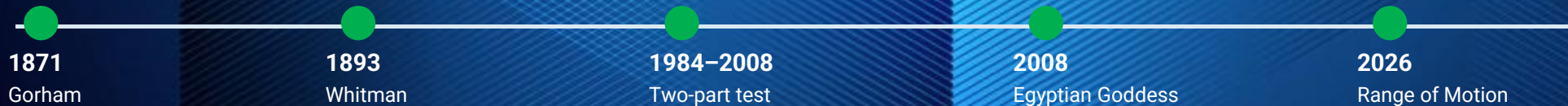


Similarity vs. Dissimilarity – Did Range of Motion Reframe the Design Patent Infringement Test?



Our Speakers



Sean Jungels
Shareholder
Banner Witcoff



George Raynal
Managing Partner
DesignLaw Group

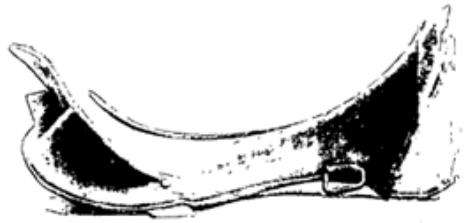
Gorham: Ordinary Observer Test



“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. (14 Wall.) 511, 528 (1871).

Whitman: Prior Art Informs Ordinary Observer

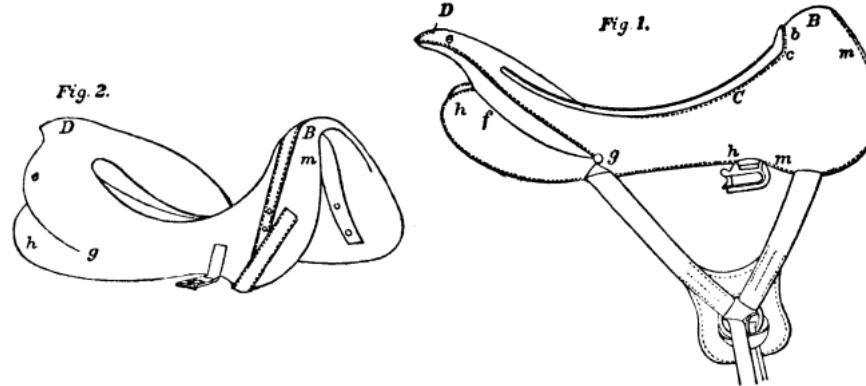


GRANGER



JENIFER

PRIOR ART



PATENTED DESIGN



ACCUSED DESIGN

In a crowded field, small differences may matter a great deal. Conversely, in a sparse field, small differences may not matter as much.

The Pre-Egyptian Goddess Two-Part Test

1 ORDINARY OBSERVER

Were the designs substantially the same in overall appearance to an ordinary purchaser?

2 POINT OF NOVELTY

Did the accused design appropriate the specific feature said to distinguish the patent from prior art?

Why Egyptian Goddess Happened

1 ORDINARY OBSERVER

Were the designs substantially the same in overall appearance to an ordinary purchaser?

2 POINT-OF-VIEW

Did the accused design appropriate the specific design features of the patented design to distinguish the patent from prior art?

EN BANC RESET

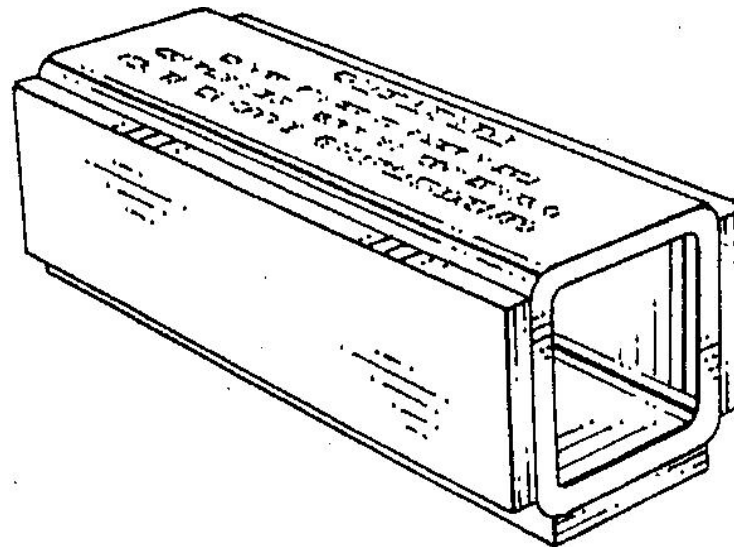
Egyptian Goddess

Swisa Nail Buffer



Accused Design

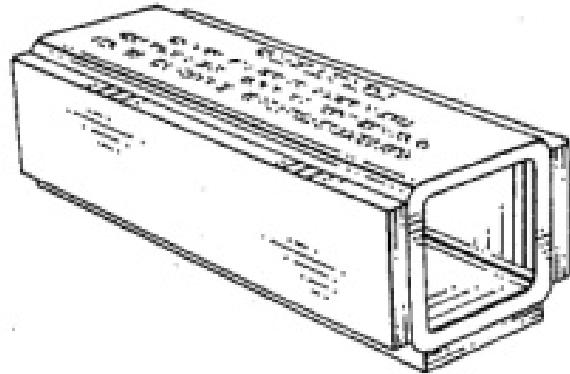
Egyptian Goddess



Egyptian Goddess



Prior Art



*Patented Design
D467,389*

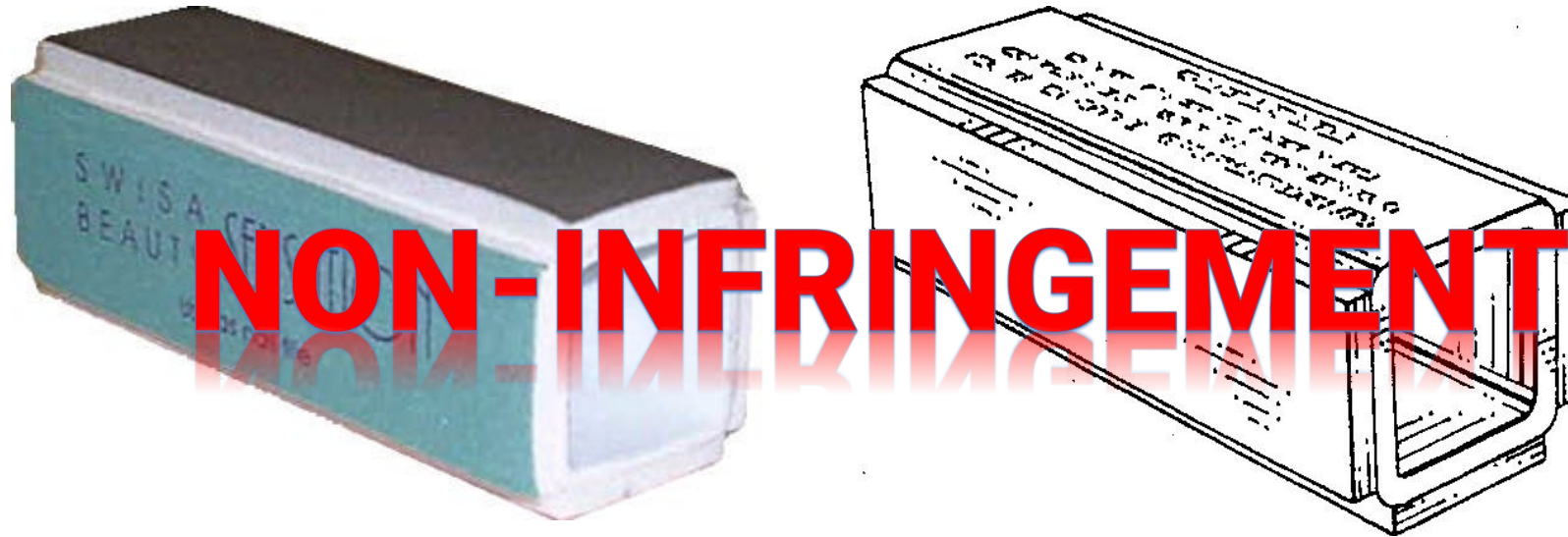


Accused Design



Prior Art

Egyptian Goddess



“In the language used by the Supreme Court in *Gorham*, 81 U.S. at 528, we hold that the accused design could not reasonably be viewed as so similar to the claimed design that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, ‘inducing him to purchase one supposing it to be the other.’ ”

Egyptian Goddess Uses Plainly Dissimilar Once

Plainly Dissimilar

“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*.”

Not Plainly Dissimilar

“In other instances, when the claimed and accused designs are not **plainly dissimilar**, resolution of the question whether the ordinary observer would 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. Where there are many examples of similar prior art designs, as in a case such as *Whitman Saddle*, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.”

Goodyear Tire & Rubber v. Hercules Tire & Rubber

In providing for infringement by “colorable imitation” the statute recognizes that minor changes in a design are often readily made without changing its overall appearance.

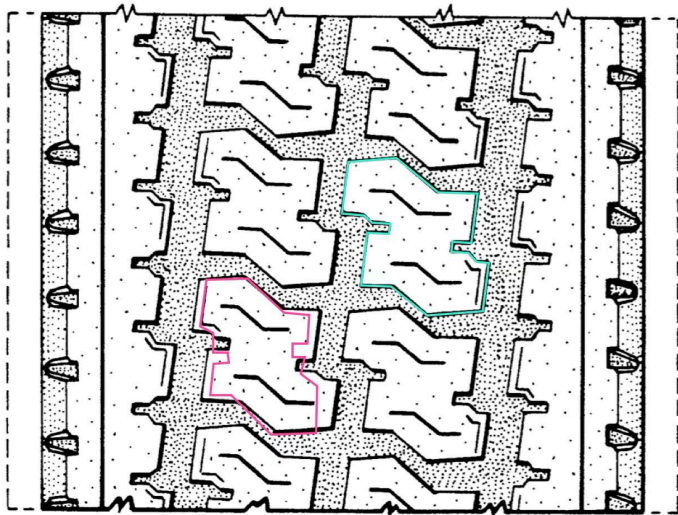
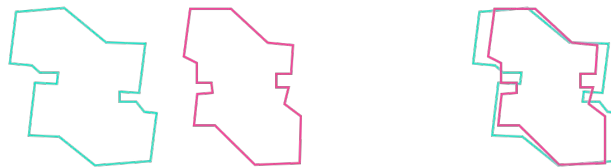
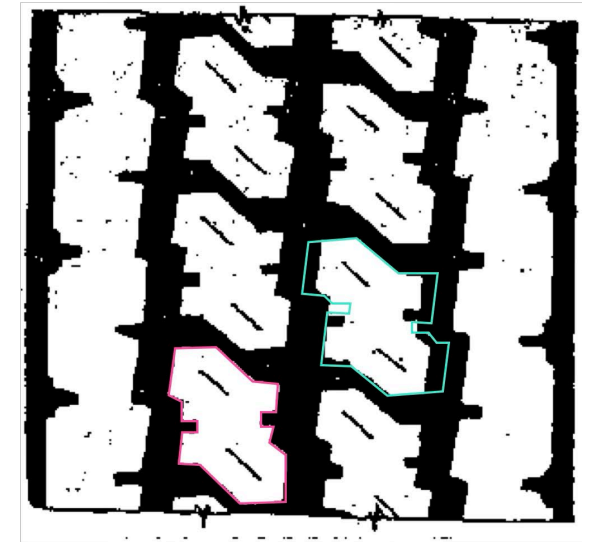


FIG. 4

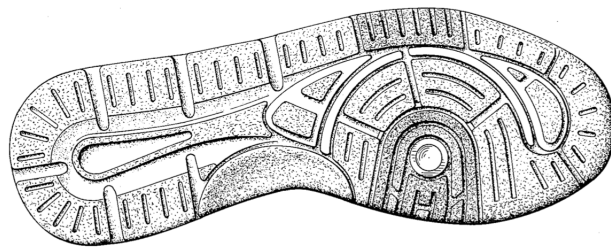


Avia v. LA Gear

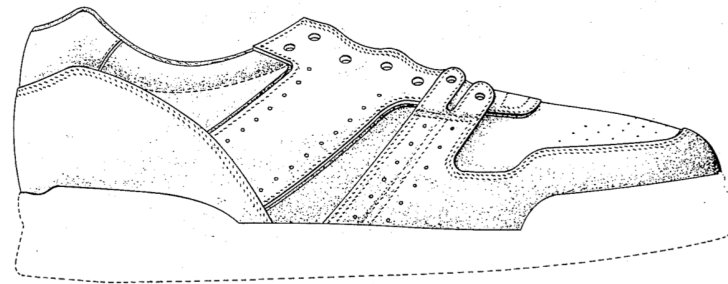
853 F.2d 1557 (Fed. Cir. 1988)

Under Rule 56(c) **summary judgment** may be granted "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is **no genuine issue as to any material fact** and that the moving party is entitled to a judgment as a matter of law."

There is no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. If the evidence [of the nonmovant] is merely colorable, or is not significantly probative, summary judgment may be granted.



D284,820

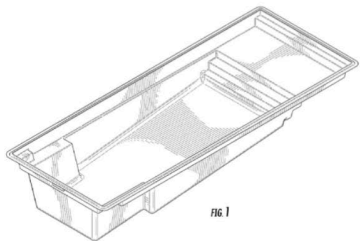
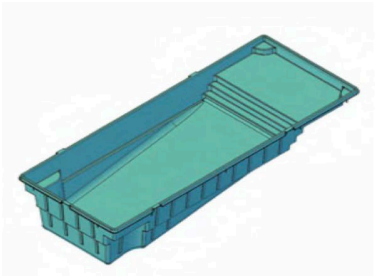
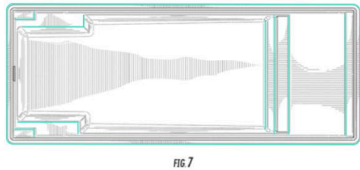
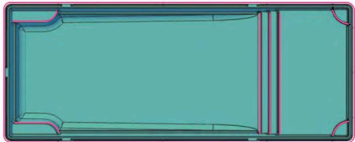


D284,301



Northstar Tech v. Latham Pool Prods.

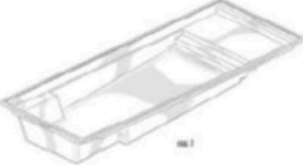
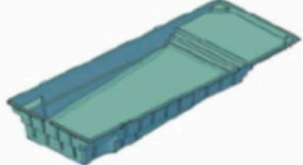
Summary judgement
non-infringement granted

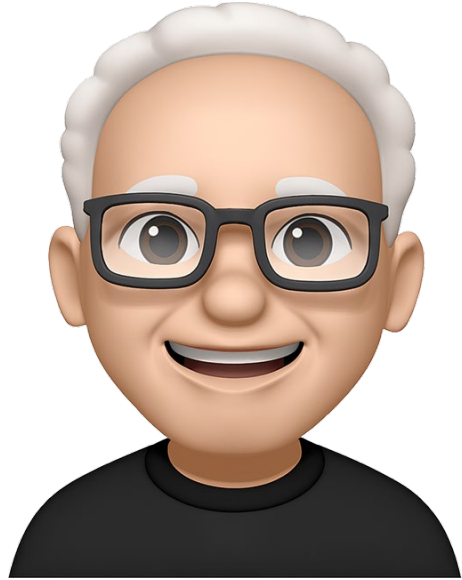


Northstar Tech v. Latham Pool Prods.

23-2138 (Fed. Cir. 2025)

Summary judgement
non-infringement granted

D'966 Patented Design	Accused Design: Corinthian 16	Prior Art: St. Thomas
		
		
		



Don't return to PoN

Know it when you see it

Rely on 3-way comparison



Sun Hill v. Easter Unlimited
48 F.3d 1193

Range of Motion Prods. v. Armaid

23-2427 (Fed. Cir. 2026)

Summary judgement
non-infringement granted

D'155 Patent (The claimed design)	Armaid2 (The accused product)	Armaid1 (The prior art)
		

What Is Happening with Design Patent Infringement at the Federal Circuit?

FEDERAL CIRCUIT RULE 36

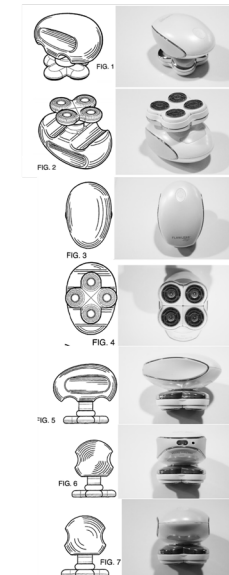
Entry of Judgment

(a) Judgment of Affirmance Without Opinion.

The court may enter a judgment of affirmance without opinion, citing this rule, when it determines that **any of the following conditions exist** and an opinion would have no precedential value:

- (1) the judgment, decision, or order of the trial court appealed from is based on findings that are **not clearly erroneous**;
- (2) the evidence supporting the jury's verdict is sufficient;
- (3) **the record supports summary judgment**, directed verdict, or judgment on the pleadings;
- (4) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or
- (5) a judgment or decision has been entered without an error of law.

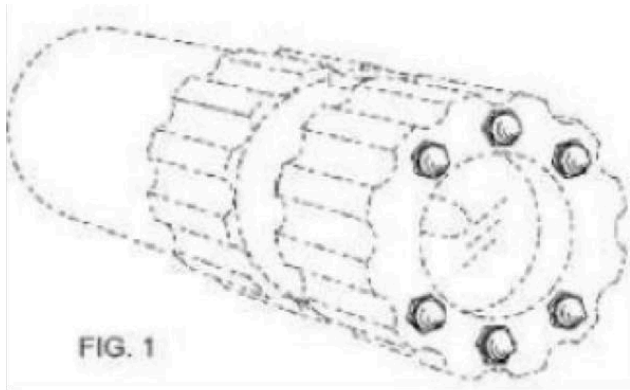
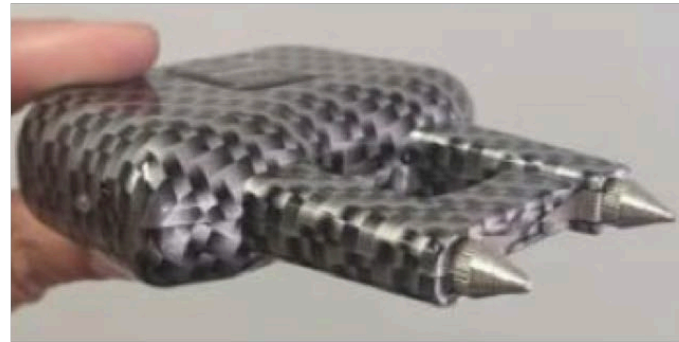
MTD ; MSJ non-infringement granted



Skullshaver v. Ideavillage Products
23-1457 (April, 2024)

PS Products Inc. v. Panther Trading Co. Inc.

23-1665 (Fed. Cir. 2024)

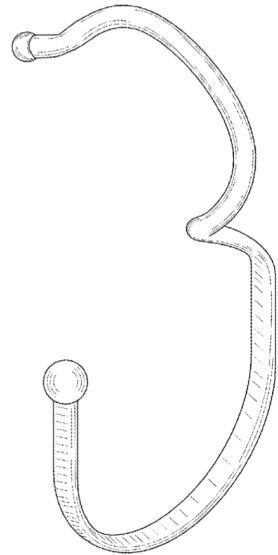
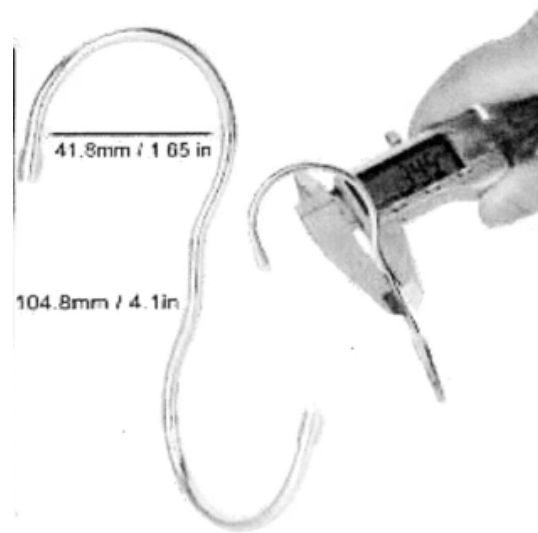


No reasonable person
could find infringement -
nuisance

No ordinary observer would be deceived into believing Panther's accused product is the same as the D'188 patented design, see above. No reasonable person could conclude that the facts of this case create a cause of action for design patent infringement. The accused product and patented design are so plainly dissimilar that it appears, as Panther argues, fairly characterized as a nuisance suit.

Jacki Easlick v. CJ Emerald

Denial of preliminary injunction affirmed



Considering distinguishing features not legal error

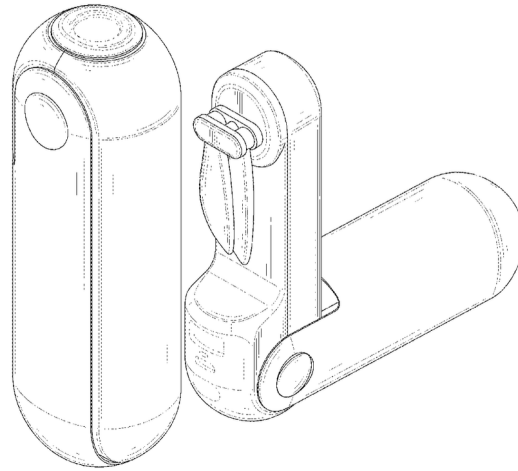
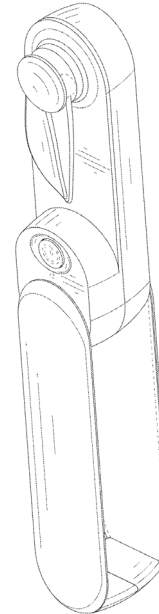
Indeed, the district court noted that “[e]ven if the pictures of the Tote Hanger and the [a]ccused [p]roduct were mixed randomly, an ordinary observer could quickly restore them to their original order upon viewing the center of the parties’ handbag hooks.” **Considering distinguishing features—as the district court did here—is not legal error.** And it is hard to imagine how a court could reasonably conduct this analysis without pointing such features out.

Shenzhen Jisu Tech v. Annex A

25-1617 (Fed. Cir. 2026)

Preliminary Injunction
granted then dissolved

D886,982
Asserted



Non-anticipation =
non-infringement

D1,046,104
Embodiment of accused design

We see no abuse of discretion in the district court's application of these themes to the facts before it as an aid in estimating the likelihood that Shenzhen would succeed in its claim for infringement. Because the accused products were purported to be coextensive with the later-issued '104 patent, the district court was within its discretion to note that the '104 patent's issuance may suggest that an ordinary observer would not find the accused products substantially similar to the design claimed by Shenzhen's '982 patent.

Shenzhen Jisu Tech v. Annex A

25-1617 (Fed. Cir. 2026)

Preliminary Injunction
granted then dissolved;
affirmed

DISSENT: Judge Stoll

To assess whether a patentee has shown a likelihood of success on the merits of proving infringement of a design patent, “the court must conduct a three[-]way analysis comparing the accused product, the patented design, and the prior art.” In conducting this three-way analysis, the district court is “to apply the ordinary observer test on a product-by-product basis,” *id.* at 943—i.e., asking whether “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.” ***This framework for assessing potential design patent infringement must be used in every case.*** But such a framework was not used here.

ABC Corp v. Schedule A

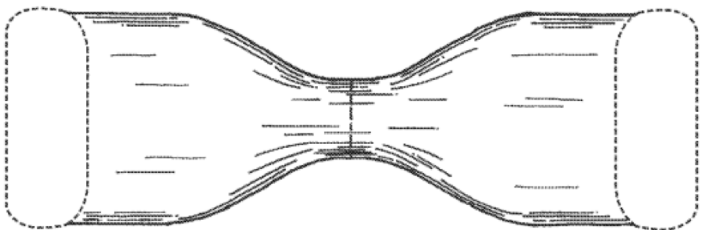
23-1071 (Fed. Cir. 2022)

24-1471 (Fed. Cir. 2025)

Preliminary injunction granted then reversed on appeal

Defendant’s MSJ non-infringement Granted and affirmed

	Top View	Bottom View	Perspective View	Front/Back View	Foot Pad	Fender
Accused Product A						
Prior Art D'996					n/a	
Patent-in-Suit D'723						
Patent-in-Suit D'256						
Patent-in-Suit D'195						



Dominant feature appears in prior art

[W]here a dominant feature of the patented design and the accused products—here the hourglass shape—appears in the prior art, the focus of the infringement substantial similarity analysis in most cases will be on other features of the design. The shared dominant feature from the prior art will be no more than a background feature of the design, necessary for a finding of substantial similarity but insufficient by itself to support a finding of substantial similarity.

Dynamite Marketing v. The Wowline

\$3.5 million jury verdict;
Denial of JMOL affirmed

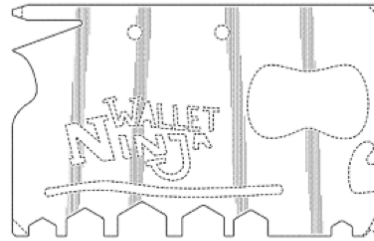


*Figure 2 (repeated): D877 Patent
(solid lines show the claimed design)*



Figure 3: Original TOL4



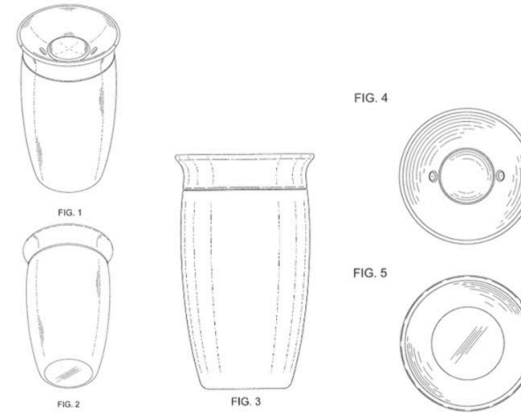
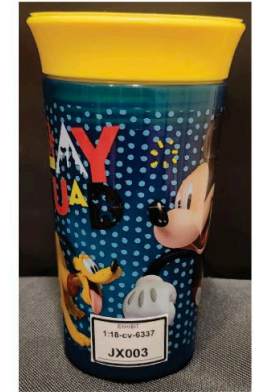
Figure 4: Redesigned TOL4

Some differences are ok for the jury

Pending Federal Circuit Cases

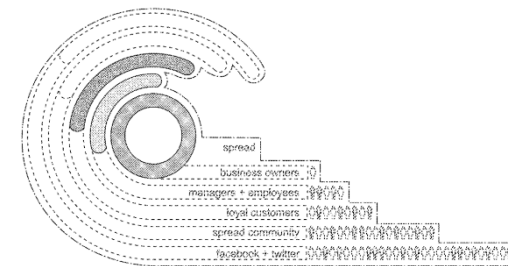
Munchkin v. Tomy 26-1820

“The court erred by denying judgment as a matter of law when the accused design was so plainly dissimilar from the patented design that no reasonable jury could have found infringement.”



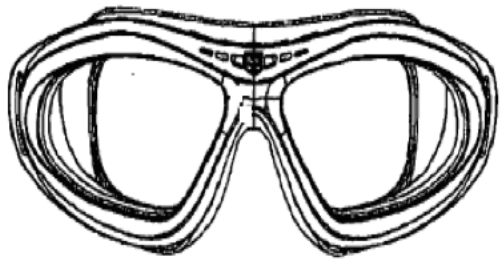
Shunock v. Apple 26-1821

“The District Court’s limited prior art treatment does not salvage its erroneous “plainly dissimilar” determination or support summary judgment of noninfringement.”



Revision Military v. Balboa (Fed. Cir. 2012)

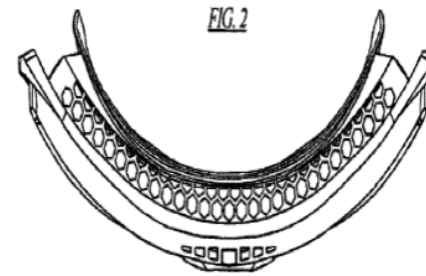
Preliminary injunction denied;
reversed and remanded



'098 Patent Figure 2



Bobster Bravo



'039 Patent Figure 2



Bobster Bravo

Although individual features may indeed serve in assessing the impact on the overall appearance in determining whether apparently minor differences between specific features would be recognized as distinguishing the designs, it is often helpful to refer to any prior art with which the ordinary observer would reasonably be familiar.

What Is Happening with Design Patent Infringement in District Courts?

91 design patent cases where MSJ non-infringement was sought

64% granted, of which 50% relied on sufficiently distinct / plainly dissimilar

leaving 50% of decisions granting summary judgement decided on other grounds

Considerations

Is it permissible to consider differences?

Should the prior art be considered every time?

Is the prior art baked into the ordinary observer perspective?

What prior art is an ordinary observer reasonably aware of?

Should designs be overlaid or annotated for comparison?

How much attention does the prior art get?

District Court Examples

Plainly Dissimilar / Sufficiently Distinct?



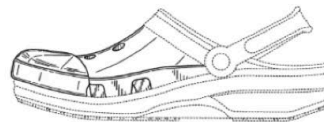
'033 Patent Fig. 1



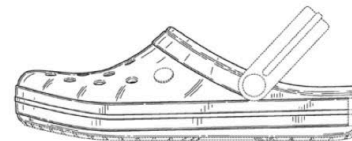
'784 Patent Fig. 1



Varsity Clog



'205 Patent Fig. 1



'784 Patent Fig. 3



Varsity Clog

District Court Examples

Plainly Dissimilar / Sufficiently Distinct?

'279 Patent	Hengda Kite
	
	

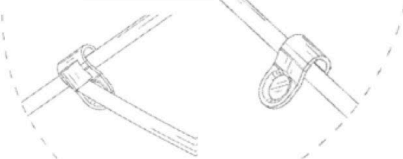
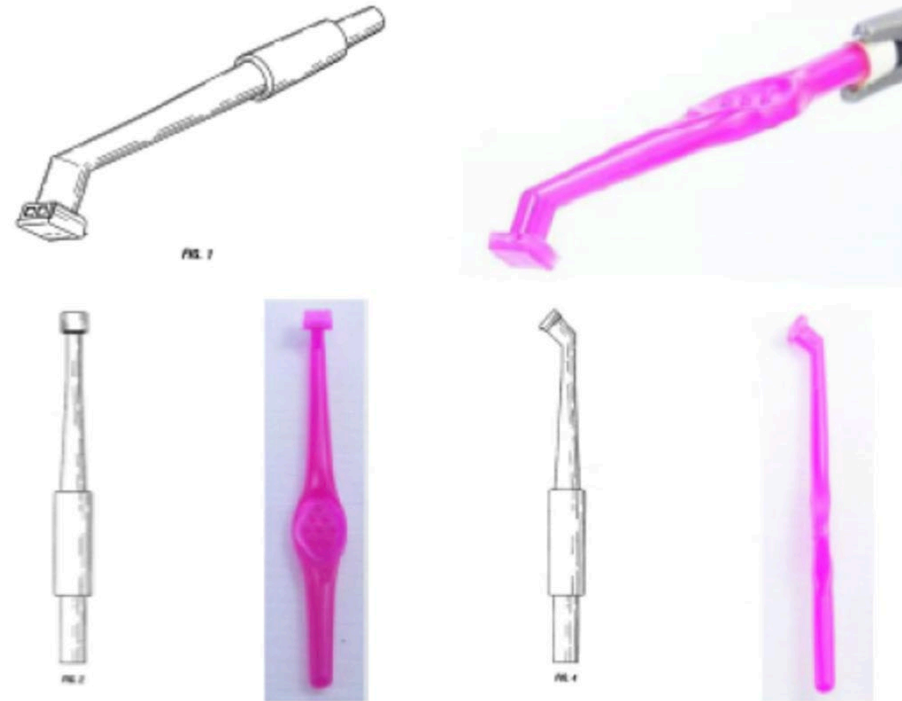

FIG 24: Connections Claimed in the '279 Patent

FIG 25: Hengda Kite's Connections

District Court Examples

Plainly Dissimilar / Sufficiently Distinct?



District Court Examples

Plainly Dissimilar / Sufficiently Distinct?



Thank you.

