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# PANITCH TRAINING ACADEMY

Insights From Leaders In IP Law

Training Academy Session # 23

# An Overview of Design Patent Litigation

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# Session Overview

1. Design Patent Basics
2. Design Patent Keys
3. Litigated Design Patent Examples
4. Design Patent Infringement
5. Defenses to Design Patent Infringement Claims
6. Design Patent Damages

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# Design Patent Basics - Types of Patents

- Distinct types of Patents:
  - Utility Patent: The "traditional" variety of patent used to protect inventions – apparatus, chemical composition, methods, device, system, etc.
  - **Design Patent**: Protects ornamental appearance embodied in or applied to an article
  - Utility Model Patent – Not Examined – 70+ countries including: China, Germany, Spain, Turkey ….
  - Plant Patent: Asexually reproduced plants
- U.S. Patent Term
  - Utility/Plant: 20 years from date of filing
  - Design: 15 years from date of grant if filed on or after May 13, 2015 and 14 years from date of grant if filed before May 13, 2015

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# Design Patent Basics

- Separate Design Patent Practitioners Bar – January 2, 2024
  - USPTO has proposed creation of a design patent practitioners bar certifying those who qualify to practice solely in design patent matters.
  - Proposed criteria for applicant's having bachelor's, master's or doctorate degrees in:
    - Industrial Design;
    - Product Design;
    - Architecture;
    - Applied Arts;
    - Graphic Design;
    - Fine/Studio Arts;
    - Art Teacher Education; or
    - Equivalent of the Above.

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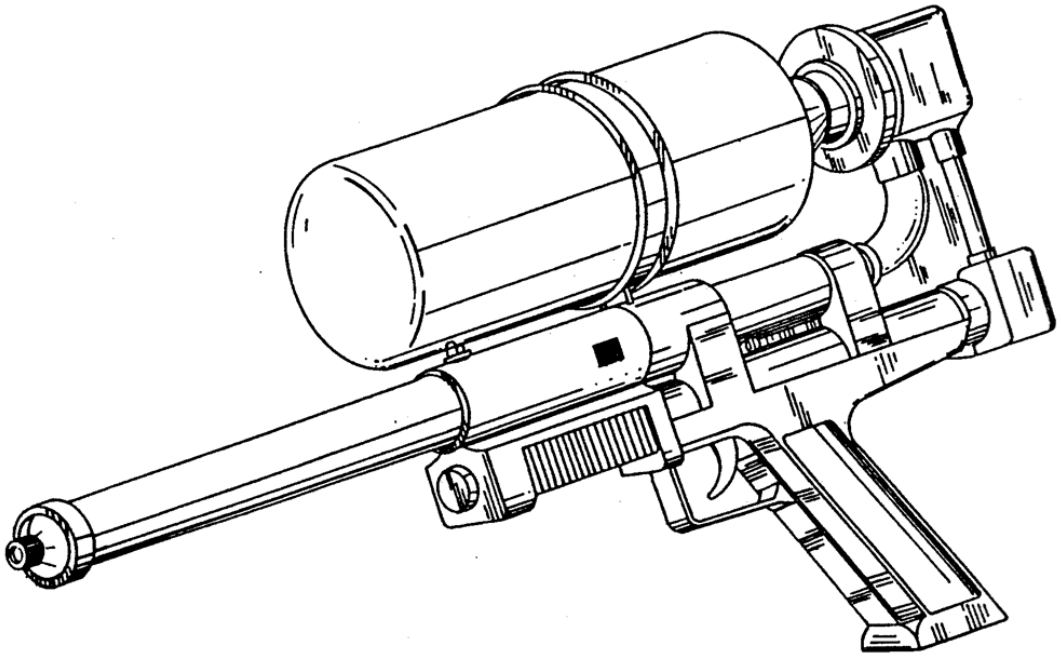
# Design Patent Basics

- Governed by 35 USC § 171
  - Whoever invents any new and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.



- Super Soaker - Over $1 Billion sold

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# Design Patent Basics - Patentability

- Novelty
  - Generally straightforward (a “yes or no” test)
  - Was the ornamental design for the article, apparatus, or product “patented, described in a [single] printed publication, or in public use, on sale, or otherwise **available to the public before the effective filing date**” of the patent application?
  - The entirety of the invention is already in the public domain

- Obviousness
  - Generally subjective determination based upon what would have been obvious to a person of ordinary skill in the art at the time the invention was made

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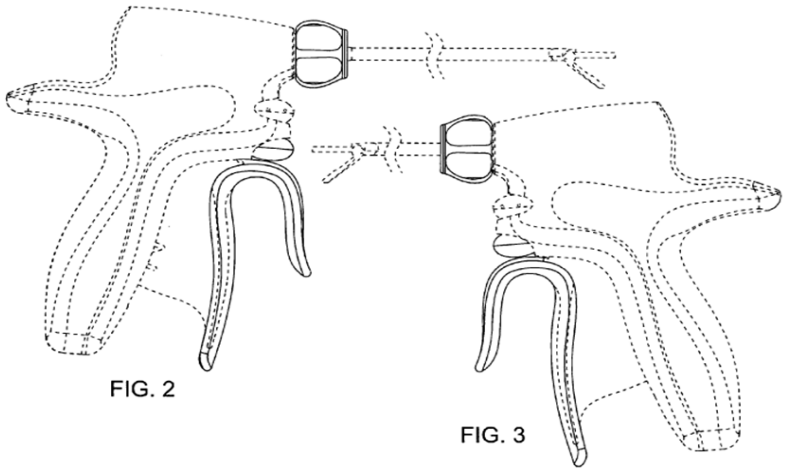
# Design Patent Basics - Patentability

- Design Patent Application Examination
  - Examiners typically focus on sufficiency of the drawings and inconsistencies or ambiguities between the different drawing views
  - Prior Art Rejections
    - Novelty
    - Obviousness
- In U.S. design patent applications, dotted lines are for environmental purposes only and don't form part of the claim
  - Rules are different in different territories

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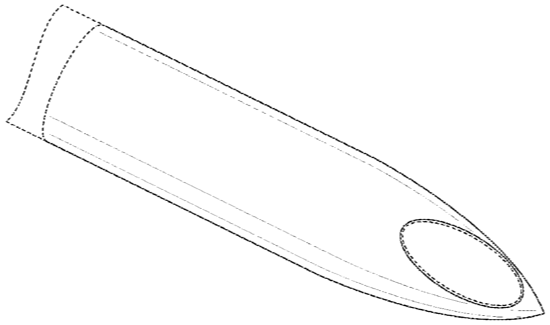
# Design Patent Basics

- May be narrow scope of protection
  - Change in appearance while performing the same function results in avoidance of the design patent scope

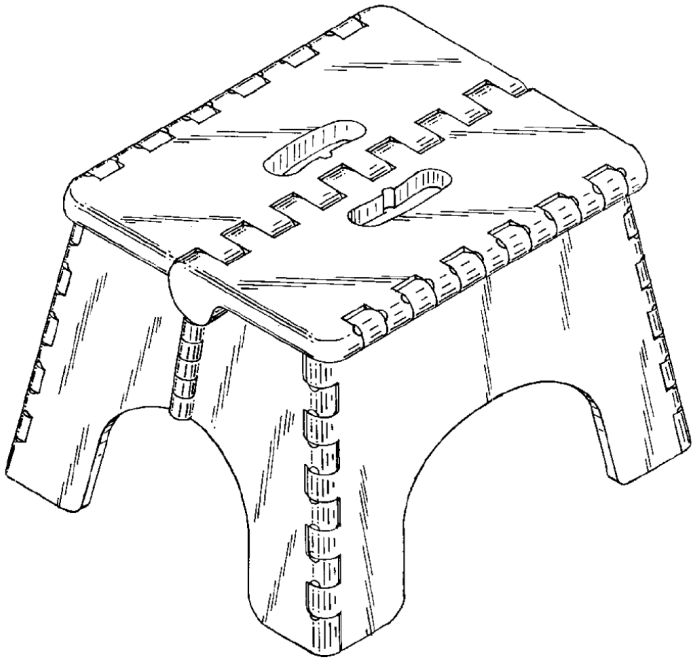
- Scope of a patent is defined by the **drawings**
  - Sufficient view(s) to enable the ornamental appearance for which protection is sought
  - **Can be directed to parts or portions of an article**
  - Typical view types: perspective, top, bottom, left side, right side, front, rear



- Needle Tip

# Design Patent Basics

- Design Patents **cover appearance, not underlying functional attributes**



- E.g.: Any “swivel-ability” of the stool does not matter
  - Only the overall appearance matters

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# Design Patent Keys

- Drawings are Key
  - Line drawings most common
  - Computer-Generated images accepted
    - Think Green v. Medela AG (re: D808,006) - Court found that using computer-generated images indicated surface material choice. The patent was interpreted as claiming only an opaque object and could not cover a translucent object!
  - Photographs accepted

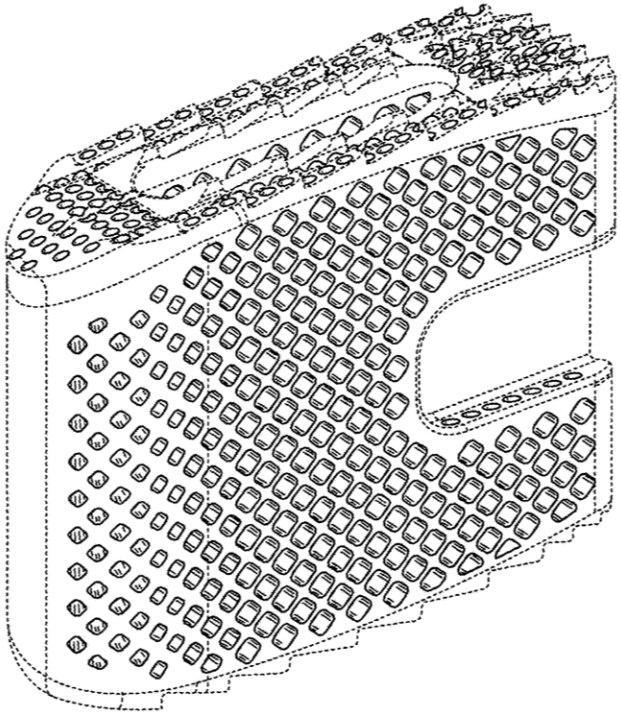
Fig. 9

*D'006 figure 9*

*Medela Silicone Breast Milk Collector*

# Design Patent Keys

- Applicant claims the subject Applicant regards as the invention
  - When visible portions of the article embodying the design are not shown, it is because they form no part of the claim to be protected
  - Limited/Single View Designs are gaining popularity



- Texture Features of a Spinal Implant

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# Design Patent Keys

- Single View Designs (Traditionally at least orthographic projection +)
  - *In re Maatita* (Fed. Cir. 2018)
  - Examiner rejected the claim as indefinite because the application used a single plan view drawing to disclose a three-dimensional design for a shoe bottom.
  - CAFC stated that "Maatita's two-dimensional drawing clearly demonstrates the perspective from which the shoe bottom should be viewed. A potential infringer is not left in doubt as to how to determine infringement." Therefore, **"[b]ecause a designer of ordinary skill in the art, judging Maatita's design as would an ordinary observer, could make comparisons for infringement purposes based on the provided, two-dimensional depiction,** Maatita's claim meets the enablement and definiteness requirements of § 112."

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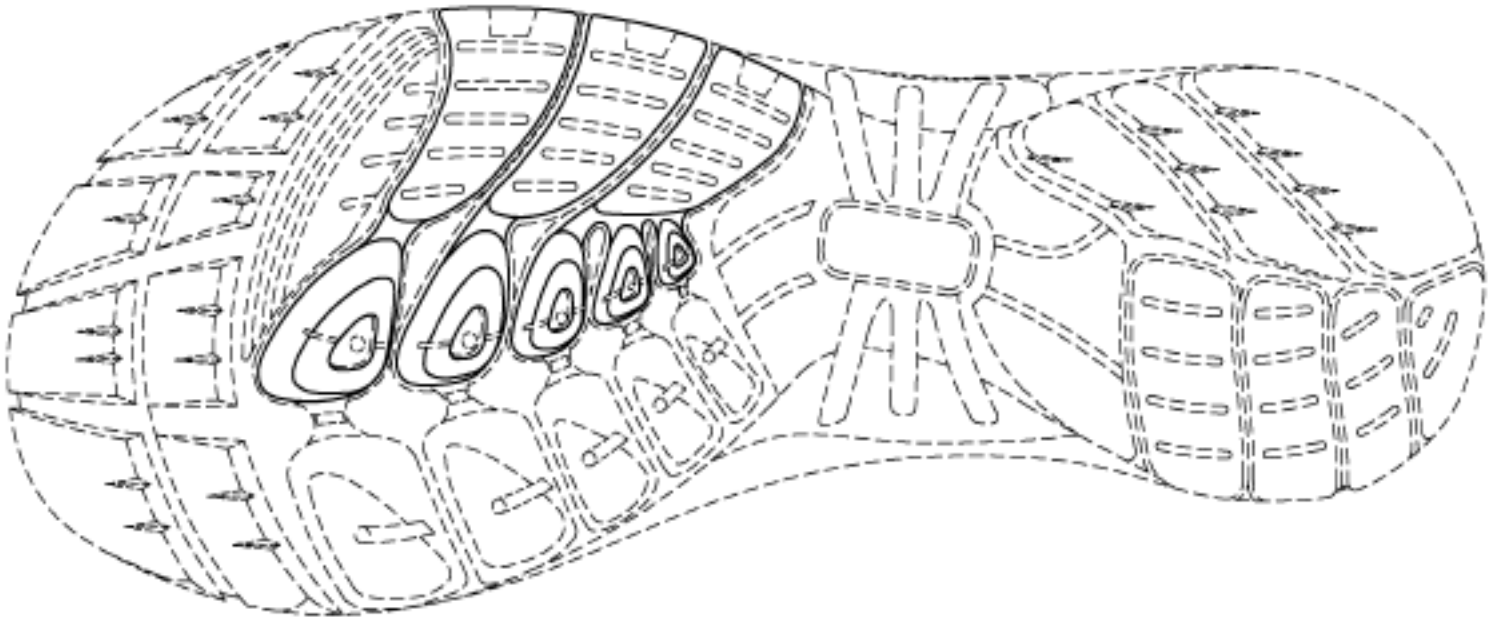
# Design Patent Keys

- *In re Maatita* Design



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# Litigated Design Patent Examples

- Consumer Electronics - Apple v Samsung
  - US Patent D593,087
  - US Patent No. D602,016

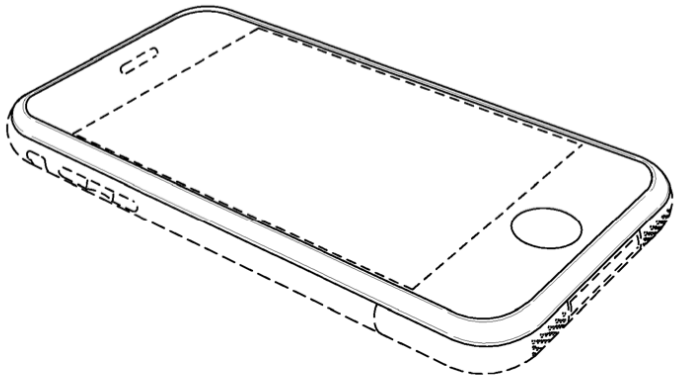
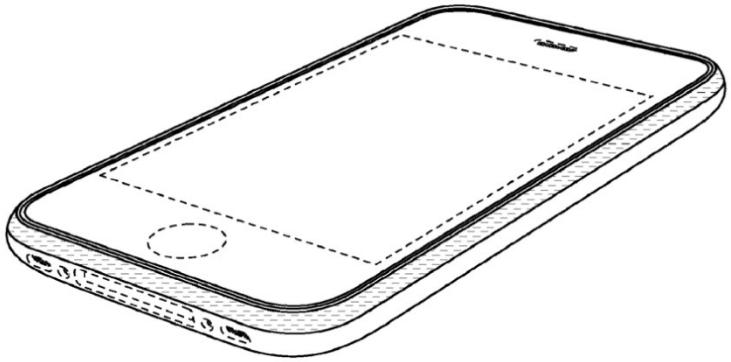


FIG. 1



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# Litigated Design Patent Examples

- Graphical User Interfaces - Apple v Samsung –
  - US Patent D617,334
  - US Patent No. D604,305



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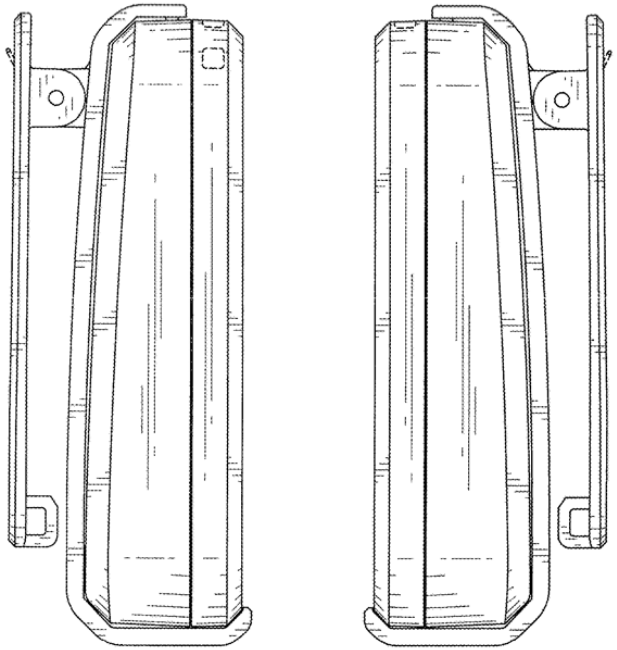
# Litigated Design Patent Examples

- Molded Housings - Life Alert v International Marketing Group, Inc.
  - US Patent D753,089
  - US Patent No. D800,085

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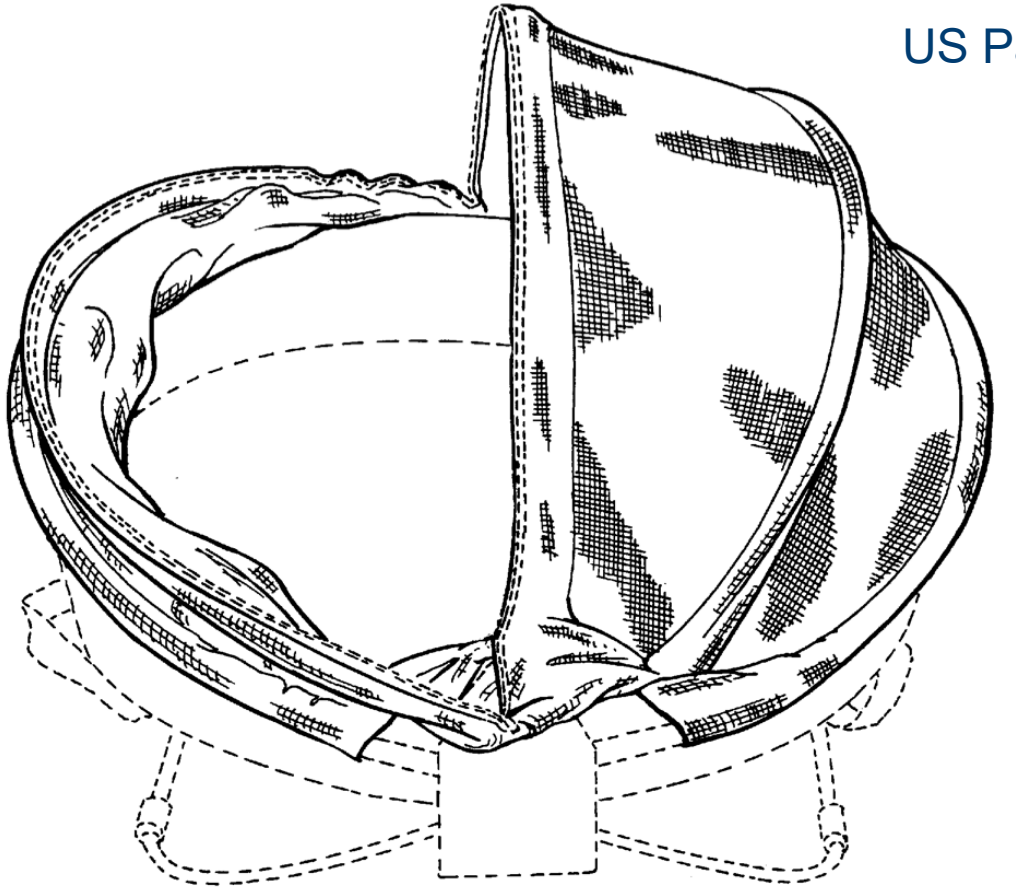
# Litigated Design Patent Examples

- Consumer Goods - Fisher Price Inc., *et al.* v Safety 1st Inc

US Patent D431,940



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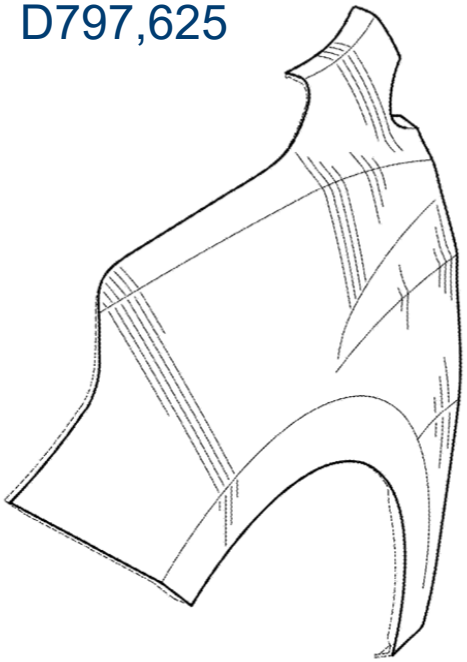
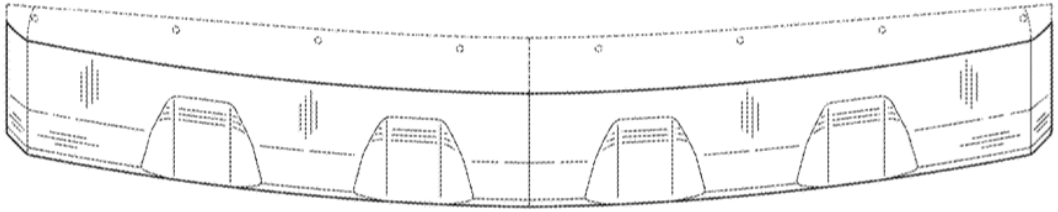
# Litigated Design Patent Examples

- Automotive Replacement Parts – LKQ Corp. v General Motors Company

US Patent
D797,625



US Patent D855,508



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# Design Patent Infringement

**Design Patent infringement occurs when:**

- "[I]f, 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. at 528*; Egyptian Goddess, Inc. v. Swisa, Inc.,* 543 F.3d 665, 670.

- An infringer, without authority, applies a “patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale,” 35 U.S.C. § 289, or they “make, use, offer to sell, sell… or import”.. any article of manufacture embodying the patented design under 35 U.S.C. § 271.

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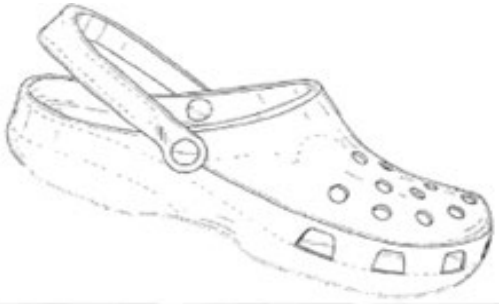
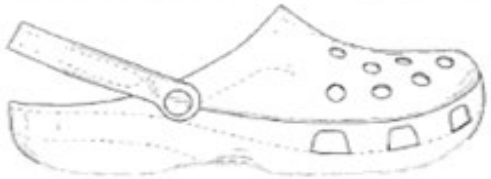
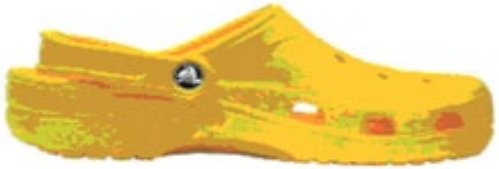
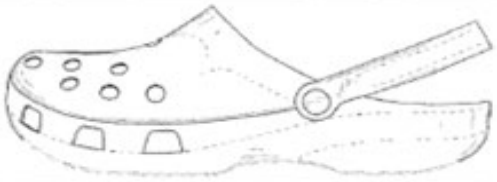
# Infringement by Doctrine of Equivalents

- Even when the differences between a design patent and accused product precludes literal infringement, infringement can be found under the Doctrine of Equivalents

- Infringement can be found for designs that are not identical to the patented design, given they are equivalent in their ornamental, not functional, features. See *In re Garbo*, 287 F.2d 192, 193, 129 USPQ 72, 73 (CCPA 1961).

# Does the Accused Product Infringe on the Design Patent?

| Us. Patent No. D517,789 | Accused Product |
| --- | --- |
|  |  |
|  |  |
|  |  |

**Crocs v. ITC, 598 F.3d 1294 (Fed. Cir. 2010)**

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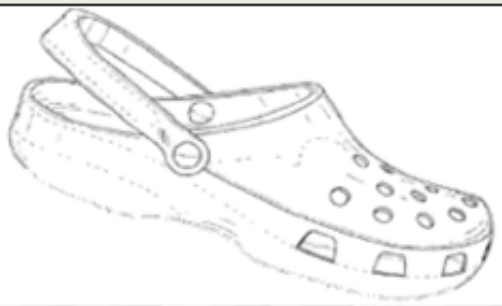
# Crocs v. ITC, 598 F.3d 1294 (Fed. Cir. 2010)

- The Federal Circuit Court entered judgement of infringement against ITC
- The Court reasoned that the "side-by-side comparisons of the…patent design and the accused products suggest that an ordinary observer, familiar with the prior art designs, would be deceived into believing the accused products are the same as the patented design"

| Us. Patent No. D517,789 | Accused Product |
| --- | --- |
|  |  |

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# Design Patent Infringement Factors

- Overall Visual Similarity
- Ordinary Observation
- Ability to Design around a product
- Prior Art
- Market Impact
- Consumer Expectations
- Expert Testimony

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# Key Tests of Design Patent Infringement

- Ordinary Observer Test
- Substantial Similarity Test
- Prior Art Test
- Three-way Visual Test

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# Ordinary Observer Test

- "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." Golden Eye Media United States, Inc. v. Trolley Bags UK, Ltd., 525 F. Supp. 3d 1145, 1178, 2021 U.S. Dist. LEXIS 48161, *14

- This test considers whether an ordinary person (not an expert in designs) can see a **definite similarity in the designs of two objects.**

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# Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008).

- The Ordinary Observer Test replaced the “point of novelty” Test. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).
- The “point of novelty” test imposed a duty on the courts to determine whether the accused design appropriated the novelty in the patented device which distinguished the patented design from the prior art.

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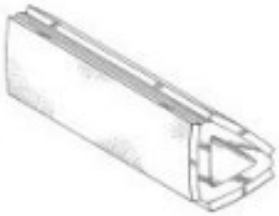
# Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008).

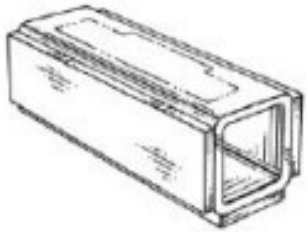
- A case for design patent infringement can be based on **substantial similarity**


Falley Buffer Block



Nailco Patent

Swisa Buffer



'389 patent

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# Substantial Similarity Test

- The issue is whether the accused product would deceive an ordinary observer to suppose it to be the patented design.
- If the differences between a patented design and an accused product demonstrate that the overall design of the patented and accused product are not substantially the same, a finding of infringement is inappropriate.
- This test is based on a Likelihood of Confusion standard (not actual confusion)
- You must take into consideration the prior art and any functional aspects of the design.

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# Lanard Toys Ltd. vs. DOLGENCORP LLC, 958 F.3d 1337 (2020)

- The court found no infringement

| Lanard Chalk Pencil | D167 patent (Fig. 1) |
|---|---|
|  |  |



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# Prior Art & Three-Way Visual Comparison Test

- In deciding whether there has been an infringement, the Court must inquire "**whether an ordinary observer, familiar with the prior art, would be deceived** into thinking that the accused design was the same as the patented design." *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 672 (Fed. Cir. 2008). **This inquiry necessitates a three-way visual analysis between the patented design, the accused design, and the prior art**. *Id.*

*Voltstar Techs., Inc. v. Amazon.com, Inc.*, 2014 U.S. Dist. LEXIS 102306, *5

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# Three-Way Visual Test

FIG. 9

'316 Patent

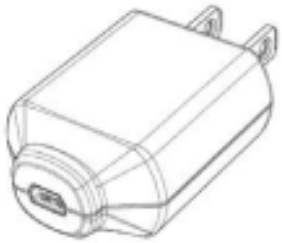

FIGURE 2

Voltstar Patent

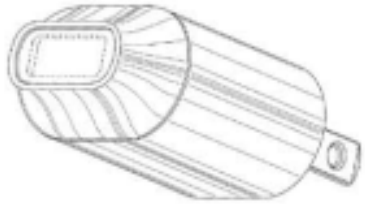

FIG. 2

Amazon Patent

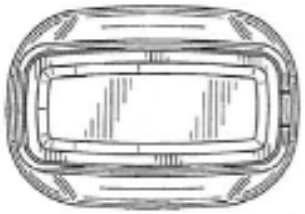

FIG. 5

'316 Patent

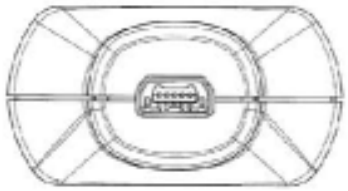

FIGURE 5

Voltstar Patent

FIG. 4

Amazon Patent

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# Columbia Sportswear N. Am. v. Seirus Innovative Access., Inc.

- The court further found that district court properly gave the ordinary-observer test for design-patent infringement jury instruction and that its addition that **actual confusion was not necessary to find design-patent infringement provided correct statements of the law.**

*Colum. Sportswear N. Am., Inc. v. Seirus Innovative Access*., Inc., 80 F.4th 1363, 2023 U.S. App. LEXIS 24552, 2023 U.S.P.Q.2D (BNA) 1083

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# Wepay Glob. Payments LLC v. PNC Bank

- “a side-by-side comparison of WPG's Asserted Design and PNC's Accused Design demonstrates that they are "sufficiently distinct" and "plainly dissimilar" such that no reasonable factfinder could find infringement. Any similarity between the two designs is limited to basic geometric shapes, but with notable differences in shape size and spacing such that no ordinary observer would mistake the Accused Design with the Asserted Design or vice versa.”

*Wepay Glob. Payments LLC v. PNC Bank N.A.*, 2022 U.S. Dist. LEXIS 97286, *8

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# Think Green v Medela AG

- If, contrary to the Court's finding, the translucency of Medela's product were insufficient for an ordinary observer to distinguish it from Think Green's design, the Court would have been required to further construe Think Green's patent claim with regard to its functionality. The functional aspects of the design are excluded from the claim, such that Medela (or any other competitor) can copy them without infringing Think Green's patent."

- The obvious and categorical difference between an opaque and translucent object means that the **failure to address functionality does not prevent the Court from granting summary judgment on the design patent claim.**

*Think Green Ltd. v. Medela AG*, 2022 U.S. Dist. LEXIS 184040, *16

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# Apple Inc. v. Samsung Electronics Co., 735 F.3d 1352, 1375 (Fed. Cir. 2013)

- Apple was awarded $399 million in damages—Samsung's entire profit from the sale of its infringing smartphones.
- The Federal Circuit rejected Samsung's argument that damages should be limited because the relevant articles of manufacture were the front face or screen rather than the entire smartphone.
- The term "article of manufacture" is broad enough to cover both a product sold to a consumer and a component of that product, despite being sold separately or not

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# How *Apple v Samsung* Impacts Design Patent Infringement Today?

- When bringing a claim for design patent infringement, it is essential for the claimant to prove the value of their design.

- A strong case should include three major elements:

    1. The design patent's scope of protection
    2. The design's value to the overall product
    3. The design's distinctiveness as related to the overall product

- It is important to calculate how much money you believe you lost due to another person violating your design patent.

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# Defenses to Design Patent Infringement

- Generally the same types of defenses as to utility patents
- Noninfringement
- Invalidity
  - Anticipation: Ordinary Observer test
  - Obviousness: whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved. Two steps:
    - (1) find a single reference that is "basically the same" as the claimed design (referred to as a Rosen reference)
    - (2) modify the Rosen reference with other references to create the "same overall visual appearance" as the claim
- Lack of ornamentality (35 USC 171) – purely functional
- PTAB proceedings (*Inter Partes* Review and Post Grant Review) are available for design patents

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# Design Patent Damages

- All utility-type damages available (reasonable royalty, lost profits, etc.)
- Disgorgement of profits (35 USC 289) – unique to design patents
  - Must apportion to the claimed "article of manufacture"
  - Statutory minimum of $250
  - If design and utility patent are asserted, profits can (but not always) awarded in addition to utility patent damages
  - But beware: enhanced damages for willful infringement not available
  - Patent marking is still required
- Can disgorge all defendants in supply chain (*Bergstrom v. Sears, Roebuck & Co.*, 496 F. Supp. 476, 496 (D. Minn. 1980); *Red Carpet Studios v. Midwest Trading Grp., Inc.*, No. 1:12cv501, 2021 U.S. Dist. LEXIS 59168, at *16 n.6 (S.D. Ohio Mar. 29, 2021))

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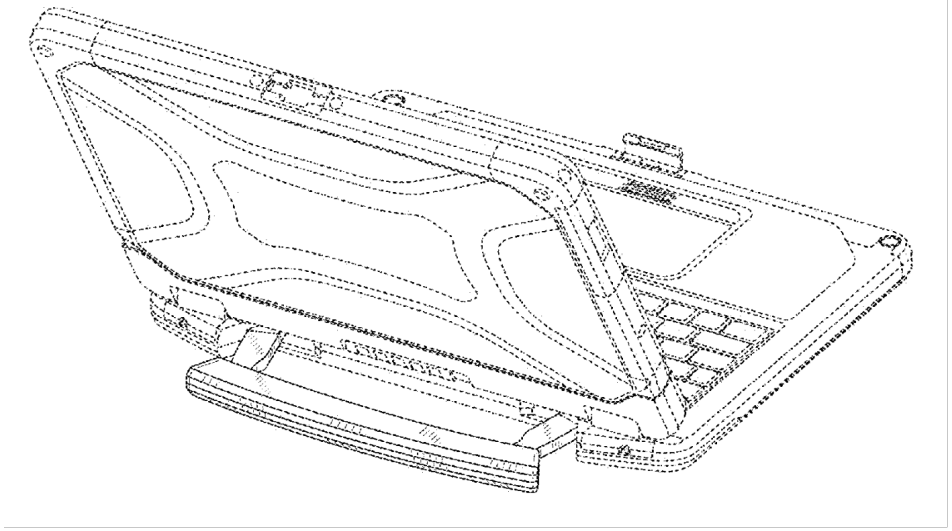
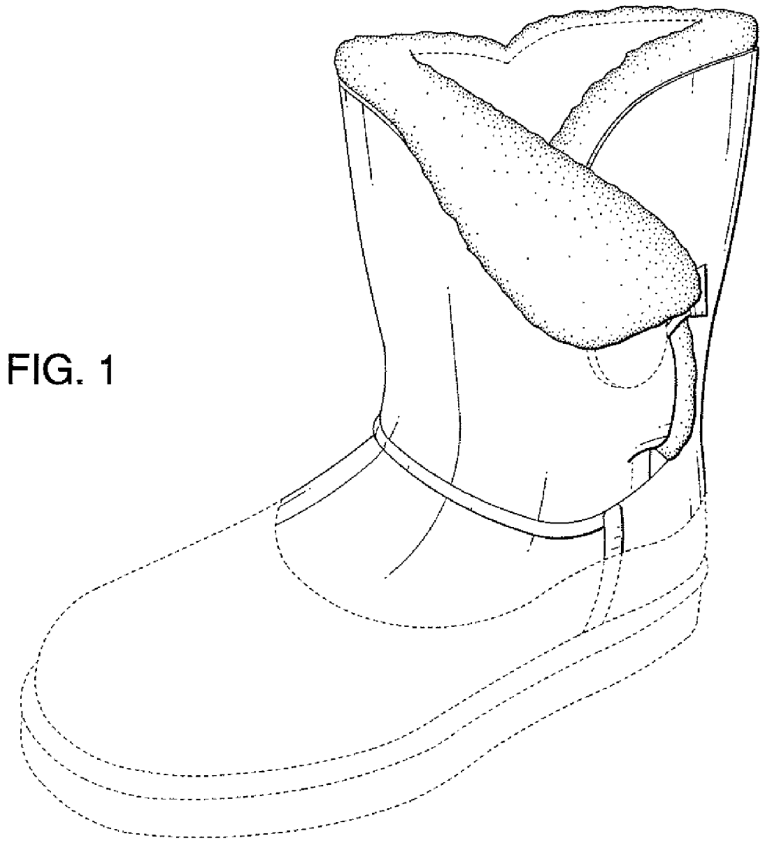
# Examples of Damages

- *Apple v. Samsung* – after the retrial on damages, the jury awarded $533M for design patent infringement and only $5.3M for utility patent infringement
  - Vacated by Supreme Court, but shows that design patents have great potential where utility patents may not
- *Panasonic v. Getac* - $17.5M for 3 design patents



# Examples of Damages

- *Decker v Romeo & Juliette* - $5.25M for infringing 2 design patents
  - Note that only the upper portion of the boot is part of the claim

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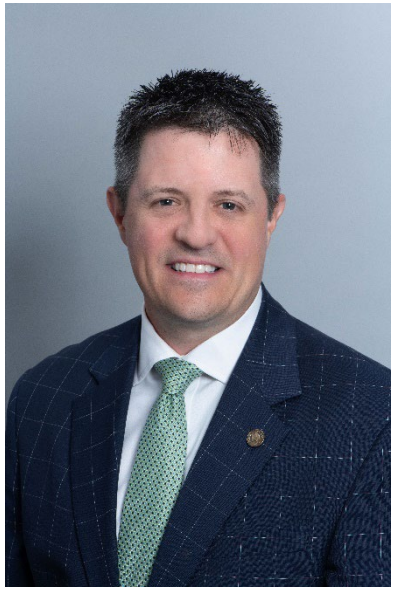
# Speakers



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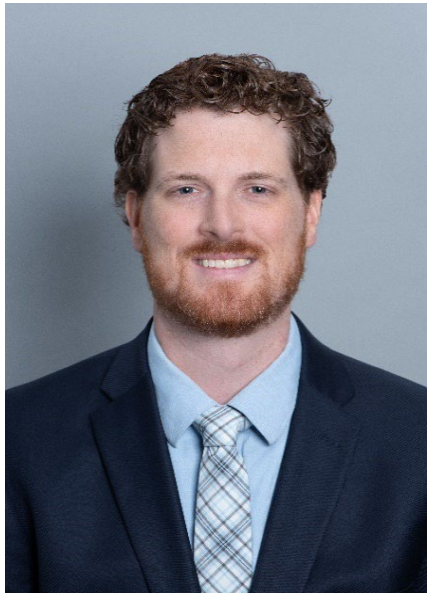

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