

Design Patent Case Digest

[Telebrands Corp v. Del Laboratories, Inc.](#)



Decision Date: September 8, 2011

Court: S.D. New York

Patents: [D596,802](#)

Holding: Coty's motion for summary judgment of invalidity denied

Opinion: Plaintiff Telebrands Corp sued Del Laboratories, Inc., Coty US, LLC, and Coty, Inc. for infringement of U.S. Design Patent D596,802, entitled Foot Micro File. Telebrands manufactures and sells the [Ped Egg](#), an oval-shaped foot file used to remove dry skin. Coty sells a three-piece pedicure set called the [Sally Hansen Pedi-Perfect](#), which includes an oval-shaped foot file. The court denied Coty's request for summary judgment of invalidity based on functionality.

In order to determine whether Coty was entitled to summary judgment, the Court first needed to determine whether there was a question of "material fact that the claimed design is functional." To do this, the court relied on the *Morton-Norwich* factors, which are "(1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product."

Coty asserted that the claimed design was functional and provided specific evidence relating to the *Morton-Norwich* factors. In particular, Coty drew attention to the fact that Telebrands pursued a utility patent for the Ped Egg that contained "unambiguous and repeated references to the functionality of the ovoid design." Coty further asserted that the Ped Egg packaging, which calls out the ergonomic and convenient shape of the file, "touts the utilitarian advantages of the design." In addition, an expert for Coty declared that a symmetrical ovoid shape is a comparatively simple form for injection molding, the method used to form the plastic housing of the Ped Egg and Pedi Perfect products.

In response, Telebrands argued that the claimed design is not functional and raised a number of triable issues of material fact. Specifically, Telebrands showed that multiple foot files with a variety of non-ovoid shapes are available on the market. Telebrands also provided evidence that Coty elected to produce an ovoid design that was more

expensive per unit than other 3-dimensional circular designs and that Coty opted not to include notches for gripping on the top of its file for purely aesthetic reasons. Because of the triable issues of fact raised by Telebrands, the Court was not able to conclude that the ovoid design of the Ped Egg was “essential to the use or purpose of the article” and therefore denied Coty’s motion for summary judgment.



Thumbs down:

This case highlights the important strategic considerations necessary when seeking both Utility and Design patent protection for the same product. While it is entirely possible to obtain valid protection through both, a coordinated strategy is necessary and may include having the same patent attorney or firm handle both applications or at the very least having coordination between the different firms.

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

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