IP Alert | Design Patent Infringement – Federal Circuit Clarifies the Definition of Comparison Prior Art and Continues to Allow Infringer's Logos to Play a Role

By Sean Jungels

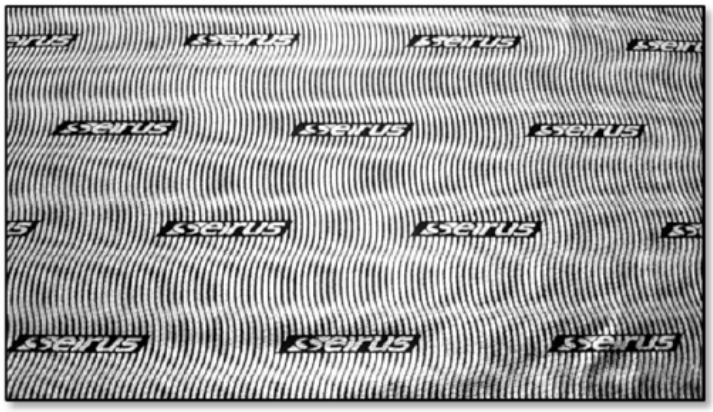
The Federal Circuit's much-anticipated opinion in Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc., vacated the jury verdict that Seirus did not infringe Columbia's design patent for a "Heat Reflective Material," and remanded to the district court. Notably, the Federal Circuit's decision here marks another signal that a design patent's title, i.e., the article of manufacture identified in the claim, is critical both for validity and infringement purposes. The decision also clarifies that, while not necessarily determinative in an infringement analysis, the presence of an infringer's logo cannot be ignored and may, in certain circumstances, be enough to establish non-infringement as a matter of law.

Quick Case Background

In this case, Columbia asserted its U.S. Design Patent No. D657,093 ("the D'093 patent") against Seirus's products made with its HeatWave material:



Columbia’s D’093 patent



Serius’s HeatWave Material

The district court originally did not consider Serius’s logo and granted summary judgment of infringement, but on the first appeal (Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc., 942 F.3d 1119 (Fed. Cir. 2019) hereinafter “Columbia I”), the Federal Circuit vacated and remanded because it found that Serius’s logo should be considered in the design patent infringement analysis. On remand, a jury found no infringement in view of certain comparison prior art that Seirus presented. Columbia then filed a second appeal (Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc., No. 2021-2299 (Fed. Cir. Sept. 15, 2023) hereinafter “Columbia II”) that focused on the jury instructions regarding what constitutes comparison prior art and the relevance of Seirus’s logo to determining infringement.

Proper Scope of Comparison Prior Art

The purpose of comparison prior art in a design patent infringement analysis is to assist when the claimed and accused designs are not plainly dissimilar. Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008). In such cases, the "ordinary observer" test (the applicable test for infringement in a design patent case) should be applied in view of prior-art designs so the ordinary observer can be given a frame of reference in answering the question of whether one thing is like another. Id. at 676–77. For example, "[c]omparison prior art can help highlight distinctions [and similarities] between the claimed and accused designs." Id. at 676. This makes the scope of what constitutes comparison prior art important in the infringement analysis.

Remarkably, the proper scope of comparison prior art that may be used in an infringement analysis is an issue of first impression for the Federal Circuit. In reaching its decision, the Federal Circuit referenced some of its recent opinions that tied aspects of design law to the article of manufacture identified in the claim. It first noted that in Surgisil, it held that "for a prior-art design to anticipate, it must be applied to the article of manufacture identified in the claim. Surgisil, 14 F.4th [1380,] 1382 (claim scope limited to a lip implant; designs applied to other articles—there, an art tool—could not anticipate)." Columbia II at 21. The Federal Circuit also noted that in Curver, it held that "for an accused design to infringe, it must be applied to the article of manufacture identified in the claim. See Curver Luxembourg, SARL v. Home Expressions Inc., 938 F.3d 1334, 1336, 1340, 1343 (Fed. Cir. 2019) (claim scope limited to a chair; design applied to a basket could not infringe)." Id. Therefore, similarly, and consistently, here, the Federal Circuit held that "to qualify as comparison prior art, the prior-art design must be applied to the article of manufacture identified in the claim." Id.

The Federal Circuit maintained that this definition of comparison prior art best supports the purpose to help inform an ordinary observer's comparison between the claimed and accused designs, reasoning that those designs necessarily must be applied to the same article of manufacture. Id. The Federal Circuit also noted that requiring prior-art designs to be applied to the article of manufacture identified in the claim conforms with many cases in which courts considered such comparison prior art. Id. at 21-22. Finally, the Federal Circuit stated that "using the same scope for anticipatory prior art and comparison prior art makes good practical sense[,] … is already in the system[,] … is also easy to articulate and provides clear boundaries." Id. at 23. While this decision is consistent with Curver and Surgisil, it continues the Federal Circuit's trend of relying on the design patent's title in numerous design patent analyses and moving even farther away from the design patent protecting the design itself.

Since the district court unavoidably did not instruct the jury on the Federal Circuit's new correct standard for determining whether an admitted prior art reference qualified as comparison prior art, the Federal Circuit held that the failure to provide it was error and prejudicial. Therefore, the Federal Circuit vacated the non-infringement judgment and remanded for further proceedings.

Infringer's Logo

Throughout this case, Seirus has taken the position that its repeated logo over its HeatWave material is prominent and should result in a finding of no infringement. Initially, the district court disagreed with Seirus and held that its logo should not be considered based on L.A. Gear, Inc. v. Thom McAn Shoe Co., in which the Federal Circuit held that labelling of a shoe with a mark did not avoid design patent infringement. 988 F.2d 1117 (Fed. Cir. 1993). Without an en banc panel, the Federal Circuit in Columbia I reversed the established reasoning of L.A. Gear and held that a fact finder cannot "ignore elements of the accused design entirely, simply because those elements included the name of the defendant." Columbia I at 1131. Instead, a jury should "consider[] an ornamental logo, its placement, and its appearance as one among other potential differences between a patented design and an accused one." Id. Based on this, the Federal Circuit vacated its summary judgment of noninfringement and remanded.

On remand, the district court instructed the jury on the ordinary observer test for design patent infringement in combination with an instruction that, "[y]ou do not need, however, to find that any purchasers were actually deceived or confused by the appearance of the accused products." Columbia II at 11. In view of these instructions, the jury found no infringement. Columbia appealed that it was error to not further clarify to the jury that "[c]onfusion as to the source or provider of the goods accused of infringing is irrelevant to determining whether a patent is infringed," and that "[l]abelling a product with source identification or branding does not avoid infringement." Id. at 10.

Even though the Federal Circuit noted that "[i]n design patent infringement cases involving logos, we appreciate the potential for a jury to be led astray and mistakenly conflate the significance of a logo's source-identifying function with whatever impact it might have on a comparison of the designs," the Federal Circuit affirmed that the jury instructions given by the district court were legally correct. Id. at 32. The Federal Circuit clarified again that logos are relevant to the infringement analysis:

"… just because a logo's potential to eliminate confusion as to source is irrelevant to design-patent infringement, its potential to render an accused design dissimilar to the patented one – maybe even enough to establish non-infringement as a matter of law– should not be discounted." Id. at 30.

In the end, the Federal Circuit held that district courts are in the best position to decide whether and when to provide clarification on this issue in the course of conducting a trial. The decision on this logo issue further blurs the design patent infringement test with a trademark-like test. It also weakens design patent rights because it allows third parties to misappropriate a design, apply its own logo, and make non-infringement arguments.

Please click here to read the opinion.

Posted: September 20, 2023