

The logo for FISH, consisting of the word "FISH" in a bold, white, sans-serif font, followed by a small teal square.

# Design Patent Litigation

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September 7, 2023

# Meet the Speakers

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Principal



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Principal



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# Overview

## Housekeeping

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  - Send NY/NJ CLE forms to [MCLEteam@fr.com](mailto:MCLEteam@fr.com)
- Questions
- Materials
  - <http://www.fr.com/insights/webinars>

# Agenda

**Overview of Design Patent Litigation**

**Litigating Design Patents – Similarities and Differences to Utility Cases**

**Claim Construction in Design Patent Litigation**

**Design Patent Damages**

# Overview of Design Patent Litigation

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# Starting With the Statute

## **(a) In General.—**

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 171

# Fashion Over Function

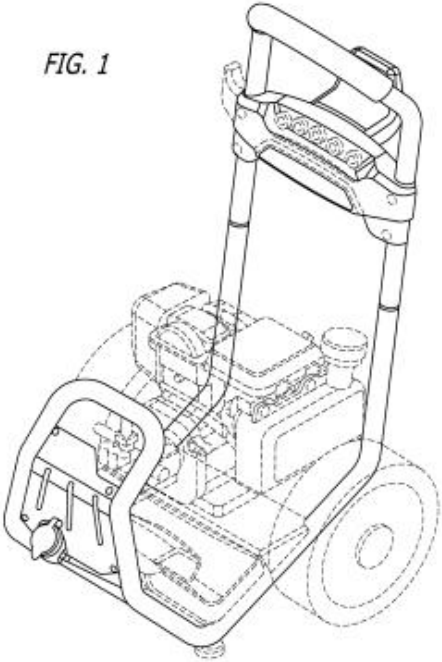


“In general terms, a ‘utility patent’ protects the way an article is used and works, while a ‘design patent’ protects the way an article looks.”  
MPEP1502.01.

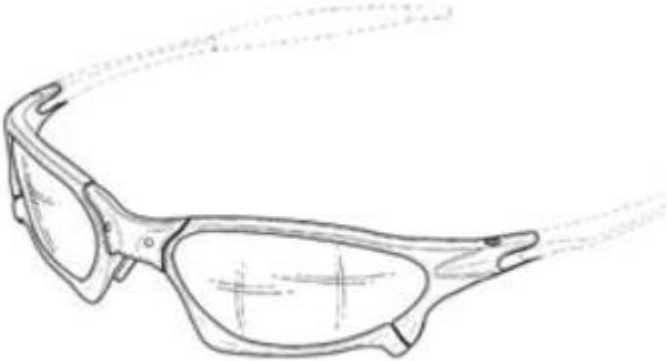
“Articles of manufacture necessarily serve a utilitarian purpose, ***but design patents are directed to ornamental designs of such articles.***” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.* 796 F.3d 1312 (Fed. Cir. 2015)

# Design Patents Across Industries—Consumer Goods

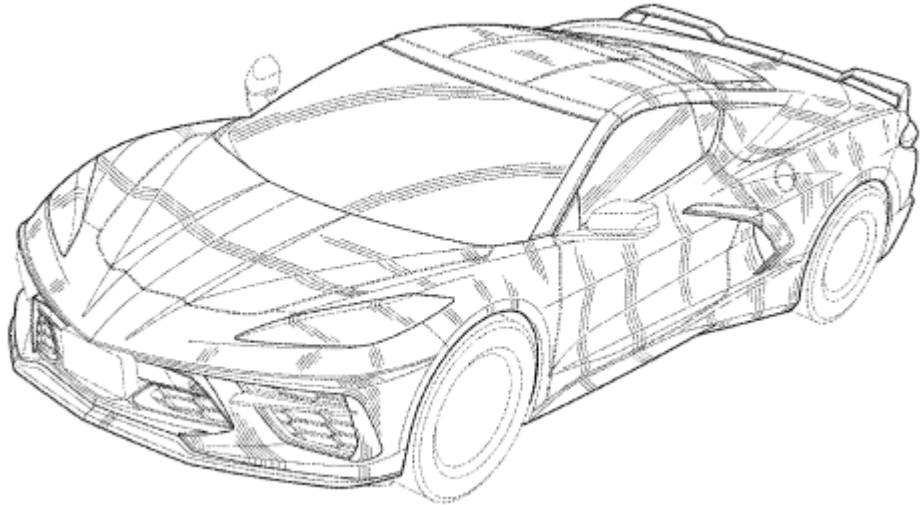
FIG. 1



D733,373



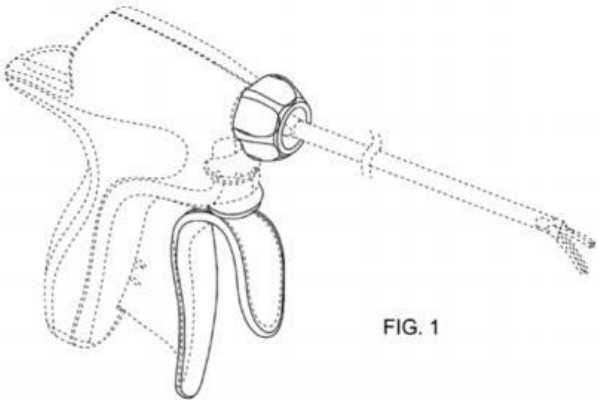
D470166



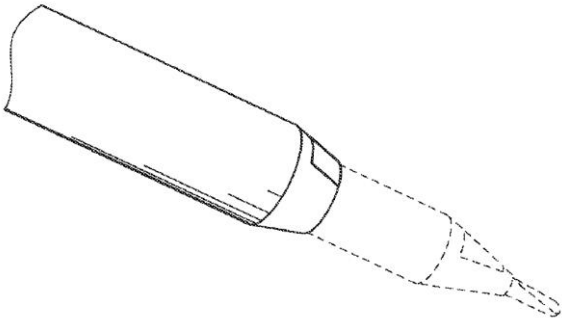
D863,104



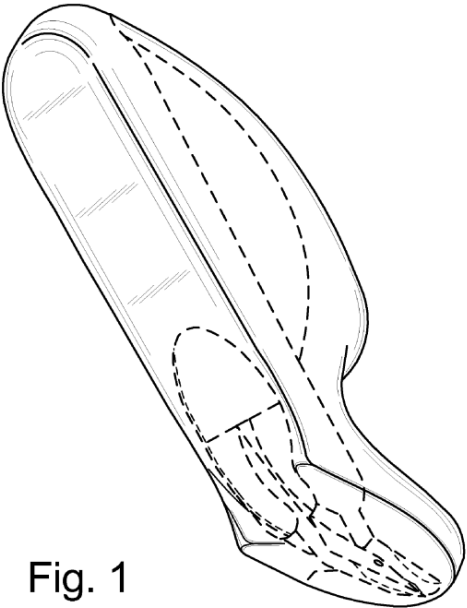
# Design Patents Across Industries--Medical



D661,804



D652,922



D576,279

# Functional And Ornamental?

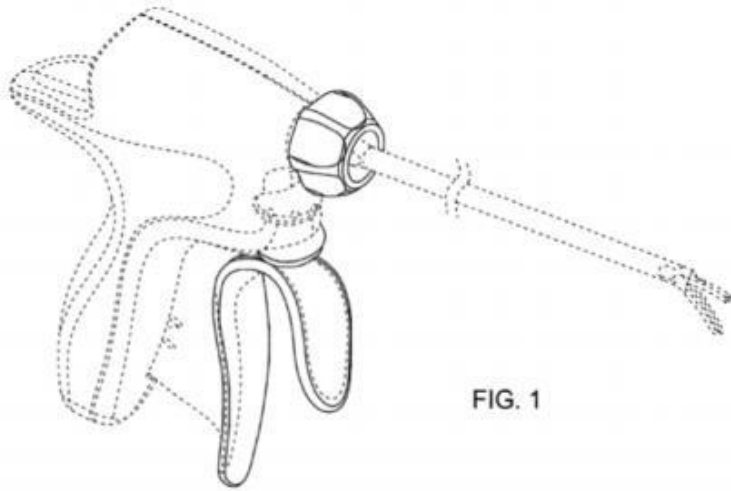


FIG. 1

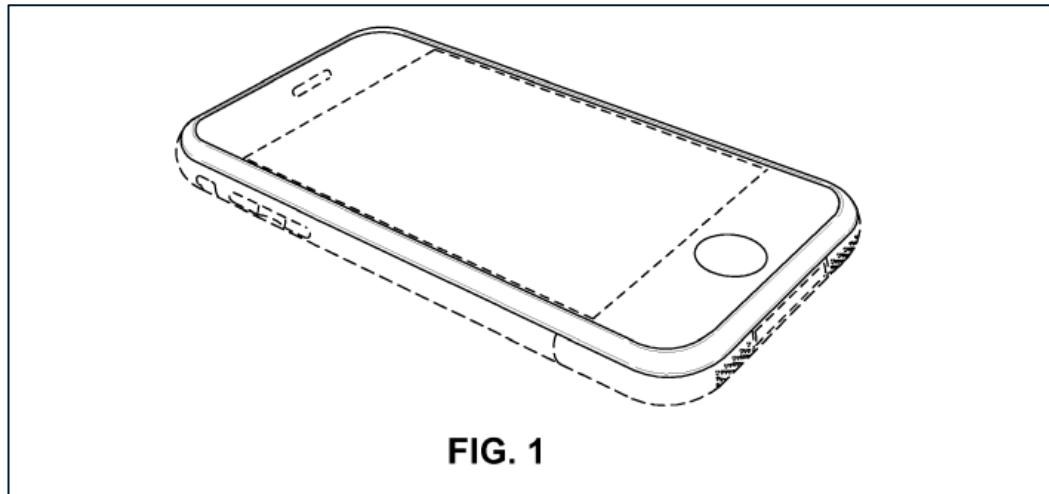
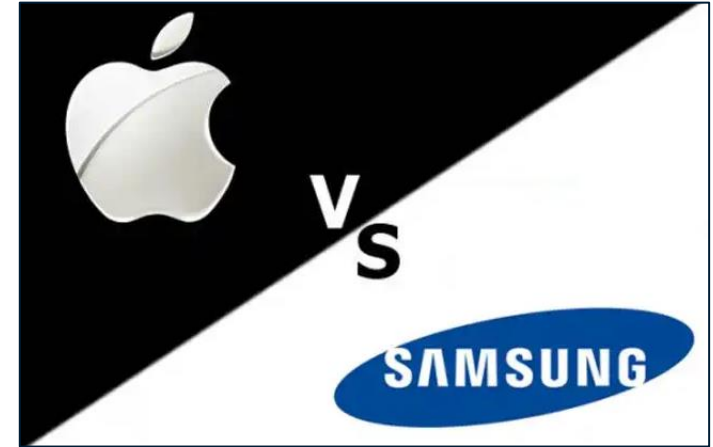
- A design may contain both functional and ornamental elements.
- The scope of a design patent must be limited to the ornamental aspects of the design.
- The shape and ornamentation of functional features are protected to the extent they contribute to the overall ornamentation of the design.
- Courts will often focus on the availability of alternative designs to accomplish the same alleged functionality.
- Other factors include whether the protected design represents the best design; whether alternative designs would adversely affect utility; whether there are related utility patents; whether advertising touts particular features of the design as having utility; whether there are any elements in the design clearly not dictated by function.

# Litigating Design Patents

- Litigation involving design patents is not necessarily any simpler than litigating utility patents:
  - Infringement
  - Invalidity/unenforceability
    - § 112 defenses
    - Inequitable conduct
    - Inventorship
    - Etc...
  - Claim Construction
  - Damages

# Increased Interest in Design Patent Litigation

- *Apple v. Samsung*
  - \$533M in damages for design patent infringement
  - \$5.3M in damages for utility infringement



D593,087

# Increased Interest in Design Patent Litigation

- In the 10 years since Apple's original verdict, design patent filings have tripled
- Litigation filings have remained steady (~200-300 lawsuits filed per year)
- Six Federal Circuit decisions in 2022 (three precedential, three non-precedential)

# Timing Considerations

Patent term and related factors:

	Design Patent	Utility Patent
Patent Term Period	15 years*	20 years
Term starts from...	Grant date	Filing date
If prosecution time frame is...	1-2 years	2-5 years
Then enforcement period is...	15 years	15-18 years

\* U.S. design patents resulting from applications filed on or after May 13, 2015 have a 15 year term from the date of grant. However, patents issued from design applications filed before May 13, 2015 have a 14 year term from the date of grant.



# Litigating Design Patents – Similarities and Differences to Utility Cases

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# Infringement and Anticipation - The Ordinary Observer



Stock Image of "Average Guy"

- Perspective from which anticipation and infringement are analyzed – no POSITA
- The ordinary observer is not an expert, but can be a sophisticated commercial buyer.



# Infringement + Anticipation

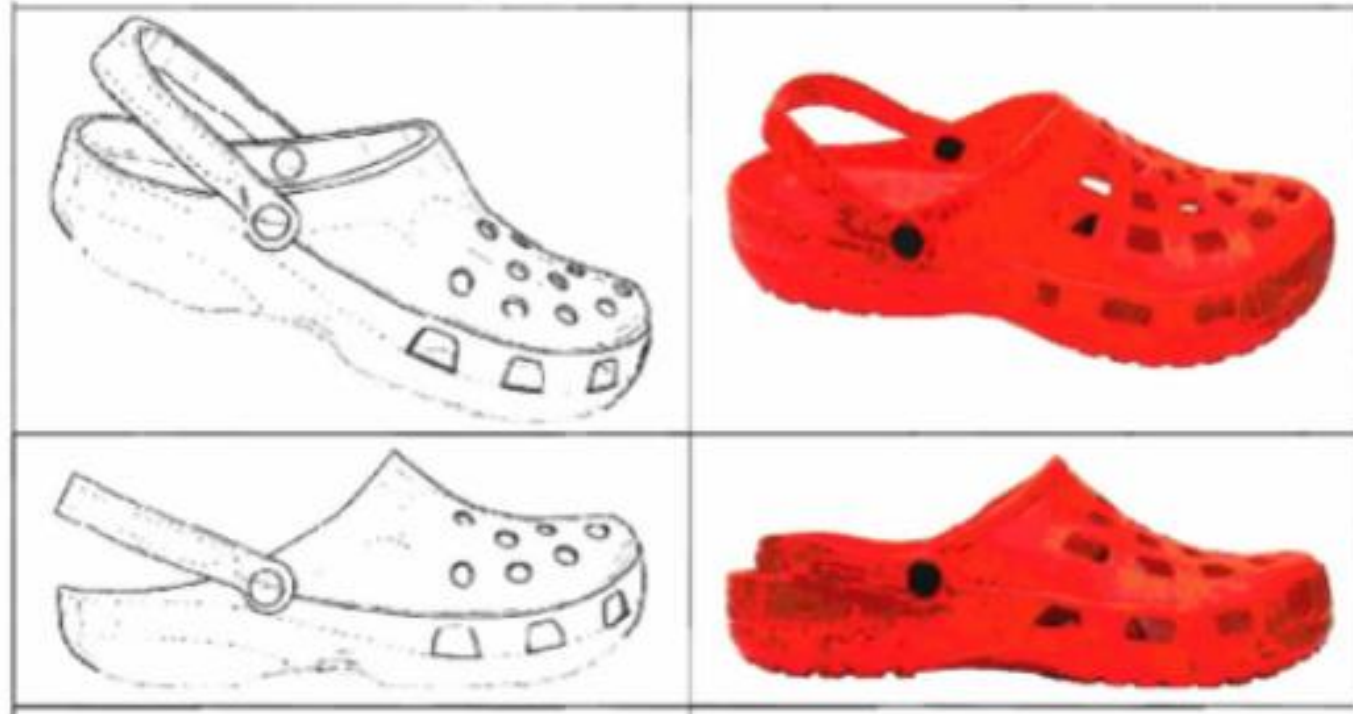
Analyzed from the perspective of an ordinary observer, not a POSITA – but it's a fact-intensive inquiry

Key is deception: "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 . . . purchase [of] one supposing it to be the other, the first one patented is infringed by the other." *Egyptian Goddess*

For infringement, the analysis should take account of the scope of the prior art because "the attention of the ordinary observer 'will be drawn to those aspects of the claimed design that differ from the prior art.'" *Lanard Toys; Egyptian Goddess*

"[M]inor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement." *Crocs v. ITC*

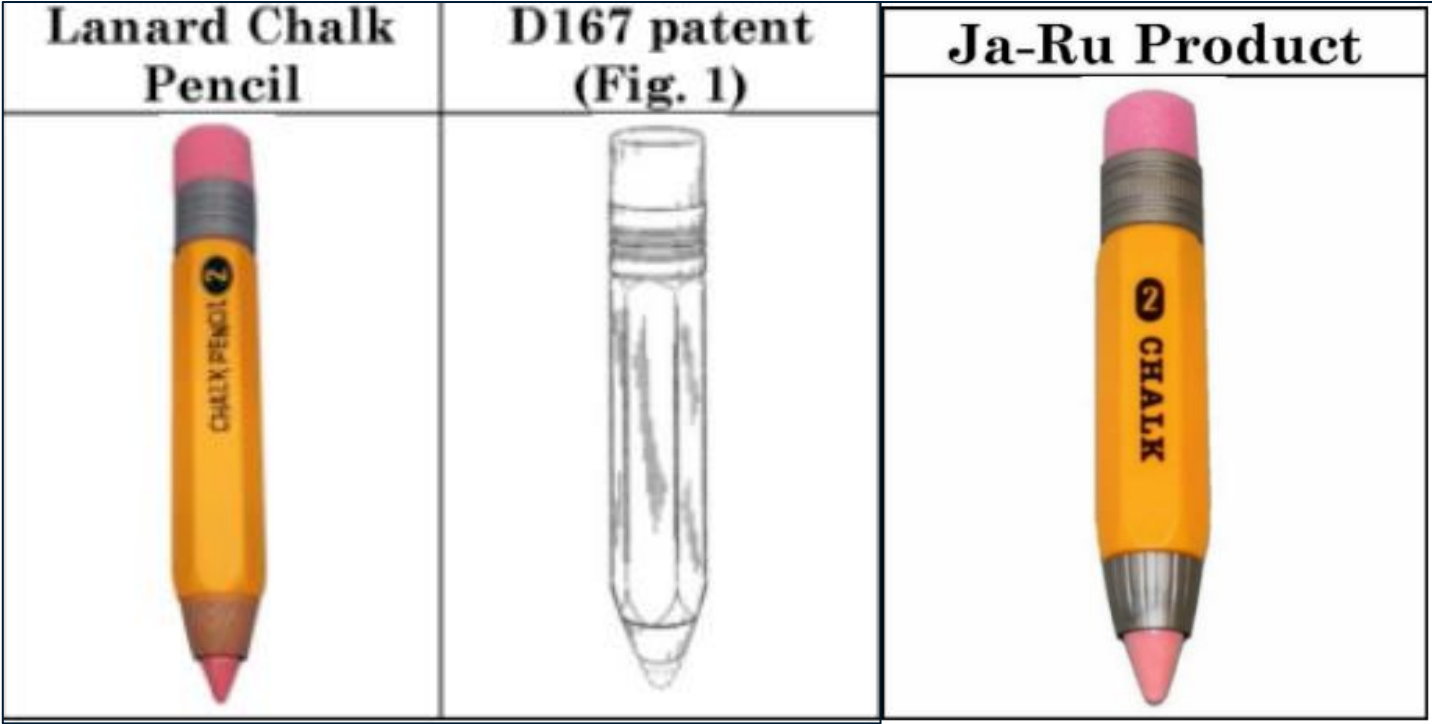
# Design Patent Infringement Examples



These side-by-side comparisons of the '789 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. In one comparison after another, the shoes appear nearly identical.

Crocs, Inc. v. Int'l Trade Comm'n, 598 F.3d 1294, 1306 (Fed. Cir. 2010)

# Design Patent Infringement Examples



The district court's detailed analysis was supportive of its conclusion that an ordinary observer, taking into account the prior art, would not believe that the accused Ja-Ru product was the same as the patented design. See *Decision*, 2019 WL 1304290, at \*17. Thus, we hold that the district court correctly granted summary judgment of noninfringement.

Lanard Toys Ltd. v. Dolgencorp LLC, 958 F.3d 1337, 1345 (Fed. Cir. 2020)

# Obviousness: The Ordinary Designer

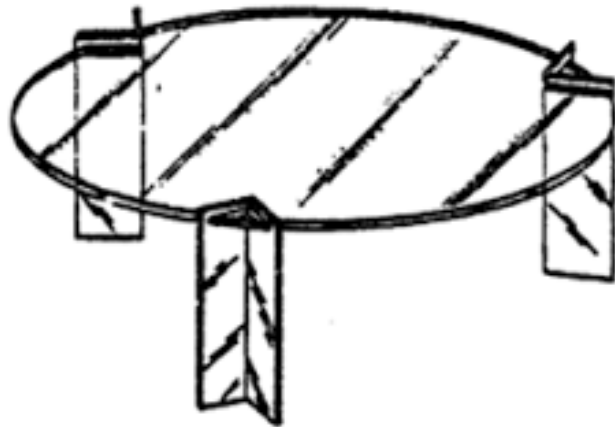


- Perspective from which obviousness is analyzed.
- Like a skilled artisan in the utility context, the level of skill will be fact dependent and differ based on field.
- Ultimate inquiry is whether the design would have been obvious to a skilled designer.

# Obviousness: The *Rosen* Reference

- First step in the obviousness analysis
- A *Rosen* reference is a "primary reference" a "something in existence" that is "basically the same" as the claimed design.
- Cases like *Durling* and *Jennings* have suggested the *Rosen* requirement serves to anchor the inquiry on the overall appearance of the design, rather than allowing hindsight-based reconstructions.

FIG. 1



# Combining References

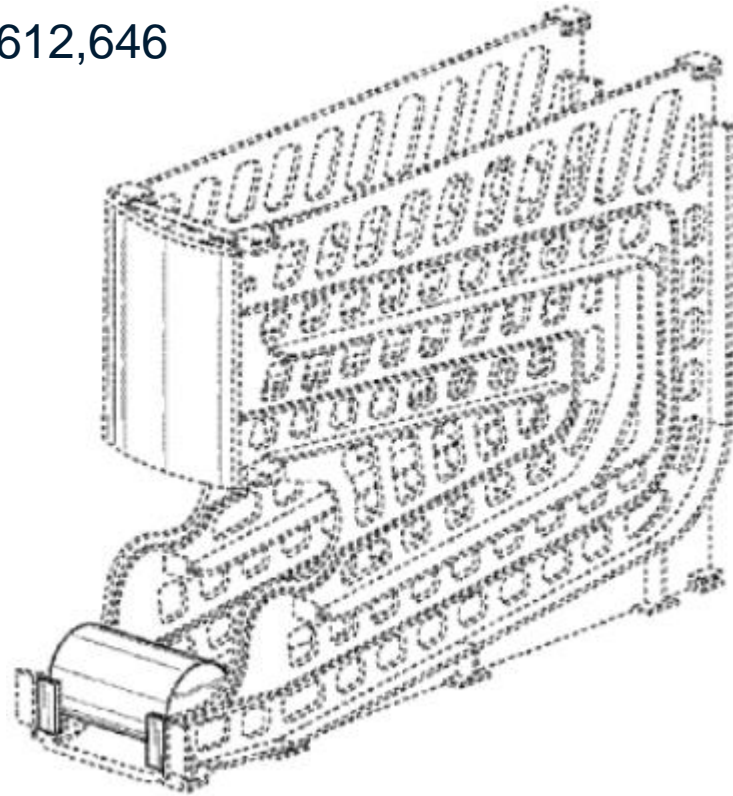


**If a *Rosen* reference exists**, secondary references may be used to modify the primary reference if they are "so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other."

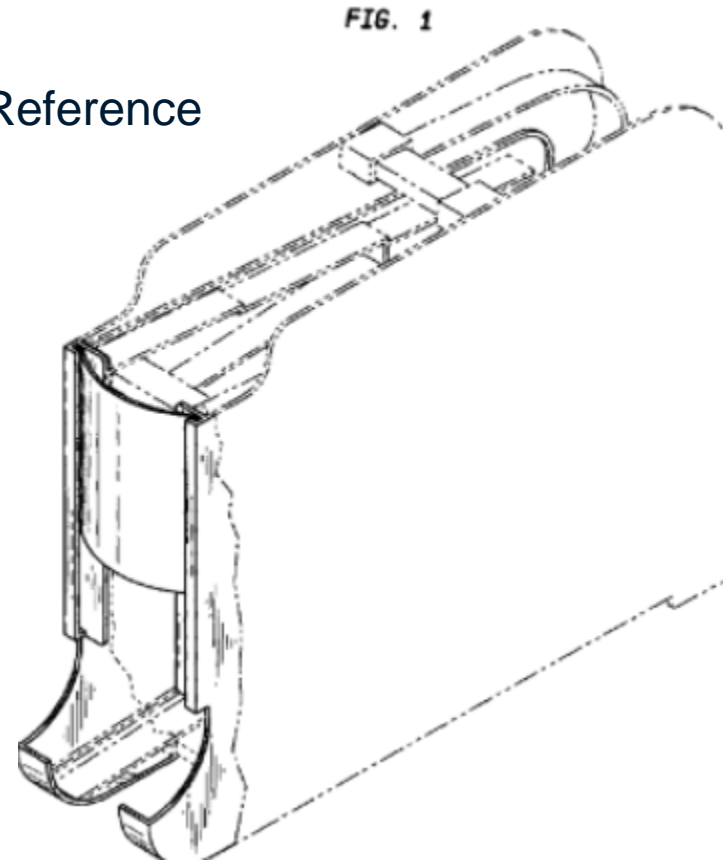
*MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014)

# Design Patent Obviousness Examples

D612,646



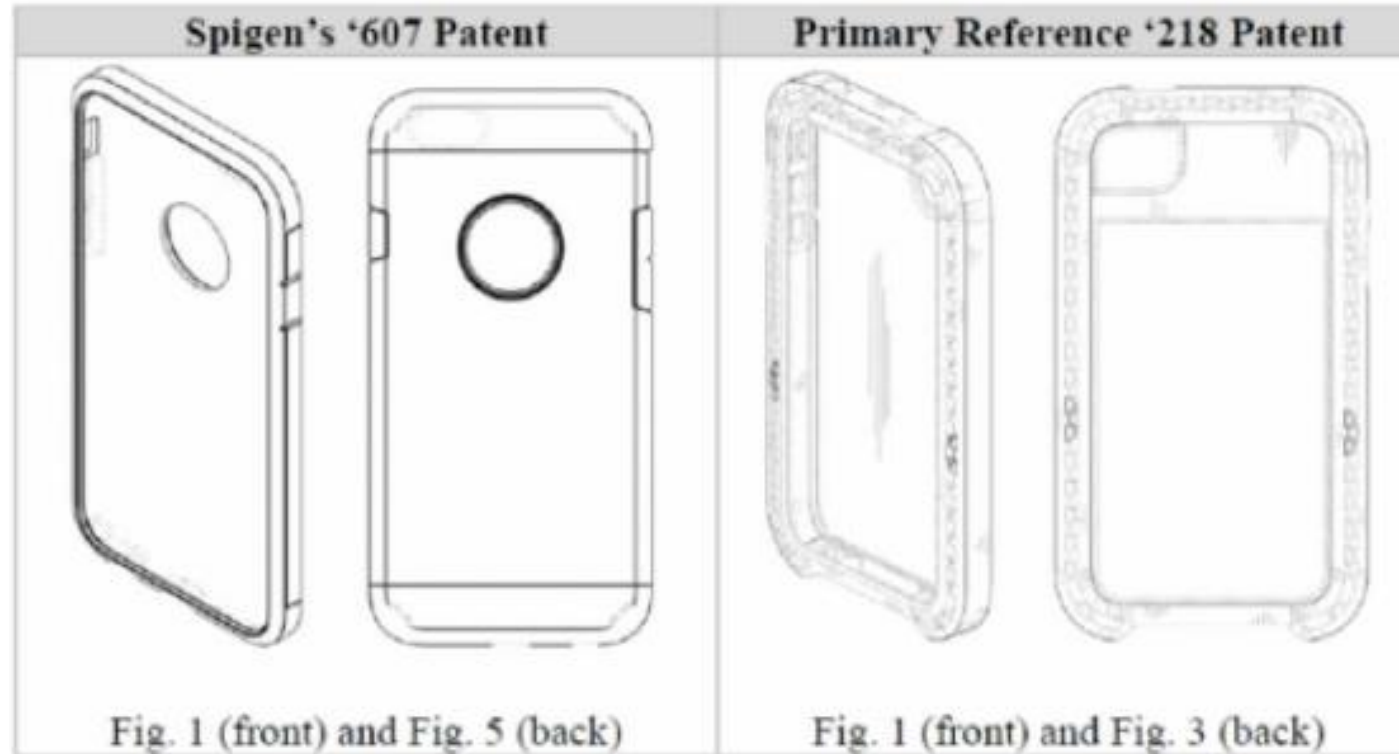
Linz Reference



Because the claimed designs would have been obvious over Linz, we reverse.

Campbell Soup Co. v. Gamon Plus, Inc., 10 F.4th 1268, 1270 (Fed. Cir. 2021), cert. denied, 142 S. Ct. 1129, 212 L. Ed. 2d 19 (2022)

# Design Patent Obviousness Examples



In the light of the competing evidence in the record, a reasonable factfinder could conclude that the '218 patent and the Spigen Design Patents have substantial differences, and, thus, are not basically the same.

Spigen Korea Co. v. Ultraproof, Inc., 955 F.3d 1379, 1385 (Fed. Cir. 2020)



# Discovery in Design Cases – Business as Usual

- **Don't expect discovery to be simpler, cheaper, or easier than in the utility context:**
  - Written discovery
  - Depositions
  - Third party discovery – especially for physical samples of prior art
  - Motion practice
- **Be sure to retain documents related to the conception of the design – especially important to demonstrate the innovative concept**
- **Ensure your experts can speak both to the perspectives of the DOSA and the ordinary observer**

# Claim Construction in Design Patent Litigation

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# Claim Construction



v.



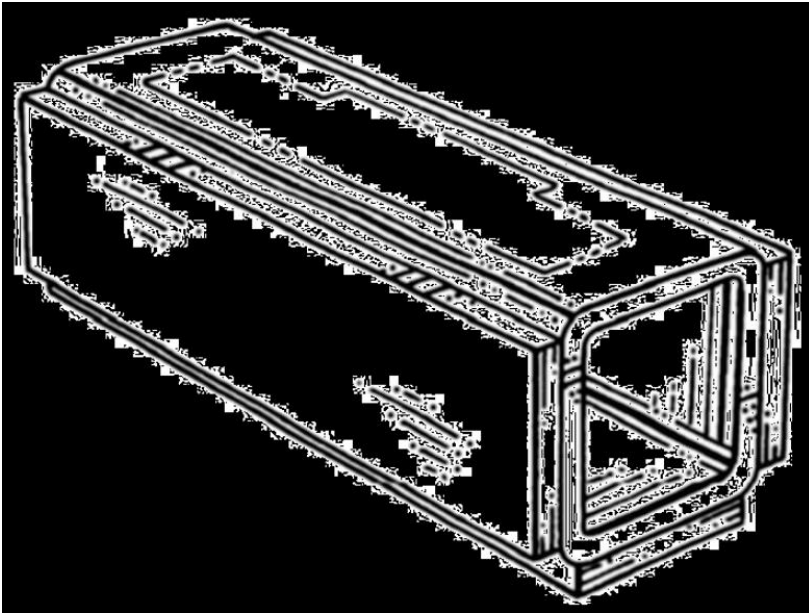
"[D]esign patents 'typically are claimed as shown in drawings' . . . For that reason, this court has not required that the trial court attempt to provide a detailed verbal description of the claimed design as is typically done in the case of utility patents." *Egyptian Goddess, Inc. V. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008).

# Claim Construction – A Wide Variety of Approaches

With that said, it is important to emphasize that a district court's decision regarding **the level of detail to be used in describing the claimed design is a matter within the court's discretion**, and absent a showing of prejudice, **the court's decision to issue a relatively detailed claim construction will not be reversible error**. At the same time, it should be clear that **the court is not obligated to issue a detailed verbal description of the design if it does not regard verbal elaboration as necessary or helpful**. . . . it is not clear that the considerable effort needed to fashion the verbal description contributed enough to the process of analyzing the case to justify the effort.

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679–80 (Fed. Cir. 2008)

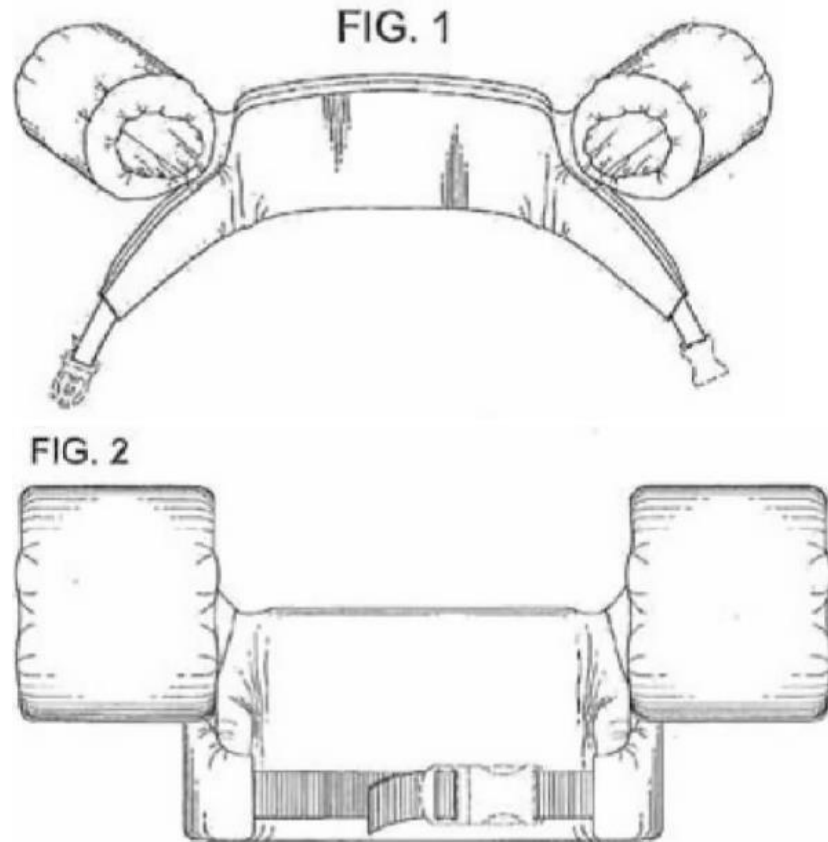
# Claim Construction – A Wide Variety of Approaches



A hollow tubular frame of generally square cross section, where the square has sides of length  $S$ , the frame has a length of approximately  $3S$ , and the frame has a thickness of approximately  $T = 0.1S$ ; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately  $1.25T$ , and the inner corner of the cross section rounded on a 90 degree radius of approximately  $0.25T$ ; and with rectangular abrasive pads of thickness  $T$  affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 668 (Fed. Cir. 2008)

# Claim Construction – A Wide Variety of Approaches

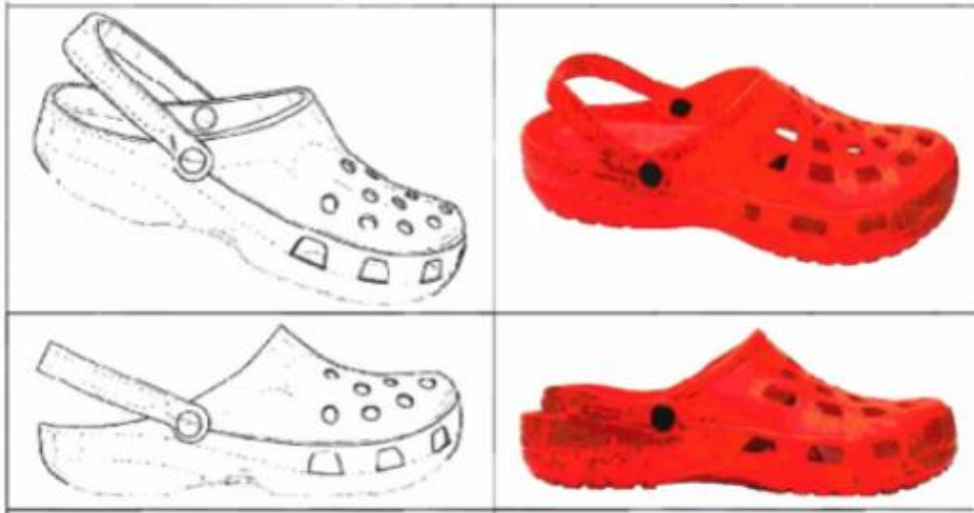


The design includes the appearance of three interconnected rectangles, as seen in Figure 2. It is minimalist, with little ornamentation. And the design includes the shape of the armbands and side torso tapering, to the extent that they contribute to the overall ornamentation of the design. As we discussed above, however, the armbands and side torso tapering serve a functional purpose, so the fact finder should not focus on the particular designs of these elements when determining infringement, but rather focus on what these elements contribute to the design's overall ornamentation.

Sport Dimension, Inc. v. Coleman Co., 820 F.3d 1316, 1323 (Fed. Cir. 2016)

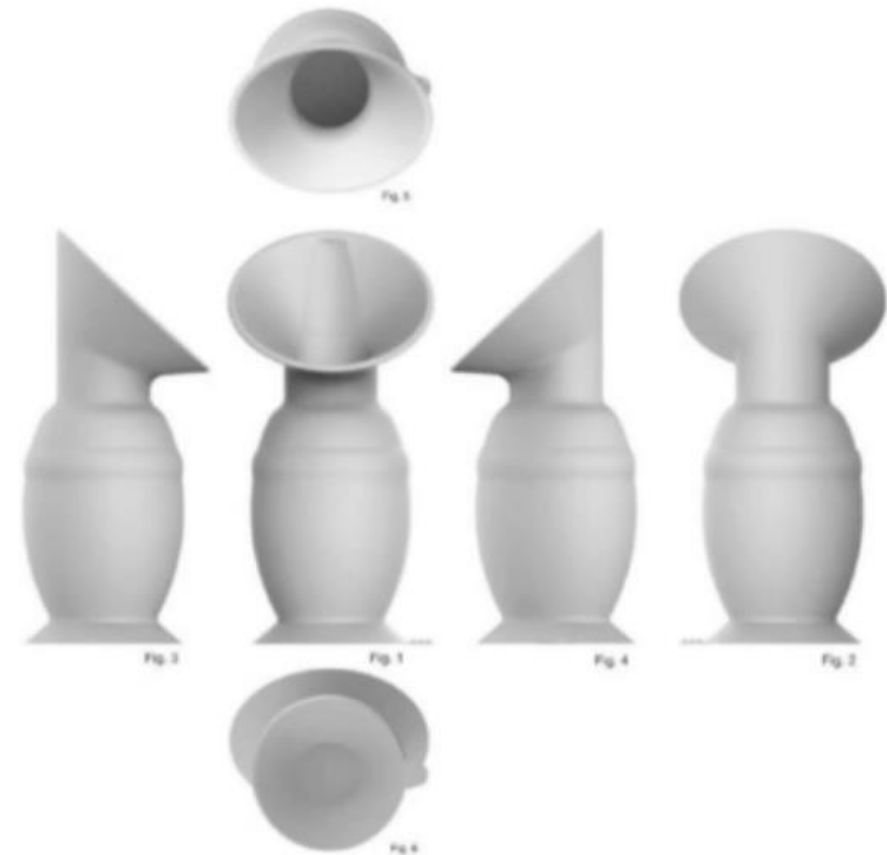
# Claim Construction – A Wide Variety of Approaches

Turning to this case, the Commission placed undue emphasis on particular details of its written description of the patented design. Those details became a mistaken checklist for infringement. Without a view to the design as a whole, the Commission used minor differences between the patented design and the accused products to prevent a finding of infringement. In other words, the concentration on small differences in isolation distracted from the overall impression of the claimed ornamental features. The proper comparison requires a side-by-side view of the drawings of the ' 789 patent design and the accused products.



Crocs, Inc. v. Int'l Trade Comm'n, 598 F.3d 1294, 1303–04 (Fed. Cir. 2010)

# Claim Construction – A Wide Variety of Approaches



Applying these principles here, the Court finds that Think Green's patent must be interpreted to claim an opaque object to the exclusion of translucent or transparent objects. The Court finds that, like a photograph, the computer-generated image constitutes a choice of surface material. For example, the dark shadow on the interior of the container depicted in the view from above of the '006 Patent clearly depicts an opaque object. A translucent or transparent object would not cast such a dark shadow on its interior.

Think Green Ltd. v. Medela AG, No. 21 C 5445, 2022 WL 6123348, at \*3 (N.D. Ill. Oct. 7, 2022)



# Design Patent Damages

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# Design Patent Damages – Several Options

- **Reasonable Royalty (*Georgia-Pacific*)**
- **Traditional Lost Profits (*Panduit*)**
- **Statutory Award of Infringing Profits (35 USC § 289)**

# Reasonable Royalty and “Traditional” Lost Profits

- **Proceeds with a similar analysis as a traditional utility litigation**
  - Reasonable Royalty: focus on comparable licenses – but often difficult to find many design licenses in discovery – and challenging to establish comparability to utility licenses
  - Lost Profits: additional challenges surrounding non-infringing alternatives to the patented design

## Statutory Damages – Potentially Easier to Prove, but May be Lower

Whoever during the term of a patent for a design, 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 ***shall be liable to the owner to the extent of his total profit***, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

35 USC § 289

# Apple v. Samsung

- **In 2016, the Supreme Court clarified the damages analysis for design patents**

“So understood, the term “article of manufacture” is broad enough to encompass both a product sold to a consumer as well as a component of that product. A component of a product, no less than the product itself, is a thing made by hand or machine. That a component may be integrated into a larger product, in other words, does not put it outside the category of articles of manufacture”

Thus, a party seeking design patent damages must take care to define the “article of manufacture” for purposes of calculating damages, as it may be less than the final, saleable product.



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# Thank You!

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