



PROTECTING DESIGNS

Columbia Sportswear Appeal Decision Covers Design Infringement; No Reflection on Damages

BY COLIN B. HARRIS | NOVEMBER 25, 2019

Last week, the U.S. Court of Appeals for the Federal Circuit (“CAFC”) issued an [opinion](#) in *Columbia Sportswear v. Seirus Innovative Accessories* (No. 2018-1329, 2018-1331 and 2018-1728) (Nov. 13, 2019). Although many interested stakeholders in the design patent world had hoped for some guidance on the “article of manufacture” issue as it relates to the calculation of a design patent infringer’s total profits, the CAFC did not reach the question of damages. Instead, the CAFC focused on the finding of infringement.

The design patent at issue in this case is U.S. [D657,093](#), which claims the ornamental design for a heat reflective material. Fig. 1 is an elevational view of the claimed design and Fig. 2 is an enlarged view of Fig. 1. These figures show that the heat reflective material has a wavy pattern.

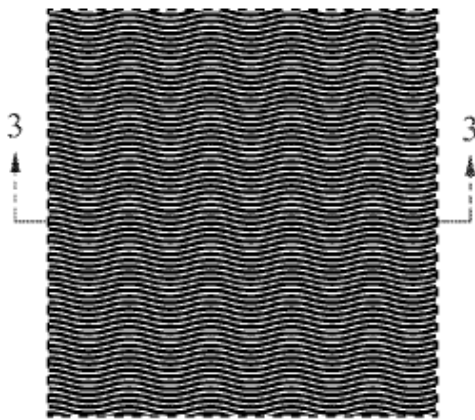


FIG. 1

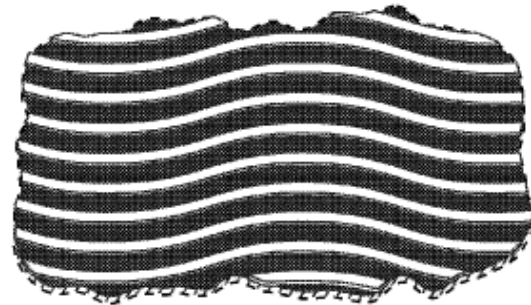


FIG. 2

Interestingly, Figs. 4-10 show different use cases for the heat reflective material that include a sleeping bag, footwear, legwear, a sock, handwear, outerwear, and more footwear. In each use case, only the heat reflective material is shown in solid lines with the rest of the each article being shown in broken lines depicting “environmental subject matter only and form[ing] no part of the claimed design.”

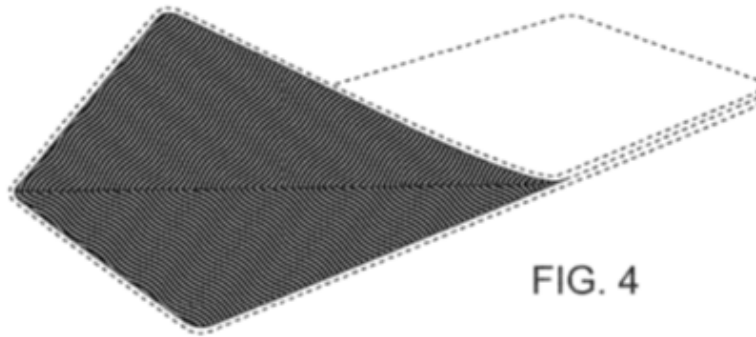
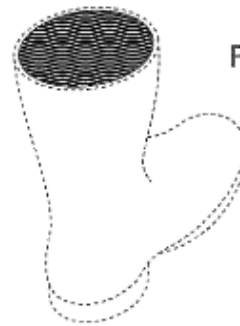


FIG. 4

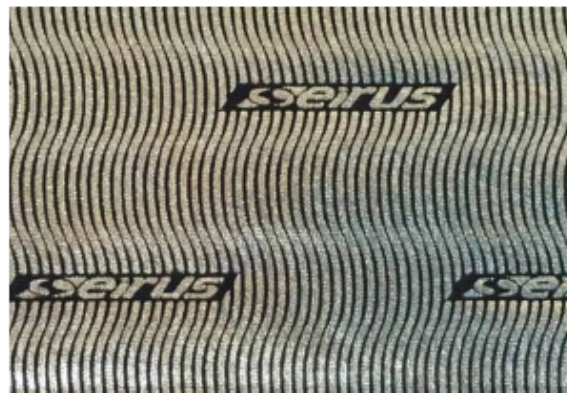
FIG. 9



FIG. 10



At the district court level, the court granted summary judgement that Seirus's HeatWave products (design copied below) infringe the '093 patent. Although the court noted certain differences between the two designs, ultimately the court found that the overall visual impression is "strikingly similar" and that "even the most discerning customer would be hard pressed to notice the differences between Seirus's HeatWave design and Columbia's patented design."



Seirus's HeatWave

A jury later awarded Columbia \$3,018,174 in damages based on Seirus's total profits, while finding that the infringement was not willful. This jury verdict was shortly after the Supreme Court's holding in [Apple v. Samsung](#) that the relevant article of manufacture for calculating total profits damages for design patent infringement does not have to be the end product sold to the consumer, but might be a component of the product sold. Although the jury did not have to define the article of manufacture for their damages calculation, it appears that the \$3 million award was based on Seirus's total profits for all infringing sales. Accordingly, as noted above, many were looking forward to some guidance from the CAFC on the article of

manufacture issue as it relates to total profits damages.

However, in deciding Seirus's cross-appeal, the CAFC found that the district court's grant of summary judgment of infringement was improper. Because the infringement finding was vacated, the CAFC did not reach the damages issue.

Specifically, the CAFC found that the district court erred in granting summary judgment of infringement for two reasons: (1) the court improperly declined to consider the effect of Seirus's logo in its infringement analysis and (2) the court resolved a series of disputed fact issues, in some instances relying on an incorrect standard, that should have been tried to a jury. While the second reason relates to the fact that the district court's finding was on summary judgement, the first reason is something that design patent practitioners should take note of. Distinguishing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993), the CAFC found that "*L.A. Gear* does not prohibit the fact finder from *considering* an ornamental logo, its placement, and its appearance as one among other potential differences between a patented design and an accused one. Indeed, the fact finder is tasked with determining whether an ordinary observer would find the 'effect of the whole design substantially the same.' *Gorham*, 81 U.S. at 530. It would be inconsistent with this mandate to ignore elements of the accused design entirely, simply because those elements included the name of the defendant."

Although the CAFC did not address how much significance the logo should play in the overall appearance of the design, the fact that the CAFC required the logo to be considered at all could be significant. Additionally, though the CAFC did not address this point, it is worth considering whether this problem would have been avoided if Columbia had claimed a smaller portion of their heat reflective material in Fig. 1 (i.e., a portion that is small enough to be mapped onto Seirus's HeatWave design between the logos). Further, the inclusion of exemplary embodiments in Figs. 4-10 would likely further complicate such a scenario.

Because the infringement finding was vacated, the CAFC did not reach the total profits damages issue. Thus, we will have to wait for another opportunity for further comment from the CAFC regarding the article of manufacture as it relates to the total profits damages calculation. As this case was remanded to the district court for further proceedings, it is possible that it could eventually find its way back to the CAFC.

Tags: [CAFC](#), [Design Patents](#), [Federal Circuit](#), [Filings and Decisions](#), [litigation](#)

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PROTECTING DESIGNS

I burn, burn like a wicker chair; chalk white and oh-so frail...

BY DAVID M. LONGO, PH.D. | SEPTEMBER 16, 2019

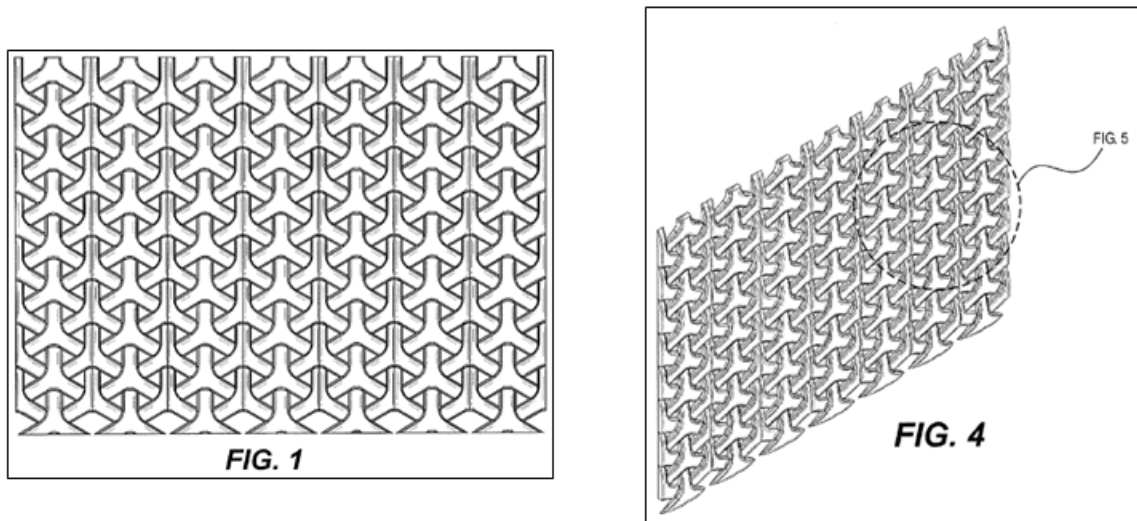


The title above refers to a lyric from a 1998 song by Eve 6, although they used the word “cabinet” instead of “chair.” While this simple substitution of a word on my part is designed to evoke an image, the choice of words and the image evoked* can mean so much more in the world of design patents.

Yesterday, in *Curver Luxembourg v. Home Expressions* (Fed. Cir. Appeal No. 18-2214), the U.S. Court of Appeals for the Federal Circuit affirmed a District Court of New Jersey decision against plaintiff-appellant Curver Luxembourg. Curver sued Home Expressions for infringement of U.S. Design Patent No. [D677,946](#), asserting that Home “makes and sells a basket that is identical to Curver’s basket in every way, including incorporating the patented overlapping “Y” design.” Home countered that its baskets could not possibly infringe Curver’s design patent, because the patent claim was limited to a *chair*. The district court agreed and dismissed the case, reasoning that Curver’s “original application was for a design on furniture. And what Curver got, as opposed to what it asked for, was a patent that protects against infringement for a particular “Y” design on chairs only.” Here, “in a case of first impression,” the Federal Circuit also agreed, holding that the scope of Curver’s U.S. design patent was limited to “an ornamental design for a pattern *for a chair*,” such that it did not read on Home’s *baskets*.

Curver’s U.S. Design Patent No. D677,946 is entitled “Pattern for a Chair,” and depicts “the ornamental design for a pattern for a chair, as shown” in 5 Figures. But each of the 5 Figures in the patent only show portions of an overlapping Y-shaped pattern—nothing more. Representative Figs. 1 and 4 are shown below. The depicted pattern called to mind something I would expect to see incorporated into a wicker¹ object made by woven rattan. Maybe that object could be a chair, but it

could also be a cabinet, a table, or even a basket. But it is not possible to understand what specific object (article of manufacture) was depicted by just viewing the Figures. One can understand that the pattern is “for a chair” only from reading the description of the Figures. The astute observer, or should I say the ordinary observer, will already see the problems this creates.



The Federal Circuit picked up on this point, noting that its cases did not “confront the atypical situation we have here, where all of the drawings fail to depict *an article of manufacture* for the ornamental design” (emphasis added). In this case, the Federal Circuit “address[ed] for the first time whether claim language specifying an article of manufacture can limit the scope of a design patent, even if that article of manufacture is not actually illustrated in the figures.” It explained “that long-standing precedent, unchallenged regulation, and agency practice all consistently support the view that design patents are granted only for a design applied to an article of manufacture, and not a design *per se*.” Thus, it held “that claim language can limit the scope of a design patent *where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures*” (emphasis added).

Curver’s original design patent application was directed to “a design for a furniture part,” and was entitled “Furniture (Part of-).” It included a foreign priority claim to an application entitled “Furniture Part.” Neither application mentioned any specific type of furniture, whether a chair, a cabinet, or a table. Nor was there any mention of other type of object, such as a basket.

The Examiner at the U.S. Patent and Trademark Office indicated in a first action that Curver’s application was in condition for allowance, but at the same time objected to the Title of the application and the descriptions of the Drawings in the Specification as being inconsistent. Here, the Title was “Furniture (Part of-),” the Drawings were described as “Furniture Part,” and the Claim recited a “rattan design for a furniture part.” The Examiner required that the Title be amended so as to designate the particular article that is the subject of the design, and “suggest[ed] the title be amended to read: “Pattern for a Chair.” The Examiner also asserted that the Claim was “too vague,” because it was not “directed to the design for an article.” But the Examiner did not similarly suggest a specific amendment for the Claim.

In response, Curver amended the Title to “Pattern for a Chair,” and similarly amended the descriptions of the Drawings. Curver also amended the Claim to replace the language “rattan design for a furniture part, as shown and described” with “pattern for a chair, as shown and described.” Curver remarked that “the title and the specification have been amended as required” by the Examiner, and that these “amendments introduce no new matter.” Curver did not provide any remarks regarding the amendment to the language of the Claim.

We can only speculate as to why the Examiner suggested amending the Title to “Pattern for a Chair.” Granted, a chair is commonly understood as an example of a piece of furniture. And the originally claimed “rattan design for a furniture part”

would probably call to mind a “chair” as a typical piece of furniture that could be a wicker object made by woven rattan. But there are other examples of furniture that the Examiner could have chosen as an article of manufacture: a cabinet, or a table, etc. The Examiner’s search notes identified the terms “Pattern, Rattan Pattern, Chair Pattern, Material Pattern, Fabric Pattern.” And, the Examiner’s search results did not point exclusively to “chairs.” In fact, other than the Examiner’s search notes and the suggested amendment to the Title, there is nothing in the application file that singles out a “chair” from any other example of “furniture.”

We can also only speculate as to why Curver accepted the Examiner’s suggested amendment, and why it similarly amended the Claim. Granted, Curver’s application referred to “furniture” and to a “rattan design for a furniture part.” But its Figures only depicted portions of the overlapping Y-shaped pattern, leaving one to guess what example of “furniture” may include the “rattan design.”

Also unanswered is why, given the specificity of the claim amendment, Curver asserted that the claim was infringed by a *basket*. Curver’s original complaint pointed out that “Curver makes and sells *storage baskets incorporating the design in the ‘946 Patent*, which it sells throughout the United States” (emphasis added). Curver’s complaint further pointed out that “The ‘946 Patent claims the ornamental overlapping “Y” design pictured” by a rotated version of Figure 1 from the patent. But the Complaint did not paint the whole picture—it omitted any mention of a “pattern *for a chair*.” Instead, it asserted infringement of the Y-shaped pattern itself—which on the basis of the Complaint alone could theoretically have been asserted against *anything* having that pattern.

According to the Federal Circuit, Curver first raised on appeal (and thus waived) an argument that the patent figures “depict a “three-dimensional *panel structure* that includes the ornamental Y pattern,” and that under *Samsung Electronics Co. v. Apple Inc.*, 137 S. Ct. 429, 435 (2016), this “panel” provides the requisite “article of manufacture” because it is a “component” of a product” (emphasis added). But the Federal Circuit distinguished *Samsung*, noting that any such panel does not “constitute[] the type of “component” contemplated by *Samsung* as being an “article of manufacture.” In *Samsung*, the components covered by Apple’s design patents were parts of a concrete “multicomponent” smartphone product, not a surface ornamentation disembodied from any identifiable product, as here.”

Importantly, the Federal Circuit noted that “our law has never sanctioned granting a design patent for a surface ornamentation in the abstract such that the patent’s scope encompasses every possible article of manufacture to which the surface ornamentation is applied.” Thus, its holding “decline[s] to construe the scope of a design patent so broadly here merely because the referenced article of manufacture appears in the claim language, rather than the figures.”

For practitioners and applicants alike, the takeaway message here is to be very careful about the choice of words in a patent application—whether it is a utility patent application or a design patent application. Particularly, in the case of design patents, be very careful about accepting an Examiner’s suggested amendment to the Title, the descriptions of the Figures, and the Claim. Doing so on the assumption that only the Figures in a design patent dictate the scope of the Claim, *i.e.*, that the words themselves do not matter, might lead to quick grant of a design patent, but it also might lead to the problems exemplified in this case if that patent is later litigated.

We are familiar with the expression that “a picture is worth a thousand words,” and have applied this in the context of design patents for years. Today, we see that an individual word can have the power to rein in the scope of that picture.

¹ Interestingly, the district court’s opinion contains the only mention of the word “wicker” in the entire case—woven into a footnote in support of an argument that Curver’s amendment resulted in the surrender of claim scope to anything that was not a chair, and that a “basket would not reasonably be regarded as an item of “furniture.”” Specifically, the district court distinguished the facts of this case from a 1959 case by the predecessor court to the Federal Circuit, noting that in “*United States v. Quon Quon Co.*, the [predecessor court] disputed whether wicker tabletops intended for use as patio furniture and

made of woven rattan should be classified as “baskets” or “furniture.” [citation omitted] The tabletops were classified as “furniture” because they were sold and used only as tops of coffee or cocktail tables; “baskets” were a separate, non-furniture category.” [citation omitted] In the end, baskets were not considered furniture unless they were being used for a non-basket purpose. That would not apply in this case.”

** The photo at the top of this article is of a 130-year old chair that has been in my family for, I suppose, 130 years. We don't sit on it much anymore. Instead, it sits in my home. May it never burn.*

Tags: CAFC, Design Patents, Fashion Designs, Federal Circuit, Patent Infringement, Practical Considerations, Filings and Decisions, litigation

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