

2023-2138

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

**NORTH STAR TECHNOLOGY INTERNATIONAL LTD.,
NORTH STAR TECHNOLOGY LTD.,**
Plaintiffs-Appellants,

v.

LATHAM POOL PRODUCTS, INC.,
Defendant-Appellee.

On Appeal from the United States District Court for the
Eastern District of Tennessee, Case No. 3:19-cv-120-KAC-DCP

**PLAINTIFFS-APPELLANTS' COMBINED PETITION FOR
REHEARING AND REHEARING EN BANC**

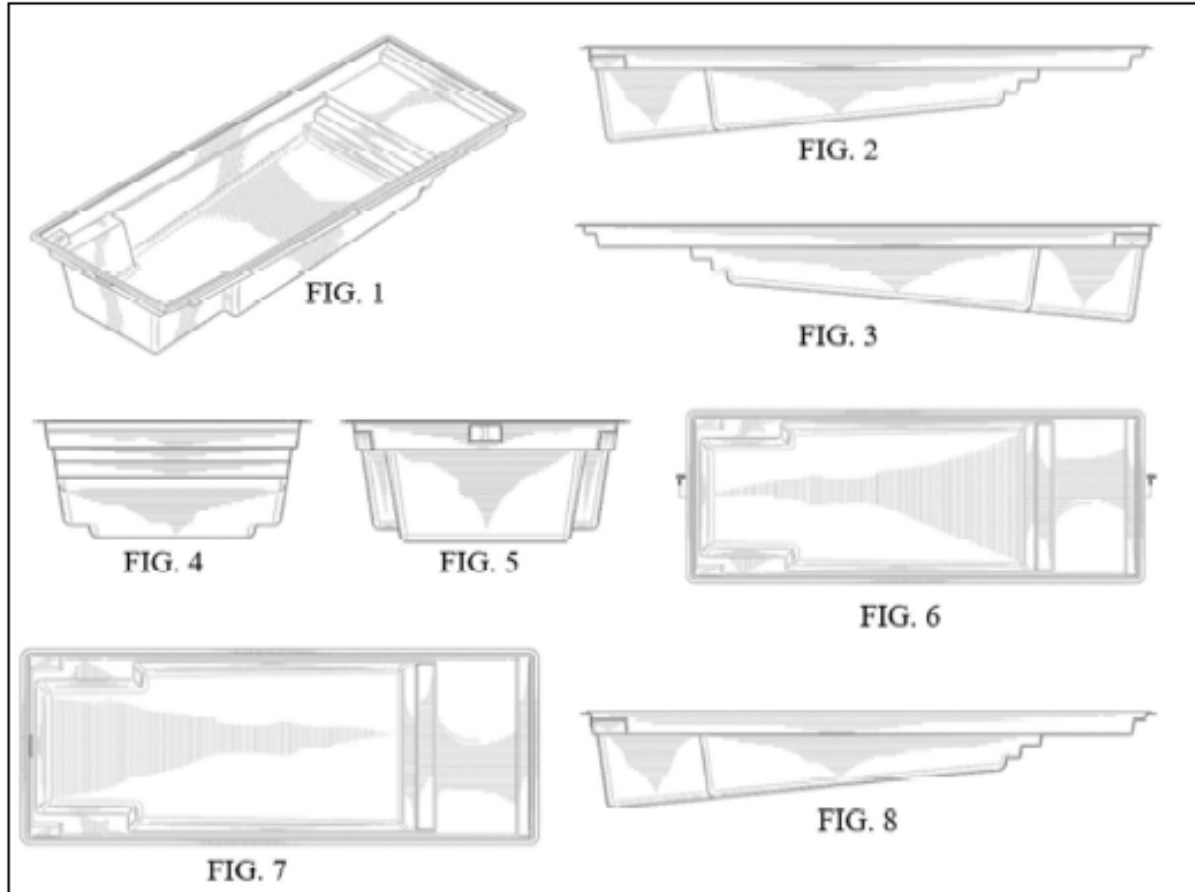
Matthew J. Dowd
Robert J. Scheffel
Dowd Scheffel PLLC
1717 Pennsylvania Ave., NW
Suite 1025
Washington, D.C. 20006
(202) 995-9175
mdowd@dowdscheffel.com
rscheffel@dowdscheffel.com

Perry J. Saidman
Perry Saidman, LLC
3 Island Ave.
Suite 8i
Miami Beach, FL 33139
(202) 236-0753
ps@perrysaidman.com

Wade R. Orr
Michael J. Bradford
Luedeka Neely Group, P.C.
900 S. Gay Street, Suite 1504
Knoxville, Tennessee 37902
worr@luedeka.com

CLAIM AT ISSUE

The ornamental design for a swimming pool, as shown and described.



Appx0023-0029.

CERTIFICATE OF INTEREST

Counsel for Appellants certifies the following:

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

North Star Technology International Ltd., and North Star Technology Ltd.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

North Star Technology International Ltd., and North Star Technology Ltd.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Perry J. Saidman, Perry Saidman, LLC

**Matthew J. Dowd, Robert J. Scheffel,
Dowd Scheffel PLLC; and**

**Wade R. Orr, Michael J. Bradford
Luedeka Neely Group P.C.**

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. See Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary):

None

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6):

None

Date: June 26, 2025

/s/ Matthew J. Dowd

Matthew J. Dowd

Counsel for Appellants

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF AUTHORITIES.....	vi
STATEMENT OF RELATED CASES	ix
STATEMENT OF COUNSEL UNDER FEDERAL CIRCUIT RULE 35	1
REASONS FOR GRANTING THE PETITION	2
SUMMARY OF PROCEEDINGS	3
I. The Alleged Design-Patent Infringement.....	3
II. The Panel Decision Affirming Summary Judgment	7
ARGUMENT.....	8
I. The “Sufficiently Distinct” Test Lacks Any Standard And Was Misapplied	8
A. Design-Patent Infringement Under <i>Gorham</i>	9
B. The “Sufficiently Distinct” Test Conflicts with <i>Gorham</i>	10
C. The “Sufficiently Distinct” Test Does Not Respect Design-Patent Scope, Which is Analogous to the Doctrine of Equivalents	13
D. The “Sufficiently Distinct” Test Lacks an Objective Standard.....	15
II. The Standardless “Sufficiently Distinct” Test Does Not Comport With A Proper Application Of Rule 56	17
A. The Summary-Judgment Standard	17
B. The Undefined “Sufficiently Distinct” Test Conflicts with the Summary-Judgment Standard.....	19

C.	The Panel Decided New Issues on Appeal.....	20
III.	The Three-Way Comparison Allows A Reasonable Jury To Find The Two Designs To Be “Substantially The Same”	22
IV.	Conclusion	26

ADDENDUM

CERTIFICATE OF COMPLIANCE

TABLE OF AUTHORITIES

	<u>Page(s)</u>
 Cases	
<i>Aatrix Software, Inc. v. Green Shades Software, Inc.</i> , 890 F.3d 1354 (Fed. Cir. 2018).....	18
<i>Adickes v. S.H. Kress & Co.</i> , 398 U.S. 144 (1970).....	17, 18
<i>Amini Innovation Corp. v. Anthony California, Inc.</i> , 439 F.3d 1365 (Fed. Cir. 2006).....	19
<i>Anderson v. Liberty Lobby, Inc.</i> , 477 U.S. 242 (1986).....	1, 3, 17
<i>Arminak & Associates, Inc. v. Saint Gobain Calmar, Inc.</i> , 501 F.3d 1314 (Fed. Cir. 2007).....	9
<i>Berry Sterling Corp. v. Pescor Plastics, Inc.</i> , 122 F.3d 1452 (Fed. Cir. 1997).....	21, 22
<i>Braun, Inc. v. Dynamics Corp. of America</i> , 975 F.2d 815 (Fed. Cir. 1992).....	24
<i>Columbia Sportswear North America v.</i> <i>Seirus Innovative Accessories, Inc.</i> , 942 F.3d 1119 (Fed. Cir. 2019).....	24
<i>Contessa Food Products, Inc. v. Conagra, Inc.</i> , 282 F.3d 1370 (Fed. Cir. 2002).....	10
<i>Crocs, Inc. v. International Trade Commission</i> , 598 F.3d 1294 (Fed. Cir. 2010).....	9
<i>Egyptian Goddess, Inc. v. Swisa, Inc.</i> , 543 F.3d 665 (Fed. Cir. 2008) (en banc).....	2, 10, 16, 24
<i>Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.</i> , 339 U.S. 605 (1950).....	14

<i>High Point Design LLC v. Buyer’s Direct, Inc.</i> , 621 F. App’x 632 (Fed. Cir. 2015).....	7
<i>Honeywell International Inc. v. 3G Licensing, S.A.</i> , 124 F.4th 1345 (Fed. Cir. 2025)	22
<i>Gorham Co. v. White</i> , 81 U.S. 511 (1871).....	1, 2, 3, 8, 9, 10, 12, 13, 14, 22, 24, 25
<i>In re Mann</i> , 861 F.2d 1581 (Fed. Cir. 1988).....	13
<i>International Seaway Trading Corp. v. Walgreens Corp.</i> , 589 F.3d 1233 (Fed. Cir. 2009).....	14
<i>Lemelson v. TRW, Inc.</i> , 760 F.2d 1254 (Fed. Cir. 1985).....	20
<i>LKQ Corp. v. GM Global Technology Operations LLC</i> , 102 F.4th 1280 (Fed. Cir. 2024) (en banc)	14
<i>Oregon v. Kennedy</i> , 456 U.S. 667 (1982).....	15
<i>Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC</i> , 739 F.3d 694 (Fed. Cir. 2014).....	13
<i>Payless Shoesource, Inc. v. Reebok International Ltd.</i> , 998 F.2d 985 (Fed. Cir. 1993).....	12
<i>Philip Morris Products S.A. v. International Trade Commission</i> , 63 F.4th 1328 (Fed. Cir. 2023)	20
<i>PS Products Inc. v. Panther Trading Co.</i> , No. 23-1665 (Fed. Cir. Dec. 6, 2024)	16
<i>Revision Military, Inc. v. Balboa Manufacturing. Co.</i> , 700 F.3d 524 (Fed. Cir. 2012).....	23, 24
<i>SCA Hygiene Products Aktiebolag v.</i> <i>First Quality Baby Products LLC</i> , 580 U.S. 238 (2017).....	18

<i>Shurtleff v. City of Boston</i> , 596 U.S. 243 (2022).....	15
<i>Singleton v. Wulff</i> , 428 U.S. 106 (1976).....	20
<i>Spalding & Evenflo Companies, Inc. v. Graco Metal Products, Inc.</i> , No. 5:90CV0651, 1991 WL 148127 (N.D. Ohio, Mar. 1, 1991)	19
<i>Spigen Korea Co., Ltd. v. Ultraproof, Inc.</i> , 955 F.3d 1379 (Fed. Cir. 2020).....	24
<i>Tolan v. Cotton</i> , 572 U.S. 650 (2014).....	17
Statutes	
35 U.S.C. § 289	13
Rules	
Fed. R. Civ. P. 56	17, 18, 22
Fed. R. Civ. P. 56(a).....	17

STATEMENT OF RELATED CASES

Under Federal Circuit Rule 47.5, counsel for Appellants state:

1. There are no, nor have there been any other, appeals in or from this same action or proceeding in the lower tribunal before this or any other appellate court.

2. Counsel is unaware of any case that will directly affect or be directly affected by the present appeal.

**STATEMENT OF COUNSEL UNDER
FEDERAL CIRCUIT RULE 35**

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting question of exceptional importance:

Whether the undefined and standardless “sufficiently distinct” test for design-patent infringement, as well as its application at the summary-judgment stage, conflicts with *Gorham Co. v. White*, 81 U.S. 511 (1871), and a court’s obligations under *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986), and other summary-judgment precedent.

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States or the precedents of this Court: *Gorham Co. v. White*, 81 U.S. 511 (1871); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986).

Date: June 26, 2025

By: /s/ Perry J. Saidman
Perry J. Saidman

REASONS FOR GRANTING THE PETITION

In *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc), the Court retired the point-of-novelty test for design-patent infringement. In doing so, the Court relied on *Gorham Co. v. White*, 81 U.S. 511 (1871), emphasizing the need to analyze designs as a whole. The unanimous opinion analyzed decades of precedent, concluding that patented and accused designs are to be evaluated “in the context of the prior art.” *Egyptian Goddess*, 543 F.3d at 676.

Egyptian Goddess also introduced the “sufficiently distinct,” or “plainly dissimilar,” test as an apparent means for dispatching easy cases. “In some instances,” the Court stated, “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.” *Id.* at 678.

But the Court provided no guidance on when the “sufficiently distinct” test applies. To this day, this standalone test lacks any guardrails or objective criteria. It leads to acontextual findings without any prior-art assessment.

The standardless “sufficiently distinct” test is more problematic in the summary-judgment context. As *Anderson* and other precedent explain, the judge’s function at summary judgment “is not himself to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial.” 477 U.S. at 249. With the “sufficiently distinct” test, however, there is no objective guidance to meaningfully assess summary judgment. Indeed, this Court has yet to reverse a summary-judgment ruling invoking the “sufficiently distinct” test.

In short, the current “sufficiently distinct” test conflicts with *Gorham*, particularly at the summary-judgment stage. Courts improperly use this test to resolve facts enveloping infringement—a quintessential fact question for the jury. The full Court should reconsider the test’s viability and, at a minimum, cabin it to the most egregious cases.

SUMMARY OF PROCEEDINGS

I. The Alleged Design-Patent Infringement

North Star’s ’996 patent covers a design for a fiberglass in-ground pool. The design encapsulates an ordered combination of ornamental

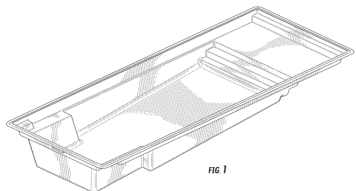
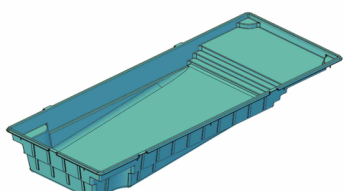
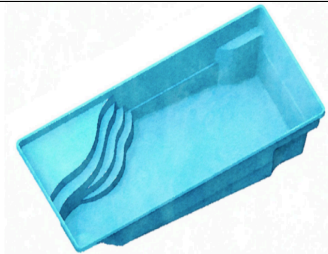
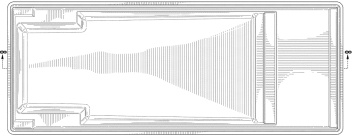



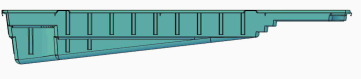

elements arranged to create a distinctive appearance to the average homeowner looking to purchase a pool.

Appellee Latham started selling its alleged infringing pool (the Corinthian 16) only after the success of North Star's patented Pinnacle pool. Latham's Corinthian 16 departed significantly from its ordinarily curved pools by adopting the symmetrical, rectangular design of North Star's pool. In view of what North Star saw as blatant infringement, it sued Latham.

The alleged infringing and patented designs have in common the combination of six ornamental features: (1) similarly shaped and positioned rectangular tanning ledges; (2) similar linear, full-width rectangular steps into the pool's shallow end; (3) similar long, substantially rectangular corner deep-end benches; (4) similarly configured bottom walls having the same gradual slope; and (5) nearly identical proportions of these features.

The sixth feature, perhaps most importantly, is the identical symmetrical configuration of those five elements. The symmetrical appearance was a stark departure from Latham's closest prior-art pools.

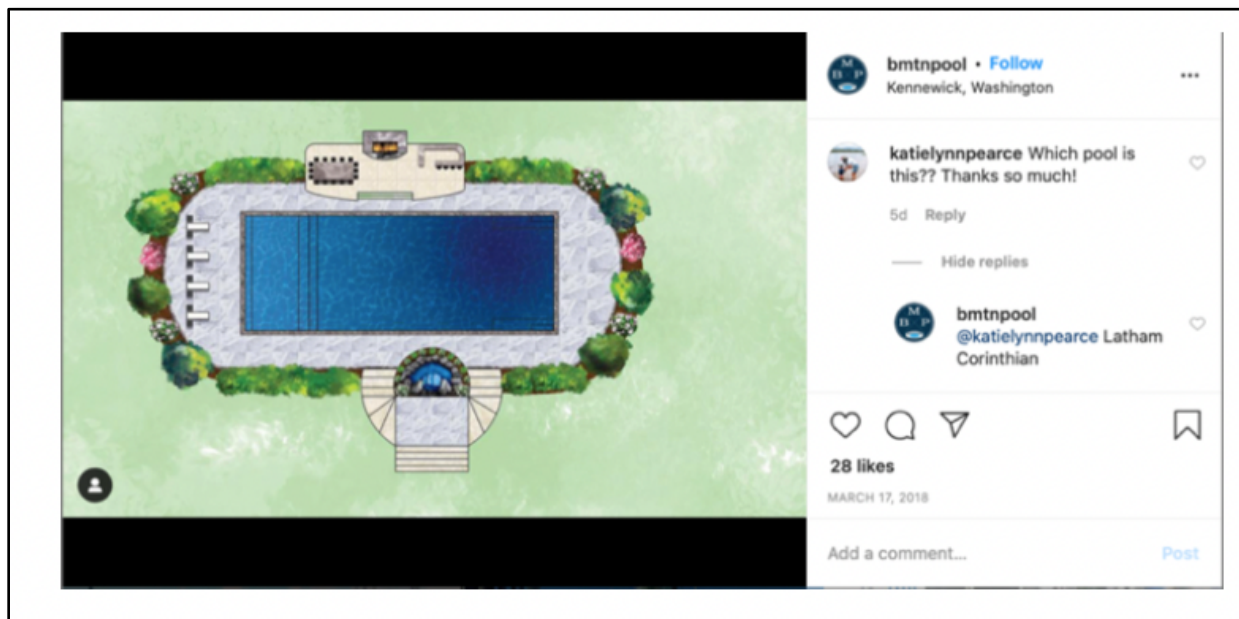
The ornamental similarity is more evident when comparing the designs with the closest prior-art pools. Latham did not challenge that its older, curved, asymmetrical pools, *e.g.*, the Olympia pool, were the closest prior art. Nor did Latham dispute that its Corinthian 16 looked much more like the patented design than any prior-art design.

Patented Design	Accused Design: Corinthian 16	Prior Art: Olympia Pool
 FIG 1		
 FIG 6		
 FIG 2		

Appx0023-0029; Appx0768-0774; Appx1108.

The evidence also established that an experienced distributor mistook the patented design for Latham's pool. In March 2018, the

distributor Boyer Mountain incorrectly told a potential customer that North Star's pool (shown in the Instagram post below) was Latham's pool.



Appx1322.¹

Unaddressed witness testimony also supported a conclusion that a consumer would view the designs as substantially the same. Lesa Kidd, North Star's experienced sales manager, testified that customer demand centered on the "tanning ledge." Appx0715. Consumers "look[] at the tanning ledge or the spa or the big focal feature of that design."

¹ Boyer Mountain stopped purchasing North Star's pool shortly after Latham introduced its Corinthian 16. Appx1004-1005.

Appx0723(83:20-84:3).² Consumers do not “spend a lot of time looking at a step” because “they’re looking at ... the big thing.” Appx0723(83:15-17) “[C]onsumers,” in Kidd’s view, do not “look at a brochure and say, oh, wow, that’s a step.” Appx0723(83:20-84:3).

Despite this evidence, the district court granted summary judgment, relying on the “sufficiently distinct” test and citing the non-precedential decision *High Point Design LLC v. Buyer’s Direct, Inc.*, 621 F. App’x 632 (Fed. Cir. 2015). Appx0012-0018. The court did not address North Star’s three-way comparisons, which highlighted the high similarity between Latham’s pool and the patented design when compared to the four closest prior-art designs.

II. The Panel Decision Affirming Summary Judgment

On appeal, the panel affirmed but appeared to discount North Star’s patented design because it contained so-called “common” and “functional” features that “existed before” North Star’s patent. Op. 3, 5 (“North Star cannot monopolize common ornamental pool features or functional pool features by registering a combination of those features as

² Latham did not rely on any consumer-based evidence at summary judgment.

a design patent.”). North Star’s patent does not, of course, “monopolize common ornamental pool features”; it instead protects a specific combination of six features, creating a novel visual impression when viewed as a whole. Even accepting the panel’s narrow focus on the individual design features, one can envision myriad pool configurations having similar steps, tanning ledges, and benches that are beyond the patent’s scope.

The panel’s opinion also did not address North Star’s three-way prior-art comparisons, thus declining to provide a standard by which a factfinder can assess whether an accused design is “sufficiently distinct” from the patented design. The opinion does not address the undisputed fact that Latham’s accused design looks much more like the patented design than any prior-art design.

ARGUMENT

I. The “Sufficiently Distinct” Test Lacks Any Standard And Was Misapplied

The “sufficiently distinct” test lacks any standard or guidance, making it entirely subjective. It impedes *Gorham*’s clear directive that minor differences cannot preclude infringement. Lacking objective guidance, the test should be discarded or cabined to the narrowest of cases.

A. Design-Patent Infringement Under *Gorham*

Whether a product design infringes a patented design is assessed from the perspective of the ordinary observer. *Gorham*, 81 U.S. at 528. The ordinary-observer test provides 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.” *Id.*

The ordinary observer can make “a reasonably discerning decision when observing the accused item’s design whether the accused item is substantially the same as the item claimed in the design patent.” *Arminak & Assocs., Inc. v. Saint Gobain Calmar, Inc.*, 501 F.3d 1314, 1323 (Fed. Cir. 2007). Importantly, the “ordinary observer” is not an expert but an observer “of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give.” *Gorham*, 81 U.S. at 528.

Equally important, “[t]he ordinary observer test applies to the patented design in its entirety, as it is claimed.” *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010). “What is controlling is

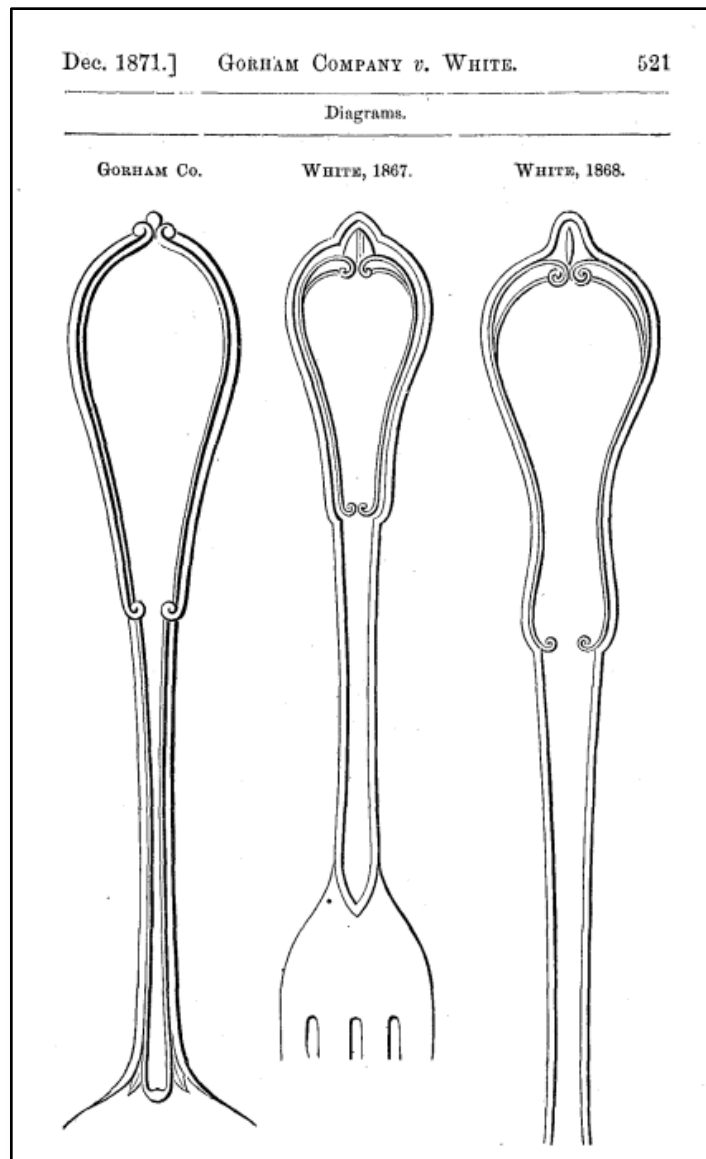
the appearance of the design as a whole in comparison to the accused product.” *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002) (citations omitted).

Egyptian Goddess reinforced the need for the proper frame of reference when assessing infringement. That “frame of reference” is “the background prior art.” 543 F.3d at 677. In reaching its holding on infringement, the full Court compared the patented design, the accused design, and the closest prior-art design, *id.* at 681—the same type of comparison North Star asked the district court and this Court to consider.

B. The “Sufficiently Distinct” Test Conflicts with *Gorham*

The “sufficiently distinct” test—particularly as applied in this case—conflicts with *Gorham* and its rejection of the misconception that minor differences can prevent an infringement finding.

In *Gorham*, the Supreme Court found infringement despite the evident ornamental differences. The patented design (left) and the two infringing designs (middle and right) are shown below:



81 U.S. at 521.

For instance, the Court observed that, “[a]t the upper part of the handle, immediately above the point where the broader part widens from the stem with a rounded shoulder, while the external lines of both designs are first concave, and then gradually become convex, the degree of concavity is greater in the White design.” *Id.* at 529. The Court relied on

the “large number of witnesses,” including Charles Louis Tiffany (then-head of Tiffany & Co.), some of whose testimony “specif[ie]d only the minor differences.” *Id.* at 513-14, 530.

Gorham did not ask if the infringing design was identical but if “the effect of the whole design [is] substantially the same?” *Id.* at 530. Stated differently, does the accused design “produce an appearance” that “work[s] the same result in the same way” and is “therefore a colorable evasion of the prior patent, amounting at most to a mere equivalent?” *Id.* In the Court’s view, “[e]ven the minor differences are so minute as to escape observation *unless observation is stimulated by a suspicion that there may be a diversity.*” *Id.* (emphasis added). Thus, if one must search to find differences, the designs are substantially the same.

While this Court’s precedent generally follows *Gorham*, the panel opinion does not apply its “mere equivalent” or “stimulated by a suspicion” standards, as appreciated elsewhere. *Cf. Payless Shoesource, Inc. v. Reebok Int’l Ltd.*, 998 F.2d 985, 991 (Fed. Cir. 1993) (“[M]inor differences between a patented design and an accused article’s design cannot, and shall not, prevent a finding of infringement.”).

C. The “Sufficiently Distinct” Test Does Not Respect Design-Patent Scope, Which is Analogous to the Doctrine of Equivalents

The undefined “sufficiently distinct” test also fails to properly respect a design patent’s scope. Design-patent scope is subsumed within the infringement standards of “substantially the same” and, under 35 U.S.C. § 289, “colorable imitation.”

Design-patent scope may not be expansive, but it exists and cannot be ignored. The “substantially the same” and “colorable imitation” standards incorporate an “equivalents” analysis, necessarily informed by the prior art. *See Gorham*, 81 U.S. at 521; *Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 700-01 (Fed. Cir. 2014) (“For design patents, the concepts of literal infringement and equivalents infringement are intertwined.”).

One problem permeating this case was Latham’s repeated yet erroneous reliance on a non-binding statement that “[d]esign patents have almost no scope.” Appx0539 (quoting *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988)). *Mann*’s statement is dictum, and it cannot override *Gorham*’s “equivalents infringement,” *i.e.*, “substantially the same” or “colorable imitation.” Nor can *Mann*’s bare statement be reconciled with

the Supreme Court’s analysis and conclusion in *Gorham*. “The mandated overall comparison” must “tak[e] into account significant differences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another.” *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1243 (Fed. Cir. 2009).

While design-patent infringement necessarily includes similar designs, the “sufficiently distinct” test lacks any analogous guidance that we have in the utility-patent context. There, non-literal infringement is assessed through several tests, such as function-way-result. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950). And unless barred by a legal limitation such as ensnarement, doctrine-of-equivalents infringement will typically be decided by the jury. The “sufficiently distinct” test departs from its utility-patent analogue. *Cf. LKQ Corp. v. GM Global Tech. Operations LLC*, 102 F.4th 1280, 1290 (Fed. Cir. 2024) (en banc) (explaining that courts can draw from “considerable [utility-patent] precedent” “when assessing obviousness in the design patent context”).

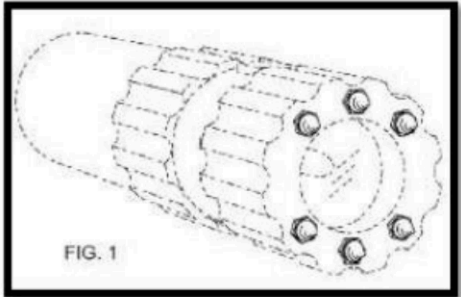
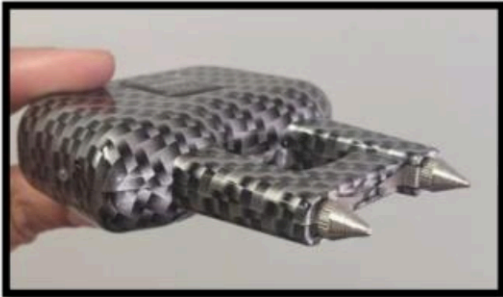
D. The “Sufficiently Distinct” Test Lacks an Objective Standard

Almost two decades after its introduction, the “sufficiently distinct” test stands bare without an analytical framework. It remains a know-it-when-I-see-it test that unfairly and inconsistently impedes a design innovator’s right to protect an innovative design.

The Supreme Court has repeatedly criticized the same types of standardless inquiries that produce conflicting outcomes. *E.g.*, *Oregon v. Kennedy*, 456 U.S. 667, 675 n.5 (1982) (rejecting a prosecutorial-misconduct “overreaching” rule as “an essentially standardless rule”); *see also Shurtleff v. City of Boston*, 596 U.S. 243, 282 & n.9 (2022) (Gorsuch, J., concurring in the judgment) (rejecting the infamous *Lemon* test as “unworkable in practice”).

This Court should revisit the “sufficiently distinct” test and either discard the test or cabin it to the rarest of circumstances when the differences are immediately apparent, for example, when (a) the designs do not share any ornamental features and (b) there is no evidence of a consumer mistaking one design for the other. It should be reserved for frivolous and near-frivolous infringement claims.

One recent example is *PS Products Inc. v. Panther Trading Co.*, No. 2023-1665 (Fed. Cir. Dec. 6, 2024). There, the patented and accused designs looked nothing alike, evident without resort to the prior art.

TABLE 1	
'188 Patent Figures	Panther's Accused Product
 <p>FIG. 1</p> <p>Perspective view of claimed design</p>	 <p>Perspective view of accused product</p>

When design differences are not discernable on a quick look, however, design-patent infringement should always consider the prior art as the “frame of reference.” As *Egyptian Goddess* instructs, comparing the relevant designs—*i.e.*, the patented, accused, and closest prior-art designs—is the only reasonably objective manner to assess “whether the accused design has appropriated the claimed design as a whole.” 543 F.3d at 677.

II. The Standardless “Sufficiently Distinct” Test Does Not Comport With A Proper Application Of Rule 56

This Court’s “sufficiently distinct” test, at least as applied here, also does not comport with the summary-judgment standard. Rule 56 does not permit a patent-specific exception.

A. The Summary-Judgment Standard

Summary judgment is proper only if there is no genuine dispute as to any material fact. Fed. R. Civ. P. 56(a). “The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor.” *Tolan v. Cotton*, 572 U.S. 650, 651 (2014) (quoting *Anderson*, 477 U.S. at 255). At this stage, “the judge’s function is not himself to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial.” *Anderson*, 477 U.S. at 249.

Weighing evidence and making credibility determinations are functions of the jury, not the court. *Id.* at 249, 255. This is because “[t]he right to confront, cross-examine and impeach adverse witnesses is one of the most fundamental rights sought to be preserved by the Seventh Amendment provision for jury trials in civil cases.” *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 176 (1970) (Black, J., concurring). “The advantages

of trial before a live jury with live witnesses, and all of the possibilities of considering the human factors, should not be eliminated by substituting trial by affidavit and the sterile bareness of summary judgment.” *Id.*

If the “sufficiently distinct” test is intended to impose a special gloss on Rule 56, that gloss cannot stand. *See SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods. LLC*, 580 U.S. 328, 340 (2017) (“Patent law is governed by the same common-law principles, methods of statutory interpretation, and procedural rules as other areas of civil litigation.”); *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 890 F.3d 1354, 1356 (Fed. Cir. 2018) (Moore, J., concurring) (“Though we are a court of special jurisdiction, we are not free to create specialized rules for patent law that contradict well-established, general legal principles.”).

A fundamental factual question—design-patent infringement—cannot be treated as an exception for courts to resolve in the face of competing evidence. Summary judgment is not a proper means for resolving disputed factual issues about design-patent infringement, which must be left for the jury. *Cf. id.* at 1357 (“If there is a genuine dispute of material fact, Rule 56 requires that summary judgment be denied.”).

B. The Undefined “Sufficiently Distinct” Test Conflicts with the Summary-Judgment Standard

At base, the “sufficiently distinct” test improperly and unfairly enables—and likely encourages—district courts to dispose of reasonably close infringement claims. Such a result contravenes a patent owner’s right to have a jury decide the disputed factual issues for infringement.

“[C]onclusions about reasonable jurors are difficult to make on an issue of this factual dimension.” *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1371-72 (Fed. Cir. 2006). That difficulty further urges against summary judgment in close cases, especially absent prior-art context. With the “sufficiently distinct” test, however, courts speculate—in the absence of an objective frame of reference—about what reasonable jurors would decide because there is no prior-art context.

Accused infringers will continue to press Latham’s identical argument here—that “[c]ases involving design patents ‘are relatively simple and the failure to grant summary judgment when otherwise appropriate would be an absurd waste of time.’” Appx0539 (quoting *Spalding & Evenflo Cos., Inc. v. Graco Metal Prods., Inc.*, No. 5:90CV0651, 1991 WL 148127, at *3 (N.D. Ohio Mar. 1, 1991)).

C. The Panel Decided New Issues on Appeal

Another error with the panel decision—and symptomatic of the “sufficiently distinct” test—is the opinion’s deciding new issues on appeal for the first time.

The Supreme Court and this Court have repeatedly explained that appellate courts should not decide issues—particularly factual issues—which neither party raised on appeal or before the district court. *Singleton v. Wulff*, 428 U.S. 106, 120 (1976); *Philip Morris Prods. S.A. v. Int’l Trade Comm’n*, 63 F.4th 1328, 1348 (Fed. Cir. 2023). “For summary judgment, fact-finding is an inappropriate exercise, at either the appellate or the district court level.” *Lemelson v. TRW, Inc.*, 760 F.2d 1254, 1260 (Fed. Cir. 1985). “If a dispute requiring a finding exists as to any material fact, summary judgment is improper.” *Id.*

Here, the opinion appears to have *sua sponte* narrowed the patent scope by invoking “functional” considerations, limiting the patent to “the angular shape.” Op. 5. The key paragraph asserted that, “[a]lthough the designs share *structural* similarities,” a design patent can protect only “nonfunctional aspects of the ornamental design.” *Id.* (emphasis added). The opinion stated that North Star “cannot monopolize ... functional pool

features” and then deemed the designs to relate to “rectangular swimming pools with steps, benches, and tanning ledges,” dismissing any protection over those features for being functional. *Id.*³

Notably, the panel opinion does not acknowledge the patented design’s symmetry—an undisputedly ornamental feature absent from Latham’s closest prior-art designs. The opinion does not acknowledge that no prior-art pool incorporated the same design features in a symmetrical manner to create an “elegant, streamlined design” having a “more balanced” look compared to the prior-art pools. *See* Appx0626; Appx0632; Appx0639-0640; Appx0646-0647.

The panel’s apparent functionality/claim-construction analysis veered far from Latham’s arguments and the record evidence. Latham did not seek summary judgment on the basis that the patented design covered functional elements that should be disregarded.

Moreover, whether a feature is functional depends on analyzing underlying facts. *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d

³ The opinion notes that the design elements “existed before” North Star’s patent, Op. 3, but that is no reason to deny infringement. If anything, it might implicate validity, but Latham did not raise that defense at summary judgment. Of course, almost all designs consist of known elements.

1452, 1456 (Fed. Cir. 1997). Latham notably did not rely on its functionality argument when seeking summary judgment. This Court therefore should not affirm by relying on factual findings that Latham never argued and that the district court did not decide.

In the end, the panel opinion provides an intermingled conclusion on two issues—namely, functionality and claim scope—not briefed or argued below or on appeal. Rehearing on that point is warranted. *See, e.g., Honeywell Int’l Inc. v. 3G Licensing, S.A.*, 124 F.4th 1345, 1356 (Fed. Cir. 2025) (Stoll, J., dissenting) (noting that the majority improperly invoked “arguments for the parties that they did not make and then deciding those arguments”).

III. The Three-Way Comparison Allows A Reasonable Jury To Find The Two Designs To Be “Substantially The Same”

Here, summary judgment should not have been granted when considering the disputed facts and that all reasonable inferences should have been resolved in North Star’s favor. The “sufficiently distinct” test enabled a ruling contrary to *Gorham* and Rule 56. Rather than focus on the designs as a whole, the outcome here was “stimulated by a suspicion” of finding minor differences—differences that are “mere equivalents.”

The panel’s short opinion focused on the so-called “geometric shapes” of the patented design, even though the Corinthian 16 has substantially the same geometric shapes. The opinion also noted “two separate curved entry steps shaped like quarters of a circle” in Latham’s design, but the opinion does not address Kidd’s testimony about consumers not focusing on smaller features, such as corner steps. Nor does the opinion acknowledge Boyer Mountain’s mistaken Instagram identification, which occurred even though North Star’s patented pool does not contain the corner steps of Latham’s pool. Nor does the opinion address that Boyer Mountain stopped buying North Star’s pools when Latham introduced its pool—circumstantial evidence of replacement purchases. These quintessential factual issues contradict the assertion that a homeowner would not “accidentally purchase one pool thinking it was the other.” Op. 5. Moreover, the reasonable inferences (such as the relevance and import of the Instagram post) should have favored North Star.

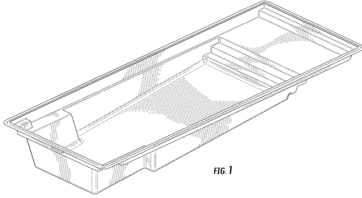
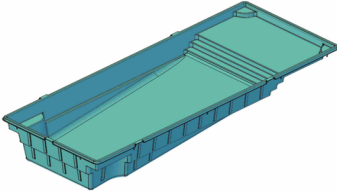

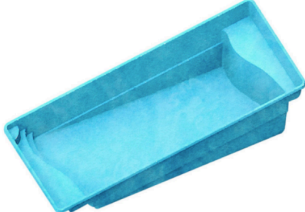

The outcome also conflicts with this Court’s guidance. In *Revision Military, Inc. v. Balboa Manufacturing Co.*, 700 F.3d 524, 526 (Fed. Cir. 2012), this Court vacated a preliminary-injunction ruling, noting that the district court incorrectly refused to consider the prior art. The district

court viewed the case as not “particularly close,” but this Court instructed that the “the design-as-a-whole criterion” in view of the prior art should apply on remand. *Id.* at 527.

Similarly, “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.” *Spigen Korea Co., Ltd. v. Ultraproof, Inc.*, 955 F.3d 1379, 1384 (Fed. Cir. 2020) (emphasis in original). The same rationale applies here. *See also Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119, 1131 (Fed. Cir. 2019) (reversing because “the district court made a finding of fact” about “whether an element of Seirus’s design would give an ordinary observer a different visual impression than Columbia’s design”); *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 821 (Fed. Cir. 1992) (applying three-way comparison to affirm infringement after jury trial).

The deficiencies of the “sufficiently distinct” test become more evident when viewed through the combined lens of *Gorham*’s “mere equivalent” standard and *Egyptian Goddess*’s proper prior-art “frame of reference.” The unchallenged three-way comparisons (below) show that Latham’s pool is nearly identical to the patented design in comparison to

the asymmetrical prior-art pools. They also show that the minor ornamental differences are within *Gorham's* “mere equivalent” standard. North Star had more than enough evidence for a reasonable jury, which could have rejected North Star’s position but also could have reviewed the three-way comparisons and found infringement, particularly with the testimonial and Instagram evidence.

Patented Design	Corinthian 16	Three Prior-Art Designs
		
		
		

IV. Conclusion

The petition should be granted.

Date: June 26, 2025

Respectfully submitted,

By: /s/ Perry J. Saidman

Wade R. Orr
Michael J. Bradford
Luedeka Neely Group, P.C.
900 S. Gay Street, Suite 1504
Knoxville, Tennessee 37902
worr@luedeka.com

Perry J. Saidman
Perry Saidman, LLC
3 Island Ave.
Suite 8i
Miami Beach, FL 33139
(202) 236-0753
ps@perrysaidman.com

Matthew J. Dowd
Robert J. Scheffel
Dowd Scheffel PLLC
1717 Pennsylvania Avenue, NW
Suite 1025
Washington, D.C. 20006
(202) 559-9175
mdowd@dowdscheffel.com
rscheffel@dowdscheffel.com

ADDENDUM

NOTE: This disposition is nonprecedential.

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

**NORTH STAR TECHNOLOGY INTERNATIONAL
LTD., NORTH STAR TECHNOLOGY LTD.,**
Plaintiffs-Appellants

v.

LATHAM POOL PRODUCTS, INC.,
Defendant-Appellee

2023-2138

Appeal from the United States District Court for the
Eastern District of Tennessee in No. 3:19-cv-00120-KAC-
DCP, Judge Katherine A. Crytzer.

Decided: April 24, 2025

MATTHEW JAMES DOWD, Dowd Scheffel PLLC, Wash-
ington, DC, argued for plaintiffs-appellants. Also repre-
sented by ROBERT JAMES SCHEFFEL; MICHAEL J. BRADFORD,
WADE R. ORR, Luedeka Neely, P.C., Knoxville, TN; PERRY
SAIDMAN, Perry Saidman, LLC, Miami Beach, FL.

RUSSELL KORN, Kilpatrick Townsend & Stockton LLP,
Atlanta, GA, argued for defendant-appellee. Also

represented by MICHAEL A. BERTELSON, COURTNEY
DABBIERE; MEGAN ELIZABETH BUSSEY, New York, NY.

Before LOURIE, CHEN, and HUGHES, *Circuit Judges*.

HUGHES, *Circuit Judge*.

North Star Technology International Limited and North Star Technology Limited (collectively, North Star) sued Latham Pool Products, Inc. in the U.S. District Court for the Eastern District of Tennessee for alleged infringement of a design patent related to swimming pools. The district court granted Latham’s motion for summary judgment of non-infringement, reasoning that Latham’s pool is plainly dissimilar to North Star’s design patent. We find no reversible error in the district court’s determinations and affirm its grant of summary judgment of non-infringement.

I

North Star owns and manufactures products that practice U.S. Design Patent No. D791,966 which claims the ornamental appearance of a swimming pool. The D’966 patent was filed on, and thus has a priority date, of January 28, 2016. J.A. 21. Latham manufactures and sells a fiberglass swimming pool it brands as the Corinthian 16. As seen in the depiction below, both the D’966 patent (on the left) and the accused Corinthian 16 design (on the right) relate to rectangular swimming pools with tanning ledges.

NORTH STAR TECHNOLOGY INTERNATIONAL LTD. v.
LATHAM POOL PRODUCTS, INC.

3

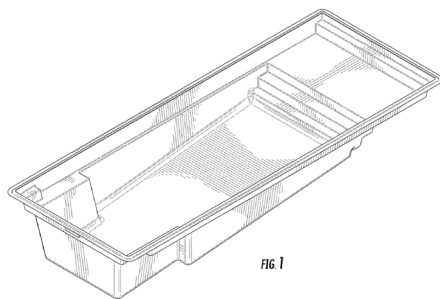


FIG. 1

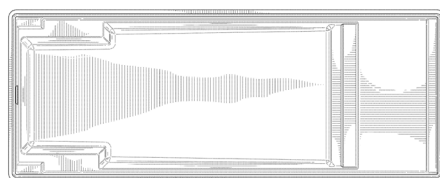
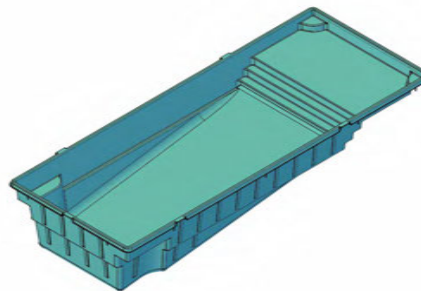
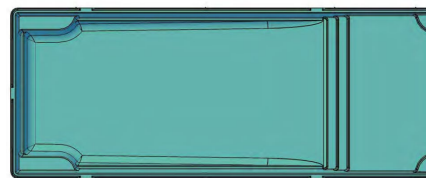


FIG. 7



**D'966 patent, Fig. 1 and
Fig. 7**

**Latham's accused product,
the Corinthian 16**

In April 2019, North Star filed a complaint against Latham, alleging infringement of its D'966 Patent. J.A. 45–52. Latham filed a motion for summary judgment of non-infringement, arguing that the designs are plainly dissimilar and that “any similarities that do exist between the D'966 Patent and Corinthian 16 designs stem from their use of design elements that were commonly used in pool designs before the D'966 Patent.” J.A. 532. The district court agreed, explaining that the “prominent ornamental elements of the two designs”—including the shape of the entry steps and deep end benches—“differ significantly, creating an overall ‘plainly dissimilar’ appearance.” J.A. 18 (internal citation omitted). It added that a review of the prior art confirmed non-infringement because “[e]ach of the pertinent design elements included in the D'966 Patent and Corinthian 16 . . . existed *before* [North Star] filed the D'966 Patent.” J.A. 19 (emphasis added). The district court cited to examples of pools with rectangular tanning ledges that

pre-date the D’966 Patent, *see* J.A. 5–9, as well as to Latham’s own use of the same deep end benches used in the Corinthian 16 in its older pool models.

The district court entered final judgment dismissing North Star’s claims on June 6, 2023. J.A. 1. North Star timely appealed, and we have jurisdiction under 28 U.S.C. § 1295(a)(1).

II

We follow regional circuit law when reviewing a district court’s grant of summary judgment. *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900, 907 (Fed. Cir. 2022). The Sixth Circuit reviews a grant of summary judgment *de novo*. *Loyd v. Saint Joseph Mercy Oakland*, 766 F.3d 580, 588 (6th Cir. 2014). Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); *Kalich v. AT & T Mobility, LLC*, 679 F.3d 464, 469 (6th Cir. 2012).

III

A design patent is infringed “[i]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance [can] deceive such an observer, inducing him to purchase one supposing it to be the other.” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (quoting *Gorham Co. v. White*, 81 U.S. 511, 528 (1871)). Where the claimed and accused designs are “plainly dissimilar,” the patent owner does not meet its burden of proving infringement. *Egyptian Goddess*, 543 F.3d at 678. “Differences . . . must be evaluated in the context of the claimed design as a whole, and not in the context of separate elements in isolation.” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1335 (Fed. Cir. 2015).

NORTH STAR TECHNOLOGY INTERNATIONAL LTD. v.
LATHAM POOL PRODUCTS, INC.

5

As the district court correctly identified, the D’966 patent’s ornamental features are characterized by straight edges and “geometric shapes”—producing an overall “angular . . . appearance”—while the Corinthian 16 is characterized by “rounded shapes” and a “curved” design. J.A. 15. For example, the entry step in the D’966 patent is a pool-width rectangle, while the Corinthian 16 has two separate curved entry steps shaped like quarters of a circle. J.A. 15–16. Because no ordinary observer, defined by the district court as a “homeowner considering purchasing a swimming pool for their home,” J.A. 18, would accidentally purchase one pool thinking it was the other, the designs are plainly dissimilar.

Although the designs share structural similarities, design patents only protect the original, “nonfunctional aspects of an ornamental design as shown in the patent.” *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (citing *KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993)). North Star cannot monopolize common ornamental pool features or functional pool features by registering a combination of those features as a design patent. *See Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988) (explaining that “[d]esign patents do not and cannot include claims to the structural or functional aspects of the article” and are limited to the “ornamental design” of the article); *Egyptian Goddess*, 543 F.3d at 674 (“[A] patented design that consists ‘only of bringing together old elements with slight modifications of form’ is not infringed by ‘another who uses the same elements with his own variations of form . . . if his design is distinguishable by the ordinary observer from the patented design.’”) (quoting *Zidell v. Dexter*, 262 F. 145 (9th Cir. 1920)). Both designs relate to rectangular swimming pools with steps, benches, and tanning ledges, but North Star’s patent only protects the ornamental aspect—here, the angular shape—of those ubiquitous features.

We have considered North Star's remaining arguments regarding the district court's allegedly erroneous decisions to disregard or exclude certain evidence and find them unpersuasive. The district court did not abuse its discretion in declining to consider documents which were not relevant or authenticated, or by striking lay testimony which lacked foundation and amounted to expert testimony from a witness who was not qualified as an expert. We thus affirm the district court's grant of summary judgment on the issue of non-infringement.

AFFIRMED

FORM 19. Certificate of Compliance with Type-Volume Limitations

Form 19
July 2020

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

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2023-2138

Short Case Caption: North Star Technology International Ltd. v. Latham Pool Products, Inc.

Instructions: When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it meets one of the following:

- ☒ the filing has been prepared using a proportionally-spaced typeface and includes 3900 words.
- ☐ the filing has been prepared using a monospaced typeface and includes _____ lines of text.
- ☐ the filing contains _____ pages / _____ words / _____ lines of text, which does not exceed the maximum authorized by this court's order (ECF No. _____).

Date: 06/26/2025

Signature: /s/ Perry J. Saidman

Name: Perry J. Saidman