

Design Patent Case Digest

[Kedem, LLC v. Team International Group of America, Inc.](#)



Decision Date: January 30, 2015

Court: Southern District of Florida

Patents: [D686,869](#); [D694,057](#)

Holding: Defendant's motion for summary judgment DENIED

Opinion:

Kedem, LLC owns U.S. Design Patent Nos. D686,869 and D694,057, each entitled, "Assembly for Cooking Elongated Food Products." The design patents cover a vertical cooking device that prepares food, such as eggs, in an elongated, thin, cylindrical shape. Because Kedem could not afford to produce and market the vertical cooking device, it licensed the design patents to Team International Group of America, Inc., doing business as Kalorik ("TIGA"). TIGA now sells a vertical cooking device under the trademark [ROLLIE®](#) that is an embodiment of the design patents.

Due to various alleged breaches of the contract, Kedem sued TIGA for design patent infringement, trademark infringement, and other claims. TIGA moved for summary judgment declaring the design patents invalid for anticipation and denying Kedem's trademark claims.

TIGA asserted that the design patents were invalid as anticipated by U.S. Patent Pub. No. [2011/0256302](#) ("the '302 publication"), also owned by Kedem. To succeed on its motion for summary judgment, TIGA needed to show by clear and convincing evidence that an ordinary observer would find the design in the '302 publication to be substantially similar to the patented designs, such that a purchaser would be induced to buy one, thinking it was the other. In particular, TIGA relied on Figures 45, 45A, 51, 52, and 53 of the '302 publication as being "virtually identical or substantially similar" to the patented designs.

The court held that TIGA failed to meet its burden because "[e]ven a cursory review of the drawings shows differences." Specifically, the court noted that the patented designs had two circles of similar size near the bottom, while the '302 publication showed one large circle with a smaller circle on each side. In addition, the texture of the middle portions of the designs differed, as well as the designs of the upper rim. Accordingly, there was a genuine issue of material fact as to whether the designs are substantially similar.

TIGA also asserted that Kedem's trademark claims must fail because the claims were premised on Kedem being the owner of the ROLLIE® trademark, when in fact TIGA owns the ROLLIE® trademark. While TIGA filed the trademark application in its own name, a clause of the licensing agreement between Kedem and TIGA set forth that Kedem would own rights to additional trademarks created by either party for the vertical cooking device. TIGA argued that this clause was invalid as an assignment clause. The court disagreed with TIGA because the language of the agreement did not support TIGA's position and because the record did not support TIGA's

assumption that it owned the ROLLIE® trademark. Trademark ownership is based on usage, but the record lacked any evidence that TIGA used the ROLLIE® trademark. As a result, there remained a genuine issue of material fact as to whether TIGA or Kedem owned the ROLLIE® trademark.

Accordingly, the court denied TIGA's motion for summary judgment as to both the design patent and trademark infringement claims.

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

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1100 New York Ave. NW, Washington, DC 20005

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