



# PROTECTING DESIGNS

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## Patent Law Treaties Implementation Act of 2012

S. 3486 (the "Act") has passed the House and the Senate, and awaits signature by the President.

The summary of this Act reads, with emphasis added:

*Amends federal patent law to implement the Geneva Act of the Hague Agreement Concerning the **International Registration of Industrial Designs (Hague Treaty)** and the Patent Law Treaty. (Both treaties were ratified by the Senate on December 7, 2007.) Standardizes application procedures to be consistent with other member countries.*

Of note:

- 1) The Act will amend 35 USC 173 to change the term of a design patent from 14 years to 15 years from the date of issuance.
- 2) The Act will add 35 USC 381-390, of which 390 provides for the publication of the international design application, and will amend 35 USC 154(d) to expand Provisional Rights to a published international design application.
- 3) Under the Hague Agreement and the Geneva Act, [WIPO states](#) the "international application may include up to 100 different designs. All designs must, however, belong to the same class of the International Classification of Industrial Designs (the [Locarno Classification](#))." Although not specifically set forth in the Act, it is expected that International Design Applications filed under this Act will also be able to be filed with up to 100 different designs belonging to the same Locarno Classification.

**Tags:** [Design Patents](#), [Geneva Act](#), [Hague Agreement](#)

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## Apple v. Samsung: The UK

As we [previously posted](#), Judge Birss ordered Apple to publish a notice on its website for six months, as well as in several newspapers and magazines, that the Samsung Galaxy tablets do not infringe Apple's designs, to "correct the damaging impression" that Samsung copied Apple's product.

On October 18, 2012, the Court of Appeal [affirmed Judge Birss](#). Of note, the judgment stated:

Because this case (and parallel cases in other countries) has generated much publicity, it will avoid confusion to say what this case is about and not about. **It is not about whether Samsung copied Apple's iPad.**

Infringement of a registered design does not involve any question of whether there was copying: the issue is simply whether the accused design is too close to the registered design according to the tests laid down in the law. Whether or not Apple could have sued in England and Wales for copying is utterly irrelevant to this case. If they could, they did not. Likewise there is no issue about infringement of any patent for an invention.

So this case is all about, and only about, Apple's registered design and the Samsung products. **The registered design is not the same as the design of the iPad. It is quite a lot different.** For instance the iPad is a lot thinner, and has noticeably different curves on its sides. There may be other differences - even though I own one, I have not made a detailed comparison. Whether the iPad would fall within the scope of protection of the registered design is completely irrelevant. We are not deciding that one way or the other. This case must be decided as if the iPad never existed.

As noted above, Apple was ordered to publish a notice on its website, which the Court of Appeal affirmed. The notice was recently [published on Apple's UK website](#).

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

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## Apple v. Samsung: ITC Initial Determination

On October 24, 2012, the ITC issued an "Initial Determination on Violation of Section 337," in Inv. No. 337-TA-796. In this case, Apple alleged Samsung had imported various infringing devices (smartphones and tablets) into the U.S.

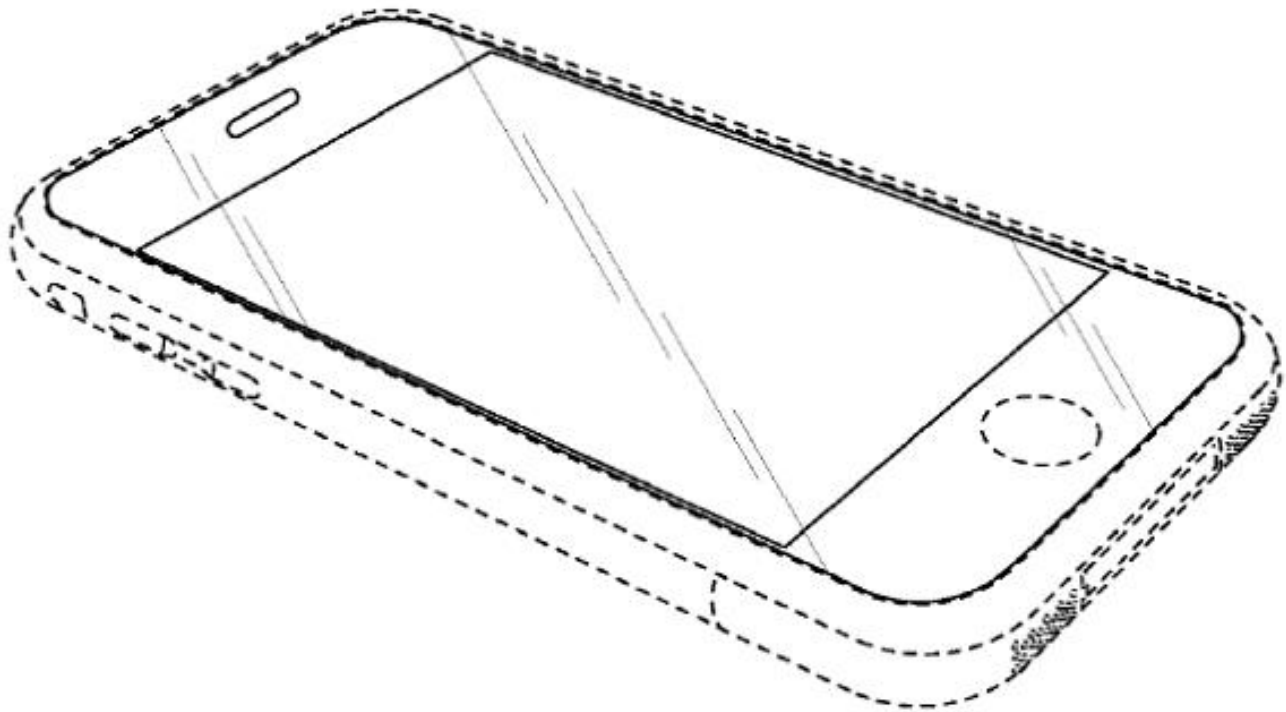
In summary, ALJ Tomas B. Pender determined that a violation of Section 337 of the Tariff Act of 1930 has been found in connection with several utility patents and U.S. Design Patent No. D618,678 (Fig. 1 of which is reproduced below). ALJ Pender also concluded that this patent is not invalid.

**U.S. Patent**

**Jun. 29, 2010**

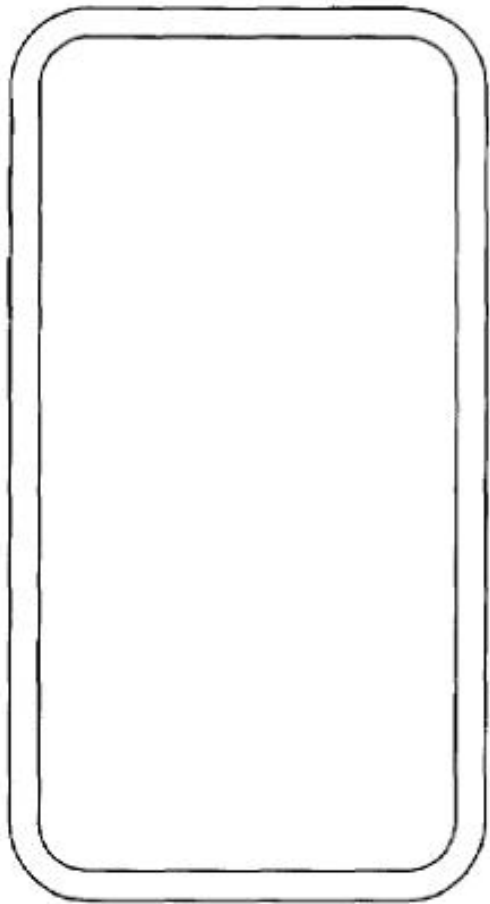
**Sheet 1 of 2**

**US D618,678 S**

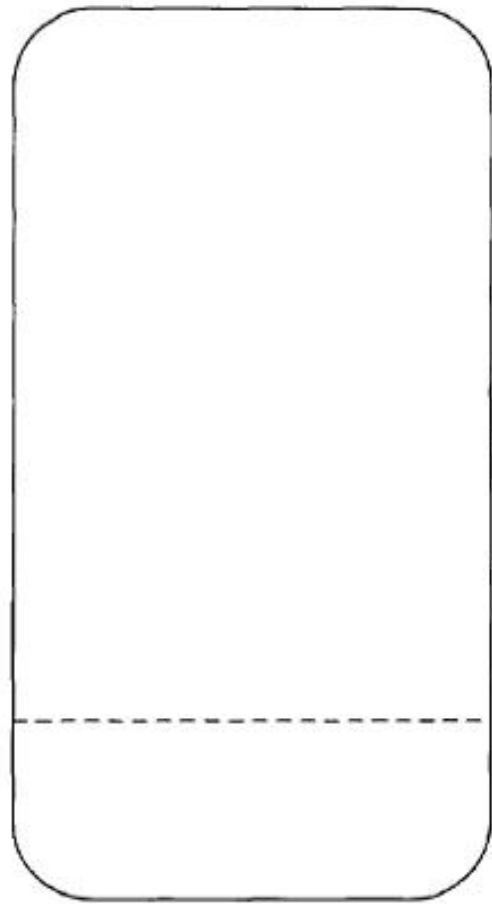


**FIG. 1**

ALJ Pender also determined that no violation of Section 337 was found in connection with U.S. Design Patent No. D558,757 (Figs. 3-4 of which is reproduced below), and concluded that this patent is not invalid.



**FIG. 3**



**FIG. 4**

**Tags:** Apple, Design Patents, ITC, Samsung

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# PROTECTING DESIGNS

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## Fashion Design Bill - Innovative Design Protection Act of 2012

The Senate Judiciary Committee has approved [S. 3523](#). The companion bill in the House, HR 2511, which was the subject of our [prior post](#) concerning the Innovative Design Protection and Piracy Prevention Act, is pending and has been referred to the Subcommittee on Intellectual Property, Competition and the Internet.

**Tags:** [Fashion Designs](#)

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# PROTECTING DESIGNS

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## Apple v. Samsung: Apple requests injunctions

Following the jury verdict, Apple has requested an injunction of seven Samsung phones based on design patent infringement of D677 and D305.

**Tags:** Apple, Design Patents, Injunction, Samsung

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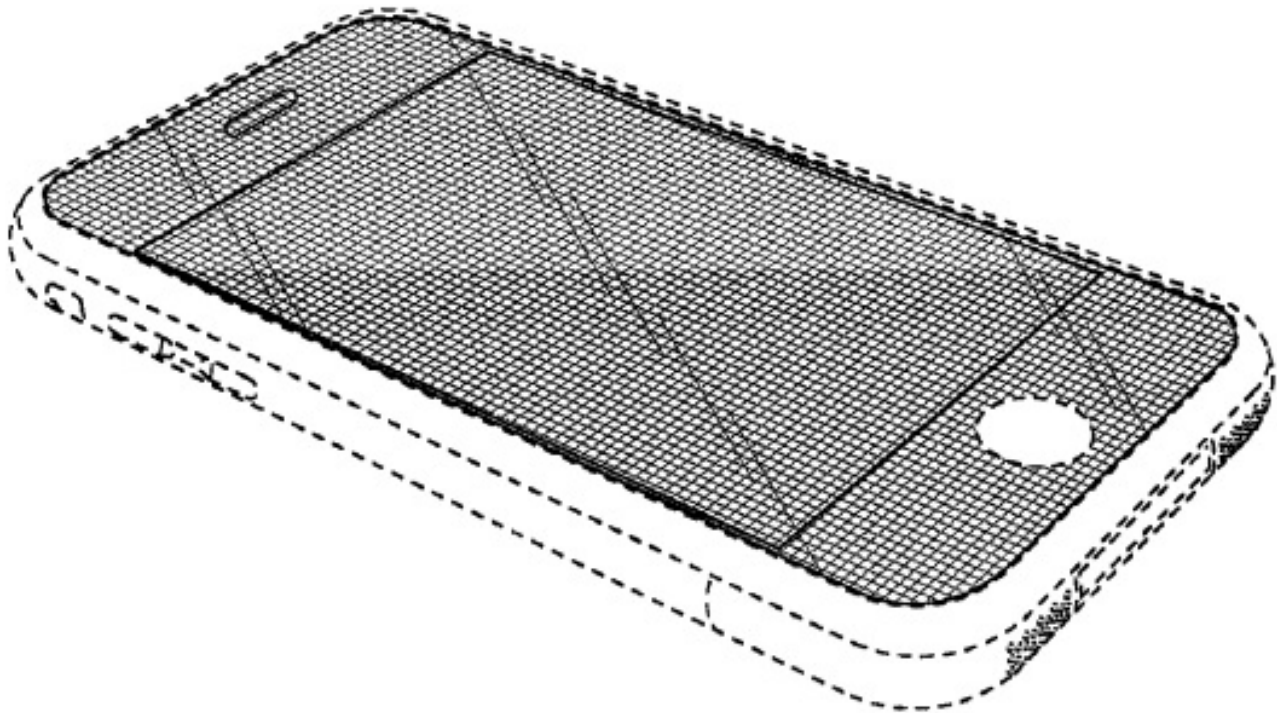


# PROTECTING DESIGNS

## Apple V. Samsung: Jury Verdict

Apple obtained a [\\$1.05 billion verdict](#) in the Northern District of California. The jury found that all of Apple's asserted patents were valid and enforceable. [CNET has posted a color graphic outlining the devices found to be infringing](#), which also includes the trade dress claims. As to infringement of the design patents, the jury found the following (from pp. 6-7 of the verdict).

### The [D667 patent](#):



**FIG. 1**

5. For each of the following products, has Apple proven by a preponderance of the evidence that Samsung Electronics Co. (SEC) and/or Samsung Telecommunications America (STA) has infringed the D'677 Patent?

(Please answer in each cell with a "Y" for "yes" (for Apple), or with an "N" for "no" (for Samsung). Do not provide an answer for any cell that is blacked out.)

Accused Samsung Product	Samsung Electronics Co., Ltd.	Samsung Telecommunications America, LLC
Fascinate (JX 1013)	Y	Y
Galaxy Ace (JX 1030)	N	
Galaxy S (i9000) (JX 1007)	Y	
Galaxy S 4G (JX 1019)	Y	Y
Galaxy S II (AT&T) (JX 1031)	Y	Y
Galaxy S II (i9100) (JX 1032)	Y	
Galaxy S II (T-Mobile) (JX 1033)	Y	Y
Galaxy S II (Epic 4G Touch) (JX 1034)	Y	Y
Galaxy S II (Skyrocket) (JX 1035)	Y	Y
Galaxy S Showcase (i500) (JX 1017)	Y	Y
Infuse 4G (JX 1027)	Y	Y
Mesmerize (JX 1015)	Y	Y
Vibrant (JX 1010)	Y	Y

6. For each of the following products, has Apple proven by a preponderance of the evidence that Samsung Electronics Co. (SEC) and/or Samsung Telecommunications America (STA) has infringed the D'087 Patent?

(Please answer in each cell with a "Y" for "yes" (for Apple), or with an "N" for "no" (for Samsung). Do not provide an answer for any cell that is blacked out.)

Accused Samsung Product	Samsung Electronics Co., Ltd.	Samsung Telecommunications America, LLC
Galaxy S (i9000) (JX 1007)	Y	
Galaxy S 4G (JX 1019)	Y	Y
Galaxy S II (AT&T) (JX 1031)	N	N
Galaxy S II (i9100) (JX 1032)	N	
Galaxy S II (Epic 4G Touch) (JX 1034)	N	N
Galaxy S II (Skyrocket) (JX 1035)	N	N
Infuse 4G (JX 1027)	N	N
Vibrant (JX 1010)	Y	Y



**The D305 patent:**

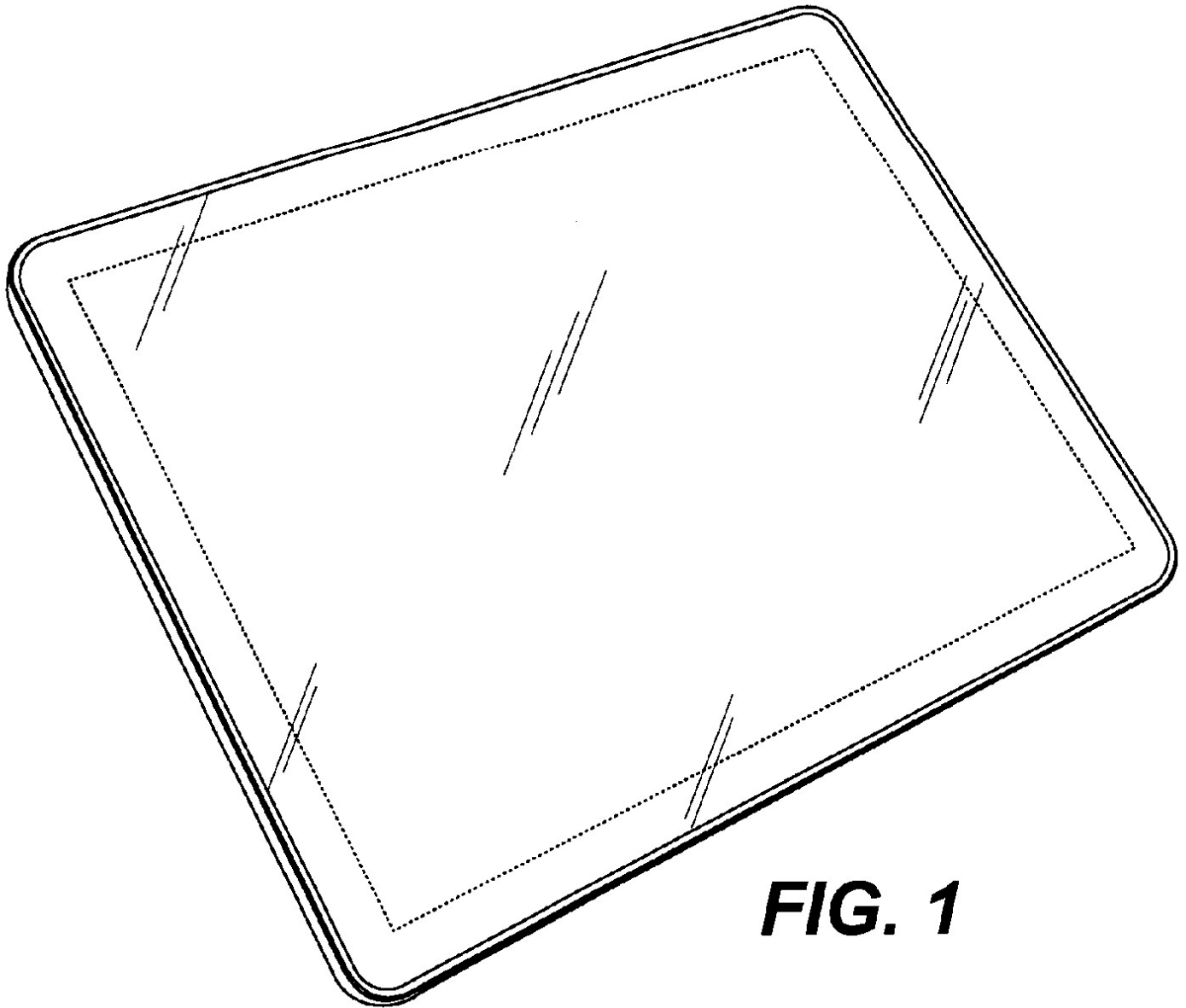


7. For each of the following products, has Apple proven by a preponderance of the evidence that Samsung Electronics Co. (SEC) and/or Samsung Telecommunications America (STA) has infringed the D'305 Patent?

(Please answer in each cell with a "Y" for "yes" (for Apple), or with an "N" for "no" (for Samsung). Do not provide an answer for any cell that is blacked out.)

Accused Samsung Product	Samsung Electronics Co., Ltd.	Samsung Telecommunications America, LLC
Captivate (JX 1011)	Y	Y
Continuum (JX 1016)	Y	Y
Droid Charge (JX 1025)	Y	Y
Epic 4G (JX 1012)	Y	Y
Fascinate (JX 1013)	Y	Y
Galaxy S (i9000) (JX 1007)	Y	
Galaxy S 4G (JX 1019)	Y	Y
Galaxy S Showcase (i500) (JX 1017)	Y	Y
Gem (JX 1020)	Y	Y
Indulge (JX 1026)	Y	Y
Infuse 4G (JX 1027)	Y	Y
Mesmerize (JX 1015)	Y	Y
Vibrant (JX 1010)	Y	Y

The D889 patent:



**FIG. 1**

8. For each of the following products, has Apple proven by a preponderance of the evidence that Samsung Electronics Co. (SEC), Samsung Electronics America (SEA), and/or Samsung Telecommunications America (STA) has infringed the D'889 Patent?

(Please answer in each cell with a "Y" for "yes" (for Apple), or with an "N" for "no" (for Samsung). Do not provide an answer for any cell that is blacked out.)

Accused Samsung Product	Samsung Electronics Co., Ltd.	Samsung Electronics America, Inc.	Samsung Telecommunications America, LLC
Galaxy Tab 10.1 (WiFi) (JX 1037)	N	N	
Galaxy Tab 10.1 (4G LTE) (JX 1038)	N		N

**Tags:** Apple, Design Patents, Samsung

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## Apple v. Samsung: Samsung records a win in the UK

Following Samsung's successful attempt for temporary relief from an injunction against their Galaxy Nexus smart phone, and Samsung's unsuccessful attempt for temporary relief from an injunction against their Galaxy Tab 10.1 tablet, see [Bloomberg](#), British High Court Judge Colin Birss has issued a [judgment](#) that at p. 39 states, with emphasis added:

The informed user's overall impression of each of the Samsung Galaxy Tablets is the following. From the front they belong to the family which includes the Apple design; but the Samsung products are very thin, almost insubstantial members of that family with unusual details on the back. They do not have the same understated and extreme simplicity which is possessed by the Apple design. ***They are not as cool.*** The overall impression produced is different.

...

***The Samsung tablets do not infringe Apple's registered design No. 000181607-0001.***

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

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# PROTECTING DESIGNS

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## Apple v. Samsung: The District Court responds to the CAFC decision

Further to the CAFC decision discussed in [our prior post](#), Judge Koh of the United States District Court for the Northern District of California has issued a preliminary injunction against the Samsung Galaxy Tab 10.1, based on the CAFC decision overruled the District Court's assessment of D'889. A copy of the order granting the preliminary injunction has been posted by [AllThingsD](#).

[Foss Patents](#) has reported that Samsung has appealed the order.

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

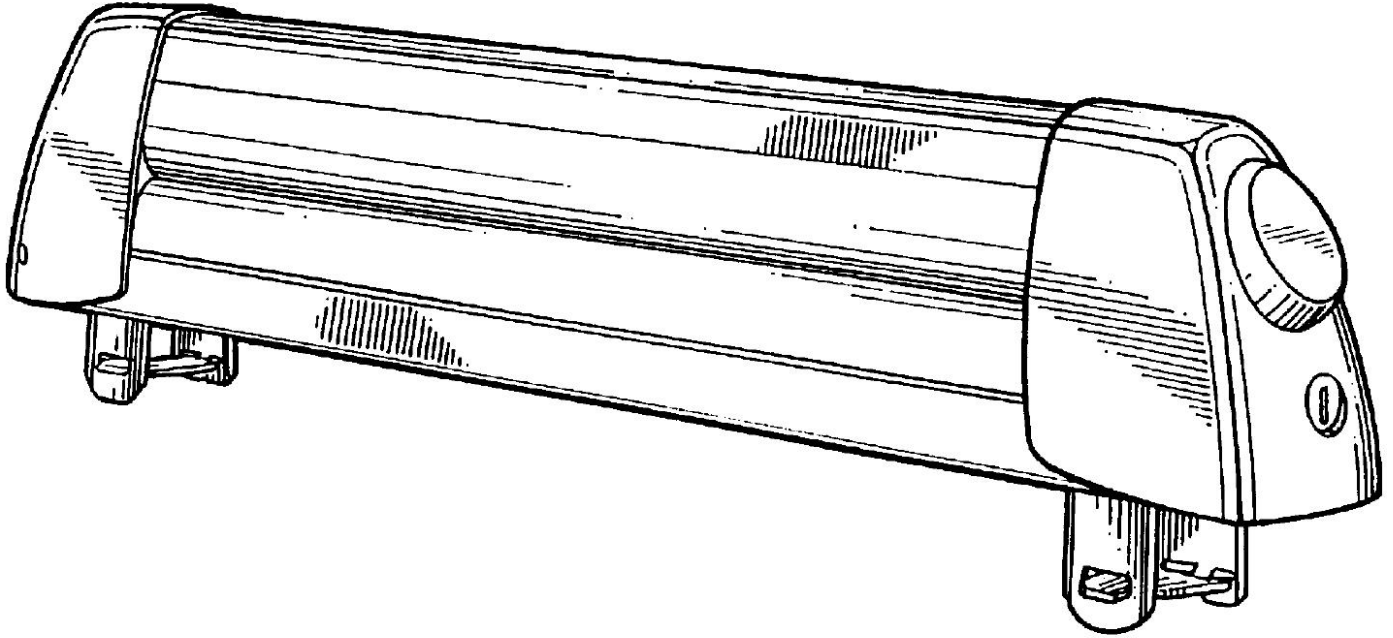
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# PROTECTING DESIGNS

## Thule files suit alleging infringement of auto roof rack design



Thule, Inc. and Thule Sweden AB filed suit against Stachura Holdings, LLC, and its subsidiaries, AtomixAuto and roofrackforcars.com, and Strona Industrial Inc. in the District of Connecticut alleging infringement of Thule's design and utility patents for automobile roof racks. The [complaint](#) alleges that the defendants infringe the plaintiffs' design patent, D415,096, which claims "the ornamental design for a ski-carrier for vehicles." A figure from the design patent at issue is shown to the right.

An image of Thule's 92726 Universal Pull Top Rack, taken from their [website](#) (last visited 06/12/2012), is shown below.



\*Jeremy Barton is a Summer Associate at Oblon Spivak.



**Tags:** [Design Patents](#)

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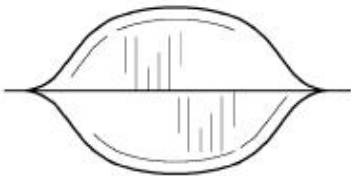
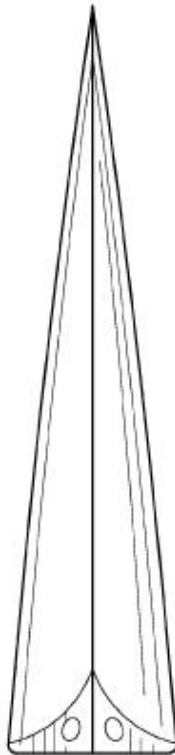
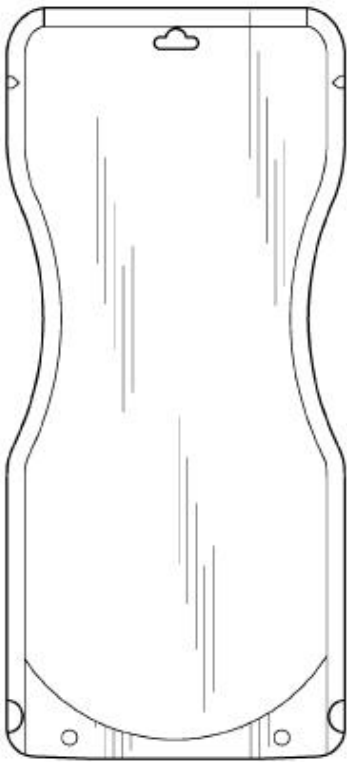


# PROTECTING DESIGNS

## Captain Morgan sued for beverage packaging design infringement

American Beverage Corp. (ABC) and Pouch Pac Innovations filed suit against Diageo and its subsidiary, the Captain Morgan Co., in the Western District of Pennsylvania alleging, *inter alia*, design patent infringement. The complaint alleges that the defendants infringe the plaintiffs' design patent, D571,672, which claims "the ornamental design for a flexible pouch." Figures from the design patent at issue are shown to the right.

An image of a commercial embodiment of the claimed design, as used for ABC's Dailey's Cocktails, is shown below (left) alongside the defendants' Parrot Bay Cocktail package (right), which is alleged to infringe the patented design.





Tags: Design Patents

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# PROTECTING DESIGNS

## Apple V. Samsung: CAFC Appeal Decision - The Dissent

Further to our [prior post concerning the recent CAFC Appeal Decision](#), on May 14, 2012, the Federal Circuit reversed and remanded the district court's decision to deny a preliminary injunction to plaintiff Apple for its design patent D504,889 for a tablet. The Federal Circuit affirmed the district court's decision denying a preliminary injunction with regard to two other design patents and a utility patent drawn to smartphones.

The dissent by circuit Judge O'Malley urged the majority to immediately enter a preliminary injunction for design patent D504,889. The majority remanded the decision to the district court to complete the analysis of the balance of the hardship factors and the public interest factors, which were only performed for the smartphone patents by the district court. The dissent argues that these factors favor Apple with respect to the tablet patent D504,889, and that this analysis should not be remanded to the district court, as the delay would further prejudice Apple. In particular, Judge O'Malley stated on p. 2 of the dissent that:

the majority's decision to remand this matter for further proceedings relating to the D'889 Patent is unwarranted because: (1) remand will cause unnecessary delay, which is inconsistent with the very purpose of preliminary injunctive relief; and (2) once we reject its validity analysis, the district court's decision, taken in its entirety, reveals that all of the prerequisites for preliminary injunctive relief are satisfied. Remand is particularly inappropriate where, as here, both this court and the district court agree that Apple will suffer irreparable harm absent injunctive relief. The majority's decision to remand for further proceedings will only exacerbate that harm.

Judge O'Malley emphasizes that injunctive relief is a "drastic remedy" and "exists for a reason to provide speedy relief from irreparable injury." Although Judge O'Malley acknowledges that the district court did not make any findings with regard to the balance of hardships and the public interest with respect to the tablet patent D504,889, Judge O'Malley argues that the record from the district court is complete and sufficient for determining that an injunction should be entered. Of note, Judge O'Malley at pp. 11-12 of the dissent states:

As this court has recognized, "[a]lthough the public interest inquiry is not necessarily or always bound to the likelihood of success o[n] the merits, . . . absent any other relevant concerns . . . the public is best served by enforcing patents that are likely valid and infringed." *Abbott Labs. v. Andrx Pharm., Inc.*, 452 F.3d 1331, 1348 (Fed. Cir. 2006). So too here, because the record at this stage shows that the D'889 Patent is likely valid and infringed, and there are no other relevant concerns, the public interest is best served by granting a preliminary injunction.

Concerning the balance of hardships requirement, Judge O'Malley states at p. 10 of the dissent that the balance of hardships weighs in Apple's favor because it has an interest in enforcing its patent rights. As we previously noted in our prior post, Samsung is rolling out the Galaxy Tab 2 10.1, which has a different bezel than the Galaxy Tab 10.1, and appears to be poised as a replacement in the marketplace. Below is an image from [Samsung's product page for the Galaxy Tab 2 10.1](#).



The design of the Samsung Galaxy Tab 2 10.1 is not identical to the Samsung Galaxy Tab 10.1N (see our prior post concerning the "Design Around" in Germany last year). Since the Samsung Galaxy Tab 2 10.1 appears to be poised as a replacement in the marketplace, the court may view the balance of hardships as weighing further in Apple's favor because Samsung has already "designed around" the tablet patent D504,889 (presuming the Samsung Galaxy Tab 2 10.1 does not infringe the tablet patent D504,889).

Edward Tracy contributed to this post.

**Tags:** Apple, Design Patents, Patent Infringement, Samsung

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# PROTECTING DESIGNS

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## Apple V. Samsung: CAFC Appeal Decision

In December, 2011, Apple appealed Judge Lucy Koh's denial of a preliminary injunction in the pending lawsuit in the U.S. District Court for the Northern District of California with respect to four Apple patents:

D618,677, which is alleged to be infringed by Samsung's Infuse 4G and Galaxy S 4G smartphones;

D593,087, which is alleged to be infringed by Samsung's Infuse 4G and Galaxy S 4G smartphones;

D504,889, which is alleged to be infringed by Samsung's Galaxy Tab 10.1; and

7,469,381, which is alleged to be infringed by all four products (the three mentioned above and the Droid Charge).

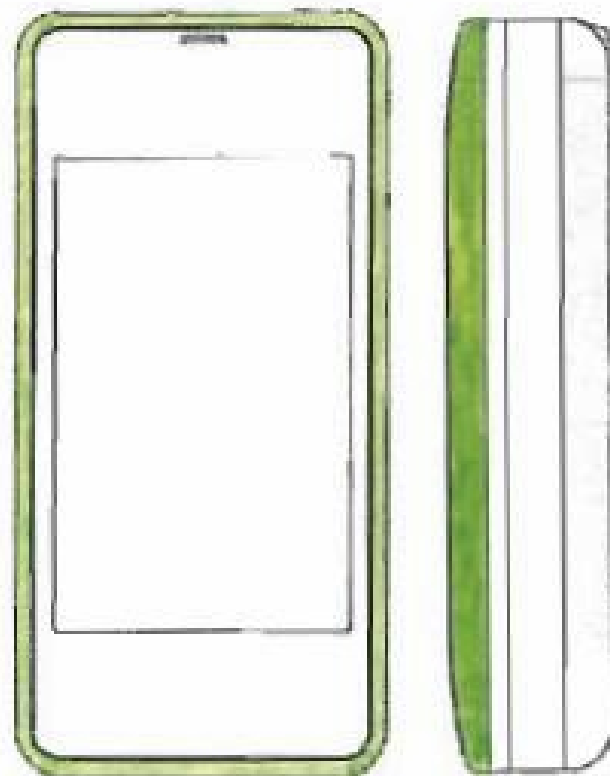
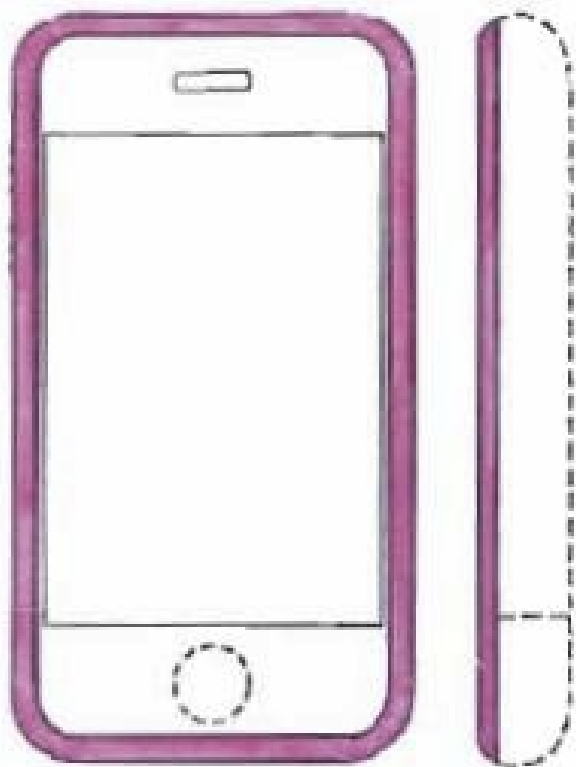
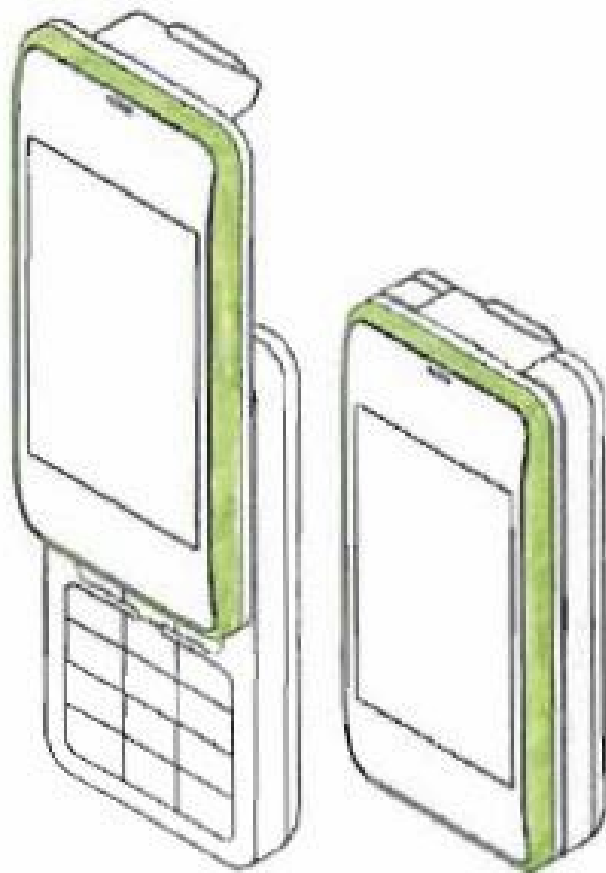
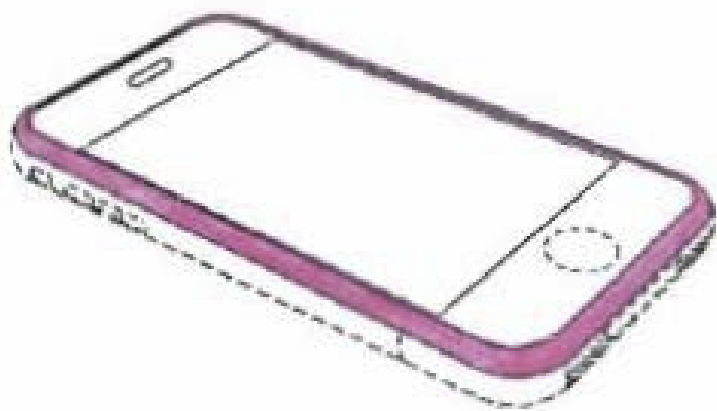
The CAFC ruled on the appeal from the denial of a preliminary injunction on May 14, 2012, providing a mixed bag of results for Apple and Samsung. This ruling follows oral arguments that took place on April 6, 2012.

As recited in the CAFC ruling on p. 15, "[a] plaintiff seeking a preliminary injunction must establish that he is likely to succeed on the merits, that he is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in his favor, and that an injunction is in the public interest," citing to *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 20 (2008). Also, as stated on pp. 15-16 of the CAFC ruling, "[t]he decision to grant or deny a preliminary injunction lies within the sound discretion of the district court, and we will not reverse its judgment absent an abuse of that discretion," citing to *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1375 (Fed. Cir. 2009).

In summary, the CAFC acknowledges the heavy burden on Apple to make the case to convince the district court to grant a preliminary injunction, and the even heavier burden with respect to reversing the district court's decision.

The district court relied on varying rationales for denying a preliminary injunction. However, a general theme in the opinion was Apple's failure to show irreparable harm (irreparable injury). In particular, the CAFC affirmed (at least in part) the district court's denial of an injunction based on irreparable harm with respect to the D'667, D'087 and '381 patents.

However, the CAFC rejected the district court's ruling that D'087 is likely anticipated by JP 1241638 (JP '638). Specifically, the opinion at p. 22 states, "[w]hen the claimed portion of the side view is taken into account, the differences between the arched, convex front of the '638 reference distinguish it from the perfectly flat front face of the D'087 patent," providing the following comparison image on p. 23:



**D'007 Patent**

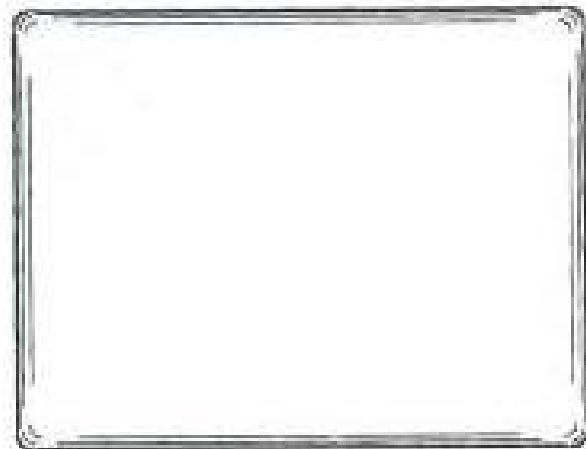
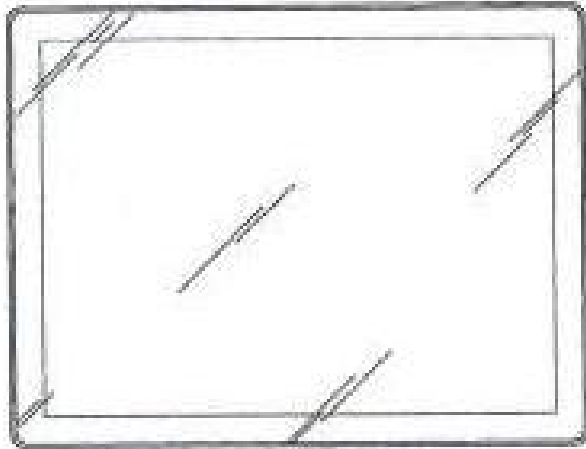
**ID '620 Patent**

D 007 Patent

JP 030 Patent

Concerning D'889, the district court concluded the irreparable harm requirement had been satisfied, but denied injunctive relief because Apple had failed to establish a likelihood of success on the merits. The CAFC disagreed with the district court, stating on p. 28 of the ruling that the relied on reference "Fidler" provided "a very different impression from the 'unframed' D'889 design." The following image was provided on p. 28 of the ruling.

## D504,889



## 1994 Fidler



Regarding the status of a preliminary injunction based on D'889, a determination as to the balance of hardships and the public interest was remanded to the district court.

There are several important items to take away from the CAFC ruling:

First: The CAFC ruling at pp. 16-17 states: "the district court was correct to require a showing of some causal nexus between Samsung's infringement and the alleged harm to Apple as part of the showing of irreparable harm." In the context of design patents, where only a portion of a product may be claimed, a nexus may be more difficult to show because consumer demand may be less likely driven by that particular claimed portion of the design, than by the overall design of the product. Nonetheless, Apple was still able to show the required nexus with respect to the alleged infringement of D'889.

Second: With respect to D'889, the district court may rule in favor of Apple and still grant a preliminary injunction with



respect to D'889. However, this may quickly become a moot issue because Samsung is rolling out the Galaxy Tab 2 10.1, which has a different bezel than the Galaxy Tab 10.1, and appears to be poised as a replacement in the marketplace.

Third: Apple's position concerning patent validity and infringement, at least concerning D'087 and D'889, is stronger.

Fourth: Irreparable harm is a requirement for a preliminary injunction - not for calculating damages and not a clear requirement for an exclusion order from the ITC (see [Dennis Crouch's post on this issue at PatentlyO](#)). Therefore, the lack of irreparable harm (or at least a showing thereof) does not indicate Apple has a weak position for obtaining significant damages or an exclusion order.

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

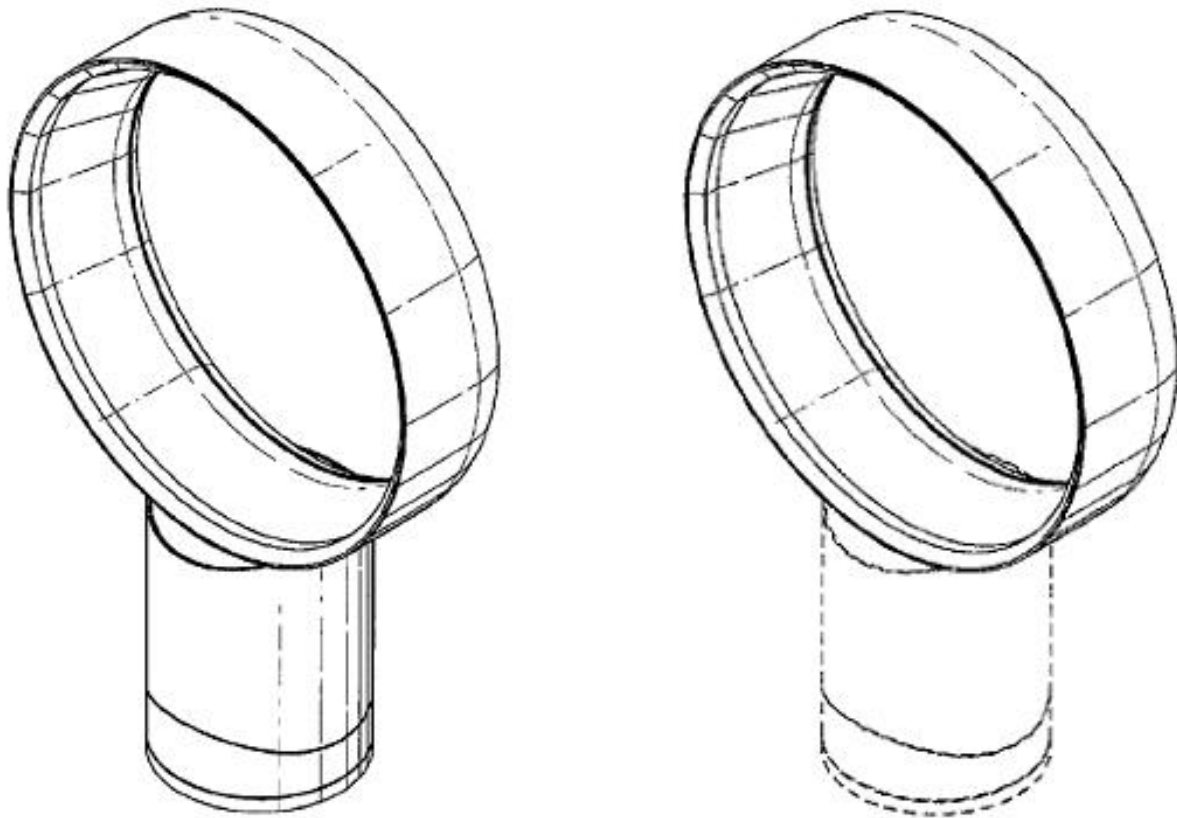
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## Dyson files suit to enforce design and utility patents for its bladeless fan



Dyson, Inc. filed suit against Cornucopia Products in the District of Arizona to enforce design and utility patents directed to a bladeless fan. The design patents at issue, [D602,143](#) and [D605,748](#), both claim the ornamental design for a fan, as shown to the right. The D142 patent claim includes a cylindrical base, whereas the D748 claim is not limited by a base.

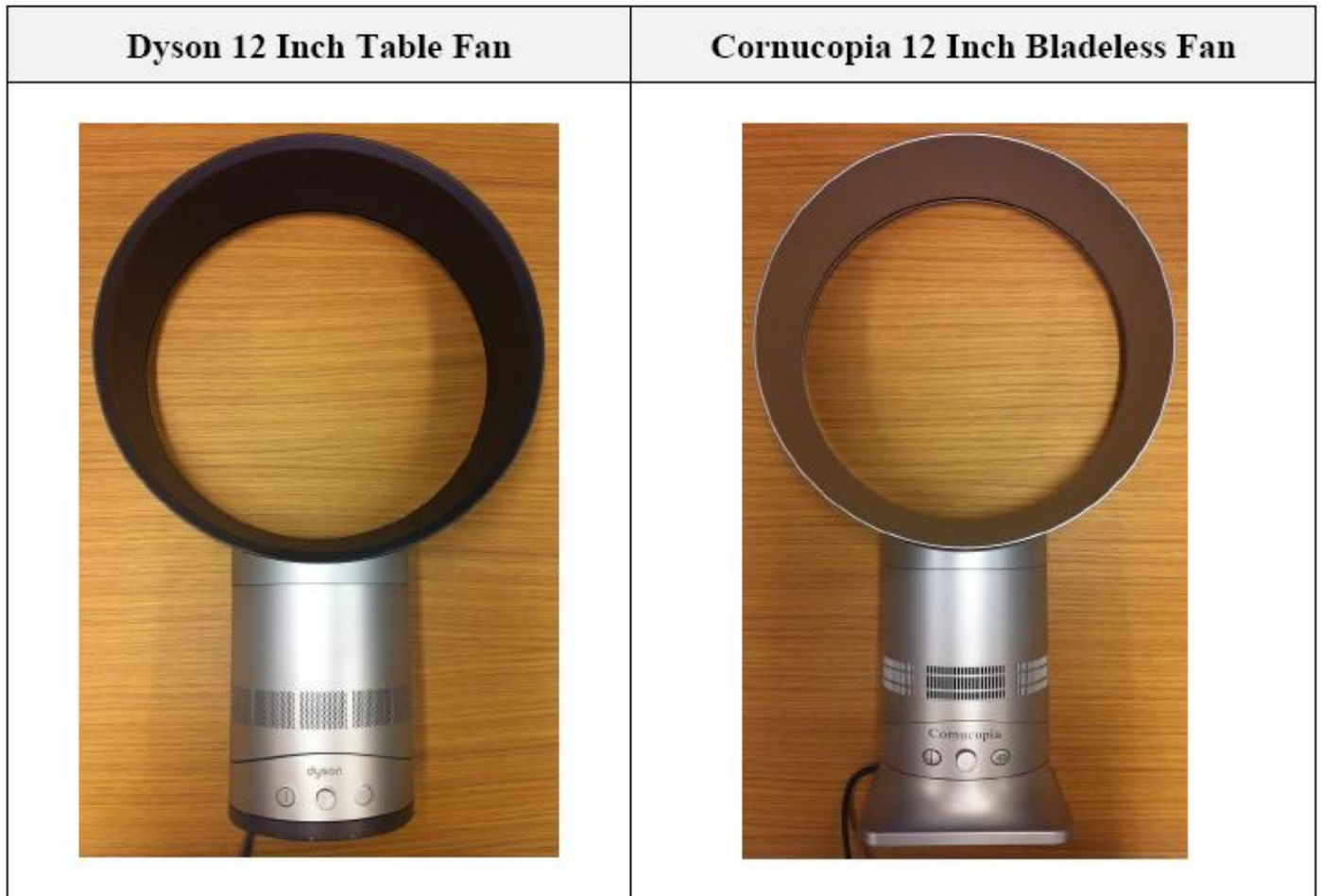
The utility patents at issue, [8,052,379](#) and [8,092,166](#), claim fan assemblies.

An image of Dyson's 12 inch fan is shown below alongside an image of the alleged infringing product.

Dyson's complaint alleges that

The copying of Dyson's fan is so pervasive that many parts of Cornucopia's fan are interchangeable with the corresponding parts of Dyson's fan. For example, Cornucopia's cylindrical air nozzle fits perfectly and locks into Dyson's base. And Dyson's cylindrical air nozzle fits perfectly and locks into Cornucopia's base.

Dyson's complaint further alleges that "Cornucopia's copying of Dyson's fan even extends to the number and position of screws for various parts, . . . the precise shapes of intricate internal components, which were designed by Dyson engineers," and "the figures of Dyson's operating manual and assembly guide."



**Tags:** Design Patents, Utility Patents

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## Apple v. Samsung: Settlement Conference

FOSS Patents has published a list of the 50+ pending Apple-Samsung lawsuits spanning the globe. Although the timely resolution of so many lawsuits may require divine intervention, Judge Lucy Koh (who is presiding over the lawsuits in the Northern District of California) "ordered the parties to comment on their availability for an Alternative Dispute Resolution (ADR) effort," as reported by FOSS Patents. As a result of Apple's and Samsung's responses, U.S. Magistrate Judge Spero will now preside over a settlement conference on May 21-22, 2012, in San Francisco.

**Tags:** Apple, Design Patents, Patent Infringement, Samsung

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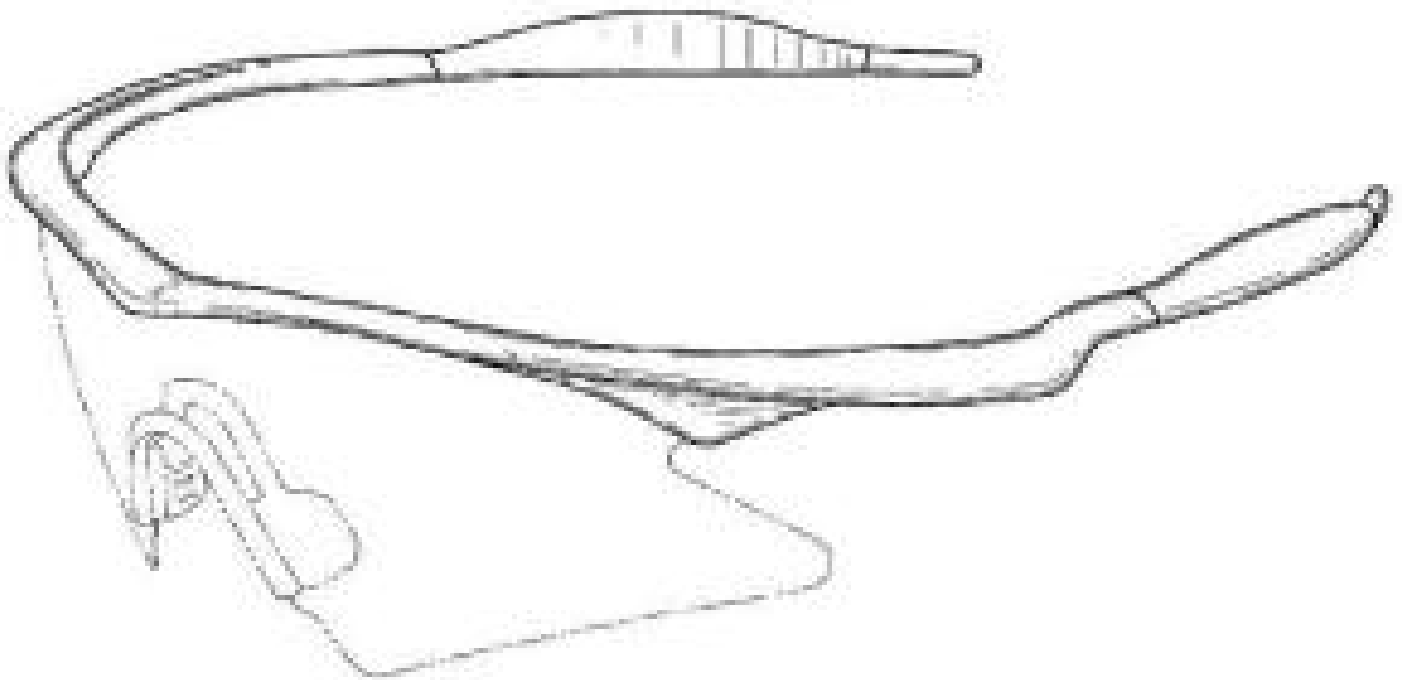
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# PROTECTING DESIGNS

## Digest of new and closed design patent cases from April 9-20, 2012

Wal-Mart and Oakley were among the parties to 8 newly-filed cases and 5 closed cases involving design patents during the two-week period of April 9-20, 2012. A tabulated summary of these cases is posted [here](#). Some cases that we found particularly interesting are mentioned below.



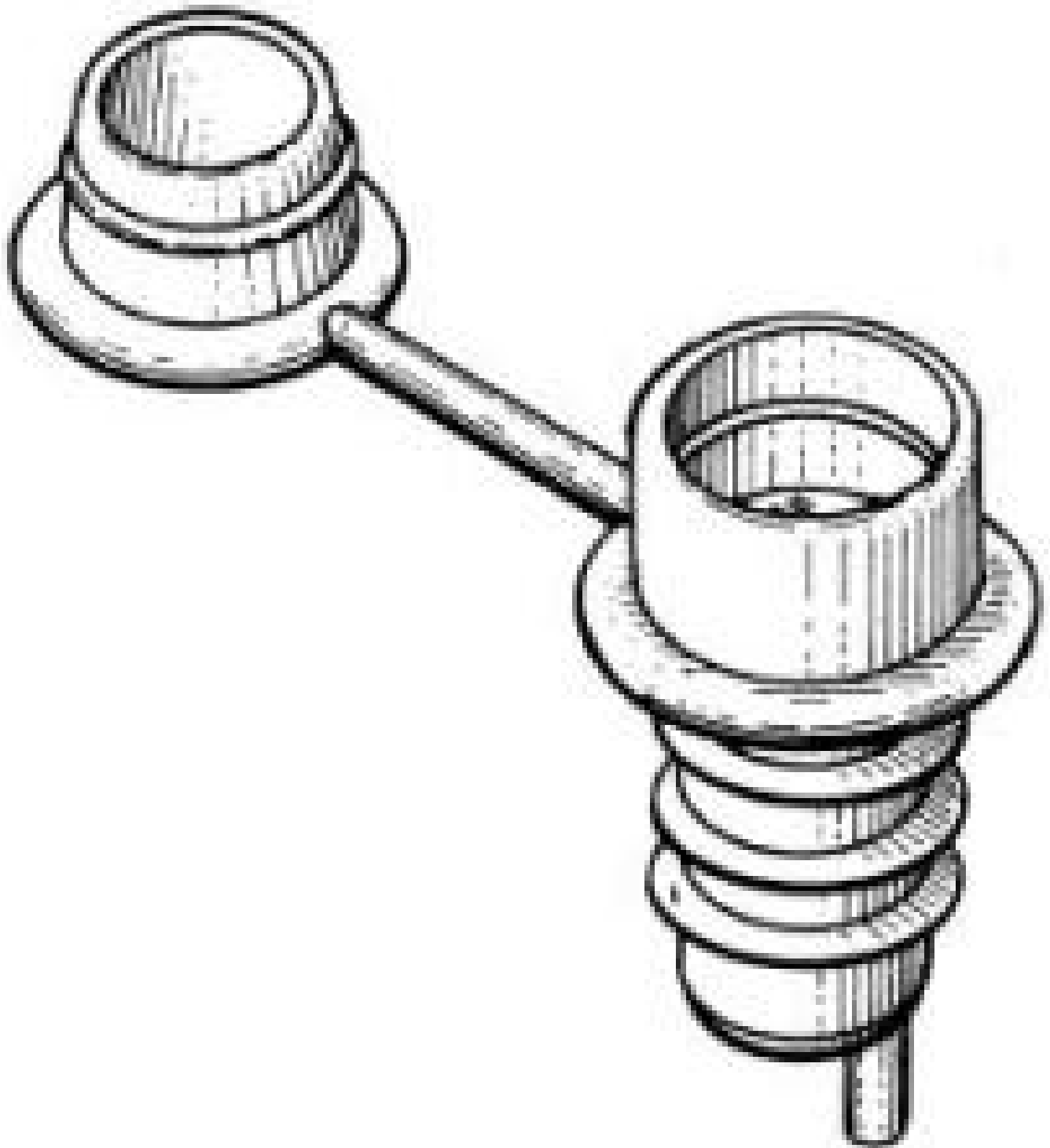
Oakley, Inc. [filed suit](#) against Great L&H Trading, Inc. in the Central District of California alleging infringement of eyewear design and utility patents. On the same day, Great L&H Trading filed a corresponding [declaratory judgment](#) action in the Southern District of New York. This new case follows other Oakley eyewear design infringement suits that we previously reported on [02/10/12](#), [02/16/12](#), and [03/12/12](#). Links to the patents at issue in this case are listed below.

D420,036      D622,755      D581,443

D581,444      D397,350      D399,866

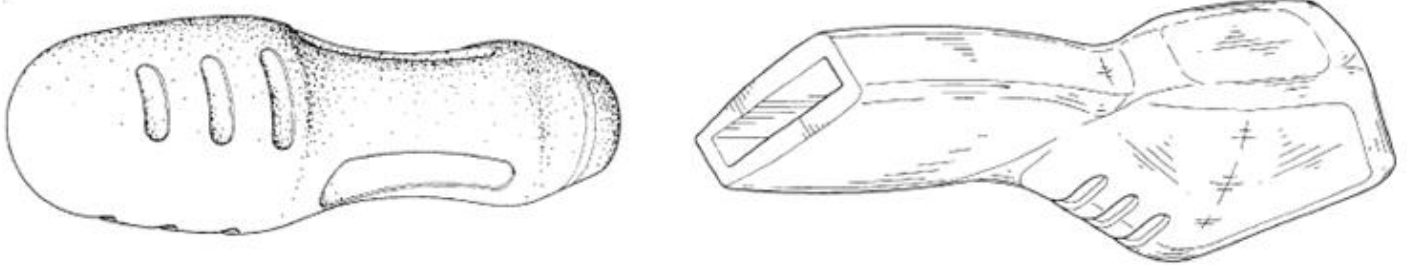
D554,689      D404,754

5,387,949      5,638,145



Vinum Corp. and Oenaphilla, Inc. settled a lawsuit involving a combined bottle "aerator, filter, pourer, re-corker and stopper, all designed into one unit," as shown to the left. Vinum's [complaint](#) alleged that Oenaphilla's Tappo Pour product infringed Vinum's [D437,782](#) patent claiming a design for a bottle stopper.

Sheng Yang Metal Co. and Wal-Mart Stores settled a lawsuit involving tool handle designs, shown below. Shen Yang Metal's [complaint](#) alleged that Wal-Mart infringed two of its patents, [D483644](#) and [D486717](#), claiming designs for tool handles.



**Tags:** [Complaint](#), [Design Patents](#), [Patent Infringement](#)

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# PROTECTING DESIGNS

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## Digest of new and closed design patent cases from Mar. 19 to April 6, 2012

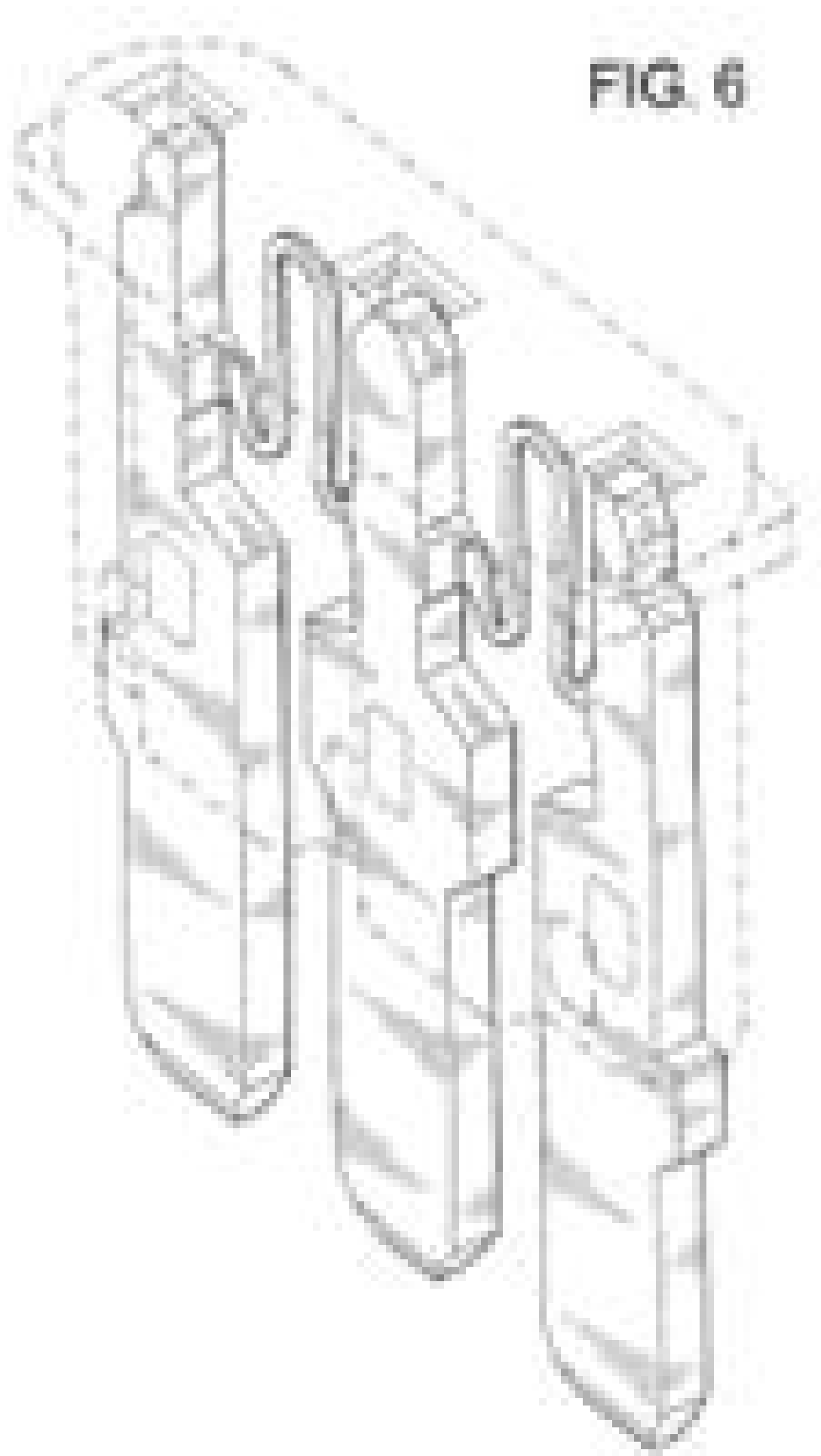
In light of the positive response we received from our [earlier Design Patent Digest post](#), we decided to post another. A table of newly filed and closed design patent cases from March 19, 2012, to April 6, 2012, including a handful of earlier cases not identified in our previous search, is posted [here](#). Over this three week period, we identified 20 new cases and 10 closed cases involving a design patent.

Some cases that we found particularly interesting are mentioned below.

The footwear design patent infringement suit, *Skechers USA v. Children's Place*, [which we previously reported](#), was dismissed without prejudice on March 28, 2012, following a settlement agreement.



**FIG. 6**



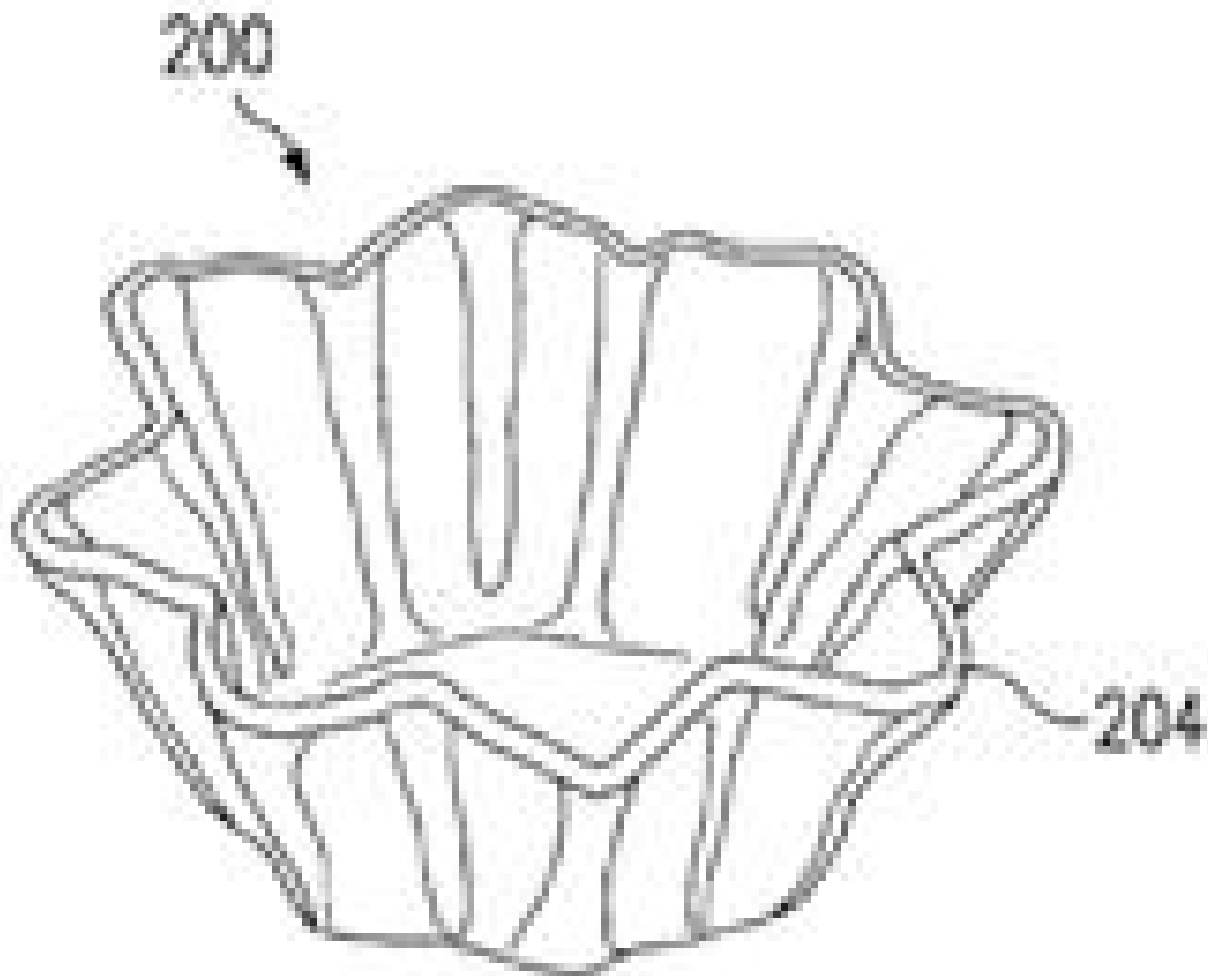
Littel Fuse, Inc. filed suit in the Eastern District of Michigan alleging infringement of utility and design patents for electrical fuses. Links to the patents at issue are included below.

[D575,746](#) Blade Fuse and Fuse Element therefor

[D584,239](#) Blade Fuse Element

[8,077,007](#) Blade Fuse

[7,928,827](#) Blade Fuse



*FIG. 2*

Frito-Lay [filed suit](#) in the Eastern District of Texas alleging infringement of utility and design patents for apparatus and methods directed to making bowl-shaped tortilla chips. The Eastern District of Arkansas [dismissed](#) the defendants' declaratory judgment action against Frito-Lay after the Eastern District of Texas ruled that the defendants were subject to its jurisdiction and that venue was proper in Texas. Links to the patents at issue are included below.

[D459,853](#) Snack Piece Mold

[6,610,344](#) Process for making a shaped snack chip

[6,592,923](#) System and method for molding a snack chip

[6,638,553](#) System and method for monolayer alignment snack chip transfer

[www.protectingdesigns.com](http://www.protectingdesigns.com)

**Tags:** [Complaint](#), [Design Patents](#), [Patent Infringement](#)

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# PROTECTING DESIGNS

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## Digest of new and closed design patent cases from Feb. 6 to Mar. 16, 2012

We have found it helpful, and interesting, to track newly filed and closed design patent cases on a weekly basis. In hope that readers of our [Protecting Designs Blog](#) might benefit as well, we have tabulated our search results over the period from February 6 to March 16, 2012, and posted them [here](#).

During this six week period, we identified 15 newly filed cases and 20 closed cases that assert a cause of action involving a design patent. Of the closed cases identified, the average pendency of the litigation was 0.6 years, where the maximum and minimum pendencies were 1.6 years and 4 days, respectively.

**Tags:** [Complaint](#), [Design Patents](#), [Patent Infringement](#)

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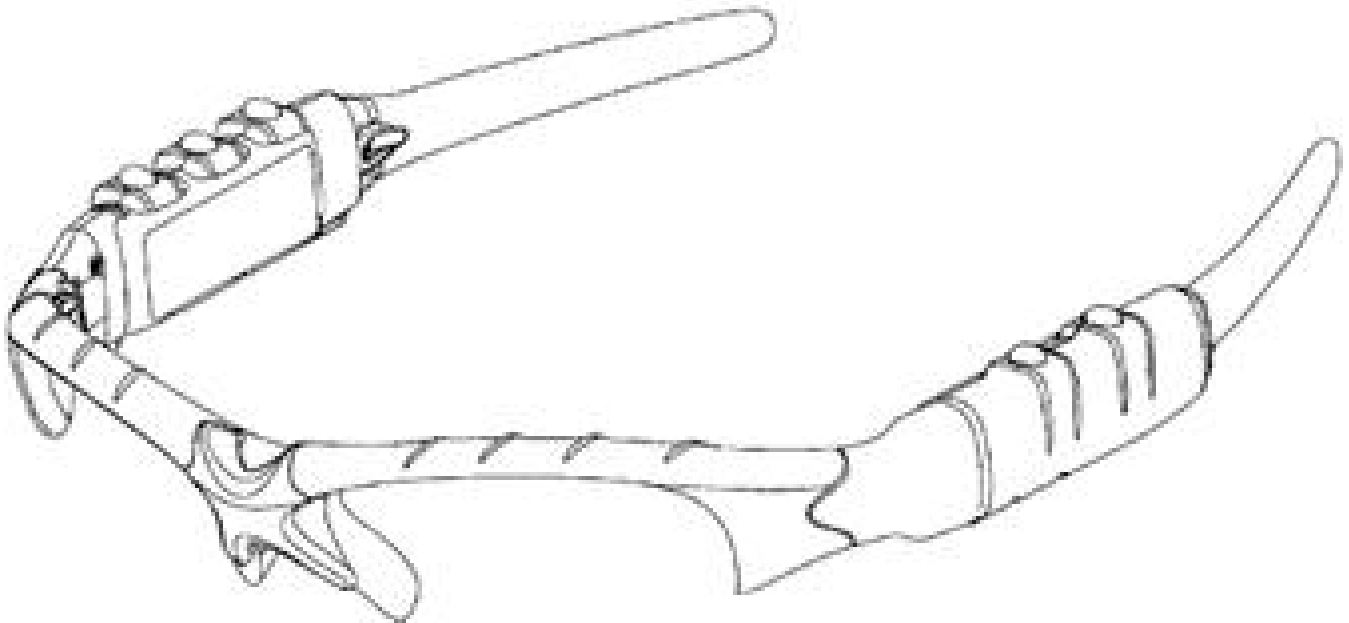
# PROTECTING DESIGNS

## Oakley drops utility patent claims and proceeds with design claim following Markman hearing; court declines to construe the design claim

On March 5, 2012, Oakley entered into a **Covenant Not to Sue** either Predator Outdoor Products or Hunter Specialties under U.S. utility patent 5,387,949 (“the ‘949 patent”). The covenant not to sue was executed on the same day as the Markman hearing in the matter of *Oakley v. Predator Outdoor Products et al.* (case no. **8:2011-cv-00456**, in the U.S. District Court for the Central District of California).

**As we previously reported**, Oakley originally alleged infringement of both the ‘949 patent and the U.S. design patent D523,461 (“the D461 patent”). However, as a result of the covenant not to sue under the utility patent, the D461 patent is currently the only remaining patent at issue in this case.

The D461 patent claims “the ornamental design for an eyeglass component, as shown and described,” below.



er, page 4.

At the outset, the court stated that “[t]he conclusion that these features serve a defined utilitarian purpose is not dispositive as to whether the features are functional in the sense that they are not entitled to design patent protection.” Order, page 5. Instead, the court clarified that “the design of a useful article is deemed to be functional when the appearance of the claimed design is dictated by the use or purpose of the article. Order, page 5 (quoting *L.A. Gear, Inc. v. Thom McAn Shoe*

Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993)).

Interestingly, in dismissing the defendants' functionality arguments, the court pointed to the defendants' own utility patent applications to demonstrate "alternatives for accomplishing the functions of storing electronic components in eyewear and providing nose support for eyewear." Order, page 5. Further, in concluding that no claim construction was necessary due to functionality, the court analogized the features in the D461 patent to those found not strictly functional in *L.A. Gear and Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378-79 (Fed. Cir. 2002), and distinguished the facts of *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294 (Fed. Cir. 2010), where the Federal Circuit concluded that design features were "purely functional elements." Order, page 6.

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

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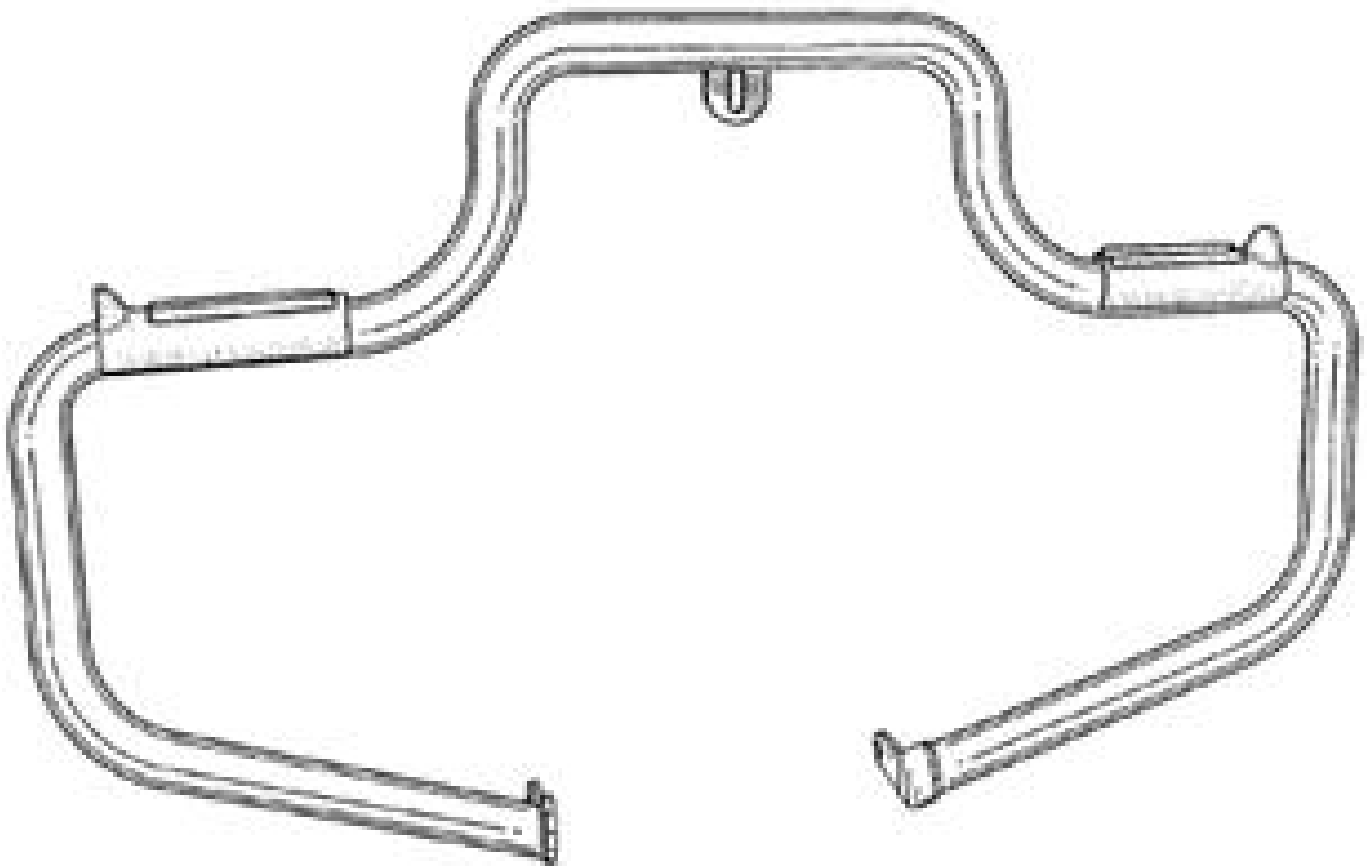


# PROTECTING DESIGNS

## Lindby Custom successfully enforces a design for motorcycle parts, but would the proposed PARTS legislation have affected the court's ruling?

On February 15, 2012, the U.S. District Court for the Central District of California entered Default Judgment in the matter of *Lindby Custom, Inc. v. AMI Group* (case no. 8:10-cv-01779). In its [Complaint](#), Lindby Custom alleged infringement of U.S. Design Patent [D548,142](#) ("the D142 patent"), in addition to trade dress and unfair competition claims.

The D142 patent claims "the ornamental design for the combined engine guard and highway peg" for motorcycles, shown below.



In its [Default Judgment](#) order, the court ordered AMI to pay Lindby Custom compensatory damages of \$285,000, and attorneys' fees and costs of \$9,800, in addition to ordering a permanent injunction against continued infringement.

The court's ruling follows less than two weeks after introduction of a bill in Congress, [H.R. 3889](#), intended to create exceptions to acts of design patent infringement under 35 USC § 271 for certain component parts of motor vehicles, as we [previously reported](#). In turn, we thought it would be interesting to consider whether the proposed legislation could have affected the *Lindby Custom v. AMI Group* ruling, had the legislation been in effect.

As a threshold question we considered whether the *Lindby* case involves:

"a design patent that claims **a component part of a motor vehicle as originally manufactured.**"

H.R. 3889 (emphasis added). The answer to this question may depend on an issue of statutory construction.

First, if the clause "as originally manufactured" modifies only the term "a motor vehicle," then the proposed legislation might only apply to design patents that claim parts installed on a motor vehicle as it leaves the manufacturer's assembly line. Accordingly, under this first interpretation, the proposed legislation might not apply to the D142 patent because there is no evidence that Lindby Custom provided engine guards for "motor vehicle[s] as originally manufactured."

However, in the alternative, if the clause "as originally manufactured" modifies the term "a component part," then the proposed legislation might apply to all motor vehicle component parts, as the component parts themselves are originally manufactured. Under this second interpretation, the proposed legislation would likely apply more broadly to include design patents for aftermarket parts, such as the D142 patent, even if those parts were never installed on a motor vehicle as part of that motor vehicle's original manufacture. Thus, under this second interpretation, the proposed legislation may have acted to diminish the damages award in the *Lindby* case by providing an exception to infringement for acts intended "for the repair of a motor vehicle so as to restore such vehicle to its appearance as originally manufactured." H.R. 3889.

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

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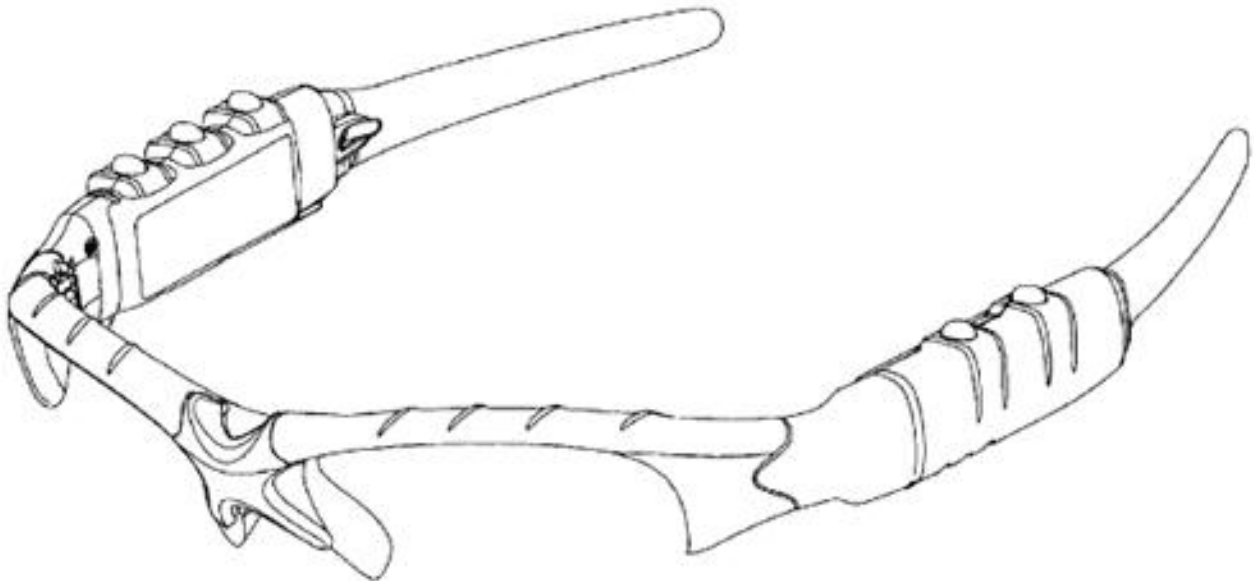


# PROTECTING DESIGNS

## Oakley concludes one successful enforcement suit and continues another

On February 9, 2012, Oakley, Inc., concluded a successful suit to enforce eyeglass utility and design patents in the U.S. District Court for the Southern District of California (*Oakley v. Talitor Far East Co. Ltd et al.*, case no. 3:2011-cv-01305). The complaint, filed in June of 2011, alleged infringement of Oakley's design patent, U.S. Patent No. D523,461 ("the D461 patent"), and utility patent, U.S. Patent No. 5,387,949 ("the '949 patent"), by eleven named defendants.

The D461 patent claims the ornamental design for an eyeglass component, as shown below.



At the close of litigation, eight defendants settled by agreeing to permanent injunctions against continued infringement. Further, the court entered final judgment against one defendant, Nutech Trading USA, Inc., ordering a permanent injunction against continued infringement, payment of total profits from sales of infringing eyewear, and payment of the plaintiff's costs and reasonable attorneys' fees. [Order](#), 3:2011-cv-01305, January 31, 2012.

Oakley continues to pursue enforcement of the D461 patent and the '949 patent in another suit, *Oakley v. Predator Outdoor Products et al.* (case no. 8:2011-cv-00456), currently pending before the U.S. District Court for the Central District of California. Parties to this ongoing suit filed claim construction briefs on February 6, 2012, following a series of settlement conferences.

Previously, litigation in the Central District of California case was voluntarily stayed to conclude the declaratory judgment action, *Hunter's Specialties et al. v. Oakley* (case no. 1:2011-cv-00034), filed in the U.S. District Court for the Northern District of Iowa. Another declaratory judgment action, *Predator Outdoor Products v. Oakley* (case no. [5:2011-cv-01975](#)),

filed in the U.S. District Court for the Eastern District of Pennsylvania, which we [previously reported](#), was voluntarily dismissed to pursue the combined declaratory judgment action with Hunter's Specialties in Iowa. Chief Judge Linda Reade, of the Northern District of Iowa, dismissed the joint declaratory judgment action "in deference to the parallel action in the United States District Court for the Central District of California," reasoning that the declaratory judgment action was merely "forum shopping in the form of [an] anticipatory, declaratory judgment suit[]." [Order](#), p. 14-15, case no. 1:2011-cv-00034, August 2, 2011.

**Tags:** [Complaint](#), [Design Patents](#), [Injunction](#), [Patent Infringement](#)

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# PROTECTING DESIGNS

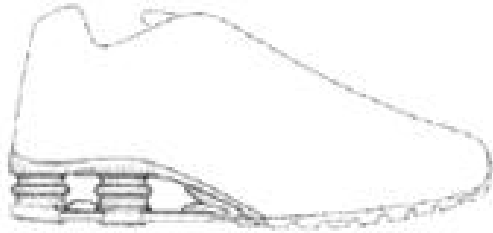
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## NIKE files a complaint alleging footwear design infringement

NIKE, Inc. filed a [complaint](#) against QiLoo International Limited, a Chinese company, on February 6, 2012 (case number 2:2012-cv-00191 in the U.S. District Court for the District of Nevada), alleging infringement of 23 U.S. design patents, listed below.

D361,884	D500,585	D546,541	D578,294
D429,877	D500,917	D547,541	D579,186
D462,830	D523,618	D555,332	D580,636
D475,523	D524,028	D573,338	D580,646
D494,353	D524,529	D573,339	D586,548
D499,247	D532,600	D575,046	

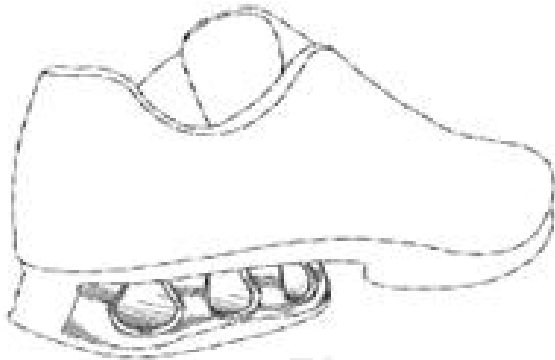
All of the patents asserted are directed to shoe designs, and the patent issue dates range from 1995 to 2009. Images of the allegedly infringing QiLoo footwear are shown below (on the right) next to a figure from the particular design patent asserted (on the left).



D429,877



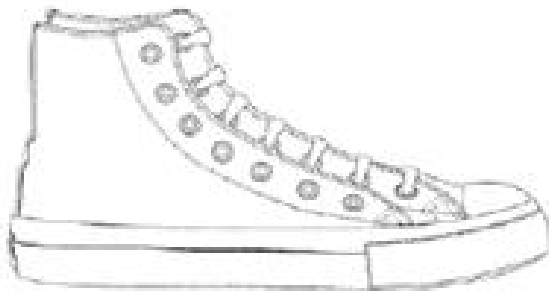
QL-21810



D499,247



QL-21712



D555,332



QL-24715

The complaint further alleges that QiLoo sold or offered to sell the allegedly infringing shoes at World Shoe Association (WSA) trade shows in Las Vegas, Nevada, and that NIKE hand delivered seven notices to QiLoo at those trade shows from 2007-2011 before bringing suit.

This complaint by NIKE follows less than a week after [Skechers filed a complaint to enforce footwear design patents](#), and following Crocs' successful enforcement of footwear design patents in both [federal court](#) and the [International Trade Commission \(ITC\)](#).

**Tags:** Complaint, Design Patents, Fashion Designs, Patent Infringement

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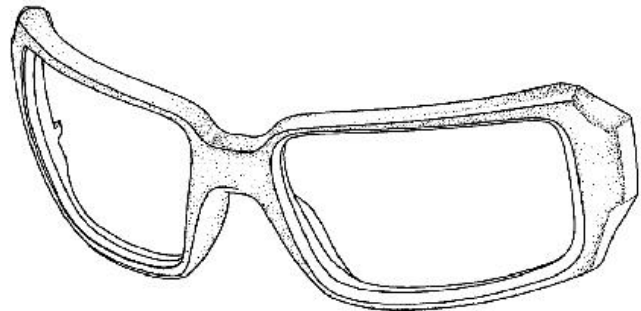
# PROTECTING DESIGNS

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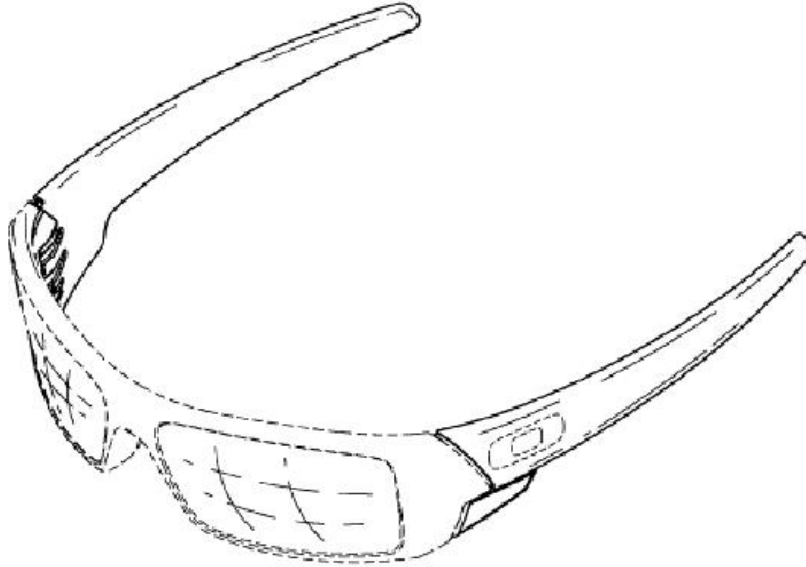
## OAKLEY FILES SUIT AGAINST UVEX OVER SUNGLASSES PATENTS

Oakley, Inc. ("Oakley") filed suit against Uvex Sports, Inc. ("Uvex") on February 3, 2012, in the in the U.S. District Court for the Central District of California. Oakley alleges that certain Uvex products infringe U.S. patent no. 5,638,145 ("the '145 patent"), D557,325 ("the D325 patent"), or D556,818 ("the D818 patent").

Specifically, the Complaint lists Uvex's *Rage* product as infringing the D325 patent. One of the commercially available Uvex *Rage* glasses is shown below to the left, with Fig. 1 of the D325 patent to the right.



Additionally, the Complaint lists Uvex's *Titan* product as infringing the D818 patent. One of the commercially available Uvex *Titan* glasses is shown below (top) with Fig. 1 of the D818 patent (bottom).



In March of 2011, Oakley was the target of a declaratory judgment from Predator Outdoor Products, LLC over design and utility patents assigned to Oakley that are not at issue in the Uvex suit. [See our prior post.](#)

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

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# PROTECTING DESIGNS

## Skechers files a complaint alleging footwear design infringement

Skechers U.S.A., Inc. filed a complaint against The Children's Place Retail Stores, Inc., on February 2, 2012 (case number 2:2012-cv-00928 in the U.S. District Court for the Central District of California) alleging that Children's Place manufactures, imports, sells, and offers to sell a line of footwear that "embodies and infringes the patented invention" disclosed in Skechers's U.S. Design Patent D571,095.

The design patent at issue claims the ornamental design for a "crystal-covered show toe cap," shown below.

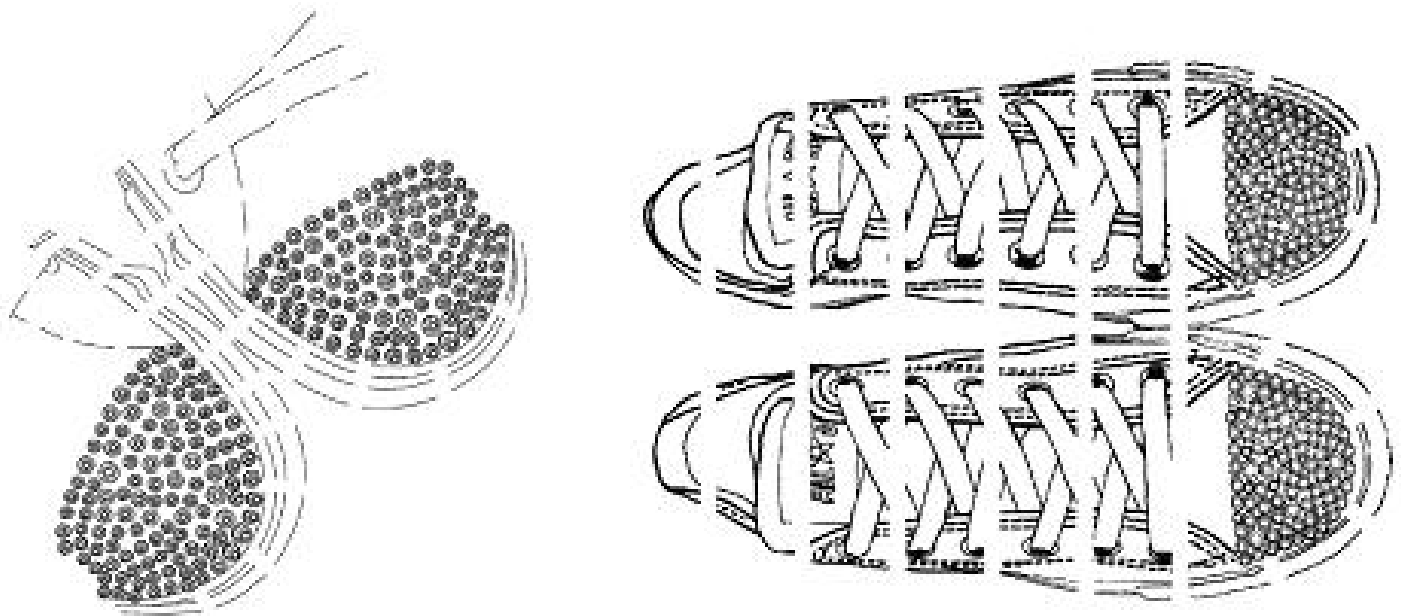


Figure 1 (left) and Figure 3 (right) from U.S. D 571,095

The complaint alleges that "Children's Place footwear line includes, among others, shoes that have a vulcanized canvas sneaker, a toe cap adorned with crystal, rhinestones, sequins or a plurality of other similar shiny elements, and canvas uppers distinguished by colorful art designs or patterns." Images of the allegedly infringing footwear, taken from page 8 of the complaint, are shown below.





Examples of allegedly infringing Children's Place footwear

This complaint against Children's Place follows Croc's successful enforcement of footwear design patents against Skechers, which we [previously covered](#).

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

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# PROTECTING DESIGNS

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## New proposed legislation to create design patent infringement exceptions for motor vehicle parts

On February 2, 2012, Representatives Darrell Issa (R-Calif.) and Rep. Zoe Lofgren (D-Calif.), members of the House Judiciary Committee, introduced H.R. 3889, a bill entitled the [Promoting Automotive Repair, Trade, and Sales \(PARTS\) Act](#).

The proposed bill would create exceptions from acts of infringement under 35 USC 271 for certain component parts of motor vehicles. Under the PARTS Act, with respect to a design patent that claims a component part of a motor vehicle as originally manufactured, “it shall not be an act of infringement of such design patent to make or offer to sell within the United States, or import into the United States, any article of manufacture that is similar or the same in appearance to the component part that is claimed in such design patent if the purpose of such article of manufacture is for the repair of a motor vehicle so as to restore such vehicle to its appearance as originally manufactured.”

Further, “after the expiration of a period of 30 months beginning on the first day on which any such component part is first offered to the public for sale as part of a motor vehicle in any country, it shall not be an act of infringement of such design patent to use or sell within the United States any article of manufacture that is similar or the same in appearance to the component part that is claimed in such design patent if the purpose of such article of manufacture is for the repair of a motor vehicle so as to restore such vehicle to its appearance as originally manufactured.”

Similar bills have been previously proposed, without success. Supporters of such reform argue that such legislation will lower cost for automobile repairs. Not surprisingly, the insurance industry endorses such efforts. Opponents of such bills point to the cost of developing quality parts, well designed to safely function as needed and to appeal to consumers at the same time. The opponents believe that allowing anyone to knock off these parts would not help the auto industry in this country.

**Tags:** [Design Patents](#), [Legislation](#)

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# PROTECTING DESIGNS

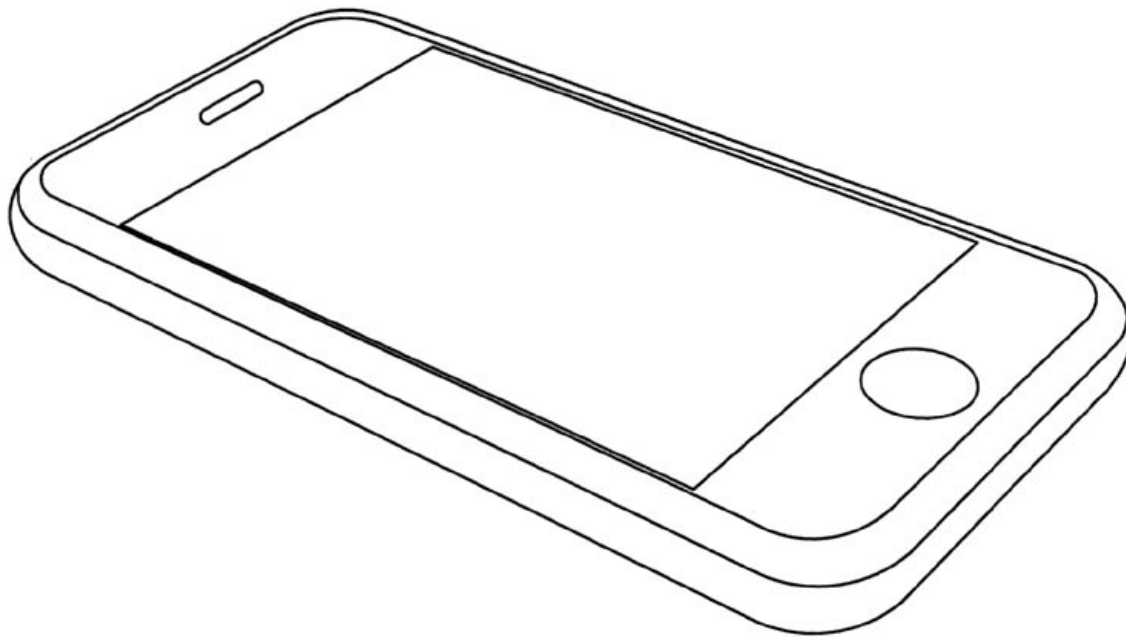
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## Apple v. Samsung: Summary Update - January 2012

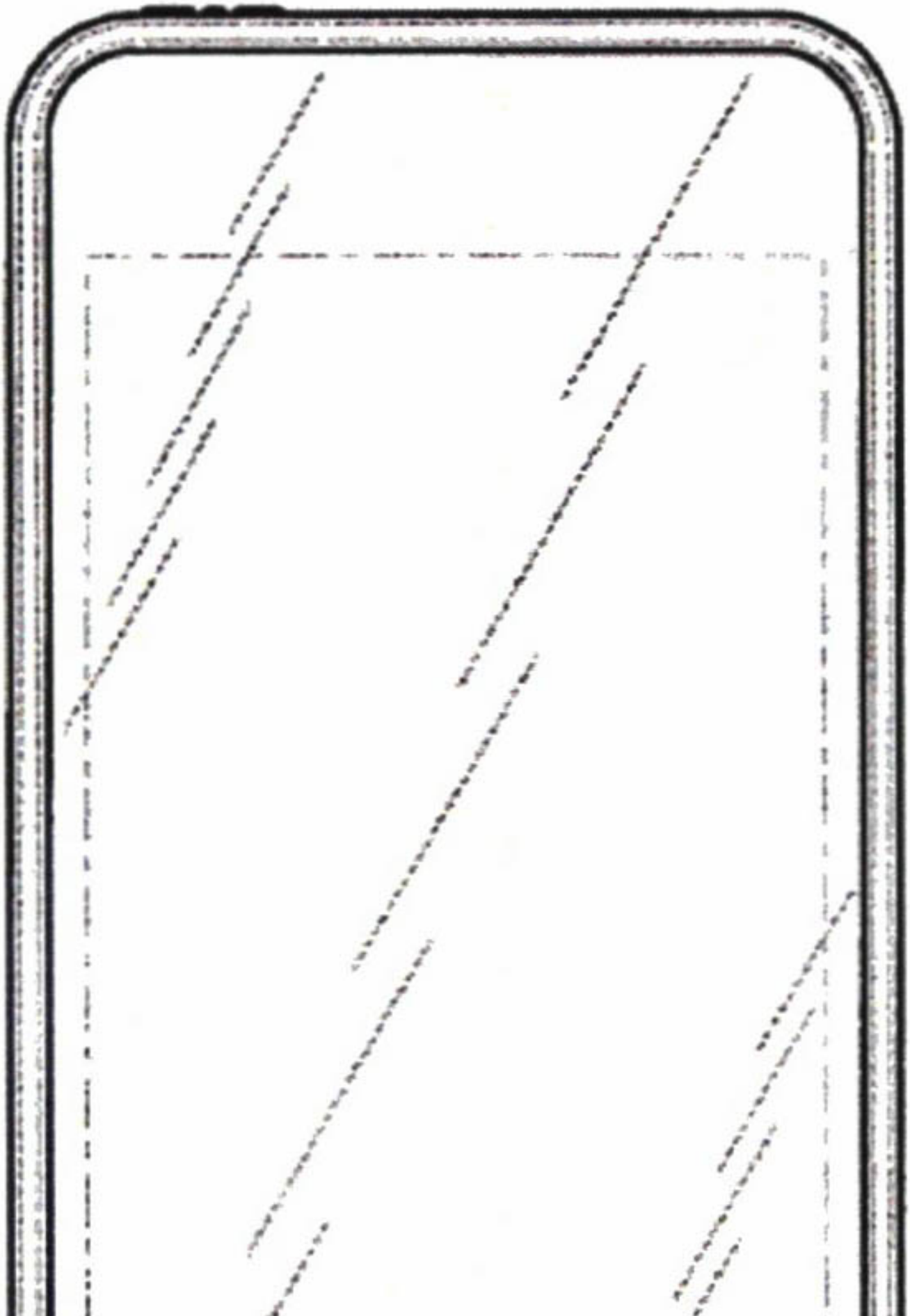
Engadget has started a "[Follow the Saga](#)" feature concerning the ongoing Apple v. Samsung feud, including the most recent announcement that the ban on the original Galaxy Tab 10.1 has been upheld in Germany. The "[Follow the Saga](#)" coverage at Engadget also includes Samsung's 3G lawsuits.

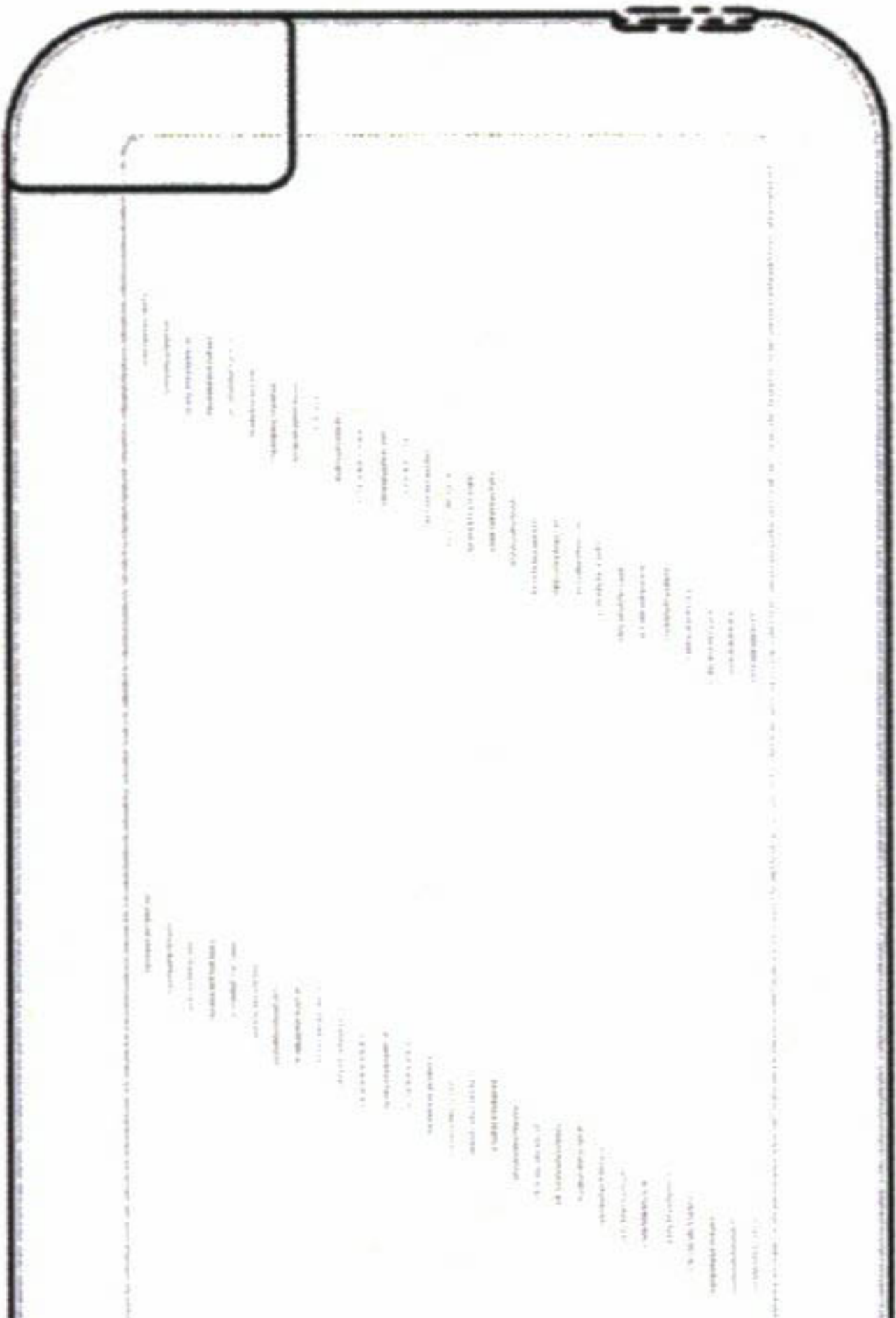
Of note, Apple filed another suit against Samsung in Germany on January 17, 2012, asserting Registered Community Design Nos. [000748280-0006](#) and [000888920-0018](#) against 15 Samsung phones between the two designs, as reported by [FOSS Patents](#). There is an invalidity proceeding pending in both, each initiated by Samsung on August 9, 2011.

Registered Community Design No. [000748280-0006](#)



Registered Community Design No. [000888920-0018](#)





Apple, Community Designs, Samsung

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# PROTECTING DESIGNS

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## **Nestlé continues Trend of Recent Consumer Products Design Patent Complaints**

Continuing a pattern of design patent infringement suits involving consumer products filed in recent months, Nestlé Healthcare Nutrition, Inc. (“Nestlé”) and Gerber Products Company (“Gerber”) sued Mead Johnson & Company, LLC (“Mead Johnson”) in the United States District Court for the District of Delaware on January 26, 2012.





The suit, 1:12-cv-0079, alleges that the sale of certain Mead Johnson bottles infringes Nestlé's U.S. Design Patent No. D 447,421 ("the '421 patent"). The complaint further alleges unfair competition, trade dress infringement, and various state law causes of action against Mead Johnson. The '421 patent is directed towards an ornamental design for a bottle. See Fig. 1 to the left.

The Nestlé complaint states that the patented bottle has been used in its Boost® line of nutritional drinks. ¶ 14. Mead Johnson has supplied Nestlé with the products covered by the '421 patent. ¶ 14. However, Nestlé alleges that Mead Johnson also supplied infringing bottles as private label products to Wal-Mart, Kroger, and Sam's Club without a license. ¶ 19. In an unusual twist, the allegedly infringing products are reportedly marked with the '421 patent number. ¶ 19.

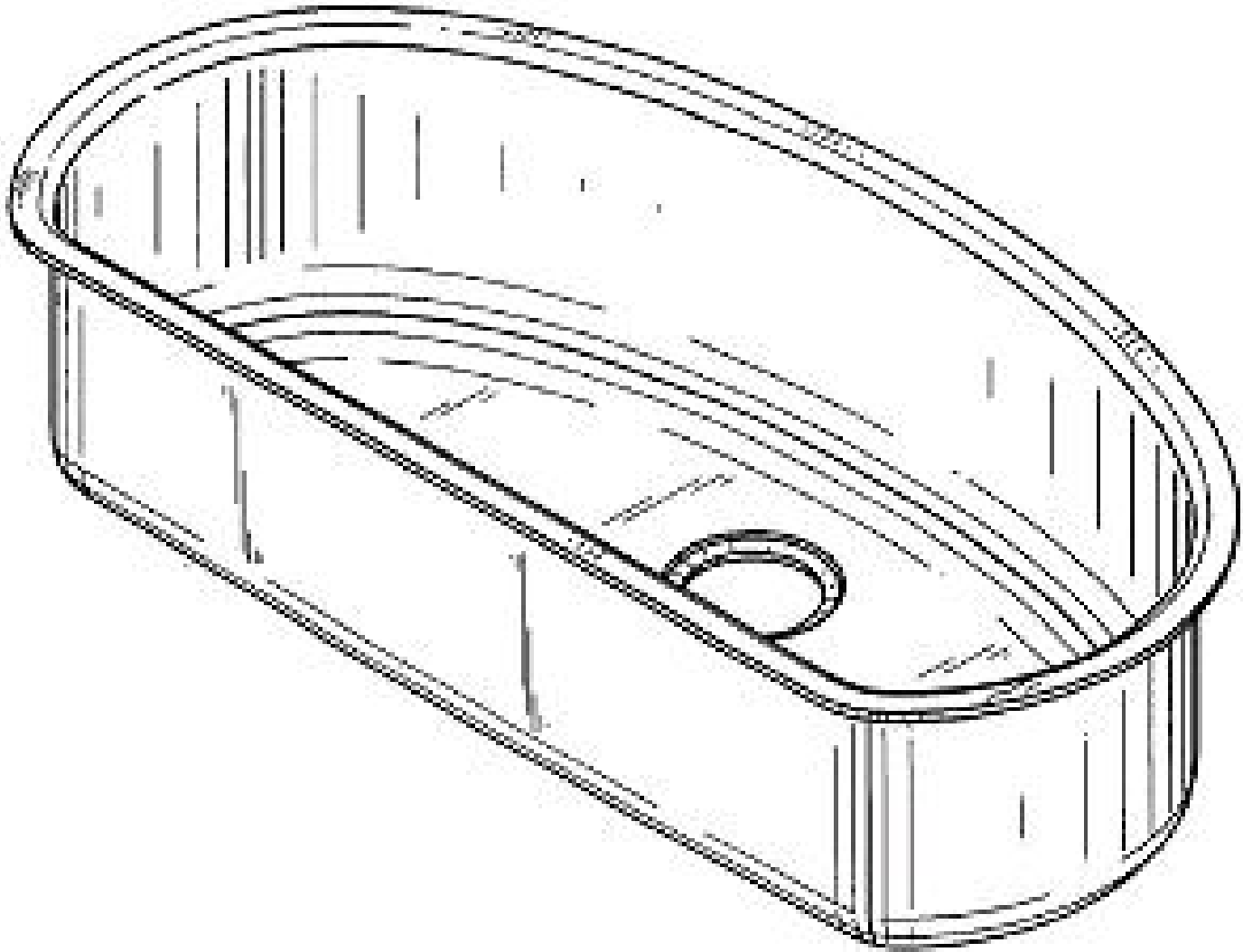
Notably, Mead Johnson had previously sued Nestlé and Gerber in United States District Court for the Southern District of Indiana in August 2011, 3:11-cv-0100, for infringement of U.S. patent no. 7,040,500 entitled "Container and Scoop Arrangement." Thus, this month's Nestlé suit asserting the '411 design patent appears to be part of a larger dispute between the companies.



In November 2011, Crocs Inc. ("Crocs") brought suit against Walgreen Co. in the United States District Court for the District

of Colorado, 1:11-cv-02954, alleging infringement of U.S. Patent No. D 610,784 (“the ‘784 patent”) and U.S. patent no. 6,993,858. The ‘784 patent is directed towards an ornamental design for footwear. See Fig. 1 to the right.

The Crocs complaint states that prior to filing suit Crocs sent Walgreens a letter asking that Walgreens cease and desist selling its “Caribbean Cartel” footwear. ¶ 20. Crocs had previously asserted other design patents on its footwear as reported, for example, in *Crocs Inc. v. Int’l Trade Comm’n.*, 598 F.3d 1294 (Fed. Cir. 2010). See our [prior post](#). The most recent Crocs suit is an example of the common strategy of asserting design patents in combination with utility patents against an alleged infringer.



Finally, in October 2011, Kohler Co. (“Kohler”) sued Amerisink, Inc. in the United States District Court for the Eastern District of Wisconsin, 11-cv-921, asserting infringement of two design patents, nos. D 510,985 (“the ‘985 patent”) and D 529,147 directed towards ornamental designs for sinks. See Fig. 1 of the ‘985 patent to the left.

Kohler asserted that Amerisink infringed these patents through its sale of certain stainless steel sinks. ¶ 21. As in the Crocs suit, Kohler reported that it sent Amerisink a cease and desist letter regarding the alleged infringement prior to filing suit. ¶ 22.

Design patents continue to be an important, though sometimes overlooked, tool in the patent portfolios of many companies, especially those in the consumer products arena. As with other recent patent design suits, the suits discussed above were brought by American companies. Whether foreign companies will also choose to assert their own design patents with greater frequency in the future remains to be seen.

**Tags:** Design Patents, Patent Infringement, Trade Dress, Unfair Competition

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