



PROTECTING DESIGNS

Justices Seem Unsatisfied With Design Patent Damages Tests

BY COLIN B. HARRIS AND DAVID M. LONGO, PH.D. | OCTOBER 17, 2016

The U.S. Supreme Court heard oral arguments in *Samsung Electronics Co., Ltd. v. Apple, Inc.* on Oct. 11, as to the following question presented in Samsung's cert petition: "Where a design patent is applied to only a component of a product, should an award of infringer's profits be limited to those profits attributable to the component?"

The oral argument drifted between a discussion of how to apply a broad test to answer the question at issue and a discussion of how to apply such a test to the specific facts of the case. But a substantial amount of the discussion focused on developing a broad test and its feasibility, as opposed to how to actually apply the test to reach a decision under the facts of the case.

Kathleen M. Sullivan, on behalf of Samsung, began the oral argument with the basic premise that it "makes no sense" to award damages to Apple for the total profit on the entire smartphone (here, \$399 million) based on "a single design patent on a portion of the appearance of the phone." Sullivan argued that 35 U.S.C. § 289 "does not require that result," and that "Apple and the government now agree that [§] 289 does not require that result." Instead, Sullivan requested "that when a design patent claims a design that is applied to a component of a phone or a component of a product, or, to use the language of [§] 289, when a design patent is applied to an article of manufacture within a multi-article product," that the Court "hold that [§] 289 entitles the patent-holder to total profit on the article of manufacture to which the design patent is applied, and not the profits on the total product."

Justice Anthony Kennedy responded skeptically: "[t]he problem is ... how to instruct the jury [at that point]." According to Justice Kennedy, "If I were the juror, I simply wouldn't know what to do ... under your test." "I'd have the iPhone in the jury room; I'd — I'd look at it. I just wouldn't know." Essentially, Justice Kennedy explained that neither Samsung nor Apple "gives us an instruction to work with."

Sullivan countered that it would be sufficient to tell a jury that "the article of manufacture to which a design has been applied is the part or portion of the product as sold that incorporates or embodies the subject matter" of the design patent. Then, the jury "should be instructed that total profit must be profit derived from the article of manufacture to which the design has been applied." But Justices Elena Kagan, Sonia Sotomayor and Ruth Bader Ginsburg questioned the practicality of implementing this type of instruction — including how to properly identify the relevant article of manufacture and how to determine the quantum of profit attributable to that article.

Addressing these two issues, Justice Kennedy referred to the "Volkswagen Beetle analogy" from the U.S. government's amicus brief, which posited that "[i]f the design in question is the shape of the Volkswagen Beetle, for example, one might reasonably say that the either that the design determines the appearance of the automobile's body or that it determines the appearance of the car as a whole." (Brief for the United States as amicus curiae in support of neither party, p. 28.) Justice Kennedy hypothesized that if "Beetle design was done in three days, and it was a stroke of genius and it identified the car," then it would be unfair to award three days' worth of profit if "it took 100,000 hours to develop the motor." In response to a question from Justice Samuel Alito on this topic, Sullivan conceded that as to the article of manufacture, "the holder of the

patent gets profit from the article, even if the profit does not come entirely from the design.”

But after further questioning from Justice Sotomayor, Sullivan asserted that “no reasonable jury could have found on this record that the entire product was the article of manufacture to which the design has been applied.” According to Sullivan, this is because “design patents cover ornamental appearance. They cannot, by definition, cover the innards of the phone.” “Just because you can show that most of the profit comes from the Beetle exterior does not mean the car is the article of manufacture.”

Brian H. Fletcher argued next for the U.S., as amicus curiae, in support of neither party. Fletcher first agreed with the Federal Circuit’s holding that § 289’s “provision for an award of total profits means that the patent-holder can recover all of the profits from the sale of the infringing articles [of] manufacture and not just the portion of the profits that the patent-holder can prove was caused by or attributable to the design as opposed to other features of the article.” But he cautioned that it is “a mistake” to read the Federal Circuit’s opinion “to have held that the relevant article of manufacture for which profits are owed is always the entire product that the infringer sells to customers.” Fletcher stated that “we understand all parties to agree with that now.” That is, when “the relevant article of manufacture to which a patented design may be applied is a part or a component of a larger product sold in commerce,” “all parties now agree that the patent-holder is entitled to only the profits from that infringing article and not to all” of the profits.

Justice Ginsburg interrupted: “When ... the article of manufacture isn’t sold apart from the entire product, how should ... the judge charge the jury on determining the profit attributable to the infringing article?” Fletcher responded that the fact-finder must first make a judgment as to “what’s the article of manufacture to which the design has been applied,” and then determine “how much of the total profits from the device are attributable to the infringing article.” Fletcher acknowledged that the latter has not been briefed, and that “[t]his case sort of stopped at the first step.” However, several follow-up questions forced Fletcher to explain how the latter question could be answered.

For example, Justice Kagan asked about “the hard cases,” such as how to determine what the relevant article is in the context of the Volkswagen Beetle analogy. Fletcher responded that “one can reasonably say that it’s either the body or the car,” and pointed to a four factor test described in the briefs: (1) “you should compare the scope of the patented design as shown in the drawings in the patent”; (2) “how prominently that design features in the accused article”; (3) “whether there are other conceptually distinct innovations or components in the article that are not part of or associated with the patented design”; and (4) “the physical relationship between the patented design and the rest of the article.” Fletcher then applied these factors to the Beetle analogy. When pressed on how to determine profits, Fletcher suggested that “the patent-holder make the argument that even though the article may be just a part of the product sold ... really, that’s what sells it,” and argue for recovery of “a very substantial portion of the profits.”

Seth P. Waxman then argued on behalf of Apple, asserting that “whatever you determine the right [jury] instruction should be, there is no basis to overturn the jury’s damages verdict in this case,” because Samsung did not “ever identify for the jury any article of manufacture other than the phones themselves.”

Justice Stephen Breyer then steered Waxman to the broader issue of how to answer the question presented to the Court in terms of developing an applicable standard. With reference to the amicus briefs, Justice Breyer mentioned a “conclusion, which is a little vague,” where the design has “been applied to only part ... of a multicomponent product and does not drive demand for the entire product,” that “the article of manufacture is rightly considered to be only the component to which the design applies. And only profit attributable to that component may be awarded.”

In response, Waxman conceded that “there is no question that in an appropriate case the jury can decide whether the article of manufacture to which the design is applied and to which it provides a distinctive and pleasing appearance could either be the article that’s actually sold to consumers, that’s bought by consumers, or it could be a component of it.” As to an applicable standard for a jury to use, Waxman stated that “the four factors that the Solicitor General articulated would be

appropriate factors to consider.”

Chief Justice John Roberts appeared unconvinced: “It seems to me that the design is applied to the exterior case of the phone. It’s not applied to the — all the chips and wires [so] there ... shouldn’t be profits awarded based on the entire price of the phone.” Waxman acknowledged that “[t]he profits are awarded on the article of manufacture to which the design is applied,” and the article may or may not be the “outside” part of the phone.

Justice Sotomayor asked Waxman if he agreed with the U.S. government’s “four-part test with respect to identifying just the article of manufacture.” Waxman agreed, with the caveat that “the factors that the jury will be told will depend on the evidence that the parties educe.” Rolling out the Beetle analogy yet again, Justice Sotomayor asked how to determine the profits to be awarded if the Volkswagen body is found to be the article of manufacture. Agreeing with Fletcher that the issue had not been briefed, Waxman stated that “conceptually, it is correct that under [§] 289 the patentee is entitled to the total profits on the sale of the articles of manufacture to which the design has been applied.”

Justice Sotomayor drove the point farther, using the Beetle as a good example “where the thing that makes the product distinctive does not cost all that much. There’s not been a lot of input. Somebody just — some engineer or some graphic artist or whatever woke up one day and said I just have this great idea for an appearance. But that’s the principal reason why the product has been successful.” “[T]he principal reason why the car has been successful has to do with this particular appearance, the design.” When asked if the fact that the principal reason why the car has been successful is due to the design is only relevant to the second inquiry, Waxman indicated that it would also be relevant to several factors in the government’s four-part test.

Sullivan concluded the oral argument with a brief rebuttal. She emphasized that “Congress did not say [that] you can’t segregate the proper article from the other articles that make up the product. So we can segregate [the] article from other articles within the product.” Sullivan stressed, however, that she was not attempting to apportion the value of the design in relation to the article. Rather, Sullivan asked the Court to “tell the nation’s economy that no one can claim a partial design patent on a portion of a front face of an electronic device and come in and get the entire profits on the phone.”

Overall, the representatives for Samsung, Apple, and the U.S. government all appeared willing to agree that the relevant article of manufacture for which profits may be owed under § 289 would not always be the entire product that an accused infringer sells to customers. Although the representatives proposed tests for determining the relevant article of manufacture and discussed — sometimes reluctantly — how to determine profits for such an article, the justices did not appear to be uniformly satisfied with such tests in view of the perceived difficulties of implementing them in practice.

Of course, patent attorneys love to have clear rules, clear definitions, and clear tests. Such clarity can yield clear guidance, which in turn can yield some measure of predictability for stakeholders and attorneys alike. Unfortunately, the oral argument did not do much to help patent attorneys see farther down the road as to these issues. While the oral argument gave us an opportunity to see the Court kicking the tires on various tests, we have no clarity as to whether any of these tests will have any traction. The Court seemed reluctant to favor any one particular test, meaning that once again the only thing we can see clearly is the dichotomy between the Court and patent attorneys in terms of having a clear rule, definition, and/or test. This is reminiscent of the Court’s reasoning in *KSR*, e.g., “Application of the bar [on patents claiming obvious subject matter] must not be confined within a test or formulation too constrained to serve its purpose” (*KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1746 (2007)), as much as it is reminiscent of the Court’s reasoning in *Alice*, e.g., “In any event, we need not labor to delimit the precise contours of the “abstract ideas” category in this case” (*Alice Corp. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2357 (2014)).

So, regardless of whether the Court adopts one of the proposed tests, develops another one or opts to let that Volkswagen Beetle coast down a hill, it appears likely that patent attorneys will be left to navigate on their own without clear guidance as to the destination. Unless the Court surprises us by announcing a clear rule, definition, and/or test, it appears that

design patentees will continue to attempt to define their claimed article of manufacture to be as much of a sold product as possible (aiming for higher damages), whereas accused infringers will continue their attempts to place limitations on that definition (aiming to minimize damages).

And, we may be left at the side of the road when it comes to how to determine profits for such an article — however it may be defined. If expert testimony would be used (discussed as a possibility during the oral argument), one can envision an analogy to how expert testimony is used in trademark litigation as to likelihood of confusion, strength of a mark, etc. This can be incredibly subjective, and complicated by how much weight may be given to it by the Court. In the case of design patents that show any portion of the article in broken lines, the complexities of design patent litigation may be exacerbated by the use of expert testimony.

Where does this leave us in the meantime? Without knowing what test — if any — that the Court might announce, it is difficult to give concrete advice for drafting new design patent applications. However, it appears that portfolio diversity may continue to be the key to starting the car. That is, it will likely continue to be good practice in most cases to include multiple embodiments that claim different amounts of an article of manufacture in a design application. While it may also be difficult to predict exactly what type of infringing products will appear somewhere down the road, having multiple embodiments that claim different amounts of an article of manufacture may increase the chances of success for a patentee's arguments for a broad definition of the claimed article of manufacture.

Tags: [Apple](#), [Design Patents](#), [Samsung](#), [SCOTUS](#)

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PROTECTING DESIGNS

Samsung Files Brief In U.S. Supreme Court Regarding Apple Decision

BY DAVID NGUYEN | JUNE 29, 2016

Samsung [filed a brief](#) in the U.S. Supreme Court on June 1, 2016 in response to the Court's grant of a petition for a writ of certiorari filed in December 2015. The petition sought a ruling on “where a patented design is applied only to a component of a product, should an award of infringer’s profits be limited to profits attributable to that component?”

This case is follow-on to Apple v. Samsung in 2012, which, generally speaking, included the U.S. District Court for the Northern District of California's denial of Samsung’s post-trial motion for judgment as a matter of law, new trial or remittitur (Pet. App. 114a-153a), followed by the U.S. Court of Appeals for the Federal Circuit (Pet. App. 1a-36a) denial of a rehearing en banc.

Samsung argues that the District Court’s interpretation of Section 289 of the Patent Act of 1887 resulted in a judgment obligating the company to “pay its entire profits on eleven [models of] smartphones” for infringing various Apple design patents. The design patents involved include U.S. Patent Nos. [D618,677](#), [D593,087](#), and [D604,305](#).

In the brief, Samsung argues that “at a minimum, a new trial is necessary” due to a number of issues in the previous cases. For example, Samsung states:

(1) Federal Circuit Court erred:

the Federal Circuit court erred in approving the district court’s instruction that, under Section 289, the jury should award the “total profit attributable to the infringing products.” ... and that Section 289 limits recoverable total profit to the profit “made from the infringement.”

(2) The District Court erred:

in declining to give Samsung’s proposed instruction that the jury “should award only those profits which were derived from the article of manufacture to which Apple’s patented design was applied” and that “[t]he article of manufacture to which a design has been applied is the part or portion of the product as sold that incorporates or embodies the subject matter of the patent.”

(3) The District Court’s rejection of Samsung’s proposed instruction ignored “traditional common-law and equitable principles of causation incorporated into Section 289 that tie monetary recovery to actual loss or gain from wrongful conduct.”

Samsung's brief further states that Congress did not intend for Section 289 of the Patent Act to be applied as it were in this instance: While Congress determined that such articles [e.g. carpets, wallpapers and oil-cloths] derive their value from their

design, it made no similar assumption for complex products like smartphones, whose value is overwhelmingly driven by functionality.

Finally, Samsung cites surveys that indicate the main reasons why customers buy smartphones relate to functionality rather than design features, and that misinterpretation of Section 289 has significant implications:

The Federal Circuit's automatic entire-profits rule would have disastrous practical consequences that Congress surely did not intend. The rule would create extreme asymmetry between design patents and utility patents, which are governed by ordinary rules of causation and proportionality. By making the most trivial design patent worth exponentially more than the most innovative utility patent, the rule would distort the patent system and harm innovation and competition. The rule would encourage companies to divert research and development from useful technologies to ornamental designs. It would encourage design-patent holders to litigate even weak infringement claims in a quest for outsized awards. And it would encourage non-practicing entities to use design patents as the next big thing for extracting holdup value from targeted businesses, with such extortionate demands posing especially grave threats to small businesses for whom a single design misstep could be an existential threat. Congress could not have intended any of these results.

Tags: [Apple](#), [Samsung](#), [SCOTUS](#), [litigation](#)

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PROTECTING DESIGNS

BMW Group Files Suit Against TurboSquid

BY COLIN B. HARRIS AND DAVID NGUYEN | MAY 9, 2016

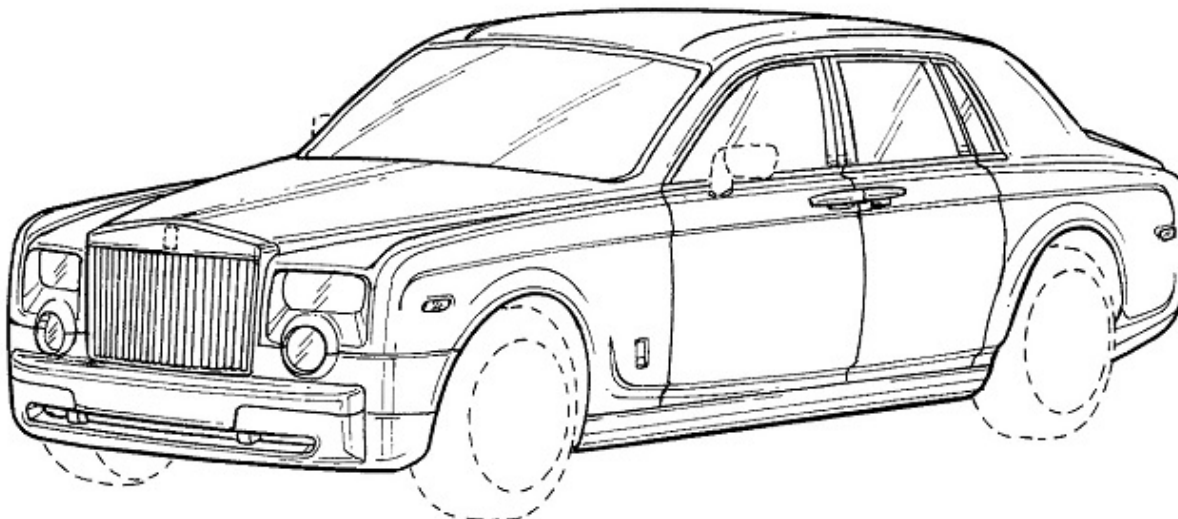
Bayerische Motoren Werke AG, BMW of North America, LLC, Rolls-Royce Motor Cars Limited, and Rolls-Royce Motor Cars NA, LLC (collectively “BMW Group”) filed suit against TurboSquid, Inc. (“TurboSquid”) on May 3, 2016 in the United States District Court for the District of New Jersey, alleging infringement of BMW Group’s design patents, trademarks, and trade dress.

BMW Group is seeking a permanent injunction for infringement, destruction of products, advertisements, and packaging in TurboSquid’s possession or control bearing BMW Group’s trademarks or trade dress, and recovery of TurboSquid’s profits from the alleged infringement, treble actual damages, and reasonable expenses.

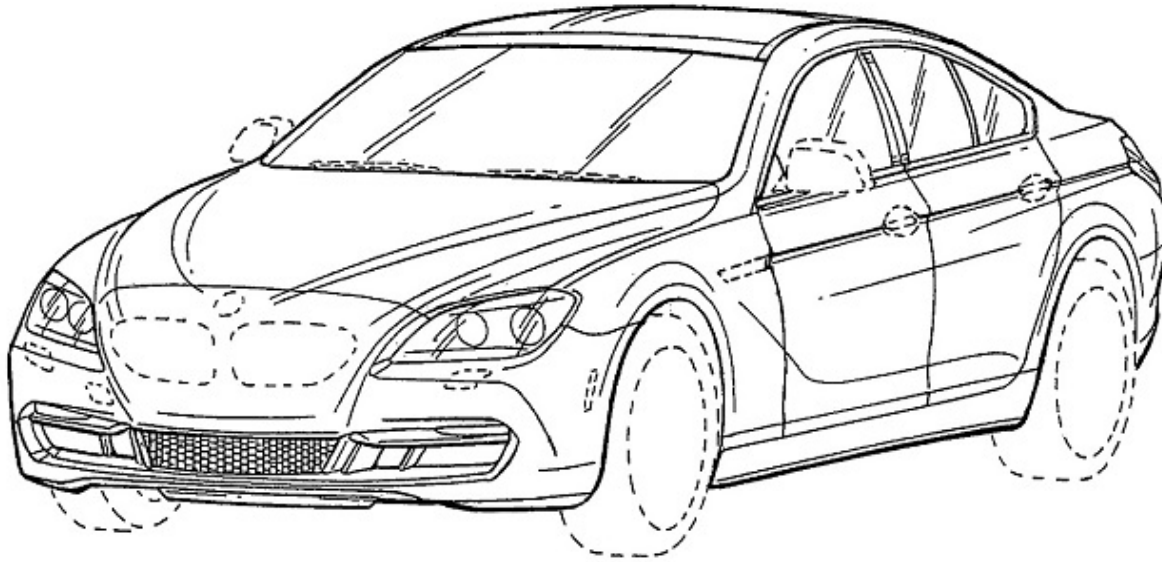
The design patents detailed in the suit include six BMW Group design patents pertaining to BMW, Mini, and Rolls-Royce branded vehicles produced by BMW Group. These are design patents D473,165, D639,209, D664,896, D714,190, D714,687, and D724,495. The ’165 patent is titled “Surface configuration of a vehicle, toy and miscellaneous consumer products incorporating the design,” and the other patents are each titled “Vehicle, toy, and/or replicas thereof.” For illustrative purposes, images from the design patents are shown below.

In the complaint, BMW Group alleges TurboSquid infringes these design patents by selling unauthorized virtual 3D models of BMW Group vehicle designs on the TurboSquid website. TurboSquid advertises itself as “the world’s largest library of real-time 3D assets for games, virtual reality, augmented reality and real-time apps.” Although TurboSquid advertises “3D assets,” it appears that the allegedly infringing designs are not 3D physical vehicles or toys.

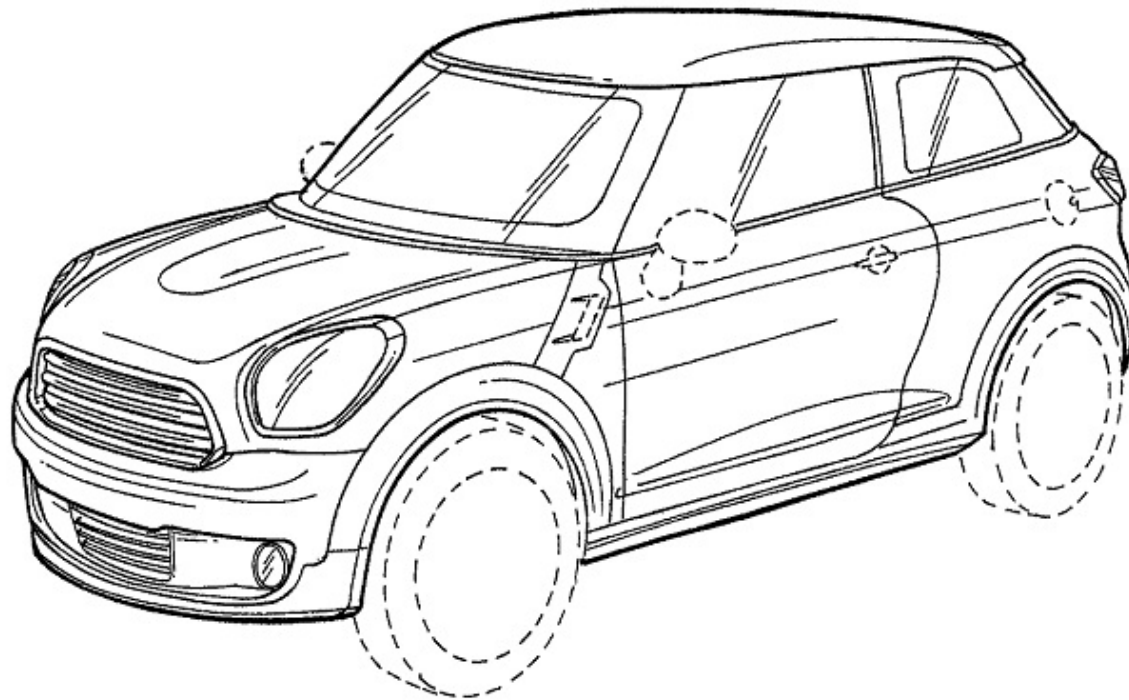
It will be interesting to see if such virtual 3D models are covered by BMW Group’s design patents.



D473,165



D639,209



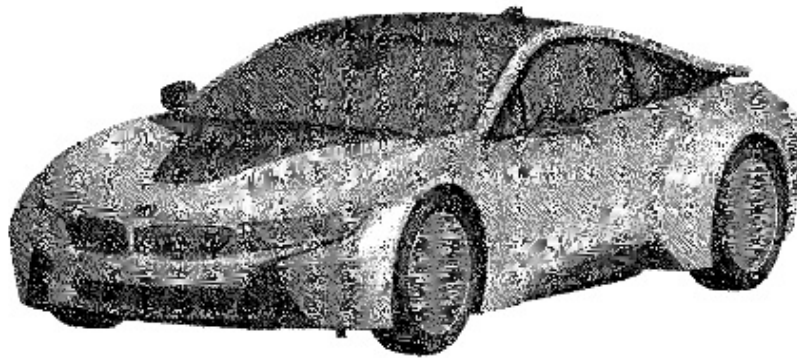
D664,896



D714,190



D714,687



D724,495

Tags: [Design Patents](#), [Patent Infringement](#), [bmw](#)

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PROTECTING DESIGNS

USPTO Publishes Request for Comments on (and Examples Addressing) the Application of the Written Description Requirement to Specific Situations in Design Applications

BY DAVID. M. LONGO, PH.D. | APRIL 15, 2016

On April 15, 2016, the U.S. Patent and Trademark Office (“USPTO”) published a Request for Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications (“Request”). See [81 F.R. 73, pp. 22233-22236](#). In particular, the USPTO is seeking the public’s help in identifying examples “to illustrate [its] proposed approach or any suggested approach for applying the written description requirement in design applications.” *Id.* (emphasis added).

Importantly, this Request also points out that “it became clear that there exists a need to supplement the current provisions in the *Manual of Patent Examining Procedure* (“MPEP”) relating to 35 U.S.C. 112 for design applications.” *Id.* (Stop the press! Does the Request really say that? Yes, yes it does. Please read on....)

According to today’s Request, the USPTO recognizes that:

in the vast majority of cases[,] there is no question that a later-claimed design [i.e., in a continuing design application], composed of only a subset of originally disclosed elements [in the parent application], satisfies the written description requirement. In certain limited situations, however, the subset of originally disclosed elements, although visible in the original disclosure, composes a later-claimed design that an ordinary designer might not have recognized in the original disclosure. In those certain limited situations, a question arises as to whether the later-claimed design satisfies the written description requirement.

[81 F.R. 73, p. 22234](#) (emphases added). Previously, the USPTO had proposed an enumerated factors-based approach for design examiners to evaluate compliance with the written description requirement. This builds from the USPTO’s earlier Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications of February 6, 2014, and subsequent roundtable event held on March 5, 2014, which were previously reported in this blog ([here](#)). See also [79 F.R., pp. 7171-7173](#). However, as indicated in today’s Request, the USPTO ultimately “decided not to pursue the factors-based approach” set forth in the earlier Request and discussed during the roundtable event. [81 F.R. 73, p. 22233](#).

Section II of today’s Request then outlines general principles in evaluating compliance with the written description requirement for design applications. For example, the Request recognizes that the “test for sufficiency of written description is the same for design and utility patents,” with citation to *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998). And, referring to *Daniels*, such a written description analysis “must be conducted from the perspective of an ordinary designer.” In a nod to *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013), the Request notes that these principles are articulated again therein. See our previous post on *In re Owens* ([here](#)).

Section III of the Request discusses another proposed approach to apply these general principles in “limited situations ... where a later-claimed design, composed of only a subset of originally disclosed elements (claimed or unclaimed), raises a question as to whether the later-claimed design is supported by the original/earlier disclosure, even though the elements composing the later-claimed design are visible in the original/earlier disclosure.” 81 F.R. 73, p. 22235 (emphasis added). The USPTO proposes that in such situations, “the examiner would determine whether an ordinary designer would recognize upon reviewing the complete original/earlier application that the inventor had possession of the later-claimed design in the original/earlier disclosure.” *Id.*

To make this determination, the USPTO proposes that the examiner consider “what the original/earlier application, in its totality (e.g., including the title, any descriptive statements, and the drawings), would have reasonably conveyed to an ordinary designer at the time of the invention, and how an ordinary designer in the art would have designed the article that is the subject of the design claim.” *Id.* According to the Request, such considerations “can include the nature and intended use of the article embodying the claimed design as identified by the title or description.” *Id.* Thereafter, “the examiner would reject the design claim for lack of written description (or in the case of a priority or benefit claim, the application would not be entitled to the earlier date)” if he or she “determines that [upon reviewing the complete original/earlier application,] an ordinary designer would not recognize ... the later-claimed design in the original/earlier disclosure.” *Id.*

Accordingly, the USPTO requests written comments from the public, including specific examples “that demonstrate adequate written description as well as examples that demonstrate a lack of written description.” *Id.*, p. 22236. Importantly, the USPTO indicates that it “would be most helpful” to receive “examples of situations in which the presence or lack of written description is not readily apparent, *i.e.*, examples that are close to the line between adequate written description and insufficient written description.” *Id.*

Those of us in the design practitioner community should heed today’s Request, especially considering that well-formulated examples might influence a supplement to the MPEP. The topic of this Request will almost certainly be discussed during the upcoming [2016 USPTO Design Day](#), which will be held on April 19th. We will report on Design Day in a future post.

Tags: [Design Day](#), [Design Patents](#), [Prosecution](#), [USPTO](#), [Written Description](#)

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PROTECTING DESIGNS

Oakley Files Suit Against Treasure Franchise Company



BY DAVID NGUYEN | APRIL 11, 2016



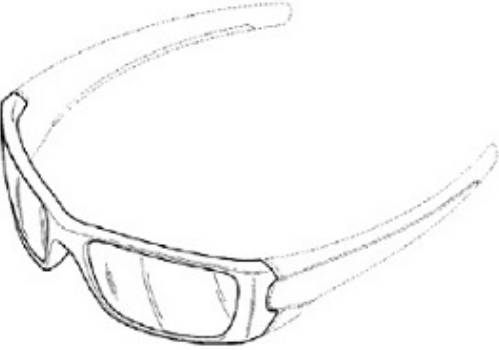

Oakley, Inc. (“Oakley”) filed suit against Treasure Franchise Company, LLC (“Defendant”) on March 29, 2016 in the United States District Court for the Southern District of California, alleging infringement a number of Oakley’s design patents for eyewear.

The patents detailed in the suit include seven Oakley design patents issued between December 11, 2007 and October 22, 2013 pertaining to its eyewear designs. These are design patents D692,047, D610,604, D616919, D620,970, D649,579, and D661,339.


In the complaint, Oakley alleges the Defendant infringes by making and selling nearly identical sunglasses, including at several California stores. Examples cited include Defendant’s eyewear model MD3072-RV, JR Optics 7306CW, JR Optics 314L, JR Optics 318L, JR Optics 311L, and JR Optics Dxtreme – DXT5318/CM.


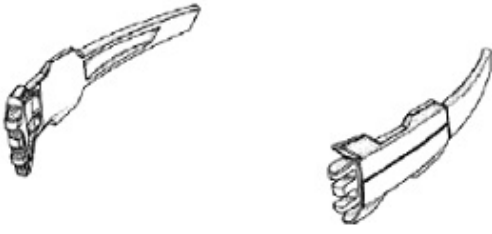
The tables below (reproduced from the complaint) offers comparisons between the patent figures and the exemplary infringing products.


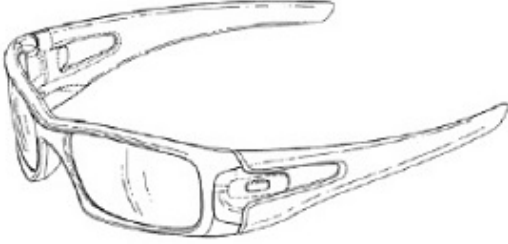
Accused Product	Oakley’s Patent
<p data-bbox="305 1178 493 1208">MD3072-RV</p> 	<p data-bbox="808 1178 1182 1208">U.S. Patent No. D692,047</p> 

Accused Product	Oakley's Patent
<p data-bbox="256 151 537 187">JR Optics 7306CW</p> 	<p data-bbox="808 151 1187 187">U.S. Patent No. D610,604</p> 
	<p data-bbox="808 704 1187 740">U.S. Patent No. D616,919</p>  <p data-bbox="808 1193 1187 1229">U.S. Patent No. D620,970</p> 

Accused Product	Oakley's Patent
<p data-bbox="284 144 511 187">JR Optics 314L</p> 	<p data-bbox="808 144 1187 187">U.S. Patent No. D610,604</p>  <p data-bbox="808 638 1187 680">U.S. Patent No. D616,919</p> 

Accused Product	Oakley's Patent
<p data-bbox="284 1253 511 1295">JR Optics 318L</p> 	<p data-bbox="808 1253 1187 1295">U.S. Patent No. D649,579</p> 

Accused Product	Oakley's Patent
<p data-bbox="282 151 511 187">JR Optics 311L</p> 	<p data-bbox="808 151 1187 187">U.S. Patent No. D557,326</p> 

Accused Product	Oakley's Patent
<p data-bbox="138 708 659 744">JR Optics Dxtreme – DXT5318/CM</p> 	<p data-bbox="808 708 1187 744">U.S. Patent No. D661,339</p> 

Oakley is seeking judgment against the Defendant, including a permanent injunction of the infringement described in the suit, and recovery of damages and expenses.

Oakley has filed suit against a number of other companies, including [Seven Eleven](#), [ICU Eyewear](#), [Hire Order](#), [Great L&H Trading](#), [Talitor Far East](#), [Uvex Sports](#), and a [host of others](#) for infringement of the company's design patents.

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PROTECTING DESIGNS

Supreme Court to Hear Design Patent Damages Issue

BY COLIN HARRIS | MARCH 21, 2016

The U.S. Supreme Court granted Samsung's petition for writ of certiorari in the Samsung v. Apple appeal. The grant was limited to Question 2 from the [petition](#), which is as follows:

2. Where a design patent is applied to only a component of a product, should an award of infringer's profits be limited to those profits attributable to the component?

Samsung's position in its petition is that the three design patents at issue (U.S. Design Patent Nos. D618,677, D593,087, and D604,305) "cover only specific, limited portions of a smartphone's design: a particular black rectangular round-cornered front face, a substantially similar rectangular round-cornered front face plus the surrounding rim or 'bezel,' and a particular colorful grid of sixteen icons." Samsung states that, despite this limited coverage, "the Federal Circuit allowed the jury to award Samsung's entire profits from the sale of smartphones found to contain the patented designs—here totaling \$399 million." The Federal Circuit opinion can be found [here](#). Contrary to the position taken by the Federal Circuit, Samsung does not believe that Section 289 of the Patent Act compels this result. Instead, Samsung's position is that "Section 289 nowhere defines the 'article of manufacture' to which a patented design is applied as the entire product (here, a smartphone) rather than the portion of the product depicted in the design patent."

The Supreme Court declined to hear Question 1 from the petition for writ of certiorari filed by Samsung. Question 1 is as follows:

1. Where a design patent includes unprotected non-ornamental features, should a district court be required to limit that patent to its protected ornamental scope.

Regardless of how the Supreme Court answers Question 2, this appeal will certainly have profound impacts on U.S. design patent practice. Be sure to check back for updates, including briefing from the parties and amicus briefs.

Tags: [Apple](#), [Design Patents](#), [Federal Circuit](#), [Samsung](#)

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PROTECTING DESIGNS

Nike Files Suit Against Fujiann Bestwinn Alleging Design Patent Infringement

BY DAVID NGUYEN | MARCH 11, 2016

NIKE, Inc. (“Nike”) filed [suit](#) against Fujiann Bestwinn (China) Industry Co., Ltd. (“Bestwinn”) on February 17, 2016 in the United States District Court for the District of Nevada, alleging infringement of a number of Nike’s design patents for various aspects of athletic shoes.

In the complaint, Nike alleges Bestwinn infringes its design patents by attending the WSA trade show in Las Vegas, Nevada at least twice yearly and promoting and selling the infringing shoes.

The patents detailed in the suit include eighteen Nike design patents issued between April 26, 2011 and December 29, 2015 pertaining to Nike’s shoe designs (see Table 1 below from the complaint).

TABLE 1: NIKE Design Patents		
United States Design Patent No.	Issue Date of Patent	Complaint Exhibit
D636,573	April 26, 2011	A
D666,405	September 4, 2012	B
D666,406	September 4, 2012	C
D673,765	January 8, 2013	D
D682,523	May 21, 2013	E
D683,119	May 28, 2013	F
D683,946	June 11, 2013	G
D694,501	December 12, 2013	H
D696,849	January 7, 2014	I
D696,853	January 7, 2014	J
D700,423	March 4, 2014	K
D701,689	April 1, 2014	L
D707,027	June 17, 2014	M
D707,028	June 17, 2014	N
D707,032	June 17, 2014	O
D707,033	June 17, 2014	P
D710,579	August 12, 2014	Q
D746,037	December 29, 2015	R

A partial list of the accused infringing products from Bestwinn include shoes with Bestwinn model numbers 90088, BW1001, BW1002, BW1003, BW71389, BW71389A-BW71389P, BW71390, BW71390A-BW71390C, BW71391, BW71391A-BW71391E, BW71390A-1-BW71390C-1, BW71391A-1, BW71391B-1, BW71391D-1, BW71392, BW71392A-BW71392N, BW71392-1 and BW71392A-1-BW71392E-1.

The table below (reproduced from the complaint) offers comparisons between the design patent figures and the exemplary infringing products.

TABLE 4: Example Infringements	
<u>Representative NIKE Design Patent Figure</u>	<u>Representative Infringing Shoes</u>
 <p>FIG. 1</p> <p>U.S. Pat. No. D666,405 See Compl. Ex. B</p>	 <p>Model No. BW71390</p>
 <p>FIG. 1</p> <p>U.S. Pat. No. D666,406 See Compl. Ex. C</p>	 <p>Model No. BW713901</p>
 <p>FIG. 2</p> <p>U.S. Pat. No. D673,765 See Compl. Ex. D</p>	 <p>Model No. BW71389F</p>

TABLE 4: Example Infringements	
<u>Representative NIKE Design Patent Figure</u>	<u>Representative Infringing Shoes</u>
 <p>FIG. 1 U.S. Pat. No. D683,946 <i>See Compl. Ex. G</i></p>	 <p>Model No. 90088</p>
 <p>FIG. 1 U.S. Pat. No. D696,849 <i>See Compl. Ex. I</i></p>	 <p>Model No. BW71389H</p>
 <p>FIG. 2 U.S. Pat. No. D696,853 <i>See Compl. Ex. J</i></p>	 <p>Model No. BW71392F</p>

TABLE 4: Example Infringements	
<u>Representative NIKE Design Patent Figure</u>	<u>Representative Infringing Shoes</u>
 <p style="text-align: center;">FIG. 2</p> <p style="text-align: center;">U.S. Pat. No. D700,423 <i>See Compl. Ex. K</i></p>	 <p style="text-align: center;">Model No. BW71392F</p>
 <p style="text-align: center;">FIG. 1</p> <p style="text-align: center;">U.S. Pat. No. D701,689 <i>See Compl. Ex. L</i></p>	 <p style="text-align: center;">Model No. BW71389A</p>
 <p style="text-align: center;">FIG. 1</p> <p style="text-align: center;">U.S. Pat. No. D707,027 <i>See Compl. Ex. M</i></p>	 <p style="text-align: center;">Model No. BW71390A</p>

TABLE 4: Example Infringements	
<u>Representative NIKE Design Patent Figure</u>	<u>Representative Infringing Shoes</u>
 <p>FIG. 1</p> <p>U.S. Pat. No. D707,028 See Compl. Ex. N</p>	 <p>Model No. BW71390B</p>
 <p>FIG. 2</p> <p>U.S. Pat. No. D707,032 See Compl. Ex. O</p>	 <p>Model No. BW71392</p>
 <p>FIG. 1</p> <p>U.S. Pat. No. D707,033 See Compl. Ex. P</p>	 <p>Model No. BW71390B</p>

TABLE 4: Example Infringements	
<u>Representative NIKE Design Patent Figure</u>	<u>Representative Infringing Shoes</u>
 <p>FIG. 1</p> <p>U.S. Pat. No. D710,579 See Compl. Ex. Q</p>	 <p>Model No. BW71389N</p>
 <p>U.S. Pat. No. D682,523 See Compl. Ex. E</p>	 <p>Model No. BW71448</p>
 <p>U.S. Pat. No. D683,119 See Compl. Ex. F</p>	 <p>Model No. BW71448</p>
 <p>U.S. Pat. No. D746,037 See Compl. Ex. R</p>	 <p>Model No. BW71448</p>

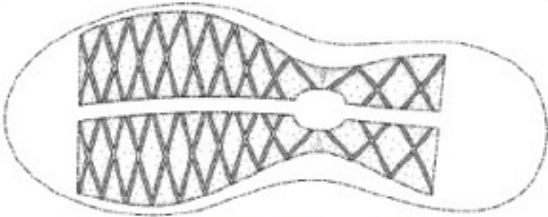

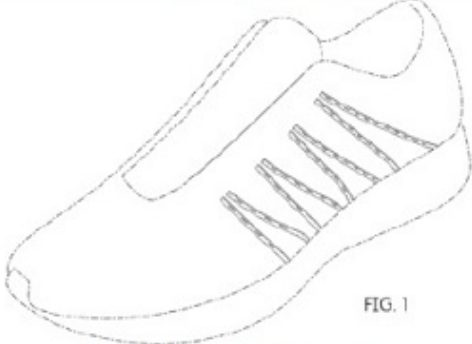

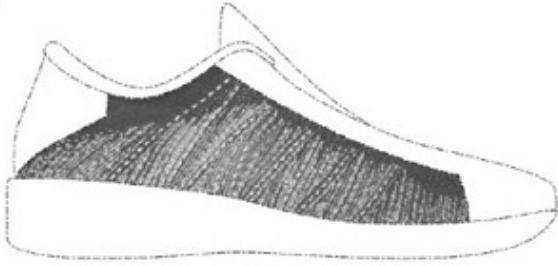



TABLE 4: Example Infringements	
<u>Representative NIKE Design Patent Figure</u>	<u>Representative Infringing Shoes</u>
 <p>U.S. Pat. No. D636,573 <i>See Compl. Ex. A</i></p>	 <p>Model No. 14149</p>
 <p>FIG. 1 U.S. Pat. No. D666,406 <i>See Compl. Ex. C</i></p>	 <p>Model No. 14149</p>

TABLE 4: Example Infringements	
<u>Representative NIKE Design Patent Figure</u>	<u>Representative Infringing Shoes</u>
 <p>FIG. 2</p> <p>U.S. Pat. No. D700,423 See Compl. Ex. K</p>	 <p>Model No. 14260</p>
 <p>FIG. 2</p> <p>U.S. Pat. No. D707,032 See Compl. Ex. O</p>	
 <p>FIG. 2</p> <p>U.S. Pat. No. D696,853 See Compl. Ex. J</p>	

Nike is seeking judgment against Bestwinn, including a permanent injunction and recovery of damages and expenses from Bestwinn.

Tags: Complaint, Design Patents, Fashion Designs, Filings and Decisions

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PROTECTING DESIGNS

Microsoft Alleges Corel Infringes Design Patents Directed to Graphical User Interfaces (GUIs)

BY DAVID NGUYEN | FEBRUARY 9, 2016

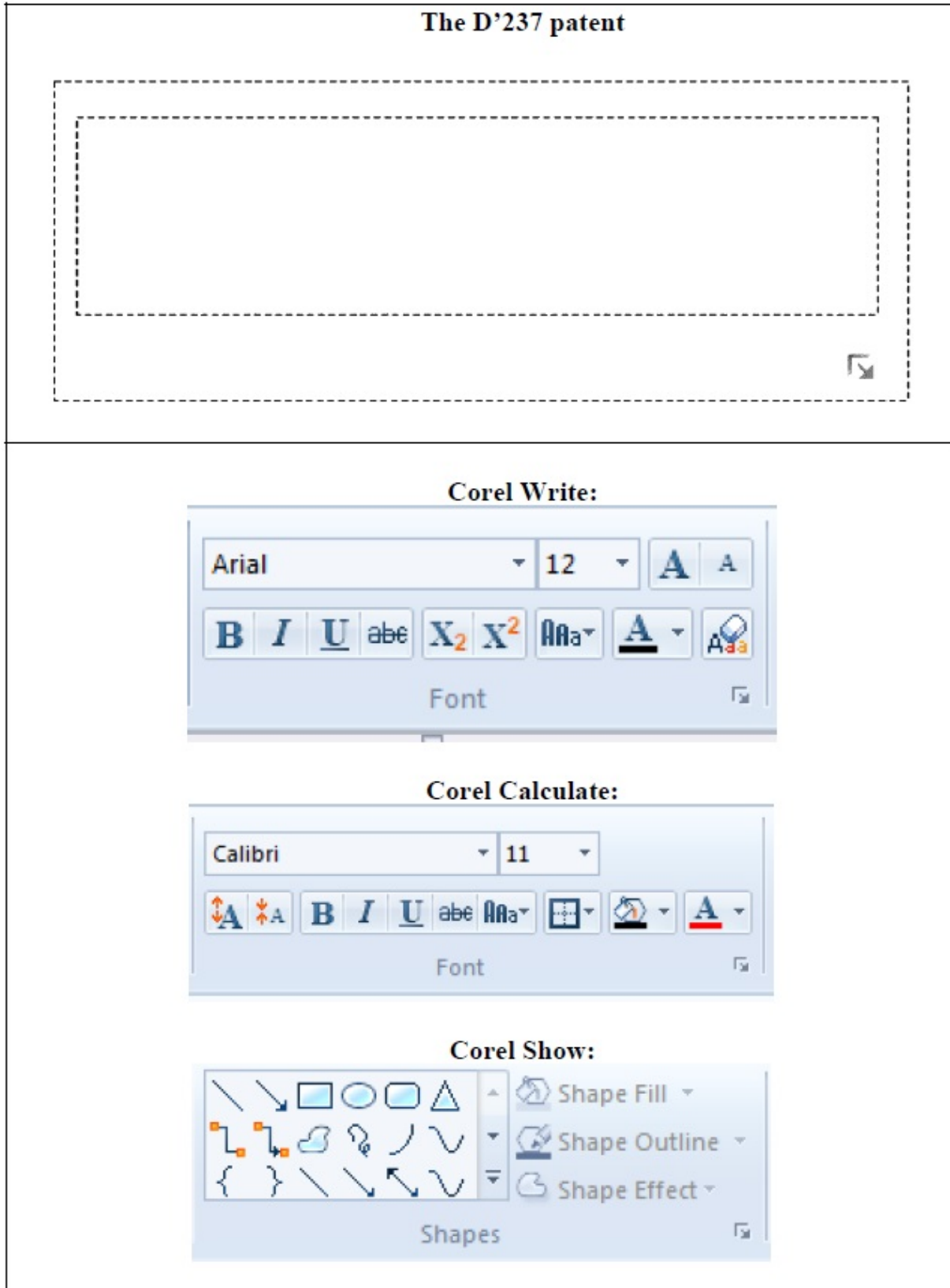
Microsoft Corporation ("Microsoft") filed [suit](#) against Corel Corporation and Corel Inc. ("Corel") in the Northern District Court of California, seeking to recover damages and costs for patent infringement.

In the complaint, Microsoft alleges Corel willfully infringes a number of Microsoft utility and design patents. In particular, Microsoft accuses Corel of infringing U.S. Patent Nos. 8,255,828 ("the '828 patent"); 7,703,036 ("the '036 patent"); 7,047,501 ("the '501 patent"); 5,715,415 ("the '415 patent"); 5,510,980 ("the '980 patent"); [D550,237](#) ("the D'237 patent"); [D554,140](#) ("the D'140 patent"); [D564,532](#) ("the D'532 patent"); and [D570,865](#) ("the D'865 patent"), all relating to aspects of graphical user interfaces ("GUIs") used in productivity software applications, such as Microsoft Office.

The four design patents forming the basis for part of the complaint are directed to "ornamental designs for parts of Microsoft user interfaces, including the Microsoft Ribbon" and, according to Microsoft, "Corel's advertising makes the copied Microsoft interfaces one of the central selling points of Corel's products: 'With a familiar Ribbon-style interface, Corel® Office looks like the office software you're used to, making it easy to get to work right away.'"

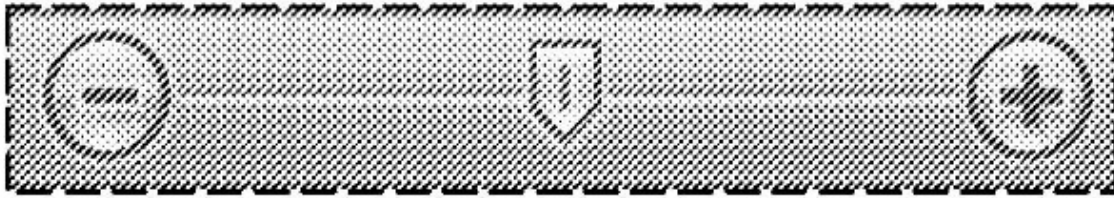
Accused Corel products associated with the asserted design patents include CorelCAD 2014-2016 and Corel Home Office, which includes Corel Write, Corel Calculate, and Corel Show.

Regarding the D'237 patent, entitled "User Interface for a Portion of a Display Screen," the complaint provides a comparison of the claimed design and certain aspects of accused Corel Home Office products.

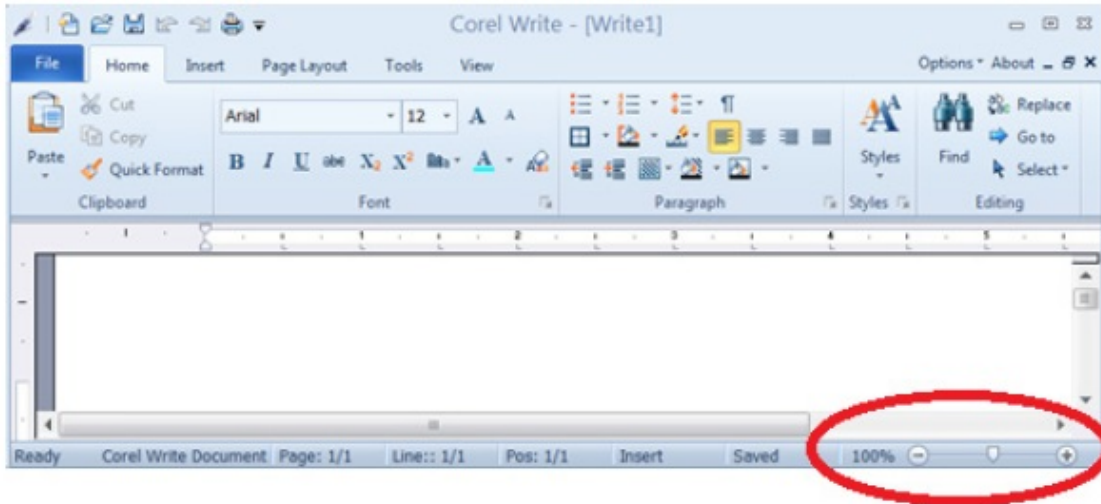


Regarding the D'140 patent, also entitled "User Interface for a Portion of a Display Screen," the complaint provides the claimed design in comparison with aspects of accused Corel Home Office products.

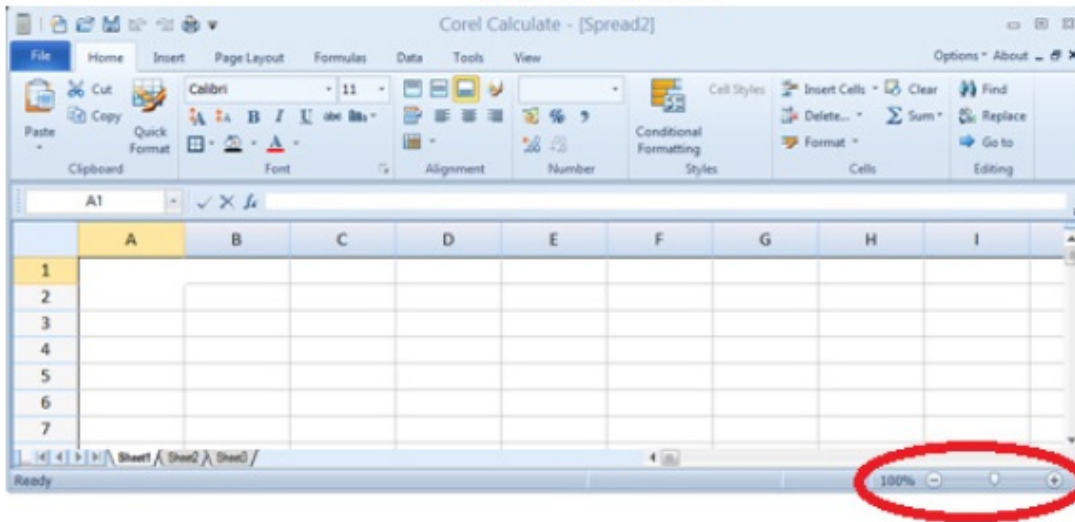
The D'140 patent



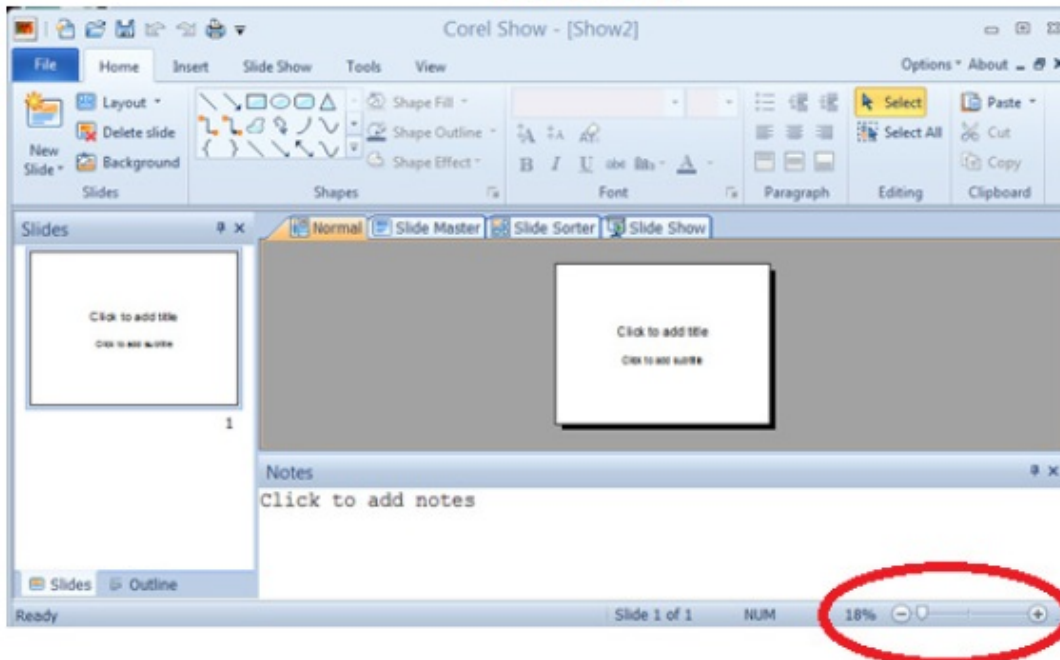
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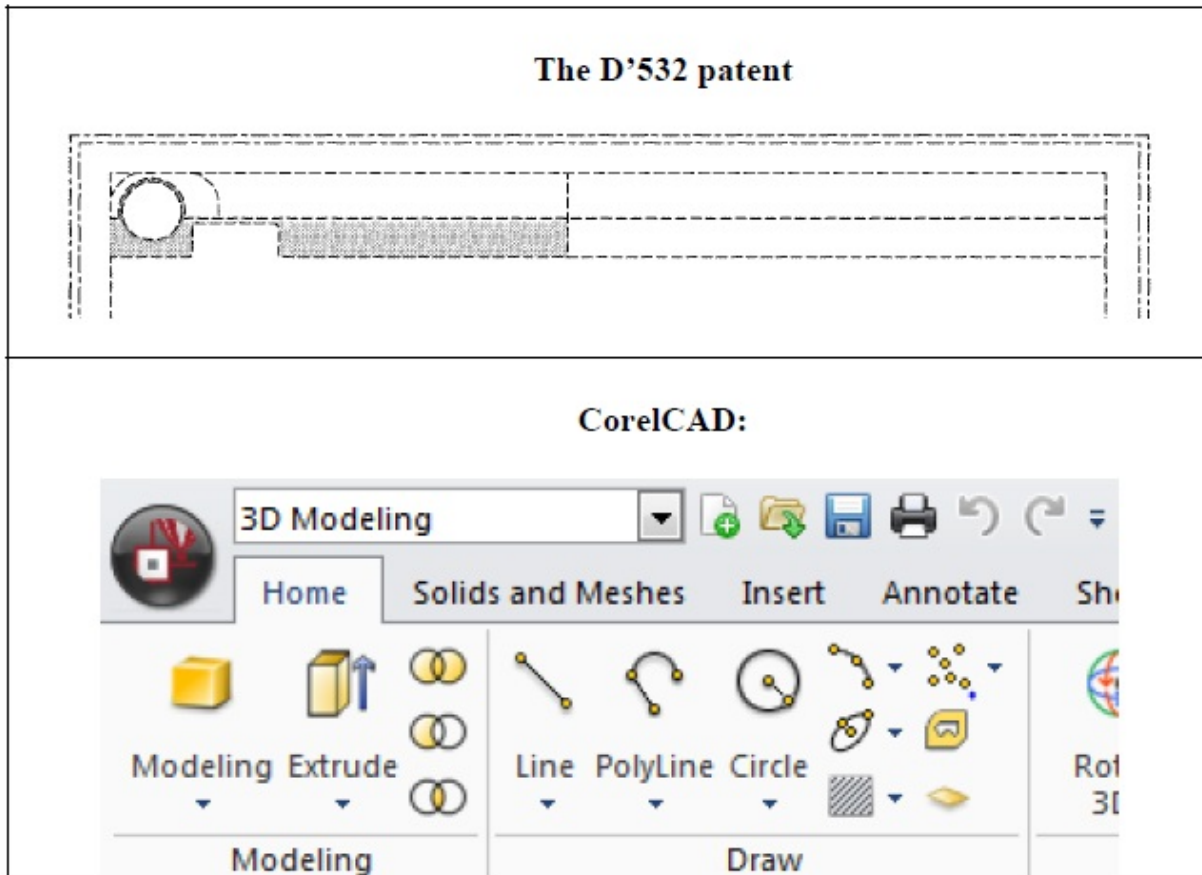
Corel Calculate:



Corel Show:

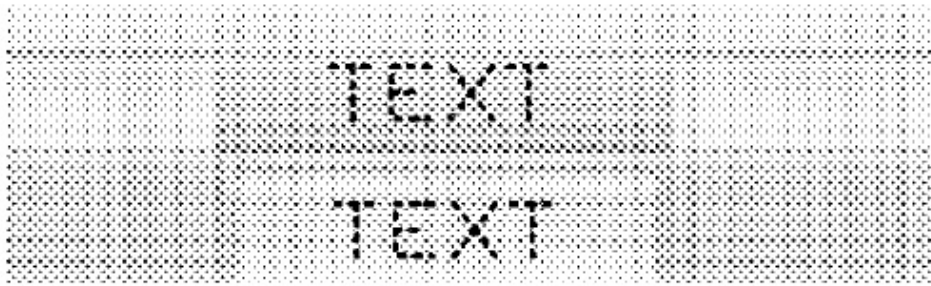


The complaint also provides a figure from the D'532 patent, which is entitled "User Interface for a Portion of a Display Screen," matched with an aspect of CorelCAD 2014-2016.



Regarding the D'865 patent, entitled "User Interface for a Portion of a Display Screen," the complaint provides the claimed design in comparison with aspects of accused Corel Home Office products.

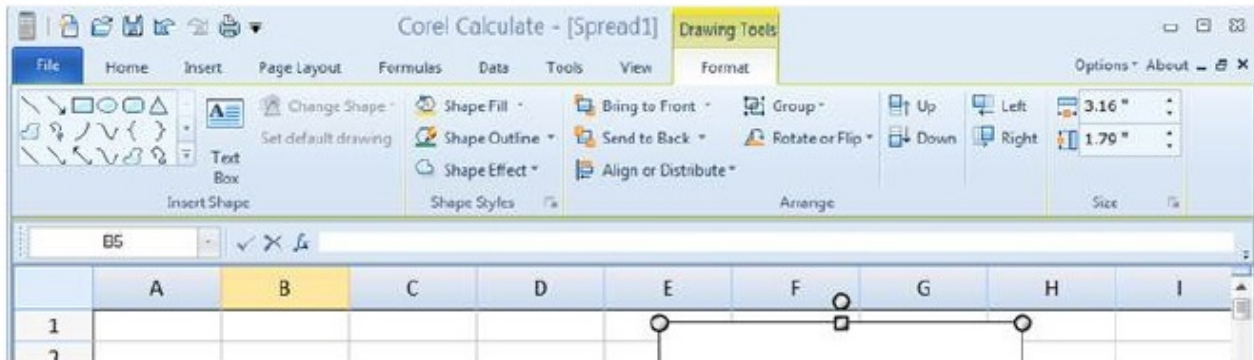
The D'865 patent



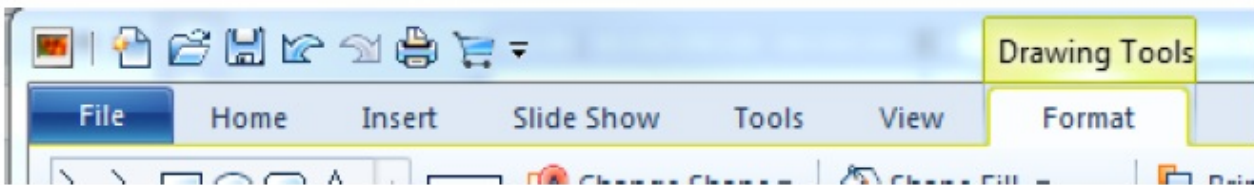
Corel Write:



Corel Calculate:



Corel Show:



Tags: Complaint, Design Patents, District Court, Patent Infringement, Utility Patents, Filings and Decisions

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PROTECTING DESIGNS

Nike Files Suit Against Skechers Alleging Infringement of Eight Design Patents

BY DAVID NGUYEN | FEBRUARY 1, 2016

NIKE, Inc. (“Nike”) filed suit against Skechers U.S.A., Inc. (“Skechers”) on January 4, 2016 in the United States District Court for the District of Oregon, Portland Division, seeking to recover damages and costs from Skechers. In the [complaint](#), Nike alleges Skechers infringes eight Nike design patents issued between January 7, 2014 and March 31, 2015 pertaining to shoe “uppers” and shoe soles (see Table 1 below from the complaint).

Table 1: The NIKE Patents

U.S. Patent Number	Title	Issue Date of Patent	Complaint Exhibit
D696,853 (the “853 Patent”)	Shoe Upper	January 7, 2014	A
D700,423 (the “423 Patent”)	Shoe Upper	March 4, 2014	B
D707,032 (the “032 Patent”)	Shoe Upper	June 17, 2014	C
D723,772 (the “772 Patent”)	Shoe Sole	March 10, 2015	D
D723,781 (the “781 Patent”)	Shoe Sole	March 10, 2015	E
D723,783 (the “783 Patent”)	Shoe Sole	March 10, 2015	F
D725,356 (the “356 Patent”)	Shoe Sole	March 31, 2015	G
D725,359 (the “359 Patent”)	Shoe Sole	March 31, 2015	H

The accused infringing products from Skechers include, but are not limited to, the Burst, Girl’s and Women’s Flex Appeal, Boy’s and Men’s Flex Advantage models of shoes. Tables 2 through 9 below (reproduced from the complaint) offer comparisons between the patent figures and the exemplary infringing products.







Table 2: Comparison of '853 Patent with Exemplary Infringing Shoes	
'853 Patent Figures	Exemplary Infringing Shoes
 <p>FIG. 1</p>	 <p>Women's Burst</p>  <p>Men's Burst</p>
 <p>FIG. 2</p>	 <p>Women's Burst</p>  <p>Men's Burst</p>







Table 3: Comparison of '423 Patent with Exemplary Infringing Shoes	
'423 Patent Figures	Exemplary Infringing Shoes
 <p>FIG. 1</p>	 <p>Women's Burst</p>  <p>Men's Burst</p>
 <p>FIG. 2</p>	 <p>Women's Burst</p>  <p>Men's Burst</p>






Table 4: Comparison of '032 Patent with Exemplary Infringing Shoes	
'032 Patent Figures	Exemplary Infringing Shoes
 FIG. 2	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  Women's Burst </div> <div style="text-align: center;">  Men's Burst </div> </div>
	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  Women's Burst </div> <div style="text-align: center;">  Men's Burst </div> </div>

Table 5: Comparison of '772 Patent with Exemplary Infringing Shoes	
'772 Patent Figures	Exemplary Infringing Shoes
 FIG. 2	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  Women's Flex Appeal </div> <div style="text-align: center;">  Men's Flex Advantage </div> </div>
	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  Girls' Skech Appeal </div> <div style="text-align: center;">  Boys' Flex Advantage </div> </div>
 FIG. 5	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  Women's Flex Appeal </div> <div style="text-align: center;">  Men's Flex Advantage </div> </div>
	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  Girls' Skech Appeal </div> <div style="text-align: center;">  Boys' Flex Advantage </div> </div>











Table 6: Comparison of '781 Patent with Exemplary Infringing Shoes	
'781 Patent Figures	Exemplary Infringing Shoes
 <p>FIG. 1</p>	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>Women's Flex Appeal</p> </div> <div style="text-align: center;">  <p>Men's Flex Advantage</p> </div> </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;">  <p>Girls' Skech Appeal</p> </div> <div style="text-align: center;">  <p>Boys' Flex Advantage</p> </div> </div>
 <p>FIG. 3</p>	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>Women's Flex Appeal</p> </div> <div style="text-align: center;">  <p>Men's Flex Advantage</p> </div> </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;">  <p>Girls' Skech Appeal</p> </div> <div style="text-align: center;">  <p>Boys' Flex Advantage</p> </div> </div>






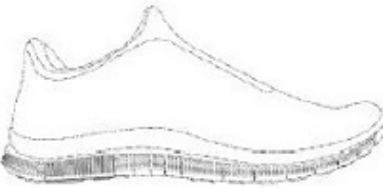




Table 7: Comparison of '783 Patent with Exemplary Infringing Shoes	
'783 Patent Figures	Exemplary Infringing Shoes
 <p>FIG. 1</p>	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>Women's Flex Appeal</p> </div> <div style="text-align: center;">  <p>Men's Flex Advantage</p> </div> </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;">  <p>Girls' Skech Appeal</p> </div> <div style="text-align: center;">  <p>Boys' Flex Advantage</p> </div> </div>
 <p>FIG. 3</p>	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>Women's Flex Appeal</p> </div> <div style="text-align: center;">  <p>Men's Flex Advantage</p> </div> </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;">  <p>Girls' Skech Appeal</p> </div> <div style="text-align: center;">  <p>Boys' Flex Advantage</p> </div> </div>

Table 8: Comparison of '356 Patent with Exemplary Infringing Shoes	
'356 Patent Figures	Exemplary Infringing Shoes
 <p>FIG. 2</p>	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>Women's Flex Appeal</p> </div> <div style="text-align: center;">  <p>Men's Flex Advantage</p> </div> </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;">  <p>Girls' Skech Appeal</p> </div> <div style="text-align: center;">  <p>Boys' Flex Advantage</p> </div> </div>
 <p>FIG. 5</p>	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>Women's Flex Appeal</p> </div> <div style="text-align: center;">  <p>Men's Flex Advantage</p> </div> </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;">  <p>Girls' Skech Appeal</p> </div> <div style="text-align: center;">  <p>Boys' Flex Advantage</p> </div> </div>

Table 9: Comparison of '359 Patent with Exemplary Infringing Shoes	
'359 Patent Figures	Exemplary Infringing Shoes
 <p>FIG. 2</p>	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>Women's Flex Appeal</p> </div> <div style="text-align: center;">  <p>Men's Flex Advantage</p> </div> </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;">  <p>Girls' Skech Appeal</p> </div> <div style="text-align: center;">  <p>Boys' Flex Advantage</p> </div> </div>
 <p>FIG. 5</p>	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>Women's Flex Appeal</p> </div> <div style="text-align: center;">  <p>Men's Flex Advantage</p> </div> </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;">  <p>Girls' Skech Appeal</p> </div> <div style="text-align: center;">  <p>Boys' Flex Advantage</p> </div> </div>

Nike is seeking judgment against Skechers, including a permanent injunction of the infringement described in the suit, and recovery of damages and expenses from Skechers.

Tags: Complaint, Design Patents, District Court, Fashion Designs, Patent Infringement, Filings and Decisions

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