

What Features Matter In A Design Patent Case?

Law360, New York (February 09, 2015, 10:11 AM ET) -- The recent *Apple Inc. v. Samsung Electronics Co. Ltd.* litigation has generated a renewed interest in design patents — and for good reason as it highlights the potency of a well-crafted design patent. It also illustrates the scope of design patent protection, the requirements for infringement, and the differences between design and utility patents. Understanding these issues can help businesses more effectively protect their intellectual property and avoid costly mistakes.

Unlike utility patents, design patents protect ornamental features and designs. 35 U.S.C. § 171 (providing patent protection for “new, original and ornamental design[s]”). In the seminal *Egyptian Goddess Inc. v. Swisa Inc.* case, the Federal Circuit clarified the proper test for infringement of a design patent: “[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.” 543 F.3d 665 (Fed. Cir. 2008) (en banc). This test focuses on the overall appearance of the design not individual elements. *Crocs Inc. v. U.S. International Trade Commission*, 598 F.3d 1294, 1303 (Fed. Cir. 2010). When drafting claims, analyzing infringement or designing around a design patent, a fundamental question arises: Can one avoid infringement by simply adding an unclaimed feature such that the overall appearance may not be substantially similar due to the unclaimed feature?



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A review of case law that includes comparisons of patented designs to accused products offers useful insight but provides no clear answer. These cases suggest that some courts take into account these extra, unclaimed feature(s), but at least one court has refused to do so explaining the infringement inquiry focuses on the appropriation of the patented design, and an additional, unclaimed element does not prevent infringement.

Nevertheless, even if legally these unclaimed elements should not be taken into account (as is the case with utility patents), at least some courts are considering them. Thus, adding a distinguishing feature to the patented design may help avoid infringement, but the safer route is to change the design such that the patented design is not present or so that the design mimics unprotected prior art.

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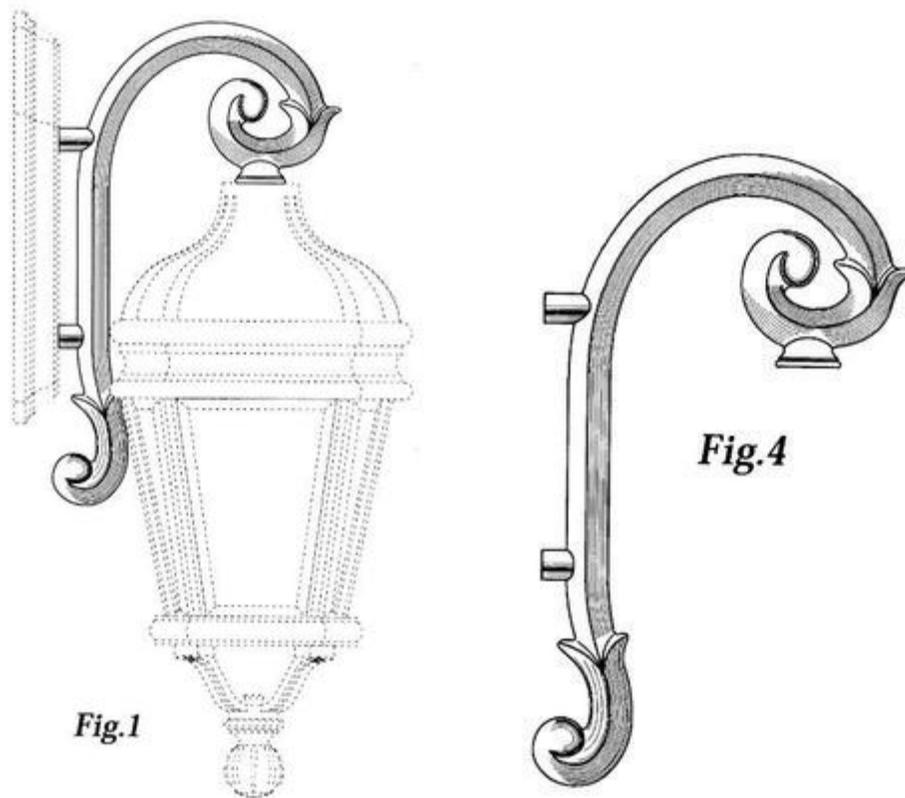
Three cases address this issue and are illustrative. First, in a 2008 decision from the Eastern District of Texas, the court explained that unclaimed features were not part of the infringement analysis and affirmed the magistrate judge’s recommendation to deny the defendant’s motion for summary judgment. *Dexas Int’l Ltd. v. Tung Yung Int’l Inc.*, No. 6:07cv334, 2008 U.S. Dist. LEXIS 106875 (E.D. Tex. Oct. 14, 2008). The below chart, included in the plaintiff’s preliminary infringement contentions and points of novelty, shows the patented design and accused design. As the chart shows, the accused design includes a calculator and clip, two features not found in the patented design.



Rejecting the defendant's argument that the magistrate judge incorrectly ignored ornamental elements that were not found in the patented design, the court noted that "[b]ecause the claimed design is defined by the drawings in the patent ... the infringement analysis should focus on the ornamental features in the claimed design." As the plaintiff aptly explained, "features added to the Accused Design, 'above and beyond the ornamental features illustrated in the '599 Patent, are irrelevant to the ordinary observer test, and were correctly ignored.'" The court agreed and instead focused on the claimed design.

Unlike the Texas court, the Northern District of Texas court took into account an unclaimed feature when granting summary judgment in favor of the defendants and finding the accused fixture did not infringe the relevant design patent. *Minka Lighting Inc. v. Maxim Lighting International Inc.*, No. 3:06-CV-995-K, 2009 U.S. Dist. LEXIS 20948 (N.D. Tex. Mar. 16, 2009). The court's order granting summary judgment included a comparison of the relevant designs, showing Figure 1 of the '591 patent side-by-side with an image of Cambria's design.

The following are figures from D461,591:



The following is an image of the defendants' accused design:



Defendants' Cambria design

While the court recognized several differences in the designs, the most notable and discussed difference was the unclaimed hook: “[m]ost notably, Defendant’s fixtures include a distinct ornamental ‘hook’ in the center portion of the lamp support arm.” The hook, extending from center of the fixture, “makes [Cambria’s fixture] readily distinguishable from the ‘591 patent.” In fact, the court said the “difference is obvious at first glance” since the hook gave the Cambria fixture three appendages while the patented design only had two. Thus, while not directly tackling the issue of auxiliary features, the court considered the unclaimed feature in its analysis, impliedly taking a

position contrary to that of the Texas court.

The District of Maryland court too took into consideration an additional unclaimed feature in a 2011 decision involving patented bench designs. *Victor Stanley Inc. v. Creative Pipe Inc.*, No. MJG-06-2662, 2011 U.S. Dist. LEXIS 112846 (D. Md. Sept. 30, 2011), *aff'd* 499 Fed. Appx. 971 (Fed. Cir. 2013). Interestingly, this case involved multiple benches that were accused of infringing the patented design; the court found one bench type to be infringing and another bench type — the bench with the additional, unclaimed support bar — to be not infringing.

The following designs were found to be substantially similar:

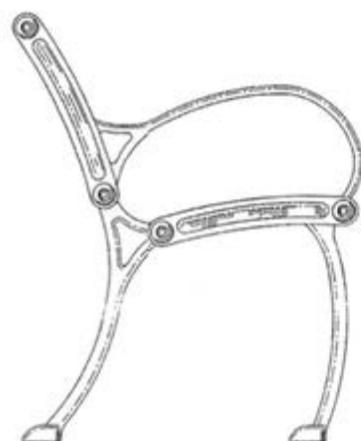


The Patent



The Nebelli Bench

The following designs, however, were deemed not substantially similar:



The Patent



The Necati Bench

The court found the addition of a second brace and an oval made the two benches distinguishable. While the court acknowledged that the individual ornamental elements might be nearly identical, the overall impression was different. "The overall effect of the design with the oval below the seat, while certainly taking advantage of the graceful curves designed into the Patent design, creates a different and distinctive look that would not confuse the ordinary observer." Taking a practical stance, the court pointed out there could only be design patent infringement if an ordinary observer would purchase a product taking it to be another; here, there was not a risk that this would happen.

As these three cases demonstrate, the law on this subject is unsettled with one court clearly stating that such auxiliary features should be ignored and two other courts taking into account these extra, unclaimed features. Indeed, the additional, unclaimed support bar seemingly played a pivotal role in the District of Maryland's Victor Stanley Inc. decision in which a bench without the unclaimed support bar was found infringing and a bench with the unclaimed support bar was found noninfringing. Therefore, the safest bet is to avoid a feature of the patented design rather than adding an unclaimed feature. However, if business considerations do not allow such a design, adding a prominent feature is likely the next best alternative.

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