

No. _____

In the
Supreme Court of the United States

SEIRUS INNOVATIVE ACCESSORIES, INC.,

Petitioner,

v.

COLUMBIA SPORTSWEAR NORTH AMERICA,
INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The questions presented are:

- (1) Whether function must be disregarded in defining the scope of comparison prior art relevant to design patent infringement; and
- (2) Whether comparison prior art can be considered in evaluating design patent infringement even if it is not the exact “same article” and thus could not anticipate for purposes of determining validity.

The Patent Act establishes that design patents are directed to ornament, not function: “[w]hoever invents any new, original and *ornamental* design for an article of manufacture may obtain a patent therefor” 35 U.S.C. § 171 (emphasis added). As this Court has explained, “[t]he object of the [utility patents] may solely be increased utility, while the object of [design patents] may *solely* be increased gratification to a cultivated taste addressed through the eye.” *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 523 (1872) (emphasis added).

In addition, this Court long ago established that prior art can be relevant to design patent infringement. *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 681-82 (1893) (finding no infringement of design patent directed to a saddle after comparing the accused design to the prior art). Prior art used in this way is referred to as “comparison prior art.”

In this case, a jury found that Petitioner’s fabric did not infringe Respondent’s design patent directed to a repeating wave patten on “heat reflective material.” The jury reached this decision after being presented with three prior art patents disclosing

fabrics with repeating wave patterns. The Federal Circuit vacated that verdict because the district court had declined to limit comparison prior art based on (i) the function performed by the prior art design and (ii) the “same article” standard used in determining whether a design patent is invalid for anticipation. App. 24a. The Federal Circuit did so noting “the proper scope of comparison prior art that may be used in an infringement analysis is an issue of first impression for this court.” *Id.* at 22a. The issue in this Petition is what constitutes permissible comparison prior art.

CORPORATE DISCLOSURE STATEMENT

Petitioner Seirus Innovative Accessories, Inc. has no parent corporation, and no publicly held corporation owns 10% or more of Seirus's stock.

RELATED PROCEEDINGS

The following proceedings are directly related to this case within the meaning of Rule 14.1(b)(iii):

Columbia Sportswear North Am., Inc. v. Seirus Innovative Accessories, Inc., Case No. 3:17-cv-1781-HZ, U.S. District Court for the Southern District of California. Summary Judgment entered August 10, 2016 (entering summary judgment of infringement as to the '093 design patent-at-issue in this Petition). Judgment entered November 22, 2017 (based on jury verdict of damages as to the '093 patent).

Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc., Case Nos. 2018-1329, 2018-1331, 2018-1728. U.S. Court of Appeals for the Federal Circuit. Judgment entered November 13, 2019 (among other rulings, reversing summary judgment of infringement as to the '093 patent and remanding for new trial on infringement).

Columbia Sportswear North Am., Inc. v. Seirus Innovative Accessories, Inc., Case No. 3:17-cv-1781-HZ, U.S. District Court for the Southern District of California. On remand, Judgment entered August 6, 2021 (based on jury verdict of no infringement of the '093 patent).

Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc., Case Nos. 2021-2299, 2021-2338. U.S. Court of Appeals for the Federal Circuit. Judgment entered September 15, 2023 (overturning jury verdict of no infringement of the '093 patent and remanding for determination of

infringement). Petition for rehearing en banc denied December 22, 2023.

Columbia Sportswear North Am., Inc. v. Seirus Innovative Accessories, Inc., Case No. 3:17-cv-1781-HZ, U.S. District Court for the Southern District of California. On remand, jury trial to determine infringement of the '093 patent is set for December 9, 2024.

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Petitioner Seirus Innovative Accessories, Inc. respectfully petitions this Court for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS AND ORDERS BELOW

The district court's entry of judgment following a jury verdict of noninfringement of Respondent's design patent is not reported, but is reprinted at App. 66a. The Federal Circuit's 2023 opinion vacating that verdict (*id.* at 1a-37a) is reported at 80 F.4th 1363 ("*Columbia II*"). The Federal Circuit's order denying rehearing (App. 64a) in *Columbia II* is unreported.

In a prior appeal, the Federal Circuit vacated the district court's entry of summary judgment of infringement of the design patent. The Federal Circuit's opinion in that prior appeal (App. 38a-63a) is reported in *Columbia Sportswear North Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119 (Fed. Cir. 2019) ("*Columbia I*"). The district court's summary judgment opinion (App. 67a-89a) is reported at 202 F.Supp.3d 1186.

JURISDICTION

The Federal Circuit issued the opinion in *Columbia II* on September 15, 2023. *Id.* at 1a. On December 22, 2023, the Federal Circuit denied Seirus's timely petition for rehearing. *Id.* at 64a-65a. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

Section 171 of the Patent Act, 35 U.S.C. § 171, provides in relevant part:

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.

STATEMENT

The Petitioner, Seirus Innovative Accessories, Inc. (“Seirus”), is a small, privately held company based in San Diego, California. App. 99a (286:6-9). It sells innovative cold-weather accessories such as gloves and hats. *Id.* 100a (288:3-9). Its specialty products have received acclaim for their innovation and high quality. *Id.* 102a (352:3-12). The Respondent, Columbia Sportswear North America, Inc. (“Columbia”), is a multibillion-dollar public corporation based in Portland, Oregon. *Id.* 99a (251:1-3). It sells a variety of outdoor goods. *Id.*

Columbia’s asserted design patent (No. D657,093) does not cover the design of any specific end-product, like a glove or hat, but covers the design of a material used to make such a product. The patent’s title is “Heat Reflective Material.” Consistent with that description, the patent claims “[t]he ornamental design of a heat reflective material, as shown and described.” App. 104a. Figures 1 and 2 show the material’s design:

3

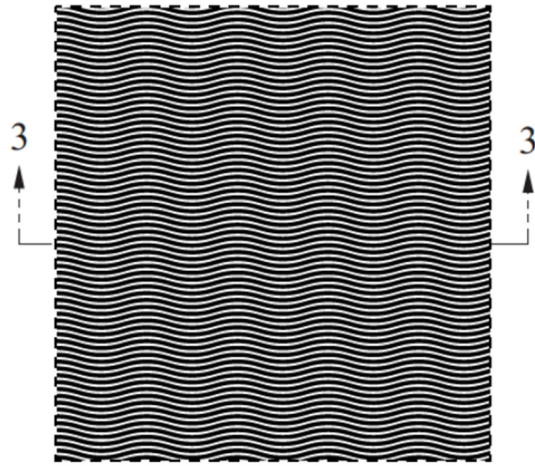


FIG. 1

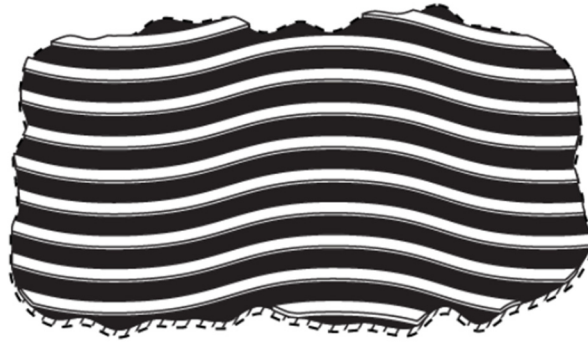
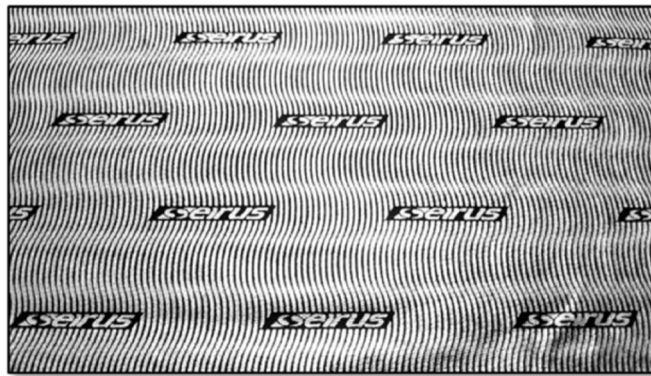


FIG. 2

App. 104a.

Earlier in the case, the district court granted summary judgment of infringement, but the Federal Circuit vacated that judgment. *Columbia I*, 942 F.3d at 1131-32. In *Columbia I*, the Federal Circuit also affirmed the jury’s verdict that Columbia’s *utility* patent on heat reflective material was invalid. *Id.* at 1126.

At the remand trial, the jury found Seirus did not infringe Columbia’s design patent based on a comparison of Seirus’s design (below) with Columbia’s design (above):



App. 3a.

The jury reached its noninfringement verdict after being instructed on the “ordinary observer” test, using language that tracked this Court’s opinion in *Gorham v. White*, 81 U.S. (14 Wall.) 511 (1872), which first articulated that test.

In evaluating infringement, the district court also permitted the jury to consider three pieces of comparison prior art: (1) the Blauer patent, which discloses a “breathable shell for outerwear” with a wavy design (App. 105a); (2) the Boorn patent, which discloses “ornamental stripes on the surface of a

coated fabric” with a wavy pattern (App. 106a); and (3) the Respass patent, which discloses “fabric with its threads or cords located in wavy directions lengthwise thereof” (App. 107a). As an example, Blauer discloses a two-layer wavy pattern for a fabric’s inner surface, which closely resembles Columbia’s design:

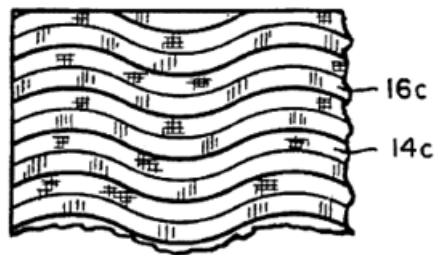


FIG. 5

App. 105a.

Prior to trial, the district court ruled that the *function* of the prior art was irrelevant to a design patent. *E.g.*, App. 109a; *id.* at 110a; *id.* at 112a. However, exercising its gatekeeping function, the district court limited the admitted prior art to “fabric” at Columbia’s request. App. 112a-113a; *Id.* at 91a-97a (14:19-19:4); *Id.* at 103a (494:15-20, 515:13-14). Seirus also elicited testimony that wave patterns are commonly associated with heat. *Id.* at 98a (164:20-165:10) (admission of Columbia inventor Snyder); *Id.* at 101a (292:16-20) (Seirus manager Wendy Carey) (302:24-303:1) (Seirus designer Sean Carey).

On appeal, Columbia argued the jury should have been limited to considering prior art consisting only of the claimed “*heat reflective material*” rather than any

other fabric. Seirus responded that “fabric”¹ is the relevant article and “heat reflective” should be disregarded as functional. In essence, Seirus emphasized the difference between how something *looks* versus what something *does*.

Nonetheless, the Federal Circuit in *Columbia II* agreed with Columbia and vacated the jury’s noninfringement verdict. *First*, it rejected the district court’s refusal to limit comparison prior art based on function, holding that “referencing **functionality** to distinguish articles of manufacture is not categorically impermissible.” App. 29a (emphasis added). *Second*, it applied the anticipation standard to comparison prior art, explaining “[w]e have held that, for a prior-art design to **anticipate**, it must be applied to the article of manufacture identified in the claim” and concluded “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.” App. 23a (emphasis added). It thus remanded for the district court to reevaluate the prior art. *Id.* at 37a.

REASONS FOR GRANTING THE WRIT

This Court should vacate the Federal Circuit’s *Columbia II* decision first because it directly contradicts this Court’s authority that **functionality** is irrelevant to design patents. Second, the Federal Circuit’s decision contradicts this Court’s precedent and the Federal Circuit’s own previous decisions

¹ Although the claim recites “material,” the patent figures show fabric and Seirus has consistently argued that the article of manufacture was the fabric.

regarding “comparison prior art” used for context when deciding design patent infringement. That precedent holds that such comparison prior art is *not* limited to the exact article of manufacture stated in the claim (the *anticipation* standard). Finally, the court of appeals in *Columbia II* created an illogical, unworkable test that will be impossible to apply in this case or in future cases.

I. The Federal Circuit Misconstrued the Role of Design Patents by Importing Functional Limitations

In “clarifying” that “referencing functionality” is not “categorically impermissible” (App. 29a)—such that the jury in this case should have considered only “heat reflective” fabric—the Federal Circuit decision contradicts the very purpose of design patents as stated both by statute and this Court. The patent statute expressly limits design patents to ornamental designs: “[w]hoever invents any new, original and *ornamental* design for an article of manufacture may obtain a patent therefor.” 35 U.S.C. § 171 (emphasis added). And as stated above, this Court has likewise explained “[t]he object of the [utility patents] may solely be increased utility, while the object of [design patents] may solely be *increased gratification to a cultivated taste addressed through the eye.*” *Gorham*, 81 U.S. (14 Wall.) at 523 (emphasis added).

The Federal Circuit has also previously recognized that design patents do not cover functionality and that functionality must be set aside when determining infringement: “[d]esign patents do not and cannot include claims to the structural or functional aspects of the article . . . Thus it is the *non-functional, design aspects that are pertinent to*

determinations of infringement.” Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed. Cir. 1988) (emphasis added); *see also Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc) (“Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”) (quoting *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)).

The Federal Circuit has also emphasized that functionality is irrelevant to design patent validity:

Unlike an invention in a utility patent, a patented ornamental design has no use other than its visual appearance, *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956), and its scope is “limited to what is shown in the application drawings,” *In re Mann*, 861 F.2d 1581, 1582, 8 USPQ2d 2030, 2031 (Fed.Cir.1988). Therefore, in considering prior art references for purposes of determining patentability of ornamental designs, the focus must be on ***appearances and not uses***. *In re Glavas*, 230 F.2d at 450, 109 USPQ at 52.

In re Harvey, 12 F.3d 1061, 1064 (Fed. Cir. 1993) (emphasis added) (upholding finding of design patent invalidity). Indeed, *Glavas* (cited above) emphatically held “the use to which an article is to be put has no bearing on its patentability as a design and that ***if the prior art discloses any article of substantially the same appearance as that of an applicant, it***

is immaterial what the use of such article is.” In re Glavas, 230 F.2d 447, 450 (CCPA 1956).²

The Federal Circuit attempted to distinguish the function of the “design” from the function of the “article” in *Columbia II*. See App. 28a (“It is true that valid design patents cannot be directed to designs that are primarily functional, as opposed to ornamental. But it is also true that “design patents are granted only for a design applied to an article of manufacture.” And articles of manufacture have functions.”) (internal citations omitted). However, what *Columbia II* actually allows is reading the functionality of the *article* into the scope of the *claims*, contrary to design patent law.

Thus, in *Columbia II*, the Federal Circuit markedly departed from statutory and judicial precedent in holding that “referencing functionality to distinguish articles of manufacture is not categorically impermissible.” The Federal Circuit did not merely “clarify[]” the law, as it states. App. 29a.³

² The Federal Circuit adopted all holdings of the Court of Customs and Patent Appeals (CCPA) as binding precedent in its very first decision. *South Corp. v. U.S.*, 690 F.2d 1368 (Fed. Cir. 1982).

³ Nor can the Federal Circuit’s decision in *Columbia II* be justified by its reliance on *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334 (2019), or *In re SurgiSil, L.L.P.*, 14 F.4th 1380 (Fed. Cir. 2021). Both decisions should be construed narrowly and, to the extent they may contradict the binding precedent cited above, underscore the need for Supreme Court review. *Curver* merely resolved “whether claim language specifying an article of manufacture can limit the scope of a design patent, even if that article of manufacture is not actually illustrated in the figures.” 938 F.3d at 1339-1340 (answering in

II. The Federal Circuit Directly Contradicted Precedent About the Scope of Comparison Prior Art by Applying the Anticipation Standard

In holding that comparison prior art must be the *same* article of manufacture as claimed (App. 24a)—again, “heat reflective” material—the Federal Circuit asserts that this is an issue of “first impression” (*id.* at 22a). Yet its holding actually contradicts precedent about whether comparison prior art is limited by the anticipation standard, including this Court’s precedent and its own en banc precedent. This split in authority supports review by this Court.

As background, the use of comparison prior art to analyze infringement is another difference that sets design patents apart from utility patents. This Court’s decision in *Whitman Saddle Co.*, 148 U.S. 674 (1893) (cited above), is credited with the approach. There, the Court examined prior art saddles to gain a better understanding of how the features of the accused saddle design related to the claimed saddle design. The Court first observed that the art was

the affirmative). *Curver* also turned on the fact that “no ‘ordinary observer’ could be deceived into purchasing Home Expressions’s *baskets* believing they were the same as the patterned *chairs* claimed in Curver’s patent.” 938 F.3d at 1343 (emphasis added). Nothing suggests the *Curver* decision was based on the *function* of chairs versus baskets, as opposed to their different *appearance*. Likewise, the three-page opinion in *SurgiSil* merely rejected the PTAB’s mistaken holding that articles of manufacture are “not limiting” and the PTAB’s further mistaken holding that “it is appropriate to ignore the identification of the article of manufacture in the claim language.” 14 F.4th at 1381-1382. In rejecting these clear errors, the Federal Circuit again said nothing to suggest functional limitations should be read into design patents.

crowded. *Id.* at 681 (“The evidence established that there were several hundred styles of saddles or saddletrees belonging to the prior art, and that it was customary for saddlers to vary the shape and appearance of saddletrees in numerous ways, according to the taste and fancy of the purchaser.”). It then observed that the patented design appeared to combine a common front-end with another common back-end. *Id.* (“Nothing more was done in this instance (except as hereafter noted) than to put the two halves of these saddles together in the exercise of the ordinary skill of workmen of the trade, and in the way and manner ordinarily done.”). With this context in mind, the Court found no infringement:

The shape of the front end being old, the sharp drop of the pommel at the rear seems to constitute what was new and to be material. Now, the saddles of the defendants, while they have the slight curved drop at the rear of the pommel, similar to the Granger saddle, do not have the accentuated drop of the patent, which ‘falls nearly perpendicularly several inches,’ and has a ‘straight inner side.’ If, therefore, this drop were material to the design, and rendered it patentable as a complete and Integral Whole, there was no infringement.

Id. at 682. Notably, the Court’s opinion says nothing about whether any of the cited prior art might anticipate. And, of course, half a saddle (whether

front or back) cannot anticipate a claim directed to a complete saddle.⁴

The Federal Circuit in *Egyptian Goddess* attempted to synthesize *Whitman Saddle* and subsequent cases into a modern rule. 543 F.3d 665. As explained in *Egyptian Goddess*, *Whitman Saddle* reversed an infringement finding where the patented saddle design was “a combination of elements from two saddle designs that were well known in the art” and “the accused design did not contain the single feature that would have made it appear distinctively similar to the patented design rather than like the numerous prior art designs.” *Egyptian Goddess*, 543 F.3d at 673-74.

Based on this precedent, *Egyptian Goddess* articulated a rule governing comparison prior art. Namely, the appeals court replaced the previous “point of novelty” test with a refinement of the *Gorham* “ordinary observer” infringement test, holding that “whether the ordinary observer would

⁴ “A person shall be entitled to a patent unless . . . 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.” 35 U.S.C. § 102(a). A prior art reference invalidates a patent claim for “anticipation” if it “discloses each and every element of the claimed invention arranged or combined in the same way as in the claim.” *Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.*, 878 F.3d 1336, 1343 (Fed. Cir. 2018). By contrast, a prior art reference may invalidate a patent claim for “obviousness” when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103; *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 405 (2007).

consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art, as in many of the cases discussed above and in the case at bar.” 543 F.3d at 678.

As indicated in the quote above, the Federal Circuit derived the rule of *Egyptian Goddess* from “the cases discussed above.” *Id.*; *see also id.* at 674 (“Subsequent cases applied that principle, interpreting the ordinary observer test of *Gorham* to require that the perspective of the ordinary observer be informed by a comparison of the patented design and the accused design in light of the prior art, so as to enable the fact-finder to determine whether the accused design had appropriated the inventiveness of the patented design.”). In addition to this Court’s decision in *Whitman Saddle*, *Egyptian Goddess* cites cases “decided in the wake of *Whitman Saddle* [that] shed light on the Supreme Court’s analysis in *Whitman Saddle* and illustrate the application of the ordinary observer test in light of the prior art.” *Id.* at 674.

One of these cases was *Bevin Brothers Manufacturing Co. v. Starr Brothers Bell Co.*, 114 F. 362 (C.C.D. Conn. 1902). The design patent in that case was directed to the shape of a **bell**. *Egyptian Goddess*, 543 F.3d at 674. Yet the Federal Circuit cited with approval the *Bevin* court’s consideration of a different type of prior art, namely a **door knob** having a similar shape:

As for infringement, the court again consulted particular *objects in the prior art having a similar shape*, including a *door knob*, and concluded that “[t]he shape of the

defendant's *bell* differs from plaintiff's more widely than plaintiff's differs from the *door knob*, and therefore defendants' construction does not infringe the patent." Thus, the court's approach, like that of the Supreme Court in *Whitman Saddle*, did not employ a point of novelty test, but invoked the ordinary observer test in which the observer was comparing the patented and accused designs in the context of *similar designs found in the prior art*.

Id. (emphasis added, internal citation omitted).

This case—and its description in *Egyptian Goddess*—makes clear that comparison prior art is *not* limited to the same article, *i.e.*, not constrained by the anticipation standard. The Federal Circuit's decision in *Columbia II*—that the anticipation standard applies to comparison prior art (App. 24a)—thus directly contradicts its determination in *Egyptian Goddess* that door knobs can be comparison prior art for a design patent directed to a bell. As stated above, this split in authority supports review by this Court.

The Federal Circuit's decision in *Columbia II* also directly contradicts another recent Federal Circuit decision that the court unsuccessfully attempts to distinguish in a footnote. *See* App. 25a n.8 (discussing *Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337 (Fed. Cir. 2020)). *Lanard* involved a design patent directed to a pencil-shaped *chalk holder*, and there the Federal Circuit approved consideration of *pencils* as relevant comparison prior art. *Id.* at 1339 (design patent claimed an “ornamental design for a chalk holder”), 1342 (“the court considered the numerous prior art references cited by the examiner on the face

of the D167 patent, as well as other designs identified by Appellees, all directed to the shape and design of a pencil”).

In *Columbia II*, the court states it “do[es] not regard *Lanard* as controlling on the proper scope of comparison prior art” because the issue supposedly was not presented on appeal. App. 25a n. 8. However, the court in *Lanard* actually stated “the scope of the claim must be construed in order to identify the *non-functional* aspects of the design as shown in the patent,” and it expressly affirmed the district court doing so: “the district court fleshed out and rejected Lanard’s attempt to distinguish its patent from the prior art by importing the ‘the chalk holder *function* of its design’ into the construction of the claim . . . we see no error in the district court’s approach to claim construction.” 958 F.3d at 1342-43 (emphasis added). Thus, contrary to the statement in *Columbia II*, this issue *was* decided in *Lanard*.

In addition, the Federal Circuit quotes the district court opinion from *Lanard* but omits the key part:

Nor is the Court persuaded by Lanard’s assertion that in the cases on which Defendants rely, the closest prior art discussed in the infringement analysis are articles which serve the same *function* as the subject patented design. It is undoubtedly true that in most cases the prior art most similar to the claimed design will involve an article of the same function. But, in this case, Lanard specifically adopted the features of a no. 2 pencil in designing its *chalk holder*. As such, it is not surprising that the prior art most similar to Lanard’s design are *pencils*.

Lanard Toys Ltd. v. Toys "R" Us-Delaware, Inc., No. 3:15-CV-849-J-34PDB, 2019 WL 1304290, at *13 n.15 (M.D. Fla. Mar. 21, 2019) (emphasis added), *aff'd sub nom. Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337 (Fed. Cir. 2020); *see also Revision Military, Inc. v. Balboa Mfg. Co.*, 700 F.3d 524, 527 (Fed. Cir. 2012) (holding “any prior art with which the ordinary observer would reasonably be familiar” may be used as comparison prior art). The Federal Circuit’s decision in this case would require the opposite result in *Lanard*—the pencil art would have to be disregarded.

Moreover, the district court in the present case did the same thing as the *Lanard* district court: it excluded the functional aspects of the claim (“heat reflective”), effectively construed “material” as “fabric” (by excluding all non-fabric prior art at Columbia’s request), and let the jury decide infringement under the *Gorham* test. The district court acted properly, and this Court should reject the Federal Circuit’s attempt to change the law.

III. The Questions Presented Are Important and Warrant Review

A. The Federal Circuit Decision Contradicts the Purpose of Comparison Prior Art

The role of comparison prior art, as articulated by this Court in *Whitman Saddle* and by the Federal Circuit in *Egyptian Goddess*, is to provide context so that the trier of fact can more easily discern salient *visual* similarities and differences when applying the *Gorham* “ordinary observer” test. *Whitman Saddle*, 148 U.S. at 681-82; *Egyptian Goddess*, 543 F.3d at 678. So understood, it makes no sense for comparison

art to be limited based on its *function* or ability to *anticipate*.⁵

For example, if someone had a design patent on a cushy, extra wide *chair*, with a claim that stated “a chair as shown in the figures,” it would not be reasonable to exclude *couch* or *love seat* prior art. Or if someone had a design patent on a *blanket* with a particular pattern printed on it, a *towel* with a similar print would be *relevant* even though blankets are “for warming” whereas towels are “for drying.” And if a person obtained a design patent for a coffee mug depicting a public domain image, such as a 19th-century impressionist painting, it would make no sense (and would be deeply unfair to anyone who based their design on the same painting) to exclude the original painting as comparison prior art simply because it appeared on *canvas* and *canvas* is not a *coffee mug*. Nor would it be fair to exclude a *beer mug* with the same painting on it. Clearly, the relevance of the public domain images transcends the particular objects.

The same is true of the patented wave design in this case. Waves are commonly used as symbols to represent heat, and wave designs are ubiquitous, appearing on everything from cancelled postage stamps to the fabrics admitted as prior art in this case. Such prior art need not render Columbia’s patent invalid or alone prove noninfringement, but it is certainly *relevant* to the ordinary observer test. As the Federal Circuit had noted in a previous appeal in this case, the existence of close comparison prior art

⁵ The Federal Circuit also avoids the question of how can prior art be relevant for obviousness but excluded from comparison prior art.

elevates the importance of small differences between the patented and accused designs. *Columbia I*, 942 F.3d at 1129. There is no logical or justifiable reason to exclude prior art that may be functionally different.

In addition, the Federal Circuit decision will encourage patentees to add functional elements to their design patents to limit the comparison prior art, unrelated to any visual aspect of the design. This will have the effect of creating *de facto* monopolies on functionality without the rigor of utility patent examination. Indeed, here, Columbia has pressed forward with a design patent on wavy lines after its corresponding utility patent on heat reflective material (also with a wavy design) was *invalidated* by a jury, as affirmed by the Federal Circuit. *Columbia I*, 942 F.3d at 1126. The Federal Circuit's *Columbia II* decision allows Columbia to recapture the functionality it lost with the invalidity of its utility patents, and transgresses binding precedent that "it is the non-functional, design aspects that are pertinent to determinations of infringement." *Lee*, 838 F.2d at 1188. Columbia even defines "heat reflective material" using the detailed technical characteristics of its invalid utility patent, such as the use of multiple layers of different materials to insure "breathability." *See* App. 115a. This Court should reject the Federal Circuit's new test, which paves the way for such anticompetitive behavior.

In short, the visual aspect of an article of manufacture should rule, not a label stating its intended purpose. The Federal Circuit's categorical approach favors labelling over visual impact. The article of manufacture is relevant, but it should not be the only factor. A district court should have flexibility

on what to allow, rather than be bound by a rigid, categorical rule, which is nonsensical and contradicts binding precedent. Many articles of manufacture are not meaningfully different (couches versus chairs), but the ruling below would exclude one over the other on the basis of the label alone.

B. The Federal Circuit Decision Creates a Test That Will Be Impossible to Apply

Apparently recognizing the contradictions created by its decision, the Federal Circuit also hedged—and in so doing made its test impossible to apply. That is, after holding that function can be used to exclude comparison prior art and that comparison prior art is limited by the anticipation test, the court then offered the following footnote partially taking back its holdings:

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 somehow 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 render the *article* genuinely distinct from other flower pots.

App. 29a n. 9.

The problem with this explanation is that it makes the rest of the opinion indecipherable. When can function or same article be ignored and when does it render the article “genuinely distinct”? The court

does not say. And why would the function of a “flower pot” allow for exclusion of comparison prior art, but the added function of “planting daisies” would not? Likewise, applied to the facts of this case, how is “planting daisies” different from “reflecting heat”? Again the court does not say. Its example does not clear up confusion, but rather adds to it.

On remand, the district court has been left with the puzzle of construing the claim with reference to function (which the court of appeals insists is relevant) but not with reference to *too much* function (“planting daisies”). Yet it is unclear how the district court—which has now been reversed twice in this case—is supposed to thread the needle and apply this Goldilocks test, especially since all material reflects heat. The Federal Circuit derides Seirus’s assertion of the latter fact (*see* App. 30a-31a), but it is true. Physics tells us that all matter reflects heat, and everyone knows that fabric in clothing reflects heat (whether one is trying to keep warm or stay cool). So where is the district court supposed to draw the line without reading *too much* functionality into Columbia’s design patent?

The district court’s approach here—serving as a gatekeeper to limit the prior art but then letting the jury decide how the prior art affected its infringement decision—was much more sensible. The district court instructed the jury: “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.” App. 117a (emphasis added). The district court acted within its discretion in formulating these instructions. *United*

States v. Echeverry, 759 F.2d 1451, 1455 (9th Cir. 1985) (“[s]o long as the instructions fairly and adequately cover the issues presented, the judge’s formulation of those instructions or choice of language is a matter of discretion”).⁶

By contrast, the Federal Circuit has created a test that will be impossible for district courts to apply in this case or in future cases. This Court should grant certiorari and reverse.

CONCLUSION

The Court should grant the petition for a writ of certiorari.

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Respectfully submitted,

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⁶ The parties agreed the Federal Circuit properly applies regional circuit law to procedural issues. *Voda v. Cordis Corp.*, 536 F.3d 1311, 1328 (Fed. Cir. 2008).