

Slap A Logo On It – The Future of Winning a Design Patent Infringement Claim?

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Columbia Sportswear

Seirus Innovative Accessories,

Related People

- Cathy Dahl



Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

When I was a kid, we anxiously awaited Christmas Eve, with the exception of traditional lutefisk dinner. If you too have ingested lutefisk, you may agree that it is unpalatable. My Dad's now family-famous quip was "just put more melted butter on it." That quip went through my head while reading the Federal Circuit's decision in *Columbia Sportswear North America, v. Seirus Innovative Accessories*. Just like adding more melted butter, the ability to add a logo to overcome a design patent infringement claim, is not palatable to the design patent bar or to design patent owners.

Columbia Sportswear filed suit against Seirus in the Southern District of California, where it received a \$3 million summary judgment with respect to the infringement of its patent in the above-featured design. Columbia's design patent consists of the ornamental design of heat reflective material—a wave pattern featured in its body gear and sleeping bag products. Seirus released a line of gloves and other products with the above-featured wave design. The district court held that "even the most discerning customer would be hard pressed to notice the differences between Seirus's HeatWave design and Columbia's patented design," and further characterized the presence of Seirus's Logo as a "minor difference."

In its decision, the district court relied upon precedent established in *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, which held that logos should be wholly disregarded in the design infringement analysis. In reversing the district court, the Federal Circuit acknowledged that the premise of *L.A. Gear* is that “a would-be infringer should not escape liability for design patent infringement if a design is copied but labeled with its name.” But the Federal Circuit narrowed the application of that decision, indicating that “*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.” The court leaned on the Supreme Court’s decision in *Gorham Co. v. White*, which explained 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.” The Federal Circuit reasoned that “a fact finder is tasked with determining whether an ordinary observer would find the ‘effect of the whole design substantially the same,’” and thus it is not proper to ignore elements of the accused design entirely. It then reversed and remanded the district court’s grant of summary judgment.

So why do we care? Because from the perspective of the design patent bar and design patent owners, several of whom filed amicus briefs in conjunction with Columbia’s petition for rehearing filed this month, this decision “will likely have far-reaching and unintended consequences for design patent law...it threatens the integrity and reliability of the design patent system and jeopardizes the value of millions of design patents.”

From that perspective, if a design is the only focus of a patent, should it not stand that the analysis in an infringement claim should be limited to the design and not additional elements? If not, then “Slapping a Logo on It” creates a path to readily overcome a design patent infringement claim on an otherwise infringing product, undermining the value and protection of design patents.

We will provide updates in this case as they develop.