

Crocs, Inc. v. International Trade Commission

No. 08-1596, Fed. Cir. (Lourie, Rader,* Prost)

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On February 24, 2010, the Federal Circuit reversed and remanded the U.S. International Trade Commission decision that U.S. Patents No. 6,993,858 and No. D517,789, which related to breathable footwear, were respectively invalid for obviousness and not infringed. The Federal Circuit stated:

This court has cautioned, and continues to caution, trial courts about excessive reliance on a detailed verbal description in a design infringement case. [M]isplaced reliance on a detailed verbal description of the claimed design risks undue emphasis on particular features of the design rather than examination of the design as a whole. In many cases, the considerable effort in fashioning a detailed verbal description does not contribute enough to the infringement analysis to justify the endeavor. Depictions of the claimed design in words can easily distract from the proper infringement analysis of the ornamental patterns and drawings.

Design patents are typically claimed as shown in drawings, and claim construction must be adapted to a pictorial setting. Thus an illustration depicts a design better “than it could be by any description and a description would probably not be intelligible without the illustration.” “[A]s a rule, the illustration in the drawing views is its own best description.”

This case shows the dangers of reliance on a detailed verbal claim construction. The claim construction focused on particular features of the '789 patent design and led the administrative judge and the Commission away from consideration of the design as a whole. This error is apparent in the Commission's explicit reference to two details required by the written claim construction but not by the '789 drawings: (1) a strap of uniform width, and (2) holes evenly spaced around the sidewall of the upper. As shown in Figure 1 of the '789 patent, the strap bulges to a greater width at the middle of the strap on the far left of the figure. Thus, the design figure does not require a strap of uniform width between the two round connectors. Also, as shown in Figure 4 of the '789 patent, the holes are not evenly spaced. Figure 4 shows a gap in the spacing (particularly towards the big toe). Nonetheless, the written claim description required uniform strap width and uniform hole spacing—contrary to the claimed invention. This error distorts the infringement analysis by

the ordinary observer viewing the design as a whole. The administrative judge and the Commission needed to apply the ordinary observer test to “the design shown in Figures 1–7.”

In determining whether an accused product infringes a patented design, this court applies the “ordinary observer” test, without any “point of novelty” perspective. To show infringement under the proper test, an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design. When the differences between the claimed and accused designs are viewed in light of the prior art, the attention of the hypothetical ordinary observer may be drawn to those aspects of the claimed design that differ from the prior art. If the claimed design is close to the prior art designs, small differences between the accused design and the claimed design assume more importance to the eye of the hypothetical ordinary observer. The ordinary observer, however, will likely attach importance to those differences depending on the overall effect of those differences on the design. Even if the claimed design simply combines old features in the prior art, it may still create an overall appearance deceptively similar to the accused design. In that case, this court will uphold a finding of infringement. In other words, “the deception that arises is a result of the similarities in the overall design, not of similarities in ornamental features in isolation.” The ordinary observer test applies to the patented design in its entirety, as it is claimed. “[M]inor differences between a patented design and an accused article’s design cannot, and shall not, prevent a finding of infringement.”

Turning to this case, the Commission placed undue emphasis on particular details of its written description of the patented design. Those details became a mistaken checklist for infringement. Without a view to the design as a whole, the Commission used minor differences between the patented design and the accused products to prevent a finding of infringement. In other words, the concentration on small differences in isolation distracted from the overall impression of the claimed ornamental features. The proper comparison requires a side-by-side view of the drawings of the ’789 patent design and the accused products. . . . These side-by-side comparisons of the ’789 patent design and the accused products suggest that an ordinary observer, familiar with the prior art designs, would be deceived into believing the accused products are the same as the patented design. In one comparison after another, the shoes appear nearly identical. If the claimed design and the accused designs were arrayed in matching colors and mixed up randomly, this court is not confident that an ordinary observer could properly restore them to their original order without very careful and prolonged effort. . . . In any event, this court perceives that the

accused products embody the overall effect of the '789 design in sufficient detail and clarity to cause market confusion. Thus, the accused products infringe the '789 design.

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