



# PROTECTING DESIGNS

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## Ugg! Deckers' Design Patent Infringement Claim Is Not Kicked to the Curb

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BY DAVID. M. LONGO, PH.D. | SEPTEMBER 15, 2014

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On September 8, 2014, Judge Otis D. Wright, II, U.S. Dist. Ct., C.D. Calif., issued an Order keeping alive a claim for design patent infringement while booting other asserted claims in a Motion to Dismiss under F.R.C.P. 12(b)(6). *See Deckers Outdoor Corp. v. J.C. Penney Co., Inc.*, C.D. Cal., Case No. 2:14-cv-02565-ODW(MANx) (“[Order Granting in Part Motion to Dismiss with Partial Leave to Amend](#),” Doc. 30, Sept. 8, 2014).

Deckers Outdoor Corporation (“Deckers”) is known for its famous UGG® sheepskin and suede boots, among other products, sold online and at retail stores throughout the U.S. According to Deckers, its UGG® line of boots began a metaphorical ascent into the stratosphere after being featured on Oprah Winfrey’s television show in 2000, when Oprah supposedly “emphatically declared ... how much she ‘LOOOOOVES her UGG boots.” *See First Amended Complaint, Doc. 18, ¶ 12*. This ascent continued, as many well-heeled celebrities embraced the boots and were photographed wearing them. With such a stamp of fashion approval, one can easily understand that Deckers would do whatever it could to protect its valuable image, brand, and products from harm by imitators seeking to capitalize on Deckers’ success.

So, when Deckers noticed that large retailer J.C. Penney Company, Inc. (“JC Penney”) was selling a line of boots—some of which it believed were very similar to its patented Bailey Button boots—it did not want to be caught flat-footed. Deckers therefore laced up a five pronged [Complaint against JC Penney](#)—complete with a jury trial demand—and filed suit in the Central District of California on April 4, 2014. Specifically, Deckers’ Complaint (and First Amended Complaint of July 2, 2014) asserted claims for relief based on: (1) trade dress infringement; (2) false designations of origin and false description; (3) federal unfair competition; (4) patent infringement (including willful infringement); and (5) unfair competition under California common law. (Deckers similarly sued Wal-Mart Stores, Inc., Sears Holdings Corp., and Dreams Footwear, Inc.—cases which have been consolidated by Judge Wright.)

Presumably due to the presence of a claim for patent infringement, the lawsuit was [transferred](#) to the [Central District of California Patent Pilot Program](#) on April 9, 2014, and was assigned to Judge Wright in the Western Division. Notably, four of the six judges in the Patent Pilot Program are in the Western Division.

In its allegations common to all claims for relief, Deckers asserted that JC Penney “has manufactured, designed, advertised, marketed, distributed, offered for sale, and/or sold various styles of knock-off UGG boots, including those that infringe upon Plaintiff’s Bailey Button Boot Trade Dress and Bailey Button Design Patents,” namely U.S. Des. Pat. Nos. [599,999](#) and [616,189](#). *First Amended Complaint, Doc. 18, ¶ 19, see also ¶ 16*. For reference, a comparison of Deckers’ design patents and the accused JC Penney products appears below, reproduced from Judge Wright’s Order. *See Order, Doc. 30, p. 8*.

**Figure 1**

<b>Deckers's Design Patents</b>	<b>Accused Products</b>
 <p data-bbox="370 746 537 783">D616,189</p>	 <p data-bbox="943 746 1393 783">Arizona Carmen Girls Boot</p>
 <p data-bbox="370 1300 537 1336">D599,999</p>	 <p data-bbox="868 1342 1471 1378">Arizona Crescent Casual Suede Boot</p>

As to its trade dress, Deckers was careful to note that “key elements thereof are non-functional.” First Amended Complaint, Doc. 18, ¶ 10. As to its design patents, Deckers also carefully noted that its “UGG® footwear products, including products embodying the Bailey Button Design Patents, bear a label on the products themselves that gives notice to the public of its patent registration.” *Id.*, ¶ 64. And, Deckers asserted that JC Penney “copied Deckers’ Bailey Button Boot Style in an effort to exploit Decker’s reputation in the market.” *Id.*, ¶ 66.

With its feet to the fire, JC Penney countered with a Memorandum in support of its Motion to Dismiss under F.R.C.P. 12(b) (6). JC Penney asserted that Deckers’ Complaint had no traction, because it simply wished “to prohibit the sale of footwear that Deckers claims looks similar to its self-described Bailey Button boot. In other words, Deckers seeks to **chill competition** and **monopolize the marketplace** for any boot that shares the **same basic, functional design** as Deckers’ product.” Memorandum, Doc. 25-1, p. 1 (emphases added).

JC Penney, however, omitted any argument regarding Deckers’ U.S. Des. Pat. No. 599,999, other than to allege that “Deckers simply lumps the D599,999 and ’189 patents together and summarily alleges that” JC Penney infringes. Memorandum, Doc. 25-1, p. 9; *see also Reply Memorandum, Doc. 29*, in which there is no mention of U.S. Des. Pat. No. 599,999. In doing so, JC Penney essentially limited its arguments to attempting to distinguish its accused boot designs only

over the tall, three-button, design of U.S. Des. Pat. No. 616,189.

Judge Wright's Order trampled on JC Penney's Motion to Dismiss as to the design patent infringement claim for relief. Specifically, Judge Wright stated:

The Court finds that Deckers properly pleaded JC Penney's alleged infringement of the '189 Patent. The Federal Circuit has held that "[i]nfringement of a design patent is a question of fact." *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1287 (Fed. Cir. 2002). It is therefore improper in a situation like this one to contend that a plaintiff has failed to allege design-patent infringement based on a comparison of the subject designs, since the Court must accept all factual allegations as true in deciding a Rule 12(b)(6) motion. **Moreover, as depicted in Figure 1 [reproduced above], a comparison of the protected designs with the accused products demonstrates a sufficient visual similarity to at least render infringement of the '189 Patent plausible. Deckers had to do no more.**

Order, Doc. 30, p. 7 (emphasis added). Judge Wright's Order, however, noted that "JC Penney does not attack Deckers' pleading with respect to the '999 Patent, so that portion of the patent-infringement claim is not subject to the Motion to Dismiss." *Id.*, p. 6, FN4.

Regarding the willful infringement component of the (4) patent infringement claim, Judge Wright granted JC Penney's motion, with leave for Deckers to further amend its Complaint. In particular, Judge Wright took issue with Deckers' citations to case law, noting that "all but one of these citations actually establish the opposite of what Deckers asserts." *Id.*, p. 9. Judge Wright also disagreed with Deckers' "contention that the Bailey Button Boots' popularity and patent notice on the products themselves suffices to establish presuit knowledge." *Id.* On this point, Judge Wright stated:

Deckers has not alleged that JC Penney was actually aware of either of the patents-in-suit prior to producing and selling the accused products. **Even if the Bailey Button Boots have garnered widespread popularity and are stamped with patent notice, those allegations, standing alone, do not establish that JC Penney actually knew about the '189 and '999 Patents. Actual knowledge—not constructive knowledge—is the criterion.** *i4i Ltd. P'ship v. Microsoft Corp.*, 598 F.3d 831, 860 (Fed. Cir. 2010) ("Infringement is willful when the infringer was aware of the asserted patent . . ."); *Seoul Laser Dieboard Sys.*, 957 F. Supp. 2d at 1196–97 (same).

*Id.* (emphasis added). (Curiously, JC Penney asserted in a footnote that "Deckers does not plead that it complied with the marking requirements of 35 U.S.C. § 287." Reply Memorandum, Doc. 29, p. 7. However, as mentioned above, Deckers had stated that its products "bear a label on the products themselves that gives notice to the public of its patent registration." First Amended Complaint, Doc. 18, ¶ 64. For further reference, see [Patent Marking and Design Patents](#), by Andrew M. Ollis, July 9, 2014.)

On the remaining claims for relief, Judge Wright denied JC Penney's motion on the (1) trade dress infringement and the (3) federal unfair competition claims because "JC Penney fails to address" these claims. *Id.*, p. 4, FN2. Judge Wright granted JC Penney's motion—without leave for Deckers to further amend its Complaint—on the (2) false designations of origin and false description and the (5) unfair competition under California common law claims.

**Tags:** [Complaint](#), [Design Patents](#), [District Court](#), [Fashion Designs](#), [Patent Infringement](#), [Trade Dress](#), [Unfair Competition](#), [Filings and Decisions](#)

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# PROTECTING DESIGNS

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## Patent Marking and Design Patents

It is important to remember that patent marking applies to design patents as well as utility patents. The Federal Circuit made this clear in *Nike Inc. v. Wal-Mart Stores*, 138 F.3d 1437 (Fed. Cir. 1998), by holding that the term “damages” as it appears in the marking statute, 35 U.S.C. § 287(a) applies to recovering the infringer’s profit under 35 U.S.C. § 289 as well as to the recovery of damages under 35 U.S.C. § 284.

In reaching their decision, the Court reviewed the statutory history of the damages and profits statutes for both design and utility patents, as well as the statutory history of the marking statutes. The Court found that the Patent Act of 1887, which was specific to design patents and removed the apportionment requirement when recovery of the infringer’s profit was sought, “was enacted to overcome the allocation problem for designs, and did not deplete the remedies available for either utility or design patent infringement.” *Id.* at 1441-43. Additionally, the Court found that the history of the marking statute supported the “conclusion that the marking statute with its use of the word ‘damages’ applies broadly to include recovery of the infringer’s profits under the special provision for design patent infringement.” *Id.* at 1445.

Consequently, the new America Invents Act (“AIA”) virtual marking provision, 35 U.S.C. § 287(a), is useful for design patent owners. The virtual marking provision states:

[p]atentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States may give notice to the public that the same is patented, either by fixing thereon the word ‘patent’ or the abbreviation ‘pat.’ together with the number of the patent, or by fixing thereon the word ‘patent’ or the abbreviation ‘pat.’ together with an address of a posting on the Internet, accessible to the public without charge for accessing the address . . .

35 U.S.C. § 287(a) (emphasis added). Thus, an article covered by one or more patents, including design patents, need not list each individual patent that covers a product. Instead, the product can be marked with the word “pat.” and list a website where the patents applicable to the article in question may be listed.

Finally, design patent owners should also be aware that the false marking statute, 35 U.S.C. § 292, applies to design patents. See e.g. *Marvellous Day Elec. (S.Z.) Co. v. Ace Hardware Corp.*, No. 11-8756, 2013 U.S. Dist. LEXIS 122212 (N.D. Ill. Aug. 27, 2013) (assessing whether Ace intended to deceive consumers into believing that Christmas lights advertised as “patented” were made or sold by Marvellous Day); *Buehlhorn v. Universal Valve Co., Inc.*, No. 10-559, 2011 U.S. Dist. LEXIS 34429 (S.D. Ill. Mar. 31, 2011) (determining whether Universal Valve Co intended to deceive consumers by marking its products with an expired design patent number). Accordingly, it is important to remember to not mark products with a design patent number that does not cover the product or with the number of an invalid or expired patent.

Andrew Ollis and Katherine Cappaert contributed to this post.

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

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## Skechers v. Fila

Skechers USA filed a [complaint](#) against Fila in the Central District of California-Western Division, alleging infringement of US D661,884 and US D688,446, both directed to slip-on shoes, and alleging unfair competition and trade dress infringement of trade dress rights in Skechers Go Walk(R) shoe.

The complaint states a letter providing written notice of infringement was sent to Fila in July 2013, and in August 2013, Fila agreed to cease making the allegedly infringing shoe, the Amazen Memory Moc (referred to as "Version 1"). Allegedly, Fila stated it redesigned the Amazen Memory Moc (the redesign referred to as "Version 2") and agreed to cease manufacture of Version 1. However, the Complaint states Version 1 "is still available for purchase nearly one year after Skechers' written notice." Complaint, pages 3 and 20.

Version 1 is alleged to infringe the trade dress of the Skechers Go Walk(R) shoe as well as both US D661,884 and US D688,446, while Version 2 is alleged to infringe only US D661,884. Images from the complaint embodying the allegations are reproduced below:

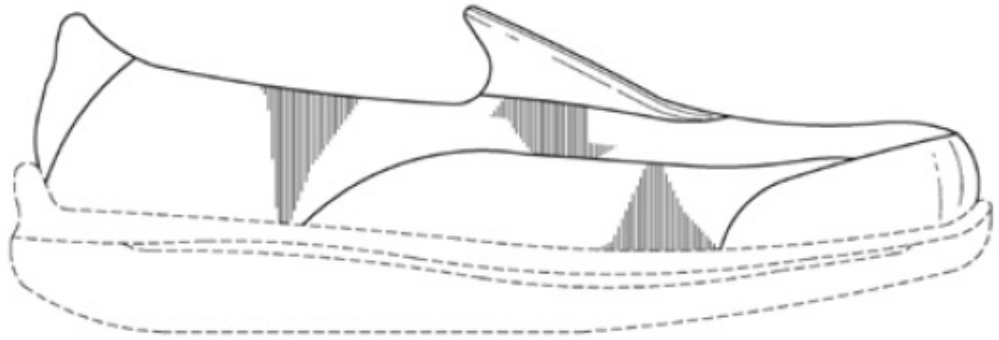
[US D661,884]

<p><b>SKECHERS U.S. DESIGN PATENT D661,884 S</b></p>	 A black and white line drawing of a slip-on shoe. The shoe has a rounded toe, a low-cut upper, and a thick, textured sole. A small detail of the heel area is shaded with vertical lines.
<p><b>FILA AMAZEN MEMORY MOC (Version 1)</b></p>	 A photograph of a dark blue slip-on shoe. The shoe has a white, textured sole and a small white FILA logo on the side of the heel. The shoe is shown from a three-quarter perspective.
<p><b>FILA AMAZEN MEMORY MOC (Version 2)</b></p>	 A photograph of a dark blue slip-on shoe, similar to the one in the previous row. It has a white, textured sole and a small white FILA logo on the side of the heel. The shoe is shown from a three-quarter perspective.

[US D688,446]



<p><b>SKECHERS U.S. DESIGN PATENT D688,446 S</b></p>
<p><b>FILA AMAZEN MEMORY MOC (Version 1)</b></p>



[Trade Dress illustration: Skechers Go Walk(R) (top); Fila Amazen Memory Moc (Version 1) (bottom)]



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

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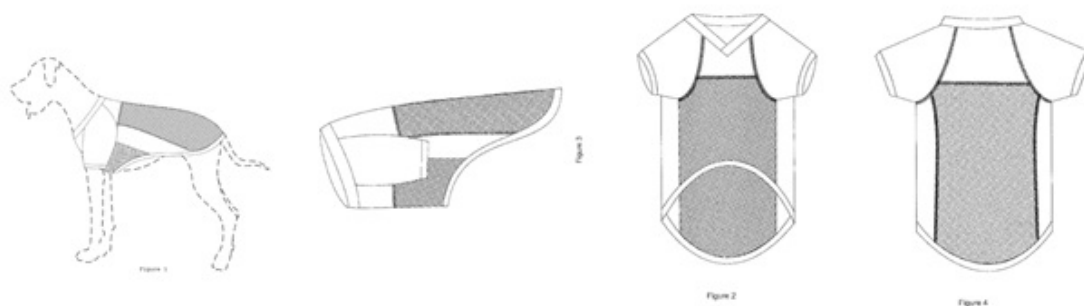


# PROTECTING DESIGNS

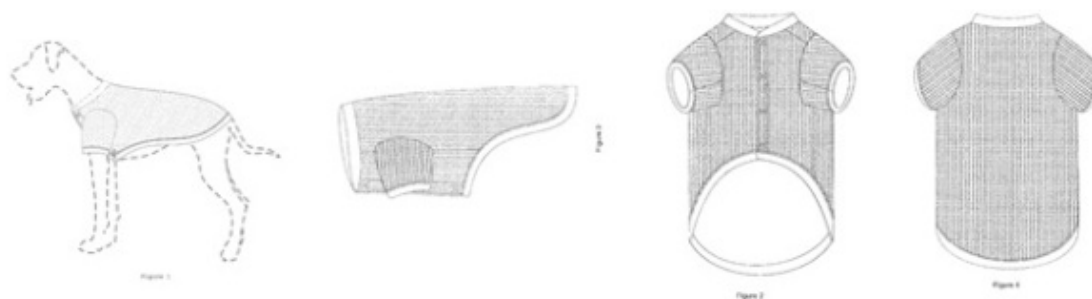
## MRC Innovations v. Hunter – to the Supreme Court!

On July 1, 2014, MRC Innovations filed a [Petition for Writ of Certiorari](#) in the Supreme Court of the United States. As we previously discussed on [April 22, 2014](#), in *MRC Innovations, Inc. v. Hunter Mfg., LLP*, No. 2013-1433 (Fed. Cir., Apr. 2, 2014), the Federal Circuit addressed the obviousness of patents (i.e., D634,488 and D634,487) covering ornamental designs for dog jerseys.

Figures from the '488 patent are reproduced below:



Figures from the '487 patent are reproduced below:



MRC appealed a grant of summary judgment of obviousness of both patents issued by Judge Gaughan from the Northern District of Ohio. The Federal Circuit affirmed.

In the Petition, MRC proposes a question as to whether the principle set forth in *KSR Int'l v. Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), "that when making an obviousness determination under 35 U.S.C. § 103 a court must provide an explicit analysis regarding whether there was an apparent reason to combine the known elements in the fashion claimed by the patent, also applies to design patents." Petition, page i.

The Petition argues "[a]s properly noted by the Federal Circuit more than 30 years ago, '35 U.S.C. § 103 (and all the case law interpreting that statute) applies with equal force to a determination of the obviousness of either a design or utility patent.' *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1441 (Fed. Cir. 1984)," but that "the Federal Circuit has

significantly departed from this Court's case law regarding 35 U.S.C. § 103 insofar as design patents are concerned." Petition, page 5.

Citing to *KSR*, the Petition argues that instead of a court providing "an explicit analysis explaining the apparent reason to combine known elements in the fashion claimed by the patent" for design patent cases, the Federal Circuit has rather relied on a "'so related' test in design patent cases that, when applied, entirely dispenses with the requirement that the court articulate whether there was an apparent reason (i.e., a "basis") to combine the known elements in the fashion claimed by the patent." Petition, pages 5-6.

In summary, MRC is arguing that the court must articulate a rationale for combining teachings of the prior art to arrive at the claimed design. In utility patent cases, this "rationale" must be articulated, consistent with *KSR*. See the exemplary rationales identified in [MPEP 2143](#).

The Petition argues that the Federal Circuit erred by merely requiring that certain elements of the claimed design be found in a related prior art, and that such a "so related" test is an "over simplification that substitutes relatedness for obviousness." Petition, page 18.

In some aspects, it appears MRC is arguing that the Federal Circuit applied a test similar to determining whether a prior art reference is analogous art. *In re Klein*, 98 USPQ2d 1991 (Fed. Cir. June 2011), established two tests for determining whether a reference is analogous and thus qualifies as prior art for an obviousness determination, citing to *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004):

Two separate tests define the scope of analogous prior art:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed and,
- (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

The USPTO issued examination guidance in view of *In re Klein* on July 26, 2011, which emphasized that a "reference not in the same field of endeavor as the claimed invention must be reasonably pertinent to the problem to be solved in order to qualify as analogous art and be applied in an obviousness rejection."

Turning back to the "so related" test discussed in the Petition, this test appears to be a summarization of the analogous art tests discussed above. Specifically, a reference is "so related" when it is in the same field of endeavor (first test) or when the reference is reasonably pertinent to the particular problem with which the inventor is involved (second test). For design cases, this second test may have limited applicability, because evaluation of the issue (at least as established by the USPTO in the examination guidance) requires a review of the problem to be solved by the claimed design, which may be difficult given there is generally no detailed discussion of problems in design applications.

However, merely concluding a prior art reference that teaches a specific design element is in the same field of endeavor, and is thus "so related," does not result in a proper and complete conclusion of obviousness. Specifically, the Supreme Court in *KSR*, 550 U.S. at 418, quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**"

Consequently, it appears MRC is arguing that the Federal Circuit merely applied a test to determine whether a prior art reference is analogous (i.e., "so related") in determining whether prior art design elements can render a design obvious, without establishing an "articulated reasoning" for combining the prior art design elements to arrive at the claimed design. Specifically, the Petition argues the "'so related' test allows for ... random picking and choosing of elements from the prior art without articulating any reasons or basis for doing so," and is thus not in accordance with the principle of *KSR*.

**Tags:** [Design Patents](#), [Federal Circuit](#), [Obviousness](#), [SCOTUS](#)

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## What about Tesla's Design Patents?

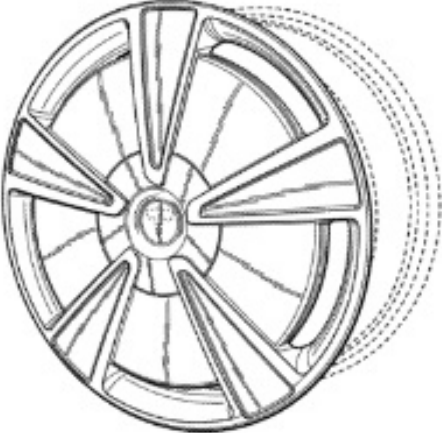


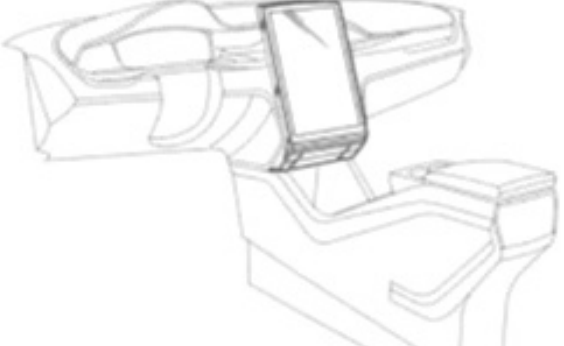
Tesla Motors announced in a [blog post](#) on June 12, 2014 that Tesla “will not initiate patent lawsuits against anyone who, in good faith, wants to use our technology.” It appears that Tesla’s goal is encourage the expansion of electric vehicle technology “in the spirit of the open source movement.” Tesla has been issued hundreds of utility patents since its inception. It remains to be seen if this strategy will work to Tesla’s advantage and if other companies will follow suit.



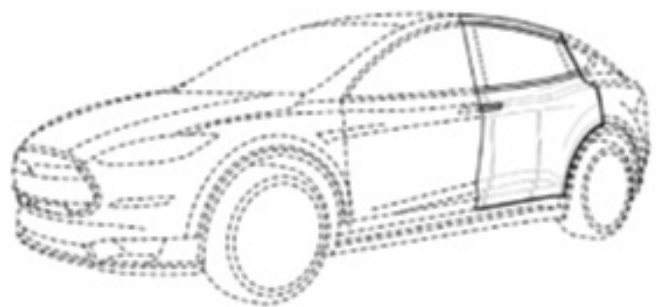
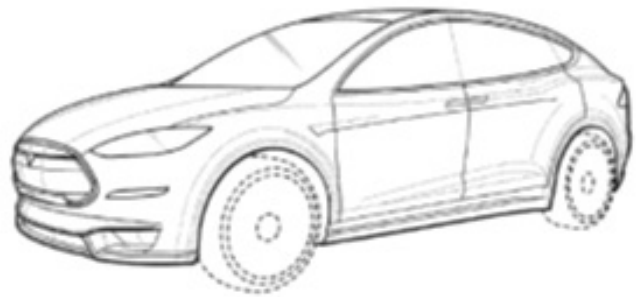
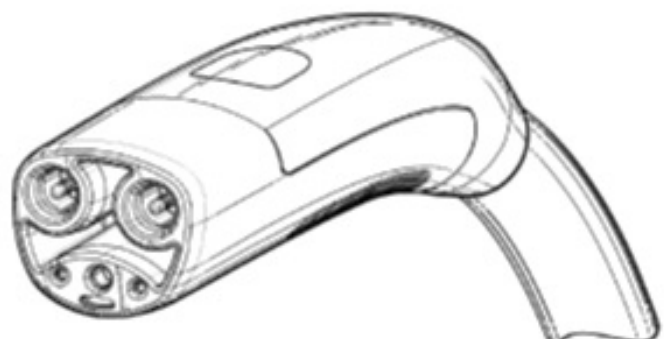
But what about Tesla’s design Patents?

Tesla is active with design patents. Over the last two years, Tesla has been issued several design patents that range from wheels to vehicle display mounts and vehicle designs. Additional design patents are probably on their way. The table below lists the design patents that have been issued to Tesla.

Tesla probably would not view copying or even improvement on its design patents as a “good faith” use of their technology. Opening up Tesla’s designs to its competition would hardly advance electric vehicle technology. Design patents, which are ornamental in nature, help a company differentiate itself from its competition, establish goodwill, and provide a strong source of protection. Tesla would probably view any use of its designs by its competitors as “bad faith.”

Likely, the last thing Tesla would want to see is a fleet of electric cars from multiple manufacturers that look exactly like Tesla’s vehicle designs. Nor would Tesla likely be pleased to see a competitor design an internal combustion engine vehicle that copies Tesla’s Model S.

Design Patent #	Title	Figure
D660,219	Vehicle wheel front face	
D660,767	Vehicle wheel front face	
D669,008	Vehicle wheel front face	
D672,307	Vehicle integrated display mount	

		
<p><a href="#">Design Patents, Patent Infringement</a></p> <p><b>D673,393</b> <b>Vehicle seat mount</b></p> <p>Copyright © 2023 Oblon, McClelland, Maier &amp; Neustadt, L.L.P.</p>		
<p><b>D678,154</b> <b>Vehicle door</b></p>		
<p><b>D683,268</b> <b>Vehicle</b></p>		
<p><b>D694,188</b> <b>Vehicle charge connector</b></p>		



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# PROTECTING DESIGNS

## Oakley v. Sunscape

Once again going on the offensive by asserting design patents in its portfolio, Oakley, Inc. (Oakley) filed a complaint for patent infringement against Sunscape Eyewear, Inc. (Sunscape) on February 14, 2014, in the Southern District of California (14Cv0358-BTM-DHB).

The complaint relates to the following thirteen design patents:

- D462,375 ('375 patent), issued in 2002, claiming Eyeglass and Eyeglass Components,
- D581,444 ('444 patent), issued in 2008, claiming Eyeglass Components,
- D581,443 ('443 patent), issued in 2008, claiming Eyeglasses Components,
- D569,412 ('412 patent), issued in 2008, claiming an Eyeglass and Eyeglass Components,
- D649,579 ('579 patent), issued in 2011, claiming an Eyeglass,
- D564,571 ('571 patent), issued in 2008, claiming an Eyeglass and Eyeglass Components,
- D547,794 ('794 patent), issued in 2007, claiming Eyeglasses,
- D554,689 ('689 patent), issued in 2007, claiming an Eyeglass frame,
- D556,818 ('818 patent), issued in 2007, claiming Eyeglass Components,
- D557,326 ('326 patent), issued in 2007, claiming Eyeglass Components,
- D616,919 ('919 patent), issued in 2010, claiming an Eyeglass Front,
- D610,604 ('604 patent), issued in 2010, claiming an Eyeglass and Eyeglass Components, and
- D620,970 ('970 patent), issued in 2010, claiming an Eyeglass Component.

Oakley asserted that the Defendant allegedly manufactured, sold, offered for sale and/or imported into the United States eyewear allegedly infringing Oakley's patent rights.


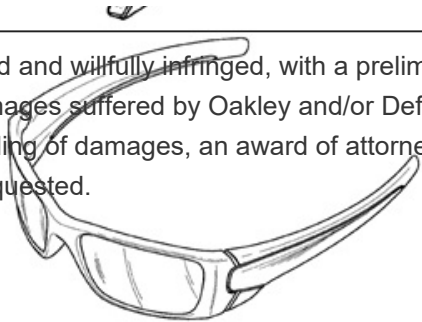
Oakley further asserted that it had provided the public with constructive notice of its patent rights by marking its products.

In the complaint, Oakley claimed that the Defendant was "knowingly, intentionally and willfully infring[ing] ... [the above-noted design patents] by making, using, selling, offering for sale and/or importing eyewear" allegedly covered by these design patents.

Oakley asserted that the Defendant had knowledge of the patents, infringed with reckless disregard for Oakley's patent rights, and knew or should have known that its actions constituted infringement.

Exhibits in the complaint included the above-noted patents, together with representations of the products allegedly infringing these patents. These representations, along with selected Figures from Oakley's patents, are reproduced alongside in the chart below.

Alleged Infringing Product	Claimed Design	Pat. No.
		'375
		'444, '443, and '412
		'579
		'571
		'794, '689, and '818
		'326

<p>Oakley requested that its thirteen patents be deemed valid and willfully infringed, with a preliminary and permanent injunction against the Defendant, and payment of “all damages suffered by Oakley and/or Defendant’s total profit from such infringement” to Oakley. Further demands included a trebling of damages, an award of attorney fees, and pre-judgment and post-judgment interests and costs. A jury trial was requested.</p>  <p>This case is ongoing.</p>		<p>'919, '604 and '970</p>
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**Tags:** Design Patents, Injunction

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## Oakley - US D523,461

Over the past few years Oakley Inc. (“Oakley”) has relied heavily on design patents to protect its product line. Most recently, Oakley filed a complaint for patent infringement against Thermor Ltd. (Thermor), Fry’s Electronics, Inc. (Fry), Best Buy Co. Inc. (Best Buy), Tool King LLC. d/b/a/ Toolking.com (Toolking), Laptop Travel, LLC., and Beach Trading Co., Inc. d/b/a/ Buydig.com (Buydig), (collectively “Defendants”) on February 14, 2014, in the Southern District of California (14CV0349-GPC-DHB).

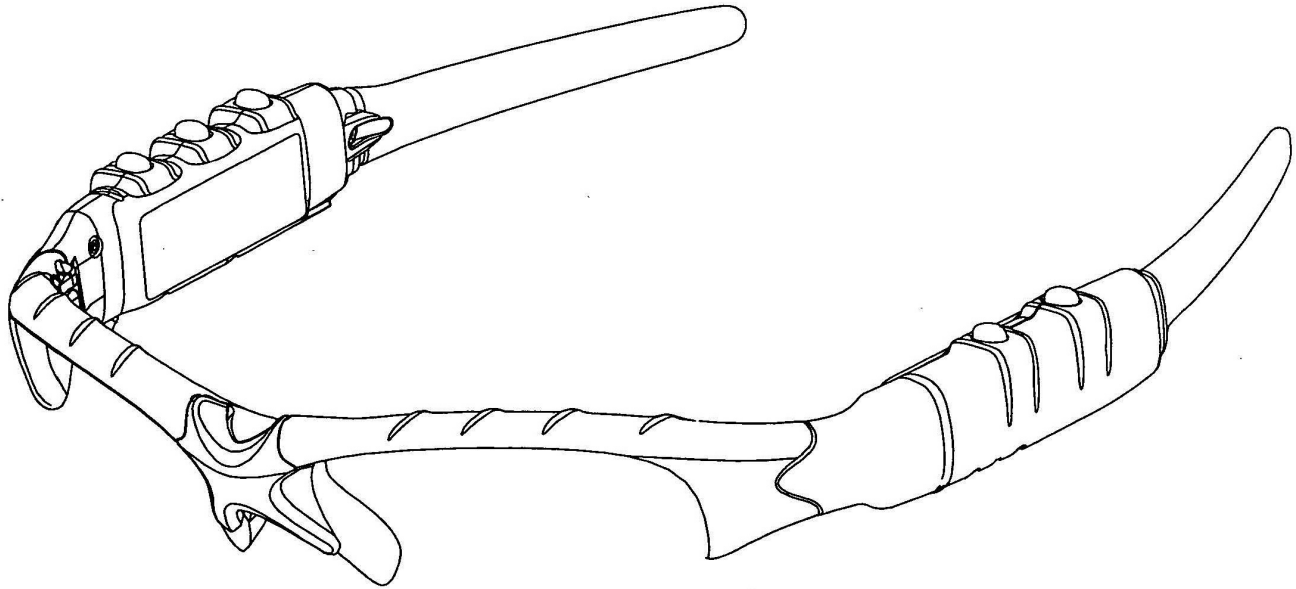
In the complaint, Oakley asserted that the Defendants manufactured, used, sold, offered for sale and/or imported into the United States, eyewear allegedly infringing Oakley’s Design Patent No. D523,461 (‘461 patent), directed to an Eyeglass Component. As discussed further below, Oakley has asserted the ‘461 patent on numerous occasions in the past.

[Oakley previously sued Hire Order, Ltd. on June 2012, \(3:12-cv-02346-DMS-WMC\)](#) over its ‘461 patent, demanding that Hire cease the sales of its Sportsman Eyewear video recording system.

In this case, Oakley claims Thermor was “knowingly, intentionally and willfully directly infring[ing], engag[ing] in acts of contributory infringement, and /or induc[ing] the infringement of the D461 patent by directly and/or directly making, using, selling, offering for sale and/or importing eyewear covered by the D461 patent.” Oakley listed Thermor’s BIOS Eyewear Cam as an allegedly infringing product.

Oakley made similar statements regarding Fry, and Fry’s BIOS Eyewear Cam, Best Buy and Best Buy’s Thermor – BIOS Eyewear Cam, Laptop Travel and their BIOS Eyewear Action Cam, as well as Toolking and Buydig for their Thermor 604FC BIOS Eyeware Action Camera.

Reproduced below is Figure 1 of the D461 patent, and a representation of the Thermor 604FC BIOS Eyeware Action Camera as listed on the Buydig.com website.



In the complaint, Oakley noted that the Defendant's alleged acts of infringement were undertaken without license from Oakley, that Defendants had "actual and/or constructive knowledge of the D461 patent ... [and] infringed the D461 Patent with reckless disregard of Oakley's patent rights." Oakley further argued that "Defendants knew, or it was so obvious that Defendants should have known" that their actions constituted infringement.

Oakley requested a preliminary and permanent injunction, damages allegedly suffered by Oakley and/or Defendants' total profit from the alleged infringement, with treble damages. Oakley further requested an award of attorney fees, and pre-judgment and post-judgment costs. A jury by trial was demanded.

This case is ongoing.

The '461 patent was also asserted by Oakley in the cases listed below, several of which are ongoing.

Case Number	Date Filed	Date Terminated	Outcome	Court	Note
8:11-cv-00456-JVS-PLA	03/22/11	06/28/12	Dismissed without Prejudice	Central District of California (Southern Division – Santa Ana)	
3:11-cv-01305-DMS-WMC	06/14/11	04/02/12	Default Judgment	Southern District of California (San Diego)	
3:13-cv-01292-DMS-WMC	06/04/13	09/04/13	Dismissed with Prejudice	Southern District of California (San Diego)	
5:11-cv-01975-JKG	03/22/11	05/12/11	Voluntary Dismissal by Plaintiff	Eastern District of Pennsylvania (Allentown)	Oakley as Defendant
1:11-cv-00034-LRR	03/21/11	08/02/11	Dismissed in deference to parallel action	Northern District of Iowa (Cedar Rapids)	Oakley as Defendant
2:09-cv-00624-JVS-AN	01/27/09	07/29/09	Default Judgment	Central District of California (Western Division – Los Angeles)	
8:09-cv-00062-JVS-AN	01/14/09	08/25/09	Dismissed with Prejudice	Central District of California (Southern Division – Santa Ana)	
3:12-cv-02346-DMS-RBB	09/26/12	N/A	Ongoing	Southern District of California (San Diego)	
3:14-cv-00349-DMS-RBB	02/14/14	N/A	Ongoing	Southern District of California (San Diego)	
3:14-cv-00270-LAB-BLM	02/14/14	N/A	Ongoing	Southern District of California (San Diego)	

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

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# PROTECTING DESIGNS

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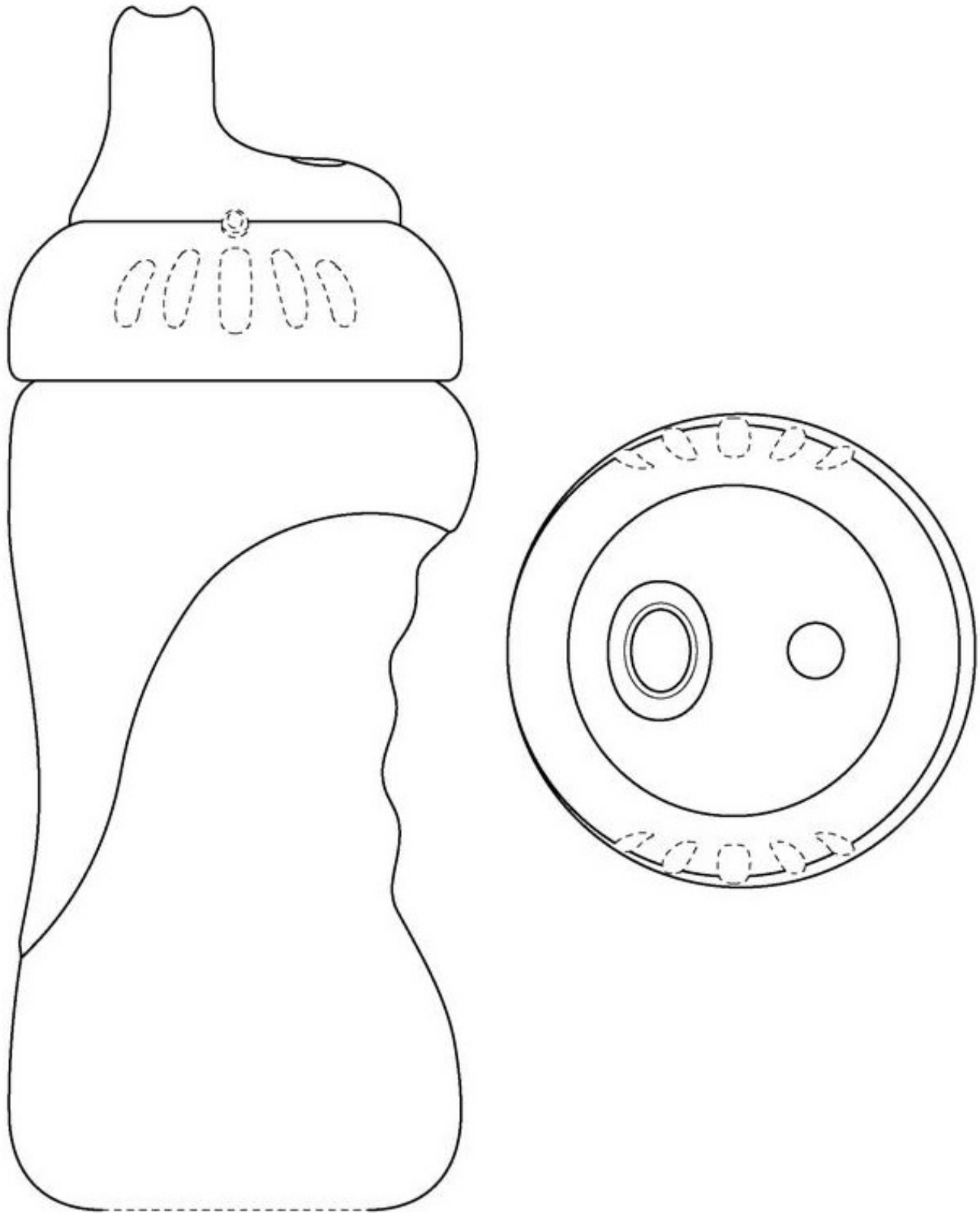
## PTAB: Munchkin v. Luv N'Care - Final Decision in IPR

On April 21, 2014 the USPTO's Patent Trial and Appeal Board issued a final written decision in *Munchkin Inc. et al. v. Luv N' Care Ltd.* (IPR2013-00072), the inter partes review of Luv N' Care Ltd.'s design patent for a baby drinking cup.

The PTAB found Luv N' Care Ltd.'s D 617,465 patent (the '465 patent) unpatentable. This is the first time that the USPTO has invalidated a design patent under a post-grant review process created by the America Invents Act.

The '465 patent claims a drinking cup. Figures 2 and 3 are reproduced below.





In January 2012, Luv N' Care filed an infringement suit for the '465 patent in the Southern District of New York, against Toys R Us and Munchkin (NYSD-2-12-cv-00228).

In the complaint, Luv N' Care stated that it had “generated hundreds of millions of dollars in revenue from the sale of goods under their trademarks and trade dress,” and that a series of competitors had allegedly “all deliberately copied [Luv N' Care's] designs, to illegally profit from them.”

Luv N' Care sued the Defendants on counts of alleged infringement, trade dress infringement and unfair competition, federal trademark dilution, unfair competition under New York law, violation of New York general business law, and contributory infringement.

The '465 patent was also involved in the Luv N' Care Ltd v. Regent Baby Products Corp, 10-9492 (S.D.N.Y filed Dec. 21, 2010), and Luv N' Care Ltd v. Royal King Infant Prod's Co. Ltd, 10-cv-00461 (E.D. Tex. Filed Nov. 4, 2010). Luv N' Care settled with Royal King Infant Prod's Co. Ltd, with Royal King agreeing to cease and desist from manufacture and sales of products likely to cause confusion.

In December 2012, Toys R Us and Munchkin ("the Petitioners") filed a petition for inter partes review, alleging that the '465 patent was obvious in view of two references, US 2007/0221604 (the '604 reference) and US 6,994,225 (the '225 reference). This was the first inter partes review initiated by the USPTO for a design patent.

The Patent and Trials Appeal Board (PTAB) determined that there was reasonable likelihood that the claim of the '465 patent would have been obvious over each of the '225 and '604 reference, and granted the petition for review.

First, Luv N' Care argued that its '465 patent was entitled to an earlier effective filing date of US Application No. 10/536,106 (the '106 application), thereby disqualifying the '225 and '604 references. In response, the Petitioners argued that the '106 application lacked written description support for the '465 patent, based on differences in the spout.

Figures from both the '465 patent and the '106 application are shown below, as reproduced from the PTAB's final written decision:

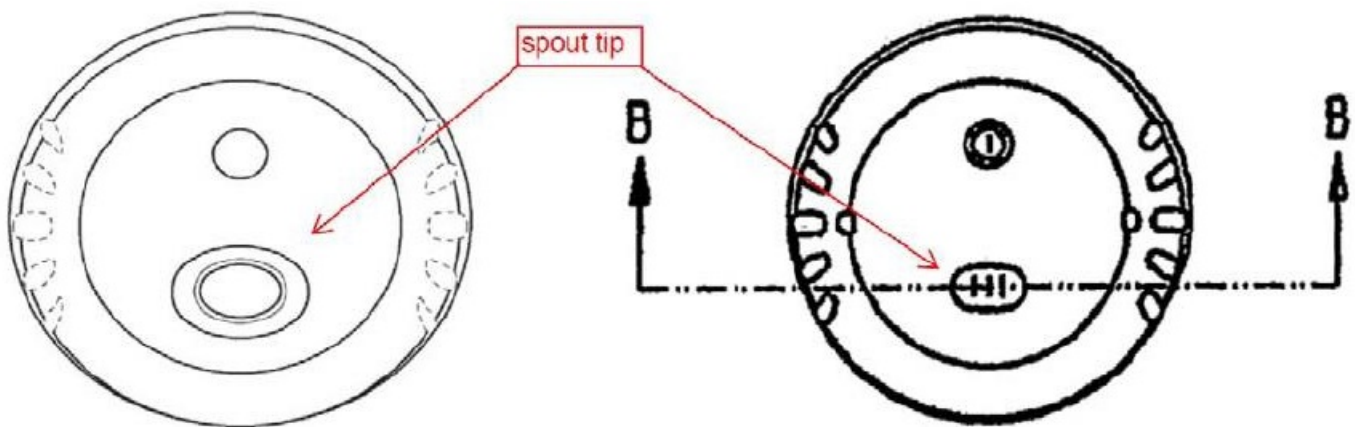


Fig. 3 of '465 patent  
(rotated 90° counter-clockwise)

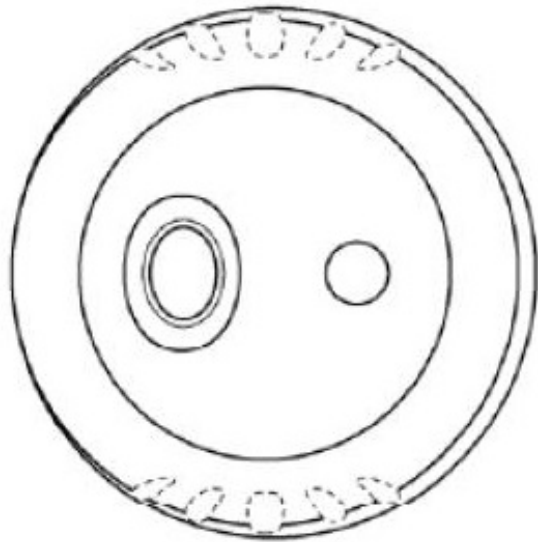
Fig. 12a of the '106 application

In its written decision, the PTAB stated the following differences "(1) the outer boundary of the spout tip of the claimed design is larger than that of the '106 application. ... (2) the spout tip of the claimed design has a different, more rounded, oval shape than that of the racetrack shape of the spout tip in the '106 application; and (3) the spout tip of the claimed design has three concentric rings that the '106 application does not disclose."

The PTAB further noted that although the '106 application stated that an oval or other shape may be used for the spout, the '106 application did not "identify the specific shape of the spout in the claimed design, or otherwise reasonably convey to those skilled in the art that the inventor had possession of the claimed design." Accordingly the PTAB concluded that the '465 patent was not entitled to the filing date of the '106 application. The written decision notes that counsel for Luv N' Care conceded that the claim was not patentable if denied the benefit of the filing date.

Second, Luv N' Care submitted a motion to amend the patent. As reiterated by the PTAB, a motion to amend the patent must be responsive to a ground of unpatentability at issue in the trial, and it may not enlarge the scope of the claims, or introduce new matter. The patent owner bears the burden to establish that it is entitled to the relief requested by its motion to amend.

The amendment proposed by Luv N' Care is shown in part below for Figure 3:



**'465 Patent – Fig. 3**



**Fig. 3 Proposed Amendment**

The PTAB stated that the “spout tip (left of center in each drawing above) is egg-shaped in the issued claim, whereas it is racetrack-shaped in the proposed amended claim. Additionally, the spout tip of the issued claim includes three concentric rings, whereas that of the proposed amended claim includes only two concentric rings.”

In its written decision, the PTAB stated that Luv N' Care effectively argued that the proposed amended claim “is not broader than the issued claim because to ‘an ordinary observer,’ the designs are ‘substantially the same.’” However, the PTAB stated that it was not “aware of any authority that has applied the ‘ordinary observer’ test ... to compare the scope of two claims.” The PTAB further noted that “the proposed amended claim is broader than the issued claim because it is broader with respect to racetrack-shaped spout tips and raised rim vents, even though it may be narrower with respect to egg-shaped spout tips and vents without raised rims.”

The PTAB held that the Petitioners had “shown by a preponderance of evidence that the sole claim of the ‘465 patent is unpatentable, and [Luv N' Care] has not met its burden of proof on the motion to amend.”

**Tags:** [Design Patents](#), [Invalidation](#), [PTAB](#), [Post-grant Review](#)

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# PROTECTING DESIGNS

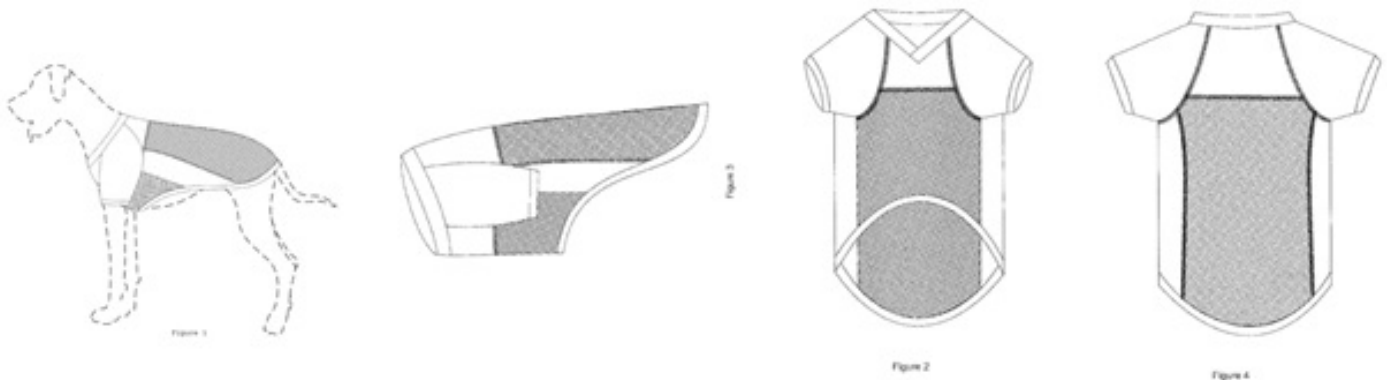
## MRC Innovations v. Hunter – A Decision with Bite for Design Patent Owners?

In *MRC Innovations, Inc. v. Hunter Mfg., LLP*, No. 2013-1433 (Fed. Cir., Apr. 2, 2014), the Federal Circuit addressed the obviousness of patents covering ornamental designs for dog jerseys. In doing so, the analysis raises questions about whether the Federal Circuit has fully moved beyond the at times dismissive approach to design patents that has characterized some of its decisions in years past.

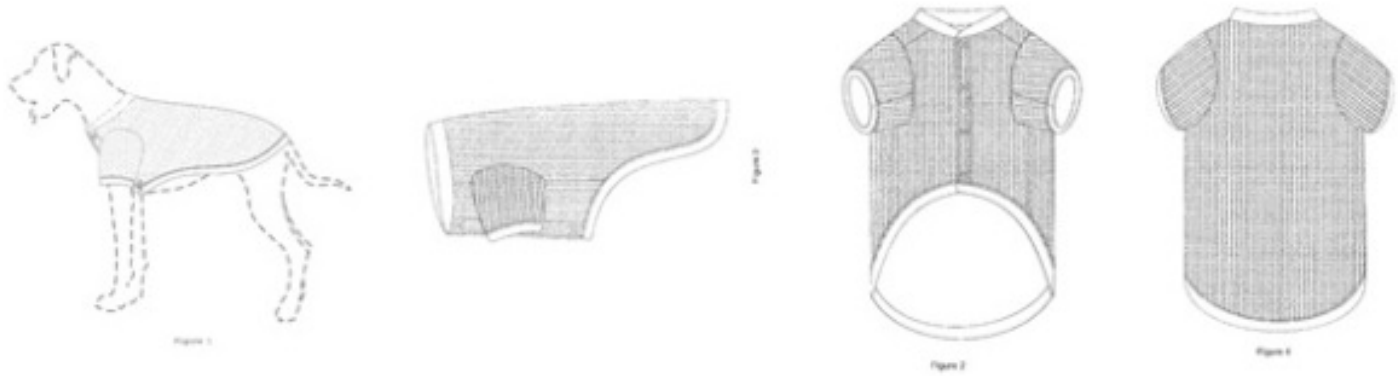
### The Decision

MRC Innovations, Inc. (MRC) owns two design patents, D634,488 (“the ‘488 patent”) and D634,487 (“the ‘487 patent”) for an ornamental design for a football and baseball jersey for a dog, respectively.

Figures from the ‘488 patent are reproduced below:

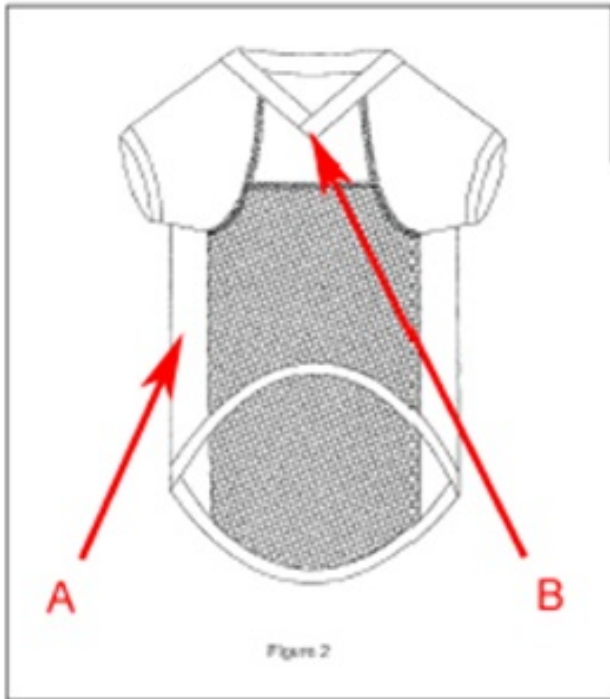


Figures from the ‘487 patent are reproduced below:



MRC appealed the grant of a summary judgment of obviousness of both patents issued by Judge Gaughan from the Northern District of Ohio. The district court specifically found the '488 patent invalid over a prior art jersey referred to as the V2 and an Eagles jersey. Reproduced below are images of the V2 jersey and Eagles jersey, respectively, as shown in the Federal Circuit's opinion. Slip Op. at 4.

The '488 Patent - Fig. 2 (Front)



The '488 Patent - Fig. 4 (Back)



Eagles Jersey - Front



Eagles Jersey - Back



The Federal Circuit further agreed that the secondary references identified by the District Court (the V2 jersey and another reference known as the “Sporty K9”) were “so related’ to the Eagles jersey that the striking similarity in appearance across all three jerseys would have motivated a skilled designer to combine features from one with features of another.”

Finally, the Federal Circuit stated that MRC “had not established a nexus between the secondary considerations and the claimed design that was sufficient to overcome the other evidence of obviousness.”

A similar analysis was performed for the '487 patent which again resulted in the Federal Circuit affirming the district court's decision that the '487 patent was obvious in view of the prior art. A side by side comparison of the '487 patent and the Sporty K9 baseball jersey which was used as the primary reference is reproduced below from Appellant's Opening brief (p. 35).



### Comments

Setting aside the ultimate conclusion of obviousness at the summary judgment stage, several statements in the opinion are troubling. The first lies with two gratuitous, though often repeated, statements from earlier design patent opinions. These

statements have rankled design patent owners in the past, but are apparently alive and well. The second concern lies with the Federal Circuit's discussion of features found to constitute similarities between the '488 patent design and the prior art.

The first gratuitous statement relates to the scope of design patents generally. Specifically, in 1988 the Court in *In re Mann* stated that design patents have "almost no scope." Slip op. at 9, fn. 1, citing 861 F.2d 1581, 1582 (Fed. Cir. 1988). While the *MRC* decision goes on to point out that differences in visual appearance have been permitted in an infringement analysis, citing to the *Crocs* case from 2010, the question is why the Court felt the need to reference *In re Mann* at all. More fundamentally, the statement in *In re Mann* cannot withstand scrutiny when considered in light of the U.S. Supreme Court's bedrock decision in *Gorham v. White*, the statute (35 USC § 289), and the Federal Circuit's *en banc* decision in *Egyptian Goddess*.

In *Gorham*, the Supreme Court found infringement of spoons that differed in numerous respects from the claimed design. In doing so, the Supreme Court did not say that design patents have almost no scope. Instead, the Supreme Court took quite the opposite approach and criticized the lower court for using too exacting of a standard for comparing the accused products to the patented design. The Supreme Court held that "if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." 81 U.S. 511, 528 (1872).

The *In re Mann* statement is also out of tune with the Federal Circuit's statement in *Pacific Coast Marine Windshields v. Malibu Boats*. 739 F.3d 694 (Fed. Cir. 2014). In *Malibu Boats* the Court pointed out that an infringement analysis of a design patent effectively involves both literal infringement and infringement by equivalents due to language of 35 U.S.C. § 289. It stated:

For design patents, the concepts of literal infringement and equivalents infringement are intertwined. Unlike the provisions defining infringement of a utility patent, the statutory provision on design patent infringement does not require literal identity, imposing liability on anyone who "without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied . . . ." 35 U.S.C. § 289 (emphases added).

(739 F.3d at 701, emphasis in original)

As *Malibu Boats* points out, the statutory test for infringement does not require identity, but merely any colorable imitation of the design. Nothing in the statute that suggests that design patents have almost no scope.

One can further ask if the *In re Mann* statement has any relevance after the Federal Circuit's *en banc* decision in *Egyptian Goddess*. There the Court held that where two designs are not plainly dissimilar, it is appropriate to consider the prior art when determining infringement. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed Cir. 2008) (*en banc*). The logic in *Egyptian Goddess* necessarily means that the scope of a design patent may vary depending on the prior art. Where there are no similar designs in the prior art, a design patent owner should expect greater scope for his patent. On the other hand, in a crowded art, the scope of a design patent may be narrower. The blanket statement from *In re Mann* that patents have "almost no scope" is thus flatly inconsistent with *Egyptian Goddess*, for example, in instances where the prior art is far removed from a patented design. When considered in light of *Gorham*, 35 U.S.C. § 289, and *Egyptian Goddess*, design patent owners would be better served if the Federal Circuit disavowed the *In re Mann* statement entirely. Doing so would avoid confusion in the district courts and inappropriate grants of summary judgment of non-infringement.



The second gratuitous statement springs from *In re Rosen's* discussion of obviousness in 1982. There the CCPA stated that in comparing a potential primary reference to a patented design, the “trial court judge may determine almost instinctively whether the two designs create basically the same visual impression.” 673 F.2d 388, 391 (CCPA 1982); Slip op. at 6. This statement is also fraught with danger for design patent owners. Obviousness must be viewed from the perspective of an ordinary designer. Is it truly appropriate to expect a district court judge to look at two different designs with the same scrutiny as an ordinary *designer* based only on the judge's personal experience? In any event, while the CCPA qualified its observation by stating that the district court judge must also communicate the reasoning behind its decision, the effect of this statement can be equally detrimental to design patent owners. The obvious danger is that district courts may feel free to substitute their own views for that of the fact finder, even where reasonable minds may differ, and too readily grant summary judgment.

The combination of *In re Mann's* statement that design patents have almost no scope and *In re Rosen's* statement that judges can instinctively find patents obvious makes design patents highly vulnerable. Both statements should be retired from the Federal Circuit's jurisprudence.

The next cause for concern in *MRC* requires an examination of the Court's reasoning in applying the prior art to the '488 patent. To its credit, the Court's discussion attempts to identify specific design features shared between the prior art jerseys and the patented design. But consider the five features identified, especially those identified as “key” design similarities (emphasis and interpolation supplied):

First, the district court pointed out three key similarities between the claimed design and the Eagles jersey: **[1] an opening at the collar portion for the head, [2] two openings and sleeves stitched to the body of the jersey for limbs, and [3] a body portion on which a football logo is applied.** *MRC*, 921 F. Supp. 2d at 809. If the district court's analysis had ended there, it might indeed have failed to meet the *High Point* verbal description requirement. However, the district court went on to point out two additional similarities between the two designs: first, the Eagles jersey is made “primarily of a mesh and interlock fabric”; and second, it contains at least some ornamental surge stitching—both features found in the '488 claimed design. *Id.* The district court also went on to acknowledge the three major differences between the two designs that are enumerated above. *See id.* Taking all of those things together (the at least five design characteristics that the claimed design shares with the Eagles jersey and three design characteristics that differ from it), the district court painted a clear picture of the claimed design.

(Slip. Op. at 8)

The three “key similarities” are (1) an opening at the collar portion for the head, (2) two openings and sleeves stitched to the body portion, and (3) a body portion with a logo. Each of these features is highly generic and applicable to any sports jersey. In addition, most of these features appear to be dictated by function (e.g., openings for heads and arms, sleeves, body portion) rather than *design* features. Thus, each of the three “key similarities” do not advance the discussion of comparing the *design* of the prior art and the '488 patent.

Despite characterizing these as key features, the Federal Circuit acknowledged that if the district court had mentioned only these features it would have failed to characterize the visual impression of the patented design with sufficient specificity. The decision thus discussed two further features found to be similar in the prior art and the '488 patent. Remarkably, however, the opinion then went back and again relied on the three discredited generic features by concluding that five features (including the three “key” features) supported similarity between

the Eagle jersey and the patented design. This logic is deeply disturbing and should make any design patent owner nervous. The decision even seems to imply that the number of features shared by the prior art and the patented design (five similar as opposed to three different) matters, adding further sting to the Court's reliance on three features applicable to almost any sports jersey.

Where future Federal Circuit decisions addressing summary judgment of obviousness and infringement of design patents will go from here is difficult to say. Unfortunately, the approach in *MRC* strongly suggests that the bar remains high for design patent owners. Surviving summary judgment and reaching trial before a jury in a design patent case may remain the rare exception for some time to come.

[Anne-Raphaëlle Aubry](#) and [Andrew M. Ollis](#) collaborated on this post.

**Tags:** [Design Patents](#), [Federal Circuit](#)

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# PROTECTING DESIGNS

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## Written Description – Where do we go from here?

As [previously reported](#), the USPTO [published](#) on February 6, 2014, a Request for Comments on the Written Description Requirements for Design Applications. The Request followed a heated discussion during **Design Day 2013** when USPTO Design Practice Specialist, Mr. Joel Sincavage gave specific examples illustrating an original design claim and an amended design claim where, in the amended claim, only a subset of elements of the original disclosure were shown using solid lines.

The USPTO seemed to take the position that, in these “rare situations,” the inventor may not have had possession of the newly claimed design because the claimed subset of elements was “seemingly unrelated” to the original design. Some members of the public attending Design Day raised concerns regarding the Office’s position.

In response to these concerns, the USPTO issued the Request for “comments on the application of the written description requirement where only a subset of elements of the original disclosure are shown using solid lines in an amendment or in a continuation application.” In its Request, the Office proposed the following factors to “only be applied by design examiners in the rare situation where there is a question as to whether an amended/continuation design claim satisfies the written description requirement:

- (1) The presence of a common theme among the subset of elements forming the newly identified design claim, such as a common appearance;
- (2) the subset of elements forming the newly identified design claim share an operational and/or visual connection due to the nature of the particular article of manufacture (e.g., set of tail lights of an automobile);
- (3) the subset of elements forming the newly identified design claim is a self-contained design within the original design;
- (4) a fundamental relationship among the subset of elements forming the newly identified design claim is established by the context in which the elements appear; and/or
- (5) the subset of elements forming the newly identified design claim gives the same overall impression as the original design claim.”

A round-table was held by the Office on March 5, 2014, during which most members of the public voiced their opposition to the proposed guidelines and factors. Criticisms included the non-compliance of the proposed guidelines with judicial precedent, the uncertainty created by the factors, and the potential loss of flexibility for *all* applicants while addressing “rare situations” where an applicant might be trying to game the system.

The window for comments closed on March 14, 2014. Of note, The IPO and the AIPLA submitted comments strongly opposing the new guidelines and factors.

In its comments, the IPO advocates the *status quo*, relying on the 1989 *en banc* Federal Circuit decision in *Racing Stroller*. In this case, the Court applied a simple visual test for determining compliance with the written description requirement. If the claimed design is “depicted” in the earlier drawings, then the requirement is met.

Nevertheless, the IPO considered a rule change to address the USPTO’s hypothetical checkered board scheme, where the original drawing is a grid of squares shown in solid lines and the amendments consist of selections of some of the squares forming designs such as a cross, an X, etc. The IPO proposed the following test to address this rare and academic situation, which seems to concern the Office so much:

*An amended design patent claim may not have written description support in the original disclosure when a designer of ordinary skill would not recognize any relationship between the claimed design and the original disclosure.*

Of interest, the IPO proposal ties the test to a designer of ordinary skill in the art. This connection should allow applicants to submit expert declarations in support of their position that the amendments are supported by the original disclosure.

The AIPLA also opposes the USPTO’s proposed factors. The AIPLA points to the uncertainty created by these new factors and their inconsistent application by the Office. The increase in the size and cost of preparing design applications as a result of this uncertainty is another stated reason for opposing the USPTO proposal. The AIPLA thus “urges the Office to adopt the following Examination guideline as an alternative to the factors suggested in the Request:

*an amended claim that does not add subject matter to the original disclosure or remove subject matter claimed in the original disclosure satisfies the written description requirement unless the amended claim introduces a claimed element not “reasonably discernible” from the original disclosure.”*

The AIPLA adds explanations regarding the meaning of adding and removing subject matter when changing solid lines to broken lines. The Association also emphasizes several concerns about each of the factors proposed by the USPTO.

### **So, where do we go from here?**

The USPTO has agreed to review the comments submitted and may issue another Federal Register notice relating to the written restriction requirement. In the meantime, Design Day 2014 will be here next week, and we may hear more on this topic from the USPTO on this occasion. We will attend this annual event and report its highlights here on our blog.

**Tags:** [Design Day](#), [Design Patents](#), [USPTO](#), [Written Description](#)



# PROTECTING DESIGNS

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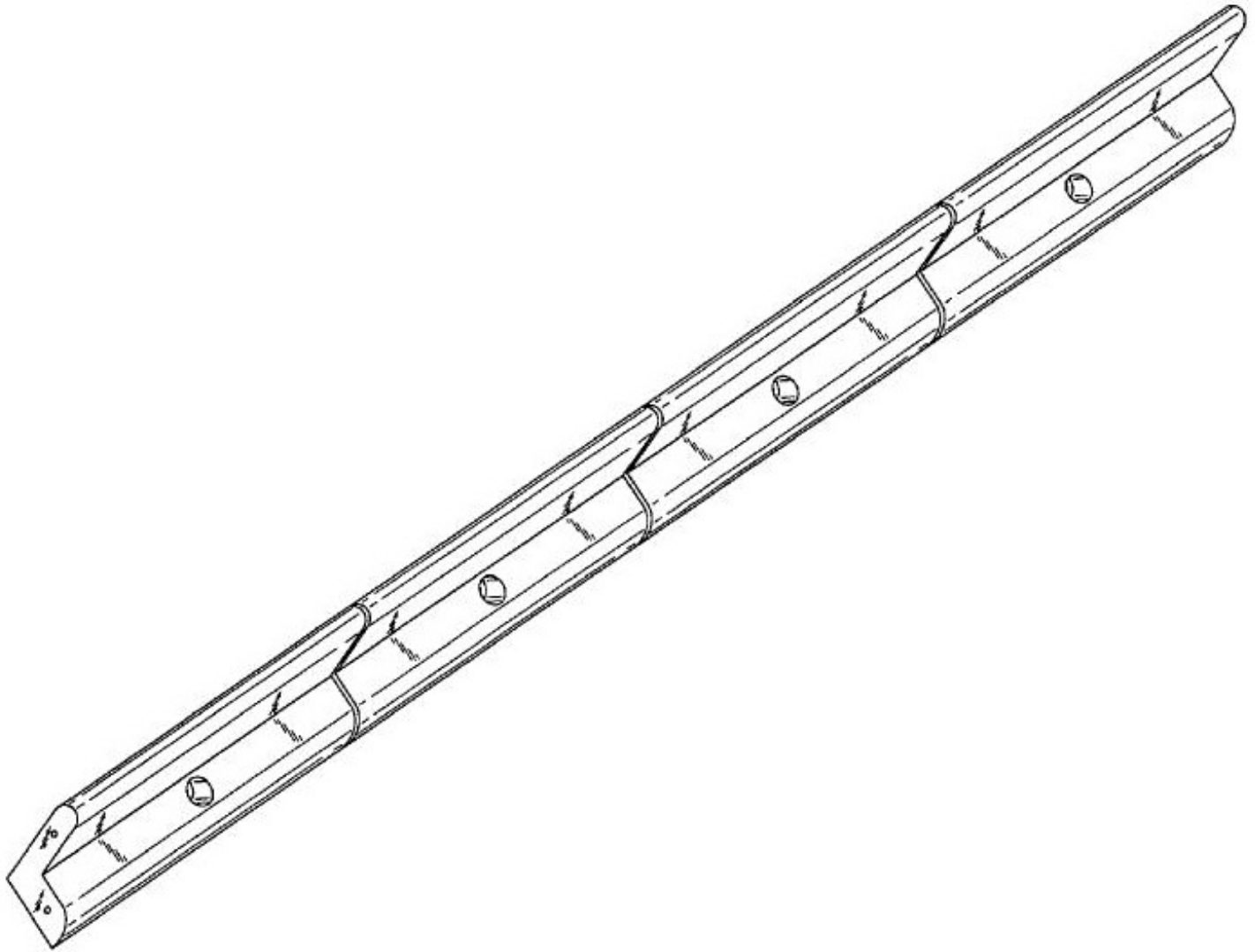
## Mulch v. Novel - Request for Declaratory Judgment

International Mulch Company, Inc. (Mulch) filed a [complaint](#) requesting declaratory judgment against Novel Ideas, Inc. (Novel) in the Eastern District of Missouri Eastern Division on March 11, 2014 (4-14-cv-00446).

In the complaint, Mulch requested a Declaratory Judgment of patent non-infringement and invalidity of two design patents owned by Novel, US D640,268 ('268) and US D654,191 ('191), both directed to flexible landscape edging.

Mulch stated that it began selling a lawn edging product to Lowe's, and that Novel allegedly took the position that Mulch's lawn edging product infringed the '268 and '191 patents. Mulch further stated it had informed Novel that its product did not infringe Novel's patents, and argued the ornamental design of their product differed from Novel's patented design due to the product having an "appearance of variable sized cobblestones," "a squared-off top," "three holes for stakes," and a "rounded inside corner."

Figure 1 of the '268 patent is reproduced below:



In the complaint, Mulch stated Novel had allegedly “on information and belief, communicated directly to Lowe’s, taking the position that the [Mulch] lawn edging product being sold by Lowe’s infringe[d] the 268 Patent and the 191 Patent.” Mulch declared “apprehension that Novel will commence litigation” against Mulch and/or Lowe’s.

Mulch argued non-infringement of both the ’268 and ’191 patents, and stated that the alleged allegations of patent infringement “have placed a cloud over [Mulch’s] business, ... are likely to cause [Mulch] to lose revenues and business opportunities, ... and will likely cause irreparable injury to [Mulch].” Mulch further argued invalidity of both the ’268 and ’191 patents “due to functionality.”

In its prayer for relief, Mulch requested that Novel be prevented from “interfer[ing] in any way with [Mulch’s] manufacture, use, offer for sale, or sale of [Mulch’s] lawn edging product. A trial by jury was requested.

This case is ongoing.

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





# PROTECTING DESIGNS

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## Interim Rule Regarding Continued Prosecution Applications

The United States Patent and Trademark Office (Office) has adopted an [interim rule](#), effective March 5, 2014, pertaining to **Continued Prosecution Applications (CPAs)**, which are only available for design patent applications.

**A CPA is typically filed when prosecution on the merits is closed in a design patent application. For example, after the Examiner issues a final rejection in a design application, the Applicant may file a CPA in order to continue prosecution in front of the Examiner, instead of appealing the final rejection to the Patent Trial and Appeals Board.** A Request for Continued Examination (RCE) is not allowed in a design patent application.

The interim rule permits the filing of a CPA even if the prior design application does not contain the inventor's declaration if the CPA is filed on or after September 16, 2012, and the prior design application contains an application data sheet indicating the name, residence, and mailing address of each inventor.

The Leahy-Smith America Invents Act (AIA) generally revised and streamlined the requirements for the inventor's declaration. In implementing the AIA inventor's declaration provisions, the Office provided that an applicant may postpone the filing of the inventor's declaration until allowance if the applicant provides an application data sheet indicating the name, residence, and mailing address of each inventor.

However, the rules pertaining to CPAs still required that the prior design application of a CPA be complete, which required that the prior design application contain the inventor's declaration. The interim rule eliminates this requirement for CPAs in order to align CPA practice with the general provisions of the AIA. Under the new rules, applicants no longer need to file the inventor's declaration in a prior design application in order to file a CPA of that application.

As a side note, the Office found "good cause to adopt the changes in this interim rule without prior notice and an opportunity for public comment, as such procedures are contrary to the public interest."

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

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# PROTECTING DESIGNS

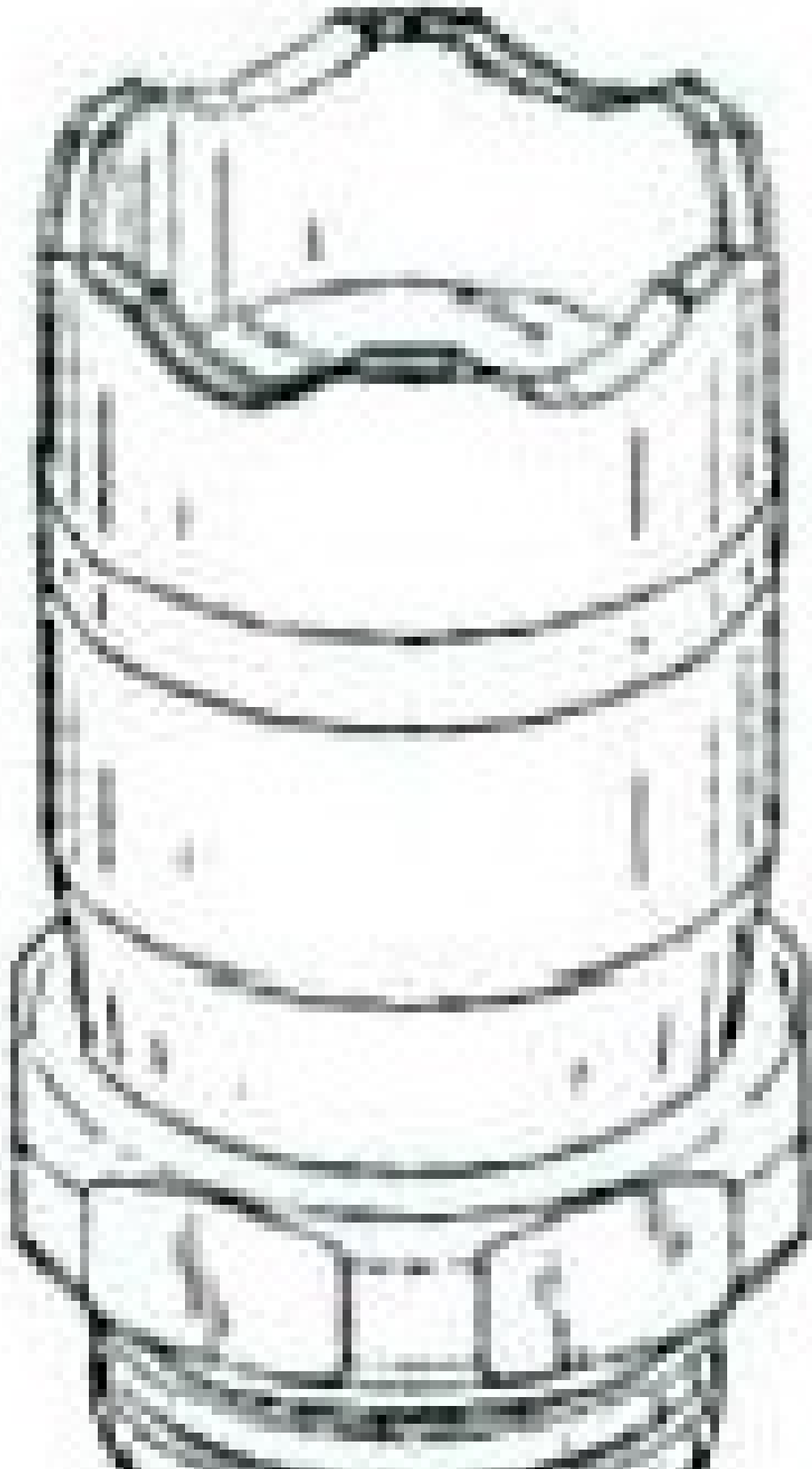
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## Skyline Design Patent Complaints

Skyline USA, Inc. (Skyline) recently filed two complaints asserting infringement of a design patent directed to a combined flashlight and stun gun.

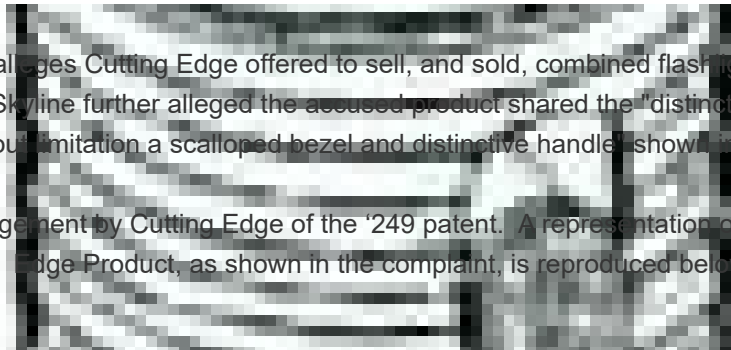
In the [first complaint](#) filed February 7, 2014, Skyline alleged infringement by Cutting Edge Products, Inc. (Cutting Edge), in the Middle District of Florida, Orlando division (6:14-cv-212-ORL-36GJK).

The complaint relates to Design Patent No. D671,249 ('249 patent), which issued November 20, 2012, and claimed a combined flashlight and stun gun. Figure 1 of the '249 patent, as shown in the complaint, is reproduced below.



In the complaint, Skyline alleges Cutting Edge offered to sell, and sold, combined flashlights and stun guns within the scope of the '249 patent. Skyline further alleged the accused product shared the "distinctive overall appearance, which includes without limitation a scalloped bezel and distinctive handle" shown in the '249 patent.

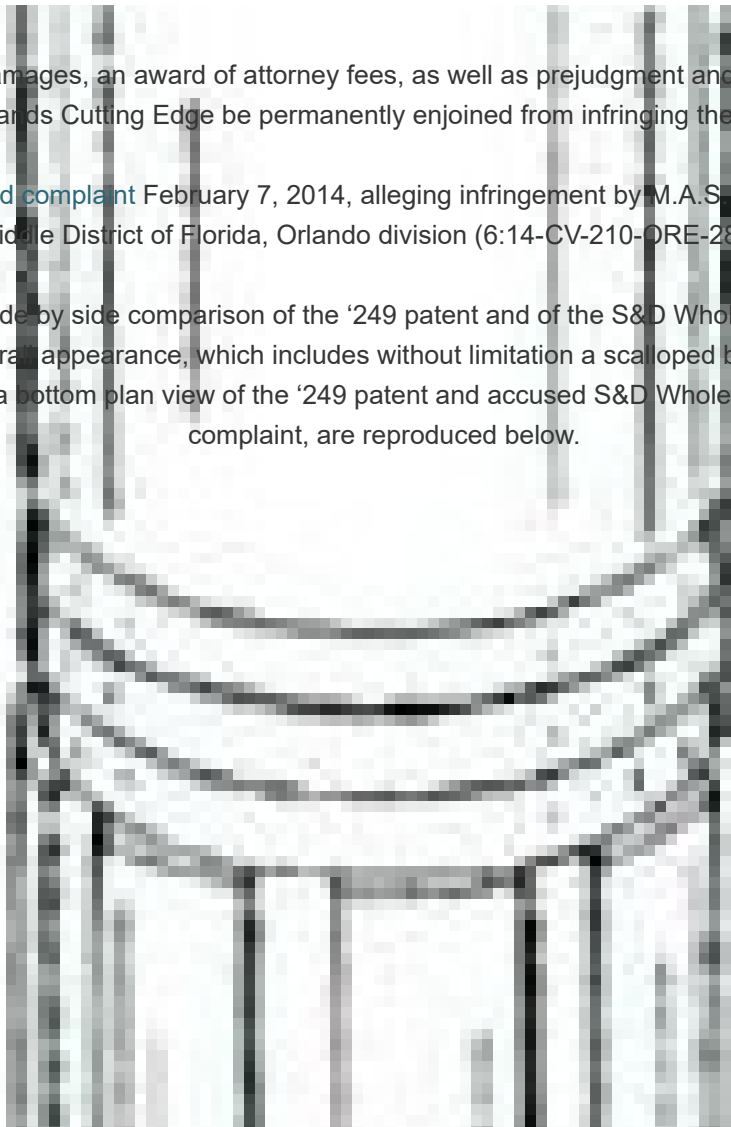
Skyline asserts willful infringement by Cutting Edge of the '249 patent. A representation of the alleged infringing Cutting Edge Product, as shown in the complaint, is reproduced below.

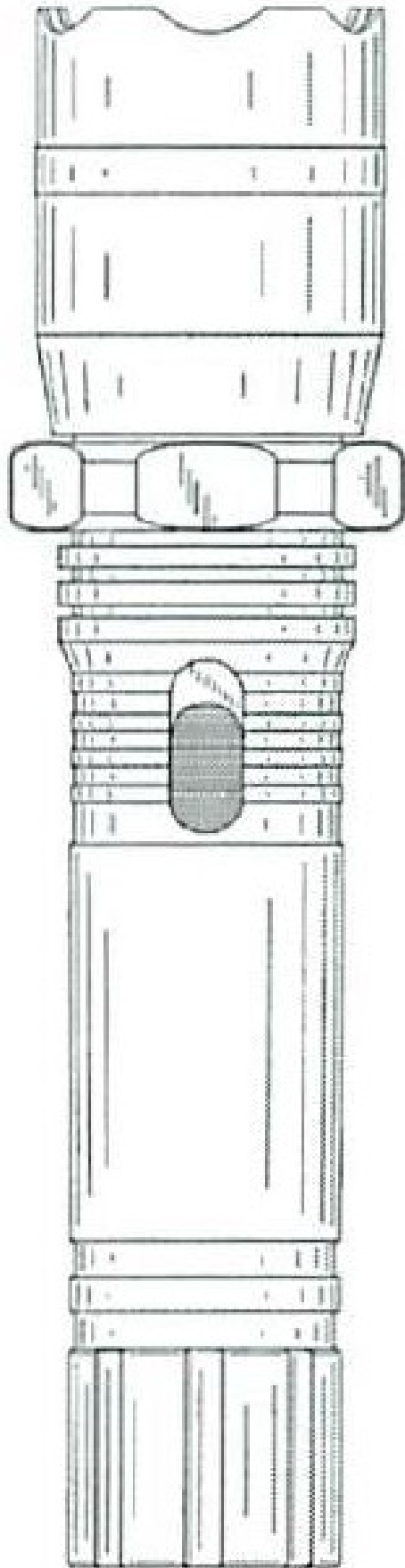


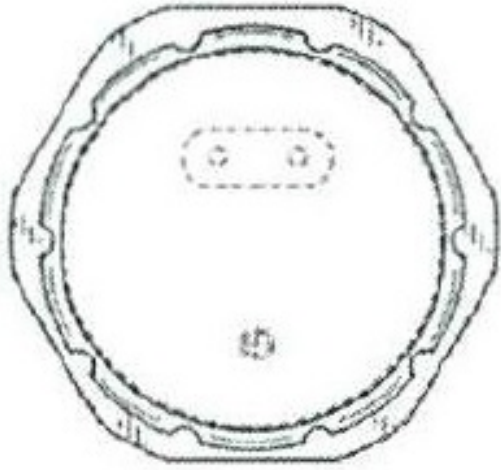
Skyline requested treble damages, an award of attorney fees, as well as prejudgment and post judgment costs. Skyline also demands Cutting Edge be permanently enjoined from infringing the '249 patent.

Skyline filed a similar [second complaint](#) February 7, 2014, alleging infringement by M.A.S. Ga LLC d/b/a/ S&D Wholesale (S&D Wholesale), in the Middle District of Florida, Orlando division (6:14-CV-210-ORE-28K), regarding the '249 patent.

The complaint includes a side by side comparison of the '249 patent and of the S&D Wholesale product, and alleges the two share a "distinctive overall appearance, which includes without limitation a scalloped bezel and distinctive handle." A rear elevational view and a bottom plan view of the '249 patent and accused S&D Wholesale product, as shown in the complaint, are reproduced below.







Skyline asserts willful infringement by S&D Wholesale of the '249 patent, and made requests identical to those in its complaint against Cutting Edge.

Both of these cases are ongoing.

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

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# PROTECTING DESIGNS

## Gillette Design Patent Enforcement

Over the past 6 months the Gillette Company (Gillette) has filed two different complaints asserting infringement of numerous design patents to protect several of its razor blade related products. In the first case, Gillette recently obtained a consent judgment, illustrating the value of design patents in its patent portfolio. The second case is ongoing.

First, on October 10, 2013, Gillette filed a complaint against BK Gifts, BK Razors, Brian Patrick, Kim Murry, and Zilo Store, Inc. (collectively, "Defendants"), in the Southern District of Ohio (*Gillette Company v. BK Gifts*, transferred to the Northern District of Ohio, Docket No. 3-13-cv-02241-1).

The suit related to the following six design patents, which Gillette asserted covered the "valuable, unique and distinctive ornamental distinctive and non-functional design" of their razors:

- D415,315 ('315 patent), issued on October 12, 1999, claiming "the ornamental design for a razor cartridge,"
- D422,751 ('751 patent), issued on April 11, 2000, claiming "the ornamental design for a razor blade cartridge,"
- D430,023 ('023 patent), issued August 29, 2000, claiming "the ornamental design for a container,"
- D440,874 ('874 patent), issued April 24, 2001, claiming "the ornamental design for a container,"
- D531,518 ('518 patent), issued on November 7, 2006, claiming "the ornamental design for a dispenser for razor cartridges," and
- D575,454 ('454 patent), issued on August 19, 2008, claiming "the ornamental design for a shaving blade unit."

The '315 patent is set to expire on October 12, 2013 and the '751 and '023 patent will expire in 2014.

Figure 1 of the '751 patent, Figure 1 of the '518 patent, and Figure 1 of the '454 patent are shown below, respectively.



component of their business on direct copies and near exact imitations of Gillette's product as embodied in the design of the '751 patent.

Gillette filed for injunctive relief and damages, individually and collectively for joint and several liability, and for willful infringement from both JCG and PNL. Gillette further requested an assessment of Gillette's damages and/or Defendant's profits, an award of attorneys' fees to Gillette. A trial by jury was demanded. This case is ongoing.

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

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# PROTECTING DESIGNS

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## USPTO PUBLISHES REQUEST FOR COMMENTS AND NOTICE OF ROUNDTABLE EVENT ON THE WRITTEN DESCRIPTION REQUIREMENT FOR DESIGN APPLICATIONS

On February 6, 2014, the USPTO published in [79 FR 7971](#):

1. a notice that it will be hosting a roundtable event on March 5, 2014, from 1:00 p.m. to 4:00 p.m.; and
2. a request for written comments on the following topics for discussion at the roundtable event. Registration is required to attend in-person or by webcast. Requests for participation as a speaker must be made in writing by February 14, 2014. The USPTO has also [published additional information on its website](#).

The topics for written comments and discussion at the roundtable event include:

1. Factors in Determining Whether an Amended/Continuation Design Claim Satisfies the Written Description Requirement; and
2. Establishing Adequate Written Description Support in the Original Disclosure.

Specifically, the USPTO is seeking “comments on the application of the written description requirement where only a subset of elements of the original disclosure are shown using solid lines in an amendment or in a continuation application.” The request for comments derives from discussion during [Design Day 2013](#). Notably, however, the USPTO indicated that it “is not seeking comments on the issue of the introduction of boundary lines via amendment or in a continuation application, as addressed in *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013).”

**Tags:** [Design Day](#), [USPTO](#), [Written Description](#)

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# PROTECTING DESIGNS

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## IPO submits comments regarding Proposed Hague Rules

As [previously reported](#), on November 29, 2013, [78 FR 71869](#) was published as a proposed rule to implement the Hague Agreement.

On February 4, 2014, the Intellectual Property Owners Association (IPO) submitted [comments](#) on the proposed Hague rules.

In summary, the IPO comments are directed to:

1. 37 CFR 1.53(d)(1)(ii) - continued prosecution application (CPA) practice in international design applications (IDAs);  
and
2. the payment of fees for IDAs when filing through the USPTO (indirect filing).

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

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# PROTECTING DESIGNS

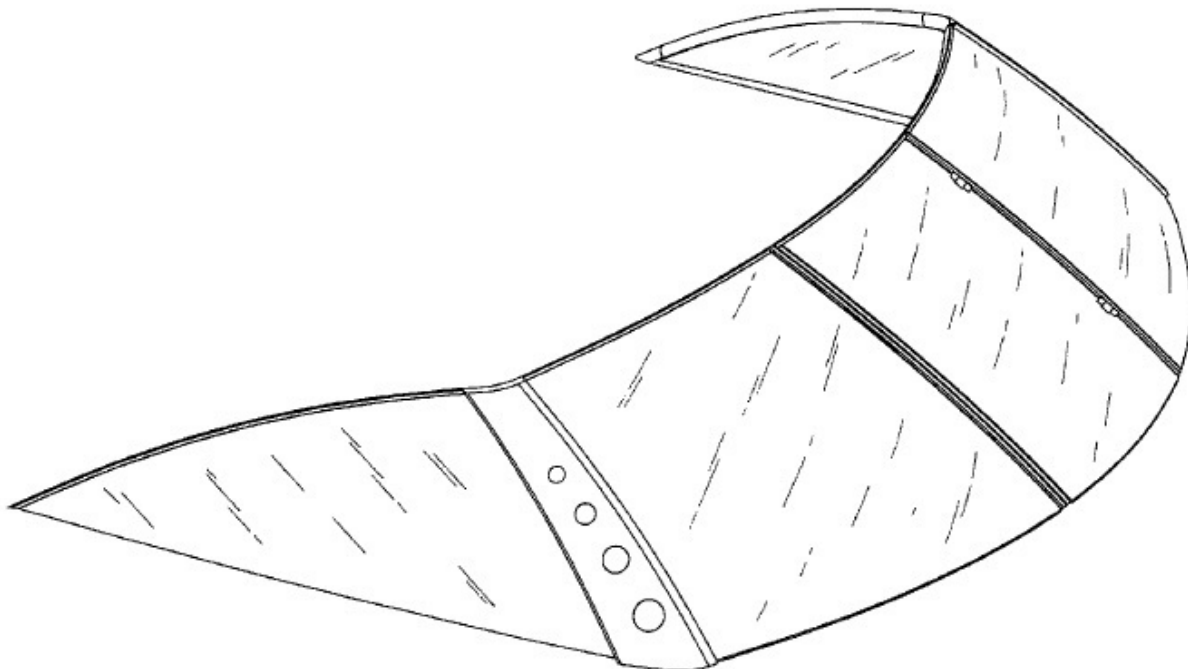
## Pacific Coast v. Malibu Boats

In 2011, Pacific Coast Marine Windshields Limited (Pacific Coast) brought suit (No. 12-CV-0033) against Malibu Boats, LLC (Malibu) in the Middle District of Florida, alleging infringement of [U.S. Patent No. D555,070](#). The District Court held that Pacific Coast was barred from alleging infringement due to prosecution history estoppel, and Pacific Coast appealed.

On January 8, 2014, the Federal Circuit held that “the principles of prosecution history estoppel apply to design patents” but reversed the district court’s summary judgment of non-infringement because “the accused infringing design was not within the scope of the subject matter surrendered during prosecution.”

A design patent application filed in 2006 by Darren Bach, CEO of Pacific Coast, depicted various embodiments of the claimed ornamental design for a marine windshield with configurations including zero, two, and four vent holes on a corner post. In response to a restriction requirement, the applicant elected a group corresponding to a single figure with four vent holes, and canceled the remaining figures. Mr. Bach later obtained a patent for a divisional of the originally filed application, claiming a windshield with no vent holes. The application issued as D555,070.

Figure 1 of the '070 patent is reproduced below.



The accused infringing design of Malibu Boats is a boat windshield with three trapezoidal holes, as shown below.



The District Court granted Malibu Boats' motion for summary judgment of non-infringement, finding that prosecution history estoppel barred the infringement claim. The District Court's decision recognized that the accused design had one fewer vent hole but explained that "the accused design is still clearly within the territory [surrendered] between the original claim and amended claim."

On appeal, the Federal Circuit noted that the doctrine of prosecution history estoppel is well established for utility patents, but that the concept of prosecution history estoppel as applied to design patents was "one of first impression" for the court.

For utility patents, the doctrine of prosecution history estoppel prevents a patentee from recapturing in an infringement action subject matter which was surrendered during prosecution.

The Federal Circuit noted that "for design patents, the concepts of literal infringement and equivalents infringement are intertwined," and stated that accordingly "the test for design patent infringement is not identity, but rather sufficient similarity." Furthermore, the Federal Circuit acknowledged that Pacific Coast had "characterized the substantial similarity between the accused designs and the '070 patent as the basis for an infringement claim 'under the doctrine of equivalents.'" The Federal Circuit concluded that "the principles of prosecution history estoppel apply to design patents as well as utility patents."

The Federal Circuit then addressed the question of whether the prosecution history estoppel barred infringement in this case.

The Court determined that there was a surrender of claim scope during prosecution, and that "by removing broad claim language referring to alternate configurations and cancelling the individual figures showing the unelected embodiments, the applicant narrowed the scope of his original application, and surrendered subject matter."

In addition, the Federal Circuit noted that the claim scope was surrendered to secure the patent, but not to avoid prior art. Whereas Pacific Coast argued that only surrenders to avoid prior art were within the doctrine, the Federal Circuit cited *Festo* stating that "the rationale behind prosecution history estoppel 'does not cease simply because the narrowing

amendment, submitted to secure a patent, was for some purpose other than avoiding prior art.”

With respect to the scope of the surrender, the District Court had determined that the accused design was within the scope of the surrender, i.e., that by abandoning a design with two holes and obtaining patents on designs with four holes and no holes, the range between four and zero was abandoned. In contrast, the Federal Circuit stated that “this range concept does not work in the context of design patents where ranges are not claimed, but rather individual designs.” The Federal Circuit further noted that “the applicant surrendered the claimed design with two holes on the windshield corner post, but neither submitted nor surrendered any three-hole design.”

Thus, the Federal Circuit held that the prosecution history estoppel principles apply to design patents, but do not bar Pacific Coast’s infringement claim, and remanded for further proceedings.

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

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