

TABLE OF APPENDICES

	Page
Appendix A - Court of appeals panel opinion (Sept. 15, 2023).....	1a
Appendix B - Court of appeals panel opinion (Nov. 13, 2019).....	38a
Appendix C - Court of appeals order denying rehearing (Dec. 22, 2023).....	64a
Appendix D - District court judgment (Aug. 10, 2021).....	66a
Appendix E - District court opinion (August 10, 2016).....	67a
Appendix F - Trial transcript (Aug. 3-6, 2021).....	90a
Appendix G - U.S. Patent D657,093 ("Snyder").....	104a
Appendix H - U.S. Patent 5,626,949 ("Blauer").....	105a
Appendix I - U.S. Patent 2,539,690 ("Boorn").....	106a
Appendix J - U.S. Patent 1,515,792 ("Respass").....	107a
Appendix K - Joint proposed jury instructions.....	108a
Appendix L - Pretrial hearing transcript (July 16, 2021).....	111a
Appendix M - Court of appeals blue brief (Jan. 13, 2022).....	114a
Appendix N - Final jury instructions (Aug. 6, 2021).....	116a

TABLE OF APPENDICES CONT.

	Page
Appendix O - Constitutional and statutory provisions:.....	118a
35 U.S.C. § 102	
35 U.S.C. § 103	
35 U.S.C. § 171	
28 U.S.C. § 1254	

APPENDIX A

**UNITED STATES COURT OF APPEALS
FOR THE FEDERALCIRCUIT**

**COLUMBIA SPORTSWEAR NORTH
AMERICA, INC.,**
Plaintiff-Appellant

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.,
Defendant-Cross-Appellant

2021-2299, 2021-2338

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

Decided: September 15, 2023

NICHOLAS FREMONT ALDRICH, JR., Schwabe,
Williamson & Wyatt P.C., Portland, OR, argued for
plaintiff-appellant. Also represented by SCOTT D.
EADS, SARA KOBAK. Also argued by CHRISTOPHER V.
CARANI, McAndrews, Held & Malloy, Ltd., Chicago,
IL.

SETH MCCARTHY SPROUL, Fish & Richardson, P.C.,
San Diego, CA, argued for defendant-cross-
appellant. Also represented by CHRISTOPHER
MARCHESE, JOHN WINSTON THORNBURGH.

Before PROST, REYNA, and HUGHES, *Circuit Judges*.

PROST, *Circuit Judge*.

Columbia Sportswear North America, Inc. (“Columbia”) sued Seirus Innovative Accessories, Inc. (“Seirus”) for infringing U.S. Design Patent No. D657,093 (“the D’093 patent”). After the district court granted summary judgment of infringement and a jury awarded Columbia \$3,018,174 in damages, Seirus appealed to this court. In *Columbia I*,¹ we vacated the summary judgment of infringement and remanded for further proceedings.

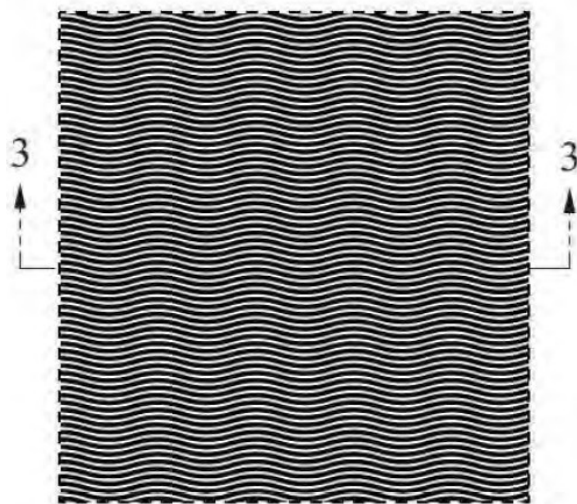
On remand, a jury found that Seirus did not infringe. Columbia appeals, mainly challenging the jury instructions. Seirus conditionally cross-appeals as to damages. For the reasons discussed below, we vacate the non-infringement judgment and remand for further proceedings.

BACKGROUND I

Columbia’s D’093 patent, titled “Heat Reflective Material,” claims “[t]he ornamental design of a heat reflective material, as shown and described” in various figures. D’093 patent, at [54], [57]. Figure 1, described as “an elevational view of a heat reflective material,” J.A. 4, is reproduced below:

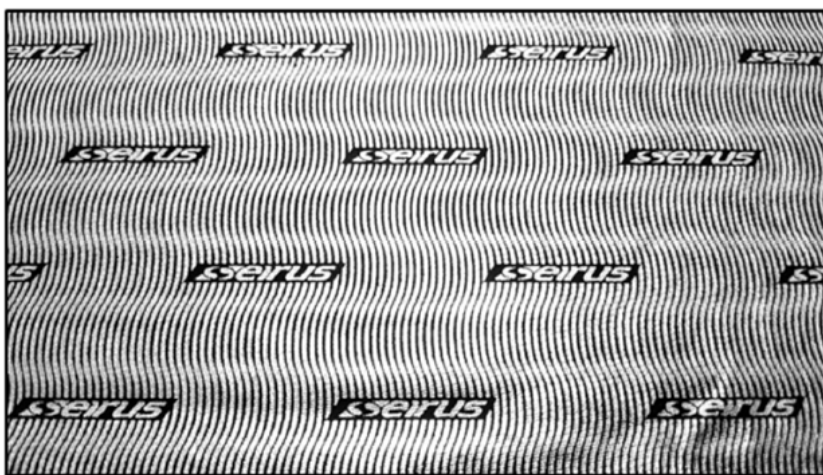
¹ *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119 (Fed. Cir. 2019) (“*Columbia I*”).

3a



J.A. 1704.

Seirus markets and sells products (e.g., gloves) made with material that it calls HeatWave. An image of Heat-Wave material appears below:



Cross-Appellant's Br. 17 (citing J.A. 3992).

II

A

Columbia sued Seirus in district court,² accusing Seirus of infringing the D’093 patent via its HeatWave products.

Columbia sought both a construction of the D’093 patent’s claim and summary judgment of infringement. The district court declined to construe the claim but granted summary judgment of infringement all the same. *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 202 F. Supp. 3d 1186, 1189 (D. Or. 2016) (“*SJ Opinion*”).

The district court’s summary-judgment opinion began with the “ordinary observer” test for design-patent infringement, drawn from the Supreme Court’s *Gorham* decision:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

SJ Opinion, 202 F. Supp. 3d at 1190–91 (alteration

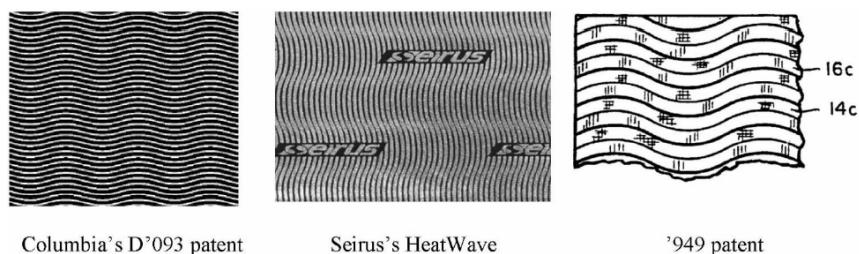
² Columbia sued in the U.S. District Court for the District of Oregon, which later transferred the case to the U.S. District Court for the Southern District of California, from which it came to this court on appeal in *Columbia I* and comes again to this court now. See *Columbia I*, 942 F.3d at 1124, 1132–33. Because the distinction is immaterial to our discussion, we refer to the two district courts interchangeably as the district court.

in original) (quoting *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871)).

The district court also addressed the topic of comparison prior art. In a design-patent infringement analysis, comparison prior art serves as background when comparing a claimed and accused design. *See id.* at 1195 (stating that the “ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art,” and “when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer” (quoting *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676 (Fed. Cir. 2008) (en banc))).

The district court then discussed two issues relevant here. First, it rejected Seirus’s argument that the Seirus logo appearing throughout the design of HeatWave material made that design different enough from the claimed design to preclude summary judgment of infringement. *Id.* at 1193–94. Indeed, relying on its interpretation of this court’s precedent, the district court disregarded the Seirus logo altogether in its infringement analysis. *Id.* at 1193 (citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1126 (Fed. Cir. 1993)). Second, the district court evaluated the comparison prior art that Seirus had offered in support of its non-infringement position. As to U.S. Patent Nos. 2,539,690 (“Boorn”) and 1,515,792 (“Respass”), the district court found that they “cover[ed] products far afield” from the D’093 patent’s heat reflective material and therefore were not relevant comparison prior art. *See id.* at 1196. As to U.S.

Patent No. 5,626,949 (“Blauer”), however, the district court compared it side-by-side with both the D’093 patent and the HeatWave material (as shown below, with Blauer listed as the ’949 patent):



Id. at 1197. The district court found that “the contrasting waves of Seirus’s design are still substantially closer to the contrasting wave design disclosed in the D’093 patent than either Seirus’s or Columbia’s design is to the pattern disclosed in [Blauer].” *Id.* (finding that “[t]he waves in [Blauer] are not contrasting colors” and that “the waves in the Columbia and Seirus designs are very close to the same wavelength and amplitude”). In light of this evaluation, the district court found that “[t]he overall visual effect of the Columbia and Seirus designs [is] nearly identical.” *Id.*

With infringement thus established, damages were tried to a jury, who awarded Columbia \$3,018,174.

B

Seirus appealed the district court’s summary judgment of infringement and the jury’s damages award to this court. In *Columbia I*, we vacated the summary judgment, concluding that the district court erred in two respects.

First, the district court had improperly declined to

consider the effect of Seirus’s logo in its infringement analysis. *Columbia I*, 942 F.3d at 1130. We explained that, while a “would-be infringer should not escape liability for design patent infringement if a design is copied but labeled with its name,” our precedent “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.” *See id.* at 1131 (emphasis in original). Second, the district court had resolved certain fact issues that should have been left to a jury. Among these issues was the impact of Seirus’s comparison prior art. In particular, after we described the district court’s three-way comparison of the D’093 patent, the Seirus HeatWave material, and Blauer—as well as the court’s resulting finding that “[t]he overall visual effect of the Columbia and Seirus designs [is] nearly identical”—we concluded that this factfinding was improper on summary judgment. *Id.* (first alteration in original) (quoting *SJ Opinion*, 202 F. Supp. 3d at 1197).

We therefore vacated the summary judgment and remanded for further proceedings. Although we noted Seirus’s separate arguments concerning damages, we “d[id] not reach them because we ha[d] vacated the infringement finding.” *Id.* at 1132.

III

Infringement was then tried to a jury. Three aspects of that trial are relevant here: (1) the comparison prior art (and related arguments), (2) the jury instructions on comparison prior art, and (3) the jury instructions implicating the Seirus logo. We discuss each in turn.

A

Before trial, the district court limited admissible comparison prior art to “wave patterns on *fabric*.” J.A. 421 (emphasis added). In light of this ruling, Seirus presented to the jury Boorn, Respass, and Blauer as alleged comparison prior art.

Boorn is a 1951 utility patent that discloses a method of inlaying plastic threads into plastic sheets. In particular, it says that prior-art methods of simply painting, stamping, or printing ornamental stripes on the surface of a coated fabric or a plastic sheet produce stripes that are “likely to wear off readily,” and it seeks to overcome that problem by “forcing into such surface preformed plastic threads or ribbons to thereby embed them in the surface of the plastic material and form the desired inlaid striped design.” J.A. 1465 col. 1 ll. 1–19.

Respass is a 1924 utility patent that discloses a “process of making a strong pliable unwoven fabric.” *See* J.A. 1468 col. 1 ll. 13–14. One of the objects of the invention is to make such a fabric so that it “may readily be formed around the core in making a rubber tire and similar articles.” J.A. 1468 col. 1 ll. 22–29.

Blauer is a 1997 utility patent titled “Breathable Shell for Outerwear.” J.A. 1457. It describes its “Field of the Invention” as “relat[ing] to fabric constructions for outerwear, and, more particularly, to shell fabric constructions for coats, pants, jackets, boots, gloves, and other outer clothing that are designed for protection against inclement weather.” J.A. 1460 col. 1 ll. 10–15. Its outerwear shell seeks to achieve “vapor

permeability, water repellency, wind obstruction, stain resistance, dimensional stability, and external durability.” J.A. 1460 col. 2 ll. 1–8.

The district court, in addition to admitting these references because they disclosed fabric, precluded Columbia from trying to distinguish them as not disclosing *heat reflective material*. The district court reasoned that allowing Columbia to do so (e.g., by argument or witness questioning) would improperly import functional considerations into the design-patent infringement analysis. *See* J.A. 421.

B

Columbia proposed two jury instructions addressing the proper scope of comparison prior art. Proposed jury instruction no. 9E (titled “Claim Scope”) stated that “[t]he [D’093 patent] is limited to the design of heat reflective materials, as shown and described in the patent,” and that “[t]he plain and ordinary meaning of ‘heat reflective materials’ in the context of the [D’093 patent] does not include all materials.” J.A. 360 (capitalization normalized). Proposed jury instruction no. 9F (titled “What is Prior Art”) stated:

In design patent law, the term “prior art” refers to prior designs that address the same subject matter or field of endeavor as the patented design or that address a field of endeavor so similar that a designer having ordinary skill would look to articles in that field for their designs. The subject matter and field of endeavor of the D’093 patent is ornamental designs for heat reflective materials.

J.A. 369 (capitalization normalized).

During trial, the district court gave the parties a draft of its jury instructions. Columbia took issue with the district court's draft instruction no. 11, which concerned comparison prior art. Columbia argued that (1) the scope of comparison prior art "is not the universe of abstract design but is limited to designs of the same article of manufacture or of articles so similar that a person of ordinary skill would look to such articles for their designs," and (2) at the very least, the jury (as fact finder) should get to decide for themselves whether Boorn, Respass, and Blauer were within the proper scope. *See* J.A. 1172–73 (cleaned up). The district court then invited the parties to propose revisions to its draft jury instructions. J.A. 1185. Columbia proposed including a sentence in draft instruction no. 11 stating: "The term 'prior art' refers to prior designs of the same article of manufacture or of articles so similar that a person of ordinary skill would look to such articles for their designs." J.A. 1481.

The district court declined to include Columbia's proposed sentence and gave instruction no. 11 (in relevant part) to the jury as follows:

You must decide what is prior art. Prior art includes things that were publicly known, or used in a publicly accessible way in this country, or that were patented or described in a publication in any country before the creation of the claimed design.

You must familiarize yourself with the prior art in determining whether there has been infringement. When the claimed design is visually close to prior art designs, small

differences between the accused design and the claimed design may be important in analyzing whether the overall appearances of the accused and claimed designs are substantially the same.

J.A. 1521.

Thus, aside from publication and date requirements— matters undisputed as to Boorn, Respass, and Blauer—the jury instructions provided no standard by which the jury should decide what is comparison prior art.

C

Columbia also proposed two jury instructions addressing Seirus’s logo on the accused HeatWave design. Pro- posed jury instruction no. 9B (titled “Design Patent Infringement”) stated that “[c]onfusion as to the source or provider of the goods accused of infringing is irrelevant to determining whether a patent is infringed.” J.A. 348. Pro- posed jury instruction no. 9D (titled “Logo/Confusion”) stated:

Labelling a product with source identification or branding does not avoid infringement. Consumer confusion as to the source or provider of the products is not a consideration in an infringement analysis. [B]ut you may consider an ornamental logo, its placement, and its appearance as one among other potential differences between a patented de- sign and an accused one in deciding whether the overall appearance of the patented and accused de- sign are substantially similar.

J.A. 356.

The district court's draft jury instructions did not include Columbia's proposals (at least not verbatim). See Appellant's Br. 37–38. Instead, draft instruction no. 10 did two basic things. First, it recited the ordinary-observer test: "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 an ordinary observer, inducing him to purchase one supposing it to be the other." Appellant's Br. 38; see *Gorham*, 81 U.S. at 528. Second, it added: "You do not need, however, to find that any purchasers were actually deceived or confused by the appearance of the accused products." Appellant's Br. 38.

Columbia took issue with the district court's draft instruction no. 10, arguing that it should have added that the jury also need not find a *likelihood* of consumer confusion. J.A. 1159–60. Columbia proposed revising a sentence in the instruction to state: "You do not need, however, to find that any purchasers were actually deceived, nor do you need to find any actual confusion *or likelihood of confusion* amongst consumers in the marketplace." J.A. 1481 (emphasis added). The district court declined to include Columbia's proposed revision and instead gave instruction no. 10 (in relevant part) to the jury as follows:

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 an ordinary observer,

inducing him to purchase one supposing it to be the other. You do not need, however, to find that any purchasers were actually deceived or confused by the appearance of the accused products.

J.A. 1520.

* * *

The jury returned a verdict of non-infringement, and the district court accordingly entered judgment for Seirus. Columbia appeals, and Seirus conditionally cross-appeals as to damages. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

Our discussion proceeds as follows. Part I addresses the parties' arguments concerning the preclusive effects of prior proceedings. Parts II.A and II.B address Columbia's jury-instruction and other challenges concerning comparison prior art and Seirus's logo. Part III addresses Seirus's conditional cross-appeal.

I

The parties argue that prior proceedings through *Columbia I* create certain preclusive effects here. These effects take various labels. Both parties invoke law of the case, while Seirus adds judicial estoppel to the mix. We reject each of these contentions.

The law-of-the-case doctrine relies on the force of a matter having already been decided in the case. *See, e.g., Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 817 (1988) (noting that the doctrine "expresses the practice of courts generally

to refuse to reopen what has been decided” (cleaned up)). Columbia, citing the district court’s previous exclusion of comparison prior art concerning products “far afield” from heat reflective material, argues that this ruling as to what qualifies as comparison prior art became the law of the case when Seirus failed to challenge it in *Columbia I*. Appellant’s Br. 55–56 (citing *SJ Opinion*, 202 F. Supp. 3d at 1196 (excluding Boorn and Respass from consideration as comparison prior art)). Seirus does not dispute that it failed to challenge that particular ruling in *Columbia I*.³ Instead, it maintains that, because *Columbia I* vacated the summary judgment, that ruling cannot be relied upon as law of the case. Cross-Appellant’s Br. 48–49 (citing *Rumsfeld v. Freedom NY, Inc.*, 329 F.3d 1320, 1332 (Fed. Cir. 2003) (“[A] vacated judgment has no preclusive force . . . as a matter of the law of the case.” (cleaned up))).

Columbia’s argument, however, does not implicate law of the case so much as it does forfeiture⁴—a related, yet distinct, concept in this

³ To be sure, Seirus challenged the district court’s comparison of the claimed and accused designs with Blauer as resulting in factual determinations improperly made against it at summary judgment. But it did not challenge how the district court decided *which* comparison prior art to consider in the first place. Unsurprisingly, given Seirus’s failure to raise that issue, *Columbia I* did not pass upon it. That being so, Seirus’s statements throughout its briefing that *Columbia I* reversed the district court on “exactly th[at] issue[],” Cross-Appellant’s Br. 12—or that Columbia’s position in this appeal regarding comparison prior art is “*directly contrary* to this [c]ourt’s decision in *Columbia I*,” *id.* at 38, 42 (emphasis added)—are inaccurate (at best).

⁴ Although Columbia’s briefing and several authorities on this issue use the term “waiver,” we believe “forfeiture” is more accurate. See 18B Charles Alan Wright, Arthur R. Miller &

area. *See, e.g., Crocker v. Piedmont Aviation, Inc.*, 49 F.3d 735, 739 (D.C. Cir. 1995) (noting that the bar on litigating issues “omitted from prior appeals” is “best understood as a species of waiver doctrine” and is “analytically distinct” from “law-of-the-case doctrine proper”); *id.* at 739–40; *see also* 18B Wright & Miller § 4478.6 (distinguishing between law of the case and forfeiture). The argument is that Seirus’s *failure* to challenge the district court’s scope-of-comparison-prior-art ruling in *Columbia I* cemented that ruling as, essentially, the law of the case. Viewed that way, it is unclear why our disposition in *Columbia I* would relieve Seirus of the consequences of its failure to challenge that particular ruling—at least given that, aside from recounting the ruling as background, *Columbia I*, 942 F.3d at 1130, our disposition neither addressed it nor necessarily disturbed it.

Still, whether to excuse a forfeiture is generally within our discretion. *See, e.g., Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1344 n.7 (Fed. Cir. 2022). And here, the circumstances counsel against letting Seirus’s forfeiture dictate what qualifies as comparison prior art. Seirus’s forfeiture could fairly cover only the district court’s ruling as applied to Boorn and Respass (references the court excluded from consideration). The district court considered Blauer extensively, so Seirus had no

Edward H. Cooper, Federal Practice and Procedure § 4478.6, pp. 786, 791–92 (3d ed. 2019) (observing in this area that, “[a]lthough forfeiture would be a more suitable expression,” that term “is not always used; waiver often takes its place”); *see also In re Google Tech. Holdings LLC*, 980 F.3d 858, 862–63 (Fed. Cir. 2020) (explaining that courts and litigants often use the term “waiver” when applying the doctrine of forfeiture).

occasion to challenge the ruling as applied to Blauer. *See United States v. Lee*, 358 F.3d 315, 324 (5th Cir. 2004) (“An issue is not waived if there was no reason to raise it in the initial appeal.”). And, because Blauer persisted as potential comparison prior art in the infringement trial, Columbia’s current appeal would in any event require us to articulate the proper scope of comparison prior art—an issue of first impression for this court. *See infra* Discussion Part II.A. Because we are just now articulating this scope, we deem it the better course to allow the parties and the district court to engage with it afresh—both as to Blauer and other references. *Cf. Crocker*, 49 F.3d at 740 (noting that an intervening change in the law will support departing from the “previously established law of the case” and that “[t]he preclusive barrier of the waiver doctrine is even one notch weaker”).

Seirus, for its part, likewise invokes law of the case, albeit likewise in a way that implicates forfeiture. According to Seirus, when Columbia failed to challenge (in *Columbia I*) the district court’s decision not to construe the claim, it forfeited the ability to seek a claim construction—thus cementing a non-construction as the law of the case and barring Columbia from arguing about what a heat reflective material is. *See* Cross-Appellant’s Br. 47–48 (arguing that Columbia’s proposed jury instruction—that heat reflective materials not mean *all* materials—is improper due to that alleged forfeiture).

We reject Seirus’s argument. Insofar as *Columbia*

I concerned the D’093 patent,⁵ Columbia came to this court as the appellee, having *prevailed* on infringement. We therefore do not see—nor has Seirus supplied—any reason why Columbia should have quibbled with the district court’s decision not to construe the claim. *See Laitram Corp. v. NEC Corp.*, 115 F.3d 947, 954 (Fed. Cir. 1997) (distinguishing between applying “waiver” as against a prior appellant and appellee and noting that the issue was “not what [appellee] *could* supposedly have argued [in the prior appeal], but rather what it was *required* to argue, or indeed could *properly* have argued” (emphasis in original)); *see also Yesudian ex rel. United States v. Howard Univ.*, 270 F.3d 969, 971 (D.C. Cir. 2001) (“[A]ny forfeiture from failure to raise an issue in an initial appeal is far from absolute, especially where . . . the party failing to present the issue was the appellee, defending on a field of battle defined by the appellant.”). Accordingly, there was no forfeiture here, and therefore nothing amounting to a “law of the case” foreclosing a claim construction or related arguments.

Finally, Seirus argues that Columbia should be judicially estopped from maintaining that the relevant article of manufacture—for purposes of infringement-related comparison prior art—is heat reflective material. *See Cross-Appellant’s Br. 47*. Seirus argues that such a position would be inconsistent with Columbia’s position at the damages trial that the relevant “article of manufacture”—for purposes of calculating damages

⁵ *Columbia I* also concerned a Columbia utility patent that is no longer at issue.

under 35 U.S.C. § 289—is an *entire* end product (e.g., gloves with portions not made of HeatWave material).

We disagree that judicial estoppel is appropriate here. Judicial estoppel “is an equitable doctrine invoked by a court at its discretion.” *New Hampshire v. Maine*, 532 U.S. 742, 750 (2001) (cleaned up). Factors that typically inform whether to apply the doctrine include: (1) whether a party’s earlier and later positions are “clearly inconsistent”; (2) whether the party “succeeded in persuading a court to accept” the earlier position; and (3) whether the party would “derive an unfair advantage or impose an unfair detriment” on the opposing party if not estopped. *Id.* at 750–51 (cleaned up). Setting aside whether Columbia’s positions are “clearly inconsistent”—an issue we do not reach in this case, *cf. infra* Discussion Part III (declining to reach Seirus’s damages issues on the merits)—judicial estoppel is an equitable doctrine. And we see no equity in letting a position Columbia took while securing a (currently inapplicable) damages award impede its efforts to secure infringement liability—and thus damages—*at all*. Any incompatibility between a determination of infringement and the previously determined damages award may be addressed, if at all, if Columbia prevails on infringement.

II

We turn now to Columbia’s challenges to (1) the jury instructions (and exclusion of evidence and argument) concerning comparison prior art and (2) the jury instructions implicating Seirus’s logo.

The parties agree that we should review

Columbia’s jury-instruction challenges under the law of the regional circuit—here, the Ninth Circuit. Appellant’s Br. 46 (citing *Voda v. Cordis Corp.*, 536 F.3d 1311, 1328 (Fed. Cir. 2008)); Cross-Appellant’s Br. 40 (same). We also applied Ninth Circuit law in reviewing a jury-instruction challenge in *Columbia I*. 942 F.3d at 1127–28. We do so again here. That means we “review de novo whether an instruction states the law correctly” and review for abuse of discretion “a district court’s formulation of civil jury instructions.” *Peralta v. Dillard*, 744 F.3d 1076, 1082 (9th Cir. 2014) (en banc); *id.* (noting further that jury instructions must “fairly and adequately cover the issues presented, correctly state the law, and not be misleading”); *see also Gantt v. City of L.A.*, 717 F.3d 702, 706 (9th Cir. 2013) (“Incomplete instructions are treated as legal errors and reviewed de novo as well.”).⁶

⁶ We acknowledge precedent “apply[ing] Federal Circuit law to review the legal sufficiency of jury instructions on an issue of patent law without deference to the district court.” *Eko Brands, LLC v. Adrian Rivera Maynez Enters., Inc.*, 946 F.3d 1367, 1378 (Fed. Cir. 2020) (cleaned up); *see id.* at 1378 & n.4 (asking whether instructions were “incomplete as given” and whether they “correctly state[d] an issue of patent law” (cleaned up)); *see also DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1304 (Fed. Cir. 2006) (en banc in relevant part) (“This [c]ourt . . . only orders a new trial when errors in the instructions as a whole clearly mis- lead the jury.” (cleaned up)). Ultimately, which standard— the Ninth Circuit’s or ours—governs here is immaterial because our conclusions would be the same under either standard. *See ADASA Inc. v. Avery Dennison Corp.*, 55 F.4th 900, 914 (Fed. Cir. 2022) (declining to resolve which standard of review for jury instructions applies when either would produce the same result).

We review the district court’s exclusion of evidence or argument at trial under the law of the regional circuit. *See Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d 1364, 1372 (Fed. Cir. 2011). The Ninth Circuit reviews such rulings for abuse of discretion. *See Wagner v. Cnty. of Maricopa*, 747 F.3d 1048, 1052 (9th Cir. 2013) (evidence); *U.S. Fid. & Guar. Co. v. Lee Invs. LLC*, 641 F.3d 1126, 1137 (9th Cir. 2011) (argument).

We first address the comparison-prior-art issues, then the logo issues.

A

1

We begin with the purpose of comparison prior art in a design-patent infringement analysis.⁷

Before our en banc opinion in *Egyptian Goddess*, design-patent infringement required satisfying two separate tests. One was the ordinary-observer test. *Egyptian Goddess*, 543 F.3d at 670–72 (citing *Gorham*, 81 U.S. at 528). The other was the “point of novelty” test, which asked whether the similarity between the claimed and accused designs was attributable to the novelty that distinguished the claimed design from the prior art. *Id.* at 670–72, 675–76 (discussing *Litton Sys., Inc. v. Whirlpool*

⁷ Using prior art in an infringement analysis is, by and large, peculiar to design-patent law. In analyzing infringement of a *utility* patent (which is the type of patent we usually consider), the task generally consists of simply comparing the properly construed patent claim to the accused product or method. *See, e.g., Philip Morris Prods. S.A. v. ITC*, 63 F.4th 1328, 1348 (Fed. Cir. 2023).

Corp., 728 F.2d 1423 (Fed. Cir. 1984)); *see Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990) (describing this test's purpose as focusing on aspects of a design that render it different from the prior art).

In *Egyptian Goddess*, we eliminated the point-of-novelty test as a separate test and held that the ordinary-observer test is the sole test for design-patent infringement. 543 F.3d at 678. In doing so, however, we retained a role for prior art in cases where “the claimed and accused designs are not plainly dissimilar.” *Id.*; accord *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1337 (Fed. Cir. 2015). Specifically, we explained that in such cases the ordinary-observer test should be applied with reference to prior-art designs, because those designs can inform the perspective of the hypothetical ordinary observer:

Particularly in close cases, it can be difficult to answer the question whether one thing is like another without being given a frame of reference. The context in which the claimed and accused designs are compared, i.e., the background prior art, provides such a frame of reference and is therefore often useful in the process of comparison. Where the frame of reference consists of numerous similar prior art designs, those designs can highlight the distinctions between the claimed design and the accused design as viewed by the ordinary observer.

Egyptian Goddess, 543 F.3d at 676–77; *see Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009) (noting that *Egyptian*

Goddess “refined the ordinary observer test” by incorporating the context of the prior art).

Comparison prior art can help highlight distinctions between the claimed and accused designs because

[w]hen the differences between [those] design[s] are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.

Egyptian Goddess, 543 F.3d at 676. But such art can also cut the other way—i.e., it can highlight *similarities* between the claimed and accused designs. As we explained:

If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing.

Id. at 677.

As Columbia notes, the proper scope of comparison prior art that may be used in an infringement analysis is an issue of first impression for this court.

Columbia correctly states that a design-patent

claim's scope is limited to the article of manufacture identified in the claim (which here is heat reflective material), and it argues that the scope of comparison prior art should be likewise limited. Appellant's Br. 42, 49 (citing *In re Surgisil, L.L.P.*, 14 F.4th 1380, 1382 (Fed. Cir. 2021)). Seirus, though quick to say "that is not the law," Cross-Appellant's Br. 46, does not meaningfully dispute that this is an open question of law. And, outside of a passing remark that comparison prior art must be "close," *id.*, Seirus does not develop a relevant argument as to what the scope should be. In any event, we agree with Columbia.

We have held that, for a prior-art design to anticipate, it must be applied to the article of manufacture identified in the claim. *Surgisil*, 14 F.4th at 1382 (claim scope limited to a lip implant; designs applied to other articles—there, an art tool—could not anticipate). We have also held that, for an accused design to infringe, it must be applied to the article of manufacture identified in the claim. *See Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1336, 1340, 1343 (Fed. Cir. 2019) (claim scope limited to a chair; design applied to a basket could not infringe); *see also Int'l Seaway*, 589 F.3d at 1240 (holding that the same test applies as between design-patent infringement and anticipation). We conclude that this requirement also applies to comparison prior art used in an infringement analysis. That is, to qualify as comparison prior art, the prior-art design must be applied to the article of manufacture identified in the claim.

We apply this requirement to comparison prior art for a few reasons. First, doing so best accords

with comparison prior art's purpose. In an infringement analysis, that purpose is to help inform an ordinary observer's comparison between the claimed and accused designs—designs that, necessarily, must be applied to the same article of manufacture. Naturally, prior-art designs will help in that comparison only to the extent that they too are applied to that article of manufacture.

Second, although the proper scope of comparison prior-art designs has never been squarely at issue in our cases, requiring that such designs be applied to the article of manufacture identified in the claim conforms with many cases in which courts considered such designs—including the cases most instructive on the role of comparison prior art. For example, we have regarded the Supreme Court's *Whitman Saddle* case as foundational for using comparison prior art in an infringement analysis. See *Egyptian Goddess*, 543 F.3d at 672–74, 676 (recounting the history of this issue, beginning with *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893)). There, the patent covered the design of a saddle, and the comparison prior art consisted of saddles. See 148 U.S. at 675–76, 680–82. Likewise, in *Egyptian Goddess*, the patent covered the design of a nail buffer, and the comparison prior art consisted of nail buffers. 543 F.3d at 668, 680–82. Similar examples abound. See, e.g., *ABC Corp. I v. P'ship & Unincorporated Ass'ns Identified on Schedule "A"*, 52 F.4th 934, 937–38, 943 (Fed. Cir. 2022) (hoverboards vs. hoverboard); *Wallace v. Ideavillage Prods. Corp.*, 640 F. App'x 970, 971, 975–76 (Fed. Cir. 2016) (nonprecedential) (body-washing brush vs. body-washing brush); *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314,

1318, 1324–25 (Fed. Cir. 2007) (sprayer shroud vs. sprayer shrouds); *Unidynamics Corp. v. Automatic Prods. Int’l, Ltd.*, 157 F.3d 1311, 1313, 1324 (Fed. Cir. 1998) (vending machine for food vs. vending machines for food).⁸

Third, using the same scope for anticipatory prior art and comparison prior art makes good practical sense. This standard is already in the system. *Surgisil*, 14 F.4th at 1382. It is also easy to articulate and provides clear boundaries. *See*

⁸ Although neither party’s briefing raised it as an issue, we recognize that, in *Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337 (Fed. Cir. 2020), we “[saw] no error” in the district court’s rejection of the patentee’s “attempt to distinguish its patent [covering a pencil-shaped chalk holder] from the prior art [e.g., pencils] by importing . . . ‘the chalk holder function of its design’ into the construction of the claim.” *Id.* at 1342–43 (quoting *Lanard Toys Ltd. v. Toys “R” Us-Del., Inc.*, No. 3:15-cv-849, 2019 WL 1304290, at *13 (M.D. Fla. Mar. 21, 2019)). Critically, however, the patentee there had not argued that pencil designs should not be considered as comparison prior art for the design of a pencil-shaped chalk holder—a point the district court repeatedly emphasized. *Lanard*, 2019 WL 1304290, at *12 (“Although Lanard emphasizes throughout its briefing that the [patent] pertains to a chalk holder specifically, Lanard does not contend that pencils and pencil-shaped containers are not appropriately considered as prior art.”); *id.* at *13 n.15 (“Lanard does not dispute that the [c]ourt can properly consider such objects in its analysis of the prior art.”). Moreover, in the patentee’s appeal to this court, the only developed argument in its opening brief concerning the district court’s treatment of the prior art was that the district court had improperly revived the point-of-novelty test—an argument we separately rejected. *Lanard*, 958 F.3d at 1344; *see also* Opening Br. of Pl.-Appellant Lanard Toys Ltd. at 24–25, 43–46, *Lanard Toys Ltd. v. Dolgencorp LLC*, No. 19-1781 (Fed. Cir. July 17, 2019), ECF No. 20. We therefore do not regard *Lanard* as controlling on the proper scope of comparison prior art.

Curver, 938 F.3d at 1341 (“[T]ying the design pattern to a particular article provides more accurate and predictable notice about what is and is not protected by the design patent.”). Further, close questions may arise as to the relationship between a given article of manufacture and what the claim identifies. Such questions could arise in the context of determining whether a prior-art design could anticipate or whether an accused design infringes. But such questions could just as easily arise in the context of establishing the comparison prior art itself—i.e., in setting the background for an infringement analysis. Using the same standard in each of these contexts allows litigants, courts, and the U.S. Patent and Trademark Office to benefit from guidance provided in any one of them.

In sum, we conclude for the foregoing reasons that, to qualify as comparison prior art, the prior-art design must be applied to the article of manufacture identified in the claim.

Returning now to the case at hand, Columbia argues that the district court erred by failing to instruct the jury as to the scope of the D’093 patent claim (design for a heat reflective material) and, relatedly, the proper scope of comparison prior art. We agree. That error might be characterized as a failure to “fairly and adequately cover the issues presented,” see *Peralta*, 744 F.3d at 1082, or the giving of “[i]ncomplete instructions,” see *Gantt*, 717 F.3d at 706. The problem was that, aside from the date and publication requirements for comparison prior art, the jury lacked the correct standard for determining whether an admitted reference

qualified as such art. Whether a particular reference meets that standard for comparison prior art—i.e., whether it discloses a design applied to the article of manufacture identified in the claim—is a question of fact reserved for the fact finder (at least, where there could be reasonable disagreement on that fact question such that it has not been reduced to a question of law). *See, e.g., ADASA*, 55 F.4th at 910 (noting in the utility-patent context that the “question of what a reference teaches and whether it describes every element of a claim is a question for the finder of fact” (cleaned up)). But the standard *itself* is legal. And the failure to provide it was error—albeit quite an understandable one, given that we have only now articulated the standard.

We are also persuaded by Columbia’s showing on this record that this error was prejudicial, and we are unpersuaded by Seirus’s attempt to show otherwise. *Compare* Appellant’s Br. 60–62, *and* Appellant’s Reply Br. 25, *with* Cross-Appellant’s Br. 63–66. This prejudicial error warrants vacating the non-infringement judgment and remanding for further proceedings. *See, e.g., Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 869 (9th Cir. 2020).

Columbia also argues that the district court abused its discretion in prohibiting Columbia from trying to distinguish Boorn, Respass, or Blauer as not disclosing designs applied to heat reflective material. More generally, Columbia argues that heat reflective material is a genuinely distinct article of manufacture and does not mean just *any* material. Seirus, however, maintains that permitting distinctions among materials (as articles of manufacture) based on whether they are

heat reflective would improperly read a functional limitation into Columbia's design patent. *E.g.*, Cross-Appellant's Br. 38, 43–46. Without opining on what might qualify as a heat reflective material—a matter not currently before us—we may safely clear up Seirus's general misconception about the role of function in design patents.

It is true that valid design patents cannot be directed to designs that are primarily functional, as opposed to ornamental. *See, e.g., Ethicon*, 796 F.3d at 1328. But it is also true that “design patents are granted only for a design *applied to an article of manufacture.*” *Curver*, 938 F.3d at 1340 (emphasis added); *accord Surgisil*, 14 F.4th at 1382; *see also* 35 U.S.C. § 171 (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor”). And *articles of manufacture* have functions. *Ethicon*, 796 F.3d at 1328. An article's function “must not be confused with ‘functionality’ of the *design* of the article.” *Hupp v. Siroflex of Am.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997) (emphasis added). Concern with the latter is what has featured prominently in our case law. The idea is to preclude design-patent protection for something that, though purported to be an “ornamental” design, is really dictated by function. *See Ethicon*, 796 F.3d at 1328–30.

Here, the issue we are confronting is not whether the D'093 patent's *design* (e.g., a wavy pattern) is dictated by function. Rather, the issue is whether the claimed *article* to which that design is applied is the same as another article. A natural, relevant consideration for distinguishing one article from another involves looking to the articles' respective functions. That is one way we could tell in *Surgisil*

that an art tool was not a lip implant: one was “used for smoothing and blending large areas of pastel or char- coal”; the other was for implanting in a lip. *See* 14 F.4th at 1381–82 (cleaned up).⁹ Even if the two *designs* in *Surgisil* might have looked similar in some respects, the art- tool design could not anticipate the lip-implant design be- cause those designs were applied to different *articles*. And we knew they were different articles at least in part be- cause of their different functions. But, aside from clarifying that referencing functionality to distinguish articles of manufacture is not categorically impermissible, we need not further address Columbia’s argument that the district court abused its discretion in prohibiting Columbia from trying to make such distinctions, as we have already remanded for further proceedings based on the comparison- prior-art jury-instruction issue.

Columbia further asks us to direct that none of Boorn, Respass, and Blauer be considered as comparison prior art at any new trial. This we decline to do in the first instance. The main problem with Columbia’s request is that its opening brief did not adequately preserve a challenge to the district court’s admission of these references. Instead, its brief focused on the district court’s jury instructions

⁹ This is not to say that simply including some function with a claimed article’s description (e.g., via naming or argument) will necessarily exclude articles from a design- patent claim’s scope that would otherwise fall within it. For example, we suspect that, if a design patent were some- how granted for a design applied to a “flower pot *for planting daisies*,” designs applied to prior-art flower pots not so designated could still anticipate. Including that additional function (“for planting daisies”) would not necessarily ren- der the *article* genuinely distinct from other flower pots.

and prohibition of Columbia’s attempt to distinguish the admitted references. *See, e.g.*, Appellant’s Br. 2–4 (Statement of the Issues); *id.* at 41–44 (Summary of Argument); *see also* Oral Arg. at 10:16–11:00, 15:37–16:08, 18:03–19:28 (discussing the preservation issue).¹⁰ That preservation shortcoming, along with the fact that the district court has not yet had a chance to engage with the standard we have articulated, counsels against granting Columbia’s request.¹¹

On remand, the district court will likely be confronted with questions implicating what qualifies as heat reflective material. Such questions could be difficult to answer without knowing what heat reflective material is. The district court may therefore wish to consider construing that term. The parties have at various points offered their view of what it means. Columbia has indicated it means “a material designed to reflect heat,” *see* J.A. 6696 (Columbia’s Opening *Markman* Brief), or “metallic foil on a base material to reflect heat,” Appellant’s Br. 63 (citing J.A. 617–18). Seirus, on the other hand, has indicated that heat reflective material means *any* material—on the theory that, as a matter of physics, *all* materials reflect heat to some extent. *See* Cross-Appellant’s Br. 49 (citing J.A. 363). Without

¹⁰ No. 21-2299, https://oralarguments.cafc.uscourts.gov/default.aspx?fl=21-2299_01122023.mp3.

¹¹ Given the circumstances, however—including Columbia’s other challenges concerning comparison prior art and the proper scope of such art being an issue of first impression—we do not think any forfeiture-based “law of the case” principles regarding Columbia’s inadequate preservation of an appellate challenge to the district court’s admission of these references should bar any effort by Columbia to secure their exclusion at any new trial.

evaluating the merit of Seirus’s position, we feel compelled to note that the accused design here is not applied to just *any* material. It is instead applied to material (called Heat- Wave, of all things) that Seirus touts for its heat reflective qualities. *See, e.g.*, J.A. 3834 (Seirus marketing materials describing HeatWave as “reflect[ing] radiated heat back for more warmth”). This might suggest that, at least in the minds of some, heat reflective material connotes something genuinely distinct from just any material. But again, we leave it to the district court on remand to determine whether and to what extent the term needs construing.

B

We turn now to Columbia’s jury-instruction challenges related to Seirus’s logo. Columbia challenges the district court’s jury instructions as erroneous for not specifying (1) that consumer confusion as to source is irrelevant to design-patent infringement, or (2) that a jury need not find a likelihood of consumer confusion to find such infringement. Because Columbia’s challenges implicate distinctions between trademark (including trade-dress) law on the one hand and design-patent law on the other, we briefly discuss the relevant legal principles applicable to each before considering those challenges.

1

Trademark and design-patent infringement differ as to the relevance of consumer confusion regarding a product’s source. Trademark infringement *requires* that consumers will likely be confused as to

a product's source.¹² *See, e.g., Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (noting that the Lanham Act “broadly prohibits uses of trademarks, trade names, and trade dress that are likely to cause confusion about the source of a product”); *see also* 4 McCarthy § 23:1; 1 McCarthy § 8:1. For design-patent infringement, however, “[l]ikelihood of confusion as to the source of the goods is not a necessary or appropriate factor.” *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986); *see also Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 828 (Fed. Cir. 1992) (noting that, while “purchasers’ likelihood of confusion as to the source of a good is a necessary factor for determining trademark and trade dress infringement,” “a different quantum of proof applies to design patent infringement, which does not concern itself with the broad issue of consumer behavior in the marketplace”).

Given this difference, applying a logo or other clear source identifier in conjunction with a product can create different effects as between trademark and design-patent infringement. For trademark infringement, a distinctive logo’s application can, under some circumstances, be significant evidence that there will be no consumer confusion as to a product’s source, and therefore no infringement. *See, e.g., Groeneveld Transp. Efficiency, Inc. v. Lubecore Int’l, Inc.*, 730 F.3d 494, 515 (6th Cir. 2013) (“[The

¹² Although trademark infringement contemplates additional types of confusion, *see, e.g., J. Thomas McCarthy*, 4 McCarthy on Trademarks and Unfair Competition §§ 23:5, 23:8, 24:6 (5th ed. 2023), for simplicity’s sake—and because of the nature of Columbia’s jury-instruction challenges—we refer specifically to confusion as to a product’s source.

accused infringer] has in fact scrupulously avoided such confusion by choosing a starkly different logo that it prominently displays on its [products] and on all its sales and marketing literature.”); *Int’l Ass’n of Machinists & Aerospace Workers, AFL-CIO v. Winship Green Nursing Ctr.*, 103 F.3d 196, 204 (1st Cir. 1996) (“[W]e have recognized that in certain circumstances otherwise similar marks are not likely to be confused if they are used in conjunction with clearly displayed names, logos[,] or other source-identifying designations of the manufacturer.” (collecting cases)); *see also Converse, Inc. v. ITC*, 909 F.3d 1110, 1124 (Fed. Cir. 2018) (noting, in a trade-dress case, that “we have not held that [brand-name] labeling is always legally sufficient to avoid likelihood of confusion but rather that those labels may be highly probative evidence”); 4 McCarthy § 23:53.

Logos are analyzed somewhat differently in the design-patent context. Again, because design-patent infringement does not consider consumer confusion as to source, such infringement “is not avoided ‘by labelling.’” *Columbia I*, 942 F.3d at 1131 (quoting *L.A. Gear*, 988 F.2d at 1126); *see also id.* (“A would-be infringer should not escape liability for design patent infringement if a design is copied but labeled with its name.”). But logos are hardly irrelevant, either. As we explained in *Columbia I*, our precedent “does not prohibit the fact finder from *considering* an ornamental logo, its placement, and its appearance as one among other potential differences between” a claimed and accused design. *See id.* (emphasis in original). Indeed, it would be improper “to ignore elements of the accused design entirely, simply because those elements included the

name of the [accused infringer].” *Id.*

The takeaway is: just because consumers might not be confused about an accused product’s *source*, that alone would not preclude an ordinary observer from deeming the claimed and accused *designs* similar enough to constitute design-patent infringement. See *Braun*, 975 F.2d at 828 (discussing differences between trademark and design-patent infringement and noting that what matters for the latter is “that an ordinary observer would be deceived *by reason of an accused [product]’s ornamental design*” (emphasis added)). At the same time, however, 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.

2

With these legal principles in mind, we consider Columbia’s logo-related jury-instruction challenges.

Again, the district court’s jury instruction on design-patent infringement did two basic things. First, it recited the ordinary-observer test for infringement—the very test we endorsed in *Columbia I* and have endorsed numerous times in the past. J.A. 1520; see *Columbia I*, 942 F.3d at 1129; see also, e.g., *Egyptian Goddess*, 543 F.3d at 678 (“[I]n accordance with *Gorham* and subsequent decisions, we hold that the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed.”). Second, it added that the jury did “not need, however, to find

that any purchasers were actually deceived or confused by the appearance of the accused products.” J.A. 1520.

Columbia insists that the district court erred by not going further—by not adding that consumer confusion as to source is irrelevant for design-patent infringement, or that *likelihood* of confusion (in addition to actual confusion) need not be found. We disagree. The district court gave the ordinary-observer test for design-patent infringement materially identically to how the Supreme Court and this court have stated it, and it added that actual confusion was not necessary to find design-patent infringement. These could hardly be called incorrect statements of law. And we are not convinced that the district court’s decision not to include Columbia’s requested additions or clarifications was an abuse of discretion or resulted in instructions that were misleading or incomplete.¹³

That said, we are not insensitive to Columbia’s overarching concern. At a surface level, the ordinary-observer test could be read as evoking concepts of consumer confusion as to source, given that it asks whether the

¹³ Indeed, although Columbia challenges the jury instructions, its real complaint seems to lie with the following statement Seirus made during closing:

Hard to imagine *with all those logos* that an ordinary observer, the consumer, would be deceived . . . I don’t see how that’s possible *because Seirus is telling the world this is ours*. This is ours.

Appellant’s Br. 77 (emphasis and alterations supplied by Columbia) (quoting J.A. 1225–26). But, outside of using these statements to animate its challenges to the jury instructions, Columbia has not suggested that these statements themselves provide a basis for appellate relief.

resemblance between two designs “is such as to deceive [an ordinary] observer, inducing him to purchase one supposing it to be the other,” *Gorham*, 81 U.S. at 528. In design- patent-infringement cases involving logos, we appreciate the potential for a jury to be led astray and mistakenly conflate the significance of a logo’s *source-identifying* function with whatever impact it might have on a comparison of the *designs*. But district courts are in the best position to decide whether and when to provide clarification in the course of conducting a trial. And here we see no legal error or abuse of discretion in the district court’s jury instructions, which are the only subject of Columbia’s challenge on this issue.

III

We turn now to Seirus’s conditional cross-appeal regarding damages.

Seirus argues that, for purposes of calculating damages under 35 U.S.C. § 289,¹⁴ the relevant “article of manufacture” is the HeatWave material—not the entire end product to which it is applied (e.g., gloves with portions not made of HeatWave material). Cross-Appellant’s Br. 66–67 (encouraging us to “streamline further proceedings” by so holding). Seirus also argues that the district court erred by instructing the jury (at the damages trial)

¹⁴ Section 289 provides (in relevant part):

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

that *Seirus* bore the burden of proving that the article of manufacture for § 289 damages purposes is less than the entire end product. According to *Seirus*, Columbia—as the patentee—bore the burden of proving what that article is. The parties further disagree as to whether any damages retrial on profit-disgorgement issues should be tried to a jury or the bench.

As we indicated in *Columbia I*, these are important issues. *See* 942 F.3d at 1132. But we did not reach them there because our disposition left the case with no infringement determination. *See id.* Because our disposition here likewise leaves the case without an infringement determination, we do not reach these issues.

CONCLUSION

We have considered the parties' remaining arguments and find them unpersuasive. For the foregoing reasons, we vacate the non-infringement judgment and remand for further proceedings.

35 U.S.C. § 289.

VACATED AND REMANDED

COSTS

Costs to Columbia.

APPENDIX B

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

2018-1329, 2018-1331, 2018-1728

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

Decided: November 13, 2019

NICHOLAS (NIKA) FREMONT ALDRICH, JR.,
Schwabe, Williamson & Wyatt, Portland, OR, argued
for plaintiff-appellant. Also represented by **DAVID
W. AXELROD, SARA KOBAK.**

SETH MCCARTHY SPROUL, Fish & Richardson,
PC, San Diego, CA, argued for defendant-cross-
appellant. Also represented by **CHRISTOPHER
MARCHESE, OLIVER RICHARDS, TUCKER N.
TERHUFEN.**

Before LOURIE, MOORE, and STOLL, *Circuit Judges*.

LOURIE, *Circuit Judge*.

Columbia Sportswear North America, Inc. (“Columbia”) appeals from the U.S. District Court for the Southern District of California’s judgment after a jury trial that claims 2 and 23 of U.S. Patent 8,453,270 (“the ’270 patent”) are invalid as anticipated and obvious. *See* Judgment, *Columbia Sportswear N. Am. v. Seirus Innovative Accessories, Inc.*, No. 3:17-cv-01781 (S.D. Cal. Nov. 22, 2017), ECF No. 403. Seirus Innovative Accessories, Inc. (“Seirus”) cross-appeals from the U.S. District Court for the District of Oregon’s grant of summary judgment that it infringes U.S. Patent D657,093 (“the ’093 patent”) and from its entry of the jury’s damages award. *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 202 F. Supp. 3d 1186 (D. Or. 2016) (“*Summary Judgment Decision*”). Because we conclude that the court did not err in holding claims 2 and 23 of the ’270 patent invalid but that it did err in granting summary judgment of infringement for the ’093 patent, we affirm-in-part, reverse-in-part, and remand for further proceedings.

BACKGROUND

At issue in these proceedings are two patents: the ’270 patent and the ’093 patent. The ’270 patent is a utility patent directed to materials that use a pattern of heat-directing elements coupled to a base fabric to manage heat through reflection or conductivity. ’270 patent col. 1 ll. 22–27. Figures in the patent depict the material’s use in cold-weather and camping gear, including jackets, boots, gloves, hats, pants, sleeping bags, and tents. *Id.* figures 4–

15. At issue here are claims 2 and 23. Claim 2 depends from claim 1, which recites:

1. A heat management material adapted for use with body gear, comprising:

a base material having a transfer property that is adapted to allow, impede, and/or restrict passage of a natural element through the base material; and

a discontinuous array of discrete heat-directing elements, each independently coupled to a first side of a base material, the heat directing elements being positioned to direct heat in a desired direction, wherein a surface area ratio of heat-directing elements to base material is from about 7:3 to about 3:7 and wherein the placement and spacing of the heat-directing elements permits the base material to retain partial performance of the transfer property.

Id. col. 8 ll. 8–22. Claim 2 further requires that “the base material comprises an innermost layer of the body gear having an innermost surface, and wherein the heat-directing elements are positioned on the innermost surface to direct heat towards the body of a body gear user.” *Id.* col. 8 ll. 23–26.

The '093 patent is a design patent drawn to the “ornamental design of a heat reflective material.” As with all design patents, what is claimed is “the ornamental design . . . as shown and described.” 37 C.F.R. § 1.153(a). Figure 1 depicts the claimed wave-pattern design:

41a

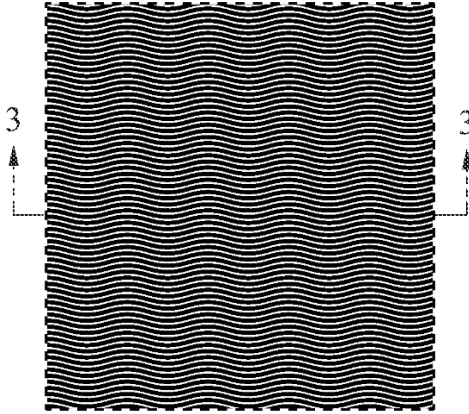


FIG. 1

Several remaining figures in the patent depict the design as applied to sleeping bags, boots, pants, gloves, and jack- ets. '093 patent figures 4–10.

On January 12, 2015, Columbia filed suit in the Dis- trict of Oregon accusing Seirus of infringing both patents. Seirus first filed a motion to dismiss for improper venue under Fed. R. Civ. P. 12(b)(3). Relying on *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574 (Fed. Cir. 1990), Seirus argued that it was not subject to personal jurisdiction in Oregon, so it did not reside in the district for purposes of 28 U.S.C. § 1400(b). Defendant Seirus Innova- tion Accessories, Inc.'s Memorandum in Support of Motion to Dismiss, or, Alternatively, Transfer Venue to the South- ern District of California, *Columbia Sportswear N. Am. v. Seirus Innovative Accessories, Inc.*, No. 3:17-cv-01781 (Feb. 27, 2015), ECF No. 16. Seirus moved in the alternative to transfer the case to the Southern

District of California for convenience. The court declined to dismiss or transfer the case because it found itself to have personal jurisdiction over Seirus and found the convenience transfer factors to be balanced. *See Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, No. 3:15-CV-00064-HZ, 2015 WL 3986148, at *1 (D. Or. June 29, 2015).

The district court also granted summary judgment that Seirus's HeatWave products infringe the '093 patent. *See Summary Judgment Decision*, 202 F. Supp. 3d 1186. The court first held that the "ordinary observer" for the design patent infringement analysis would be the end buyer and user of Seirus's gloves and products. *Id.* at 1192. Viewing the designs side-by-side, the court then reasoned that "even the most discerning customer would be hard pressed to notice the differences between Seirus's HeatWave design and Columbia's patented design," characterizing the difference in wave pattern, orientation, and the presence of Seirus's logo as "minor differences." *Id.* at 1192–93.

Two years after its first venue motion, Seirus moved again under Rule 12(b)(3) to dismiss the case for lack of jurisdiction or to transfer it to the Southern District of California. This time, Seirus's argument relied on the Supreme Court's intervening decision in *TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 137 S. Ct. 1514 (2017), which overruled *VE Holding*. Although it found Seirus had waived its venue challenge, the district court found *TC Heartland* to be "an intervening change in the law excusing [Seirus]'s waiver" and transferred the case to the Southern District of California. *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 265 F. Supp. 3d 1196, 1208 (D. Or. 2017) ("*Transfer*

Decision”).

In that court, infringement and invalidity of the '270 patent were tried to a jury, and the jury determined that claims 2 and 23 were invalid as both anticipated and obvious. *See* Jury Verdict Form, *Columbia Sportswear N. Am. v. Seirus Innovative Accessories, Inc.*, No. 3:17-cv-01781 (Sept. 29, 2017), ECF No. 377, J.A. 4–6. The jury did not reach the issue of infringement of the '270 patent. The jury also considered damages and willfulness for infringement of the '093 patent, awarding Columbia \$3,018,174 in damages but finding that the infringement was not willful. *Id.*

Both parties filed post-trial motions for judgment as a matter of law and for a new trial, but the court summarily denied them in a two-page opinion. J.A. 7–9. Both parties filed notices of appeal. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

In its appeal, Columbia argues that the district court should have granted its motion for judgment as a matter of law that the invention of the '270 patent was not anticipated and would not have been obvious at the time of the invention. Columbia also asks us to grant it a new trial on validity issues for the '270 patent. If the case is remanded for any reason, Columbia requests that we reverse the district court's decision, rendered after *TC Heartland*, to transfer the case to the Southern District of California. In the cross-appeal, Seirus requests that we reverse the district court's grant of summary judgment that its products infringe the '093 patent and reverse or vacate the damages. We consider each issue in turn.

In reviewing issues tried to a jury, we review the district court’s denial of post-trial motions for judgment as a matter of law and for a new trial under the law of the regional circuit—here, the Ninth Circuit. *See Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197, 1202 (Fed. Cir. 2010) (citing *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1370 (Fed. Cir. 2009)). In evaluating a district court’s ruling on motions for judgment as a matter of law, we ask whether the verdict was supported by substantial evidence. *Unicolors, Inc. v. Urban Outfitters, Inc.*, 853 F.3d 980, 984 (9th Cir. 2017) (citing *Harper v. City of Los Angeles*, 533 F.3d 1010, 1021 (9th Cir. 2008)). Under Ninth Circuit law, “[a] jury’s verdict must be upheld if supported by substantial evidence.” *OTR Wheel Eng’g, Inc. v. W. Worldwide Servs. Inc.*, 897 F.3d 1008, 1015 (9th Cir. 2018) (citing *Unicolors*, 853 F.3d at 984). “Substantial evidence is evidence adequate to support the jury’s conclusion, even if it is possible to draw a contrary conclusion from the same evidence,” and “[t]he credibility of the witnesses and the weight of the evidence are issues for the jury and are generally not subject to appellate review.” *Id.*

We review the district court’s denial of a motion for a new trial for an abuse of discretion. *Molski v. M.J. Cable, Inc.*, 481 F.3d 724, 728 (9th Cir. 2007) (citing *Dorn v. Burlington N. Santa Fe R.R. Co.*, 397 F.3d 1183, 1189 (9th Cir. 2005)). Rule 59(a)(1)(A) provides that the district court may grant a motion for a new trial after a jury trial “for any reason for which a new trial has . . . been granted in an action at law in federal court.” A “motion for a new trial may invoke the discretion of the court in so far as it is bottomed on the claim that the verdict is against

the weight of the evidence . . . and may raise questions of law arising out of alleged substantial errors in admission or rejection of evidence or instructions to the jury.” *Montgomery Ward & Co. v. Duncan*, 311 U.S. 243, 251 (1940). In the Ninth Circuit, a “trial court may grant a new trial only if the verdict is contrary to the clear weight of the evidence, is based upon false or perjurious evidence, or to prevent a miscarriage of justice.” *Passantino v. Johnson & Johnson Consumer Prods., Inc.*, 212 F.3d 493, 510 n.15 (9th Cir. 2000) (citing *Ace v. Aetna Life Ins. Co.*, 139 F.3d 1241, 1248 (9th Cir. 1998), *cert denied*, 525 U.S. 930 (1998)).

I. THE APPEAL – THE ’270 PATENT

We first consider the jury’s findings that the ’270 patent is invalid. At trial, Seirus presented two invalidity grounds to the jury: that the asserted claims were anticipated by Fottinger and that the claims would have been obvious over Fottinger alone or in combination with one of Halley, Worley, Vaughn, or Blauer. The jury found the claims invalid under both theories.

Fottinger, U.K. Patent Application GB 2,073,613A, describes textile sheets coated on at least one face with a binder and metal powder. Fottinger lists as suitable “[a]ll known dispersible binders” and comments that aluminum or aluminum alloy are preferred metals. The coating is described as discontinuous and as coating from 5% to 40% of the surface area of the coated face, while the textile sheet is described as “very suitable for use as interlinings and as lining fabrics for articles of clothing.” Fottinger col. 2 ll. 48–50.

The other references each relate to outerwear

materials with various coatings. Halley, U.S. Patent Application 2002/0197924, relates to composite lining materials for garments. Halley Abstract. Halley describes a water-resistant, water-vapor permeable, flexible substrate that has fabric secured to one side and a plurality of discrete abrasion-resisting polymeric dots on the other. *Id.* The abrasion-resisting dots cover 30% to 70% by area of the flexible substrate, and “coverage of the substrate material is not too great to substantially affect the water-vapor-permeability thereof.” *Id.* ¶ 44.

Vaughn, U.K. Patent Application GB 2,350,073, similarly describes a water-resistant water-vapor permeable material with polymer coating to improve abrasion resistance, while Blauer, U.S. Patent 5,626,949, describes a breathable shell for outerwear with a high tensile strength stratum printed on the inner face of the fabric, covering 10% to 90% of the surface area of the inner face. Worley, U.S. Patent 7,135,424, also describes a substrate coated discontinuously with a polymeric material for use in apparel, footwear, medical products, and other products.

Columbia argues on appeal that the district court should have granted its motion for JMOL that the claims are not anticipated and would not have been obvious over the references. It devotes most of its briefing to the anticipation ground. But because we agree with Seirus that substantial evidence supports the jury’s verdict that the claims would have been obvious, we need not reach Columbia’s anticipation arguments.

Columbia raises two challenges to the jury’s obviousness findings: (1) that Fottinger fails to

disclose certain claim limitations, and (2) that Seirus's expert testimony was deficient. First, Columbia argues that Fottinger fails to teach the placement of "discrete heat directing elements," "each individually coupled" to a base material, on the "innermost surface" of a garment. Specifically, Columbia points to a passage in Fottinger that states that the disclosed materials are "very suitable for use as interlining and as lining fabrics" and suggests that interlinings differ from the innermost surface of a garment. Appellant's Br. 44 (citing Fottinger, col. 2 ll. 48–52). Columbia further maintains that Fottinger does not disclose heat-directing elements because the plastic binder in Fottinger does not direct heat, and, if the aluminum particles in the binder are considered to be the heat-directing elements, those particles are not independently coupled to the base material as required by the claims.

To the extent Seirus relies on other references to meet these limitations, Columbia argues that the record lacks evidence regarding combining the art. Additionally, Columbia contends that a person of skill would not have expected 30% to 70% coverage to be successful in view of Fottinger, which teaches no more than 40% coverage of a material with the binder.

Second, Columbia argues that this case involves a technical area beyond the training and education of most jurors and thus requires competent expert testimony on the issue of obviousness. Columbia then suggests that Dr. Block's testimony is unable to support the jury's verdict because he failed to apply the correct legal standard for obviousness and failed to consider objective indicia in his analysis.

As to the merits of the obviousness defense, Seirus responds that the range in Fottinger and the range in the claims overlap and that the overlap establishes a prima facie case of obviousness, which was not rebutted. Seirus also counters that Fottinger discloses every limitation of the claims, but, to the extent Fottinger fails to meet every limitation, Seirus relies on any of Vaughn, Halley, Blauer, and Worly as disclosing 30% to 70% coverage.

In response to Columbia's argument regarding expert testimony, Seirus maintains that expert testimony is not required in this case because the references are easily understandable. If expert testimony is required, however, Seirus relies on Dr. Block's testimony and argues that it is legally correct.

We agree with Seirus that the jury's obviousness verdict was supported by substantial evidence. Obviousness is a question of law, supported by underlying fact questions. *In re Baxter Int'l, Inc.*, 678 F.3d 1357, 1361 (Fed. Cir. 2012). In evaluating obviousness, we consider the scope and content of the prior art, differences between the prior art and the claims at issue, the level of ordinary skill in the pertinent art, and any secondary considerations. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966). “[A] prima facie case of obviousness arises when the ranges of a claimed composition overlap the ranges disclosed in the prior art.” *In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005) (citing *In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003)). The parties dispute three claim limitations: (1) “discrete heat directing elements” that are “each individually coupled to a base material; (2) that those elements are present on the innermost surface

of a garment; and (3) that the elements cover 30% to 70% of the base material.

Fottinger discloses “a textile sheet” with a “discontinuous coating comprising a binder and metal powder” covering “from 5 to 40% of the surface area of the coated face.” Fottinger col. 2 ll. 54–60. The jury was entitled to rely on Fottinger’s disclosed “discontinuous coating comprising a binder and metal powder” as the claimed “discrete heat directing element.” Likewise, the jury was entitled to read Fottinger’s disclosure that the coating is “on at least one face” and could be used as “lining fabrics for articles of clothing” to mean that Fottinger’s coated face was on the innermost surface of a garment. The range of coverage in Fottinger significantly overlaps that in the claims, and “even a slight overlap in range establishes a *prima facie* case of obviousness.” *In re Peterson*, 315 F.3d at 1329.

Columbia’s specific arguments that the heat directing elements in Fottinger are the aluminum particles and that the Fottinger coating could not have been on the innermost surface of a garment are simply inconsistent with the facts as indicated above. The record evidence was “adequate to support the jury’s conclusion,” even if Columbia would “draw a contrary conclusion from the same evidence.” *OTR Wheel Eng’g*, 897 F.3d at 1015.

Columbia also argues that Seirus’s obviousness defense lacked necessary, competent expert testimony. But we are not persuaded that the legal determination of obviousness in this case requires such evidence. The technology here—coated materials for cold weather and outdoor products—is “easily understandable without the need for expert

explanatory testimony.” *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009) (quoting *Centricut, LLC v. Esab Grp., Inc.*, 390 F.3d 1361, 1369 (Fed. Cir. 2004)). The primary topics covered by the ’270 patent specification are the pattern of the heat-directing elements, percentage coverage of the base material, and the various ways the material could be used in body gear. There is no discussion of thermodynamics or the mechanism that yields the claimed material’s heat retentive properties in the patent. Thus, given the patent and references’ general, easily understood language, this is not a case that requires expert explanation. See *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1348 (Fed. Cir. 2017) (holding expert testimony was not required for motivation to combine where the specification and claims did not include any new manufacturing equipment or instructions to produce the claimed food containers). Because expert testimony is not required in this case, Columbia’s critiques of Dr. Block’s testimony do not persuade us that Columbia is entitled to judgment as a matter of law.

In light of the foregoing and considering the record before the district court, the jury’s verdict that the claims of the ’270 patent would have been obvious is certainly supported by substantial evidence, and judgment as a matter of law was properly denied.

Columbia argues in the alternative that it is entitled to a new trial for two reasons: (1) because the court declined to instruct the jury with Columbia’s proposed instruction

on anticipatory ranges and (2) because Seirus's expert, Dr. Block, falsely testified that Fottinger taught an embodiment with 36% coverage.

First, Columbia argues that the district court should have instructed the jury to apply a set of factors in determining whether Fottinger's overlapping range anticipates the range in the claims. The proposed instruction would have asked the jury to consider whether "there is a considerable difference" between the two ranges, whether the claimed range was "critical to the invention," and whether the claimed range "performs contrary to what might be expected from the prior art." J.A. 1567.

Because Columbia does not challenge the instructions given as misleading or incorrect statements of the law, we review the district court's jury instruction for an abuse of discretion. *Mockler v. Multnomah Cty.*, 140 F.3d 808, 812 (9th Cir. 1998). Further, in the Ninth Circuit, "[h]armless error review applies to jury instructions in civil cases." *Kennedy v. S. Cal. Edison Co.*, 268 F.3d 763, 770 (9th Cir. 2001). We need not decide whether the district court abused its discretion in declining to instruct the jury on anticipatory ranges because the jury also found the claims obvious under other jury instructions unchallenged by Columbia on appeal. Any error in the instructions for anticipation thus constitutes harmless error.

Second, Columbia submits that Dr. Block's testimony regarding Fottinger entitles it to a new trial. Specifically, Dr. Block testified at trial that Fottinger's use of a "25 mesh" with half-millimeter spots yielded an embodiment with 36% coverage.

Both Seirus and Columbia agree that this testimony was incorrect. Appellant's Br. 68; Appellee's Br. 64. Seirus characterizes Dr. Block's testimony as an error in interpreting how the dot pattern in Fottinger repeated, Appellee's Br. 67, while Columbia characterizes it as intentionally introduced false testimony, Appellant's Br. 69–70.

We have considered the issue of false testimony in at least two cases, *Fraige v. American-National Watermat-tress Corp.*, 996 F.2d 295 (Fed. Cir. 1993), and *Rembrandt Vision Technologies, L.P. v. Johnson & Johnson Vision Care, Inc.*, 818 F.3d 1320 (Fed. Cir. 2016). Both came to us after denials of motions under Rule 60(b), which specifically provides for relief from a judgment in the case of fraud. Even putting aside this procedural difference, however, the facts here—a few lines of mistaken expert testimony—are in stark contrast to the facts in those cases. For example, in *Fraige*, the defendant's fraudulent conduct was so significant that the court imposed sanctions against the defendant under Fed. R. Civ. P. 11 and referred the matter of misconduct to the United States Attorney. 996 F. 2d at 296–97. In *Rembrandt*, an expert falsely testified about performing experiments material to the issues in the case and withheld data that would have undermined his opinions. 818 F.3d at 1323–24. Such conduct infects the proceedings and can result in an unfair trial, but the record here is not comparable. Even if Dr. Block purposefully misrepresented the contents of Fottinger, Fottinger itself was in the record for the jury to consider. The jury could have easily verified any representations about the reference. Moreover, Columbia had ample opportunity to cross-examine Dr. Block on his incorrect understanding of

Fottinger's disclosure. Under these circumstances and given the uncomplicated nature of the evidence, we cannot conclude that Dr. Block's misstatements warrant a new trial.

II. THE CROSS APPEAL – THE '093 PATENT

In the cross-appeal, Seirus argues that the district court erred in granting summary judgment that its products infringe the '093 patent and that the court made a series of errors regarding damages for infringing that patent. But, because we agree with Seirus that the district court erred in granting summary judgment, we need not reach its arguments regarding damages.

We review a grant of summary judgment under the law of the regional circuit, which in this case is the Ninth Circuit. *See Charles Mach. Works, Inc. v. Vermeer Mfg. Co.*, 723 F.3d 1376, 1378 (Fed. Cir. 2013). The Ninth Circuit “review[s] a district court’s order granting or denying summary judgment de novo.” *City of Pomona v. SQM N. Am. Corp.*, 750 F.3d 1036, 1043 (9th Cir. 2014).

Summary judgment is appropriate when the moving party demonstrates that “there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322–23 (1986). “We determine, viewing the evidence in the light most favorable to the non-moving party, whether there are any genuine issues of material fact and whether the district court correctly applied the relevant substantive law.” *Wallis v. Princess Cruises, Inc.*, 306 F.3d 827, 832 (9th Cir. 2002) (citing *Clicks Billiards, Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1257 (9th Cir. 2001)). The court “does not

weigh the evidence or determine the truth of the matter, but only determines whether there is a genuine issue for trial.” *Balint v. Carson City*, 180 F.3d 1047, 1054 (9th Cir. 1999) (citing *Summers v. A. Teichert & Son, Inc.*, 127 F.3d 1150, 1152 (9th Cir. 1997)).

Design patent infringement is a question of fact, which a patentee must prove by a preponderance of the evidence. *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010) (citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993)). The “ordinary observer” test is the sole test for determining whether a design patent has been infringed. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc). The test originates from the Supreme Court’s *Gorham* decision, which provides that “if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.” *Gorham Co. v. White*, 81 U.S. 511, 528 (1871). “The ordinary observer test applies to the patented design in its entirety, as it is claimed.” *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010). The ordinary observer is considered to be familiar with prior art designs, and “[w]hen 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.” *Id.* (citing *Egyptian Goddess*, 543 F.3d at 681). “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.” *Id.*

In analyzing whether Seirus’s products infringe, the district court began by identifying the ordinary observer. The court found that it was the “retail customer who buys and uses Seirus’s products lined with the HeatWave fabric to keep their hands, feet, or head warm during outdoor activities,” and deemed such an end buyer and user of Seirus’s products to be the ordinary observer. *Summary Judgment Decision*, 202 F. Supp. 3d at 1192. Considering the designs side-by-side, the court found that “even the most discerning customer would be hard pressed to notice the differences between Seirus’s HeatWave design and Columbia’s patented design.” *Id.*

Seirus argued that there were substantial and significant differences between the designs—including that the waves in Seirus’s design were interrupted by repeated use of Seirus’s logo, that waves varied in terms of orientation, spacing, and size, and especially that some of the designs differed by 90°. But the district court disagreed. First, the district court declined to consider Seirus’s logo placement because logo placement was not claimed in Columbia’s patent. *Id.* at 1194. As for orientation, the court discounted this feature because the ’093 patent did not require a particular design orientation. In comparing the wave spacing and size, the court found those differences were not claimed in the patent and were irrelevant to its analysis. *Id.* at 1195. Even considering the differences, however, the court found them to be “so minor as to be nearly imperceptible” and that they

did “not change the overall visual impression that the Seirus design is the same as Columbia’s patented one.” *Id.* To complete its analysis, the court considered Seirus’s submitted prior art designs, which the court found to be “far afield from Columbia’s ‘heat management materials.’” *Id.* at 1196. Considering the closest design, however, the court found Columbia and Seirus’s designs to be “substantially closer” than the pattern disclosed in a prior art patent. *Id.* at 1197.

Seirus argues that this case should not have been resolved on summary judgment because of several fact disputes. For example, Seirus suggests that the parties disputed the identity of the ordinary observer, and a jury could have determined that the ordinary observer was a sophisticated, commercial buyer, not an end customer buying the products directly. Appellee’s Br. 23. Such a buyer, according to Seirus, would have noticed differences between the designs, including the physical orientation of the designs and the thickness of the waves. Seirus also contests the court’s evaluation of the prior art as improper resolution of disputed fact issues. Seirus argues that the district court’s principal mistake, however, was to “ignore the repeating Seirus logo boxes, which are an integral part of the accused design.” *Id.* at 28. According to Seirus, excluding such ornamental elements of the accused design simply because they include its logo is at odds with this court’s jurisprudence that the ordinary observer compare the overall appearance of the two designs.

Columbia responds that there was no genuine dispute of material fact regarding infringement. According to Columbia, the ordinary observer is not the intervening commercial reseller but the end

consumers who are the principal purchasers of products with Seirus's design. Regarding Seirus's logo, Columbia argues that its presence does not make Seirus's design less infringing, and, when the design is compared without the logo, it is virtually identical to that claimed in the '093 patent. As for the product's orientation, Columbia argues that fabric can be oriented in any direction depending on how it is held, so the court was correct to reject Seirus's defense that orientation was material to the analysis.

Given the record in this case, we are persuaded that the district court erred in granting summary judgment of infringement for two reasons: (1) the court improperly declined to consider the effect of Seirus's 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.

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.” *Id.* at 1126. 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. 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.

Before the district court, Seirus raised several disputed fact issues regarding differences between its design and Columbia’s patented one. For example, Seirus argued that the waves in its design are not of a uniform thickness, whereas the ’093 patent waves are consistent and that this difference would affect the infringement analysis. However, the court found that the wave thickness was not claimed in Columbia’s patent. This finding is in error, however, because the claim of the ’093 patent is drawn to the “ornamental design of a heat reflective material as shown and described,” and Columbia’s design has uniform line thickness in every figure in the patent.

The court then deemed the wave thickness difference “minor” and found that it did “not change the overall visual impression that the Seirus design is the same as Columbia’s patented one.” *Summary Judgment Decision*, 202 F. Supp. 3d at 1195. But the district court’s piecemeal approach, considering only if design elements independently affect the overall visual impression that the designs are similar, is at odds with our case law requiring the fact-finder to analyze the design as a whole. *See Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006). An ordinary observer is deceived by an infringing design as a result of “similarities in the overall design, not of similarities in ornamental

features considered in isolation.” *Id.* at 1371.

Likewise, in evaluating the prior art, the court erroneously compared Columbia’s design, Seirus’s HeatWave product’s design, and a prior art patent design side-by-side before concluding that “[t]he overall visual effect of the Columbia and Seirus designs are nearly identical and if the logo was removed from the Seirus design, an ordinary observer would have great difficulty distinguishing between the Seirus and Columbia designs.” *Summary Judgment Decision*, 202 F. Supp. 3d at 1197.

The district court’s evaluation of the prior art and its evaluation of wave thickness present another problem. In both instances, the district court made a finding of fact— whether an element of Seirus’s design would give an ordinary observer a different visual impression than Columbia’s design—over a disputed factual record. Such fact findings are not permitted by Rule 56 and should be re- solved by a jury on remand.

The parties raise additional issues regarding the court’s damages award under 25 U.S.C. § 289. For example, Columbia argues that the § 289 remedy is one of disgorgement that should be tried to the bench. And there is a significant issue as to whether the proper article of manufacture in this case should be the HeatWave product actually sold or the fabric encompassing the design. Both of these issues are important, but we do not reach them be- cause we have vacated the infringement finding.

III. VENUE

Columbia challenges the district court’s transfer

of the case to California. This case was initially filed in the District of Oregon in January 2015. In Seirus's initial responsive pleadings, it contested personal jurisdiction, and, relying on *VE Holding*, venue. Two years later, the Supreme Court decided *TC Heartland*, which overruled *VE Holding*. Thereafter, Seirus filed a renewed motion to dismiss or transfer the case for improper venue, now relying on *TC Heartland*.

Considering the fact that Seirus had filed a Rule 12 motion without challenging venue under § 1400(b) as interpreted by *Fourco Glass Co. v. Transmirra Products Corp.*, 353 U.S. 222 (1957), the court first found that Seirus waived its venue objection under Fed. R. Civ. P. 12(g). *Transfer Decision*, 265 F. Supp. 3d at 1202. The court then considered whether Seirus's litigation conduct amounted to waiver of any objection to venue. Comparing this case to other district court cases on this issue, the court found that Seirus had engaged in substantially more litigation conduct than the defendants in those cases and had waived its defense on this basis as well. *Id.* at 1202–03. Although Seirus had waived its objection to venue in two different ways, the court excused that waiver because *TC Heartland* constituted an intervening change in the law. Thus, the court transferred the case to the Southern District of California. *Id.* at 1203–08.

We review a district court's decision to exercise or, as here, not exercise its inherent power to find waiver for an abuse of discretion. *See Dietz v. Bouldin*, 136 S. Ct. 1885, 1895 (2016) (reviewing a district court's exercise of its inherent power to rescind a discharge order and recall a dismissed jury for an abuse of discretion); *In re Micron Tech.*,

Inc., 875 F.3d 1091 (Fed. Cir. 2017).

Columbia argues that the court’s decision to excuse Seirus’s waiver was in error, and that, if this case is remanded for any reason, we should “hold that the transfer of venue was improper[] and remand with an order to transfer the case back to the District of Oregon for all further proceedings.” Appellant’s Br. 74. Columbia relies on this court’s *In re Micron* decision to argue that *TC Heartland*’s intervening change in the law excused only Seirus’s Rule 12 waiver, not its litigation conduct-based waiver.

Seirus contests Columbia’s interpretation of this court’s *Micron* decision and maintains that the district court acted within its discretion to excuse both rule- and non-rule-based waiver.

The Federal Rules of Civil Procedure provide that “[e]very defense to a claim for relief in any pleading must be asserted in the responsive pleading if one is required.” Fed. R. Civ. P. 12(b). Motions asserting certain defenses, however, including improper venue must be filed before a responsive pleading is filed. Fed. R. Civ. P. 12(b)(3). A party that moves under Rule 12 for improper venue “must not make another motion under this rule raising a defense or objection that was *available* to the party but omitted from its earlier motion.” Fed. R. Civ. P. 12(g)(2), (h)(1). “[I]ssues of waiver or forfeiture of patent-venue rights under § 1400(b) and § 1406(a) are governed by [Federal Circuit] law,” *In re Oath Holdings Inc.*, 908 F.3d 1301, 1305 (Fed. Cir. 2018), and we addressed the circumstances under which a district court can find patent venue waived in *In re Micron*, 875 F.3d at 1100–01.

In *Micron*, as here, the defendant failed to raise a venue defense contesting that the definition of “resides” in 28 U.S.C. § 1391(b) was trumped by the patent-venue statute, § 1400, in its first motion under Rule 12 but proceeded to do so in a later motion after the Court issued *TC Heartland*. Noting that controlling precedent precluded a district court from accepting a litigant’s objection to venue before *TC Heartland*, we held that the venue defense was “not ‘available’” and that Rule 12’s waiver rule was inapplicable. *In re Micron*, 875 F.3d at 1100.

We further explained, however, that a district court could find a venue defense waived outside of the Rule 12 framework. While Rule 12(h)(1) provides for waiver in certain circumstances, “[i]t does not state that there is no other basis on which a district court might find a defendant to have forfeited an otherwise-meritorious venue defense.” *Id.* Relying on the Supreme Court’s *Dietz* decision, we explained that a district court’s inherent authority to manage its own affairs to achieve the orderly and expeditious disposition of cases permits it to find forfeiture of a venue objection, provided that the court respects and does not circumvent relevant rights granted by statute or rule. *Id.* at 1101. Such “authority must be exercised with caution to avoid the forbidden circumvention.” *Id.*

Columbia submits that our *Micron* decision stands for the proposition that “*TC Heartland*’s intervening change in the law only excused rule-based waiver.” Appellant’s Br. 73. Columbia is incorrect. In *Micron*, this court explained that the district court had *authority* to find waiver outside of the context of Rule 12. But we did not prohibit a district court from

excusing litigation conduct-based waiver based on an intervening change in the law. The court found that “[i]t would have been unreasonable to expect [Seirus] to argue that venue was proper only in the state of its incorporation prior to *TC Heartland*,” and that finding was not an abuse of discretion. *Transfer Decision*, 265 F. Supp. 3d at 1207. Indeed, “[j]ust because a district court has the inherent power to [find waiver] does not mean that it is appropriate to use that power in every case.” *Dietz*, 136 S. Ct. at 1893. Because the district court did not abuse its discretion in excusing Seirus’s waiver of its venue defense, we do not find that the district court needs to retransfer this case back to Oregon.

CONCLUSION

We have considered the parties’ remaining arguments but find them unpersuasive. Accordingly, we affirm the district court’s judgment that claims 2 and 23 of the ’270 patent are invalid under § 103, reverse the district court’s grant of summary judgment that Seirus infringed the ’093 patent, and remand for further proceedings concerning the design patent in the Southern District of California.

**AFFIRMED-IN-PART, REVERSED-IN-PART,
AND REMANDED**

COSTS

Costs to Seirus.

APPENDIX C

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

**COLUMBIA SPORTSWEAR NORTH AMERICA,
INC.,**
Plaintiff-Appellant

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.,
Defendant-Cross-Appellant

2021-2299, 2021-2338

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

ON PETITION FOR REHEARING EN BANC

Before MOORE, *Chief Judge*, LOURIE, DYK,
PROST, REYNA, TARANTO, CHEN, HUGHES,
STOLL, CUNNINGHAM, and STARK, *Circuit
Judges*.¹

PER CURIAM.

¹ Circuit Judge Newman did not participate.

65a

ORDER

Seirus Innovative Accessories, Inc. filed a petition for rehearing en banc. The petition was first referred as a petition to the panel that heard the appeal, and thereafter the petition was referred to the circuit judges who are in regular active service.

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue December 29, 2023.

Date: December 22, 2023

/s/ Jarrett B. Perlow
Clerk of Court

APPENDIX D

IN THE UNITED STATES DISTRICT COURT FOR
THE SOUTHERN DISTRICT OF CALIFORNIA

No. 3:17-cv-01781-HZ

COLUMBIA SPORTSWEAR
NORTH AMERICA, INC.,
Plaintiff,

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.,
Defendant.

JUDGMENT

HERNÁNDEZ, District Judge:

This matter being tried and the jury having rendered its verdict on August 6, 2021, IT IS ORDERED AND ADJUDGED that judgment is entered in favor of Defendant Seirus Innovative Accessories, Inc., and against Plaintiff Columbia Sportswear North America, Inc.

DATED: August 10, 2021.

/s/ Marco A. Hernández
United States District Judge

APPENDIX E

IN THE UNITED STATES DISTRICT COURT FOR
THE DISTRICT OF OREGON

No. 3:15-cv-00064-HZ

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

v.

SEIRUS INNOVATIVE ACCESSORIES, a Utah
corporation,
Defendant.

OPINION & ORDER

Nicholas F. Aldrich, Jr.
David W. Axelrod
Scott D. Eads
Schwabe Williamson & Wyatt, PC
1211 SW Fifth Avenue, Ste. 1600
Portland, OR 97204
Attorneys for Plaintiff

Eric M. Jaegers
Troutman Sanders LLP
11682 El Camino Real, Ste. 400
San Diego, CA 92130

Matthew D. Murphey
Troutman Sanders LLP
5 Park Plaza , Ste. 1400

Irvine, CA 92614

Alison A. Grounds
Paul E. McGowan
Troutman Sanders LLP
600 Peachtree St. NE, Ste. 5200
Atlanta, GA 30308

Anup M. Shah
Troutman Sanders LLP
301 S. College St., Ste. 3400
Charlotte, NC 28202

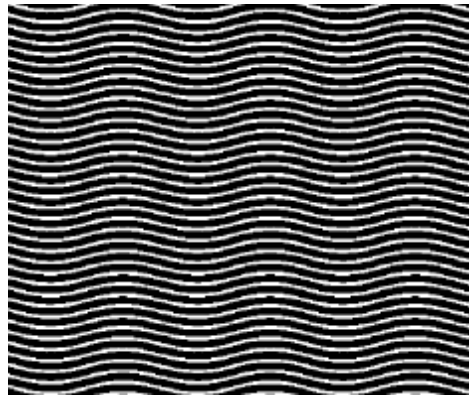
Jasmine C. Hites
Troutman Sanders LLC
100 SW Main, Ste. 1000
Portland, OR 97204
Attorneys for Defendant

HERNÁNDEZ, District Judge:

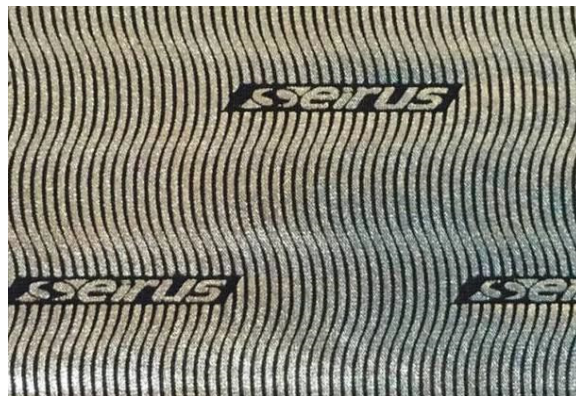
Plaintiff, Columbia Sportswear North America, Inc. (“Columbia”) owns three patents, U.S. Patent Nos. 8,424,119 (the ’119 Patent), 8,453,270 (the ’270 Patent), and D657,093 (the D’093 patent), protecting its “Omni-Heat” technology, a heat reflective material that can reflect body heat but allow for breathability and moisture wicking. Compl. ¶ 2. The Omni-Heat material is used as a lining in a variety of outdoor gear such as jackets, shirts, gloves, and more. Defendant Seirus Innovative Accessories, Inc. (“Seirus”) sells its own brand of cold weather gear, including gloves and glove liners with a breathable, heat reflective material it calls HeatWave. Aldrich Decl. Exs. O, T, U, ECF 76-3. Columbia alleges that

69a

Seirus's HeatWave product infringes its Omni-Heat patents, including design patent D'093. Columbia's patented design and Seirus's HeatWave design are depicted below:



Columbia's D'093 design



Seirus's HeatWave

The Court recently issued a claim construction Opinion & Order in which it declined to give a textual construction to Columbia's patented design,

choosing to address the parties' legal arguments about the scope of Columbia's D'093 patent in this Opinion & Order. Currently before the Court is Columbia's motion for partial summary of infringement of the design patent D'093. The striking visual similarity between Seirus's design and Columbia's patented design is likely to confuse an ordinary observer, and therefore, Columbia's motion is granted.

STANDARDS

Summary judgment is appropriate if there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. FED. R. CIV. P. 56(a). The moving party bears the initial responsibility of informing the court of the basis of its motion, and identifying those portions of “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any,” which it believes demonstrate the absence of a genuine issue of material fact.” Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986) (quoting FED. R. CIV. P. 56(c)).

Once the moving party meets its initial burden of demonstrating the absence of a genuine issue of material fact, the burden then shifts to the nonmoving party to present “specific facts” showing a “genuine issue for trial.” Fed. Trade Comm'n v. Stefanchik, 559 F.3d 924, 927–28 (9th Cir. 2009) (internal quotation marks omitted). The nonmoving party must go beyond the pleadings and designate facts showing an issue for trial. Bias v. Moynihan, 508 F.3d 1212, 1218 (9th Cir. 2007) (citing Celotex, 477 U.S. at 324).

The substantive law governing a claim determines whether a fact is material. Suever v. Connell, 579 F.3d 1047, 1056 (9th Cir. 2009). The court draws inferences from the facts in the light most favorable to the nonmoving party. Earl v. Nielsen Media Research, Inc., 658 F.3d 1108, 1112 (9th Cir. 2011).

DISCUSSION

I. Design Patent Infringement Standard

“A design patent protects the nonfunctional aspects of an ornamental design as shown in the patent.” Arminak & Associates, Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1319 (Fed. Cir. 2007) abrogated on other grounds by Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) (quotation omitted); see also 35 U.S.C. § 171 (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”). “[A] design patent is infringed by the ‘unauthorized manufacture, use, or sale of the article embodying the patented design or any colorable imitation thereof.’” Arminak, 501 F.3d at 1319 (quoting Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1116–17 (Fed. Cir. 1998)).

Infringement of a design patent is evaluated in a two-step process similar to that of a utility patent. “First, the court must construe the claims of the design patent to determine their meaning and

scope.” Id. (citing OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1404–05 (Fed. Cir. 1997). Design patents typically are claimed as shown in drawings, though district courts have the discretion to construe design patents with a detailed textual description. Goodyear, 162 F.3d at 1116. The court then compares the construed claims to the accused design. Id. at 1320. The accused product infringes the design patent if “the designs have the same general visual appearance, such that it is likely that the purchaser (or the ordinary observer) would be deceived into confusing” the two designs. Id.; see also Crocs, Inc. v. Int’l Trade Comm’n, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (design patent is infringed if “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.”); Gorham Manufacturing Co. v. White, 81 U.S. (14 Wall.) 511, 528 (1871) (“[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”).

“[I]n conducting a design patent infringement analysis, the patented design is viewed in its entirety, as it is claimed. The ultimate question requires determining whether ‘the effect of the whole design is substantially the same.’ ” Payless Shoesource, Inc. v. Reebok Int’l Ltd., 998 F.2d 985, 990–91 (Fed. Cir. 1993) (citing L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d at 1117, 1918 (Fed. Cir. 1993) (quotation and alterations omitted). “[M]inor differences between a patented design and

an accused article's design cannot, and shall not, prevent a finding of infringement." Id. (citing Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984); see also Crocs, 598 F.3d at 1303 (explaining that the focus of the infringement analysis is the "overall impression of the claimed ornamental features" rather than "small differences in isolation.")).

II. Infringement Analysis

As mentioned above, the Court recently issued an Opinion & Order in which it declined to give a textual construction to Columbia's D'093 patent. See Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679 (Fed. Cir. 2008) (the "preferable course ordinarily will be for a district court not to attempt to 'construe' a design patent claim by providing a detailed verbal description of the claimed design."). Accordingly, the Court turns here to the second step of the infringement analysis: comparing Columbia's patented design and Seirus's accused HeatWave design and asking "whether an ordinary observer, familiar with the prior art . . . would be deceived into believing" the Seirus design is the same as Columbia's patented one. Id. at 681.

a. Ordinary Observer

The first issue to address is the identity of the ordinary observer. Arminak, 501 F.3d at 1321 ("A question that is central to this case, and every design patent case, is the identity of the 'ordinary observer' of the design at issue . . ."). "[T]he focus is on the actual product that is presented for purchase, and

the ordinary purchaser of that product.” Goodyear Tire, 162 F.3d at 1117 (Fed. Cir. 1998) (abrogated on other grounds by Egyptian Goddess, 543 F.3d at 678).

The ordinary observer in this case is a retail customer who buys and uses the articles of manufacture Seirus sells—gloves, socks, hats, and other gear—that incorporate the patented design. Gorham, 81 U.S. at 528 (describing “ordinary observers” as those “who buy and use” the products at issue); see also Braun Inc. v. Dynamics Corp. of Am., 975 F.2d 815, 820 (Fed. Cir. 1992) (proper ordinary observer in a design patent case involving hand held blenders was a person seeking to purchase such a blender)

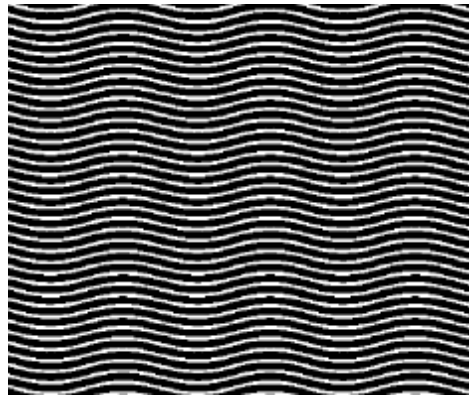
Seirus argues that the ordinary observer here should be the “commercial purchaser rather than an individual consumer.” Defendant’s Response (“Def. Resp.”) at 15–16, ECF 82. But the cases it cites in support are all readily distinguishable because they did not involve products that were intended for sale to retail consumers. For example in Arminak, the patented design at issue was a “trigger shroud,” which in turn was part of a “trigger sprayer,” a device that attaches to the top of a bottle with a tube extending down into the liquid to create a spray bottle. 501 F.3d at 1318. The ordinary observer of the trigger shroud was the industrial purchaser and not a retail customer because it was the purchaser who bought and used the trigger shroud by combining it with other parts to create a finished retail product (such as a bottle of glass cleaner). Id. at 1323–24. Similarly, in a case involving the design

of a lingerie hanger specially designed to create more efficient retail displays, the court correctly found that the ordinary observer was “not the general public, but the sophisticated buyer for the garment manufacturer, who purchase[d] the hangers” and used them to create the displays. Spotless Enterprises, Inc. v. A & E Products Grp. L.P., 294 F. Supp. 2d 322, 347 (E.D.N.Y. 2003). Here, by contrast, it is the retail customer who buys and uses Seirus’s products lined with the HeatWave fabric to keep their hands, feet, or head warm during outdoor activities. Thus, the ordinary observer in this case is the end buyer and user of Seirus’s gloves and other products.

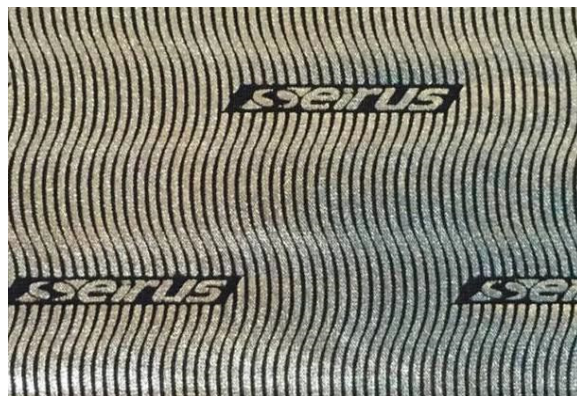
Finally, Seirus argues that its products are “specialty products” and thus the “appropriate ordinary observer is more discriminating about design differences.” Def. Resp. at 16 (citing Arc’teryx Equip., Inc. v. Westcomb Outerwear, Inc., No. 2:07-CV-59 TS, 2008 WL 4838141, at *2 (D. Utah Nov. 4, 2008)). The plaintiff in Arc’teryx asserted that a competing design for a “curvilinear zipper” infringed its design patent. Id. at *1. “The parties agree[d] that the ‘ordinary observer’ . . . [was] an outdoor clothing customer who is more discerning than an average retail shopper.” Id. at *2. The Court then found that the defendant’s zipper design was noninfringing because the ordinary observer would clearly see that the accused zipper had three sections, not two like the patented design. Id. at *3. Further, the accused zipper was much longer and was placed in a different section of the coat than the patented design. Id. When compared to the prior art, the court found the accused zipper was closer to another patent than the plaintiff’s asserted patent.

Id. Thus, “based on the differences” between the two items, “no reasonable jury could find that an ordinary observer, familiar with the prior art, would be deceived into confusing” the two designs. Id.

But here, even the most discerning customer would be hard pressed to notice the differences between Seirus’s HeatWave design and Columbia’s patented design:



Columbia’s D’093 design



Seirus's HeatWave

The overall visual impression of these two designs is strikingly similar, as both use a nearly identical wave pattern with contrasting colors, and the waves have approximately the same wave length and amplitude. A customer shopping for outdoor gear with a heat-reflective element could easily be confused into thinking that the Seirus product was actually a Columbia product, or that the Seirus product was somehow affiliated with Columbia's patented design. As explored in more detail below, Seirus argues that its design is distinguishable because it incorporates the Seirus logo and its wave pattern is slightly irregular and vertically oriented. But those minor differences, to the extent they are relevant at all, do not change the conclusion that the effect of the whole Seirus design is substantially the same as Columbia's patented design. Payless Shoesource, Inc. v. Reebok Int'l Ltd., 998 F.2d 985, 990–91 (Fed. Cir. 1993) (citing L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d at 1117, 1918 (Fed. Cir. 1993) (“The ultimate question [of design patent infringement] requires determining whether the effect of the whole design is substantially the same. Moreover, . . . minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement.”)) (citations and quotation marks omitted).

III. Substantially Dissimilarity

“In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not

met its burden of proving the two designs would appear ‘substantially the same’ to the ordinary observer, as required by Gorham.” Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008). Seirus asserts that “[t]his is one of those instances,” Def. Resp. at 18, and points to the following “substantial and significant differences” between the two designs:

- “[T]he waves appearing in the accused design are ***decidedly interrupted***” by the repeated use of its logo. Def. Resp. at 9 (double emphasis in original).
- “[T]he wavy lines are at all times orthogonal¹ to the ‘Seirus’ surface ornamentation, giving them a vertical appearance in comparisons to the ‘Seirus’ design.”
- “[T]he lines in the accused wave pattern are neither uniformly-spaced nor uniformly-sized.”

Def. Resp. at 9–10. None of these purported “substantial and significant” distinguishing features stands up to scrutiny.

a. Logo

Seirus’s first claimed distinguishing feature is that its logo, or as Seirus artfully describes it, the Seirus “surface ornamentation,” is an “innate and

¹ “Orthogonal” means “at a right angle.”

integral” part of the wavy-lined design of its “HeatWave” fabric. Def. Resp. at 9. It is, however, well-settled that a defendant cannot avoid infringement by merely affixing its logo to an otherwise infringing design. L.A. Gear, 988 F.2d at 1126 (“Design patent infringement . . . does not . . . allow of avoidance of infringement by labelling.”); Cornucopia Products, LLC v. Dyson, Inc., No. CV 12-00234-PHX-NVW, 2012 WL 3094955, at *4 (D. Ariz. July 27, 2012) (explaining that, in applying the ordinary observer test, “labeling usually may not be considered. The company logo undoubtedly helps ordinary observers distinguish products, but design patent protection would essentially collapse if putting one’s own logo on an otherwise identical product could defeat the ordinary observer test.”); Torspo Hockey Int’l Inc. v. Kor Hockey Ltd., 491 F. Supp. 2d 871, 881 (D. Minn. 2007) (“[T]he presence of a logo cannot defeat a design-infringement claim[.]”); Rockport Co., Inc. v. Deer Stags, Inc., 65 F. Supp. 2d 189, 195 (S.D.N.Y. 1999) (defendant’s mark was “irrelevant” to question of design patent infringement). Therefore the Court does not consider Seirus’s “surface ornamentation,” i.e. the Seirus logo, in the infringement analysis.

Seirus asserts that “courts can consider logos . . . when applying the ordinary observer test.” Def. Resp. at 21 (citing Apple Inc. v. Samsung Elecs. Co., No. 11-CV-01846-LHK, 2011 WL 7036077, at *16 (N.D. Cal. Dec. 2, 2011)). But that argument ignores a key distinguishing fact in the Apple analysis, as Judge Koh stated:

Typically, the use of a mark will not avoid

infringement of an otherwise infringing product. *See L.A. Gear*, 988 F.2d at 1126 (“Design patent infringement ... does not ... allow avoidance of infringement by labeling”). Nonetheless, a logo’s placement can be considered **when logo placement and appearance are part of the style claimed** in the patented designs.

Id. (emphasis added). Here, Columbia’s patents do not claim logo placement as part of the claimed design. Thus, that passage from Apple simply does not come into play.

Finally, Seirus’s reliance on the Warsaw case to support its argument regarding the “significance of surface ornamentation” is similarly inapt. Def. Resp. at 19 (citing Warsaw Orthopedic, Inc. v. NuVasive, Inc., No. 12-cv-2738-CAB (MDD), slip op. at 11 (S.D. Cal. Oct. 20, 2015)). In that case, the added “ornamentations” were not a logo, but numerical markings on a medical device that served a functional purpose (specifically, measuring the diameter of a dilation). See id. Seirus’s logo here on its “HeatWave” fabric, by contrast, does not serve any purpose other than to identify the source of the products, according to deposition testimony from Seirus’s President:

Q: And you wanted customers to identify this fabric with Seirus’s brand; is that right?

A: Of course.

Q: And so that’s why you put the logo in

this fabric as you were – the fabric design as you were developing it; is that right?

A: That's correct.

Aldrich Decl. Ex. A, ECF 93, at 155:12–18. Moreover, Columbia provided a number of examples of Seirus marketing materials where the Seirus logo does not appear on the fabric. See Pl. Reply at 7–10. Seirus's President explained that "it is not necessary to put [the logo] in back drop iterations of the wave if it's very clear in the document that this product is sourced by Seirus." Id. at 205:10–14. It is evident, then, that Seirus's logo is a source identifier and not some functional marking that might bring the present case more in line with Warsaw.

b. Vertical Orientation

Another "distinguishing feature" Seirus claims is that its "wavy lines are at all times orthogonal to the 'Seirus' surface ornamentation, giving them a vertical appearance" Def. Resp. at 9. But the scope of the '093 patent is not limited to a particular orientation; the figures used in the patent show that the fabric is used in multiple orientations, including on the horizontal and diagonal. See D'093 patent, figs. 7–9. Secondly, Columbia also produced pictures of Seirus products where the wavy lines fabric is horizontally oriented, and Seirus's President admitted in his deposition that the orientation of the lines in the HeatWave pattern depends on how the product is held:

Q: If the lines—if the wavy lines move in the direction of the wrist to the fingertip, is that horizontal?

...

A: If you hold the product so that they are horizontal it would be.

Aldrich Decl. Ex. A at 180:11–16; see also Pl. Reply at 16–17.

Finally, Judge Koh rejected a similar argument in another Apple v. Samsung decision. Samsung argued that the Apple’s D’889 patent for the iPad was invalid in part because “drawings showing the design oriented in different directions make it impossible to know which way the design is supposed to be oriented” Apple, Inc. v. Samsung Elecs. Co., 932 F. Supp. 2d 1076, 1085 (N.D. Cal. 2013). “[C]ontrary to Samsung’s assertion,” Judge Koh wrote, “there is simply no requirement that a claimed design must have a particular preferred orientation; indeed, Samsung cites no law even suggesting that there is.” Id. at 1086. “The fact that the D’889 Patent shows a design in different orientations merely shows that the particular orientation— landscape or portrait, head-on or perspective—is not part of what is claimed.” Id. at 1086.

Similarly here, there is nothing in the D’093 patent requiring the design to be oriented any

particular way. As a practical matter, this makes sense because the fabric is intended to line body gear; the direction of the wavy lines changes as the fabric is fitted into jacket sleeves or fingers of gloves. Therefore, the Court does not consider the particular orientation of the wavy lines as a distinguishing feature.

c. Difference in Line Width

Finally, Seirus asserts that its wavy-line design for the HeatWave fabric is distinguishable from Columbia's patented design because the lines in the accused design "are neither uniformly-spaced nor uniformly sized." Def. Resp. at 9–10. But again, those limitations are not claimed in the patent, and thus are not relevant to the analysis. Unique Functional Products, Inc. v. Mastercraft Boat Co., 82 F. App'x 683, 690 (Fed. Cir. 2003) ("[T]he '777 patent is not limited to any particular size or color. We conclude, therefore, that the court erred by taking those features into consideration in its infringement analysis[.]"); Hutzler Mfg. Co. v. Bradshaw Int'l, Inc., No. 11 CIV. 7211 PGG, 2012 WL 3031150, at *12 (S.D.N.Y. July 25, 2012) ("Where—as here—the design patent is not limited to a particular size, color, or construction material, such factors should not be taken into consideration in performing an infringement analysis."). Moreover, even considering the slight variation in wave width or spacing, the differences between the Seirus design and the Columbia design are so minor as to be nearly imperceptible, and do not change the overall visual impression that the Seirus design is the same as Columbia's patented one. Crocs, 598 F.3d at 1303

(“Minor differences between a patented design and an accused article’s design cannot, and shall not, prevent a finding of infringement.”).

IV. Prior Art Comparisons

“[T]he ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art.” Egyptian Goddess, 543 F.3d at 676. “When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art.” Id. “And when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.” Id.; see also Arcteryx, 2008 WL 4838141 at *3 (comparing and contrasting claimed design and accused design to prior art). “[I]f the accused infringer elects to rely on the comparison prior art as part of its defense against the claim of infringement, the burden of production of that prior art is on the accused infringer.” Egyptian Goddess, 543 F.3d at 678. “The accused infringer is the party with the motivation to point out close prior art, and in particular to call to the court’s attention the prior art that an ordinary observer is most likely to regard as highlighting the differences between the claimed and accused design.” Id.

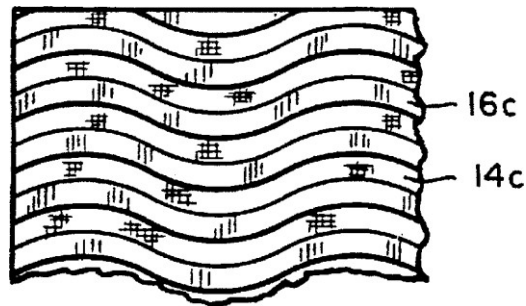
Seirus presents a small collection of prior art that reflects “wavy line” designs. Def. Resp. at 25–29. But

Seirus's prior art consists almost entirely of utility patents which disclose functional, not aesthetic features, such as skid-resistant footwear, or latex glove grips. Columbia's D'093 patent protects the "**ornamental design** of a heat reflective material, as shown and described," meaning the utility patents are of little, if any relevance. See 35 U.S.C. § 171 (protecting "any new, original and ornamental design for an article of manufacture . . .").

Moreover, the vast majority of Seirus's prior art covers products far afield from Columbia's "heat management materials," which, again, significantly limits the relevance of the prior art in this case. Courts examining design patents in relation to prior art cabin their analysis to prior art specific to the class of articles identified in the design patent at issue. See, e.g., Egyptian Goddess, 543 F.3d at 680 (comparing claimed and accused nail buffer designs with "[t]he two closest prior art nail buffers"); Arminak, 501 F.3d at 1324–25 (comparing claimed and accused designs for spray bottle trigger shrouds against prior spray bottle trigger shroud designs); Cornucopia Products, 2012 WL 3094955 at *4 (explaining that "the ordinary observer is assumed to be familiar with the prior art—*i.e.*, all relevant preexisting designs for similar products," and then comparing claimed and accused fan design against prior fan designs); Arc'teryx, 2008 WL 4838141 at *3 (comparing claimed and accused designs for jacket zippers against prior designs for jacket zippers). Accordingly, Seirus's prior art that discloses shoe treads (Ostberg '131 and Di '716), textured grips for gloves (Smalls '121), a utility for creating stronger fabrics (Respress '792), and other industrial utility

patents (Boorn '690, Pratte '191) is not relevant to a comparison between Columbia's and Seirus's designs for heat reflective material.

The only prior art that even approaches relevance to Columbia's design patent are a pair of utility patents issued regarding a "waterproof breathable lining and outerwear constructed therefrom," U.S. Patent No. 5,514,459, and a "breathable shell for outerwear." U.S. Patent No. 5,626,949. One of the figures in the patent, depicted below, does resemble the wavy design of Columbia's patent:

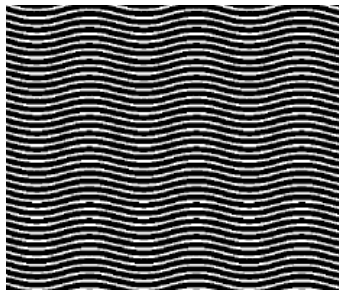


'949 patent, Murphey Decl. Ex. E. That figure depicts one of several example arrangements of a "relatively high-tensile-strength, highly flexible elastomer, such as an acrylic urethane," which is applied directly to the inner face of a weather-impermeable fabric to provide "[d]imensional stability" and "vapor transmission." '949 patent, col. 2, ll. 17-20; col. 3, ll. 42-45. But again, neither of these patents is a design patent, and neither one makes a claim to this particular pattern or, for that matter, any aesthetic features.

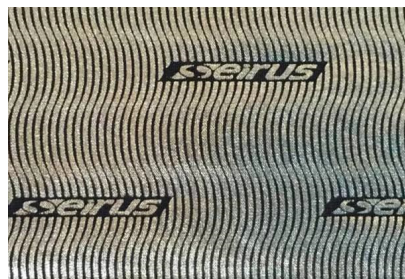
Even if the Court were to consider these patents

87a

as relevant prior art, the contrasting waves of Seirus's design are still substantially closer to the contrasting wave design disclosed in the D'093 patent than either Seirus's or Columbia's design is to the pattern disclosed in figure 5 of the '949 patent, as can clearly be seen by comparing the three designs here:

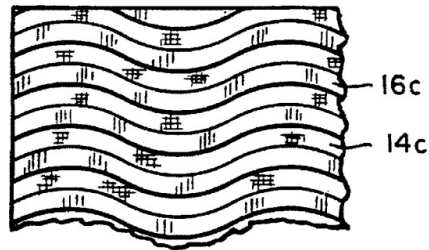


Columbia's D'093 patent



Seirus's HeatWave

88a



'949 patent

The waves in the '949 are not contrasting colors, and the waves in the Columbia and Seirus designs are very close to the same wavelength and amplitude. The overall visual effect of the Columbia and Seirus designs are nearly identical, and if the logo was removed from the Seirus design, an ordinary observer would have great difficulty distinguishing between the Seirus and Columbia designs. L.A. Gear, 988 F.2d at 1126 (“Design patent infringement . . . does not . . . allow of avoidance of infringement by labelling.”). Thus, Seirus’s HeatWave design infringes Columbia’s D’093 patent.

CONCLUSION

An ordinary observer familiar with the prior art would be likely to confuse Seirus’s design with Columbia’s patented design. Therefore, Columbia’s motion [75] for partial summary judgment of infringement of U.S. Design Patent No. D657,093 is granted.

//

//

89a

IT IS SO ORDERED

Dated this 10 day of August, 2016.

/s/ Marco A. Hernández
United States District Judge

APPENDIX F

IN THE UNITED STATES DISTRICT COURT FOR
THE SOUTHERN DISTRICT OF CALIFORNIA

No. 3:17-cv-01781-HZ

COLUMBIA SPORTSWEAR
NORTH AMERICA, INC.,
Plaintiff,

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.,
Defendant.

EXCERPTS FROM TRANSCRIPT OF JURY TRIAL

BEFORE THE HONORABLE
MARCO A. HERNANDEZ
UNITED STATES DISTRICT COURT CHIEF
JUDGE

DATED: August 3-6, 2021.

AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT
(14:19-19:4)

THE COURT: IF HE UTILIZED IT -- IN OTHER WORDS, IF HE LOOKED AT IT AND SAID, I WANT TO USE THIS EXISTING PIECE OF SOFTWARE IN ORDER TO MAKE MY DESIGN, I SUPPOSE THEY COULD USE IT IN THAT WAY. YOU'RE ENTITLED TO AN INSTRUCTION, HOWEVER, THAT WOULD SAY THE JURY WILL NOT UTILIZE THIS IN ORDER TO DETERMINE, OR USE IT AS PRIOR ART. THEY CAN ONLY UTILIZE IT IN ORDER TO HELP EXPLAIN HOW A DESIGN WAS DEVELOPED.

MR. ALDRICH: MAY I RESPOND, YOUR HONOR?

THE COURT: SURE.

MR. ALDRICH: NEITHER PARTY USED THAT DOCUMENT IN CREATING THEIR DESIGNS. THAT DOCUMENT ISN'T AN OWNER'S MANUAL FOR ADOBE ILLUSTRATOR. IT ISN'T ADOBE ILLUSTRATOR. IT'S A BLOG POST FROM SOMEONE THAT EXPLAINED HOW HE CREATED SOME WAVY LINE DESIGNS, AND THEY WANT TO PUT A DOCUMENT INTO EVIDENCE THAT NEITHER PARTY EVER

ACTUALLY SAW UNTIL A YEAR AGO IN ORDER
AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT
(14:19-19:4)

TO -- THEIR EXPLANATION IS THEY WANT TO
USE A THIRD-PARTY DOCUMENT THAT
NOBODY EVER SAW IN ORDER TO HAVE THE
WITNESSES TESTIFY ABOUT HOW THEY DID
THEIR WORK. THE WITNESSES SHOULD
TESTIFY ABOUT HOW THEY DID THEIR WORK
FROM THEIR OWN DOCUMENTS, NOT FROM A
DOCUMENT THAT THEY'VE NEVER SEEN
BEFORE.

THE COURT: THAT SOUNDS MUCH
DIFFERENT THAN WHAT THEY ARE --

MR. ALDRICH: YES, BECAUSE THIS BLOG
POST IS NOT ADOBE ILLUSTRATOR. ADOBE
ILLUSTRATOR IS A PIECE OF SOFTWARE. THE
BLOG POST IS FROM A THIRD-PARTY AUTHOR
WHO IS EXPLAINING HOW HE CREATED SOME
WAVY LINE DESIGNS. BUT NEITHER PARTY
HAD SEEN THIS DOCUMENT UNTIL A YEAR
AGO, TWO YEARS AGO.

MR. SPROUL: FIRST OF ALL, IT IS A THIRD-
PARTY BLOG, AND IT SHOWS THE UBIQUITY
OF A FUNCTION IN ADOBE ILLUSTRATOR.
BOTH GRAPHIC DESIGNERS IN THIS CASE USE
ADOBE ILLUSTRATOR, AND IT IS MEANT TO
SHOW THAT THIS FEATURE WAS AVAILABLE
AT THE TIME.

AUG. 3, 2021 TRIAL TRANSCRIPT EXCERPT
(14:19-19:4)

THE COURT: BUT THAT'S DIFFERENT THAN WHAT YOU TOLD ME. WHAT I UNDERSTOOD IS THAT YOUR CLIENTS USED THIS IN THE DEVELOPMENT OF THEIR DESIGN.

MR. SPROUL: USED -- EXCUSE ME. SORRY, YOUR HONOR. MY CLIENT DIDN'T USE THIS PARTICULAR FUNCTION. IT WAS AVAILABLE TO CREATE WAVES. AND WHAT I WOULD LIKE TO DO IS ASK MY CLIENT OR MY CLIENT'S EMPLOYEE ABOUT HOW HE DID IT AND WHETHER HE USED THIS FUNCTION AND WHETHER HE KNEW IT EXISTED. I WOULD ALSO LIKE TO ASK MR. SNYDER, THE INVENTOR --

THE COURT: IS THE ANSWER TO THAT GOING TO BE NO?

MR. SPROUL: THE ANSWER IS HE DIDN'T USE THE ZIGZAG FUNCTION. IT WAS AVAILABLE, AND IT'S AN ALTERNATE WAY, AND IT HAS A DIFFERENT EFFECT WHEN YOU USE IT.

THE COURT: NO. THEN THE ANSWER IS NO. UNLESS IT WAS ACTUALLY UTILIZED TO DEVELOP THIS DESIGN AND PART OF THE HISTORY IS, YEAH, I SAW THE DESIGN AND THAT'S WHAT I WANTED TO, OURS WAS GOING

TO BE A LITTLE BIT DIFFERENT

AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT

(14:19-19:4)

PRESUMABLY, AND WE UTILIZED THE SOFTWARE IN ORDER TO MAKE THE DESIGN, THAT'S OKAY. BUT THAT'S NOT WHAT YOU'RE TELLING ME HAPPENED.

MR. SPROUL: WELL, I WOULD HAVE A DIFFERENT SET OF QUESTIONS FOR MR. SNYDER, WHICH IS I DON'T

KNOW EXACTLY WHAT HE USED AND I WOULD LIKE TO KNOW WHETHER HE USED THIS EXISTING CAPABILITY TO CREATE HIS DESIGN BECAUSE I THINK THE EFFECT OF THE DESIGN, BASED ON HOW YOU CREATE IT, IS RELEVANT TO THE ISSUES IN THIS CASE AND WHAT THE DESIGN LOOKS LIKE.

THE COURT: ALL RIGHT. SO YOU HAVE SOME SUSPICION THAT THE COLUMBIA PEOPLE USED THIS SOFTWARE IN ORDER TO DEVELOP THEIR WAVE DESIGN. YOU CAN ASK THAT QUESTION, BUT IT WON'T BE IN FRONT OF THE JURY. IF THE ANSWER IS NO, THEN THE JURY WILL NEVER HEAR IT.

MR. SPROUL: OKAY. YES, YOUR HONOR. THANK YOU.

MR. ALDRICH: YOUR HONOR, WHETHER OUR WITNESS USED A FEATURE THAT HAPPENS TO BE DISCUSSED IN A BLOG

*AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT
(14:19-19:4)*

POST IS IRRELEVANT TO ANY QUESTION
HERE BEFORE THE JURY.

THE COURT: IT'S OKAY. IT WON'T BE
BEFORE THE JURY. I'LL HEAR IT, AND I'LL
DECIDE WHETHER OR NOT IT'S ADMISSIBLE.

MR. ALDRICH: THANK YOU, YOUR HONOR.

THE COURT: THEN THE LAST THING IS
THE '1457 PATENT. WHAT IS THE FUNCTION
OF THAT '1457 PATENT? WHAT IS THE
PURPOSE OF THAT PATENT?

MR. THORNBURGH: IT IS DESCRIBING
MATERIALS INCLUDING WOVEN CLOTH.

THE COURT: IS IT A DESIGN PATENT?

MR. THORNBURGH: IT'S NOT A DESIGN
PATENT.

THE COURT: IT'S A UTILITY PATENT THAT
USES THE WAVY LINES BECAUSE IT
INCREASES STRENGTH IN CERTAIN
PRODUCT; IS THAT, CORRECT?

MR. THORNBURGH: THAT'S THE
FUNCTIONAL PURPOSE BUT IT ALSO TALKS
ABOUT THE APPEARANCE.

*AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT
(14:19-19:4)*

THE COURT: HAS IT BEEN USED IN FABRIC?

MR. THORNBURGH: YES. IT SAYS WOVEN CLOTH PROBABLY TIMES AND WE HIGHLIGHTED --

THE COURT: WHAT'S THAT WOVEN CLOTH USED FOR?

MR. THORNBURGH: I THINK IT CAN BE USED FOR A LOT OF, YOU KNOW, BUILDING VARIOUS THINGS.

THE COURT: IS IT USED FOR APPAREL?

MR. THORNBURGH: I DON'T THINK APPAREL IS MENTIONED, BUT IT'S CERTAINLY FABRIC BECAUSE IT'S WOVEN CLOTH.

THE COURT: I NEED TO THINK ABOUT THAT ONE. IS THERE ANYTHING YOU WANT TO TELL ME?

MR. ALDRICH: YOUR HONOR, IT'S WOVEN -- CARBON FIBER IS USED FOR THINGS LIKE BICYCLES AND GOLF CLUBS AND AIRPLANE WINGS AND THINGS LIKE THAT. AND CARBON FIBER IS MADE BY TAKING STRANDS OF CARBON AND WEAVING THEM LIKE CLOTH, AND SO WHAT THIS PATENT HAS TO

DO WITH IS USING CARBON FIBER WOVEN
AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT
(14:19-19:4)

AND THEN ADHERING IT TO EACH OTHER TO LAMINATE IT IN ORDER TO MAKE THINGS LIKE STRUCTURAL I-BEAMS, AIRCRAFT WINGS, ROTORS, GOLF CLUBS, BASEBALL BATS AND THE LIKE. CLOTHING IS FAR REMOVED FROM ANYTHING THAT THIS PATENT HAS TO DO WITH, AND WE BELIEVE IT'S A HIGHLY TECHNICAL PATENT THAT WOULD REQUIRE AN EXPERT TO EXPLAIN WHAT THIS PATENT EVEN MEANS IN ORDER TO UNDERSTAND WHAT THE DIAGRAMS EVEN SHOW AND THERE'S NO QUALIFIED EXPERT WHO CAN TESTIFY ABOUT WHAT THIS GRAPHITE CARBON FIBER STRUCTURE WOULD ACTUALLY LOOK LIKE IN THE REAL WORLD AS OPPOSED TO THESE ARTIST RENDITIONS THAT ARE SHOWN IN THE DIAGRAMS.

THE COURT: ALL RIGHT. I'M NOT GOING TO RULE ON THIS AT THIS TIME. THIS IS GOING TO BE SOMETHING THAT YOU WOULD INTRODUCE IN YOUR PART OF THE CASE ANYWAY. I NEED TO SPEND SOME TIME WITH THE PATENT.

*AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT
(164:20-165:10)*

Q. And that when designing your waves, you envisioned heat rising off the ground. Correct?

A. That is correct, yes.

Q. And that image itself is pretty commonly understood; is that fair to say?

A. I -- I believe it is, yes.

Q. That you -- that's not a unique vision to you of heat rising off the ground? That's something people see in many different settings, and experience for themselves?

A. As a part of that discoverable design, that would be the intent, is to find something that people could identify with, and it's not unique to me.

Q. So the basis for your wave design is a commonly observed heat effect?

A. Correct. The basis for my design is the observation of --of heat.

*AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT
(209:14-16)*

- Q. Can you describe Columbia's business today.
A. Sure. Columbia is in the business of making outdoor gear. So that's jackets, shirts, footwear.

*AUG. 3. 2021 TRIAL TRANSCRIPT EXCERPT
(251:1-3)*

- Q. Columbia is a public company that's traded on NASDAC stock exchange. Correct?
A. Yes, that's accurate.

*AUG. 4. 2021 TRIAL TRANSCRIPT EXCERPT
(286:6-9)*

- Q. AND HOW WOULD YOU SUM UP SEIRUS IN A NUTSHELL?
A. SEIRUS IS A PRIVATELY-OWNED, LOCALLY-LOCATED, FAMILY-RUN, SMALL COMPANY WITHIN THE SNOWSPORTS AND

100a

HUNTING WORKWEAR INDUSTRY.

*AUG. 4. 2021 TRIAL TRANSCRIPT EXCERPT
(288:3-9)*

Q. I WANT TO TALK A LITTLE BIT MORE ABOUT SEIRUS NOW. WHY IS THERE A COLD-WEATHER-GEAR COMPANY BASED IN SAN DIEGO?

A. THAT'S A GOOD QUESTION BECAUSE ALTHOUGH WE BOTH, MIKE AND I, LIKE TO SKI, HE PARTICULARLY DOES NOT LIKE TO BE COLD. SO LIVING IN SAN DIEGO AND BASING OUR COMPANY HERE WAS A MUCH MORE PRACTICAL SOLUTION, AND THE OTHER PART OF IT WAS TO CREATE PRODUCTS THAT MAKE IT MORE COMFORTABLE TO BE IN THE COLD.

*AUG. 4. 2021 TRIAL TRANSCRIPT EXCERPT
(292:16-20)*

A. SO THEN ONCE WE COME UP WITH A BASIC CONCEPT -- AND I REALLY, I BELIEVE THAT THE CONCEPT OF HEATWAVES WHICH ARE PRETTY COMMON CAME UP, AND THEREFORE, THE NAME HEATWAVE, AND THE IDEA OF TRYING TO EMULATE THIS HEAT COMING OFF OF A ROAD OR OFF OF A DESERT OR WHATEVER YOU MIGHT BE.

*AUG. 4. 2021 TRIAL TRANSCRIPT EXCERPT
(302:24-303:1)*

A. IN MY MIND, I PRESENTED THE NAME HEATWAVE AS I WAS ENVISIONING HEAT RETURN OR HEAT RETURNING, HEATWAVES KIND OF BEING RETURNED, AND HEATWAVE CAME INTO MY MIND.

*AUG. 4, 2021 TRIAL TRANSCRIPT EXCERPT
(352:3-12)*

Q. HAS SEIRUS RECEIVED AWARDS FOR ITS PRODUCTS?

A. YES, WE HAVE. WE'VE BEEN VERY FORTUNATE THAT WE'VE RECEIVED A NUMBER OF AWARDS.

Q. CAN YOU PULL UP DDX-304? MR. CAREY, CAN YOU TELL US WHAT WE'RE LOOKING AT HERE?

A. ON THE LEFT YOU'VE SEEN A NUMBER OF THE ENTITIES THAT HONORED US. SKI MAGAZINE, CNET, OUTSIDE MAGAZINE AND FREESKIER AND SOME OF THE THINGS WE'RE AWARDED FOR OUR GLOVE DEVELOPMENT, NEW GEAR, HIGH TECH THINGS. BUT THOSE ARE OUR PRESS CLIPPINGS. WHAT WE DO NEXT IS MOST IMPORTANT.

*AUG. 4. 2021 TRIAL TRANSCRIPT EXCERPT
(494-15-20)*

THE COURT: A couple of matters that -- please be seated. A couple of matters that I put on hold. One was the defense wanted to introduce an exhibit which was a patent -- I don't remember the name of it, but it was the machine that made a woven fabric. And the issue was whether or not that was admissible or not, as prior art. I have reviewed the exhibit. It is admissible, and it will be received into evidence.

*AUG. 4. 2021 TRIAL TRANSCRIPT EXCERPT
(515:13-14)*

THE COURT: Well, I excluded prior art that didn't have to do with fabric, I think, is what I said.

MR. THORNBURGH: Right. And so I think the Court has

ruled, as a matter of law, what prior art is going to be allowed. And if that's the approach of the Court, then it would be consistent to continue as the Court has proposed.

THE COURT: Well, if I'm wrong on the law regarding whether or not it's a question of fact or question of law, then I need to be right on the law to the extent that I can be.

APPENDIX G

Excerpts from United States Patent No.:
D657,093 S (Snyder)
Date of Patent: April 3, 2012

Heat Reflective Material

Claim

The ornamental design of a heat reflective material, as shown and described.

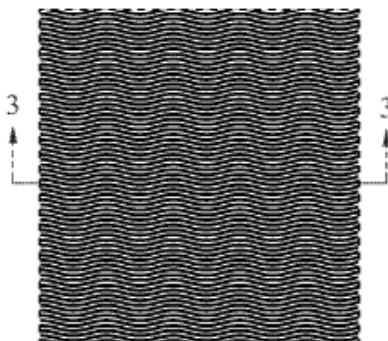


FIG. 1

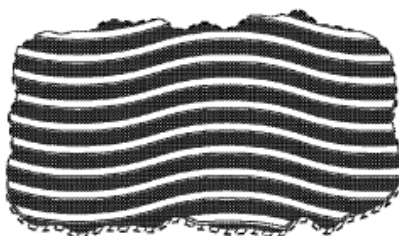


FIG. 2

APPENDIX H

Excerpts from United States Patent No.:
US 5,626,949 (Blauer)
Date of Patent: May 6, 1997

Breathable Shell for Outerwear

1

FIELD OF THE INVENTION

The present invention relates to fabric constructions for outerwear, and, more particularly, to shell fabric constructions for coats, pants, jackets, boots, gloves, and other outer clothing that are designed for protection against inclement weather. 10
15

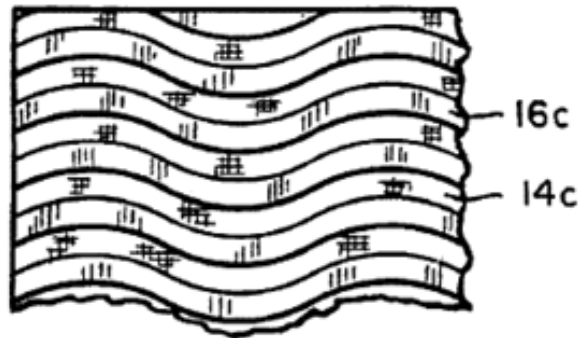


FIG. 5

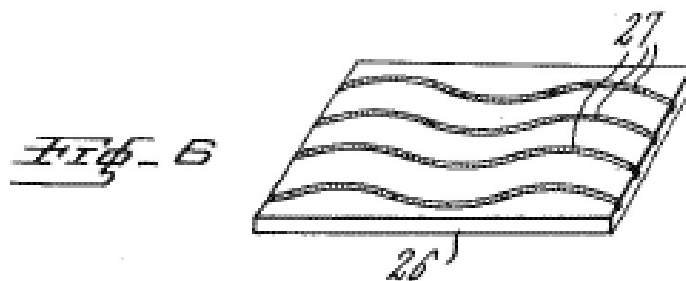
APPENDIX I

Excerpts from United States Patent No.:
US 2,539,690 (Boorn)
Date of Patent: Jan. 30, 1951

Method of providing plastic sheets with inlaid stripes

1

It is relatively easy to paint, stamp or 10
print ornamental stripes on the surface
of a coated fabric or a plastic sheet,



APPENDIX J

Excerpts from United States Patent No.:
1,515,792 (Respass)
Date of Patent: Nov. 18, 1924

Unwoven fabric and process for making the same

2

Fig. 4 Shows a portion of the fabric with its threads or cords running in straight lines lengthwise thereof;	55
Fig. 5 represents the fabric with its Threads or cords located in wavy directions lengthwise thereof;	60



APPENDIX K

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF
CALIFORNIA SAN DIEGO DIVISION

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

Plaintiff,

v.

SEIRUS INNOVATIVE ACCESSORIES,
INC., a Utah corporation,

Defendant.

Case No.: 3:17-cv-01781-HZ

EXCERPTS FROM JOINT PROPOSED JURY
INSTRUCTIONS

Judge: Marco A. Hernandez
Date Action Filed: January 12, 2015
Trial Date: August 3, 2021

EXCERPTS FROM JOINT PROPOSED JURY
INSTRUCTIONS

COLUMBIA'S REQUESTED JURY INSTRUCTION
NO. 9E
Claim Scope

The Design Patent is limited to the design of Heat Reflective Materials, as shown and described in the patent. The term "Heat Reflective Materials" has its plain and ordinary meaning. The ordinary meaning of a claim term is not the meaning of the term in the abstract. Instead, the "ordinary meaning" of a claim term is its meaning to the ordinary artisan after reading the entire patent. In other words, the term takes its meaning from the context in which it is used in the patent.

The plain and ordinary meaning of "Heat Reflective materials" in the context of the Design Patent does not include all materials.

The claimed design is not limited to a particular orientation. The orientation of the design (e.g., vertical or horizontal) is not relevant to your infringement determination.

110a

EXCERPTS FROM JOINT PROPOSED JURY
INSTRUCTIONS

COLUMBIA'S REQUESTED JURY INSTRUCTION
NO. 9F

What is Prior Art

In design patent law, the term “prior art” refers to prior designs that address the same subject matter or field of endeavor as the patented design or that address a field of endeavor so similar that a designer having ordinary skill would look to articles in that field for their designs. The subject matter and field of endeavor of the D'093 patent is ornamental designs for Heat Reflective Materials.

111a

APPENDIX L

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF
CALIFORNIA SAN DIEGO DIVISION

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

Plaintiff,

v.

SEIRUS INNOVATIVE ACCESSORIES,
INC., a Utah corporation,

Defendant.

Case No.: 3:17-cv-01781-HZ

July 16, 2021
EXCERPTS FROM TRANSCRIPT OF
PROCEEDINGS
(Pretrial Conference)

Judge: Marco A. Hernandez
Date Action Filed: January 12, 2015
Trial Date: August 3, 2021

*EXCERPT FROM JULY 16, 2021 HEARING
TRANSCRIPT*

6

MR. ALDRICH: There may be some other lingering issues, but those are just the ones that come immediately to mind about the testimony that they were going to provide.

THE COURT: Okay. We'll talk about prior art. And, again, to the extent that they were looking at a particular fabric sample and pattern and want to compare it to the patented design, they're going to be able to do that generally.

14

THE COURT: All right. Let's move on. Seirus moves in limine to preclude prior art distinctions on functional grounds. We're starting to get to talking about prior art here. So let's talk about the prior art. First of all, I think Seirus is correct. Functional grounds are not a relevant consideration. So that motion is granted. And we're going to spend a little bit of time about -- talking about prior art. Appearance is what is relevant in this particular case; however, appearance on any object that has a wave pattern is not relevant. , I am going to limit the prior art to wave patterns on fabric, and I will leave it at that.

114a

APPENDIX M

No. 21-2299, - 2338 IN THE
United States Court of Appeals
for the Federal Circuit
COLUMBIA SPORTSWEAR NORTH AMERICA,
INC.,

Plaintiff-Appellant,

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.

Defendant-Cross-Appellant.

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

EXCERPT FROM CORRECTED OPENING BRIEF
OF PLAINTIFF-APPELLANT COLUMBIA
SPORTSWEAR NORTH AMERICA, INC

Nika Aldrich Scott D. Eads Sara Kobak
SCHWABE, WILLIAMSON & WYATT P.C.
1211 S.W. 5th Avenue, Suite 1900
Portland, Oregon 97204
Telephone: 503-222-9981
Facsimile: 503-796-2900

Attorneys for Columbia Sportswear North America,
Inc.

January 13, 2022

4

Heat reflective materials derive from NASA's invention of the space blanket, a thin sheet of highly reflective metal foil that reflects the wearer's heat back to them. The clothing industry has long since used heat reflective materials in apparel. (Appx617-618.) But, although the metal foil is highly heat reflective, it disadvantageously blocks the transfer of moisture vapor away from the wearer. This lack of "breathability" can cause the inside of the garment to become wet, accelerating heat loss due to the increased heat conductivity of wet materials. (Appx779-780.)

In 2008, Columbia invented a new approach. Columbia used two layers: a layer of heat reflective foil glued to a layer of breathable, base material. Pieces of the heat reflective foil were arranged in an array on the base material, leaving portions of the base material uncovered. (Appx779-781.) This way, the foil would reflect heat to keep the wearer warm while the exposed sections of base material would ensure breathability, keeping the inside of the garment dry. While Columbia's engineering team had developed the material that could achieve these characteristics, Columbia still had to develop appealing designs that could be applied to such a heat reflective material—a particular and peculiar article of manufacture.

5

APPENDIX N

IN THE UNITED STATES DISTRICT COURT FOR
THE SOUTHERN DISTRICT OF CALIFORNIA

No. 3:17-cv-01781-HZ

COLUMBIA SPORTSWEAR
NORTH AMERICA, INC.,
Plaintiff,

v.

SEIRUS INNOVATIVE ACCESSORIES, INC.,
Defendant.

EXCERPTS FROM FINAL JURY INSTRUCTIONS

BEFORE THE HONORABLE
MARCO A. HERNANDEZ
UNITED STATES DISTRICT COURT CHIEF
JUDGE

DATED: August 6, 2021.

Excerpt from final jury instructions

No. 11: Prior Art

You must decide what is prior art. Prior art includes things that were publicly known, or used in a publicly accessible way in this country, or that were patented or described in a publication in any country before the creation of the claimed design.

You must familiarize yourself with the prior art in determining whether there has been infringement. When the claimed design is visually close to prior art designs, small differences between the accused design and the claimed design may be important in analyzing whether the overall appearances of the accused and-claimed designs are substantially the same.

While the evaluation of the prior art may be helpful, please keep in mind that the sole test for infringement is whether the overall appearances of the accused design and the claimed design are substantially the same. If you find that the accused design is substantially the same, then you must find that the accused design infringes the Design Patent.

APPENDIX O

35 U.S.C.A. § 102(a)

§ 102. Conditions for patentability; novelty

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b) , in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

119a

35 U.S.C.A. § 103

§ 103. Conditions for patentability; non-obvious
subject matter

Effective: March 16, 2013

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

120a

35 U.S.C.A. § 171

§ 171. Patents for designs

Effective: December 18, 2013

(a) In General.--Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

(b) Applicability of This Title.--The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) Filing Date.--The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

121a

28 U.S.C.A. § 1254

§ 1254. Courts of appeals; certiorari; certified questions

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

- (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;
- (2) By certification at any time by a court of appeals of any question of law in any civil or criminal case as to which instructions are desired, and upon such certification the Supreme Court may give binding instructions or require the entire record to be sent up for decision of the entire matter in controversy.