

Nos. 19-1435, -1717

**IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

SPIGEN KOREA CO., LTD., a Republic of Korea corporation
Plaintiff - Appellant

v.

**ULTRAPROOF, INC., a California corporation, ULTRAPROOF, INC., a
Nevada corporation, ENDLISS TECHNOLOGY, INC., a California
corporation,**

Defendants - Cross-Appellants

DOES, 1 through 10, inclusive,
Defendant

**Appeal from the United States District Court for the Central District of
California in Case Nos. 2:16-cv-09185-DOC-DFM and 2:17-cv-01161-DOC-
DFM United States District Judge David O. Carter**

**COMBINED PETITION FOR PANEL REHEARING AND REHEARING
EN BANC OF DEFENDANT-APPELLEES ULTRAPROOF, INC. AND
ENDLISS TECHNOLOGY, INC.**

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CERTIFICATE OF INTEREST

Counsel for Appellees/Cross-Appellants Ultraproof, Inc., a Nevada corporation, and Endliss Technology, Inc. certifies the following:

1. The full name of every party or amicus represented by me is:

Ultraproof, Inc. and Endliss Technology, Inc.

Plaintiff/Appellant Spigen Korea Co., Ltd. also named an entity called Ultraproof, Inc. (a California corporation). No such entity exists.

2. Name of Real Party in Interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:

None

3. Parent corporations and publicly held companies that own 10% or more of stock in the party:

None

4. The names of all law firms and the partners and associates that have appeared for the party in the lower tribunal or are expected to appear for the party in this court and who are not already listed on the docket for the current case:

Prometheus Partners L.L.P. f/k/a Puritan Law: Jack I. Jmaev

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal.

None

Dated: May18, 2020

/s/Benjamin A. Campbell
Benjamin A. Campbell
Counsel for Cross-Appellants

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I. Counsel’s Statement in Accordance With Federal Circuit Rule 35(b)(2)

A. Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States and the following precedents of this Court:

Graham v John Deere Co., 383 U.S. 1 (1966).

KSR Int’l Co. v. Teleflex, Inc., 550 U.S. 398 (2007).

B. Based on my professional judgment, I believe this appeal requires an answer to one or more precedent setting questions of exceptional importance:

Whether obviousness of a design patent should require an initial threshold step of identifying a primary reference that is “basically the same” as a patented design?

/s/Benjamin A. Campbell
Benjamin A. Campbell
Attorney for Defendant-Appellees

II. Points of Law or Fact Overlooked or Misapprehended by the Panel of the Court

A. The Court failed to appreciate the inventor's implicit admission that the '218 patent is a suitable primary reference in his conception drawing.

B. The Court misapprehended the effect of having the inventor's actual references he considered in conceiving the patented design by requiring that one of the references be a "basically the same" primary reference for obviousness.

III. The Argument in Support of a Panel Rehearing

A. Introduction

This Court held that it was an error for the District Court to analyze whether the asserted prior art references obviate the Spigen Design Patents¹ because there was a dispute of fact as to whether U.S. Patent No. D729,218, ("the '218 Patent") is "basically the same" as the Spigen Design Patents, and, thus, a proper primary reference in an obviousness analysis. *See* Opinion at p.6. In doing so, the Court relied upon the parties competing experts presented below and held that "[i]n view of the competing evidence in the record, a reasonable factfinder could conclude that the '218 patent and the Spigen Design Patents have substantial differences, and, thus, are not basically the same." *Id.* at p. 8 (citing Fed. R. Civ. P. 56(c)).

¹ The patents at issue in this appeal, collectively referred to as the "Spigen Design Patents," are U.S. Patent Nos. D771,607 ("the '607 Patent), D775,620 ("the '620 Patent"), and D776,648 ("the '648 Patent").

The Court then cited *Durling v. Spectrum Furniture Co.*, 101 F. 3d 100, 105 (Fed. Cir. 1996) for the holding that “Without . . . a primary reference, it is improper to invalidate a design patent on grounds of obviousness.” *Id.*

As the Court noted “[s]ummary judgement of obviousness is appropriate if ‘the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors.’” Opinion at p. 5 (quoting *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014)). Whether the claim is obvious in the design patent context ultimately turns on “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1371, 1380-81 (Fed. Cir. 2009) (quoting *Durling* 101 F.3d at 103 (Fed. Cir. 1996)). While the ultimate question of obviousness is a question of law (*see e.g.*, *M.R.C. Innovations*, 747 F.3d 1331), the Court’s precedent introduces an initial threshold question of fact: whether there is a primary reference, “a single reference, ‘a something in existence, the design characteristics of which are basically the same as the claimed design.’” *Durling*, 101 F.3d at 103 (quoting *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982)).

B. This Court Erred by Failing to Appreciate the Inventor’s Own Evidence Supporting Obviousness

The original intent behind the Court’s primary reference standard appears to

be the avoidance or hindsight bias and the piecemeal, undirected, combination of elements from a plethora of references. See *In re Jennings*, 182 F.2d 207, 208 (C.C.P.A. 1950) (reversing a decision of the Board of Appeals of the United States Patent Office rejecting a design application over the combination of individual elements from five utility patents). In *Rosen*, the Court cited *In re Jennings* and held “[t]hus there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness.” *In re Rosen*, 673 F.2d at 391.

While the existence of a primary reference requiring only minor modification to arrive at the claimed design certainly aides in avoiding hindsight bias and piecemeal obviousness determinations, it is certainly not the only way that the obviousness of a design can be apparent. The ultimate question is, and must remain, “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Durling*, 101 F.3d at 103 (citing *In re Rosen*, 673 F.2d at 390). This ordinary designer, however, is not an automaton, but rather, is charged with knowledge of the prior art and ordinary creativity. See e.g., *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 421 (2007).

Here, the inventor’s own statements and knowledge should be considered to inform that ordinary creativity. Specifically, the references cannot be viewed in a vacuum separated from the actual designing process. In this case, we know that

the '218 Patent and '208 Patent were integral to the design process because the former is specifically referenced in the inventor's conception drawing and the latter is the inventor's own prior design (as co-inventor). *See* Appx5893 (identifying the commercial embodiment of the '218 Patent) *and* Appx171 (the '209 Patent naming Dae-Young Kim as co-inventor). The avoidance of a hindsight combination of references, therefore, is not a factor in this obviousness analysis and requiring a "basically the same" primary reference is unnecessary. Knowing the references actually known to and considered by the inventor, the only question remaining is whether the resulting combination of those references is, as the District Court held, an obvious result.

IV. The Argument in Support of a Rehearing En Banc

This Court reversed the District Court's Summary Judgment Order which found each of the asserted design patents obvious in view of two references: U.S. Patent No. D729,218 ("the '218 Patent") and U.S. Patent No. D772,209 ("the '209 Patent"). In particular, this Court held it was error for the District Court to hold the '218 Patent as a suitable primary reference at summary judgment because the parties presented competing experts who disagreed as to whether the '218 Patent was "basically the same" as the asserted designs. Accordingly, this Court held that a genuine issue of material fact existed, thereby preventing a summary judgment ruling. This Court then declined to address any remaining issues, including:

whether the '209 Patent was a suitable secondary reference; whether the combination of the '218 Patent and the '209 Patent would render the asserted design patents obvious; and whether the same combination of the '218 Patent and the '209 Patent, with the '209 Patent designated as the “primary” reference and the '218 Patent designated as the “secondary” reference would render the asserted design patents obvious.

Under current precedent, obviousness in the context of design patents is a two-step inquiry designed to determine whether a designer of ordinary skill in the art would have combined prior art references to create a design with the same overall visual appearance as the claimed design. *See Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). The first step in the two-step analysis is to identify “a single reference, ‘a something in existence, the design characteristics of which are basically the same as the claimed design.’” *Id.* (quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)). To determine if a design is “basically the same” the Court looks to the “visual impression created by the patented design as a whole.” *Id.*

Under the second step of the two-step analysis, other references “may be used to modify [the primary reference] to create a design that has the same overall visual appearance as the claimed design.” *Id.* 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.” *Id.* (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996) (alteration in original)).

The initial threshold factual question of whether a single reference is “basically the same” as the asserted design has long been questioned by commentators² and this Court sitting *en banc* should take this opportunity to overturn precedent requiring this element. While the existence of such a reference may be relevant to an obviousness analysis, the same way a teaching, suggestion, or motivation to combine two references may be relevant to the obviousness of a utility patent, it cannot stand as a rigid and exclusive test for determining obviousness of design patents. Particularly in a case where, as here, the inventor actually relied upon the two combined invalidating references. Why should it matter which if the two references are labeled “primary” and “secondary” in such an instance?

Design patents are subjected to the same validity constrictions as utility patents; primarily, novelty and non-obviousness. *See* 35 U.S.C. § 171(b) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”). As to obviousness, Section 103 of the

² *See e.g.*, Sarah Burstein, *Visual Invention*, 16 Lewis & Clark L. Rev. 169 (2012) and Paul Morgan, *Design Patents §103 – Obvious to Whom and As Compared to What?*, PATENTLYO guest blog post (2014) (available at: <https://patentlyo.com/patent/2014/09/§103-obvious-compared.html>, last accessed 5/17/2020).

Patent Act provides:

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.

35 U.S.C. §103.

The Supreme Court has specifically cautioned against any rigid and formulaic tests used to elicit whether an invention is obvious. In *KSR*, the Supreme Court analyzed the obviousness of a utility patent under the then-governing “TSM test” being used by this Court, which mandated that a patent claim was only proved obvious “if the prior art, the problem’s nature, or the knowledge of a person having ordinary skill in the art reveals some motivation or suggestion to combine the prior art teachings.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The Supreme Court unanimously rejected the TSM test as too rigid and held that the *Graham* framework remains the proper analysis of obviousness under §103:

We begin by rejecting the rigid approach of the Court of Appeals. Throughout this Court's engagement with the question of obviousness, our cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here. To be sure, *Graham* recognized the need for uniformity and definiteness. Yet the principles laid down in *Graham* reaffirmed the functional approach of *Hotchkiss*. To this end, *Graham* set forth a broad inquiry and invited courts, where appropriate, to look at any secondary considerations that would prove instructive.

Neither the enactment of § 103 nor the analysis in *Graham* disturbed this Court's earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art. For over a half century, the Court has held that a patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

KSR, 550 U.S. at 415-16 (citations and quotations omitted) (referring to *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *Hotchkiss v. Greenwood*, 52 U.S. 248 (1851)).

Like the TSM test in *KSR*, the “basically the same” test has been too rigidly applied by the Court in this case. There is no genuine issue of fact as to the content of the prior art (*i.e.*, whether the '218 and '209³ Patent constitute prior art).

Likewise, there is no material dispute as to the scope of the patent claim or the level of ordinary skill in the art. As such, the only question at summary judgment is whether the obviousness of the Spigen Design Patents is apparent in light of

³ At the District Court, Spigen argued that the '209 Patent should not constitute prior art because Mr. Kim has assigned his rights and the co-inventor was under an obligation to assign his rights to Spigen, making the '209 Patent commonly owned with the Spigen Design Patents. *See* 35 U.S.C. §102(b)(2)(C). However, the District Court correctly held that under the applicable laws of South Korea, the coinventor had no obligation to assign his inventions absent an employment contract requiring such assignment. Since Spigen failed to produce such a contract, the '209 Patent remained applicable prior art.

those factors, which is a legal question. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014). It is improper to insert an additional and, at least in this case, unnecessary factual inquiry into this analysis.

Similarly, the fact that the parties presented competing experts who disagreed as to the obviousness conclusion does not foreclose summary judgment:

To the extent the court understood the *Graham* approach to exclude the possibility of summary judgment when an expert provides a conclusory affidavit addressing the question of obviousness, it misunderstood the role expert testimony plays in the analysis. In considering summary judgment on that question the district court can and should take into account expert testimony, which may resolve or keep open certain questions of fact. That is not the end of the issue, however. The ultimate judgment of obviousness is a legal determination. Where, as here, the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate.

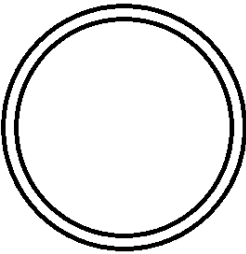
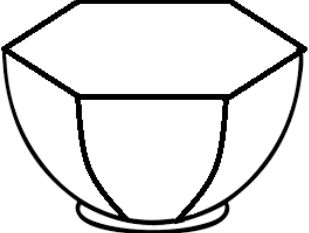
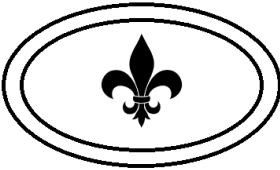

KSR, 550 U.S. 426-27 (citation omitted).

Following *KSR*, the *Graham* framework sets forth the outer bounds of a proper obvious analysis. More rigid tests that define a smaller subset of the broader obvious analysis may be helpful to determine whether a subject patent is obvious. However, the failure to meet a more rigid test cannot establish that a patent is not obvious. *See KSR*, 550 U.S. at 418-419 (“When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine known elements in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. . . . Helpful insights,

however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents.”).

The broader guidelines of the *Graham* framework require analysis of obviousness for design patents that goes beyond the strict requirements of the “basically the same” test the same way that courts must look beyond the TSM test to analyze the obviousness of utility patents.

Consider the following hypothetical prior art and design patent. Reference A is a circular dinner plate; Reference B is a hexagonal salad bowl; Reference C is an oblong platter with a fleur de lis on its base; and the Hypothetical Design Patent is an hexagonal dinner plate with a fleur de lis on its base.

Reference A	Reference B	Reference C	Hypothetical Design Patent
			

Would any of these hypothetical references be “basically the same” as the hypothetical design patent? Reference A shares no design characteristics with the hypothetical design patent but provides the general idea of a dinner plate.

Reference B teaches us that dinnerware can be hexagonally shaped, rather than the more traditional circular appearance. Reference B might even be said to suggest

the desire to create other hexagonally shaped dinnerware so as to complement the design of the bowl. However, Reference B is arguably non-analogous art and would require substantial modification to become a plate. Finally, Reference C teaches us that dinnerware may be adorned with a fleur de lis, but again says nothing about dinner plates and would require modification to become a hexagonal plate. The hypothetical design patent appears to include 3 design elements: (1) a dinner plate; (2) having a hexagonal outer shape; and (3) a fleur de lis adorned on its surface. None of the references share more than one of these elements, yet it is hard to imagine that a designer of even minimal creativity being familiar with these references would not consider the final product obvious.

While, perhaps an oversimplification, the above-outlined hypothetical demonstrates that requiring a court to first find a primary reference which is “basically the same” as the asserted patent forecloses a broad range of combinations that an ordinary designer might determine are obvious.

In the present case, there is actually an express suggestion to combine the asserted references. As noted above, the '209 Patent was coined by the inventor of the Spigen Design Patents and the commercial embodiment of the '218 Patent is specifically referenced for its dimensions in the inventor's conception drawing. In other words, we know that the inventor was considering modifying his earlier design to include design elements from the commercial embodiment of the

'218 Patent.

The narrowness of the current obvious analysis can also be demonstrated by comparison to the novelty test under 35 U.S.C. §102. In order to be novel, a design cannot be “substantially the same” as a prior design, when viewed by “an ordinary observer, giving such attention as a purchaser usually gives.” *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009) (quoting *Gorham v. White*, 81 U.S. (14 Wall.) 511, 528 (1872)). If the appearance of the new design “is such as to deceive such an observer, inducing him to purchase [the new design] supposing it to be the other,” then the design is not novel. *Id.* (quoting *Gorham*, 81 U.S. (14 Wall.) at 528). In this analysis, the ordinary observer is “deemed to view the differences between the patented design and the accused product in the context of the prior art.” *Id.* (quoting *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676 (Fed. Cir. 2008) (en banc)).

In other words, a design patent is not novel if a single reference is “substantially the same” as the patented design. There is virtually no practical difference between a reference being “substantially the same” (so as to anticipate) versus being “basically the same” (such that it is an acceptable primary reference for obviousness). “Substantially” and “basically” are effectively synonyms, they both mean “mostly” or “essentially.” An obviousness test that requires near anticipation is too narrow and must be revised.

In the alternative, even without completely abandoning the “basically the same” primary reference standard, an exception to this general requirement should be recognized. Where, as here, the references actually known to and considered by the inventor are shown from contemporaneous evidence, the step of designating one such reference as the “primary reference” serves no purpose. Consequently, the analysis should collapse into the question of whether the resulting combination of those known references is, as the District Court held here, an obvious result.

V. Conclusion and Relief Sought

Defendant-Appellees respectfully request a rehearing and a rehearing *en banc*. This Court should reject the strict application of the current test for obviousness of design patents and instead follow the framework set forth in *Graham*: (1) determine the scope and content of the prior art; (2) ascertain any differences between the prior art and the patented design; (3) determine the level of ordinary skill in the pertinent art; and (4) determine whether, in view of those determinations, the subject design is obvious. *See Graham* 383 U.S. 17-18.

DATED: May 18, 2020

Respectfully submitted by,

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CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(b)(2), because this brief contains 3,556 words, excluding the parts of the brief exempted by Federal Circuit Rule 35(c)(2).

Dated: May 18, 2020

/s/Benjamin A. Campbell
Benjamin A. Campbell

ADDENDUM

**United States Court of Appeals
for the Federal Circuit**

**SPIGEN KOREA CO., LTD., A REPUBLIC OF
KOREA CORPORATION,**
Plaintiff-Appellant

v.

**ULTRAPROOF, INC., A CALIFORNIA
CORPORATION, ULTRAPROOF, INC., A NEVADA
CORPORATION, ENDLISS TECHNOLOGY, INC., A
CALIFORNIA CORPORATION,**
Defendants-Cross-Appellants

DOES, 1 THROUGH 10, INCLUSIVE,
Defendant

2019-1435, 2019-1717

Appeals from the United States District Court for the
Central District of California in Nos. 2:16-cv-09185-DOC-
DFM, 2:17-cv-01161-DOC-DFM, Judge David O. Carter.

Decided: April 17, 2020

JOSHUA DAVID CURRY, Lewis Brisbois Bisgaard &
Smith LLP, Atlanta, GA, argued for plaintiff-appellant.
Also represented by BRIAN G. ARNOLD, JOSEPHINE BROSAS,
JEAN KIM, Los Angeles, CA.

BENJAMIN ADAM CAMPBELL, Bishop Diehl & Lee, Ltd., Schaumburg, IL, argued for defendants-cross-appellants. Also represented by EDWARD L. BISHOP, JAMES JAGODA.

Before NEWMAN, LOURIE, and REYNA, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* REYNA.

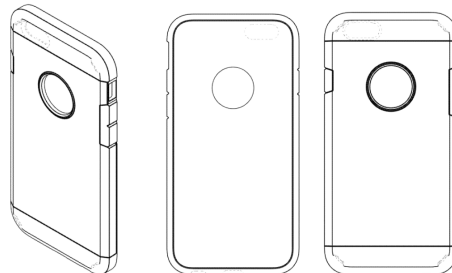
Circuit Judge LOURIE dissents.

REYNA, *Circuit Judge*.

Spigen Korea Co., Ltd., appeals the decision of the United States District Court for the Central District of California granting summary judgment of invalidity of three asserted design patents. Ultraproof, Inc., cross-appeals the district court’s denial of its motion for attorneys’ fees. Because the district court improperly resolved a genuine dispute of material fact at summary judgment, we reverse the district court’s decision and remand for further proceedings. We dismiss the cross-appeal as moot.

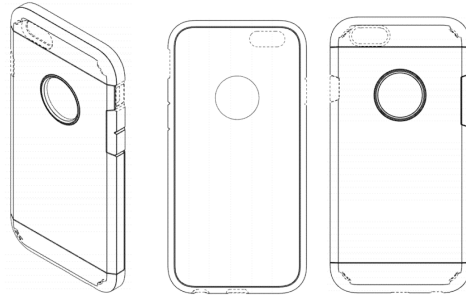
BACKGROUND

Spigen Korea Co., Ltd., (“Spigen”) owns U.S. Design Patent Nos. D771,607 (“the ’607 patent”), D775,620 (“the ’620 patent”), and D776,648 (“the ’648 patent”) (collectively the “Spigen Design Patents”), which each claim a case for a cellular phone. Figures 3–5 of the ’607 patent are illustrative of the claimed design:



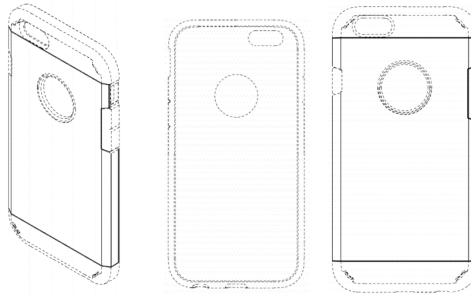
J.A. 88–90.

The '620 patent disclaims certain elements present in the '607 patent. Figures 3–5 of the '620 patent are illustrative of the claimed design¹:



J.A. 99–101.

Lastly, the '648 patent disclaims most of the elements present in the '607 and '620 patents. Figures 3–5 of the '648 patent are illustrative of the claimed design²:



J.A. 110–12.

On February 13, 2017, Spigen sued Ultraproof, Inc., (“Ultraproof”) for infringement of the Spigen Design Patents in the United States District Court for the Central

¹ The design figures of the patent contain solid and broken lines. The broken lines depict features disclaimed from of the claimed design.

² See *supra* note 1.

District of California. Ultraproof filed a motion for summary judgment of invalidity of the Spigen Design Patents. Ultraproof argued that the Spigen Design Patents were obvious as a matter of law in view of a primary reference, U.S. Design Patent No. D729,218 (“the ’218 patent”), and a secondary reference, U.S. Design Patent No. D772,209 (“the ’209 patent”). Spigen opposed the motion, arguing that as a matter of law, the Spigen Design Patents were not rendered obvious by the ’218 patent and the ’209 patent. Alternatively, Spigen argued, various underlying factual disputes precluded summary judgment. The district court held as a matter of law that the Spigen Design Patents were obvious over the ’218 patent and the ’209 patent and granted summary judgment of invalidity in favor of Ultraproof.

Subsequently, Ultraproof moved for attorneys’ fees pursuant to 35 U.S.C. § 285. The district court denied the motion. Spigen timely appeals the obviousness determination. Ultraproof cross-appeals the denial of attorneys’ fees. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

DISCUSSION

We review a grant of summary judgment under the law of the regional circuit, which in this case is the Ninth Circuit. *See, e.g., Cheetah Omni LLC v. AT&T Servs., Inc.*, 949 F.3d 691, 693 (Fed. Cir. 2020). The Ninth Circuit reviews a district court’s grant of summary judgment de novo. *See, e.g., L.F. v. Lake Wash. Sch. Dist. #414*, 947 F.3d 621, 625 (9th Cir. 2020). 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). In other words, summary judgment may only be granted when no “reasonable jury could return a verdict for the nonmoving party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

Summary judgment of obviousness is appropriate if “the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors.” *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014) (citation and quotation marks omitted). Design patents are presumed valid and, thus, a moving party seeking to invalidate a design patent at summary judgment must submit such clear and convincing evidence of facts underlying invalidity that no reasonable jury could find otherwise. *See Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1328 (Fed. Cir. 2015).

I

Spigen raises several grounds for reversing the district court’s grant of summary judgment. First, Spigen argues that there is a material factual dispute over whether the ’218 patent is a proper primary reference that precludes summary judgment. We agree.

For design patents, the ultimate inquiry for obviousness “is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1380–81 (Fed. Cir. 2009) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). This inquiry is a question of law based on underlying factual findings. *See, e.g., MRC Innovations*, 747 F.3d at 1331. One underlying factual issue is whether a prior art design qualifies as a “primary reference.” *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311 (Fed. Cir. 2013) (explaining that a “finder of fact” must identify a primary reference); *see also Campbell Soup Co. v. Gamon Plus, Inc.*, 939 F.3d 1335, 1340 (Fed. Cir. 2019) (same); *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (same).

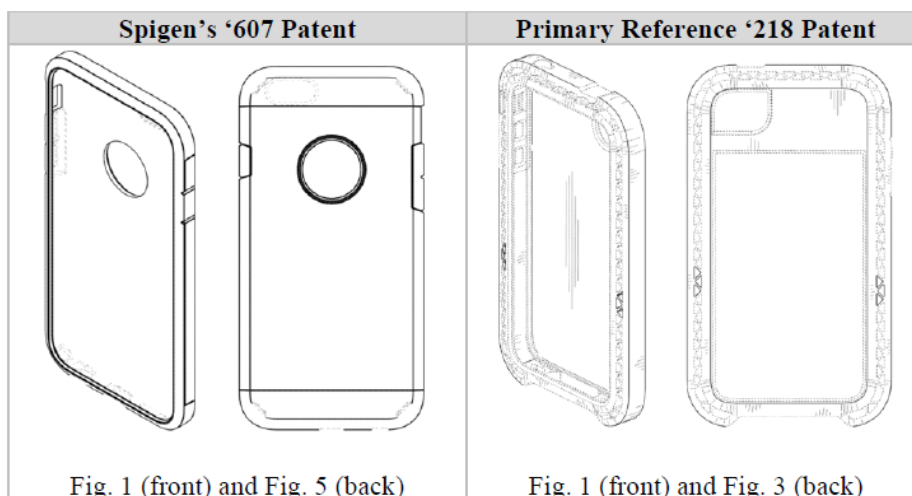
A “primary reference” is “a single reference that creates ‘basically the same’ visual impression” as the claimed design. *High Point Design*, 730 F.3d at 1312 (quoting *Durling*, 101 F.3d at 103). To be “basically the same,” the designs at issue cannot have “substantial differences in the[ir] overall visual appearance[s].” *Apple*, 678 F.3d at 1330. Additionally, if “major modifications” would be required to make a design look like the claimed design, then the two designs are not “basically the same.” *In re Harvey*, 12 F.3d 1061, 1063 (Fed. Cir. 1993). “[S]light differences” in design, however, do not necessarily preclude a “basically the same” finding. *MRC Innovations*, 747 F.3d at 1333.

Although a “trial court judge may determine almost instinctively whether the two designs create basically the same visual impression,” *Durling*, 101 F.3d at 103, a trial court is not free to find facts at the summary judgment phase. *Lemelson v. TRW, Inc.*, 760 F.2d 1254, 1260 (Fed. Cir. 1985) (“For summary judgment, fact-finding is an inappropriate exercise, at either the appellate or the district court level. If a dispute requiring a finding exists as to any material fact, summary judgment is improper.”). Thus, if based on the evidence, a reasonable jury *could* find in favor of the non-moving party, a trial court must stay its hand and deny summary judgment of obviousness. *See High Point Design*, 730 F.3d at 1314–15 (reversing the district court’s grant of summary judgment because “there appear to be genuine issues of material fact as to whether the Woolrich Prior Art are, in fact, proper primary references”).

Here, the district court found that despite “slight differences,” the ’218 patent undisputedly was “basically the same” as the Spigen Design Patents, and, thus, a proper primary reference. J.A. 27. This determination was error because, based on the competing evidence before the district court, a reasonable factfinder could find otherwise.

Spigen’s expert, Mr. Delman, testified that the Spigen Design Patents and the ’218 patent are not “at all similar,

let alone ‘basically the same.’” J.A. 4703 (quoting Delman Rebuttal Expert Report ¶176). He also testified that unlike the Spigen Design Patents, the ’218 patent “[has] unusually broad front and rear chamfers and side surfaces’ and a ‘substantially wider surface,’ ‘lack[s] any outer shell-like feature or parting lines,’ ‘lacks an aperture on its rear side, and ‘[has] small triangular elements illustrated on its chamfers.” *Id.* The following side-by-side comparison of Spigen’s ’607 patent, representative of the Spigen Design Patents, and the ’218 patent, displays these differences:



J.A. 86, 90, 161, 163.

Spigen also argued before the district court that:

[d]efendants have proposed so many modifications to the ’218 Patent to make it look more like the Spigen patents (*e.g.*, add outer shell that wraps around back and side surfaces, add lateral parting lines, add large circular aperture to rear, shrink the side surfaces, shrink the chamfers, and remove ornamental triangular elements), that the ’218 patent can no longer qualify as a primary reference.

J.A. 4704.

Ultraproof, contrastingly, argued below that the '218 patent was “‘basically the same’ as the claimed designs” because all of the designs had (1) a “generally rectangular appearance with rounded corners,” (2) a “prominent rear chamfer and front chamfer,” and (3) “elongated buttons corresponding to the location of the buttons of the underlying phone.” J.A. 374–75. Ultraproof argued that the “only perceivable difference[s]” between the '218 patent and the Spigen Design Patents were the “circular cutout in the upper third of the back surface and the horizontal parting lines on the back and side surfaces.” J.A. 375 (footnote omitted).³

In the light of the competing evidence in the record, a reasonable factfinder could conclude that the '218 patent and the Spigen Design Patents have substantial differences, and, thus, are not basically the same. *See* Fed. R. Civ. P. 56(c). Accordingly, the district court’s grant of summary judgment of obviousness was in error and must be reversed. *See Durling*, 101 F.3d at 105 (“Without . . . a primary reference, it is improper to invalidate a design patent on grounds of obviousness.”); *see also High Point*, 730 F.3d at 1314–15. We therefore need not address Spigen’s

³ On appeal, Ultraproof argues that many of the differences between the Spigen Design Patents and the '218 patent are “largely differences of degree, not characteristic,” and, thus, irrelevant to the “basically the same” inquiry. For example, Ultraproof asserts that the '218 patent’s “bulkier appearance” is “a difference of degree (large vs small) as opposed to a difference in characteristics, such as [a] sunken screen.” We reject this argument. No precedent makes such a distinction, and we decline to do so today.

alternative grounds for reversal.⁴ We now turn to Ultraproof's alternative grounds for affirmance.

II

Ultraproof presents four alternative grounds for affirming if we determine the district court's obviousness analysis was flawed. Three of these grounds—obviousness over the '209 patent as the primary reference and the '218 patent as the secondary reference; obviousness over various combinations of other prior art; and inequitable conduct—were not decided by the district court. We therefore decline to decide these issues in the first instance. *See TriMed, Inc. v. Stryker Corp.*, 608 F.3d 1333, 1339 (Fed. Cir. 2010) (“Because, as a general matter, a federal appellate court does not consider an issue not passed upon below, . . . we decline to address these arguments in the first instance and refer them to the district court for consideration on remand.” (citation and quotation marks omitted)). The district court is free to consider these grounds on remand.

As to the fourth ground, Ultraproof argues that we must affirm because the Spigen Design Patents' claimed designs were described in a printed publication before their effective filing date and are thus precluded from patent protection under 35 U.S.C § 102(a). Ultraproof cites to two copyright registrations for support. The district court,

⁴ Spigen's alternative grounds for reversal are that the district court erred by determining that the '209 patent was an appropriate secondary reference and that Ultraproof's hypothetical combination of the '218 patent and the '209 patent rendered obvious the Spigen Design Patents. Spigen also asserts that even if Ultraproof had made a prima facie case of obviousness, secondary considerations of non-obviousness present a genuine dispute of material fact, precluding summary judgment.

however, determined that a genuine dispute of material fact exists regarding the publication date of the copyright registration certificates. The district court thus denied this ground of invalidity at the summary judgment phase. We agree with the district court and thus reject this alternative ground.

CONCLUSION

We have considered the parties' remaining arguments and find them unpersuasive. We determine that a genuine dispute of material fact exists as to whether the '218 patent is basically the same as the Spigen Design Patents and hence, a proper primary reference. We thus reverse the district court's grant of summary judgment of invalidity and remand for further proceedings. Because we remand for further proceedings, Ultraproof is no longer the prevailing party. We thus dismiss Ultraproof's cross-appeal of the district court's denial of attorneys' fees as moot. *Circuit Judge Lourie* dissents.

REVERSED AND REMANDED

COSTS

No Costs.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CERTIFICATE OF SERVICE

I certify that I served a copy on counsel of record on May 18, 2020
by:

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