Simonian’s complaint with leave to amend pursuant to the pleading requirements described in the opinion.

The full text of the case can be found [here](#).

Tags: [Design Patents](#), [False Marking](#)

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PROTECTING DESIGNS

VW's Community Design Registration for New Beetle Invalidated

On February 2, 2011, VW's European Community design registration for its second-gen modernized VW Beetle, **Community Design no: 000111596-0001** ("CD'001"), was invalidated by the Invalidation Division of the **Office for Harmonization in the Internal Market** (OHIM), a European Union agency that oversees registration of trademarks and designs.



Figure 1 - Images from CD'001

AUTEC AG, a maker of toy car models, filed for a declaration of invalidity of VW's community design **000111596-0001** ("CD'001") on December 16, 2009, for lack of novelty and individuality. As evidence, AUTEC cited a VW beetle fan website that recounts the evolution of the "new Beetle" design from early 1991 to 1998, and argued that the "new Beetle" design was known to the public because, prior to registering CD'001, VW had shown the "new Beetle" at several major public car shows and units had been produced and shipped to the U.S. AUTEC then argued that comparing CD'001 and the known "new Beetle" design would acquaint the informed user of any differences between the designs, and that any

such differences would have been within the field of freedom of the designer in question, and, as such, invalidation of CD'001 would be appropriate under **CDR Article 6**.

VW countered by arguing that CD'001, which was registered on December 9, 2003, covered a second generation model of the "new Beetle" which was substantially different from the first generation and original concept models. In doing so, VW elaborated that its modern interpretation of the classic VW Beetle was developed in 1991 during a design study called "Concept 1," which then matured into a model called "Concept 1." Concept 1's design was registered with WIPO in 1994 (DM/030041). The first generation model of the "new Beetle" was developed based on "Concept 1," and its design was registered with WIPO in 1996 (DM/037400).

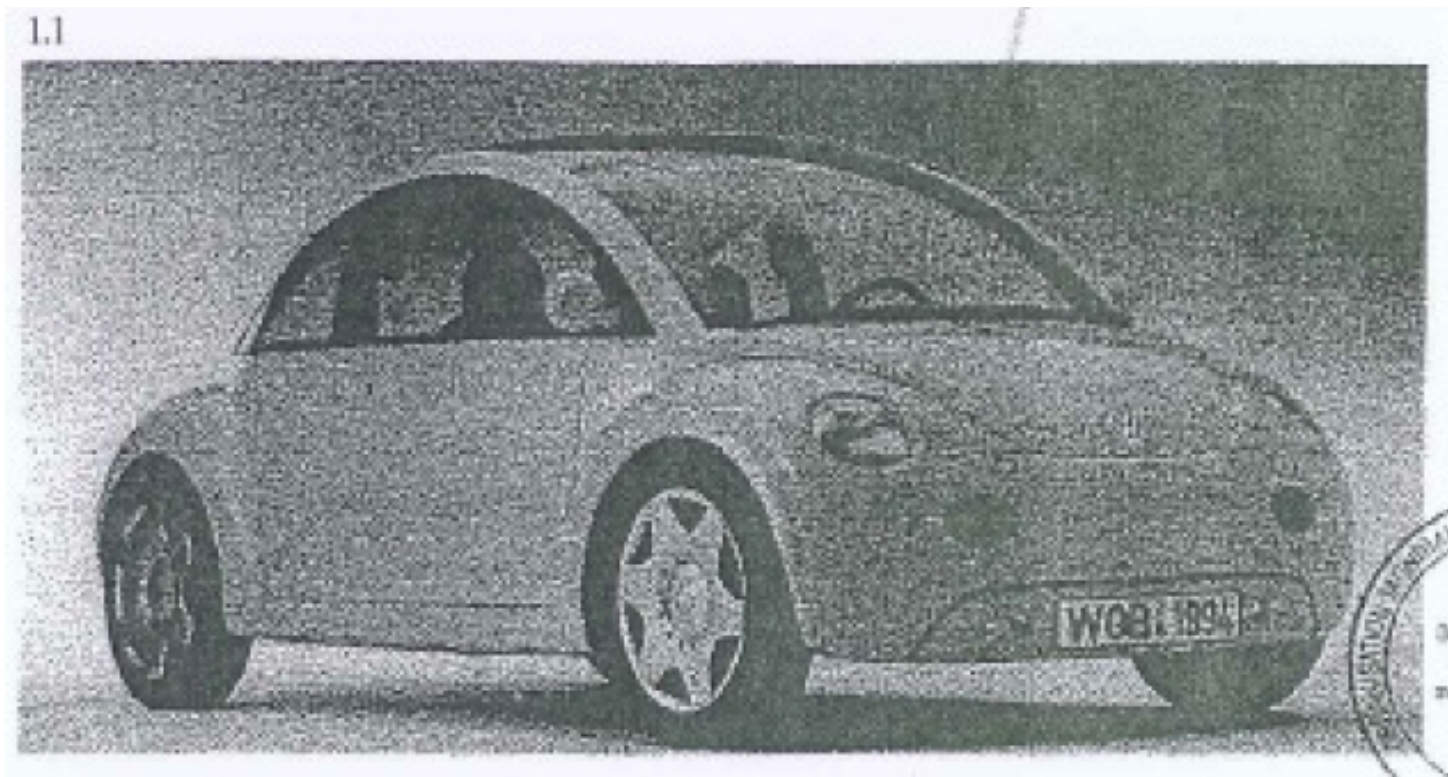


Figure 2 - Image from DM/030041

1.1



Figure 3 - Image from DM/037400

VW further noted that the second generation model of the “new Beetle” design wasn’t shown publicly until September 2005 (which is after the application for CD’001 was filed), when it was unveiled at the International Motor Show in Frankfurt. VW argued that this second generation model differed significantly from Concept 1 and the first generation model of the “new Beetle” for a number of different features including a wider fender, different tail lights, and a distinguished bumper. VW concluded that CD’001 met the individual character requirement because the informed user, who would have had experience with more expensive products like cars, would have perceived the details, and would have appreciated both the similarities and the differences between CD’001 and the prior registrations.

In rendering its decision, the Invalidity Division compared the features of CD’001 to the features of the international registrations and identified the differences between them. The Invalidity Division noted that the informed user would be familiar with vehicles and their function, and would grasp the restrictions on the freedom of a designer in designing vehicles. The Invalidity Division then stated that the differences falling within the field of freedom of the designer was not determinative of invalidity, noting that a designer can naturally only move within the context of his or her freedom. The Invalidity Division then weighed the similarities and differences between CD’001 and the prior international registrations and concluded that the differences did not shift the balance in favor of the differences, even in light of any increased attention by the informed user. The Invalidity Division then held that CD’001 and the prior registrations did not meet the individual character standard under Article 6 because they would have given the informed user the same overall impression, and ruled CD’001 invalid.

The individual character requirement under **Article 6** of the Community design regulation appears somewhat akin to the U.S. non-obviousness requirement under **35 U.S.C. § 103**. For example, under the individual character requirement, the Invalidity Division first considered the level of knowledge of the “informed user” prior to determining the overall impression the prior art designs had rendered on the informed user. Analogously, under § 103, as interpreted by the court in *In re Rosen*, **673 F.2d 388 (C.C.P.A. 1982)**, the proper standard for obviousness is whether the design-in-suit would have been obvious to a designer of ordinary skill of the articles involved, which initially requires the court to look to the knowledge of

the “ordinary designer.”

However, there are subtle differences between the individual character standard and § 103 when evaluating prior art. For example, In considering what overall impression publically available prior designs would give the informed user under the individual character standard, the Invalidity Division compared CD'001 to the prior WIPO registrations (DM/030041 & DM/037400) so as to ascertain the similarities and differences between them, and then weighed whether these differences would distinguish the CD'001 over the similarities found between CD'001 and the prior WIPO registrations. In contrast, when evaluating prior art under § 103, as provided by *In re Rosen*, the claimed design, viewed as a whole, must be compared to a reference that has basically the same design characteristics as the claimed design and, in light of such a reference, it must be determined whether the claimed design would have been obvious to the ordinary designer.

Tags: [Community Designs](#), [Invalidation](#)

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PROTECTING DESIGNS

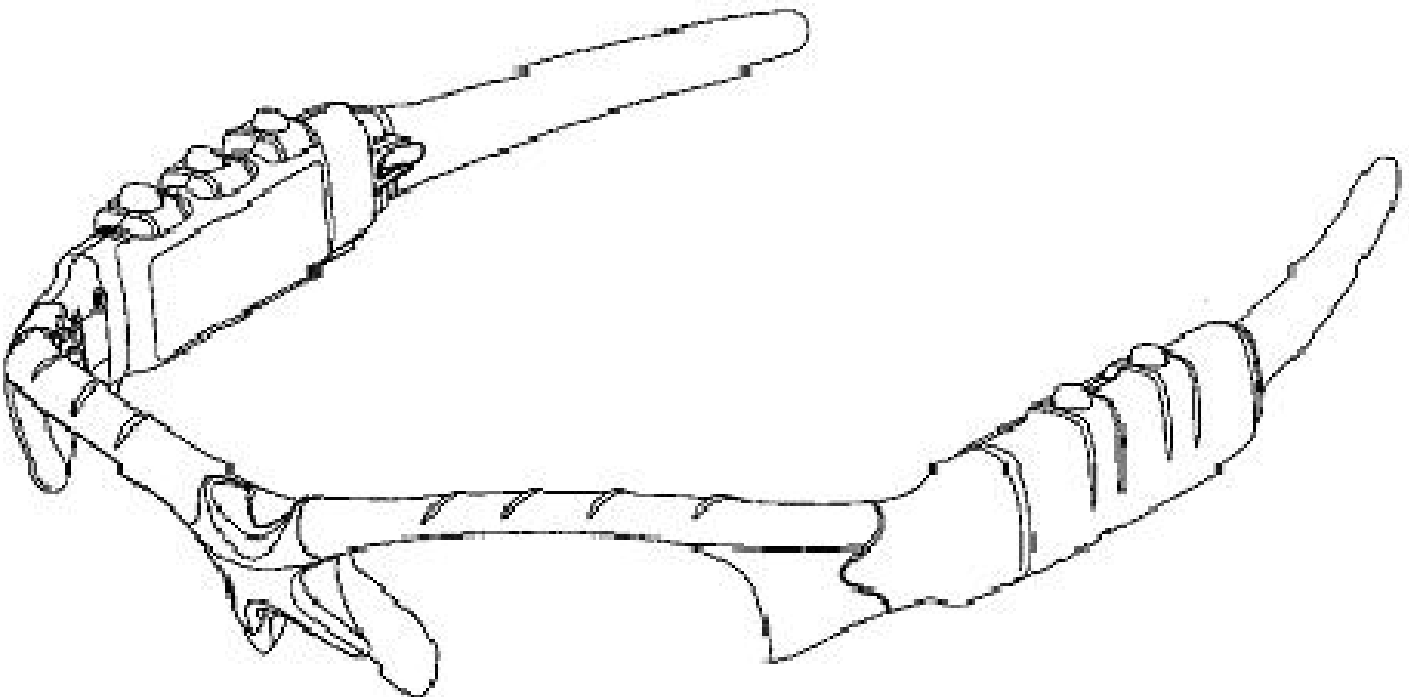
Predator Outdoor Products, LLC v. Oakley, Inc.

On March 21, 2011, Predator Outdoor Products, LLC (“Predator”) filed suit against Oakley, Inc. (“Oakley”) in the U.S. District Court for the Eastern District of Pennsylvania. Predator’s Complaint seeks a declaratory judgment that Predator does not infringe any valid claim of U.S. patent no. 5,387,949 (“the ‘949 patent”) or U.S. D523,461 (“the D461 patent”).

Predator filed suit after receiving a letter from Oakley asserting that Predator’s i-Kam Extreme products infringe the ‘949 and D461 patents. Oakley’s letter further demanded that Predator “immediately cease” infringing the patents, demanded an accounting for the sales of all allegedly infringing products, and enclosed a draft Complaint against Predator.

This case provides another example of a patent holder obtaining design and utility patent protection on a product and then asserting both the design and utility patents against a competitor. The case further illustrates that an assertion of a design patent can give rise to a declaratory judgment action as with the assertion of a utility patent.

For reference, Fig. 1 of the D461 patent and one of the commercially available i-Kam Extreme glasses is shown below:



D461 Fig. 1



i-Kam Extreme

Tags: [Design Patents](#), [Utility Patents](#)

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PROTECTING DESIGNS

Garmin Ltd. v. Bryton Inc.

Garmin filed suit against Bryton in a Kansas federal court, claiming that Bryton devices for cycling enthusiasts infringe design and utility patents held by Garmin. The design patent in suit is U.S. Patent No. D632,984 (hereinafter “the ‘984 patent”) and is titled “Electronic Device.” Figure 1, which is a front perspective view, and Figure 2, which is a rear perspective view, of the ‘984 patent are reproduced below.

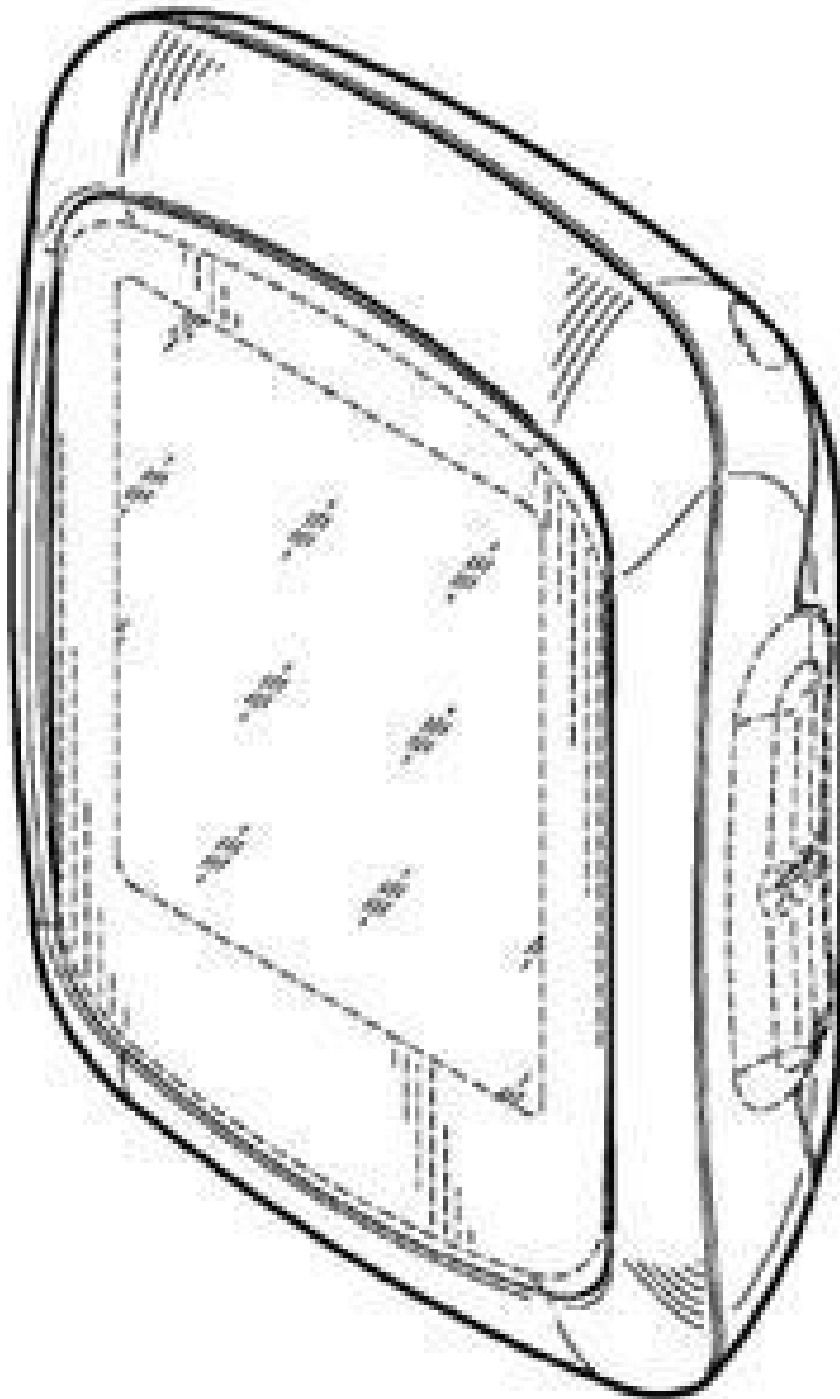


Fig. 1

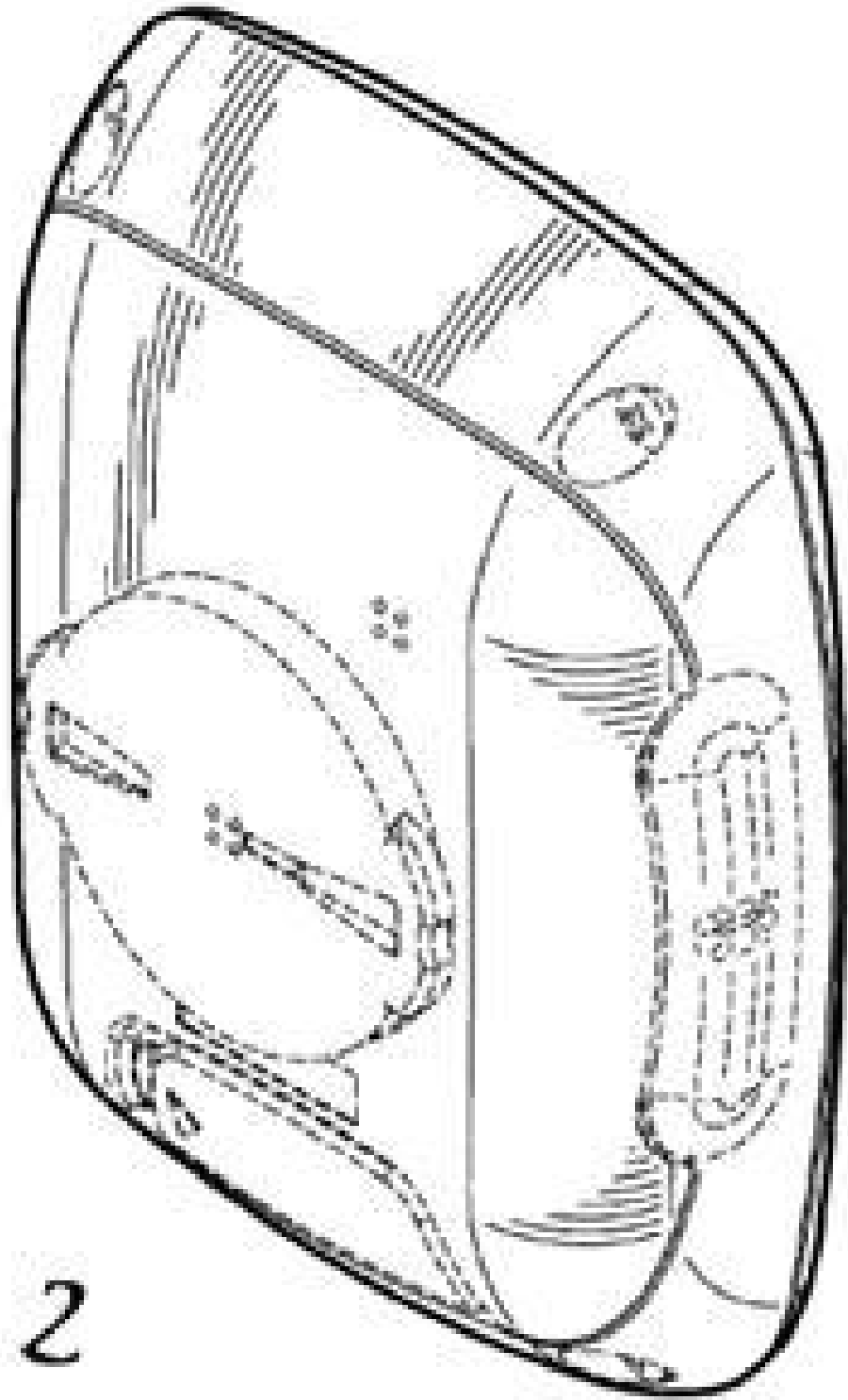


Fig. 2

Bryton's accused products include the Rider 30 cycling computer and the Rider 50 cycling computer, which are shown below.



In the complaint, Garmin asks the court for a preliminary injunction against Bryton, blocking the sale of the company's products in the U.S.

Tags: [Design Patents](#)

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PROTECTING DESIGNS

Chrysler's ITC Complaint alleging Design Patent Infringement of a Concept Vehicle Results in Settlement, Cease and Desist Orders

Chrysler's ITC Complaint alleging Design Patent Infringement of a Concept Vehicle Results in Settlement, Cease and Desist Orders and Limited Exclusion Orders

[See our posting on the ITC 337 Law Blog of March 16, 2011.](#)

The Jeep Hurricane is a 4x4 concept vehicle which was unveiled at the North American International Auto Show in Detroit, Michigan in 2005, by Jeep, a division of Chrysler Group LLC. Chrysler obtained U.S. Design Patent No. D513,395 (the '395 patent) on January 3, 2006, which is directed to an automobile body corresponding to the Jeep Hurricane.

Chrysler filed a 337 complaint in the ITC regarding certain automotive vehicles on May 14, 2010 ([see our ITC 337 Law Blog posting of May 18, 2010](#)), and the ITC instituted an investigation (337-TA-722) regarding certain automotive vehicles on June 11, 2010 ([see our ITC 337 Law Blog posting of June 15, 2010](#)).

On October 12, 2010, Chrysler and respondents including Xingyue Group Co., Ltd. filed an amended joint motion to terminate the pending investigation on the basis of a consent order, and the ALJ issued an order on October 27, 2010, granting the joint motion for termination. The joint motion to terminate was based on a settlement agreement these respondents will not import, sell, etc. the accused XYJK800 vehicle manufactured by Xingyue, which was alleged to infringe the '395 patent.

On October 29, 2010, Chrysler filed declarations requesting immediate relief against the then defaulting respondents (Vehicles Online, Inc. and Shanghai Tandem). Having determined that the statutory requirements were met, the ITC issued a notice ordering relief on March 10, 2011.

The relief included (1) cease and desist orders against Vehicles Online, Inc. and Shanghai Tandem concerning automotive vehicles and designs therefor that infringe the '395 patent, and (2) a limited exclusion order prohibiting unlicensed entry of automotive vehicles and designs therefor that infringe the '395 patent, which are manufactured abroad or imported by or on behalf of Shanghai Tandem (namely, the accused Tandem TDUV800-2). Since no other issues remained pending, the ITC terminated the investigation.

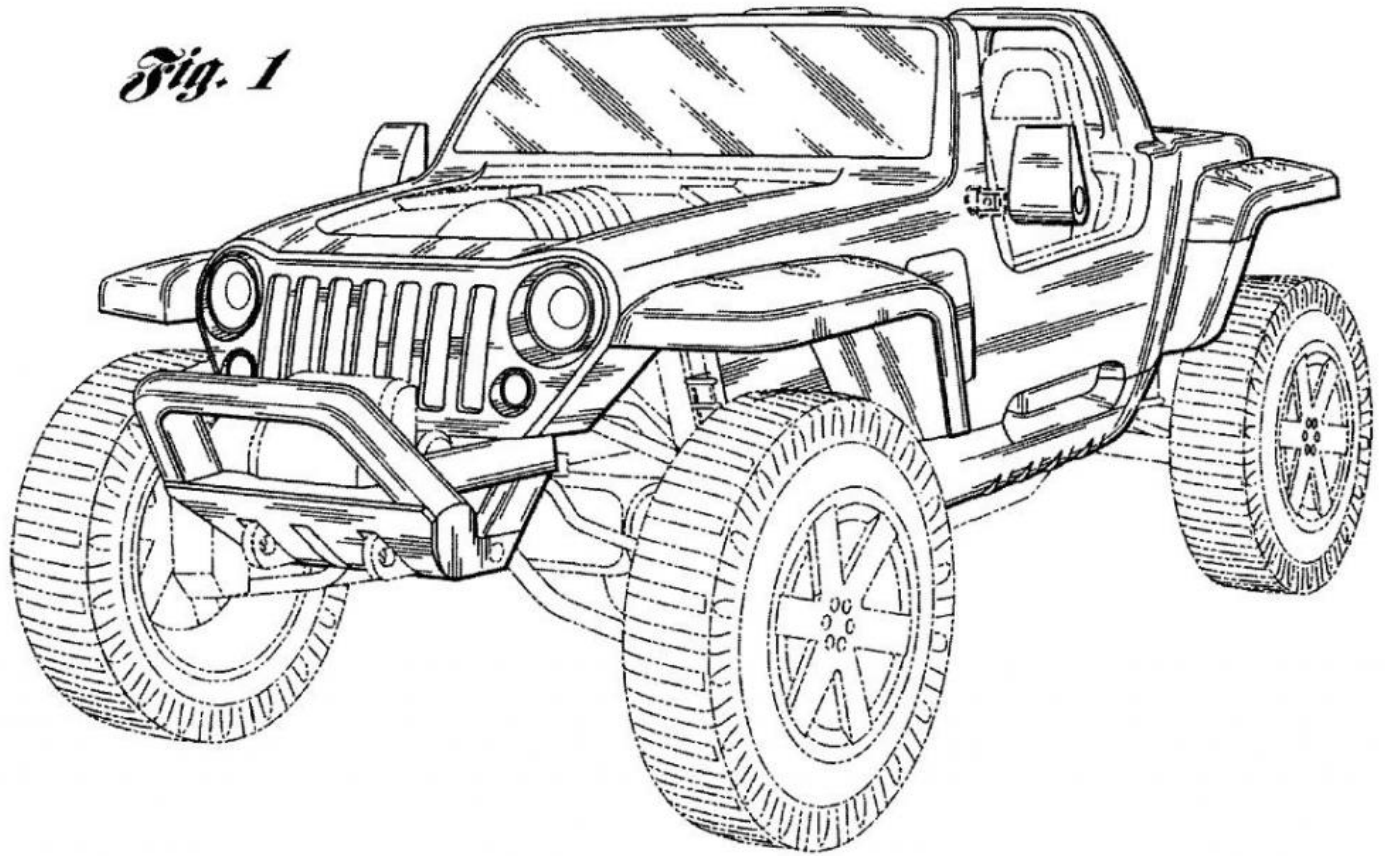


Figure 1 of U.S. D513,395



Jeep Hurricane (www.jeep.com)



Alleged Infringer Xingyue XYJK800 ([source](#))

Alleged Infringer Tandem TDUV800-2 ([source](#))

Tags: [Design Patents](#), [ITC](#)

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PROTECTING DESIGNS

Bell Helicopter Awarded Large Judgment Against No-Show Defendant

Bell Helicopter was recently awarded \$22.5 million in a trade dress infringement suit against the government of Iran. Judge Urbina, writing for the U.S. District Court for the District of Columbia, handed down the award two years after entering a default judgment against the government of Iran. Iran failed to respond to Bell's complaint or enter an appearance in court, resulting in the default judgment.

Bell's trade dress suit related to helicopter designs which were also protected, in part, by three design patents: D388,048, D375,077 and D363,054. Iran was accused of manufacturing at least thirteen counterfeit helicopter designs beginning in 2001 and promoting the counterfeit helicopters at an air show held annually in Iran. Although two of the design patents in question have expired, Bell succeeded in its claim for trade dress infringement by demonstrating to the satisfaction of the court that its helicopter designs are inherently distinctive and have acquired secondary meaning since being first introduced in 1966. The court also agreed with Bell that Iran's designs are "confusingly similar" to that of Bell and that Bell's designs are non-functional and ornamental. See Opinion, at page 6.

In several recent opinions involving design patents, judges have articulated why and how a claimed design is similar to an accused design, including reasons for why particular features were considered functional or non-functional. In these cases, courts being have found many features of a design to be functional. See, for example, **Richardson v. Stanley Works, 597 F.3d 1288 (Fed. Cir. 2010)**. Although the functionality analysis performed by judges can be different for trade dress claims as compared to design patent claims, in this case, perhaps because of Iran's failure to answer or present any counter-evidence, the court did not perform any functionality analysis or find any features of Bell's helicopter design to be functional. The opinion also contains no side-by-side or element-by-element comparisons of the competing designs to support the finding that the designs are confusingly similar.

The District Court's opinion can be found at: https://ecf.dcd.uscourts.gov/cgi-bin/show_public_doc?2006cv1694-17

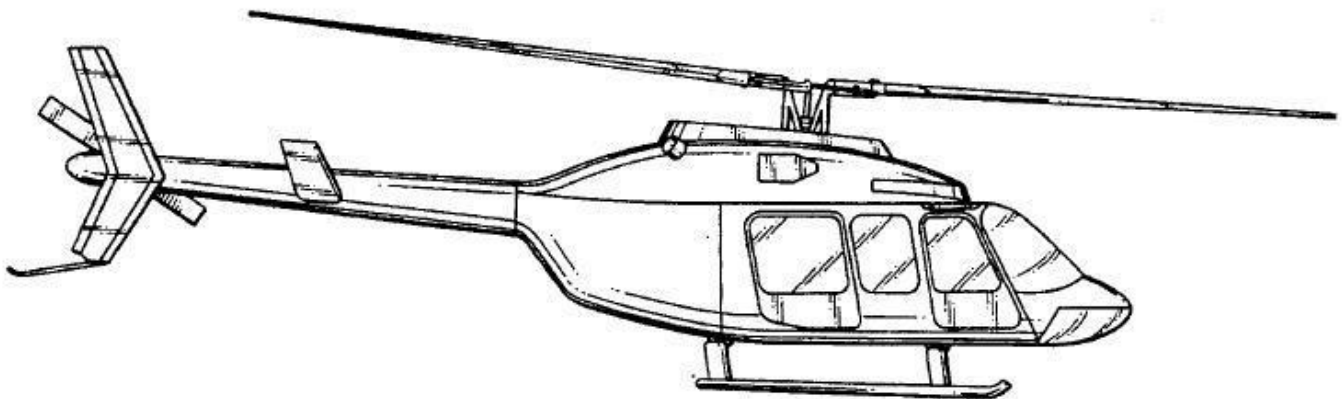


Fig. 1 of U.S. Design Patent No. D375,077

Tags: [Design Patents](#)

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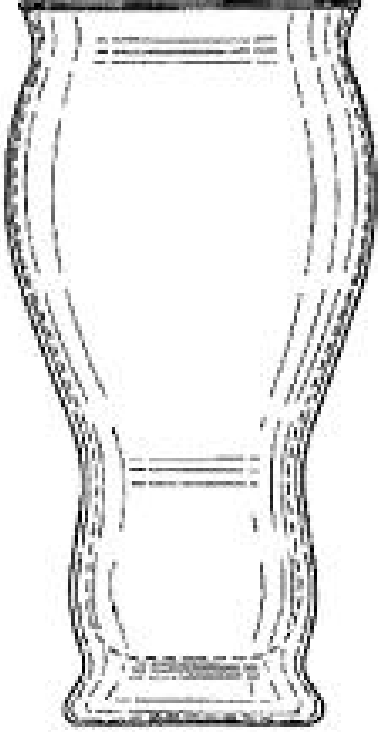

PROTECTING DESIGNS

Sam Adams Brewer Asks ITC To Block Beer Glasses

As reported on Oblon, Spivak's [ITC Blog](#), Boston Beer Corporation ("Boston Beer") filed a [complaint](#) requesting that the ITC commence an investigation pursuant to Section 337.

Boston Beer, which is a subsidiary of the brewer of Samuel Adams beer, alleges that 1 Source Signature Glassware, Inc., di Sciacca Co., and San Tan Brewing Co. (collectively, the "Proposed Respondents") — all of Chandler, Arizona — unlawfully import into the U.S. and/or sell within the U.S. after importation certain glassware that infringes U.S. Patent Nos. D582,213 and D569,189 (collectively, the "asserted patents").

The following is a comparison from the complaint of the San Tan glassware that is alleged to infringe U.S. Patent Nos. D582,213 and D569,189.

U.S. PATENT NO. D569,189	ACCUSED 'SAN TAN' GLASSWARE
 <p data-bbox="370 1025 495 1064">FIG. 1</p>	

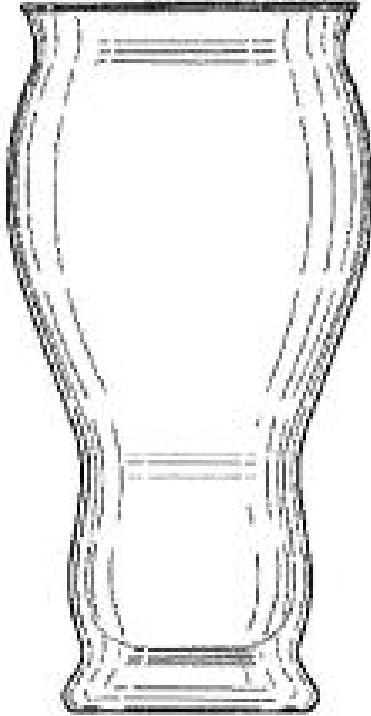

U.S. PATENT NO. D582,213	ACCUSED 'SAN TAN' GLASSWARE
	

FIG. 1

Tags: Design Patents, ITC

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PROTECTING DESIGNS

Design Patents and False Marking

The false marking statute ([35 U.S.C. § 292](#)) expressly authorizes members of the public to bring an action on behalf of the U.S. government (i.e., a *qui tam* action) for a product falsely marked with a patent number with the intent of deceiving the public. Theoretically, the penalty for falsely marking a product can be a hefty one as the false marking statute allows the court to assess a sanction of up to \$500 for every offense. The Federal Circuit in *Bon Tool* held in late 2009 that “offense” means on a per article basis. Ever since the *Bon Tool* decision, the number of false-marking lawsuits has surged because of the economic windfall that might result from mass-produced, falsely marked products. Products marked with design patent numbers are not exempt from such actions.

One recent [complaint](#) filed by Main Hastings against the Village Company in the Eastern District of Texas alleges the Village Company violated § 292 by marking a Mr. Bubble bottle with design patent no. D-408,290 (“the ‘290 patent”). Specifically, Main Hastings alleges that the Village Company marked the Mr. Bubble bottle knowing that that the ‘290 patent does not cover the ornamental design of the Mr. Bubble bottle. In Exhibit B of the complaint, Main Hastings sets forth a comparative analysis between two Mr. Bubble bottles and Figure 2 of the ‘290 patent to demonstrate the alleged false marking. Included below are images from the second comparison of Exhibit B of Main Hastings’ complaint.

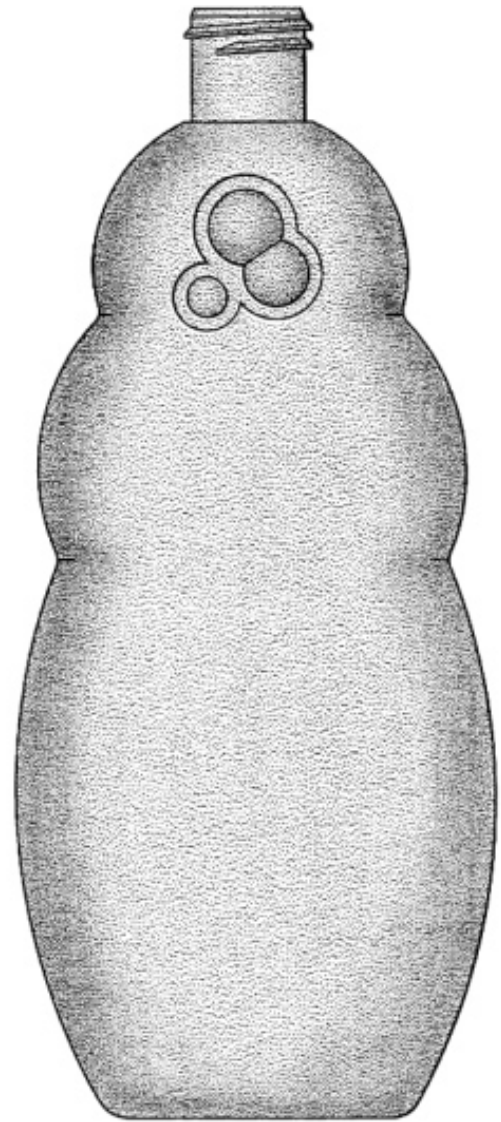


FIG. 2

Main Hastings, LLC v. The Village Company, LLC is not an isolated case. A **recent search** has shown that, in 2010 alone, 674 false-marking lawsuits were filed in federal district court, which is a dramatic increase over previous years. This surge in false marking cases largely involves trolling plaintiffs who initiate lawsuits based on products labeled with expired patent numbers, but can also involve the more traditional false marking case where the marked product is allegedly not covered by the patent listed in the mark, like the *Main Hastings* case discussed above. See ***Simonian v. Weber-Stephen Products Co.*** for an example of a case involving products allegedly marked with expired design patent numbers.

A legal remedy to address this recent barrage of false-marking cases may be on the horizon. On February 23, 2011, Federal District Court Judge Dan Aaron Polster of the Northern District of Ohio found the *qui tam* provision of § 292 to be unconstitutional. **In the opinion**, Judge Polster held that, because “the government lacks sufficient control to enable the President to ‘take Care that the Laws be faithfully executed,’ . . . the False Marking statute lacks any of the statutory controls necessary to pass Article II Take Care Clause muster.” However, it remains to be seen whether Judge Polster’s opinion will be upheld on appeal, as **other district court precedent** has found the *qui tam* provision of § 292 to be

constitutional based on a number of factors including the legislative history of *qui tam* statutes in the U.S. and the U.S. government's ability to intervene as of right.

Congress has also taken up the issue. The U.S. Senate is now debating the **Patent Reform Act of 2011** (S.23.RS) and the U.S. House of Representatives recently conducted a hearing on the issue of comprehensive patent reform and a bill corresponding to S.23.RS will likely be introduced in the House soon. S.23.RS specifically amends the *qui tam* provision of § 292 to require that plaintiffs show competitive injury caused by the false marking. For plaintiffs other than the U.S. government, the level of damages would change from the current "\$500 per article" standard to a level that is "adequate to compensate for the injury." S.23.RS also includes a statute of limitations provision that limits false marking cases to the earlier of 10 years after the alleged misconduct or one year after the plaintiff in such a case is informed of the misconduct. In addition to the above-noted legislation, the **Patent Lawsuit Reform Act of 2011** (H.R.243), which is a stand-alone bill and not part of a larger patent reform package, was recently introduced in the U.S. House of Representatives. H.R.243 also amends the *qui tam* provision of § 292, but unlike S.23.RS, H.R.243 limits recovery in false-marking lawsuits to a total of \$500.

However, given Congress' inability to pass patent reform legislation in previous sessions (various forms of the Patent Reform Act have been introduced in Congress every year since 2005), it is uncertain whether legislation that addresses the current exploitation of § 292 will pass during this year's congressional session. For more information on U.S. patent reform, the following resources from Oblon Spivak are available. **Philippe Signore** and **Steve Kunin** will be presenting on the state of U.S. patent reform at the **5th Annual Patent Law Institute** on March 21 and 22, 2011, and an article based on their presentation will be published in Chapter 14 of the **Institute's Course Handbook**. Additionally, updates on the progress of patent reform are frequently published on **Patents Post Grant**, a blog maintained by Oblon, Spivak's **Reexamination/Reissue Practice Group**.

Tags: [Design Patents](#), [False Marking](#)

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PROTECTING DESIGNS

Patentability of Bank of America Corp.'s Design Patent Affirmed

As reported in Oblon Spivak's [Patents Post-Grant blog](#), the U.S. Court of Appeals for the Federal Circuit affirmed the patentability of Bank of America Corp.'s design patent for a miniature credit card, agreeing that a patent examiner erred in initially rejecting the patent claim as obvious. The decision was made without explanation.

A discussion of the *inter partes* reexamination that led to the Federal Circuit appeal can be found [here](#).

Tags: [Federal Circuit](#), [Obviousness](#), [Post-grant Review](#)

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PROTECTING DESIGNS

Fashion Design Bill Approved for Consideration by U.S. Senate

New protections for fashion designs may be on the horizon, as the Judiciary Committee has approved a modified version of the **Innovative Design Protection and Piracy Prevention Act** (the IDPPPA) for consideration by the Senate. The IDPPPA would amend § 1301 *et seq.* of the copyright statute (Title 17) to include provisions expressly protecting fashion designs. Presently, Title 17 is limited to protecting the design of a vessel hull, which is defined as the frame or body of a vessel, including the deck.

The IDPPPA is being advocated as necessary to address the problem of piracy in the fashion design world. Several well-known fashion designers, the Council of Fashion Designers of America, and the American Apparel and Footwear Association have **thrown their weight behind the IDPPPA**, with the Council of Fashion Designers hosting a website called **www.stopfashionpiracy.com** to promote and track its progress.

Some notable protections that the IDPPPA would afford include:

- protecting the appearance as a whole of an article of apparel, including its ornamentation;
- requiring that the fashion design be (i) the result of a designer's own creative endeavor; and (ii) provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles;
- expressly protecting qualifying men's, women's, or children's clothing, including undergarments, outerwear, gloves, footwear, and headgear; handbags, purses, wallets, duffel bags, suitcases, tote bags, and belts; and eyeglass frames;
- establishing an infringement standard by defining the term "substantially identical" as meaning an article of apparel which is so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial;
- providing a three year statutory bar for public disclosure and a three year protection term;
- providing a "home sewing exception" that allows a person to produce a single copy for personal use or for use of an immediate family member;
- not requiring registration of fashion designs, but instead providing protection once the fashion design is first made public; and
- requiring a claimant who brings an action for infringement to plead certain facts with particularity.

However, protection appears to extend only to the actual fashion design articles, and not advertisements or illustrations of those articles.

Passage of the IDPPPA would represent a significant change in the U.S. for the protection of fashion designs. We will keep a close eye on the progress of this proposed legislation.

Tags: [Fashion Designs](#), [Legislation](#)

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