

# Report from the Front Line: U.S. District Courts

A brief review of U.S. district court decisions over the past year

Dunstan H. Barnes, Ph.D.

McAndrews, Held & Malloy, Chicago, Illinois

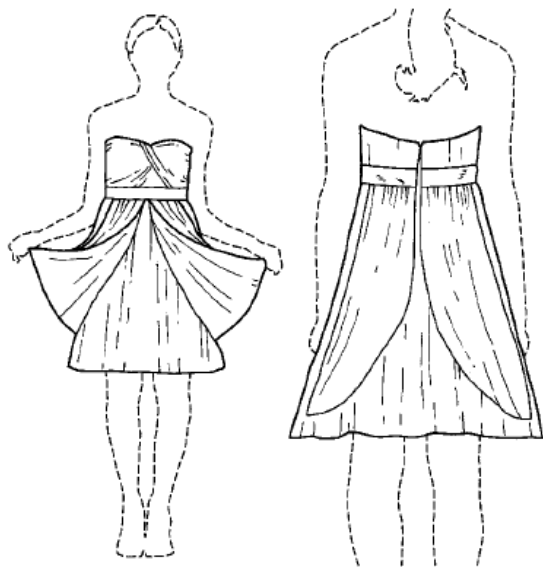
# OUTLINE

- A review of U.S. District Court design patent cases over the past calendar year focusing on four general topics:
  - Prosecution history estoppel
  - Claim construction
  - Anticipation and obviousness
  - Infringement and Section 289 damages

PROSECUTION HISTORY ESTOPPEL

## JENNY YOO COLLECTION, INC. V. WATTERS DESIGN INC. (S.D.N.Y.)

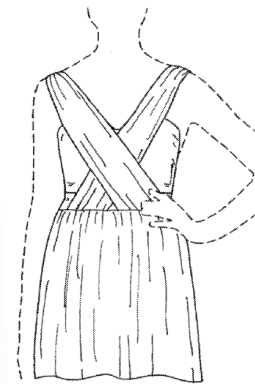
- **July 2013:** During prosecution of D698,120, Jenny Yoo receives restriction requirement; elects Group I and shortly after files divisional directed to Group II, which issues as D744,723
- **March 2016:** Jenny Yoo sues defendants for infringing these two convertible bridesmaid gown design patents (D698,120 and D744,723)



D698,120 (Jenny Yoo)  
Dress



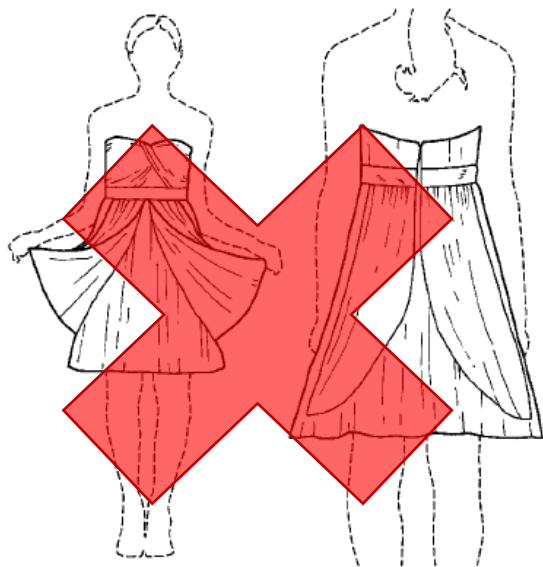
D698,120 (Jenny Yoo)  
Convertible Dress



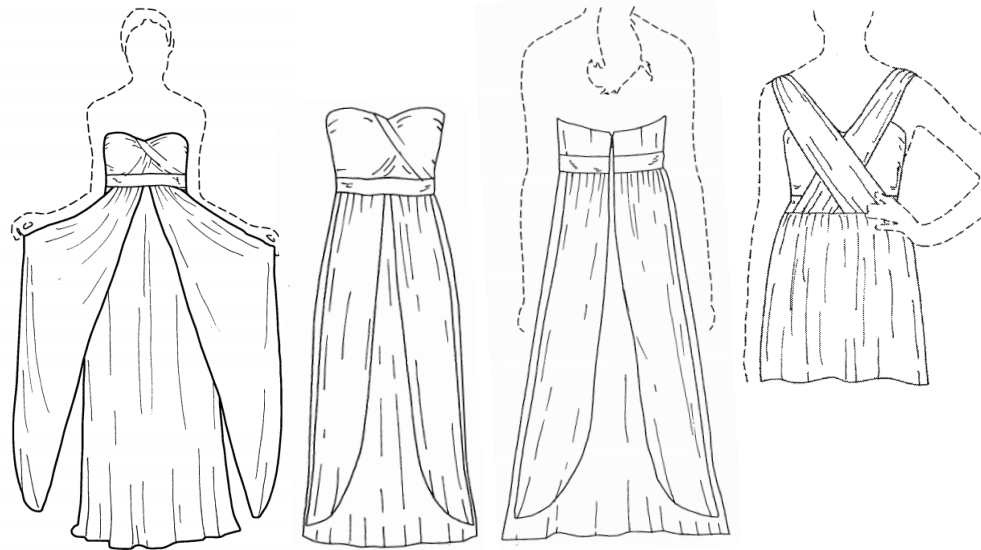
Accused Dresses

## JENNY YOO COLLECTION, INC. V. WATTERS DESIGN INC. (S.D.N.Y. OCT. 20, 2017)

- **October 20, 2017:** Court grants motion to dismiss for non-infringement of D698,120 (short dress) based on prosecution history estoppel
  - Court finds DBI's accused dresses (all long dresses) are within the surrendered claim scope of D698,120
  - However, case continues forward with alleged infringement of D744,723 (directed to long convertible dress)



D698,120 (Jenny Yoo)  
Dress



D744,723 (Jenny Yoo)  
Convertible Dress

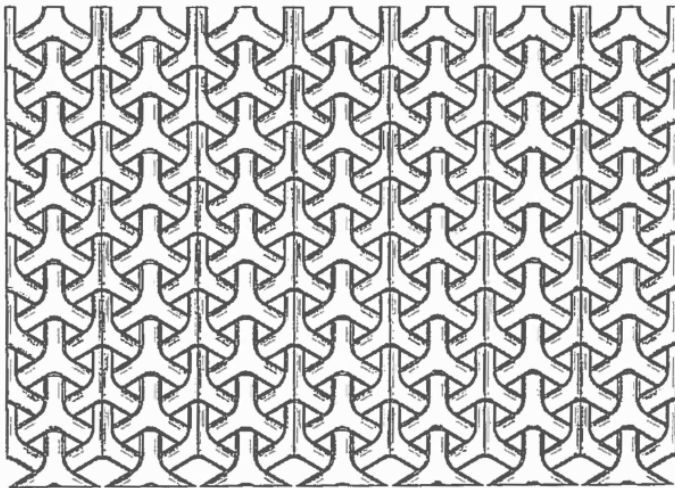


Accused Dresses

## CURVER LUXEMBOURG V. HOME EXPRESSIONS INC. (D.N.J.)

- **April 2015:** During prosecution, Curver Luxembourg receives *Ex Parte Quayle* Office Action
  - Applicant's design claims priority to Israel design registration for "Furniture (Part of)"
  - Examiner objects to title as too vague; suggests amending title to "Pattern for a Chair"
  - Applicant amends title to "Pattern for a Chair"

Figure 1



D677,946 (Curver Luxembourg)  
Pattern for a Chair

Figure 2



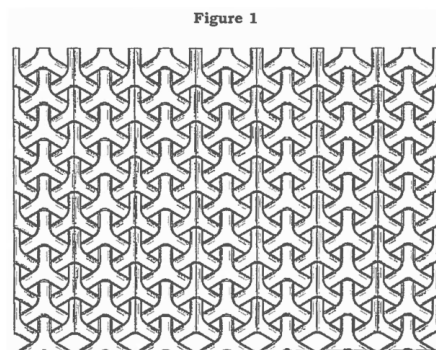
Figure 3



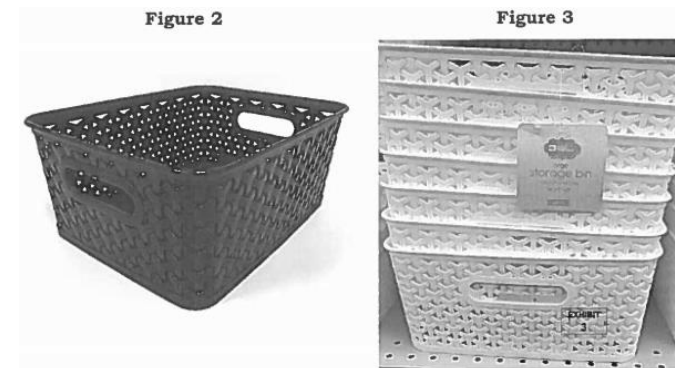
Accused Baskets

## CURVER LUXEMBOURG V. HOME EXPRESSIONS INC. (D.N.J. JAN. 8, 2018)

- **June 2017:** Curver Luxembourg sues Home Expressions for design patent infringement
- **January 8, 2018:** Court holds that Applicant's title amendment bars the infringement claim against baskets under prosecution history estoppel, even though baskets are visually "substantially similar" to Applicant's claimed design, because
  - (a) there was surrender of claim scope,
  - (b) it was for reasons of patentability, and
  - (c) the accused design is within the scope of the surrender



D677,946 (Curver Luxembourg)  
Pattern for a Chair

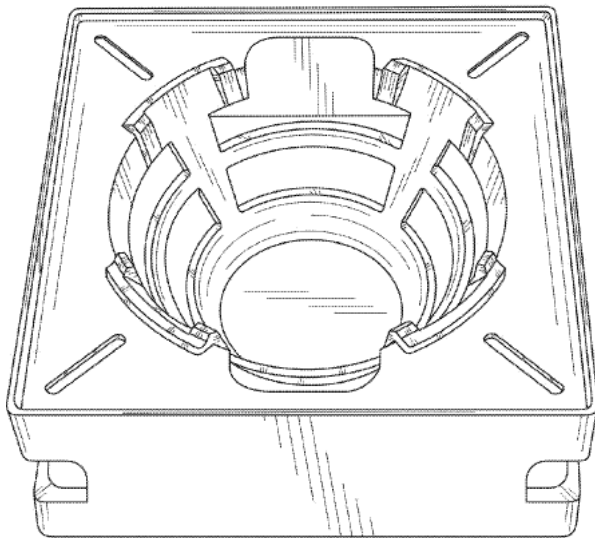


Accused Baskets

# CLAIM CONSTRUCTION

## BOILING POINT GRP., INC. V. FONG WARE CO. (C.D. CAL.)

- Boiling Point Group sues Fong Ware for infringing its hot pot holder design



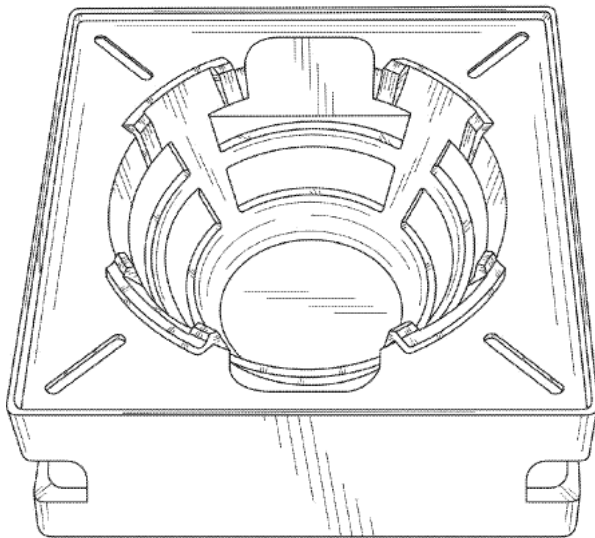
D680,811 (Boiling Point Group)  
Apparatus for Holding and Heating a Hot Pot



Accused Hot Pot Holders

## BOILING POINT GRP., INC. V. FONG WARE CO. (C.D. CAL. APR. 27, 2017)

- **April 27, 2017:** Claim construction order
  - The Court construes the claim as “the ornamental design for an apparatus for holding and heating a hot pot, as shown and described, **excluding the functional aspects of the frustoconical bowl and of the prongs around the rim thereof to hold the hot pot in place, and of openings to allow air flow.**”



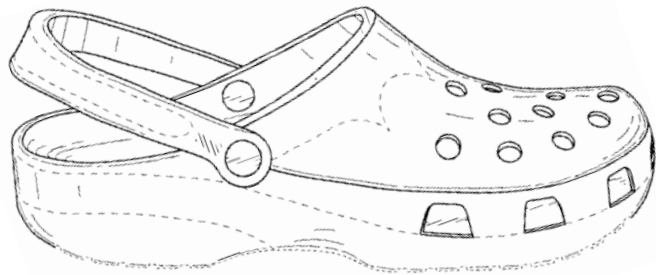
D680,811 (Boiling Point Group)  
Apparatus for Holding and Heating a Hot Pot



Accused Hot Pot Holders

## CROCS, INC. V. EFFERVESCENT, INC. (D. COLO.)

- **April 2006:** Crocs sues numerous defendants, including Double Diamond Distribution (behind a line of footwear called Dawgs Clogs), for infringing its footwear design patent



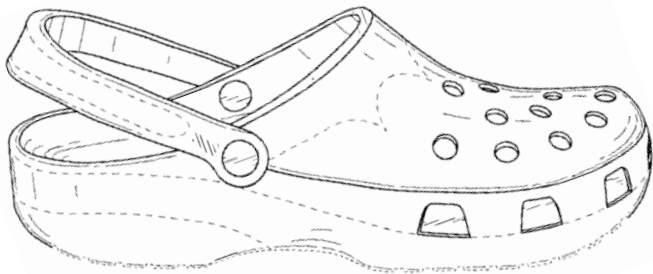
D517,789 (Crocs)  
Footwear



Accused Dawgs product  
(available in April 2006)

## CROCS, INC. V. EFFERVESCENT, INC. (D. COLO. JUNE 27, 2017)

- **June 27, 2017:** Claim construction order
  - Defendants sought to exclude functional features of claimed design
  - Court holds that although there are factors weighing in favor of finding that the strap is functional, it also plays an aesthetic role
  - **Court declines to improperly eliminate functional features that contribute to the ornamental appearance**



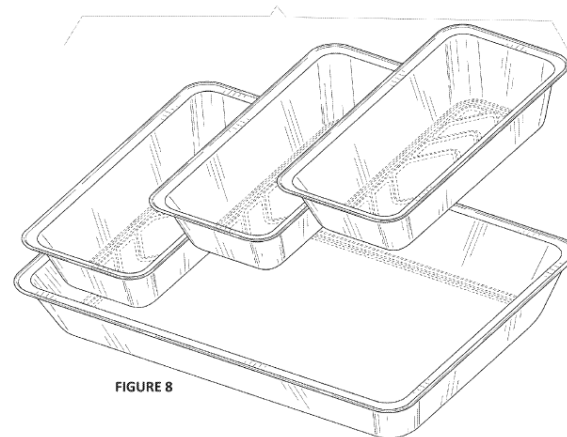
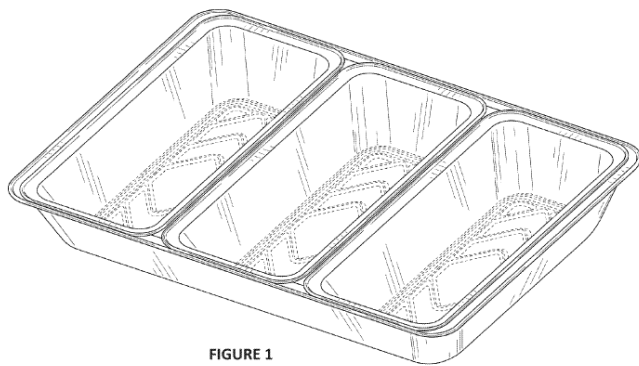
D517,789 (Crocs)  
Footwear



Accused Dawgs product  
(available in April 2006)

## HFA, INC., PLAINTIFF, V. TRINIDAD-BENHAM CORP. (E.D. TEX.)

- HFA sues Trinidad-Benham for allegedly infringing its nested pans design patent



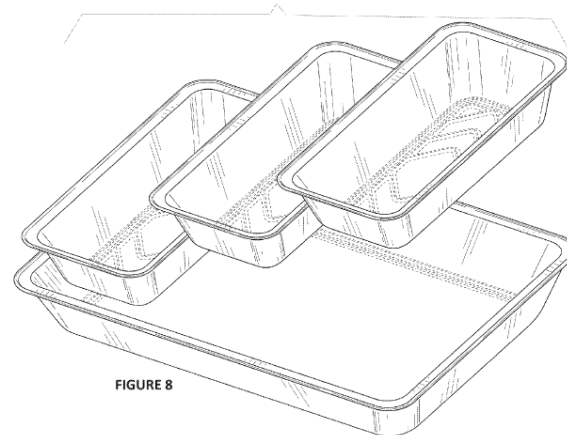
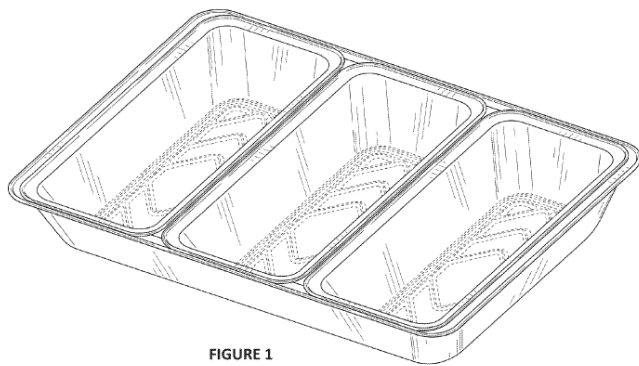
D713,196 (HFA)  
Nested Pans



Accused Pans

# HFA, INC., PLAINTIFF, V. TRINIDAD-BENHAM CORP. (E.D. TEX. MAR. 7, 2018)

- **March 7, 2018:** Claim construction order
  - “Indisputably, here, the nested pans are both functional and ornamental.”
  - Court construes the claim as **“the ornamental design for a nested pans, as shown and described in Figures 1 to 14, excluding the elements shown in broken lines.”**



D713,196 (HFA)  
Nested Pans



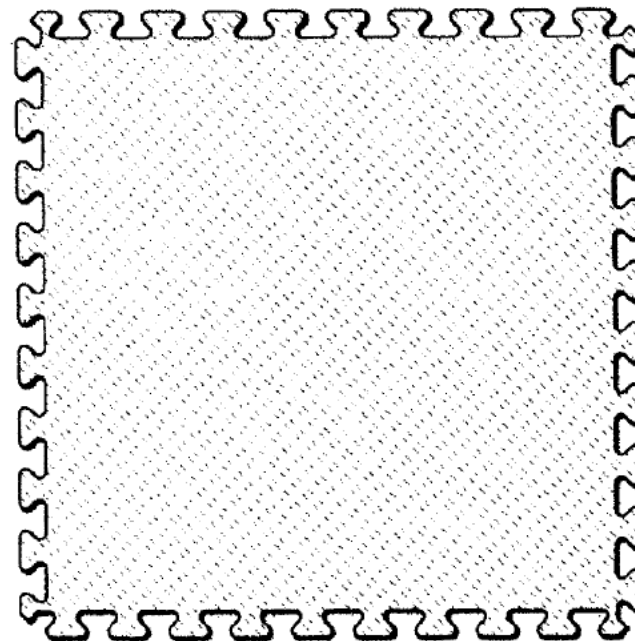
Accused Pans

# PARALLAX GRP. INT'L, LLC V. INCSTORES, LLC (C.D. CAL.)

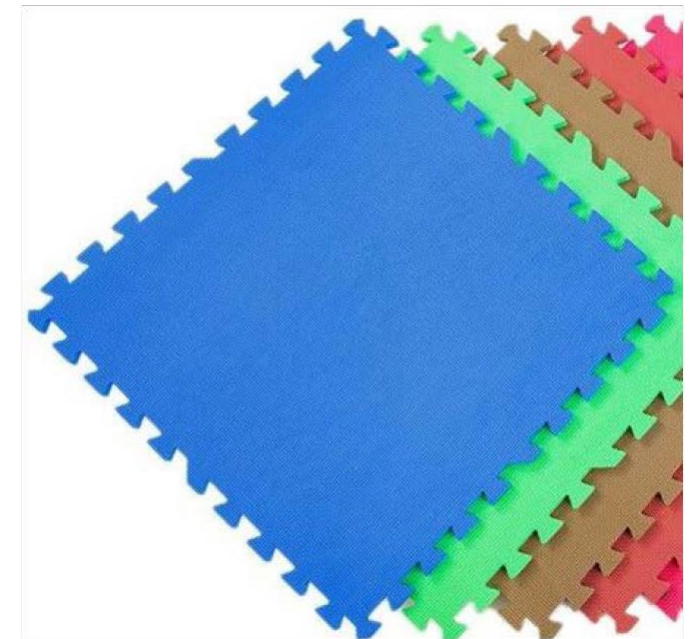
- **May 2016:** Parallax Group sues Incstores for infringing its two-color resilient mat



Prior Art Mats



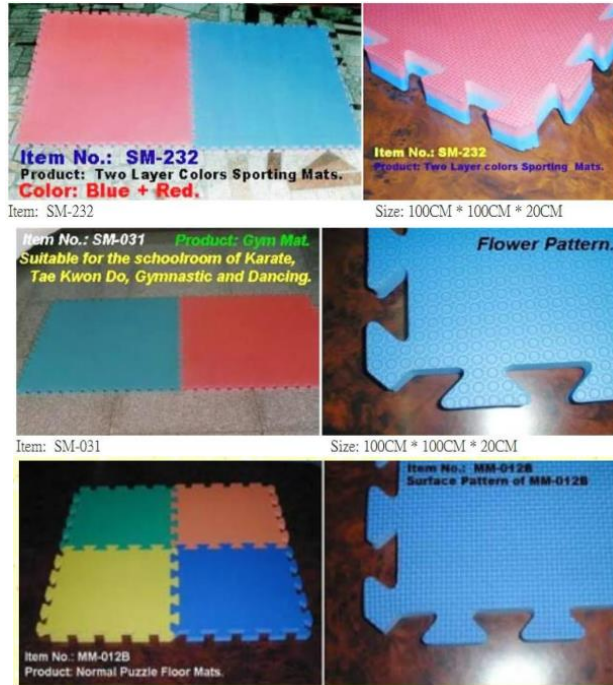
D543,764 (Parallax Group Int'l)  
Resilient Mat



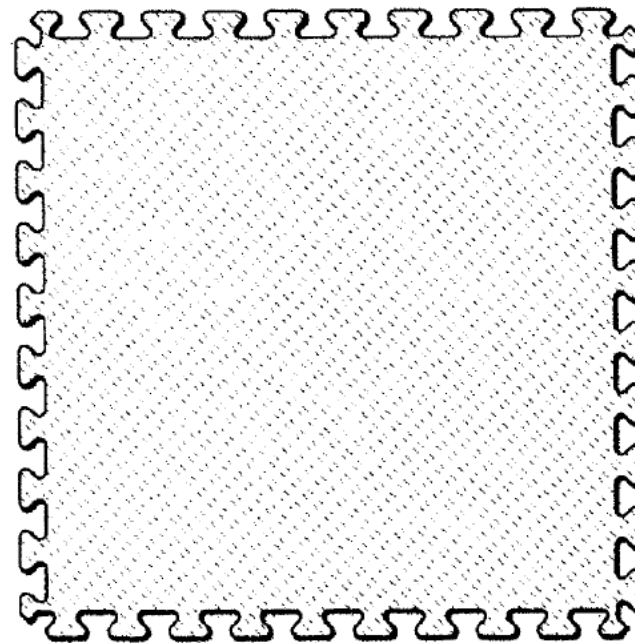
Accused Mats

# PARALLAX GRP. INT'L, LLC V. INCSTORES, LLC (C.D. CAL. JUNE 30, 2017)

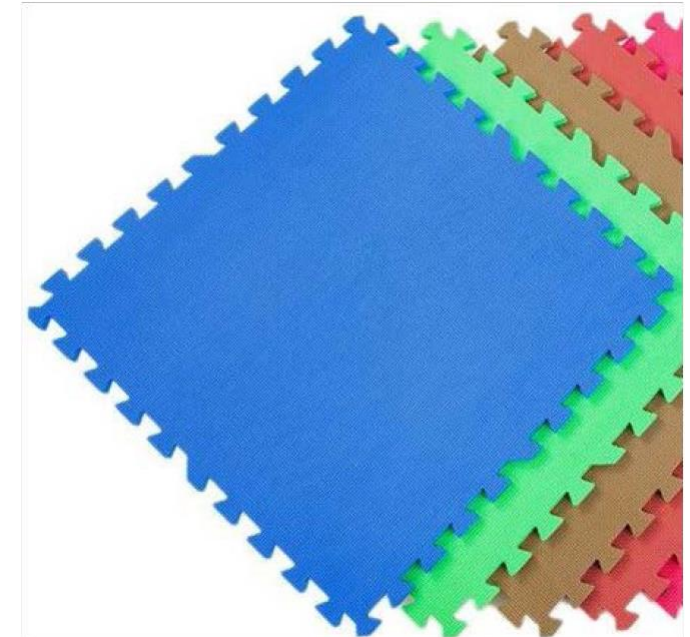
- **June 30, 2017:** Claim construction order
  - **No construction is necessary, and the Court construes the design patent as shown.**



Prior Art Mats



D543,764 (Parallax Group Int'l)  
Resilient Mat



Accused Mats

ANTICIPATION & OBVIOUSNESS

## MMI, INC. V. RICH GODFREY & ASSOCS., INC. (D. ARIZ. SEPT. 29, 2017)

- Court grants summary judgment of anticipation under pre-AIA 102(b)
  - Defendants presented clear and convincing evidence that the patented minibike design was on-sale in 2006, more than one year before the patent-at-issue was filed
  - The evidence of invalidity is such that “no reasonable jury could find otherwise”



VIN L4GSDGL056S00021 (2006)

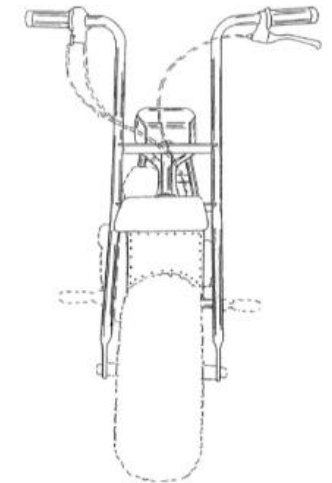
DB-30 minibike (available in 2006)



VIN L4GSDGL056S00021 (2006)



'203 Patent Figure 7



'203 Patent Figure 1

D591,203 (MMI)

Asymmetrical mini bike (filed Nov. 15, 2007)

# PARALLAX GRP. INT'L, LLC V. INCSTORES, LLC (C.D. CAL. JUNE 30, 2017)

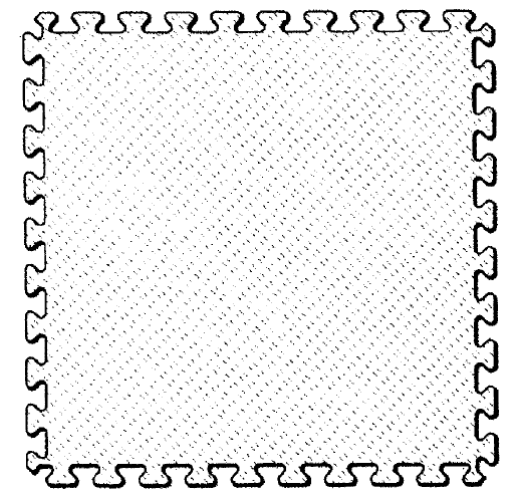
- **June 30, 2017:** Order on motion for summary judgment of anticipation and obviousness
  - Anticipation – Court denies SJ; due to slight differences in designs, genuine issue of fact
  - Obviousness – Court grants SJ of obviousness
    - Court holds that it is obvious to modify EVAHWCG mat to arrive at claimed design
    - Court finds lack of nexus for secondary considerations (such as commercial success)



Prior Art Mats



Corner comparison



D543,764 (Parallax Group Int'l)  
Resilient Mat

## DECKERS OUTDOOR CORP. V. ROMEO & JULIETTE, INC. (C.D. CAL.)

- Plaintiff Deckers (maker of UGG boots) sued Defendants for design patent infringement of four boot design patents
- As a defense, Defendants argue that asserted design patents are obvious in light of prior art patents/products
- In reply, Deckers moves for summary judgment of no invalidity for two reasons:
  - Several prior art references lack sufficient evidence of sale or publication dates
  - Any remaining prior art references are dissimilar as compared to Deckers' claimed designs

## DECKERS OUTDOOR CORP. V. ROMEO & JULIETTE, INC. (C.D. CAL. JUNE 13, 2017)

- Court grants summary judgment of **no invalidity** for D582,650 (no primary reference)
  - Asserted primary reference lacks side opening, is circular, and has prominent seams

### Asserted primary reference

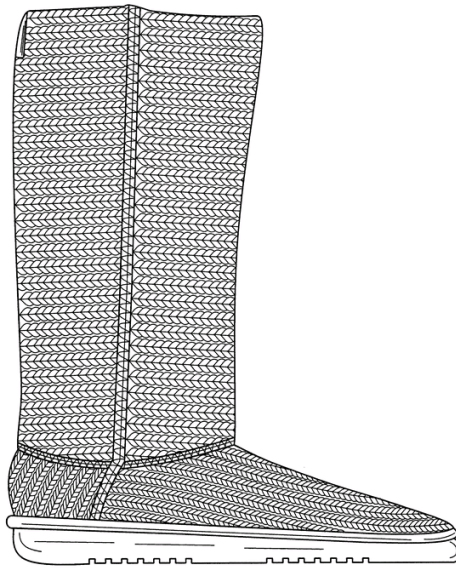


Fig. 5

Asserted Prior Art Boots  
(excluding those excluded by Court)

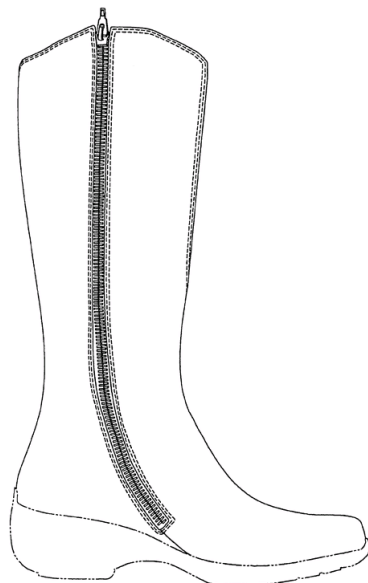
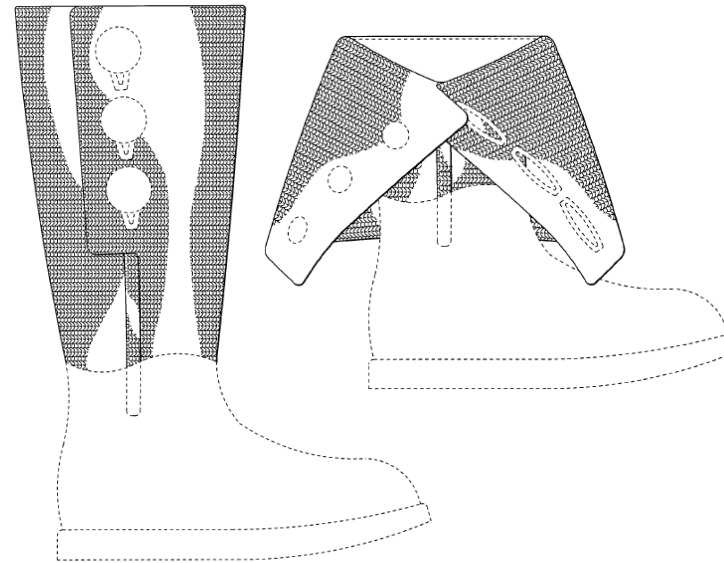


Fig. 4



D582,650 (Deckers Outdoor)  
UGG® Cardy Boot

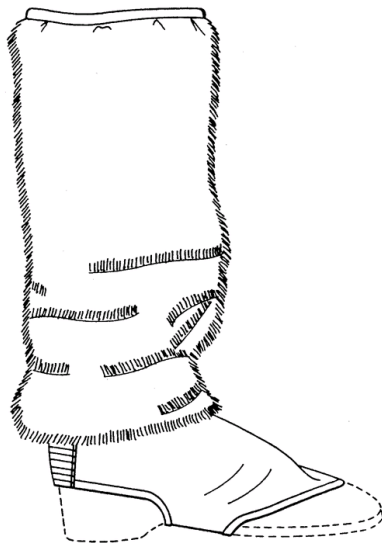


Accused Boot

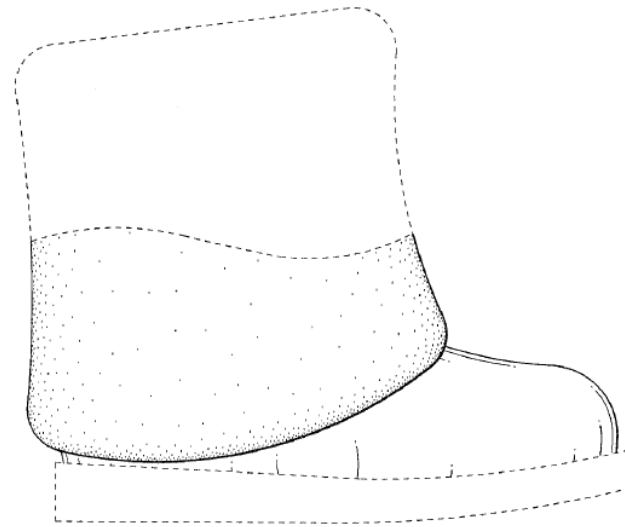
## DECKERS OUTDOOR CORP. V. ROMEO & JULIETTE, INC. (C.D. CAL. JUNE 13, 2017)

- Court grants summary judgment of **no invalidity** for D642,781 (no primary reference)
  - Defendants failed to produce authenticated images of entire boot (only single view below authenticated)

Single view



Asserted Prior Art Boots  
(excluding those excluded by Court)



D642,781 (Deckers Outdoor)  
UGG® MaylinBoot



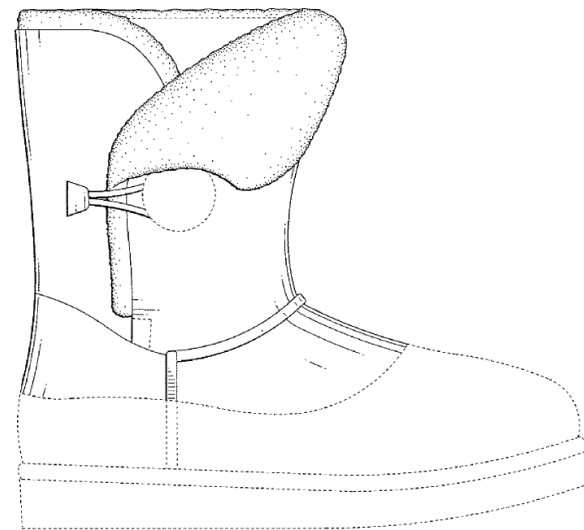
Accused Boot

## DECKERS OUTDOOR CORP. V. ROMEO & JULIETTE, INC. (C.D. CAL. JUNE 13, 2017)

- Court grants summary judgment of **no invalidity** for D599,999 (no primary reference)
  - Defendants' two asserted primary references were both excluded as inadmissible prior art



Asserted Prior Art Boots  
(excluding those excluded by Court)



D599,999 (Deckers Outdoor)  
UGG® Bailey Button Boot



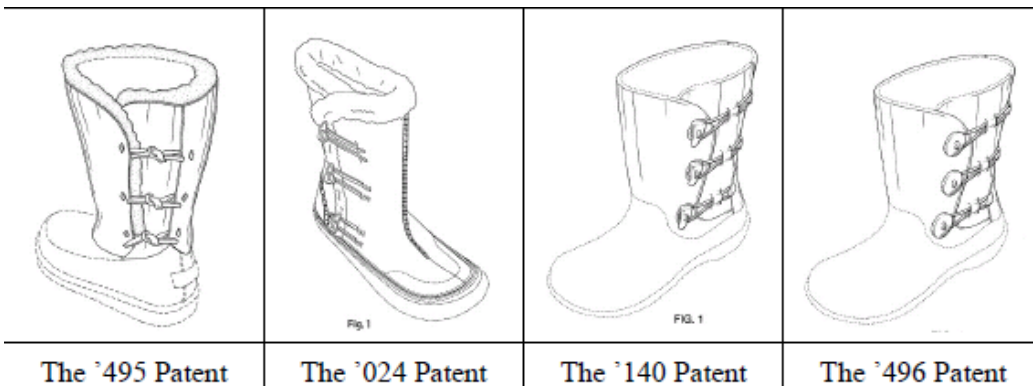
Accused Boot

# DECKERS OUTDOOR CORP. V. ROMEO & JULIETTE, INC. (C.D. CAL. JUNE 13, 2017)

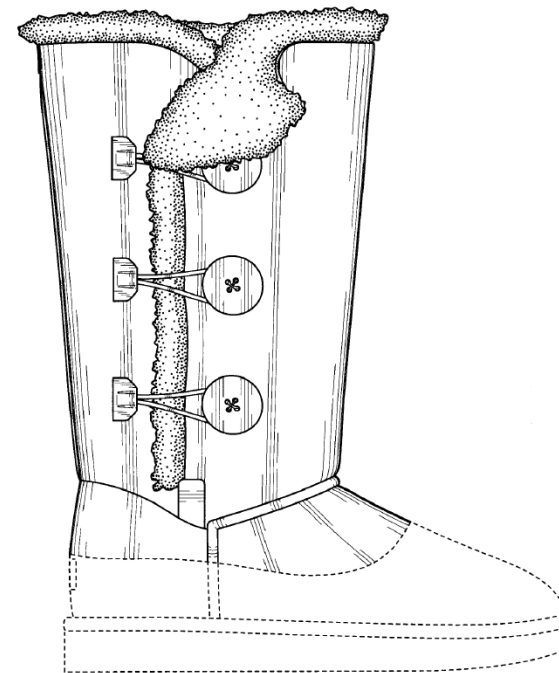
- Court **denies** summary judgment of no invalidity for D616,189
  - But, denying SJ of no invalidity  $\neq$  SJ of invalidity (rather, question of fact for jury)



Possible primary reference



Asserted Prior Art Boots  
 (excluding those excluded by Court)



D616,189 (Deckers Outdoor)  
 UGG® Bailey Button



Accused Boot

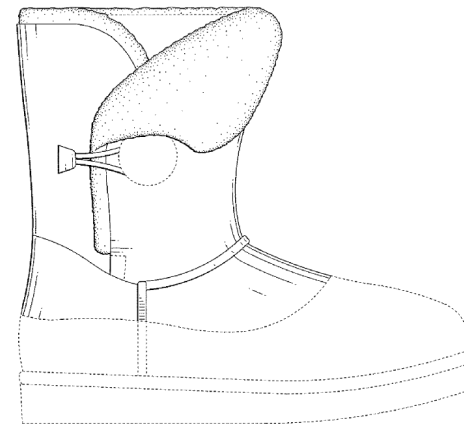
INFRINGEMENT & SECTION 289 DAMAGES

## DECKERS OUTDOOR CORP. V. ROMEO & JULIETTE, INC. (C.D. CAL. APR. 6, 2018)

- **April 6, 2018:** Jury verdict (unredacted version available)
  - Jury unanimously found that Romeo & Juliette willfully infringed '999 design patent
  - Jury found \$2.1 million of Romeo & Juliette's profits to be attributable to its sale of infringing boots



Asserted Prior Art Boots



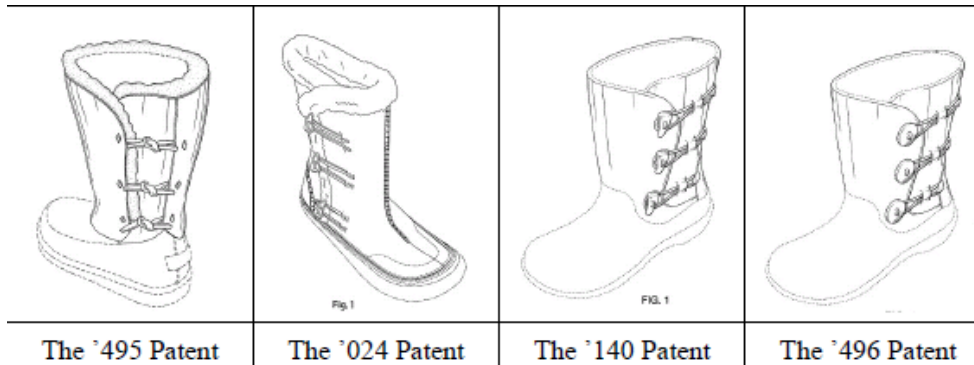
D599,999 (Deckers Outdoor)  
UGG® Bailey Button Boot



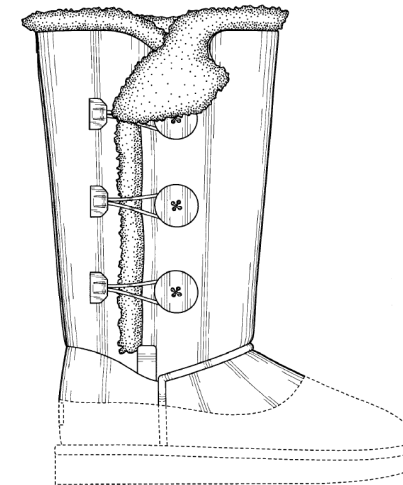
Accused Boot

## DECKERS OUTDOOR CORP. V. ROMEO & JULIETTE, INC. (C.D. CAL. APR. 6, 2018)

- **April 6, 2018:** Jury verdict (unredacted version available)
  - Jury upheld validity of '189 design patent
  - Jury unanimously found that Romeo & Juliette willfully infringed '189 patent
  - Jury found \$3.1 million of Romeo & Juliette's profits to be attributable to its sale of infringing boots



Asserted Prior Art Boots



D616,189 (Deckers Outdoor)  
UGG® Bailey Button



Accused Boot

# PO-HSUN LIN V. BELKIN INT'L, INC. (C.D. CAL.)

- **April 2016:** Po-Hsun Lin sues Belkin for design patent infringement

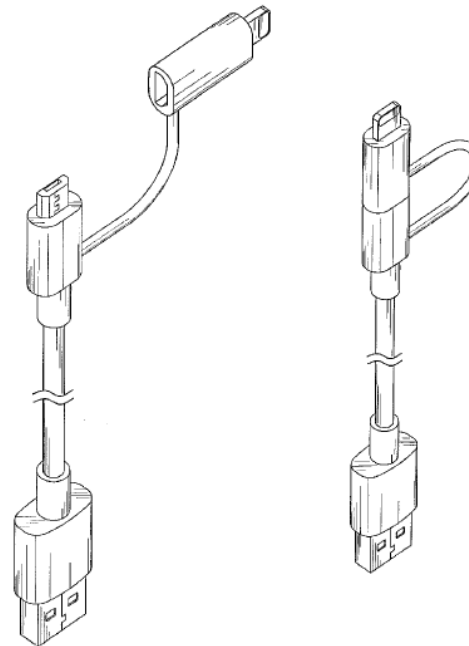


May 2012

April 2012

March 2014

Belkin's prior art products



D739,824 (Po-Hsun Lin)  
Plug assembly for transmission line



Belkin's accused product

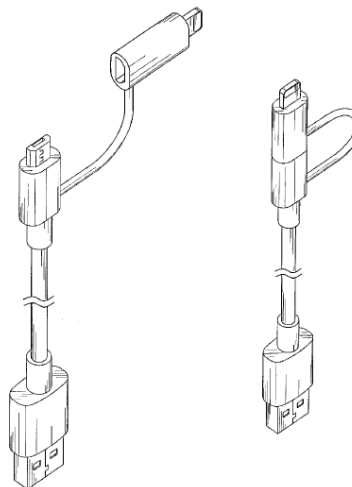
## PO-HSUN LIN V. BELKIN INT'L, INC. (C.D. CAL. MAY 12, 2017)

- **May 12, 2017:** Court grants summary judgment of non-infringement
  - Court states that the Claimed Design generates visual impression of a sleek, minimalist 2-in-1 cable with direct, permanent connection
  - Court states that, in contrast, Belkin's bulkier 2-in-1 cable has a separate tether component
  - (Court notes that if Claimed Design was broad enough to encompass a moveable tether, it would very likely be invalid for obviousness in light of Belkin's earlier products)



May 2012      April 2012      March 2014

Belkin's prior art products



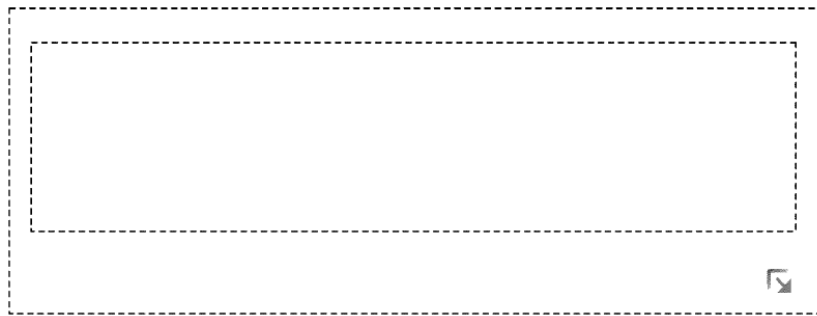
D739,824 (Po-Hsun Lin)



Belkin's accused product

## MICROSOFT CORP. V. COREL CORP. (N.D. CAL.)

- **Dec. 2015:** Microsoft sues Corel for design patent infringement



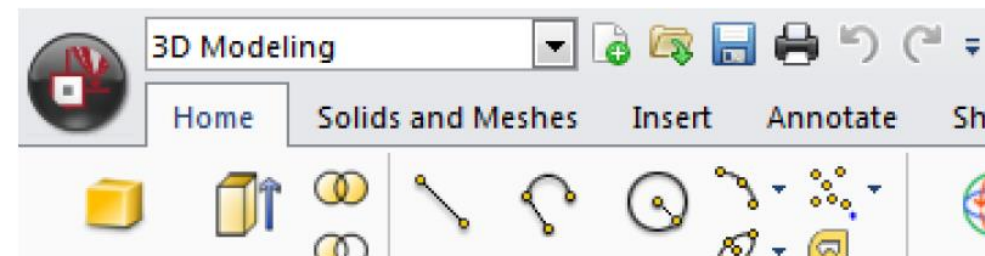
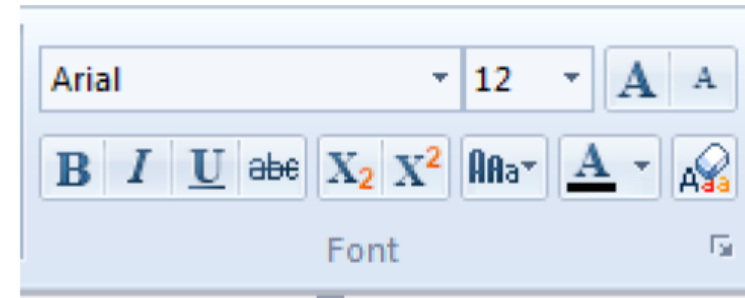
D550,237 (Microsoft)

User Interface for a Portion of a Display Screen



D564,532 (Microsoft)

User Interface for a Portion of a Display Screen



Corel's accused products

## MICROSOFT CORP. V. COREL CORP. (N.D. CAL.)

- **Dec. 2015:** Microsoft sues Corel for design patent infringement



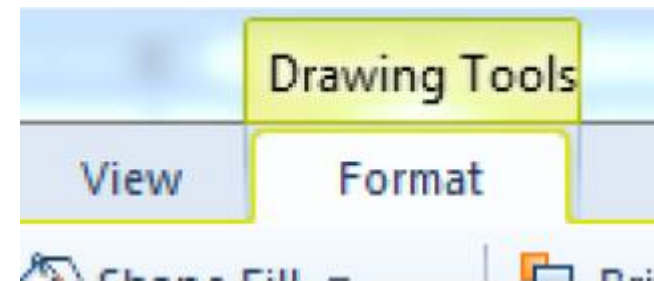
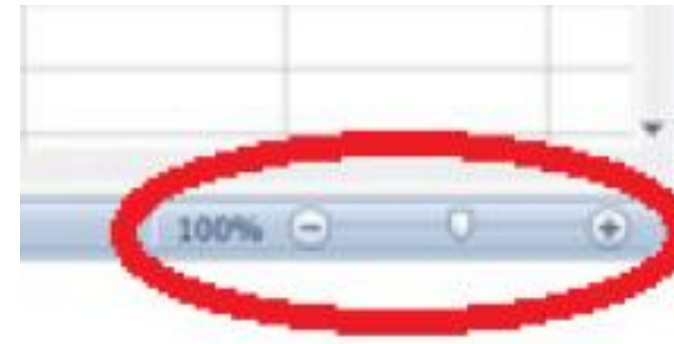
D554,140 (Microsoft)

User Interface for a Portion of a Display Screen



D570,865 (Microsoft)

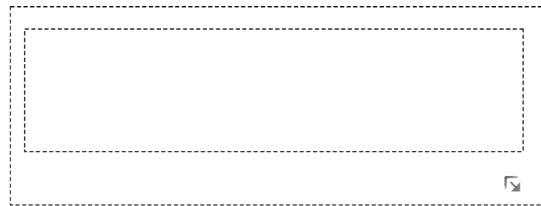
User Interface for a Portion of a Display Screen



Corel's accused products

# MICROSOFT CORP. V. COREL CORP. (N.D. CAL. FEB. 13, 2018)

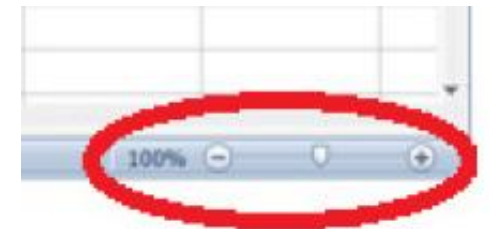
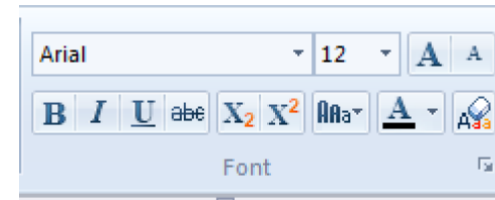
- **Feb. 13, 2018:** Jury verdict
  - Corel conceded validity and infringement of the '237, '140, '532, and '865 patents
  - Jury finds Corel had no pre-suit notice of design patents and awards \$278,000 in damages



D550,237  
(Microsoft)



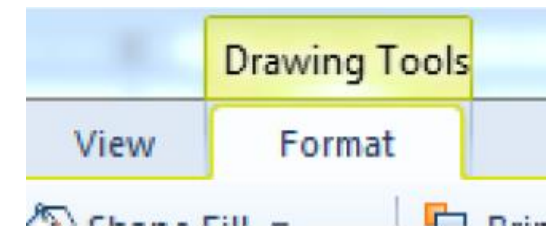
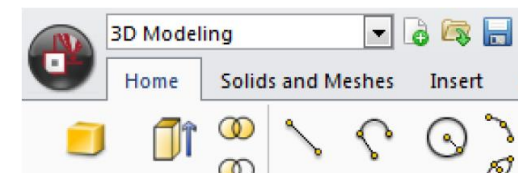
D554,140  
(Microsoft)



D564,532  
(Microsoft)



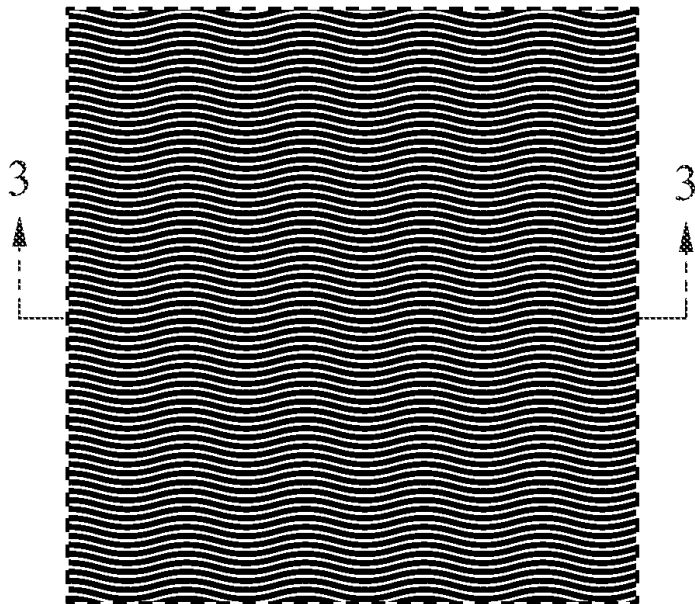
D570,865  
(Microsoft)



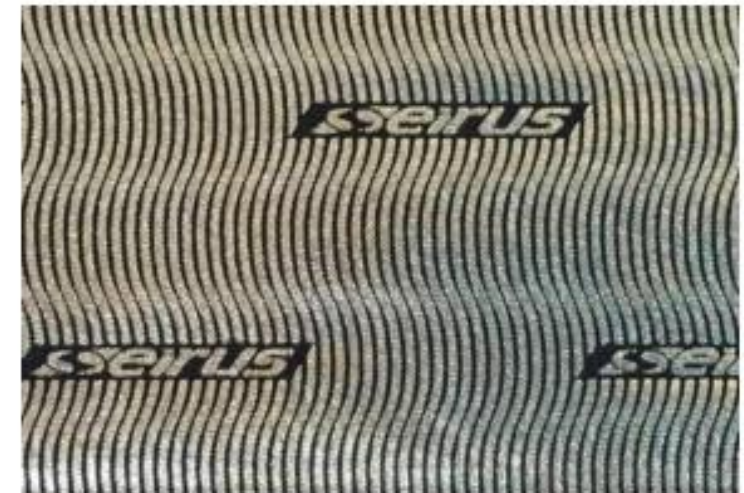
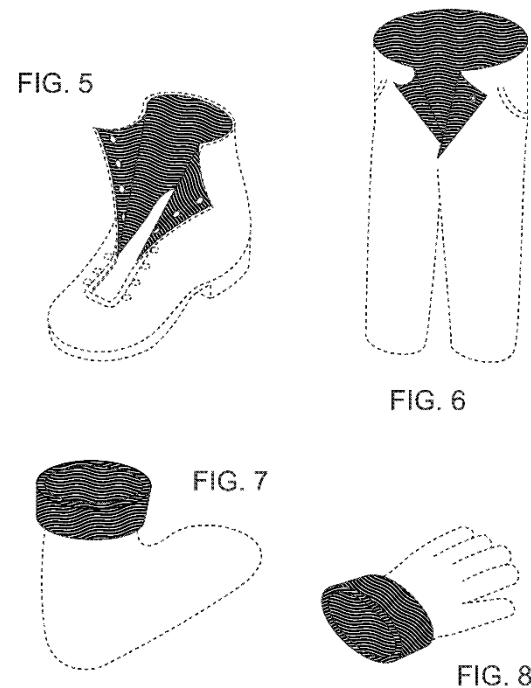
Corel's accused products

## COLUMBIA SPORTSWEAR N. AM. V. SEIRUS INNOVATIVE ACCESSORIES (S.D. CAL.)

- **Jan. 2015:** Columbia sues Seirus for infringing its heat reflective material design patent



D668,010 (Columbia)  
Heat reflective material



Seirus's accused HeatWave product

## COLUMBIA SPORTSWEAR N. AM. V. SEIRUS INNOVATIVE ACCESSORIES (S.D. CAL.)

- **Aug. 10, 2016:** Court grants summary judgment that Seirus infringed Columbia's design patent
- **Sept. 29, 2017:** Jury verdict on damages (the sole question before the jury regarding design patent)

**U.S. PATENT NO. D657,093 ("DESIGN PATENT")**

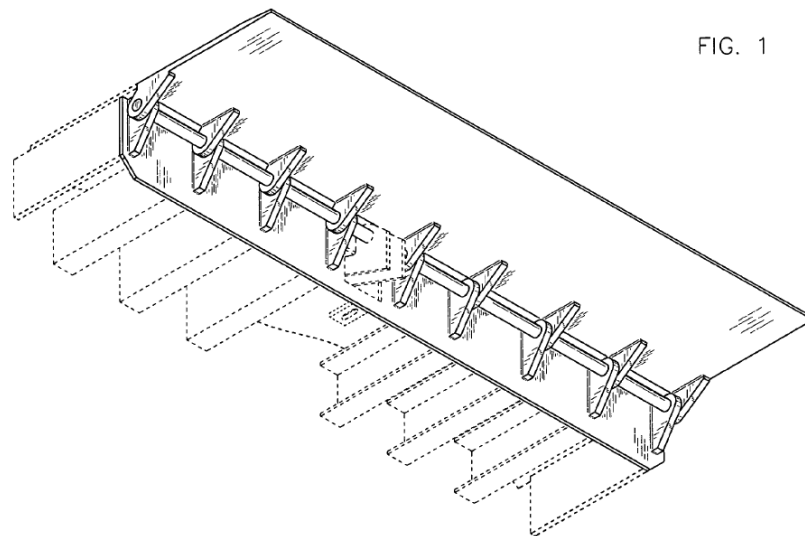
What is Seirus's total profit from sales of the relevant article of manufacture that Columbia is entitled to receive for Seirus's infringement of the Design Patent?

\$ 3,018,174

- **Nov. 16, 2017:** noting that the parties had a consent judgment that the design patent is valid, Court grants Columbia's motion for a Temporary Restraining Order (TRO) to enjoin Seirus from initiating patent reexamination proceedings with the PTO

## NORDOCK, INC. V. SYSTEMS, INC. (E.D. WIS.)

- **January 2011:** Nordock sues Systems alleging design patent infringement
- **March 2013:** Jury awards nearly \$47,000 as a reasonable royalty; both sides appeal
- **Sept. 2015:** Federal Circuit remands for new trial to determine damages under Section 289



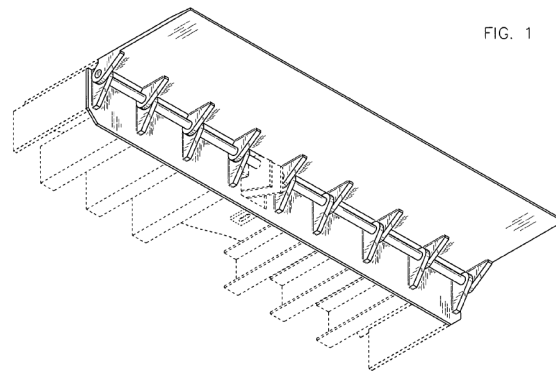
D579,754 (Nordock)  
Lip and Hinge Plate for a Dock Leveler



Systems' accused Dock Leveler

## NORDOCK, INC. V. SYSTEMS, INC. (E.D. WIS. NOV. 21, 2017)

- **December 2016:** Supreme Court grants petition for writ of certiorari; remands in light of *Samsung v. Apple*
- **March 2017:** Federal Circuit remands for new trial on damages
- **November 2017:** Eastern District of Wisconsin denies cross motions for summary judgment; jury trial on damages required
- **March 1, 2018:** Parties settle case



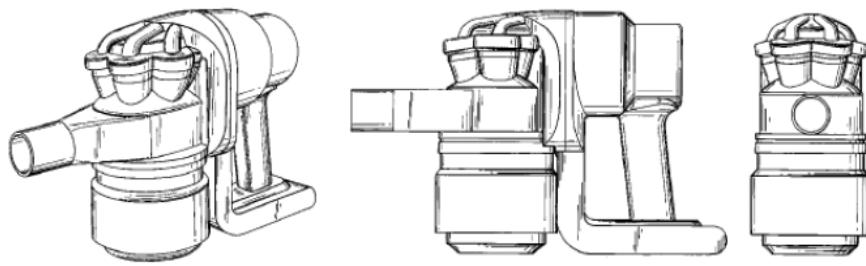
D579,754 (Nordock)  
Lip and Hinge Plate for a Dock Leveler



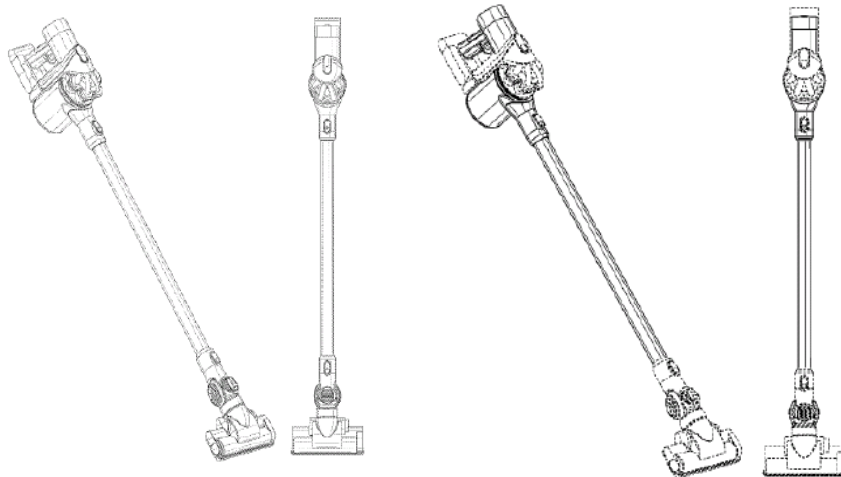
Systems' accused Dock Leveler

# DYSON, INC. V. SHARKNINJA, INC. (N.D. ILL.)

- **May 2014:** Dyson sued SharkNinja for infringement of three of its design patents



D577,163 (Dyson)



D668,010 (Dyson)

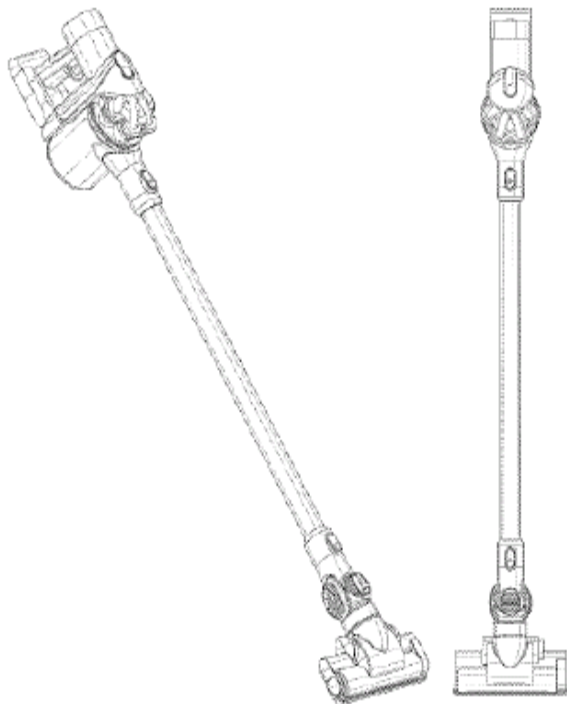
D668,823 (Dyson)



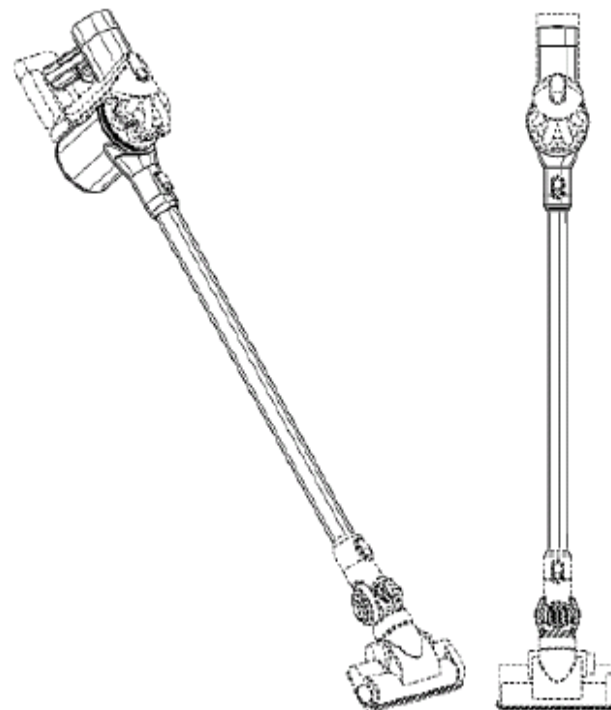
SharkNinja's accused products

## DYSON, INC. V. SHARKNINJA, INC. (N.D. ILL. MAR. 29, 2018)

- **March 29, 2018:** Summary judgment of non-infringement granted (other motions denied as moot)



D668,010 (Dyson)



D668,823 (Dyson)



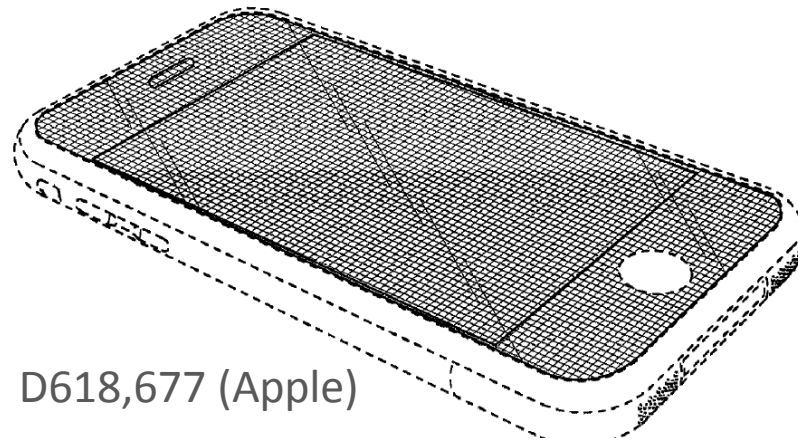
SharkNinja's accused products

# APPLE INC. V. SAMSUNG ELECS. CO. (N.D. CAL.)

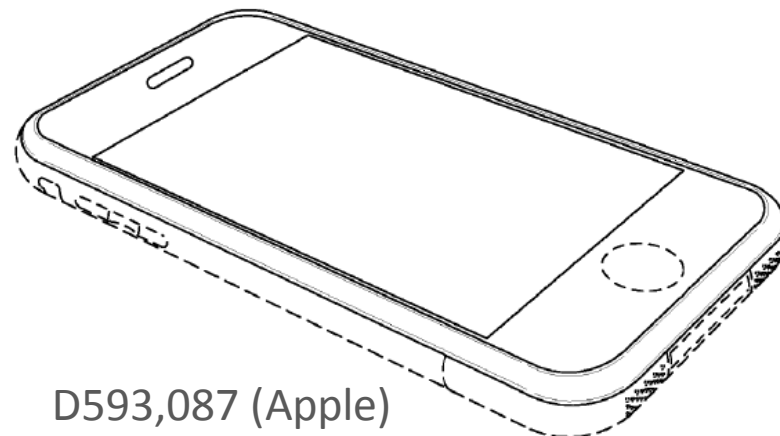
- **April 2011:** Apple sues Samsung for utility patent, design patent, and trade dress infringement



D604,305 (Apple)



D618,677 (Apple)



D593,087 (Apple)



Samsung Galaxy S

## APPLE INC. V. SAMSUNG ELECS. CO. (N.D. CAL.)

- **Between 2012 and early 2016:** After series of proceedings before Northern District of California and Federal Circuit (finding design and utility patents infringed but knocking out trade dress claims), Supreme Court grants certiorari in March 2016 solely to address question of design patent damages under Section 289
- **December 2016:** Supreme Court holds that determining Section 289 damages involves two steps:
  - 1. Identify the relevant “article of manufacture” (which may be a whole product or a component of that product)
  - 2. Calculate the infringer’s total profit made on the relevant article of manufacture
- Remanded to Federal Circuit; Federal Circuit remands to Northern District of California
  - To determine Section 289 damages using this two-step determination

## APPLE INC. V. SAMSUNG ELECS. CO. (N.D. CAL. JULY 28, 2017)

- **July 28, 2017:** On remand, Northern District of California defers decision on whether a new trial on damages is required until the parties provide further briefing on seven issues, which include:
  - (1) What is the test for identifying the article of manufacture for purposes of § 289?
  - (2) Is the identification of an article of manufacture a factual question, a legal question, or a mixed question of law and fact?
    - What issues should be decided by a jury?
    - What issues should be decided by the Court?
  - (3) Who bears the burden of proof to identify the relevant article of manufacture for purposes of § 289?
  - (4) Who bears the burden of proof to demonstrate total profits on an article of manufacture for purposes of § 289?

## APPLE INC. V. SAMSUNG ELECS. CO. (N.D. CAL.)

- **October 22, 2017:** Court decides new trial on damages is required; the test for determining the article of manufacture for Section 289 shall be the following four factors:
  - (1) The scope of the design claimed in the plaintiff's patent, including the drawing and written description;
  - (2) The relative prominence of the design within the product as a whole;
  - (3) Whether the design is conceptually distinct from the product as a whole; and
  - (4) The physical relationship between the patented design and the rest of the product, including whether the design pertains to a component that a user or seller can physically separate from the product as a whole, and whether the design is embodied in a component that is manufactured separately from the rest of the product, or if the component can be sold separately.
- **May 14, 2018:** Scheduled start date for five-day jury trial to determine damages (initially scheduled for June 1, but Court brought start date forward)

THANK YOU FOR  
LISTENING!

DUNSTAN H.  
BARNES, PH.D.

