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July 30, 2014

DESIGN PATENT DEVELOPMENTS AT THE FEDERAL CIRCUIT – 2014 TERM

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In addition to its heavy docket of utility patent cases, the Federal Circuit also rendered several design patent decisions of interest thus far in the 2014 term. Among them is in a recent non-precedential opinion in *Anderson v. Kimberly-Clark Corp.*, the Federal Circuit affirmed the application of the “ordinary observer” test at the pleading stage to find that five undergarment products did not infringe a design patent.

This case originated in the Western District of Washington, where a *pro se* plaintiff alleged that nine Kimberly-Clark products infringed its U.S. Patent No. D401,328 (the “D ‘328 patent”) directed to “an ornamental design for an absorbent disposable undergarment.” Kimberly-Clark moved for judgment on the pleadings under Fed. R. Civ. P. 12(c), asserting that it only manufactured five of the nine accused products, all under the Depend[®] and GoodNites[®] brands, and that none of those products infringed the D ‘328 patent. The district court took judicial notice that four accused products were not made by Kimberly-Clark and then compared the remaining five accused products to the D ‘328 patent. It concluded there was no infringement as a matter of law based on several factual distinctions and dismissed the case outright before discovery.

On appeal, the plaintiff argued that the district court erred in considering the product’s images because they were not attached to the complaint (notably, plaintiff did not contest that the designs were different). The Federal Circuit rejected this argument because: (1) plaintiff did not dispute the accuracy or authenticity of the images; and (2) the appearances of the patent illustrations and accused products were integral to the plaintiff’s claims. It also adopted the lower court’s non-infringement analysis. Relying on the seminal decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*, which holds that a design patent is infringed if “an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is *the same* as the patented design,” the Federal Circuit agreed with the district court that “plain differences” exist between the accused products and the design patent at issue and affirmed the district court’s dismissal.

With respect to invalidity, design patents did not fare well this term. Of note, in early April, the Federal Circuit affirmed summary judgment of obviousness for two design patents directed to football and baseball jerseys for dogs. *MRC Innovations, Inc. v. Hunter Mfg. LLP*.

The court first outlined that obviousness for design patents involves a two-step inquiry: (1) does one reference basically have the same design characteristics or visual impressions as the claimed design; and (2) is there a secondary reference that is so related to the main reference such that there would be a suggestion to apply certain features from one reference to the other?

Although the district court did not expressly describe the claimed design (as required by prior precedent), it did so implicitly by outlining several design characteristics. The primary reference was also suitable because it and the claimed design have the same fabric, shape, and stitching – despite slight differences. In an audible, the Federal Circuit noted that “in practice” design infringement has focused on the “overall visual appearance” (rather than on specific features and even though design patents are supposed to be limited to the images in the drawings), meaning infringement is permissible despite differences in features.

The Federal Circuit turned to the secondary references finding they were sufficient given their similarity to the primary reference. And even though no reference disclosed the additional stitching in the claimed design, the court noted this was a *de minimis* change, which would be within the skill of an ordinary designer of the art. The secondary considerations offered by the patentee were insufficient as it presented no evidence that the alleged commercial success and copying were related to the claimed design. Finally, the court undertook a similar analysis to find the other design patent obvious.

In one other design patent infringement case this term, on January 8, 2014, the Federal Circuit in

Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC reversed the district court's summary judgment decision of non-infringement. In doing so, the court confirmed the viability of prosecution history estoppel to design patents. **We previously reported on that decision [here](#).**

Design patents can be a significant part of a company's intellectual property portfolio, and one to which challengers must pay heed. The Federal Circuit's decisions thus far this term confirm their importance, but also present lessons for those seeking design patent protection.