

Articles

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Federal Circuit Reiterates Standards for Invalidating Design Patents

On September 11, 2013, the Court of Appeals for the Federal Circuit reiterated certain standards for determining invalidity of design patents. In *High Point Design LLC v. Buyer's Direct, Inc.*, Case No. 2012-1455, plaintiff Buyer's Direct, Inc. ("BDI") claimed that Defendant High Point Design ("HPD") infringed its design patent and its trade dress in a fuzzy slipper design.

The slipper protected by BDI's patent (U.S. Design Patent No. D598,183 (the "'183 patent'")) is embodied in its product called SNOOZIES®. A photo of the SNOOZIES® slippers and drawings from the '183 patent depicting the protected slippers are:

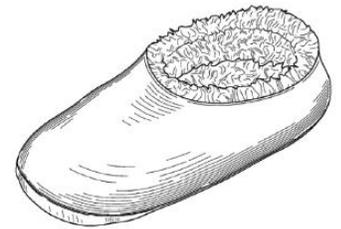


FIG. 1

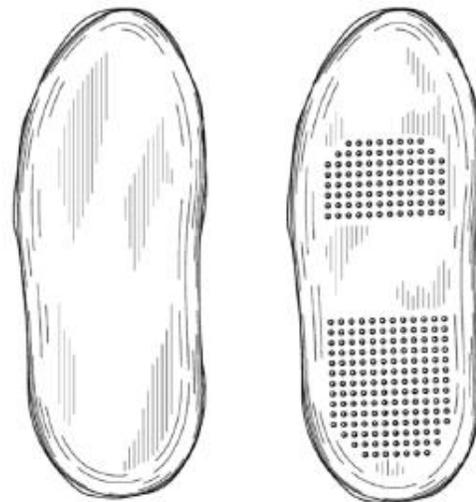


FIG. 8

FIG. 7

On a motion for summary judgment by Defendant, the U.S. District Court for the Southern District of New York held, among other things, that the '183 patent was invalid on grounds of obviousness and functionality. The Federal Circuit, in reviewing this determination, reversed and remanded, and in doing so, reiterated the appropriate standards for making such determinations.

Functionality Requires Assessment of Design As a Whole:

The Federal Circuit reiterated that design patents cover "any new, original and ornamental design for an article of manufacture . . ." Therefore, the Federal Circuit explained, "a design patent can be declared invalid if the claimed design is 'primarily functional' rather than 'primarily ornamental.'" In analyzing

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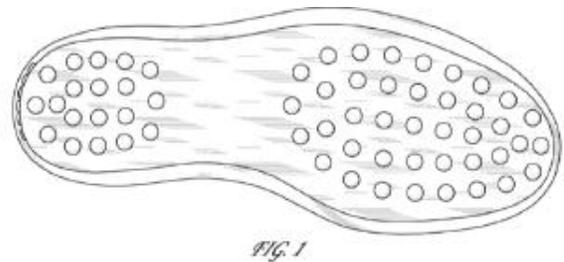
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whether a design patent is invalid because it is functional, the Federal Circuit admonished that the district court incorrectly looked at whether the design's *primary features were functional*, rather than looking at whether the design *as a whole was primarily functional*. Holding that the district court applied the incorrect standard, the Federal Circuit reversed and remanded.

Obviousness Analysis Critiqued:

The Federal Circuit explained that when evaluating claims of obviousness, "first, one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design." In doing that, "a court must both (1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates basically the same visual impression." Once that primary reference is found, "other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design." Further, the "ultimate inquiry in an obviousness analysis is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved."

The district court used as a primary reference slippers it held were "indistinguishable" from the '183 patent, along with secondary references with spots on the soles, and held that the '183 patent was obvious and thus invalid:



The Federal Circuit reversed and remanded, holding that the district court erred in several ways in its application of the standards for determining obviousness.

First, the Federal Circuit held that the district court incorrectly analyzed obviousness from the perspective of an ordinary *observer* rather than an ordinary *designer*. The Federal Circuit went on to say that the district court incorrectly disregarded expert testimony because though an expert opinion is "not necessary nor controlling," it "may be relevant to the factual aspects" and thus may be considered.

Second, the Federal Circuit held that the district court should have, but did not, make a detailed verbal description of the claimed design as part of the first step of the analysis in finding a primary reference. It further held that the district court failed to provide reasoning as to how the primary reference created the same visual impressions and as such directed on remand that the district court do a side-by-side of the patent and the primary reference.

Finally, the Federal Circuit held that the district court failed to consider secondary considerations, which if they are present, must be considered when determining obviousness. In this instance, the plaintiff put forth alleged evidence of copying and commercial success, which the Federal Circuit directed the district court to consider on remand.

By reiterating and clarifying these standards, this Federal Circuit decision helps to clarify design patent invalidity analysis. If you have any questions regarding design patents, please contact the authors or another attorney in the [Intellectual Property Division](#).