

Litigating Design Patents: If Something's Amiss, Move to Dismiss...

Richard S. Stockton

Principal Shareholder
Banner & Witcoff, Ltd.
rstockton@bannerwitcoff.com
312-463-5414

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Design Day 2017: *If Something's Amiss...*



Summary

- Introduction
- Dismissal/“Legal” Dissimilarity Overview
- Empirical Case Examples
- Summary/Conclusion

Note: Slides available online

Will 289's "Total Profit" Inspire Trolls?

"In the end, this will likely bring forward efforts to repeal § 289. Hopefully, a judicial framework will be developed that strikes the right balance and further secures § 289 as a distinguishing feature of U.S. design patent law."

-Gary Griswold, Consultant

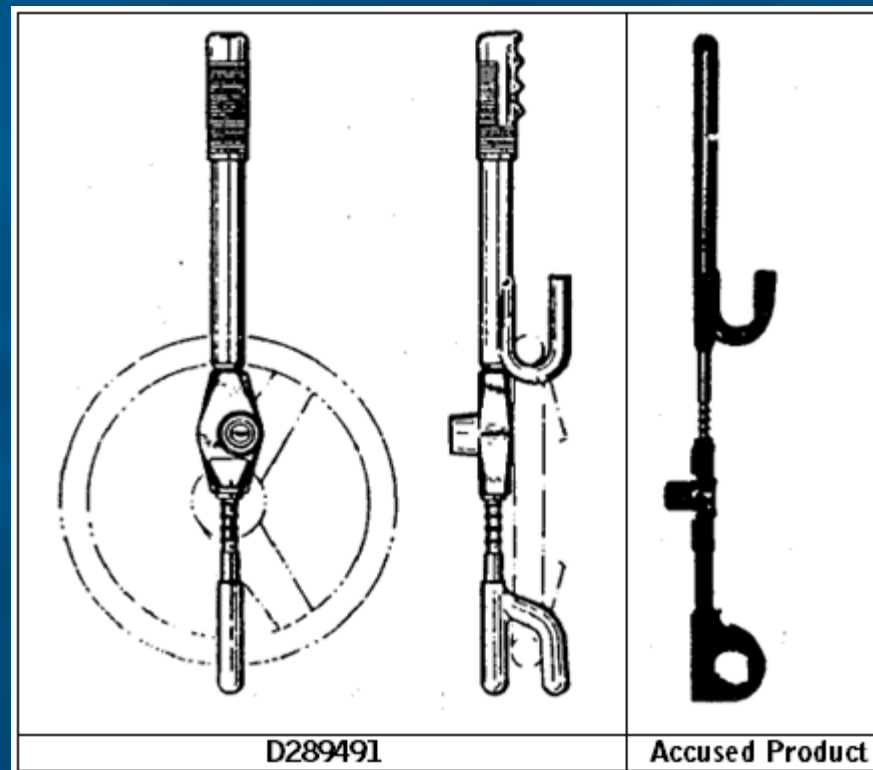
Assuming *Arguendo* There's a Problem...

- 12(b)(6) “failure to state a claim” and 12(c) “judgment on the pleadings” motions based on visual dissimilarity already provide a means to counter overzealous design patent assertions
- Not applicable to identical copying

“Legal” Dissimilarity Has Long Existed...

- *E.g.*, at Summary Judgment

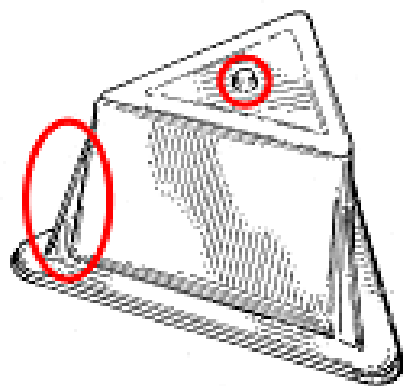
Winner Int'l Corp. v. Wolo Mfg. Corp., 905 F.2d 375 (Fed. Cir. 1990)



“Legal” Dissimilarity Has Long Existed...

- Judgment as a Matter of Law too...

Elmer v. ICC Fabricating, Inc., 67 F.3d 1571 (Fed. Cir. 1995) (reversing denial)



**Fig. 1 from the '620 Patent
(pertinent parts circled)**



Alleged Infringement



Exemplary Prior Art

...But Nascently at the Pleadings Stage

Form 18. Complaint for Patent Infringement.

(Caption – See Form 1.)

1. (Statement of Jurisdiction — See Form 7.)
2. On date, United States Letters Patent No. _____ were issued to the plaintiff for an invention in an electric motor. The plaintiff owned the patent throughout the period of the defendant's infringing acts and still owns the patent.
3. The defendant has infringed and is still infringing the Letters Patent by making, selling, and using electric motors that embody the patented invention, and the defendant will continue to do so unless enjoined by this court.
4. The plaintiff has complied with the statutory requirement of placing a notice of the Letters Patent on all electric motors it manufactures and sells and has given the defendant written notice of the infringement.

Therefore, the plaintiff demands:

- (a) a preliminary and final injunction against the continuing infringement;
- (b) an accounting for damages; and
- (c) interest and costs.

Challenging Case Law (Pleadings Stage)

- A complaint may be dismissed under Rule 12(b)(6) if “it appears beyond doubt that plaintiff can prove no set of facts in support of his claim which would entitle him to relief.”
Hughes v. Rowe, 449 U.S. 5, 10 (1980).
- Rule 12(b)(6) does not permit “dismissal based on a judge’s disbelief of a complaint’s factual allegations.”
Nietzke v. Williams, 490 U.S. 319, 326-27 (1989).
- “The issue is not whether a plaintiff will ultimately prevail but whether the claimant is entitled to offer evidence to support the claims.”
Scheur v. Rhodes, 416 U.S. 232, 236 (1974).

Sea Change: *Twombly's* Plausibility...

- “We do not require heightened fact pleading of specifics, but only enough facts to state a claim to relief that is plausible on its face. Because the plaintiffs here have not nudged their claims across the line from conceivable to plausible, their complaint must be dismissed.”

Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570 (2007)

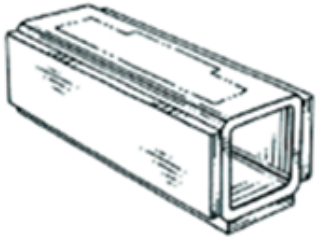



...and *Iqbal's* “Experience and Common Sense”

- “[D]etermining whether a complaint states a plausible claim is context-specific, requiring the reviewing court to draw on its experience and common sense.”

Ashcroft v. Iqbal, 556 U.S. 662, 663-64 (2009)

Meanwhile, the Design Gods are Restless...

- “In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear

			
'389 Patent	Accused Product	Falley Buffer Block	Nailco Patent

will benefit from a comparison of the claimed and accused designs with the prior art”

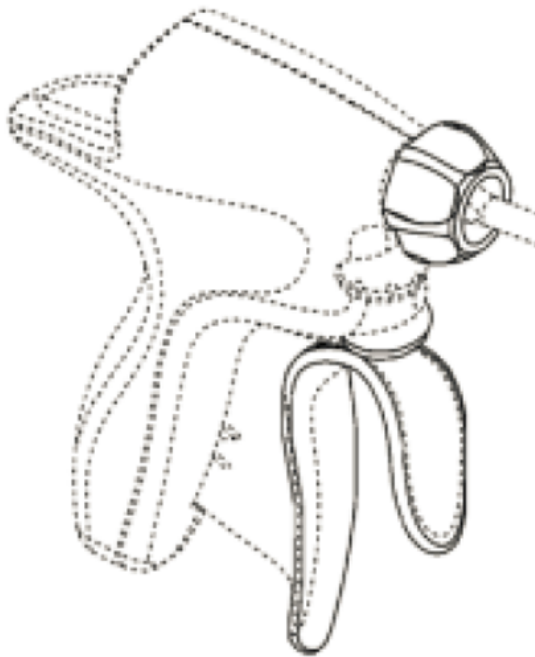
Egyptian Goddess Inc. v. Swisa Inc., 543 F.3d 665, 678 (Fed. Cir. 2008) (*en banc*)
(affirming summary judgment of noninfringement)

But Do You Always Consider Prior Art?

Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312 (Fed. Cir. 2015) (affirming summary judgment of noninfringement)



**Exemplary Ethicon Product
(ENSEAL G2 Tissue Sealer)**



**Exemplary Patent-in-Suit
(D661804 Fig. 1)**



Covidien's Accused Product

Ethicon's Part-Time “Extraordinary” Observer

- “Where the claimed and accused designs are ‘sufficiently distinct’ and ‘plainly dissimilar,’ the patentee fails to meet its burden of proving infringement as a matter of law.” *Id. at 1335 (emphasis added)*.
- Otherwise, “the inquiry may benefit from comparing the claimed and accused designs with prior art to identify differences that are not noticeable in the abstract but would be significant to the hypothetical ordinary observer familiar with the prior art.” *Id.*
- Thus, not erroneous to not consider a “frame of reference provided by the prior art” *Id. at 1337*.

Utility Analogy and Death of Form 18

- Utility patentee “has no plausible basis for alleging that the plain and ordinary meaning of ‘TV Channel’ (or ‘TV Channel’ properly construed) covers URLs”

Bartonfalls LLC v. Turner Broadcasting Systems, Inc. et al., 2:16-cv-1127 at *3 (E.D. Tex. Mar. 15, 2017) (citing *Iqbal*’s “experience and common sense”)

- Post-Rule 84 Abrogation:
70% ➔ 56% 12(b)(6)/(e) denial rate

Anthony Volpe and Joseph Matthew, “Patent infringement Complaints After the Change in Rules,” *The Legal Intelligencer* (Nov. 1, 2016)

If Something's Amiss...

EMPIRICAL EXAMPLES

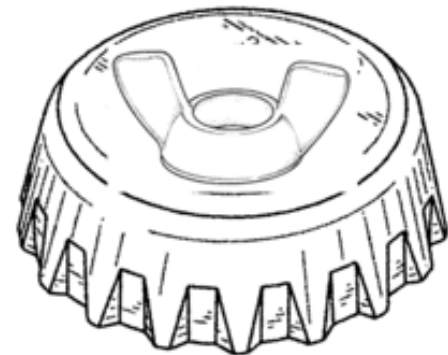
Kellman v. Coca-Cola

No. 3-cv-71542 (E.D. Mich. 2003)

- 12(b)(6) motion filed June 2003...



D387,541 (Fig. 1)



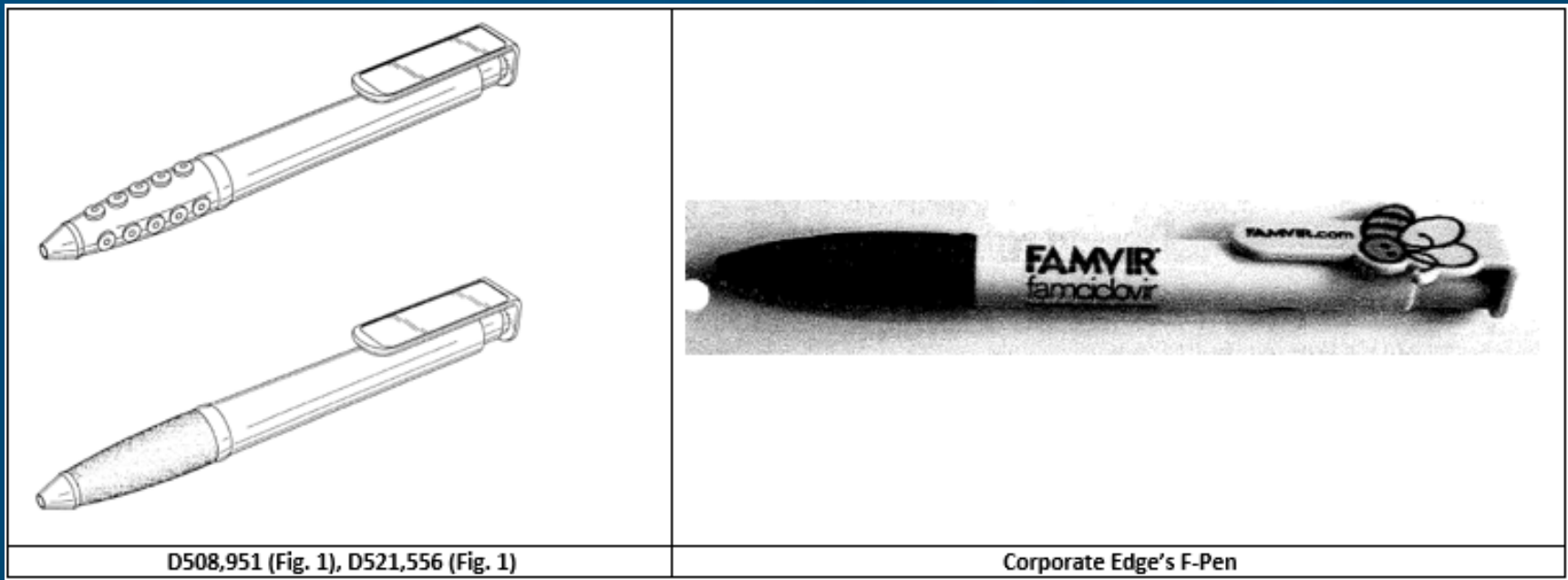
SIMULATED IMAGE of Red Wing's t-shirt and Coca-Cola bottle cap

- ...**GRANTED** Aug. 2003 280 F. Supp. 2d 670

Cotapaxi v. Corporate Edge

No. 6-cv-5183 (D.N.J. 2007)

- 12(b)(6) motion filed Dec. 2006...

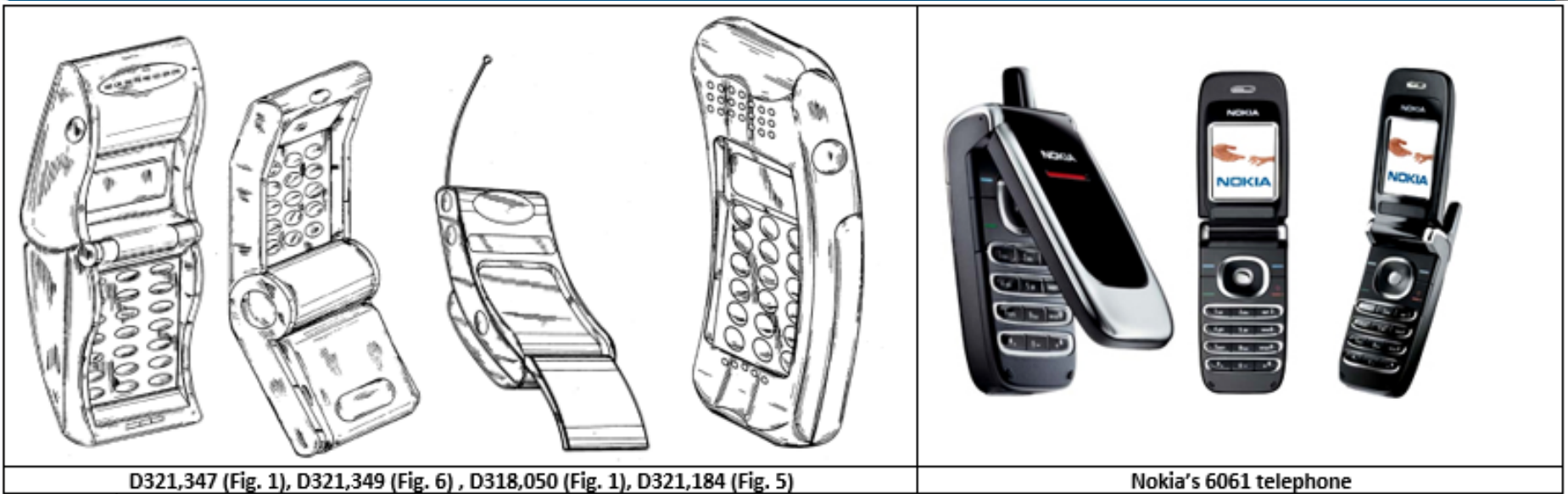


- ...**GRANTED** Oct. 2007 2007 WL 2908265

Colida v. Nokia

No. 7-cv-8056 (S.D.N.Y. 2008)

- 12(b)(6) motion filed Feb. 2008...

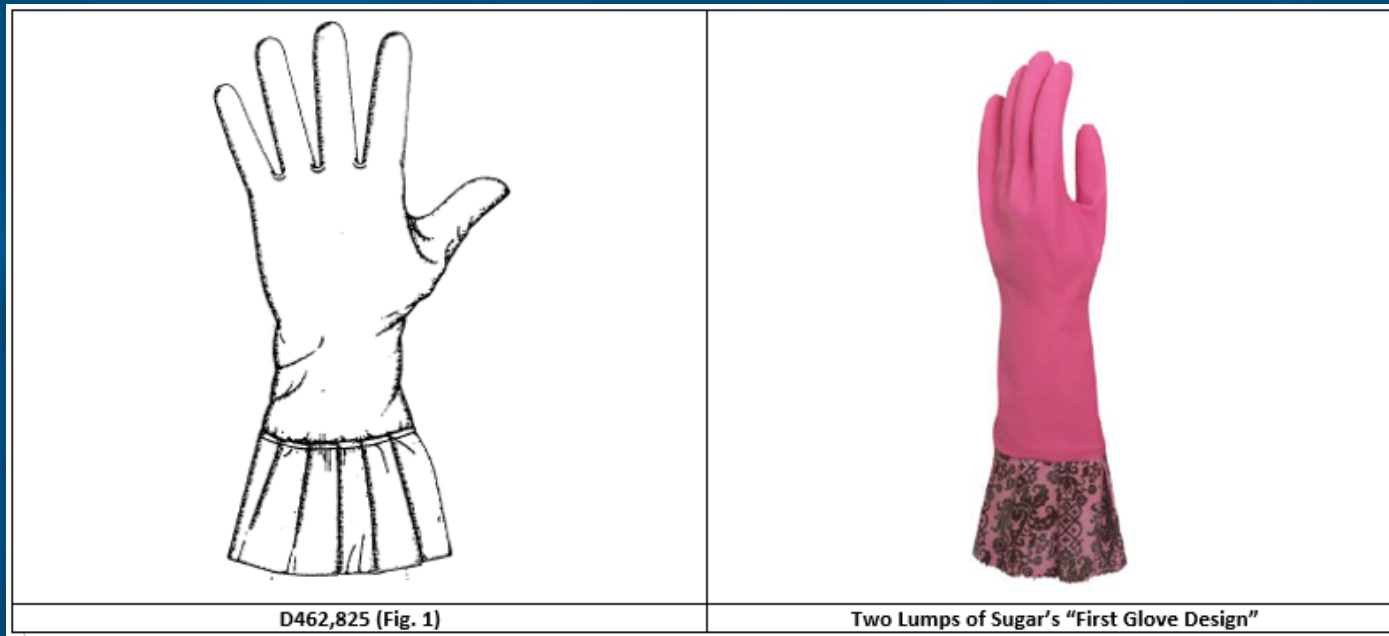


- ...**GRANTED** May 2008 2008 WL 451788
- ...**AFFIRMED (F.C.)** Oct. 2009 347 Fed. Appx. 568

Grandway Honduras v. 2 Lumps of Sugar

No.9-cv-6049 (C.D. Cal. 2010)

- 12 (c) motion filed July 2010...



- ...**DENIED** Aug. 2010

Beaumont Products v. Clean Control

No. 9-cv-3325 (N.D. Ga. 2010)

- 12(b)(6) motion filed March 2010...



D491,257 (Figs. 1 & 3)



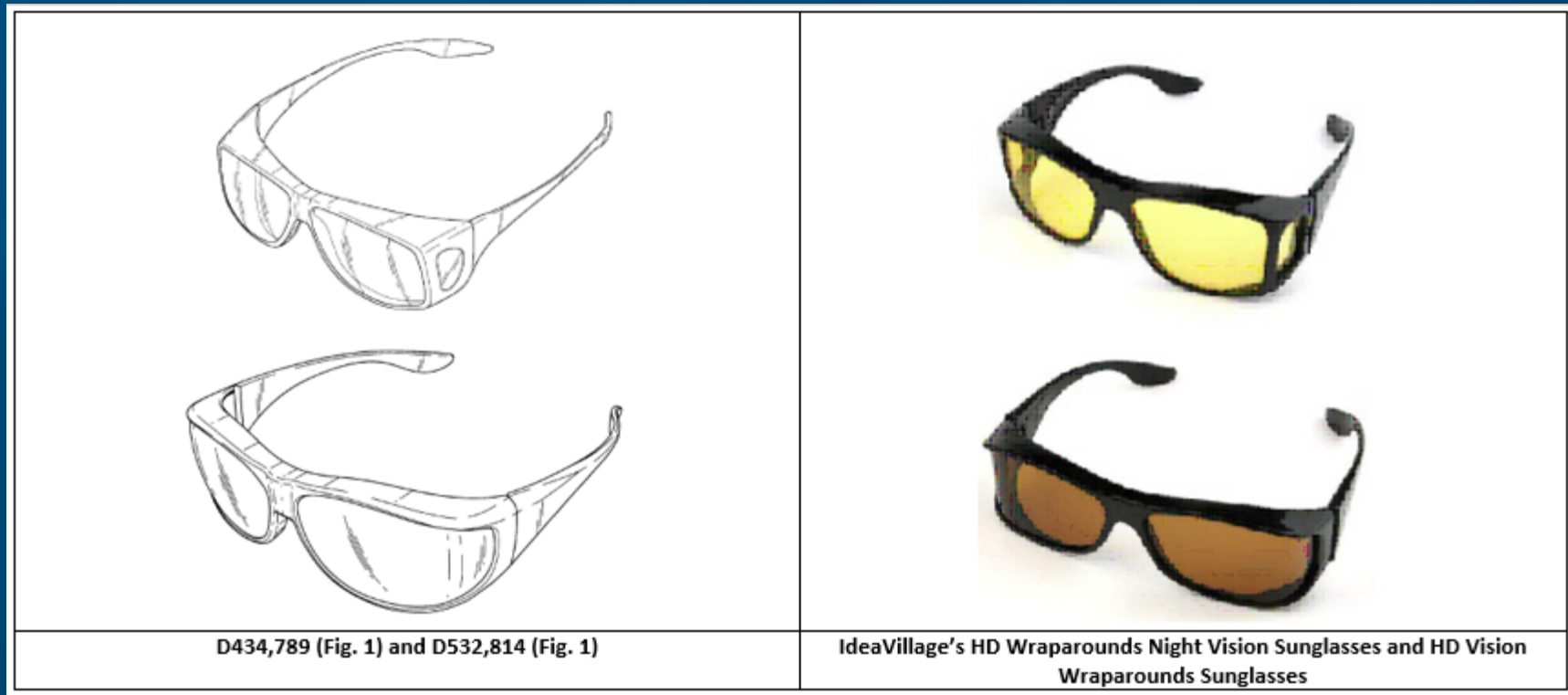
Clean Control's "OdoBan"

- ...**DENIED** Oct. 2010

Dioptics v. IdeaVillage

No. 8-cv-03538 (N.D. Cal. 2010)

- 12(b)(6) motion filed Nov. 2009...

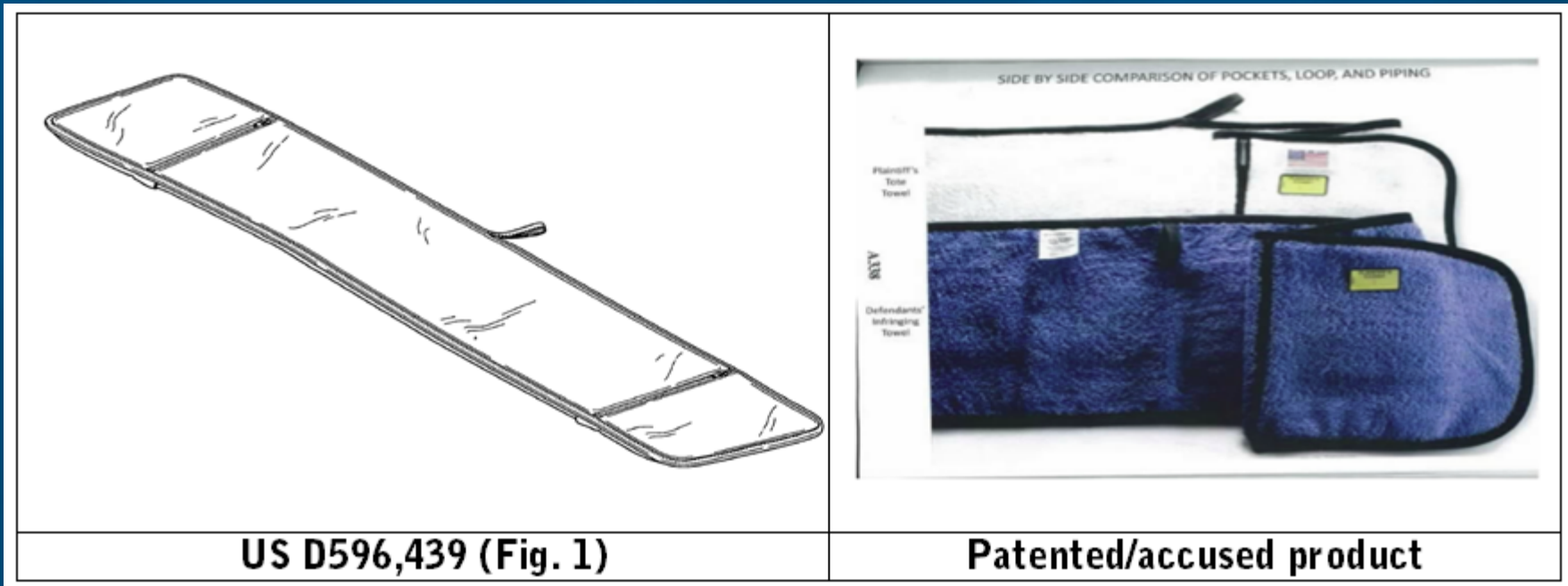


- ...**DENIED** Oct. 2010 2010 WL 4393876

Hall v. Bed Bath & Beyond

No. 10-cv-04391 (S.D.N.Y. 2010)/(Fed. Cir. 2013)

- 12(b)(6) motion filed August 2010...

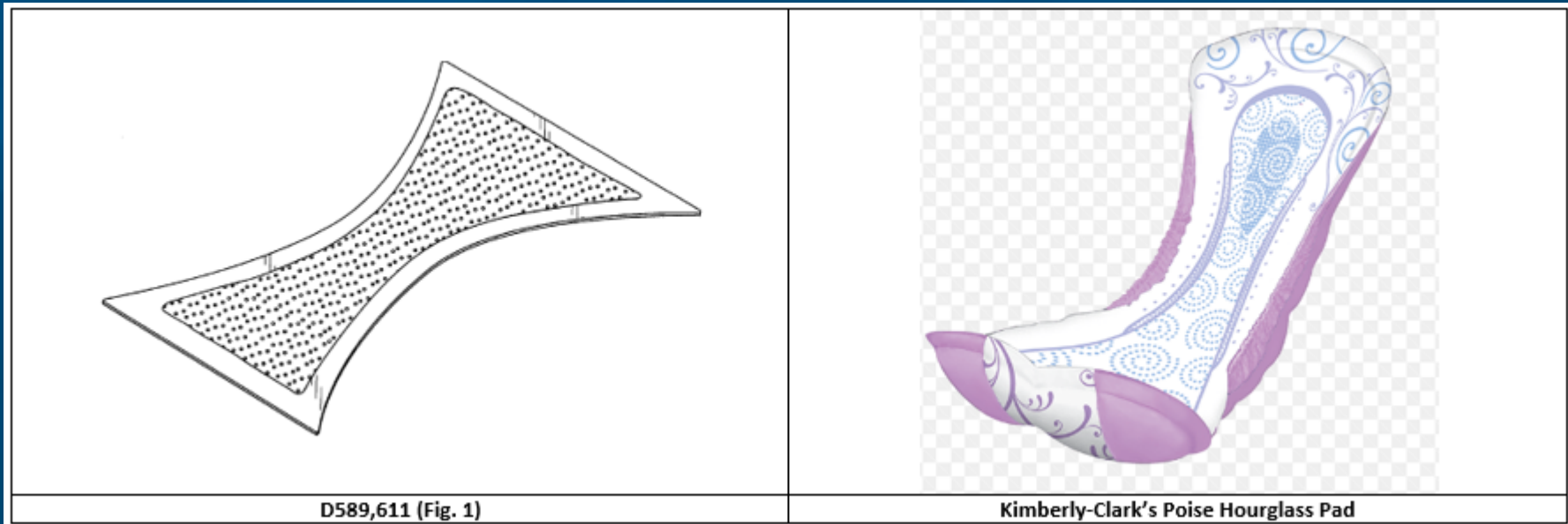


- ...GRANTED (*sua sponte*) Dec. 2010
- ...REVERSED (F.C.) Jan. 2013 705 F.3d 1357

Parker v. Kimberly-Clark

No. 11-cv-5658 (N.D. Ill. 2012)

- 12(b)(6) motion filed Oct. 2011...

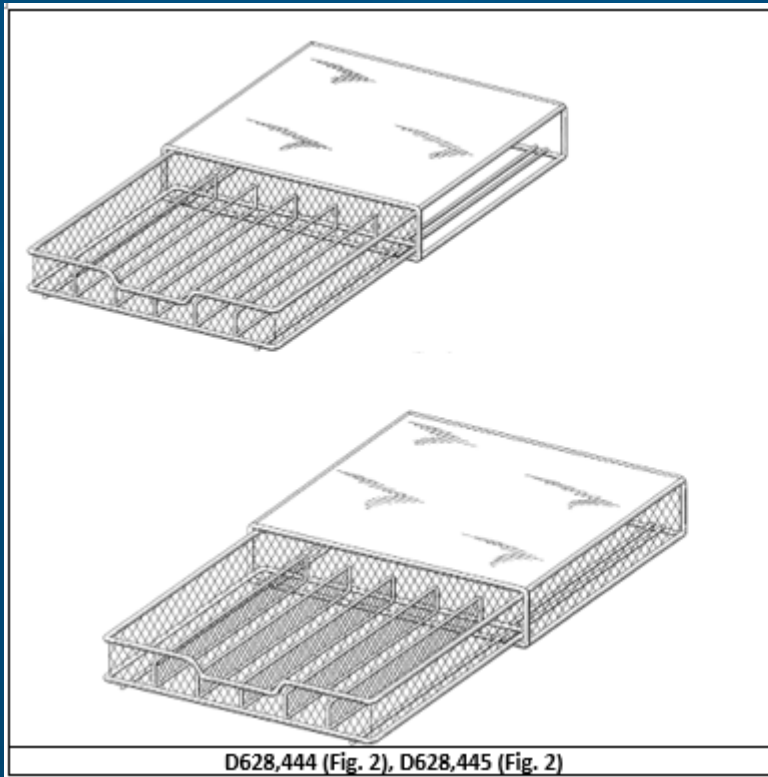


- ...**GRANTED** Jan. 2012 2012 WL 74855

MSA Products v. Nifty Home Products

No. 11-cv-5261 (D.N.J. 2012)

- 12(b)(6) motion filed Oct. 2011...



D628,444 (Fig. 2), D628,445 (Fig. 2)



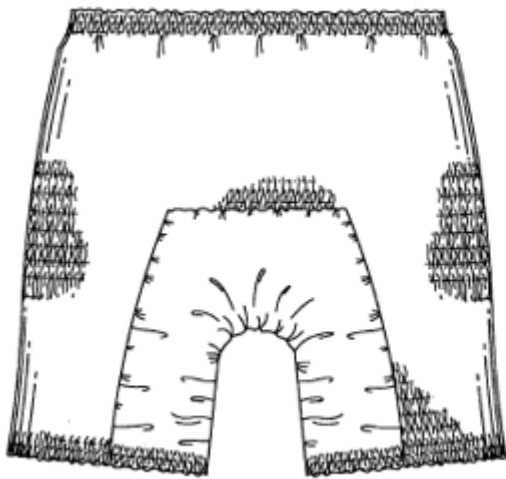
Nifty Home Product's K-Cup Drawer

- ...GRANTED Jun. 2012 883 F.Supp.2d 535

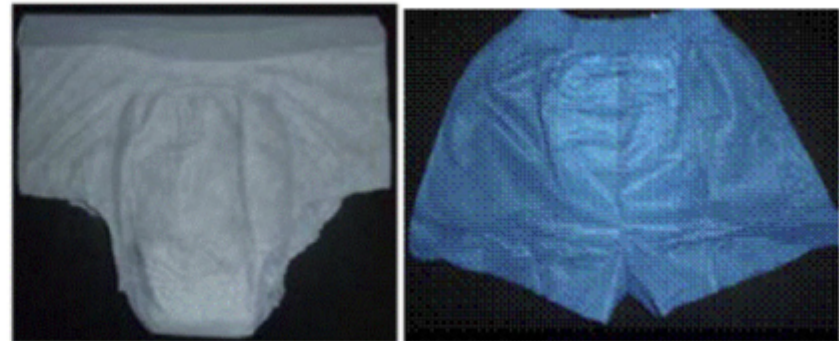
Anderson v. Kimberly-Clark

No. 12-cv-1979 (W.D. Wash. 2013)

- 12(c) motion filed Mar. 2013...



D401,328 (Fig. 2)



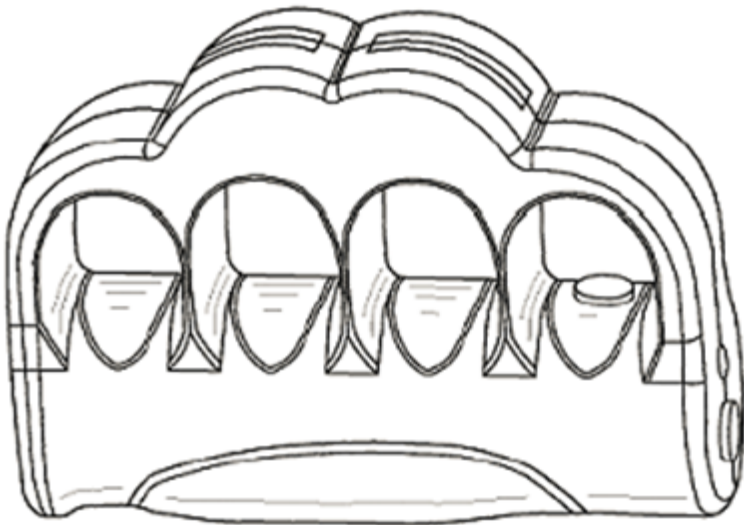
Kimberly-Clark's Depend® Real Fit for Men and GoodNite® "Boxer" style brief

- ... **GRANTED** Sept. 2013

P.S. Products v. Activision

No. 13-cv-342 (E.D. Ark. 2014)

- 12(b)(6) motion filed July 2013...



D561,294 (Fig. 6)



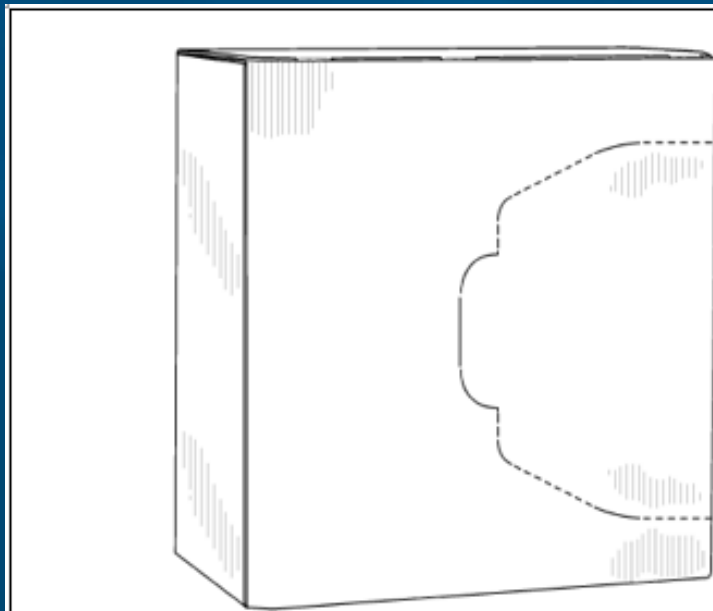
Stun Gun in *Call of Duty, Black Ops II*

- ...**GRANTED** Feb. 2014 140 F.Supp.3d 795

Poly-America v. API Industries

No. 13-cv-693 (D. Del. 2014)

- 12 (c) motion filed July 2013...



D569,719(Fig. 1)



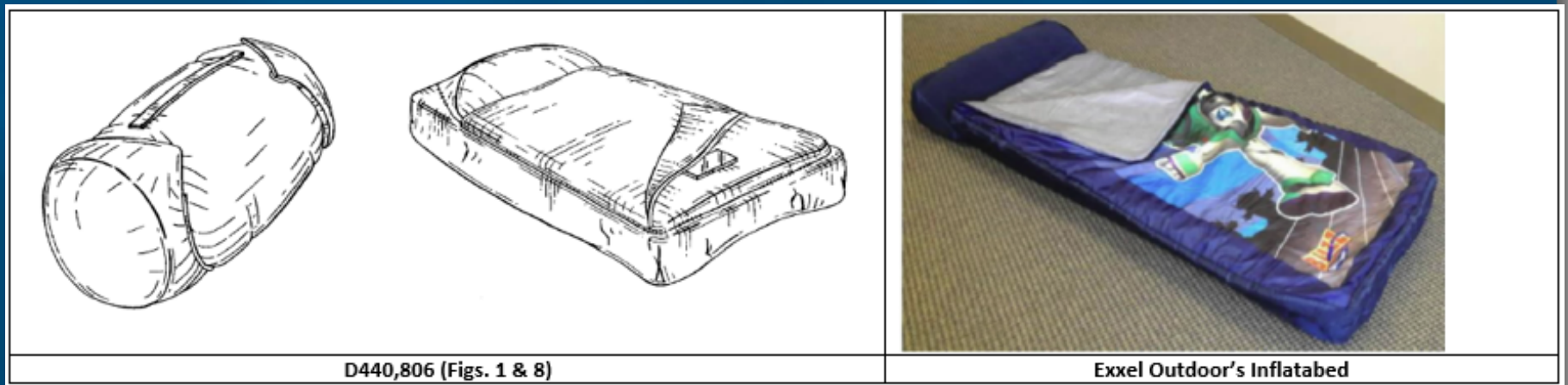
API Industries' accused bag

- ...**DENIED** April 2014

Legler v. Exxel Outdoors

NO. 13-cv-668 (E.D. Wis. 2014)

- 12(b)(6) motion filed Oct. 2013...



- ...**GRANTED** July 2014 2014 WL 3727566

Deckers Outdoor v. J.C. Penney

No. 14-cv-02565 (C.D. Cal. 2014)

- 12(b)(6) motion filed April 2014...

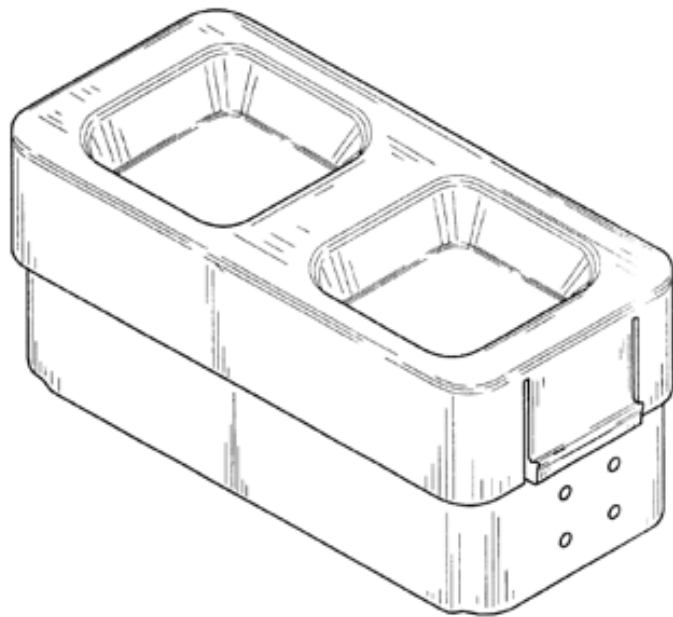


- ...**DENIED** Sept. 2014 45 F.Supp.3d 1181

OurPet's Company v. Iris USA

No.14-cv-1642 (N.D. Ohio 2015)

- 12(b)(6) motion filed Nov. 2014...



D486,274 (Fig. 1)



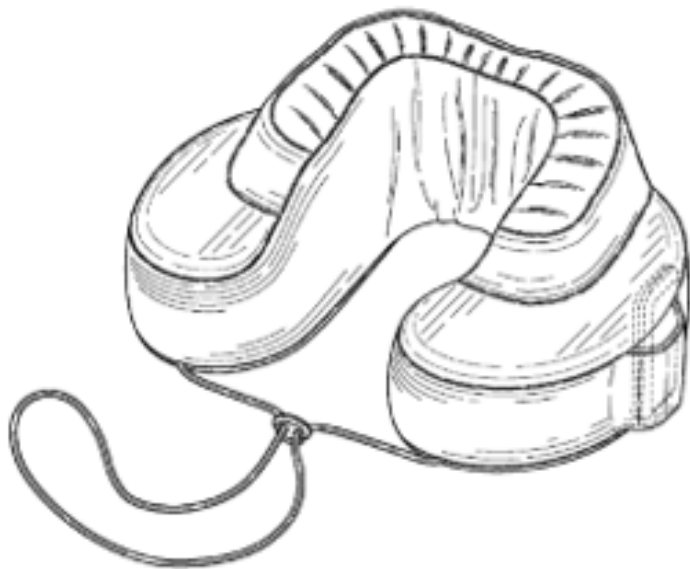
Iris Elevated Feeder

- ...**GRANTED** Mar. 2015 2015 WL 12780599

Atomi, Inc. v. Cabeau, Inc.

No. 15-cv-00276 (S.D.N.Y. 2015)

- 12(b)(6) motion filed March 2015...



D619,402(Fig.1)



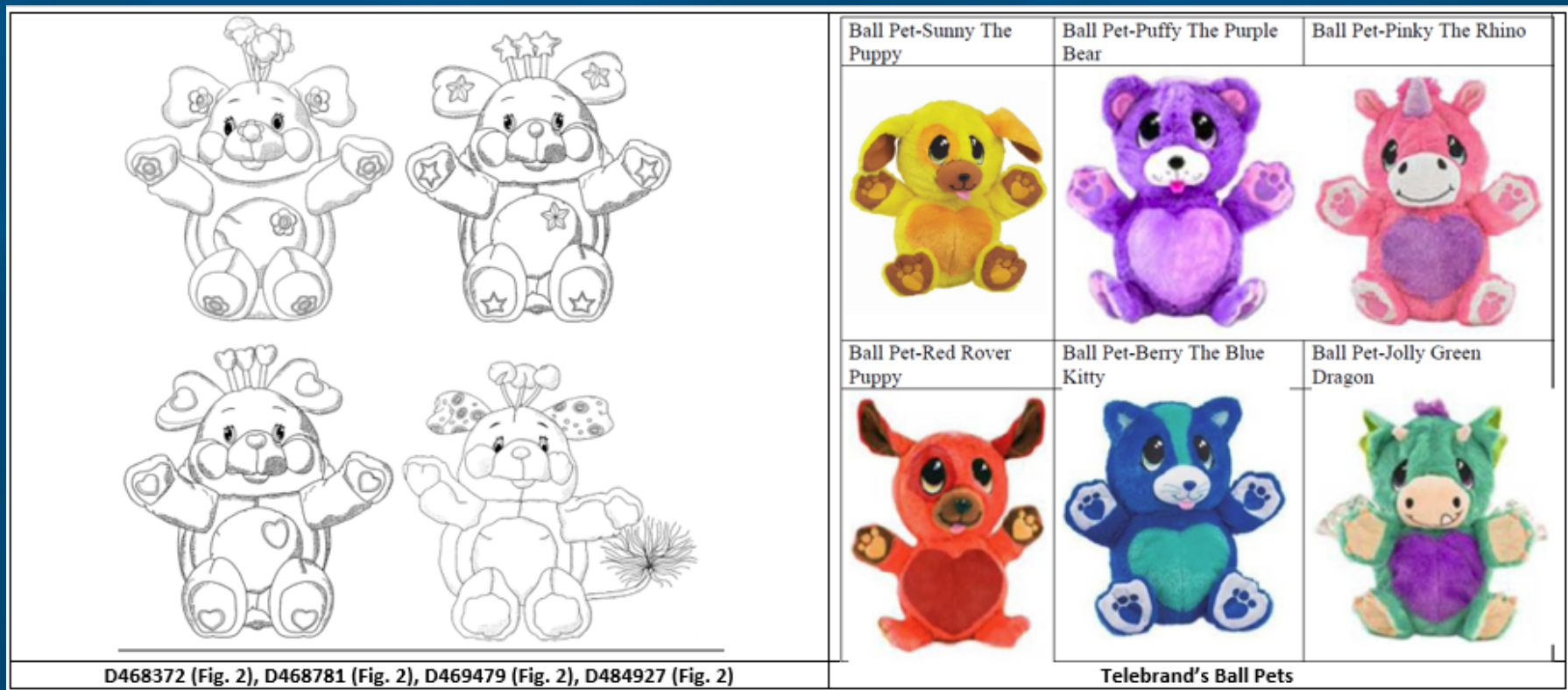
Atomi's Ultimate Pillow Memory Foam Travel Pillow

- ...**DENIED** Jun. 2015

SCG Characters v. Telebrands Corp.

No. 15-cv-00374 (C.D. Cal. 2015)

- 12(b)(6) motion filed April 2015...

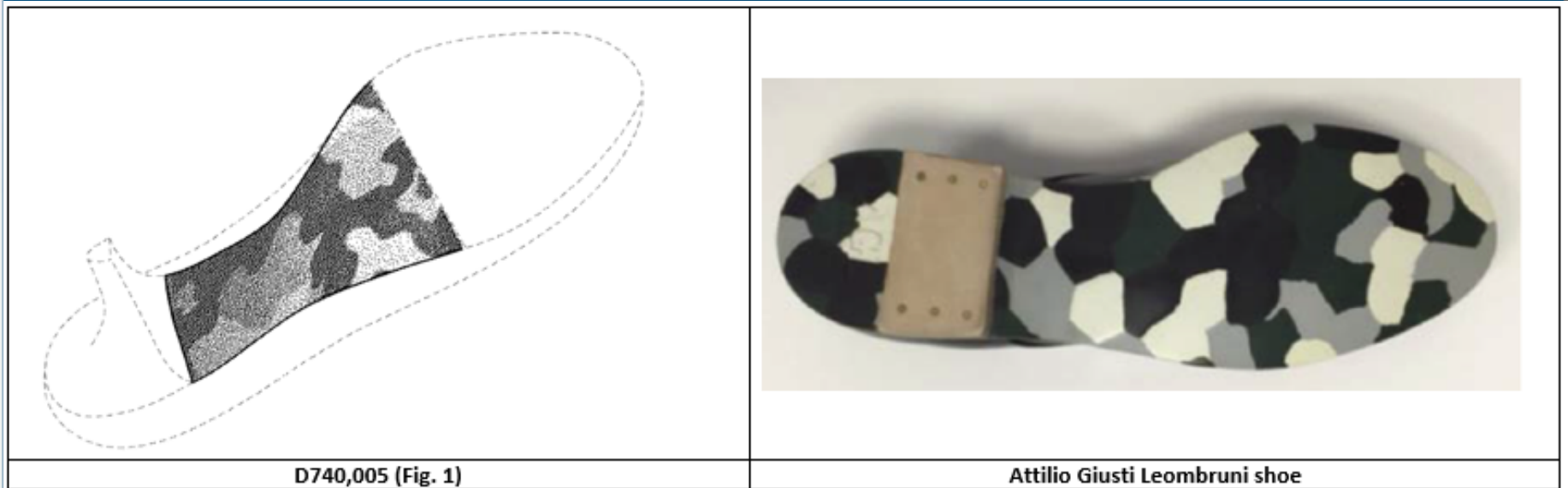


- ...**GRANTED** Aug. 2015 2015 WL 4624200

Silverman v. Attilio Giusti Leombruni SPA

No. 15-cv-2260 (S.D.N.Y. 2016)

- 12(b)(6) motion filed Dec. 2015...



- ...**GRANTED** Feb. 2016

Elite Gaming v. Spec International

No. 15-cv-08984 (N.D. Ill. 2016)

- 12(b)(6) motion filed Dec. 2015...



D677,736 (Fig. 1)



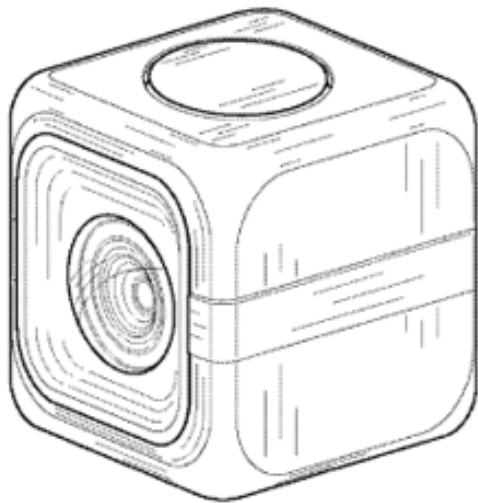
Spec International's Redemption Series DR-22, SDR-22 and Casino Series DC-22 and SDC-22

- ...**DENIED** Mar. 2016

C&A Marketing v. GoPro, Inc.

No. 15-cv-7854 (D.N.J. 2016)

- 12(c) motion filed Feb. 2016



D730,423(Fig. 1)



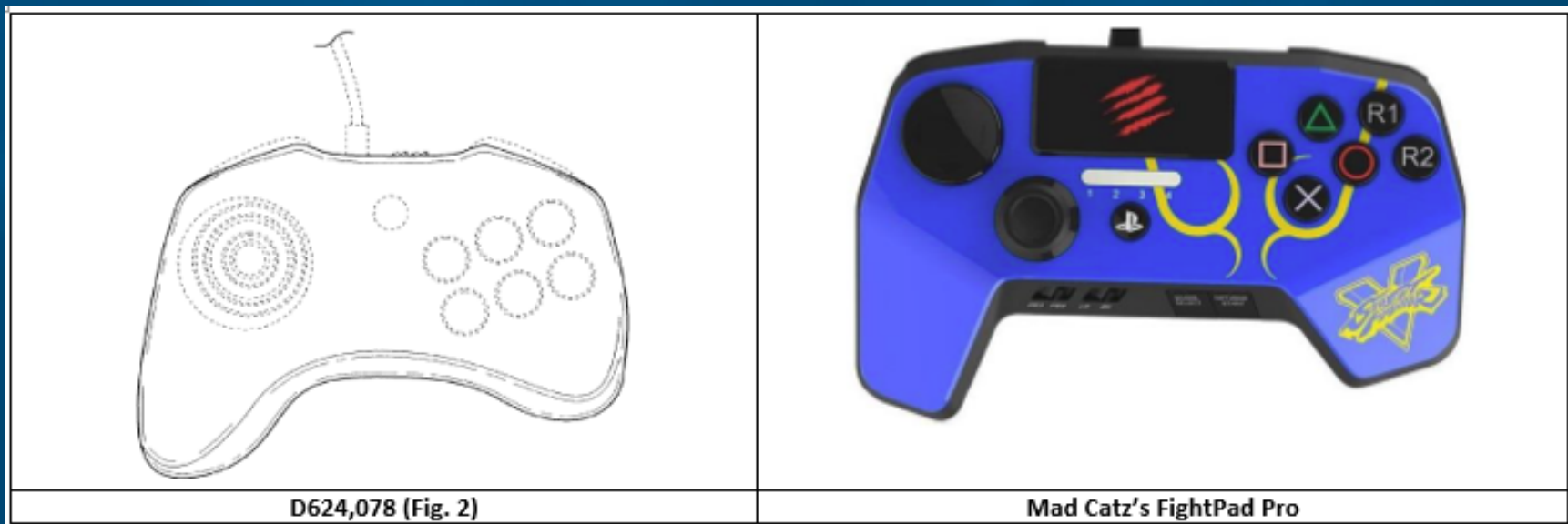
GoPro's HERO4 Session camera

- ...**DENIED** April 2016 2016 WL 1626018

Performance Designed v. Mad Catz

No. 16-cv-0629 (S.D. Cal. 2016)

- 12(b)(6) motion filed May 2016...

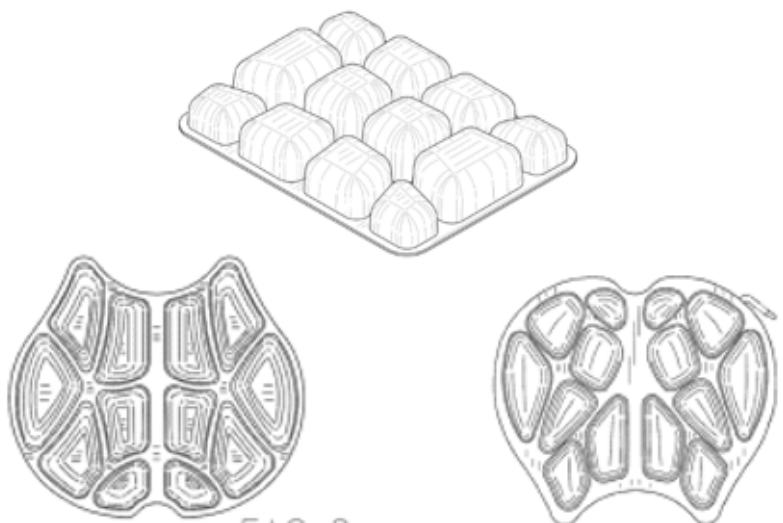
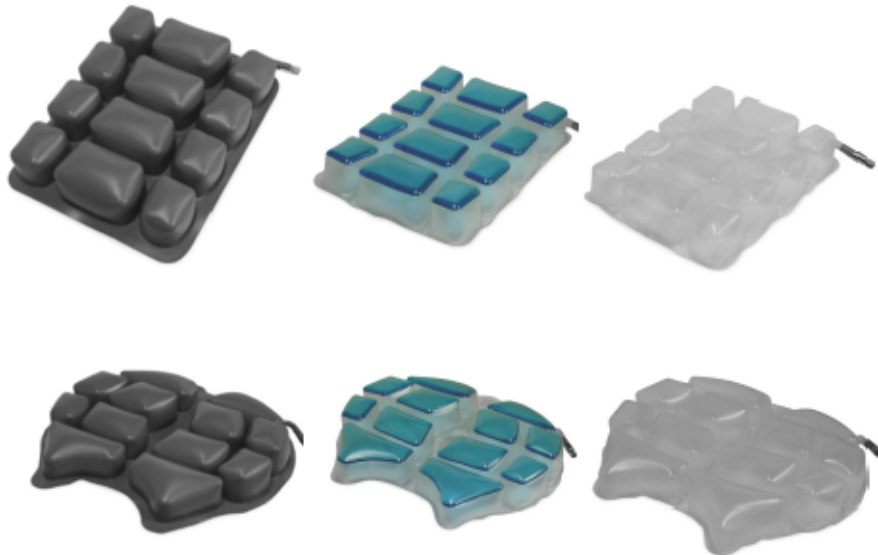


- ...**GRANTED** Jun. 2016 2016 WL 3552063

Airhawk v. THEREALCRAIGJ

No. 16-cv-00624 (C.D Cal. 2016)

- 12(b)(6) motion filed June 2016...

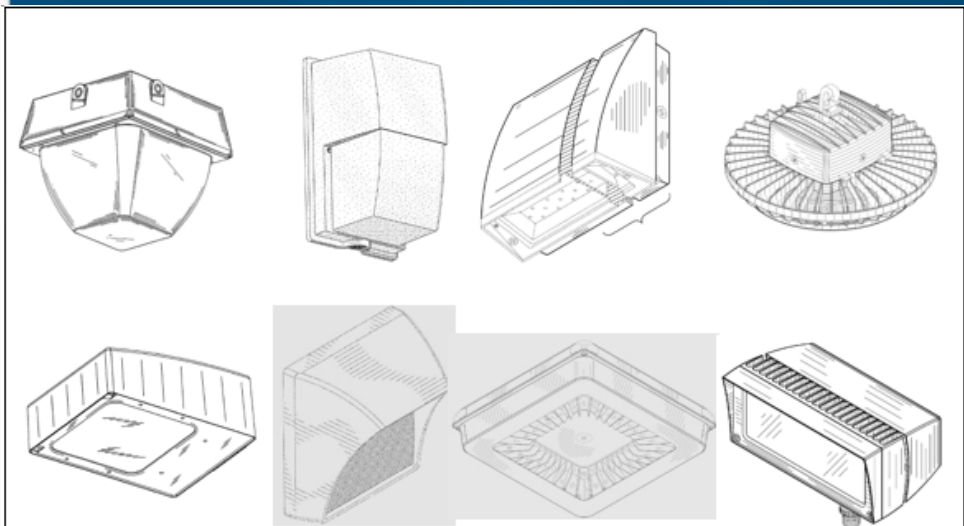

 <p>FIG. 2</p>	
<p>D673,785 (Fig. 1); D672,569 (Fig. 2); D658,396 (Fig. 2)</p>	<p>Accused Products: Classic Pillion Motorcycle Seat-Cushion, Classic Smart/Cruiser Motorcycle Seat-Cushion and Classic Sport Motorcycle Seat-Cushion</p>

- ...**DENIED** Aug. 2016

Rab Lighting v. ABB Lighting

No. 16-cv-3026 (S.D.N.Y. 2016)

- 12(b)(6) motion filed July 2016...

	
<p>D547,484 (Fig. 1); D569,029 (Fig. 1); D691,320 (Fig. 1); D690,453 (Fig. 2); D579,141 (Fig. 3); D612,975 (Fig. 1); D643,147 (Fig. 1); D747,534 (Fig. 2)</p>	<p>ABB Lighting's LED Parking Garage Light and LED Canopy Light, LED Security Light, LED Slim Wall Pack, LED High Bay Light, LED Wall Pack, LED Slim Wall Pack; LED V-Line Flood Light; LS Parking Garage Light</p>

- ...**DENIED** Sept. 2016

Bobcar Media v. Aardvark Event Logistics

No. 16-cv-885 (S.D.N.Y. 2017)

- 12(b)(6) motion filed March 2016...

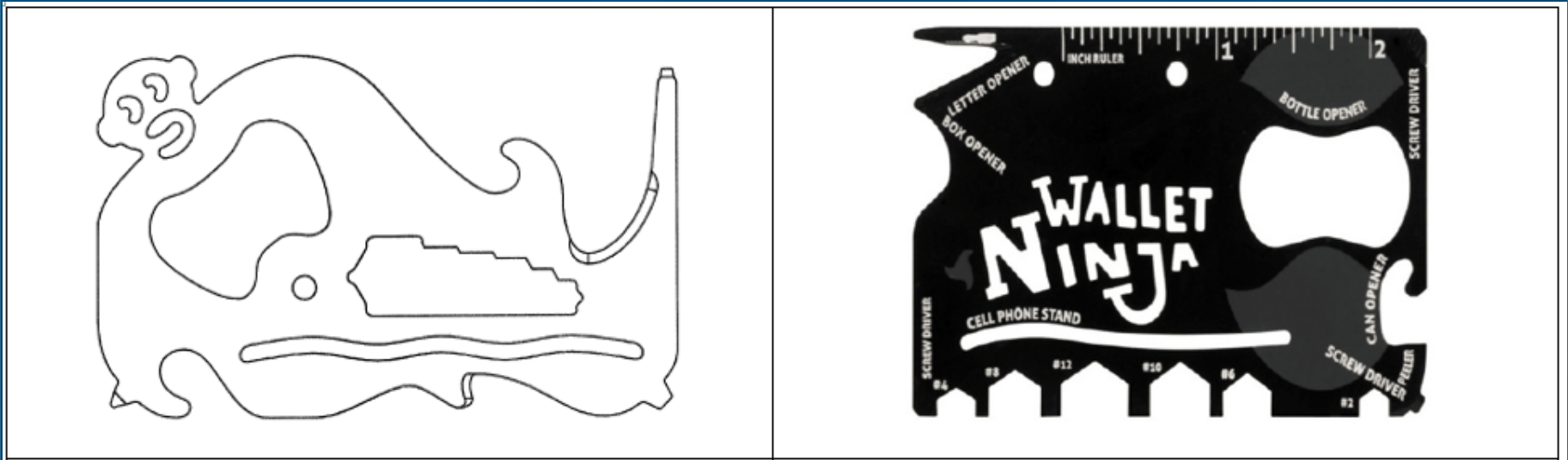


- ...**DENIED** Jan. 2017 2017 WL 41729

*Caffeinate Labs, Inc. v. Vante Inc. et al.**

No. 16-cv-12480 (D. Mass. Filed Dec. 7, 2016)

- 12(b)(6) motion filed Mar. 2017

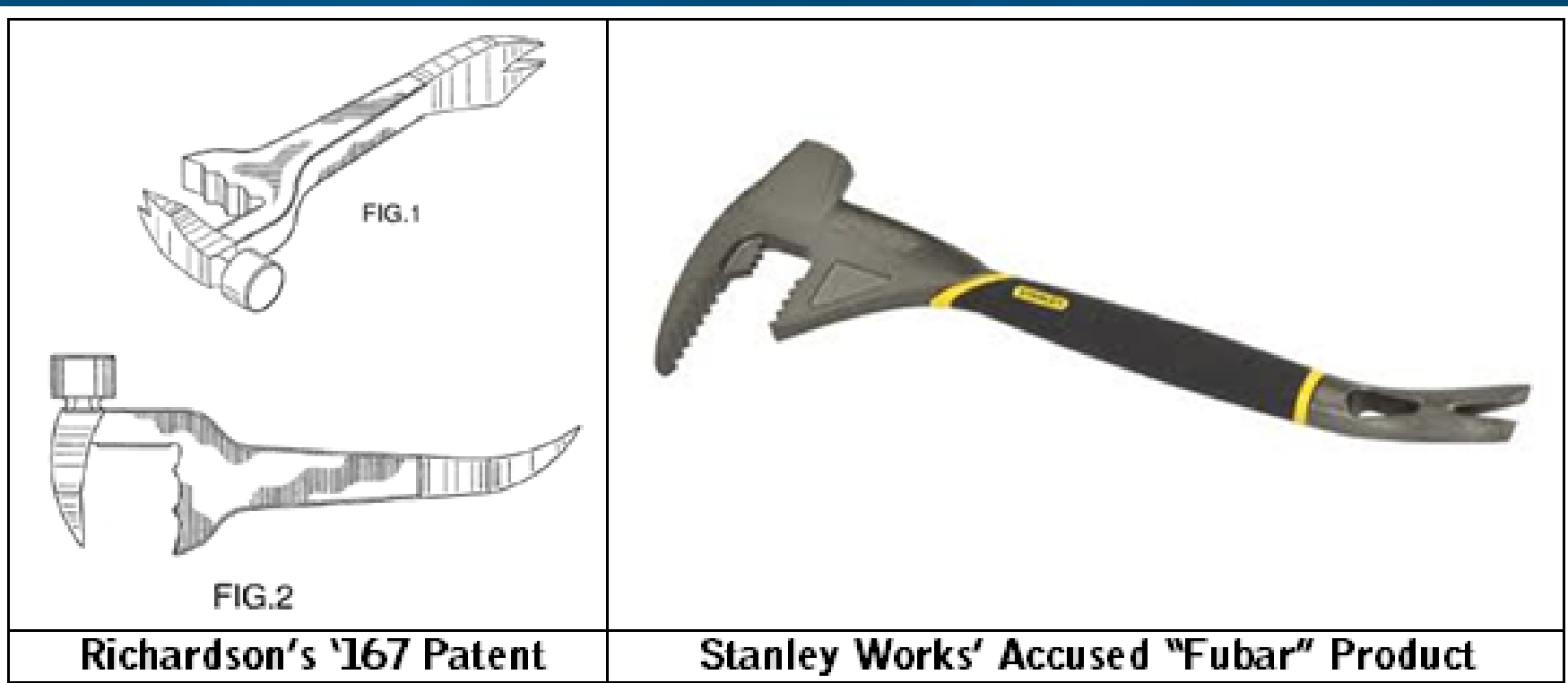


*Disclaimer: Presenter represents Defendants

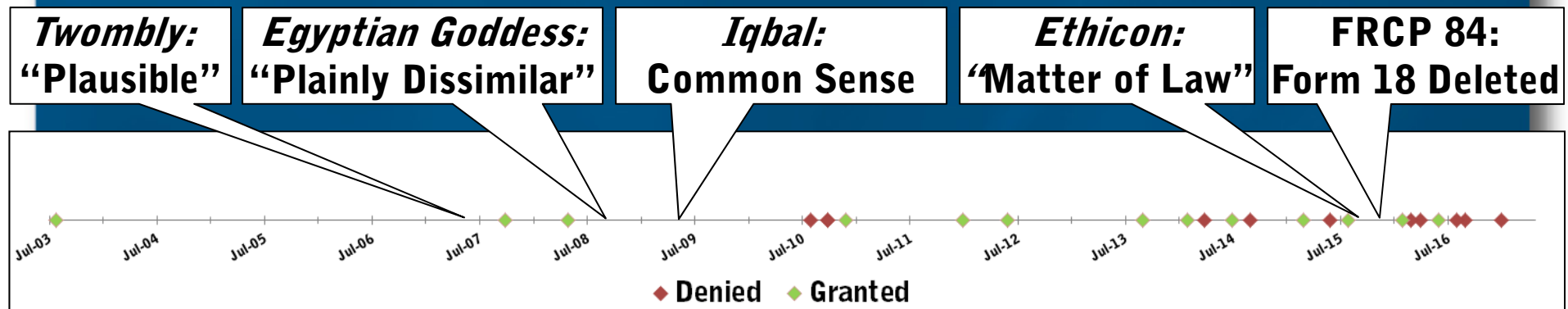
Richardson v. Stanley Works Inc.

597 F.3d 1288 (Fed. Cir. 2010) (affirming summary judgment of noninfringement)

- Could a 12(b)(6) motion have been filed?



Summary



- Dismissal motions are a growing force to counter overzealous design patent enforcement
- To date: 54% grant rate
- Not perfect, but more usage/improving

Thank you!

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CHICAGO, IL

Ten South Wacker Drive
Suite 3000
Chicago, IL 6060
T 312.463.5000
F 312.463.5001

WASHINGTON, DC

1100 13th Street NW
Suite 1200
Washington, DC 20005
T 202.824.3000
F 202.824.3001

BOSTON, MA

28 State Street
Suite 1800
Boston, MA 02109
T 617.720.9600
F 617.720.9601

PORTLAND, OR

One World Trade Center
121 SW Salmon Street, 11th Floor
Portland, OR 97204
T 503.425.6800
F 503.425.6801

