Design Patent Case Digest

Spencer v. Taco Bell Corp.

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ATTORNEYS AT LAW

Decision Date: October 2, 2013

Court: M.D. Florida

Patents: D643,474

Holding: Defendant's motion for summary judgment of patent invalidity and non-infringement GRANTED.

Opinion:

Plaintiffs Spencer and Mach 5 Leasing, Inc., sued Taco Bell Corporation and Taco Bell Foundation, Inc., for infringement of U.S. Design Patent D643,474.

The patent, entitled "Coin Drop Game," covers a hexagonal canister with ten pie-shaped pedals inside the canister. A vertical shaft runs through the center of the canister and is connected to the pedals. To play the game, the user drops a coin into the top of the canister and attempts to catch the falling coin on the pedals. The user manipulates the pedals by turning the shaft.

In 2006, Plaintiffs began selling a canister that practiced the design of '474. The '474 patent was not filed until February 18, 2011, but claims priority to U.S. Utility Patent Application 10/746,414. Application '414 has a filing date of December 24, 2003.

Defendants moved for summary judgment of patent invalidity on the basis of the "on-sale bar." Defendants argued that the '474 patent was not entitled to the earlier filing date and therefore the sale of the canister more than one year before the filing of the '474 patent application invalidated the patent. Alternatively, Defendants moved for summary judgment of non-infringement.

Priority and the On Sale Bar

In determining priority in design patent prosecution, "one looks to the drawings" of the parent to see if it discloses the subject matter of the child. In re Daniels, 144 F.3d 1452, 1456 (Fed. Cir. 1998). This is applied even if the parent is a utility application.

The court determined that the '474 patent is not entitled to the earlier filing date of the '414 application. The court found that drawings of the '414 application depict a different canister than the one claimed in the '474 patent because: 1) no identical drawing appears in both the '414 application and the '474 patent; 2) the drawings in '414 application and '474 patent differ

in six fatal ways; 3) the '474 patent has new features that are not found in the '414 application drawings; and 4) the '474 patent removes certain features from the '414 application.

Plaintiffs conceded that the depicted canisters were different but argued that the specification and claims of the '414 application should be considered in addition to the drawings.

In considering the Plaintiffs' argument, the court discussed In re Salmon, 705 F.2d 1579 (Fed. Cir. 1983). There, the Federal Circuit looked to the text of a parent application to determine if the parent provided support for a subsequent design application. Salmon, 705 F.2d at 1581. The Federal Circuit used the text, however, to describe the drawings, not to expand or contradict them. Id. Here, the Plaintiffs tried to expand the scope of the '414 application drawings with the text. The court found this to be impermissible and rejected the Plaintiffs' argument.

Because the '474 patent is not entitled to the earlier filing date, the court held that it is invalid due to the on-sale bar.

Non-Infringement

The court alternatively found no infringement. To show infringement of a design patent, the patentee must show that "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).

The court noted that both the '474 patent and the accused canister had many similarities with the prior art. It further noted seven distinctions between the '474 design patent and the accused canister. It determined that no reasonable jury could find that an ordinary observer, familiar with the prior art, would think that the accused canister was substantially the same as the patented design.

If you have any questions or would like additional information on this topic, please contact:

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