

Keywords: design patents; nonobviousness; motivation to combine

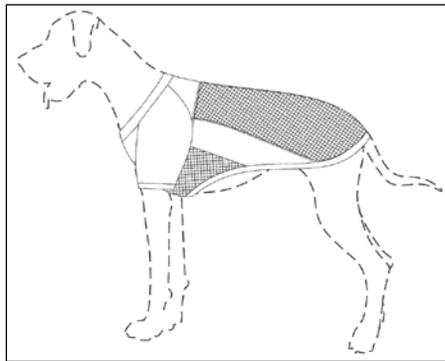
General: When determining obviousness in a design application, a two-step test is used. First, a primary reference must be identified, this primary reference being “something in existence” that has “basically the same” appearance as the claimed design. Second, other references can be used to modify the primary reference “to create a design that has the same overall visual appearance of the claimed design.”

MRC Innovations, Inc. v. Hunter MFG., LLP

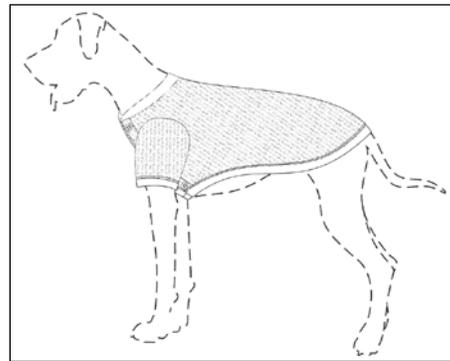
No. 2013-1433 (Fed. Cir., April 2, 2014)

I. Facts

MRC Innovations, Inc. (MRC) owns two design patents, D634,488 (D’488) and D634,487 (D’487). These patents both claim designs of sports jerseys for dogs. The D’488 patent is for a football jersey while the D’487 patent is for a baseball jersey. These jerseys are illustrated below.



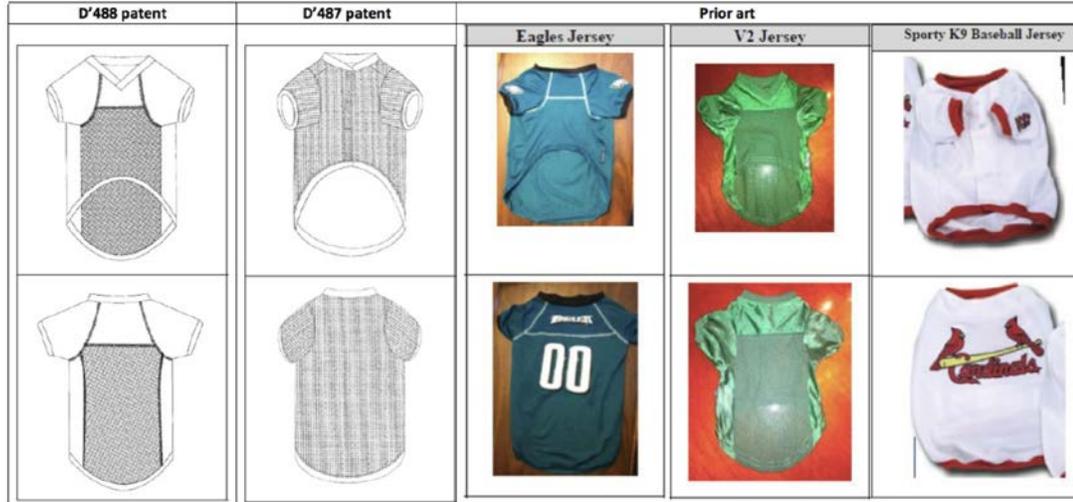
D’488 patent



D’487 patent

Hunter MFG., LLP (Hunter) is a retailer of licensed sport products, including pet jerseys. In the past, Hunter purchased pet jerseys from Mark Cohen, the principal owner of MRC and named inventor on the D’488 and D’487 patents. In December 2010, the relationship between MRC and Hunter broke down, and MRC refused to do any further business with Hunter. Hunter sought out other suppliers, and eventually contracted with CDI International, Inc. (another appellee in this case) to supply Hunter with jerseys similar to the patented football and baseball jerseys.

MRC filed suit against Hunter and CDI for willful infringement of both patents. The District Court granted summary judgment in favor of Hunter and CDI on the grounds that the D’488 and D’487 patents are invalid as obvious under 35 U.S.C. §103(a). Specifically, the District Court concluded that the patents were invalid as obvious in light of several prior art pet jerseys, two of which were sold by MRC over one year prior to the filing of the patents in suit. These jerseys include the “Eagles jersey” and the “V2 jersey”, which are both football jerseys designed to be worn by a dog, and the “Sporty K9 jersey”, which is a baseball jersey designed to be worn by a dog. These prior art jerseys are illustrated below alongside the D’488 and D’487 patents. MRC appealed the grant of summary judgment to the Federal Circuit.



II. Issues

- A. Did the District Court err in its decision that MRC’s patents were invalid under 35 U.S.C. §103(a) in view of the prior art pet jerseys?

III. Discussion

- A. No. The District Court correctly determined that the D’488 and D’487 patents were obvious in view of the prior art pet jerseys under 35 U.S.C. §103(a).

In the context of design patents, “the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1380-1381 (Fed. Cir. 2009) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). The Federal Circuit uses a two-step process to determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design. *Durling*, 101 F.3d at 103. First, the Court must identify a proper primary reference, which is “something in existence” that has “basically the same” appearance as the claimed design. Second, one or more secondary references are identified to modify the primary reference “to create a design that has the same overall visual appearance as the claimed design.” *Id.*

Step 1 – Primary References

The District Court had identified the “Eagles jersey” as a primary reference in the D’488 patent. Specifically, the District Court “described the claimed design in the context of comparing it to the prior art,” noting key similarities between the patented jersey and the “Eagles jersey”. Specifically, the jerseys have the “same overall shape, similar fabric, and ornamental surge stitching.” Even when considered against three differences that were identified by MRC, these similarities between the jerseys are such that the D’488 design created “basically the same” overall visual impression as the “Eagles jersey”. Based on this comparison, the District Court correctly identified the “Eagles jersey” as a primary reference.

Using this analysis, either of the “Eagles jersey” or the “V2 jersey” could serve as a proper primary reference for the D’488 patent. Similarly, the District Court correctly identified the “Sporty K9 jersey” as a proper primary reference for the D’487 patent, stating the “Sporty K9 jersey” had “basically the same” appearance as the patented design.

Step 2 – Secondary References

In its analysis, the District Court had identified the “V2 jersey” and the “Sporty K9 jersey” as secondary references for purposes of determining obviousness of the D’488 patent. Similarly, the court had identified the “Eagles jersey” and the V2 jersey” as secondary references for the D’487 patent. MRC argued on appeal that the District Court had failed to explain why a skilled artisan would have chosen to incorporate features of the secondary references into the respective primary references.

However, according to a standard established in *Borden*, secondary references may be “so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Id.* (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed.Cir. 1996)). That is, the similarity in appearance of the dog jerseys alone provides the suggestion that features of one should be applied to another. Indeed, in this case, “the secondary references that the district court relied on were not furniture, or drapes, or dresses, or even human football jerseys; they were football jerseys designed to be worn by dogs.” Accordingly, the District Court correctly identified proper secondary references for both patents.

Secondary Considerations

MRC also argued that the District Court failed to properly consider several secondary considerations, such as evidence of commercial success, copying, and granting of a license on the designs. However, MRC failed to meet its burden of proving a nexus between those secondary considerations and the designs claimed in D’488 and D’487. Specifically, MRC did not provide any supporting figures or data that would suggest that the “commercial success” or “copying” were attributable to the claimed design features. In addition, the licensing agreement was established between MRC and another company partially owned by Mark Cohen.

IV. Conclusion

In determining obviousness of a design patent claim, a proper primary reference must have “basically the same” visual impression as the claimed design. Similarity between primary and secondary references can be enough to provide the requisite motivation to combine ornamental features of the second reference into the first reference.