

**ALERT**

## **Federal Circuit Patent Bulletin: *MRC Innovations, Inc. v. Hunter Mfg., LLP***

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April 2, 2014

On April 2, 2014, in *MRC Innovations, Inc. v. Hunter Mfg., LLP*, the U.S. Court of Appeals for the Federal Circuit (Rader, Prost,\* Chen) affirmed the district court's summary judgment that U.S. Design Patents No. D634,488 S and No. D634,487 S, which related to ornamental designs for a football and baseball jersey for a dog, were invalid for obviousness. The Federal Circuit stated:

Obviousness is a question of law that is reviewed de novo, based on underlying factual questions that are reviewed for clear error following a bench trial. The underlying factual inquiries include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness. . . . In the context of design patents, "the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved." To answer this question, a court must first determine "whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design." That inquiry involves a two-step process. First, the court must identify "a single reference, 'a something in existence, the design characteristics of which are basically the same as the claimed design.'" The "basically the same" test requires consideration of the "visual impression created by the patented design as a whole." We have noted that "the trial court judge may determine almost instinctively whether the two designs create basically the same visual impression," but "must communicate the reasoning behind that decision." Once the primary reference is found, other "secondary" references "may be used to modify it to create a design that has the same overall visual appearance as the claimed design." These secondary references must be "so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other."

The district court used the "Eagles" pet jersey as the "primary reference" . . . . MRC argues that this was legally erroneous because there are significant differences between the Eagles jersey and the patented design of the '488 patent. Specifically, there are three differences: (1) the patented design has a V-neck collar

where the Eagles jersey has a round neck; (2) the patented design contains an interlock fabric panel on the side portion of the design rather than mesh; and (3) the patented design contains additional ornamental surge stitching on the rear portion of the jersey. MRC argues that the district court overlooked these differences by focusing on the claimed design at “too high a level of abstraction.” If the district court had translated the claimed design into a verbal description . . . , MRC insists, it would have concluded that neither the Eagles jersey nor any other prior art reference contained design characteristics that were “basically the same” as the claimed design. . . .

Taking all of those things together (the at least five design characteristics that the claimed design shares with the Eagles jersey and three design characteristics that differ from it), the district court painted a clear picture of the claimed design. The district court did far more than merely ask whether the Eagles jersey disclosed the “general concept” of a pet jersey; it thoroughly considered the “distinctive ‘visual appearances’ of the reference and the claimed design.” Thus, the district court did not err by failing to provide an express verbal description of the claimed design; rather, it described the claimed design in the context of comparing it to the prior art. Nor did the district court err in finding that the design characteristics of the ‘488 design created “basically the same” overall visual impression as the Eagles jersey prior art reference. . . .

After concluding that the Eagles jersey could be a “primary reference,” the district court determined that the V2 jersey and another reference known as the “Sporty K9” jersey were “so related to the primary reference” that they could serve as “secondary references” that would motivate the skilled artisan to make the claimed design. The district court found that both jerseys suggested the use of a V-neck pattern and non-mesh fabric on the side panels—the first two differences described above. MRC argues that the district court erred by failing to explain why a skilled artisan would have chosen to incorporate those features of the V2 and Sporty K9 jerseys with the Eagles jersey.

We disagree. It is true that “[i]n order for secondary references to be considered, . . . there must be some suggestion in the prior art to modify the basic design with features from the secondary references.” However, we have explained this requirement to mean that “the teachings of prior art designs may be combined only when the designs are ‘so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.’” In other words, it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design. [T]he secondary references that the district court relied on were not furniture, or drapes, or dresses, or even human football jerseys; they were football jerseys designed to be worn by dogs. . . . We therefore agree that those references were “so related” to the Eagles jersey that the striking similarity in appearance across all three jerseys would have motivated a skilled designer to combine features from one with features of another.

In support of the non-obviousness of its patents, MRC submitted evidence relating to commercial success, copying, and acceptance by others. . . . As the patentee, it was MRC's burden of production to demonstrate a nexus between the claimed design and the secondary considerations. MRC presented no evidence whatsoever that the commercial success and copying were related to the merits of the claimed invention. Merely stating—with no supporting figures or data—that the V3 was more successful than the V2 is insufficient on its own to establish that the V3 has been a "commercial success" and that its success was attributable to the claimed design features. Moreover, the only license MRC produced was between MRC and FiG, a company that is at least partially owned by Mark Cohen, who also owns MRC.