

Design Patent Case Digest

Robinson v. JoeyBra LLC



Decision Date: May 8, 2013 and June 3, 2014

Court: W.D. Virginia

Patent: [D448,541](#)

Holding: Plaintiff's motion for reconsideration of order denying preliminary injunction DENIED. Defendant's motion for fees DENIED.

Opinion:

Plaintiff Charles Robinson sued JoeyBra LLC in May 2012 for infringement of U.S. Design Patent No. D448,541 entitled "Brassiere." Robinson obtained a patent for his pocketed bra design in 2001. JoeyBra's product, the [JoeyBra](#), is also a pocketed bra intended to hold phones, IDs, keys, and other small items. This opinion addresses Robinson's motion for reconsideration following the court's denial of a motion for preliminary injunction on the basis that Robinson was not likely to succeed on the merits. Robinson claimed the court erred in its likelihood of success determination in two respects: (1) it relied on a 2010 patent of a pocketed bra design to determine that his patent was likely not novel, and thus invalid; and (2) it determined that the JoeyBra design was substantially different than the patented design.

To invalidate a patent based on novelty, a court must rely only on prior art references which were available before the patent's filing date. Thus, Robinson would have been correct if the court truly relied on a 2010 patent to find Robinson's 2001 patent to not be novel. The judge dismissed the first argument by stating that the court had not considered the 2010 patent in the context of the validity of Robinson's patent, but had merely mentioned the 2010 patent to indicate that Robinson's patent had "not been a bar on other [later] pocketed bra design patents." Therefore, not all pocketed bra designs would necessarily infringe on Robinson's patent.

The test for infringement of a patent design is whether "the product's design appears 'substantially the same' as the patented design to the 'ordinary observer.'" Robinson argued that the court erroneously "assum[ed] his patent drawings were to scale" when it decided that "'the size, orientation, and accessibility' of the pocket" of the JoeyBra were substantially different from that of the patent. The court noted that for design patents, unlike utility patents, the drawings must be to scale because the patent specifically claims the design "as shown and described." Robinson further argued that any difference between his design and the JoeyBra were only minor or insubstantial, thus invoking the doctrine of equivalents. The court responded that "the Federal Circuit has stated that '[t]he substantial similarity test [for design patent infringement] by its nature subsumes a doctrine of equivalents analysis.'" Thus, the court denied Robinson's motion for reconsideration of the order denying his preliminary injunction request.

After the court denied Robinson's motion for reconsideration, the court dismissed the case without prejudice for Robinson's failure to prosecute. Fourteen days after the dismissal, JoeyBra filed a Motion for Fees.

In exceptional cases, the court may award reasonable attorney fees to the prevailing party. A fee determination is a two part inquiry. First, the court must determine which party is the “prevailing party.” Second, the court must determine if the case is “exceptional.”

A party is the prevailing party if it has obtained a court order carrying sufficient “judicial imprimatur” to materially change the legal relationship of the parties. Some examples of judicially imprimatur orders include judgments on the merits, court-ordered consent decrees, and dismissals with prejudice. Orders that do not carry sufficient judicial imprimatur include private settlements not subject to consent decrees, a party’s voluntary change in conduct, orders remanding a case to a lower court, and dismissals for lack of personal jurisdiction. Further, the denial of a preliminary injunction is generally not sufficient to make a party a prevailing party because the denial is not based solely on the merits but on a likelihood and balancing of the harms. Thus, a party who has not received at least some relief on the merits is not a prevailing party.

JoeyBra cited three grounds under which they were a prevailing party. First, Robinson’s claim was dismissed for failure to prosecute. Second, JoeyBra was successful in defending against Robinson’s motion for a preliminary injunction. Third, JoeyBra was successful in their motion to dismiss claims against the individual defendants for lack of personal jurisdiction.

The court addressed each argument in turn. The court first determined that the dismissal for failure to prosecute was a dismissal without prejudice, and thus it was not an adjudication on the merits. The court then determined that non-merit based factors were used to deny the preliminary injunction. Thus, the denial of the preliminary injunction was not a decision on the merits, as it did not change the legal relationship of the parties. Finally, the court held that the dismissal for lack of personal jurisdiction was not a merits-based dismissal and did not preclude the parties from litigating the case in the proper forum.

Having found that neither party was the prevailing party, the court declined to analyze whether this case was “exceptional.” The court denied JoeyBra’s motion for fees.

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

Tracy-Gene G. Durkin, Director
tdurkin@skgf.com

David K.S. Cornwell, Director
davidc@skgf.com

Special thanks to Associate Stephen A. Merrill for his role as a contributing author of this digest.

© 2015 Sterne, Kessler, Goldstein & Fox P.L.L.C.



1100 New York Ave. NW, Washington, DC 20005

SKGF.COM