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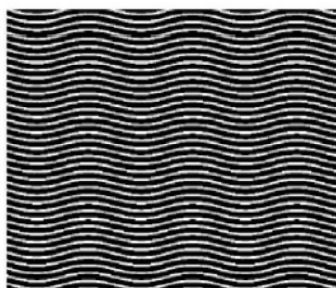
## SCOPE OF PRIOR ART IN DESIGN PATENTS

By [Kien Le](#)

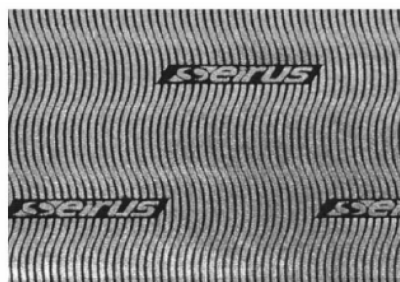
[Columbia Sportswear N. Am, Inc. v. Seirus Innovative Accessories, Inc.](#), Appeal No. 2021-2299 (Fed. Cir., September 15, 2023, [Prost](#), Reyna, and Hughes, precedential)

- To qualify as comparison prior art in a design-patent infringement analysis, a prior art design must be applied to the same article of manufacture identified in the claim.
- 디자인 특허 침해 분석에서 비교 선행기술로 인정받기 위해서는 선행기술 디자인이 청구항에 명시된 것과 동일한 제조물에 적용되어야 한다.
- 为了在外观设计专利侵权分析中符合比较现有技术的资格，必须将现有技术设计应用于权利要求中指定的相同产品。
- 意匠特許侵害解析において比較先行技術として適格となるためには、先行技術意匠が、クレームにおいて特定されたものと同じ製造品に適用されていなければならない。
- District courts are in the best position to decide whether and when to provide jury instructions on the effect of a logo in a design-patent infringement case.
- 디자인 특허 침해 소송에서 로고의 효력에 대한 배심원 지시를 제시할지 여부와 제시 시기를 결정하는 데 가장 적절한 위치에 있다.
- 在外观设计专利侵权案中，地方法院最适合决定是否以及何时就商标的效果向陪审团提供指示。
- 意匠特許侵害訴訟においてロゴの効果に対する陪審への指示を提示するかどうかおよびいつ提示するかを決定する地位として、地方裁判所が最善である。

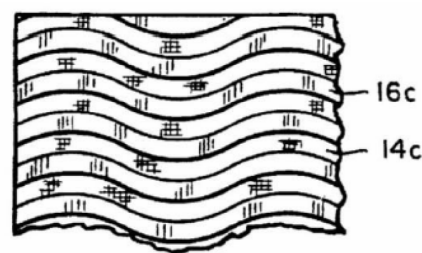
Columbia sued Seirus for infringing Columbia's U.S. Design Patent No. D657,093. The patent claims the ornamental design of a heat reflective material having continuous wavy patterns. Seirus's accused infringing products include similar wavy patterns *plus* Seirus's logo arranged at intervals to disrupt the wavy patterns. The District Court disregarded Seirus's logo completely, excluded certain comparison prior art submitted by Seirus as being far afield, and granted summary judgment of infringement. The various designs at issue are shown below.



Columbia's D'093 patent



Seirus's HeatWave



'949 patent

On appeal in *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119 (Fed. Cir. 2019) (“*Columbia I*”), the United States Court of Appeals for the Federal Circuit (“CAFC”) vacated and remanded, finding that the District Court improperly ignored Seirus's logo and that certain facts should have been left to a jury. In the remand trial before a jury, the District Court declined to provide the jury any standard by which to decide what is properly considered comparison prior art for a design, and refused to give jury instructions implicating Seirus's logo. The jury found no infringement. Columbia appealed, challenging the District Court's jury instructions on both comparison prior art and Seirus's logo (“*Columbia II*”).

The issue of comparison prior art is related to the ordinary-observer test for design-patent infringement. Two designs are substantially the same if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the resemblance between the two designs is such as to deceive such an ordinary observer, inducing him to purchase one supposing it to be the other. *See, Gorham Co. v. White*, 81 U.S. 511 (1871). In cases where the claimed and accused designs are not plainly dissimilar, the ordinary-observer test should be applied with reference to prior-art designs (i.e., comparison prior art) which provide a frame of reference to highlight distinctions and/or similarities between the claimed and accused designs. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676 (Fed. Cir. 2008) (en banc). In *Columbia II*, CAFC held that to qualify as comparison prior art, a prior-art design must be applied to the article of manufacture identified in the claim. This is the same standard for anticipatory prior art in a design-patent patentability analysis. Here, the article of manufacture identified in Columbia's patent claim is "a heat reflective material," and therefore, proper comparison prior art must be applied to a heat reflective material. CAFC agreed with Columbia that the District Court erred by failing to instruct the jury as to the scope of the patent claim (design for a heat reflective material) and the proper scope of comparison prior art. For this reason, CAFC vacated and remanded for the District Court to reconsider the comparison prior art issue. CAFC hinted that "heat reflective material" connotes something genuinely distinct from just *any* material, but left it to the District Court on remand to construe the term.

The logo issue implicates distinctions between trademark (including trade-dress) law and design-patent law. Trademark infringement requires that consumers will likely be confused as to a product's source. *See, Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003). A distinctive logo can be significant evidence that there will be no consumer confusion as to source. However, design-patent infringement does not consider consumer confusion as to source, and such infringement is not avoided by

labelling. *See, Columbia I*, 942 F.3d at 1131. Just because consumers might not be confused about an accused product's source (due to its logo), that alone would not preclude an ordinary observer from deeming the claimed and accused designs similar enough to constitute design-patent infringement. Conversely, 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. With these legal principles, CAFC found no error in the District Court's jury instructions which included no instructions related to Seirus's logo. CAFC stated that district courts are in the best position to decide whether and when to provide jury instructions on the effect of a logo in a design-patent infringement case.

This case establishes a clear standard for determining the scope of comparison prior art in a design-patent infringement analysis. It further confirms that the effect of a logo in a design-patent infringement analysis is to be decided on a case-by-case basis, and clarifies that district courts have discretion to decide whether and when to provide jury instructions regarding logos in design-patent infringement cases.

## TREATMENT OF OBJECTIVE EVIDENCE OF NONOBVIOUSNESS

By [Nick Fan](#)

[Volvo Penta of the Americas, LLC v. Brunswick Corp.](#), Appeal No. 2022-1765

(Fed. Cir., August 24, 2023, [Moore](#), Lourie, and Cunningham, precedential)

- Discounting the probative weight of objective evidence of non-obviousness must be supported by substantial evidence.
- 비자명성의 객관적 증거의 중요도를 낮추기 위해서는 실질적인 증거에 의해 뒷받침되어야 한다.
- 降低非显而易见性客观证据的证明力必须有实质性证据的支持。
- 非自明性の客観的証拠の重視度を下げさせるためには実質的な証拠にサポートされていなければならない。
- Presumption that objective evidence of non-obviousness has the requisite nexus with the challenged claim must be supported by more than conclusory statements that a product embodies the challenged claim and is coextensive with it, or that the objective evidence is a direct result of the claimed features.
- 비자명성의 객관적 증거가 의심스러운 청구항과 필수적인 연관성이 있다는 추정은, 어떤 제품이 이의 제기된 청구항을 구현하고 있고 그것과 공존한다는 단정적인 진술, 또는 객관적 증거가 청구된 특징의 직접적인 결과라는 것 이상의 진술에 의해 뒷받침되어야 한다.
- 非明显性的客观证据与被质疑的权利要求具有必要联系的推定·所必须得到支持应不仅仅是以结论性的陈述作为支持·即产品体现了被质疑的权利要求并与其具有共同范围·或者客观证据是权利要求特征的直接结果。
- 非自明性の客観的証拠が疑義あるクレームと必須の結びつきがあるという推定は、ある製品が疑義あるクレームを実施化したものでありそれと同一の広がりを持つあるいは客観的証拠がクレームされた特徴の直接の結果である、というような推論による陳述を超えてサポートされていなければならない。

## Background:

Volvo Penta (“VP”) appeals from a final written decision of USPTO Patent Trial and Appeal Board (“the Board”) holding all claims, claims 1–18, of U.S. Patent 9,630,692 unpatentable as obvious.

The ’692 patent, assigned to VP, is directed to a tractor-type stern drive for a boat. Brunswick petitioned for inter partes review of all claims of the ’692 patent. Brunswick asserted that the challenged claims would have been anticipated or obvious based on several references. VP argued that a person of ordinary skill in the art would not have been motivated to combine the references with a reasonable expectation of success and that the objective indicia of non-obviousness overcame any prima facie case of obviousness. The Board concluded claims 1–18 would have been obvious over the cited references.

## Holding:

The Board failed to properly consider the evidence of objective indicia of non-obviousness, even though the Board’s finding of a motivation to combine is supported by substantial evidence. The case is vacated and remanded.

## Discussion:

Objective evidence of non-obviousness includes: (1) commercial success, (2) copying, (3) industry praise, (4) skepticism, (5) long-felt but unsolved need, and (6) failure of others. For objective evidence of non-obviousness to be relevant, the evidence must have nexus with the challenged claim. Commercial evidence of success is entitled to a presumption of nexus where it is shown that a product that is the subject of the commercial evidence embodies the claim and is coextensive with it, or that the success is a direct result of claimed features. To the extent that any objective evidence of non-obviousness is discounted, substantial evidence must support such weighting.

The Federal Circuit agreed with VP that the Board’s analysis of objective evidence of non-obviousness, including its decision to ignore VP’s showing of direct nexus and assignments of weight to different considerations, lacked support of substantial evidence. The Federal Circuit found that, although VP failed to support a presumption of nexus between the challenged claims and the objective evidence of non-obviousness, VP’s evidence showed direct nexus between the objective evidence of non-obviousness and claimed features. The Board, however, improperly found that VP had failed to identify the unique characteristics or merits of the claims alleged to have nexus with the objective evidence. Finding that VP had indeed identified such characteristics, the Federal Circuit found the Board’s decision to discount VP’s showing of nexus as lacking support of substantial evidence.

VP demonstrated several categories of non-obviousness evidence, but the Board discounted the weight of VP’s objective evidence without sufficient explanation or support of substantial evidenced. The Board’s assignment of only “some weight” to the evidence of copying was not supported by substantial evidence. The Board found no evidence detracting from its finding of commercial success. The Board failed to sufficiently explain and support the proper weight it should give to the factors, such as industry praise, commercial success, and copying. The Board failed to properly evaluate long-felt but unresolved need. The Board failed to provide any explanation for its conclusion that “Patent Owner’s objective evidence weighs somewhat in favor of nonobviousness” but that Brunswick’s “strong evidence of obviousness outweighs Patent Owner’s objective evidence of nonobviousness.” The Federal Circuit concluded that the Board failed

to properly consider the evidence of objective indicia of non-obviousness, and that its conclusion of obviousness was not supported by substantial evidence.

## ARGUING NON-ANALOGOUS FIELD OF ENDEAVOR IN OBVIOUSNESS CHALLENGES

By [David Lynch](#)

[Netflix, Inc. v. DIVX, LLC](#), Appeal No. 2022-1138

(Fed. Cir., September 11, 2023, Hughes, Stoll, and Stark, precedential)

- An argument asserting overlapping field of endeavor in a patent invalidity analysis does not fail merely by neglecting to articulate the words “field of endeavor,” where the argument, considered as a whole, nonetheless alleges a field of endeavor.
- 특허 무효 분석에서 분야(field of endeavor)가 중복된다는 주장은 단순히 "분야"라는 단어를 분명히 명시하지 않았다고 해서 주장의 설득력이 없는 것이 아니다. 그 주장을 전체적으로 고려하면, 여전히 어떤 “분야” 를 주장하고 있는 것이다.
- 在专利无效分析中主张重叠努力领域的论点并不仅仅因为忽略了对“努力领域”这个词的阐明而失败，而从整体上看，该论点仍然主张一个努力领域。
- 特許無効の解析において、努力分野に重なりがあると主張する反論は、“努力の分野”という言葉をも、単純に軽視しているということのみによって、明瞭にすることに失敗しているわけではない。そこでは、その反論を全体として考慮すれば、ある努力分野をそれでもなお主張している。

Netflix petitioned for Inter-Partes Review (“IPR”) of the claims of U.S. Patent No. 8,472,792 (“the ‘792 patent”), a DivX patent relating to encoding, transmission, and decoding of multimedia files. Netflix asserted that the challenged claims would have been obvious in view of prior art patents to Zetts and Kaku. During the IPR, DivX relied on expert testimony to argue that Kaku is non-analogous art. Netflix responded that both the DivX patent and Kaku concern AVI files as well as encoding and decoding multimedia files. The Board ruled that Netflix failed to show that Kaku is analogous art because Netflix did not identify the field of endeavor for either the DivX patent or Kaku. Netflix appealed.

The Court of Appeals for the Federal Circuit explained that there are two separate tests to define the scope of analogous art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if not within the field of endeavor, whether the reference still is reasonably pertinent to the particular problem addressed by the inventor.

The court first considered the same field of endeavor test. The Federal Circuit found that, although Netflix did not articulate a field of endeavor using those exact “magic” words, Netflix identified two alternative theories for what it viewed as the overlapping fields of endeavor of Kaku and the ‘792 patent—“AVI files” or “encoding and decoding multimedia files.” The court noted statements by Netflix, in its reply brief before the Board, that “Kaku must be considered for the AVI teachings” and that “Kaku includes embodiments directed to particular implementations of the AVI file format.” The court also noted statements by Netflix in its reply brief that the ‘792 patent includes “encoding...and decoding of multimedia files,” and that Kaku teaches “encoding...and decoding” for image data in AVI files. The Federal Circuit disagreed with the Board’s unduly rigid view of the requirements for alleging field of endeavor. Thus, explaining that, even where a petitioner does not explicitly define a field of endeavor, its briefing may

nonetheless present an argument on that issue when taken as a whole, the Federal Circuit found that the Board had erred by imposing a higher burden than that required by precedent, and remanded the question to the Board to consider overlapping fields of endeavor including the arguments submitted by Netflix.

Turning to the reasonably pertinent test, the Federal Circuit held that substantial evidence supports the Board's conclusion that Kaku is not reasonably pertinent to the problem addressed by the '792 patent. The Board had found that Kaku addressed a different problem than that addressed by the DivX patent. Noting that the claims consistently recite key elements found nowhere in Kaku, and crediting expert witness testimony that Kaku and the '792 patent address different problems, the Federal Circuit ruled that the Board's finding that Kaku is not reasonably pertinent to the problem addressed by the '792 patent is not unreasonable.

## ADDITIONAL INFORMATION

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