

18-1329, -1331, -1728

United States Court of Appeals for the Federal Circuit

COLUMBIA SPORTSWEAR NORTH AMERICA, INC.,
an Oregon Corporation,
Plaintiff - Appellant,

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.,
a Utah Corporation,
Defendant - Cross-Appellant.

**Appeal from the United States District Court for the Southern District of
California in No. 3:17-cv-01781-HZ, Judge Macro A. Hernandez**

**BISON DESIGN, LLC AND GOLIGHT, INC.'S MOTION FOR LEAVE TO
FILE AN *AMICUS CURIAE* BRIEF IN SUPPORT OF PETITION FOR
REHEARING AND REHEARING *EN BANC* OF PLAINTIFF-APPELLANT**

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*Counsel for Amicus Curiae
Bison Designs, LLC
Golight, Inc.*

Dated: January 27, 2020

Pursuant to Federal Rules of Appellate Procedure 29 and 35, and Federal Circuit Rule 35, Bison Designs, LLC (“Bison”) and Golight, Inc. (“Golight”)¹ respectfully move this Court for leave to file an *amicus curiae* brief in support of Plaintiff-Appellant Columbia Sportswear North America, Inc.’s (“Columbia”) petition for rehearing and rehearing *en banc* in the above-captioned matter.

STATEMENT OF CONSENT

Counsel for Columbia has indicated that it consents to this motion. Counsel for Defendant-Cross-Appellant Seirus Innovative Accessories, Inc. (“Seirus”) has indicated that it opposes this motion.

STATEMENT OF INTEREST

Bison is a Colorado limited liability company which sells belts, belt buckles, keychains, and other miscellaneous products. Bison owns over 150 U.S. design patents for its product designs. Golight is a Nebraska corporation which sells searchlights, work lights, and other lighting-related products. Golight owns approximately 15 U.S. design patents for its product designs. Amici have no personal interest in the outcome of this case, but do have an interest in seeing that the law, as it relates to design patents, develops in a clear and administrable way that serves its constitutional purpose.

¹ Bison and Golight are referred to collectively as “Amici” in this motion.

REASONS TO GRANT THIS MOTION

Amici's *amicus curiae* brief in support of Columbia's petition for rehearing *en banc* is desirable because the issues involved in this case are fundamental to the design patent system, namely, the standard for design patent infringement.

Amici's brief intends to present additional reasons, beyond those presented in the petition, regarding why this Court should grant *en banc* review to consider: (1) whether, when conducting a design-patent infringement analysis, a fact-finder may consider the addition of brand names or other labeling on an otherwise infringing design; and (2) whether when conducting a design-patent infringement analysis, a fact-finder should compare the overall appearance of the claimed design (i) to the overall appearance of the accused design, or (ii) to the overall appearance of the entire accused product, which may include aspects extraneous to the claimed design (e.g., logos, tradenames, color, size, etc.).

As explained fully in Amici's *amicus curiae* brief, the vague language of the panel opinion's in this case appears to create a sweeping new rule governing design patent infringement analysis. This new rule would have far reaching effects on design patent owners by creating a new, easy way to design around a valid design patent by placing a prominent "ornamental" logo on an otherwise infringing item. Considering logos as part of the infringement analysis is inconsistent with and confuses well-established precedent, and is detrimental to the distinct and

fundamental rights that design patents are intended to protect. Amici's *amicus curiae* brief will focus on providing the Court with a more complete perspective on what is at stake.

RELIEF REQUESTED

WHEREFORE, Bison and Golight respectfully request that the Court grant them leave to file an *amicus curiae* brief in support of Columbia's petition for rehearing and rehearing *en banc* in the above-captioned matter.

Respectfully submitted,

Dated: January 27, 2020

/s/Ian R. Walsworth

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FORM 9. Certificate of Interest

Form 9
Rev. 10/17**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc.Case No. 18-1329, -1331, -1728**CERTIFICATE OF INTEREST**

Counsel for the:

 (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)**Bison Designs, LLC and Golight, Inc.**

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
Bison Designs, LLC	None	None
Golight, Inc.	None	None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

None

FORM 9. Certificate of Interest

**Form 9
Rev. 10/17**

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

None

1/27/2020

Date

s/Ian R. Walsworth

Signature of counsel

Ian R. Walsworth

Printed name of counsel

Please Note: All questions must be answered

cc: _____

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**CERTIFICATE OF SERVICE**I certify that I served a copy on counsel of record on January 27, 2020,

by:

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- Fax
- Hand
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**Appeal from the United States District Court for the Southern District of
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**BISON DESIGNS, LLC AND GOLIGHT, INC.'S *AMICUS* BRIEF
IN SUPPORT OF PETITION FOR REHEARING**

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Golight, Inc.*

Dated: January 27, 2020

DISCLOSURE STATEMENT

There is no parent corporation or publicly held corporation that owns 10% or more of stock or interest in Bison Designs, LLC. *See* Fed. R. App. P. 26.1(a), 29(a)(4)(A).

There is no parent corporation or publicly held corporation that owns 10% or more of stock or interest in Golight, Inc. *See* Fed. R. App. P. 26.1(a), 29(a)(4)(A).

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IDENTITY AND INTEREST OF AMICUS CURIAE

Bison Designs, LLC (“Bison”) is a Colorado limited liability company which sells belts, belt buckles, keychains, and other miscellaneous products. Bison owns over 150 U.S. design patents for its product designs. Golight, Inc. (“Golight”) is a Nebraska corporation which sells searchlights, work lights, and other lighting-related products. Golight owns approximately 15 U.S. design patents for its product designs. Bison and Golight (collectively, “Amici”) have no personal interest in the outcome of this case, but do have an interest in seeing that the law, as it relates to design patents, develops in a clear and administrable way that serves its constitutional purpose.

No party or party’s counsel authored this brief in whole or in part. *See* Fed. R. App. P. 29(a)(4)(E)(i). No party, party’s counsel, or person—other than the amicus curiae, its members, or its counsel—contributed money that was intended to fund preparing or submitting this brief. *See* Fed. R. App. P. 29(a)(4)(E)(ii), (iii).

ARGUMENT

The panel opinion in *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, Nos. 2018-1329, 2018-1331, 2018-1728 (Fed. Cir. Nov. 13, 2019) (“*Columbia Sportswear*”) appears to create a sweeping new rule governing design patent infringement analysis. This new rule would have far reaching effects on design patent owners by creating a new, easy way to design around a valid

design patent by placing a prominent “ornamental” logo on an otherwise infringing item. Considering logos as part of the infringement analysis is inconsistent with and confuses well-established precedent, and is detrimental to the distinct and fundamental rights that design patents are intended to protect.

Specifically, the Court found that the district court erred by failing to consider whether the presence of Seirus’ logo on the accused product supported non-infringement. Slip Op. at 17. The panel opinion appears to directly contradict longstanding Supreme Court and Federal Circuit precedent that the analysis must focus only on the accused design—here a three-dimensional fabric pattern—and not the accused product inclusive of labeling (e.g., logos, brand names, tags, trademarks, etc.). See *Gorham v. White*, 81 U.S. 530 (1871); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993). This contradiction will have far reaching and unintended consequences for design patent law. The panel or full Court should reconsider this aspect of *Columbia Sportswear*.

I. *Columbia Sportswear* Appears to Present a Dramatic Departure from Longstanding Precedent

The Federal Circuit clearly explained and applied the Supreme Court’s *Gorham* precedent in its *L.A. Gear* decision. That decision correctly recognized the difference in trademark and design patent rights by expressly holding that clear and prominent labeling cannot avoid design patent infringement, even where that

labeling would dispel any confusion regarding the product's origin. *See L.A. Gear*, 988 F.2d at 1126, 1143.

Here, in opposing summary judgment on infringement, Seirus argued that various differences between the accused and patented designs—including that the waves in Seirus's design were interrupted by repeated use of Seirus's logo—should preclude judgment as a matter of law under the ordinary observer test. Slip Op. at 15-16 (summarizing Seirus' contentions). The district court considered and rejected most of Seirus' asserted differences between the actual wave patterns as “nearly imperceptible.” *Id.* at 16 (quoting the district court). The district court refused to consider the placement of Seirus' logo in its ordinary observer analysis, as logo presence or placement was not claimed in Columbia's patent. *Id.* at 15.

The district court cited the controlling precedent of *L.A. Gear* for the proposition that logos should be wholly disregarded in the infringement analysis. *Id.* at 17. *L.A. Gear* provides that “[t]he ultimate question requires determining ‘whether the effect of the whole *design* is essentially the same.’” *L.A. Gear*, 988 F.2d at 1125 (quoting *Gorham*, 81 U.S. at 530) (emphasis added). In *L.A. Gear*, the Court found design patent infringement under the ordinary-observer standard, and also, under a parallel Lanham Act analysis, that the prominent labeling of the brand name on the accused shoes would prevent any actual confusion. *Id.* at 1126, 1134. Specifically, the Court held that “[d]esign patent infringement relates solely

to the patented design, and does not . . . allow of avoidance of infringement by labelling.” *Id.* at 1126.

Columbia Sportswear purports to distinguish *L.A. Gear* on the basis that the parties to that case did not dispute copying or that the patented and accused designs were substantially similar. Slip Op. at 17. That copying and similarity were admitted there, however, were not the controlling facts that gave rise to the holding. They therefore do not provide reasonable bases for distinction. *L.A. Gear* expressly held that labeling is an extraneous feature that should not be considered during design patent infringement analysis. *L.A. Gear* has been interpreted to mean that logos and other features not claimed by the patented design do not inform the infringement analysis under diverse fact patterns where copying and similarity were not conceded. *See, e.g., Sun Hill Indus. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1196-97 (Fed. Cir. 1995); *Payless Shoesource, Inc. v. Reebok, Int’l, Ltd.*, 998 F.2d 985, 990 (Fed. Cir. 1993).

While *Columbia Sportswear* acknowledges that *L.A. Gear* held that infringement was not avoided “by labeling,” it then goes on to state:

But *L.A. Gear* does not prohibit the fact finder from *considering* an ornamental logo, its placement, and its appearance as one among other potential differences between a patented design and an accused one. Indeed, the fact finder is tasked with determining whether an ordinary observer would find the “effect of the whole design substantially the same.” *Gorham*, 81 U.S. at 530. It would be inconsistent with this mandate to ignore elements of the accused design entirely, simply because those elements included the name of the defendant.

Slip Op. at 17 (emphasis in original). The panel opinion thus appears to limit the holding of *L.A. Gear* to brand labels, as opposed to “ornamental logos” that are “part” of the accused design. On the other hand, if the panel opinion is based on the fact that copying was admitted in *L.A. Gear*, then all the current ruling will do is ensure that copying is never admitted.

L.A. Gear is not so limited. The Court there clearly considered and *accepted* the argument that the prominent placement of the infringer’s trademark on an accused product would adequately differentiate the product in the eyes of customers under a *trademark* infringement analysis, but *rejected* that same argument in its *design patent* infringement analysis. *Columbia Sportswear’s* attempt to narrow the holding of *L.A. Gear* is a significant change in the law that is not properly undertaken by a later panel. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988).

If, as *Columbia Sportswear* states, the placement of an ornamental logo may be considered as one among other potential differences in the infringement analysis, then the presence of the ornamental logo may become the deciding factor where the differences between the designs are not otherwise substantial. If, however, as *L.A. Gear* commands, infringement cannot be avoided by labeling, then the presence of an ornamental logo—which is a form of label—cannot, itself, be a factor that weighs against infringement. By suggesting the contrary, the panel

opinion creates unnecessary confusion surrounding the proper treatment of products that incorporate labels, ornamental logo or not, into otherwise similar designs.

II. Precedent Holds that the Accused Design is Only Compared to the Claimed Design Without Regard to Unclaimed Features

Apart from the conflict with the specific rule of *L.A. Gear*, the panel opinion also appears to conflict with the more general rule that, for a proper infringement analysis, an accused design must be compared to the claimed design without considering extraneous unclaimed features. This principle is well-established in design patent jurisprudence. *See, e.g., Sun Hill Indus.*, 48 F.3d at 1197 (providing that a fact finder must “carefully confine its comparison only to the claimed features, and not to unclaimed features, of the commercial embodiment”).

For example, in *Payless*, the district court denied Reebok’s request for a preliminary injunction, finding that one of the accused Payless shoes was distinguishable because it “had additional black coloring and did not have the logo ‘PUMP’ that is printed on the orange basketball on the tongue of the Reebok shoe.” *Payless Shoesource*, 998 F.2d at 987, 990. Another accused shoe was distinguished because its tongue included an orange basketball, which was not present on Reebok’s commercial embodiment. *Id.* at 990. The *Payless* Court found that “the district court was improperly influenced by features extraneous to the claimed design and that its decision turned on those features.” *Id.* Thus, the

Court vacated the district court's ruling, explaining "[n]one of those cited features, however, is part of the claimed designs and thus they may not serve as a valid basis for comparison in a design patent infringement analysis." *Id.*

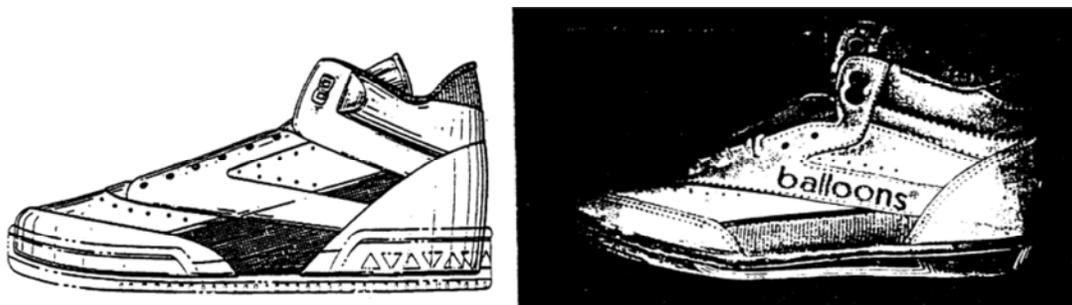
More recently, the district court in *Advantek* granted the defendant's motion for judgment on the pleadings on the ground that enforcement was barred under the prosecution history estoppel doctrine, finding the patentee had surrendered claim scope by electing a kennel embodiment without a cover in response to a restriction requirement, whereas the accused kennel included a cover. *Advantek Mktg. v. Shanghai Walk-Long Tools Co.*, 898 F. 3d 1210, 1213-15 (Fed. Cir. 2018). In reversing, this Court ruled that: "A competitor who sells a kennel embodying Advantek's patented structural design infringes the D'006 patent, regardless of extra features, such as a cover, that the competitor might add to its kennel." *Id.* at 1216-17.

Here, Columbia did not claim the placement of logos in the patent drawings. Therefore, uncertainty and confusion arises as to whether Seirus' logos comprise unclaimed extraneous features per the above case law.

III. Examples and Impact on Design Patent Stakeholders

As previously discussed, *Columbia Sportswear* appears to limit its holding with the phrase "ornamental logo" and thereby distinguish *L.A. Gear*, as the logo

in that case was in a simple type font. Figure 4 of L.A. Gear's design patent D299,081 and the accused article are provided below:



But it is unclear what distinguishes labelling from “ornamental logos.” Graphic designers may purposefully choose to use simple fonts as part of the design of a logo. Therefore, almost by definition, any logo that is placed on a product is ornamental, as it forms part of the ornamentation of the product.

Turning to examples of Amici's concerns regarding the unclear impact of *Columbia Sportswear*, Bison obtained design patent D455,642 for one of its many carabiner keychain products. Figure 1 of this patent, and an image of one commercial embodiment including a strap, keyring, and customer-specific engraving,¹ are provided below:



¹ Philmont is the name of one of the Boy Scouts of America's (BSA) ranches; the pictured product was made by Bison for the BSA with permission.

Under *Advantek*, this Court made clear that the strap and key ring added to the commercial embodiment would not change the infringement analysis. However, if the Court's ruling in *Columbia Sportswear* stands, then a logo, extraneous to the claimed design like the PHILMONT logo in Bison's commercial embodiment, should be considered in determining whether such an accused product infringes the patent.

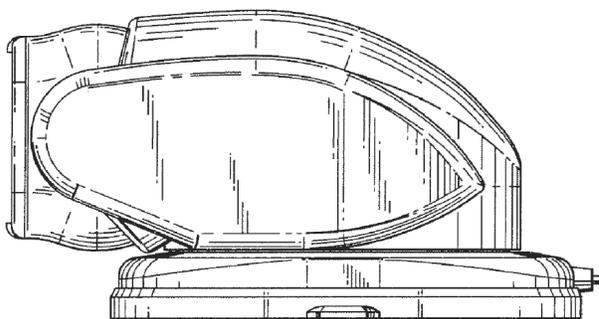
Columbia Sportswear is particularly problematic for companies like Bison, who sell into the promotional products' market.² Bison offers customer customization of its carabiner keychains and other products with an option to laser engrave company logos thereon. If such logos are considered in an infringement analysis, then this substantial market for Bison's products embodying patented designs will be vulnerable to increased infringement, as infringers can now claim that the addition of "ornamental" logos avoids infringement Bison's design patents under *Columbia Sportswear*.

Golight previously appeared before this Court in a case involving its utility patent infringement claim against Wal-Mart. *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F. 3d 1327 (Fed. Cir. 2004). There, this Court upheld the district court's

² Since 2000, Bison has sold more than 9 million "accessories" products which include both patented and non-patented designs, with over 5 million of these customized with engravings.

claim construction and finding of willful infringement. *Id.* at 1330-35, 1339.

Although that case involved a utility patent, Golight can readily envisage a scenario where Wal-Mart had infringed one of its design patents. In this scenario, the argument emerges under *Columbia Sportswear* that merely placing a logo on the side of one of Golight's patented products would allow Wal-Mart to escape infringement, or at least avoid a motion for summary judgment on infringement, thereby forcing Golight to litigate the issue of “*considering* an ornamental logo, its placement, and its appearance” through trial. Compare, for example, Figure 2 of Golight's design patent D582,084 and a mockup of such a potential accused product below:



Leveling the current ruling may add immense cost to the enforcement efforts of design patentees. In the past, Amici have been successful in enforcing their design patents through simple cease-and-desist letters and efficient settlement, as many such infringers had bought the accused products from overseas sellers without knowledge of Amici's patents. When made aware of the design patents,

the majority of opposing parties were willing to enter a settlement agreement promptly; the courts were never involved.

However, infringers now have an escape hatch to perhaps avoid liability in claiming that the addition of a logo comprises an “ornamental logo” within the meaning of *Columbia Sportswear*. Therefore, *Columbia Sportswear*’s departure from the clear rule of *L.A. Gear* has the very real potential to increase the cost of enforcement, with respect to both preliminary party discussions as well as litigation, where *Columbia Sportswear* may be used to avoid summary judgment on infringement and protract proceedings.

In the case of *Bison*, during the life of its most popular carabiner keychain patents—the star, heart and dog bone—more than fifty companies settled upon being informed of the design patents’ existence. The cost and resources required to pursue even a handful of these matters through litigation would be outside *Bison*’s means, or indeed many companies, which says nothing of the higher burden on the courts’ resources if such cases are increasingly litigated.

CONCLUSION AND RELIEF SOUGHT

Accordingly, *Columbia Sportswear* appears to represent a dramatic departure from established precedent. The vague language of the panel opinion conflicts with the previously-clear rule of *L.A. Gear* that infringers cannot escape liability by labelling, and with the more general rule that an accused design must

be compared to the claimed design without regard to unclaimed features.

Confusion and uncertainty thus arise as to meaning of *Columbia Sportswear* and its application moving forward, which will have a substantial impact on the integrity and reliability of the design patent system as well as the scope and value of design patent protection itself. This is particularly true for promotional products where the inclusion of different “ornamental” logos is, by definition, expected. And from a practical perspective, the current panel opinion in *Columbia Sportswear* invites the opportunity for more contentiousness resolutions in design patent enforcement efforts, which would increase the burden on both stakeholders and the courts. For at least these reasons, Amici respectfully request the Court address and clarify this aspect of *Columbia Sportswear*.

WHEREFORE, the panel or full Court should grant the petition for rehearing and clarify the extent to which the incorporation of a logo in a design may distinguish the overall design from a patent.

Respectfully submitted,

Dated: January 27, 2020

/s/Ian R. Walsworth

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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Ian R. Walsworth

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION,
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This brief contains [state the number of] 2,552 words, excluding the parts of the brief exempted by [Federal Rule of Appellate Procedure 32\(f\)](#), or

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s/Ian R. Walsworth

(Signature of Attorney)

Ian R. Walsworth

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Representing amici curiae Bison Designs, LLC and Golight, Inc.

(State whether representing appellant, appellee, etc.)

1/27/20

(Date)

Case Nos. 18-1329, -1331, -1728

**UNITED STATES COURT OF APPEALS
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Appeals from the United States District Court for the
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Judge Marco A. Hernandez

**INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, INC.’S
MOTION FOR LEAVE TO FILE AN *AMICUS CURIAE* BRIEF**

Pursuant to Federal Rules of Appellate Procedure 29 and 35, the INDUSTRIAL DESIGNERS SOCIETY OF AMERICA (“IDSA”) respectfully moves the Court for leave to file an amicus curiae in connection with Plaintiff-Appellant Columbia Sportswear North America, Inc.’s Combined Petition for Rehearing and Rehearing En Banc in Appeal Nos. 18-1329, -1331, -1728 (“Petition”).

Founded in 1965, IDSA is one of the oldest and largest membership associations for professional industrial designers. IDSA is a non-profit organization dedicated to improving industrial design knowledge and representing the industrial design profession to businesses, the government, and the public. IDSA has thousands of members in dozens of Student Chapters, Professional Chapters, and Special Interest Sections. IDSA also sponsors the annual International Design Excellence Awards® (IDEA), one of the world's most prestigious and rigorous design competitions. The IDSA's Design Protection Section is actively involved in monitoring and commenting on legal issues relating to design rights, and has been a sponsoring partner of the USPTO's annual Design Day event. Members of the Design Protection Section routinely speak at leading law schools, have testified before Congress on design rights issues, and have served as expert witnesses in hundreds of design-related cases, including those related to design patent law.

IDSA has a primary interest in the outcome of this matter based on its longstanding commitment to design rights issues. IDSA's specific interests in this case are to ensure that the design patent infringement analysis is administered in a way that fairly protects design innovation. Accordingly, IDSA respectfully asks this Court to grant its motion for leave to file an *amicus curiae* brief.

STATEMENT OF CONSENT

IDSA submits this motion with the consent of counsel for Plaintiff-Appellant Columbia Sportswear, Inc. IDSA also conferred with counsel for Defendant - Cross-Appellant, Seirus Innovative Accessories, Inc., but did not receive consent.

Respectfully submitted,

Dated: January 27, 2020

By: /s/ Damon A. Neagle

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Counsel for Amicus Curiae
INDUSTRIAL DESIGNERS SOCIETY
OF AMERICA

CERTIFICATE OF INTEREST

Counsel for the *Amicus Curiae*, INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, INC. (“IDSA”), certifies the following:

1. The full name of every party represented by me is: INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, INC.
2. The name of the real party in interest represented by me is: INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, INC.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the parties represented by me are:
n/a
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n/a

January 27, 2020

/s/ Damon A. Neagle

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Case Nos. 18-1329, -1331, -1728

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

**COLUMBIA SPORTSWEAR NORTH AMERICA, INC.,
an Oregon corporation,**

Plaintiff - Appellant,

v.

**SEIRUS INNOVATIVE ACCESSORIES, INC.,
a Utah corporation,**

Defendant - Cross-Appellant.

Appeals from the United States District Court for the
Southern District of California in No. 3:17-cv-01781-HZ,
Judge Marco A. Hernandez

[PROPOSED] ORDER

On consideration of the INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, INC. (“IDSA”) motion for leave to file an *amicus curiae* brief in connection with the Plaintiff-Appellant Columbia Sportswear North America, Inc.’s Combined Petition for Rehearing and Rehearing En Banc it is the **ORDER OF THIS COURT** that IDSA’s motion is GRANTED.

_____, 2020

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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(Name of Attorney)

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Case Nos. 18-1329, -1331, -1728

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Defendant - Cross-Appellant.

Appeals from the United States District Court for the
Southern District of California in No. 3:17-cv-01781-HZ,
Judge Marco A. Hernandez

**[PROPOSED] BRIEF OF AMICUS CURIAE INDUSTRIAL DESIGNERS
SOCIETY OF AMERICA, INC.'S IN SUPPORT OF THE PETITION FOR
REHEARING AND REHEARING EN BANC**

CERTIFICATE OF INTEREST

Counsel for the *Amicus Curiae*, INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, INC. (“IDSA”), certifies the following:

1. The full name of every party represented by me is: INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, INC.
2. The name of the real party in interest represented by me is: INDUSTRIAL DESIGNERS SOCIETY OF AMERICA, INC.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the parties represented by me are:
n/a
4. The names of all law firms and the partners or associates that appeared for the party or *amicus curiae* now represented by me in the trial court or agency or are expected to appear in this court are:
n/a
5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court’s decision in the pending appeal.
n/a

January 27, 2020

/s/ Damon A. Neagle

Signature of counsel

Damon A. Neagle

Printed Name of counsel

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STATEMENT OF INTEREST OF *AMICUS CURIAE*

Founded in 1965, the Industrial Designers Society of America (“IDSA”) is one of the oldest and largest membership associations for professional industrial designers. IDSA is a non-profit organization dedicated to improving industrial design knowledge and representing the industrial design profession to businesses, the government, and the public. IDSA has thousands of members in dozens of Student Chapters, Professional Chapters, and Special Interest Sections. IDSA also sponsors the annual International Design Excellence Awards® (IDEA), one of the world’s most prestigious and rigorous design competitions.

IDSA has a primary interest in the outcome of this matter based on its longstanding commitment to design rights issues. IDSA’s specific interests in this case are to ensure that the design patent infringement analysis is administered in a way that fairly protects design innovation. IDSA has no stake in any of the parties to this litigation or the result of this case.

IDSA submits this brief with the consent of counsel for Plaintiff-Appellant Columbia Sportswear, Inc.. IDSA also conferred with counsel for Defendant - Cross-Appellant, Seirus Innovative Accessories, Inc., but did not receive consent.

No party or party’s counsel authored this brief in whole or in part; no party or party’s counsel contributed money that was intended to fund preparing or submitting this brief; no person or entity other than the amicus curiae, its members,

or its counsel contributed money that was intended to fund preparing or submitting the brief.

BACKGROUND

The facts of this case are laid out in the Petitioner's brief. While the Panel's opinion addressed both utility patent and design patent issues, IDSA only takes issue with the latter. Specifically, this brief addresses the new directive in the Panel opinion that the fact-finder always consider branding on the accused product in the design patent infringement analysis, save for (rare) situations where copying is admitted.

ARGUMENT

I. AS A GENERAL RULE, BRANDING ON AN ACCUSED PRODUCT IS IRRELEVANT TO THE DESIGN PATENT INFRINGEMENT ANALYSIS.

As a general rule, branding on an accused product is irrelevant to the design patent infringement analysis. This Court's precedential opinion in *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993) stands for this important and foundational principle. The Panel opinion, however, (perhaps inadvertently) used language, which if taken at face value, requires branding on the accused product to be "considered" in the design patent infringement analysis in all cases, save those limited situations where copying is admitted. This Court should grant rehearing to (i) strike the Panel's attempt to limit *L.A. Gear* to only situations where copying is admitted, and (ii) restore the

fundamental general rule that branding on an accused product is irrelevant to the design patent infringement analysis.

A. **The Panel Opinion Wrongly Limits the Reach of *L.A. Gear* to Only Situations Where Copying is Admitted.**

The Panel opinion, taken at face value, appears to emasculate this Court's foundational holding in *L.A. Gear* by limiting its reach to only those situations where copying is admitted. The troublesome paragraph in the Panel's opinion reads:

The district court relied on one precedent from this court – *L.A. Gear*—for the proposition that logos should be wholly disregarded in the design-infringement analysis. In that case, the parties did not dispute that the patented and accused designs were substantially similar. *L.A. Gear*, 988 F.2d at 1125. In fact, **“copying [was]admitted.”** Id. In evaluating infringement there, we explained that design infringement is not avoided “by labelling.” A would-be infringer should not escape liability for design patent infringement if a design **is copied** but labeled with its name. **But *L.A. Gear* does not prohibit the fact finder from considering an ornamental logo, its placement, and its appearance as one among other potential differences between a patented design and an accused one.**

(bold added, italics in original). Copying was not the hinge issue in *L.A. Gear* as to whether branding on the accused product is considered in the infringement analysis. *L.A. Gear* holding is not so limited; rather, it stands for a *much broader and important* general rule that branding on an accused product is

irrelevant to the design patent analysis. Without this general rule in place, *meaningful* U.S. design patent protection would crumble.

L.A. Gear is a good vehicle for explaining *why* branding on the accused product is not part of the design patent analysis. There, the defendant argued that the visual appearance of the branding should be considered in both the trade dress *and* design patent infringement analyses. *L.A. Gear*, 988 F.2d at 1126. The accused shoes included the branding “BALLOONS” on the side of the shoe upper:



Claimed Design



Accused Design

While the *L.A. Gear* court agreed that the branding was relevant to *trade dress* infringement analyses, the court, without qualification, rejected this argument for assessing infringement of the design patent claims:

[d]esign patent infringement relates solely to the patented design, and does not ... allow for avoidance of infringement by labeling.

Id. at 1126. The scope of *L.A. Gear* was not contingent on copying, and nor should it be. Copying is irrelevant for proving the strict liability tort design patent infringement.

B. The *Claim* of a Design Patent Dictates Parameters of Design Patent Infringement Analysis, Not the Accused Product.

The general rule of *L.A. Gear* makes good policy as it aligns with the property right that is being afforded by a design patent. A design patentee sets forth the meets and bounds of its design in a **claim**. It is these claimed attributes (e.g. shape, color, surfaces ornamentation and/or branding) that determine the parameters for the design patent infringement analysis. Attributes in the accused product that are extraneous to the patented claim are irrelevant to the infringement analysis. See, e.g., *Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co., Ltd.*, 898 F.3d 1210, 1216-17 (Fed. Cir. 2018) (extra features in accused product are irrelevant to design patent infringement analysis). District courts ever since *L.A. Gear* have consistently resisted attempts by accused infringers to bring added branding on the accused product into the design patent infringement analysis. See, e.g. *Cornucopia Prods., LLC v. Dyson, Inc.*, 2012 WL 3094955 at *4 (D. Ariz. July 27, 2012) (“design patent protection would essentially collapse if putting one’s own logo on an otherwise identical product could defeat the ordinary observer test”); *Physio-Control Corp. v. Med.*

Research Labs., 1988 U.S. Dist. LEXIS 192 (N.D. Ill. Jan. 14, 1988) (“designations are not part of the patented design and must be ignored.”).

II. ADDING BRANDING AS A NEW CONSIDERATION FOR THE FACT-FINDER WILL LEAD TO A HARMFUL DISTORTION OF THE ORDINARY OBSERVER TEST.¹

Branding (e.g., brand names, logos, logotypes, etc.) is such a powerful visual cue to the ordinary observer that its inclusion in the infringement analysis runs too high a risk of overshadowing the main objective of the infringement test, which is to determine whether the claimed design is infringed.

A. The Science of Brand Impact and Brand Equity on Ornamental Design Evaluation.

Branding is the single strongest and most effective method for product differentiation in the marketplace. As stated in the critical text “Advertising Theory” by brand experts Krugman and Hayes:

Brand image represents the total impression or net takeaway that a consumer has of the product or service and makes it easier on the consumer in terms of product selection and product use. The [brand] image serves as a mental shortcut that communicates quickly without requiring a great deal of thought on the part of the consumer. (Rodgers, S., & Thorson, E.. *Advertising Theory*, Chapter 28, *Brand Concepts and Advertising*, Krugman, D. & Hayes, J., p. 439 (2012))

¹ The undersigned wishes to acknowledge Charles L. Mauro CHFP, president and founder of Mauro Usability Science, and members of the Mauro Usability Science research staff, who provided the underlying research and assisted in the drafting of this section of the brief.

Commercial enterprises spend literally hundreds of billions of dollars² a year to increase the impact that their brands have on decision-making behaviors of consumers in the marketplace. The single most important objective of a brand is to instantly differentiate a product in the marketplace based on the consumers' knowledge and awareness of that brand in a given product category.

For example, a Mercedes automobile may have a value in the marketplace of \$50,000, but the value of the Mercedes brand indicated by the name alone is worth more than \$50 billion dollars. The reason that brands have such staggering value is that brands have equity in the mind of the consumer and represent a wide range of emotional, psychological and physical attributes of all of the products produced by that company. (Aaker, David. A., *Building Strong Brands* (2012)).

Consumer decision-making is fundamentally rooted in brand equity and brand conveyance. The same design product, one branded and one not, will be perceived by the consumer in entirely different ways; the two will equate to different products in the mind of the consumer. Injecting the consideration of

² The estimated total cost of branding includes the global costs for advertising, promotion and marketing of products for the specific purpose of impacting consumer behavior by establishing in the minds of the consumer what the brand stands for in terms of wide range of emotional, psychological and physical benefits.

brands on the accused product into the design patent infringement analysis will irreparably distort the ordinary observer test. The design patent infringement test evaluates the visual similarity of the accused design with **the claimed design**.

Research shows that, in terms of overall perception of a product's ornamental design, branding and brand indication has the ability to gain automatic attention from consumers as they inspect a product design, averting attention away from other design features, such as overall shape (Plassmann, H., Ramsøy, T. Z., & Milosavljevic, M., *Branding the Brain: A Critical Review and Outlook*, Journal of Consumer Psychology, Vol. 22(1), 18-36 (2012)). Such differentiation happens at a surprising speed of as little as 313 milliseconds (Mormann, M. M., Koch, C., & Rangel, A., *Consumers can make decisions in as little as a third of a second*. Judgment and Decision Making, Vol. 6(6), 520-530 (2011)). Brand indication and related elements are processed in the first stages of shape processing, which leads such information to influence perception of other product features such as ornamental shape (Id.).

B. Branding Reduces Cognitive Effort and Redirects Attention.

The human information processing system employs a method for navigating the everyday world; it is known technically as “cognitive minimization” (Palmer, S. E. *Vision Science: Photons to Phenomenology*, p.

289 (1999)). As consumers go about examining products in the marketplace, they will spend only as much mental effort as is required to identify the product they are seeking. Once they have confirmed that a given product is the brand they are seeking, they will not continue to examine the product further. By associating the brand of a product with the product ornamental design, consumers will spend much less time examining the ornamental shape of a product and simply move on to the next step in the decision-making process. If branding on an accused product is considered in the design patent infringement analysis, this same process will play out in the minds of fact-finders when applying the ordinary observer test.

C. Branding Impacts Consumer Behavior in Ways Ornamental Design Does Not.

There are several assets linked to a brand name or logo that largely impact consumers' perception of a product. Once these cognitive assets are attached to the ornamental design of a product, they cannot be extracted and will have a direct and dramatic impact on the ordinary observer's assessment of the product, both individually and in relation to other products. These assets are often referred to as brand equity by branding experts, and include numerous attributes such as brand personality, user imagery, self-expressive and

emotional benefits and brand-customer relationships (Aaker, *supra*). Brand equity tap into much deeper emotional, motivational and psychological factors critical to consumer decision making than would be the case without the presence of brand indicating subject matter. The consumer's product perceptions are highly affected by expectations formed from prior exposures to the product and most importantly, the associated brand (see Palmer, *supra*, at 84-85 and Kreuzbauer, R., & Malter, A. J., *Embodied cognition and new product design: Changing product form to influence brand categorization*. Journal of Product Innovation Management, Vol. 22(2), pp. 165-176 (2005).

For example, presence of branding on a product is used to communicate to the consumer the quality, reliability and status value of a product, which impacts how consumers view the product. David A. Aaker, in his seminal text *Building Strong Brands*, illustrates this concept with the following visual (see Aaker, *supra*):



Brand equity attributes go far beyond that which is relevant to the ornamental attributes that can be claimed in a design patent. The ordinary observer test is designed to examine the ornamental design values of a patented and accused design, not brand attributes. Ornamental values of the physical product design include overall shape, relative visual complexity (i.e., dimension, form, regularity, clutter), curvature (i.e., angularity, circularity, convergence), congruence (i.e., symmetry, stability, centrality, planned distortion), completeness (i.e., synthesis, amount of information, incomplete patterns) (Wedel, M., & Pieters, R., *Visual Marketing: From Attention to Action* (2007)) as well as Gestalt principles of designs, such as figure-ground articulation, continuity and closure (*Gestalt Principles*, Scholarpedia, http://scholarpedia.org/article/Gestalt_principle).

In sum, once branding is injected into the infringement evaluation, related brand equity associations, which are irrelevant to the claimed design, also come with it. This simple fact dramatically increases the complexity of decision-making for the consumer, most importantly, and necessarily distorts the accurate application of the ordinary observer test.

III. THE PANEL OPINION, IF NOT REMEDIED, PLACES DESIGN PATENTS ON THE PATH TO OBSOLESCENCE.

In *Gorham v. White*, the Supreme Court proclaimed that

The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. ... The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public.

Gorham v. White, 81 U.S. 511, 524-25 (1871). But if branding is included in the design patent infringement analysis, designers will be left with no meaningful way to protect their designs. A “competitor” could make a product using another’s claimed design, attach *prominent-enough* branding, and avoid infringement. This Court should not allow these property rights to be so easily side-stepped. This result would be contrary to Congress’ intent to provide meaningful protection for meritorious design.

Even if a party could establish infringement when branding is considered, the analysis would be significantly more expensive and complex. Naturally, small inventors and small companies will be most prejudiced by this increased cost. With the chance of success of proving infringement so small, and the cost of enforcement so great, the Panel's opinion regarding inclusion of branding in the infringement analysis sets design patents on the path to obsolescence.

CONCLUSION

For the reasons cited herein, this Court should grant the petition for rehearing or rehearing *en banc* (or provide a supplemental opinion) to address the troublesome language of the Panel opinion.

January 27, 2020

Respectfully submitted,
/s/ Damon A. Neagle
Damon A. Neagle
Attorney for *Amicus Curiae*

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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/s/ Damon A. Neagle

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Damon A. Neagle

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Jan 27, 2020

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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18-1329, -1331, -1728

United States Court of Appeals for the Federal Circuit

COLUMBIA SPORTSWEAR NORTH AMERICA, INC.,
an Oregon Corporation,
Plaintiff - Appellant,

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.,
a Utah Corporation,
Defendant - Cross-Appellant.

**Appeal from the United States District Court for the Southern District of
California in No. 3:17-cv-01781-HZ, Judge Macro A. Hernandez**

**CORRECTED GROUP OF INTERESTED PRACTITIONERS' MOTION
FOR LEAVE TO FILE AN *AMICUS CURIAE* BRIEF IN SUPPORT OF
PETITION FOR REHEARING AND REHEARING *EN BANC* OF
PLAINTIFF-APPELLANT**

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Dated: January 27, 2020

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**Columbia Sportswear North America, Inc. v.
Seirus Innovative Accessories, Inc.
Nos. 18-1329, -1331, -1728
AMENDED CERTIFICATE OF INTEREST**

Counsel for the Amici Curiae, Group of Interested Practitioners, certifies the following:

1. The full name of every party or amicus represented by me is:

Group of Interested Practitioners – see the attached list.

2. The name of the real party in interest represented by me is:

None.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

n/a

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

n/a

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b).

None.

January 27, 2020
Date

/s/ Tracy-Gene G. Durkin
Signature of counsel

Tracy-Gene G. Durkin
Printed name of counsel

Certificate of Interest Question 1 continued¹

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¹ The undersigned sign in their individual capacity. Firm names are provided for affiliation purposes only.

Pursuant to Federal Rules of Appellate Procedure 29 and 35, and Federal Circuit Rule 35, the Group of Interested Practitioners respectfully moves this Court for leave to file an *amicus curiae* brief in support of Plaintiff-Appellant Columbia Sportswear North America, Inc. (“Columbia Sportswear”) in the above-captioned matter. Counsel for Columbia Sportswear has indicated that it does not oppose this motion. Defendant-Cross-Appellant Seirus Innovative Accessories, Inc. (“Seirus”) has also indicated that it does not oppose this motion.

STATEMENT OF INTEREST

Group of Interested Practitioners is a group of seven design patent attorneys, identified in the Certificate of Interest filed herewith, who represent clients in a wide range of industries, including Fortune 500 companies, solo inventors, and small business owners.

Tracy-Gene G. Durkin has practiced patent law for more than 30 years and is an internationally recognized expert in design law. Tracy is currently a member of the Patent Public Advisory Committee of the USPTO. She is the former chair of the AIPLA Design Committee and the ABA IPL Design Committee. She is also a former vice chair of the IPO design committee and subcommittee chair of the INTA Design Committee. Tracy has taught patent preparation and prosecution as an adjunct professor with the Antonin Scalia Law School at George Mason University.

Daniel A. Gajewski has practiced patent law for 10 years. He is the current secretary of the IPO Industrial Design Committee, and has spoken on design patent topics at USPTO, AIPLA, and AUTM events.

Robert Katz is recognized both nationally and international as a leading practitioner in the field of industrial designs. He teaches Design Law at George Washington University Law School and previously taught at Georgetown University Law School. He is a past chair of the Design Committees for AIPLA, INTA and FICPI.

Margaret Polson has been practicing design patent law for 24 years and is a past chair of AIPLA's Industrial Design committee and the founding chair of AIPLA's Design Rights Boot Camp. Margaret has spoken internationally about U.S. design patents at AIPPI and FICPI events.

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having penned numerous amicus curiae briefs before the Federal Circuit and Supreme Court. He has also taught Design Law as an adjunct professor at the law school of the George Washington University.

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Amici have no personal interest in the outcome of this case, but have a professional interest in seeing that the law as it relates to design patents develops in a clear and administrable way that serves its constitutional purpose. Group of Interested Practitioners' brief reflects the personal views of the listed attorneys and does not necessarily reflect the views of their law firms or clients.

REASONS TO GRANT THIS MOTION

Group of Interested Practitioners' *amicus curiae* brief in support of Columbia Sportswear's petition for rehearing *en banc* is desirable because the issues involved in this case are fundamental to the design patent system, namely, the standard for design patent infringement. Group of Interested Practitioners' brief presents additional reasons, beyond those presented in the petition, regarding why

this Court should grant *en banc* review to consider: (1) whether, when conducting a design-patent infringement analysis, a fact-finder may consider the addition of brand names or other labeling on an otherwise infringing design; and (2) whether when conducting a design-patent infringement analysis, a fact-finder should compare the overall appearance of the claimed design (i) to the overall appearance of the accused design, or (ii) to the overall appearance of the entire accused product, which may include aspects extraneous to the claimed design (e.g., logos, tradenames, color, size, etc.). Group of Interested Practitioners' brief focuses on providing the Court with a more complete perspective on what is at stake.

Dated: January 27, 2020

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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(Date)

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18-1329, -1331, -1728

United States Court of Appeals for the Federal Circuit

COLUMBIA SPORTSWEAR NORTH AMERICA, INC.,
an Oregon Corporation,
Plaintiff - Appellant,

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.,
a Utah Corporation,
Defendant - Cross-Appellant.

**Appeal from the United States District Court for the Southern District of
California in No. 3:17-cv-01781-HZ, Judge Macro A. Hernandez**

**CORRECTED *AMICUS* BRIEF IN SUPPORT OF PETITION FOR
REHEARING**

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**Columbia Sportswear North America, Inc. v.
Seirus Innovative Accessories, Inc.
Nos. 18-1329, -1331, -1728
AMENDED CERTIFICATE OF INTEREST**

Counsel for the Amici Curiae, Group of Interested Practitioners, certifies the following:

1. The full name of every party or amicus represented by me is:

Group of Interested Practitioners – see the attached list.

2. The name of the real party in interest represented by me is:

None.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

n/a

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

n/a

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b).

None.

January 27, 2020
Date

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Certificate of Interest Question 1 continued¹

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INTEREST OF AMICUS CURIAE

Group of Interested Practitioners (GIP) is a group of seven design patent attorneys, identified in the Certificate of Interest filed herewith, who represent clients in a wide range of industries, including Fortune 500 companies, solo inventors, and small business owners. No party, party's counsel, or any person other than the members of GIP authored this brief in whole or in part. *See* Fed. R. App. P. 29(b)(4); 29(a)(4)(E). No party, party's counsel, or any person other than the members of GIP contributed money that was intended to fund preparing or submitting this brief. *Id.*

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ARGUMENT

The broad wording in the panel’s opinion in *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119 (Fed. Cir. 2019) appears to create a sweeping new rule governing the design patent infringement analysis. Such a new rule would open a Pandora’s box of label-based design patent non-infringement arguments that are inconsistent with prior Supreme Court and Federal Circuit precedent, and generally harmful to the rights that design patents are intended to protect.

Specifically, the Court found that the district court erred by failing to consider whether the presence of Seirus’ logo on the accused product supported non-infringement under the ordinary observer test. This holding, as worded in the panel opinion, appears to directly contradict longstanding Supreme Court and Federal Circuit precedent that the analysis must compare only the patented design and the accused design—here a fabric pattern—and not incorporate labeling (e.g.,

logos, brand names, tags, trademarks, etc.). *See Gorham Mfg. Co. v. White*, 81 U.S. 530 (1871); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993). This contradiction in the law will likely have far reaching and unintended consequences for design patent law. It threatens the integrity and reliability of the design patent system, and jeopardizes the value of millions of design patents. The panel or full Court should reconsider this aspect of *Columbia Sportswear*.

I. The Panel Opinion in *Columbia Sportswear* Appears to Present a Dramatic Departure from Longstanding Precedent

The Federal Circuit clearly explained and applied the Supreme Court's *Gorham v. White* precedent in its 1993 *L.A. Gear* decision. That decision found design patent infringement, concluding that infringement cannot be avoided by labelling. Every court since *L.A. Gear*, without exception, has consistently applied those governing precedents and excluded the presence of labeling from the infringement analysis. *See, e.g., Physio-Control Corp. v. Med. Research Labs.*, No. 85-C-4973, 1988 WL 5023 (N.D. Ill. Jan. 15, 1988); *Hutzler Mfg. Co. v. Bradshaw Int'l, Inc.*, No. 11-cv-7211-PGG, 2012 WL 3031150 (S.D.N.Y. July 25, 2012); *Torspo Hockey Int'l, Inc. v. Kor Hockey Ltd.*, 491 F. Supp. 2d 871, 881 (D. Minn. 2007); *Superior Merchandise Co., Inc. v. M.G.I. Wholesale, Inc.*, No. 98-3174, 1999 WL 977365 (E.D. La. Oct. 26, 1999); *Cornucopia Prods., LLC v. Dyson, Inc.*, Nos. 12-00234-PHX-NVW, 12-00924-PHX-NVW, 2012 WL 3094955, at *4

(D. Ariz. July 27, 2012) ; *Jack Schwartz Shoes v. Skechers, U.S.A.*, 233 F. Supp. 2d 512 (S.D.N.Y. 2002); *Rockport Co., Inc. v. Deer Stags, Inc.*, 65 F. Supp. 2d 189, 195 (S.D.N.Y. 1999); *Herbko Int'l. Inc. v. Gemmy Indus. Corp.*, 916 F. Supp. 322, 326 (S.D.N.Y. 1996).

On summary judgment before the district court here, Seirus argued that various differences between the accused and patented designs—including that the waves in Seirus’s design were interrupted by repeated use of Seirus’s logo—should preclude judgement as a matter of law under the ordinary observer test. The district court considered and rejected most of Seirus’ purported differences on the merits. *See Slip Op.* at 16 (quoting the district court’s finding that the differences were “so minor as to be nearly imperceptible.”). The district court refused to consider the placement of Seirus’ logo in its ordinary observer analysis, as logo presence or placement was not part of the patented design. *See Slip Op.* at 15.

This Court found two errors in the district court’s analysis: (1) the court improperly declined to consider the effect of Seirus’ logo in its infringement analysis, and (2) the court resolved a series of disputed fact issues, in some instances relying on an incorrect standard, that should have been tried to a jury. GIP takes issue only with the first purported error that the panel identifies.

The district court cited controlling precedent from *L.A. Gear* for the proposition that logos should be wholly disregarded in the design-infringement

analysis. Slip Op. at 16. *L.A. Gear* holds that “the ultimate question requires determining whether the effect of the whole *design* is essentially the same.” *L.A. Gear*, 988 F.2d at 1125 (Fed. Cir. 1993) (quoting *Gorham v. White*, 81 U.S. at 530) (emphasis added) (internal quotations omitted). *L.A. Gear* found a design patent infringed under the *Gorham* ordinary-observer standard despite also finding, under a parallel Lanham Act analysis, that the prominent labeling of the brand name on the accused shoes would prevent any actual confusion. *Id.* Specifically, the Court held that “design patent infringement relates solely to the patented design, and does not . . . allow of avoidance of infringement by labelling.” *Id.* at 1126.

The Court in *Columbia Sportswear* purports to distinguish *L.A. Gear* on the basis that the parties to that case did not dispute copying or that the patented and accused designs were substantially similar. Slip Op. at 17. The fact that copying and similarity were admitted there, however, were not the essential facts that gave rise to the holding. They therefore do not provide reasonable bases for distinction. *L.A. Gear* expressly stands for the broad proposition that labeling is an extraneous feature that does not inform the design patent infringement analysis. This exclusion of extraneous features from the infringement analysis has subsequently been applied consistently under diverse fact patterns, including where copying and similarity were not conceded. *Sun Hill Indus. v. Easter Unlimited, Inc.*, 48 F.3d

1193 (Fed. Cir. 1995); *Payless Shoesource, Inc. v. Reebok, Int'l, Ltd.*, 998 F.2d 985, 990 (Fed. Cir. 1993).

While the panel in *Columbia Sportswear* acknowledges that *L.A. Gear* held that design infringement was not avoided “by labeling,” the opinion then goes on to state:

But *L.A. Gear* does not prohibit the fact finder from considering an ornamental logo, its placement, and its appearance as one among other potential differences between a patented design and an accused one. Indeed, the fact finder is tasked with determining whether an ordinary observer would find the “effect of the whole design substantially the same.” *Gorham*, 81 U.S. at 530. It would be inconsistent with this mandate to ignore elements of the accused design entirely, simply because those elements included the name of the defendant.

Slip Op. at 17. The panel opinion thus appears to limit the holding of *L.A. Gear* to the proposition that, while the presence of a logo is not *solely dispositive* in avoiding infringement, the presence of the logo itself *must be considered* as a potential difference between the patented and accused designs. *Id.*

L.A. Gear is not so limited. The panel there clearly considered and *accepted* the argument that the large, central, and prominent placement of the infringer’s “BALLOONS” label on an accused product would adequately differentiate the product in the eyes of customers in the marketplace under a *trademark* infringement analysis, but *rejected* that same argument in its design patent infringement holding. *Columbia Sportswear*’s attempt to narrow the holding of *L.A. Gear* is a significant change in the law that is not properly undertaken by a

later panel. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988) (“[t]his court has adopted the rule that prior decisions of a panel of the court are binding precedent on subsequent panels unless and until overturned in banc.”). The panel or full Court should clarify this aspect of the *Columbia Sportswear* opinion to resolve the confusion and uncertainty that will result from these two conflicting decisions.

II. The Tension Between *Columbia Sportswear* and *L.A. Gear* Threatens Significant Harm to Design Patent Law

The panel opinion creates harmful uncertainty surrounding the proper treatment of products that incorporate labels into otherwise similar designs. If, as the panel in *Columbia Sportswear* states, the placement of a label may be considered as one among other potential differences in the infringement analysis, then the presence of the label may become the deciding factor where the differences between the designs are not otherwise substantial. If, on the other hand, as *L.A. Gear* clearly commands, infringement cannot be avoided by labeling, then the presence of the label cannot, itself, be a factor that weighs against infringement. By suggesting the contrary, the panel opinion creates harmful uncertainty surrounding the proper treatment of products that incorporate labels into otherwise similar designs.

This will open the floodgates to accused infringers arguing that labels override any design similarities, injecting unfair competition into the design patent

infringement analysis, which is at odds with *L.A. Gear*. Further, contrary to *L.A. Gear*, the panel opinion will reduce the likelihood of a grant of a summary judgment of infringement where the patented and accused designs are otherwise substantially identical but for labelling or branding on the accused design.

Cabining *L.A. Gear* to its facts was not necessary for the panel to have reached the decision that the district court erred and remand was appropriate. GIP therefore suggests that even if rehearing is denied, the panel (if not the full Court) ought to issue a simple clarification of the opinion reconciling the problematic language with the holding in *L.A. Gear*. The burden of clarification is therefore minimal, and its benefits to the legal community and design patent holders comparatively massive.

Specifically, the Court should clarify exactly how and why the integration of imagery associated with a logo might change the overall visual impression of a patented design without running afoul of or constricting the holding in *L.A. Gear*. Regardless of the source or form of the clarification, the Court must restore full force to the longstanding legal proposition that labeling does not avoid infringement when the remainder of the design is otherwise substantially similar. The current force of that proposition is uncertain in the wake of the panel opinion, and that uncertainty stands to cause catastrophic damage to design patent law.

Because logos often include words with informative content, they are highly prejudicial in the design patent analysis. Even allowing a jury to consider the content-neutral aspects of a logo, like shape and repetition, presents a risk that the jury will not be able to divorce the secondary meaning of the labeling from the use of its imagery as a design element. A competitor that chooses to use a logo or label as a design building block should bear the risk of that design choice being discounted from the infringement analysis due to the prejudicial nature of label incorporation. This Court should clarify its opinion in *Columbia Sportswear* and prevent a massive upheaval of design patent law.

CONCLUSION AND RELIEF SOUGHT

The Court should grant the petition for rehearing and clarify the extent to which the incorporation of a logo in a design may distinguish the overall design from a patent. In the alternative, the Court should issue a clarification that reconciles the language of the opinion with *L.A. Gear*.

Dated: January 27, 2019

Respectfully submitted,

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