

No. 23-2427

IN THE
United States Court of Appeals for the Federal Circuit

RANGE OF MOTION PRODUCTS, LLC,
Plaintiff-Appellant,

v.

ARMAID COMPANY INC.,
Defendant-Appellee.

On Appeal from the United States District Court
for the District of Maine
No. 1:22-cv-00091
Hon. Jon D. Levy

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

CERTIFICATE OF INTEREST

Case Number 23-2427

Short Case Caption Range of Motion Products, LLC v. Armaid Company Inc.

Filing Party/Entity Range of Motion Products, LLC

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| <p>Range of Motion Products, LLC</p> | | |
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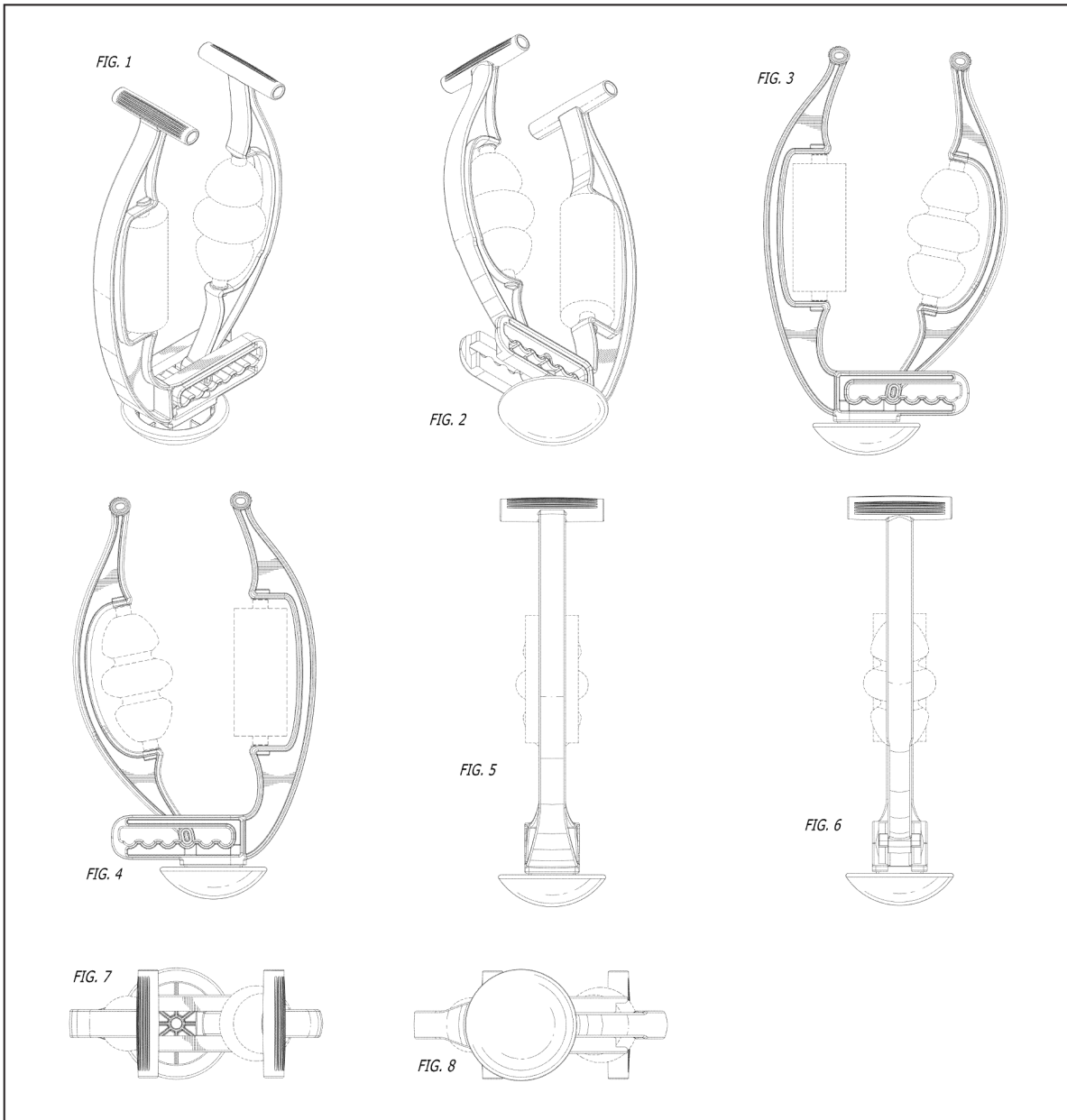
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CLAIM AT ISSUE

The ornamental design for a body massaging apparatus, as shown and described.



STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to *Gorham Manufacturing Co. v. White*, 81 U.S. (14 Wall.) 511 (1871), and *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). I also believe that this appeal presents two precedent-setting questions of exceptional importance:

(1) The test for design-patent infringement that the Supreme Court established in *Gorham* inquires only as to whether an ordinary observer would find the appearance of two designs “substantially the same.” 81 U.S. at 528. Is this Court’s test for design-patent infringement, originating in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc), inconsistent with that rule, because this Court’s test asks first whether the appearance of two designs is “plainly dissimilar”?

(2) Does this Court’s precedent holding that judges should resolve “factual dispute[s]” regarding functionality versus ornamentation at claim construction, Add7 n.2, conflict with the Seventh Amendment jury-trial right under the Supreme Court’s framework in *Markman*?

/s/ E. Joshua Rosenkranz

E. Joshua Rosenkranz

Counsel for Plaintiff-Appellant

Range of Motion, LLC

INTRODUCTION

In *Gorham Manufacturing v. White*, the Supreme Court announced the controlling test for design-patent infringement: “[I]f, in the eye of an ordinary observer..., two designs are substantially the same,” “the first one patented is infringed by the other.” 81 U.S. (14 Wall.) 511, 528 (1871). This substantial-sameness test governed for nearly 150 years.

As Chief Judge Moore’s dissent in this case explains, however, this Court “meaningfully changed” the substantial-sameness inquiry in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc). Add20. Without citing any authority, this Court inserted a rigid threshold step that inverts *Gorham*. That step inquires whether “the claimed design and the accused design [are] sufficiently distinct.” 543 F.3d at 678. A court never even gets to *Gorham*’s inquiry—“whether the ordinary observer would consider the two designs to be substantially the same”—unless it decides that the designs are not “plainly dissimilar.” *Id.*

This Court’s threshold plain-dissimilarity test has yielded a “broad[] trend” of decisions, culminating in the majority’s opinion here,

applying an incorrect legal standard biased against finding infringement and causing courts to take away that factual issue from juries through improper summary-judgment determinations. Add24-26. The Court should grant rehearing en banc to “correct [its] error in *Egyptian Goddess*.” Add26.

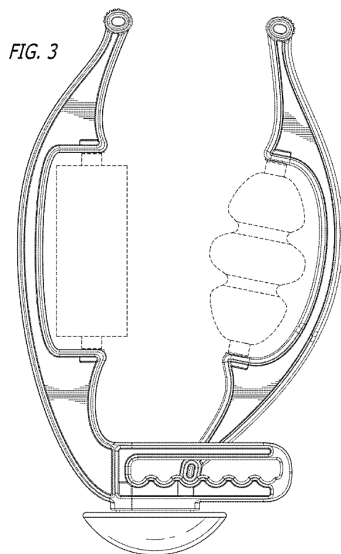
Rehearing is warranted also to address this Court’s undertheorized and incorrect holding that *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), empowers courts to resolve factual questions about whether features are functional or ornamental through design-patent claim construction. Add7 n.2. *Markman* held that courts are better suited to construe a utility patent’s written terms—a task rooted in documentary interpretation of legal text, not aesthetic assessment of design appearance. *Markman* did not address, let alone dispense with, the Seventh Amendment right to have a jury assess a design’s overall appearance, including the fact-intensive question of the extent to which it has functional versus ornamental aspects.

Separately and together, this Court’s approaches to design-patent claim construction and infringement gut *Gorham*. Instead of simply

asking the jury whether an ordinary observer would find the appearance of two designs substantially the same, as *Gorham* demands, this Court tasks judges at claim construction with functionality factfinding, assessing appearance, then further expands the judicial role by filtering the infringement inquiry through the inverse of *Gorham's* test. Rehearing should be granted.


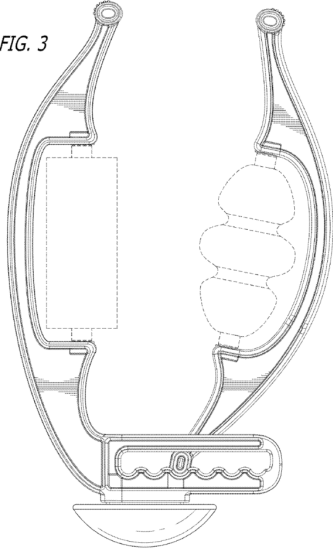

BACKGROUND

Plaintiff-Appellant Range of Motion, LLC (RoM) created an innovative massaging device, the Rolflex. Appx4. RoM's U.S. Design Patent No. D802,155 protects the Rolflex's design. Appx31; Appx73. The patented design and Rolflex are shown below:



Appx41; Appx4.

Defendant-Appellee Armaid Company Inc. sells competing massagers. In 1995, Armaid launched the Armaid1, shown below with its elongated form, scrolled handles, and thin, fixed-width arms attached to pieces of a sharply pointed roller housing. Appx553-554; Appx76. Armaid's founder, Terry Cross, later joined the team that formed RoM—though he remained Armaid's President. Appx4. After Cross had a falling out with RoM's other members, Armaid began selling a Rolflex copycat, the Armaid2. Appx73-76; Appx5. Like the Rolflex, the Armaid2 has a more elliptical shape, ridged handles appearing at the end of its arms' curves, and arms that adjust in width to form a wider-angled roller housing. Appx50-52 (side-by-side images).

| Prior Art (Armaid1) | D'155 Patent (claimed design) | Accused Product (Armaid2) |
|---|---|---|
|  |  |  |

Appx364; Appx41; Appx74. RoM sued Armaid for infringement.

Appx71.

The district court granted Armaid summary judgment of non-infringement. Appx30. The court started with claim construction, describing perceived similarities and differences across the prior art, claimed design, and accused product. Appx17-18. It then assessed the “factual record” to find “many of the Rolflex’s individual features have a functional purpose and, thus, are beyond the scope of the claim.”

Appx17-21.

Turning to infringement, the district court acknowledged that the D'155 design and the Armaid2 “look quite similar.” Appx26-27. But it

nevertheless found non-infringement as a matter of law. The court applied the “two step[]” analysis of *Egyptian Goddess* and its progeny, which requires first evaluating whether the designs are “plainly dissimilar,” and, if not, proceeding to the second step to determine whether the claimed and accused designs are substantially the same (comparing the claimed, accused, and prior-art designs through the eye of an “ordinary observer”). Appx23-24.

At step one, the district court discounted the “likeness[]” of features it previously found “functional” at claim construction to “find that the ornamental aspects of the two designs are plainly dissimilar.” Appx26-27. The court nominally stated that it would find the designs dissimilar even at the second step, but its analysis simply rehashed “again” its step-one findings. *See* Appx27-29 (“[f]actoring out the functional aspects,” emphasizing “notable differences,” and incorporating step-one “conclusion that the ornamental aspects of [the designs] are plainly dissimilar”).

A split panel affirmed. The majority held that “[t]he evidence [of] record supports” the district court’s claim-construction finding “that the shape of the arms is functional.” Add7-8. It then condoned the court’s

summary-judgment application of the plain-dissimilarity infringement test. The majority held that the court’s infringement analysis “properly focused on” whether the designs “[were] plainly dissimilar,” and properly found that the patented design and the Armaid2 were “plainly dissimilar” as a matter of law. Add13-16. The majority similarly approved the court’s passing step-two finding “that no reasonable jury could find that the designs at issue are substantially similar.” Add16.

Chief Judge Moore dissented. She explained that *Egyptian Goddess* “changed the frame of reference from whether two designs are substantially similar in overall appearance to whether two designs are ‘sufficiently distinct’ or ‘plainly dissimilar’”—a “significant change in the law.” Add20-21. She further explained that “the reframing away from similarities and towards differences” biases the infringement inquiry. Add21-24. The result is a “trend” where district courts have taken the “fact question” of infringement “away from the jury.” Add18; Add24-28. She concluded that this Court “ought to correct [its] error in *Egyptian Goddess* and reaffirm that the substantial[] similar[ity] test, announced ... in *Gorham*, is ‘the sole test.’” Add26.

ARGUMENT

I. This Court’s Plain-Dissimilarity Test Conflicts With Supreme Court Precedent.

A. This Court’s plain-dissimilarity test incorrectly inverts *Gorham’s* substantial-sameness test.

1. In *Gorham*, the Supreme Court established the test for design-patent infringement: whether an ordinary observer would find the two designs “substantially the same.” *Id.* at 528. In anchoring infringement in substantial sameness overall, the Court repeatedly admonished against focusing on individual “differences.” *Id.* at 526-30.

Gorham drew that substantial-sameness framework from the common law. It discussed *M’Crea v. Holdsworth*, where the defendant copied a star design and argued the “variation between [its] pattern and that of the Plaintiff” defeated infringement. (1870) 6 Chancery Appeal Cases, Law Reports, 418, 418-19 (Add35-37). The reviewing court, however, affirmed that infringement turns on the designs’ *similarity* and overall effect: “If the designs are used in exactly the same manner ... and have the same effect, or nearly the same effect, then of course” differences like “shifting or turning round ... a star ... cannot be allowed to protect ... from the consequences of the piracy.” *Id.* at 420;

see *Holdsworth v. M'Crea* (1867) 2 Appeal Cases, House of Lords, 388 (Add33-34) (asking “whether [designs] are or are not the same”).

Against this background, *Gorham* held that “the true test ... must be sameness of appearance” in overall impression—not “mere difference” or “slight variances.” 81 U.S. at 526-27. *Gorham* detailed many differences between the designs there, *id.* at 529-30, but emphasized those differences should not drive the infringement inquiry or “destroy the substantial identity,” *id.* at 526-27. Although “differences in the lines” or “configuration” could be considered, “the controlling consideration is the resultant effect”: whether the two designs appear substantially the same to an ordinary observer. *Id.* The Supreme Court even rejected an expert-observer test because an expert would be inclined to nitpick differences—and thus “destroy all the protection which the act of Congress intended to give.” *Id.* at 527. *Gorham* concluded: “[I]t cannot be if, while the general appearance of the design is preserved, minor differences of detail ... are sufficient to relieve an imitating design from ... infringement.” *Id.* at 528.

In the century following *Gorham*, the circuits consistently understood the test to inquire only into designs’ overall similarity—not

whether observers could spot differences. *See, e.g., Nebel Knitting Co. v. Sanson Hosiery Mills*, 214 F.2d 781, 784 (4th Cir. 1954) (“These differences must not be overlooked, but as pointed out in [*Gorham*], the controlling consideration in determining whether two designs are substantially the same is the resultant effect of the whole.”); *Ashley v. Weeks-Numan Co.*, 220 F. 899, 902-03 (2d Cir. 1915); Add20.

2. In *Egyptian Goddess*, this Court broke from *Gorham*’s substantial-sameness test “without realizing it.” Add20. Despite acknowledging that *Gorham* established “the sole test,” this Court introduced, without citation, a threshold step asking whether “the claimed design and the accused design [are] sufficiently distinct” or “plainly dissimilar.” 543 F.3d at 678. A court does not even reach *Gorham*’s substantial-sameness inquiry unless it concludes the designs are not “plainly dissimilar.” *Id.*

That two-step approach conflicts with *Gorham*. As the dissent details, focusing on “plain[] dissimilar[ity]” inverts the inquiry from similarity to difference, a “linguistic sleight of hand” resulting in “a significant change in the law.” Add20-21. Both in light of *Gorham* and general intellectual-property principles, infringement fundamentally

concerns substantial similarity. *E.g.*, 4 Nimmer on Copyright § 13D.10 (2026) (copyright infringement requires “substantial similarity”); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (Friendly, J.) (trademark infringement turns on “the degree of similarity between the two marks”). As Judge Hand recognized in the copyright context, “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.” *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). Focusing on what is “plainly dissimilar” (as the majority did here, Add12-15) flouts those basic principles and *Gorham* itself.

B. This Court’s plain-dissimilarity test improperly invites summary-judgment resolution of factual questions.

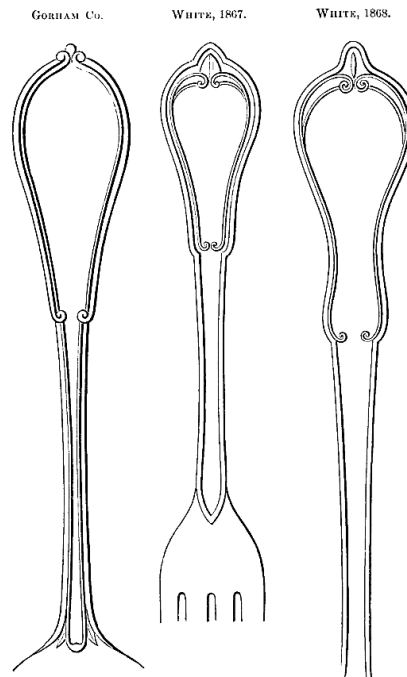
The plain-dissimilarity test invites a related error: It improperly pushes courts to “tak[e] the question” of infringement “from the fact finder” at summary judgment. Add30.

The Supreme Court has “long recognized across a variety of doctrinal contexts that, when the relevant question is how an ordinary person or community would make an assessment”—such as a “judgment

about whether two marks give the same impression to consumers”—
“the jury is generally the decisionmaker that ought to provide the fact-
intensive answer.” *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 422 &
n.2 (2015) (holding trademark tacking a jury question). Whether two
designs are “substantially the same” in “the eye of an ordinary
observer,” *Gorham*, 81 U.S. at 528, requires exactly that factual
judgment. As this Court has recognized, “a panel of jurors” is nothing
“other than a panel of ordinary observers capable of making factual
determinations as to whether they would be deceived by an accused
device’s design similarity to a patented design.” *Braun Inc. v. Dynamics
Corp. of Am.*, 975 F.2d 815, 821 (Fed. Cir. 1992).

Yet this Court’s plain-dissimilarity test pushes that fact question
from the jury’s reach. The standard’s focus on differences “makes those
differences more significant and causes [one] to lose sight of the overall
similarity.” Add21. Empirically, that is undeniable. *See, e.g.*, Thomas
Mussweiler et al., *The Ups and Downs of Social Comparison:
Mechanisms of Assimilation and Contrast*, 87(6) J. OF PERSONALITY &
SOC. PSYCH. 832, 834 (2004); Add21. *Gorham* itself provides a striking
example. When an empirical study polled a large sample of “ordinary

observers” as to whether the two infringing articles there (reproduced below) were “plainly dissimilar,” 72% said yes for one (White 1867) and 74% said yes for the other (White 1868). *IDSPP Amicus Br., North Star Tech. Int’l Ltd. v. Latham Pool Prods., Inc.*, No. 23-2138 (Fed. Cir. 2025), Dkt. 100 at 3-4.



Gorham, 81 U.S. at 521. Yet, the Supreme Court had “very little difficulty” finding infringement under the substantial-sameness test, though “variances” were “discoverable.” *Id.* at 528-30.

The plain-dissimilarity test thereby tips the scales on a subjective question about appearance—tempting courts to grant summary judgment on an issue reserved for a jury of ordinary observers. Here,

the district court granted summary judgment by “*find[ing]* that the ornamental aspects of the two designs are plainly dissimilar.” Appx27 (emphasis added); *see* Add30.¹ The majority affirmed, but as the dissent observed, it is “hard to imagine ... that no reasonable purchaser of handheld massagers could ever find that the overall designs,” overlaid below, “were substantially similar.” Add19.



Appx74-75.

¹ Although the district court and majority stated they would reach the same result on step two, the legally erroneous step-one preconception of “plain[] dissimilar[ity]” infected the step-two finding, *see* Appx27-29; Add16, “permeat[ing]” and biasing the analysis. *United States v. \$28,000.00 in U.S. Currency*, 802 F.3d 1100, 1107 (9th Cir. 2015).

As the dissent details, this is only the latest in a line of cases resolving the fact-intensive question of similarity at summary judgment. Add24-26 (discussing *North Star*, No. 23-2138, 2025 WL 1189919 (Fed. Cir. Apr. 24, 2025), and *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312 (Fed. Cir. 2015)). Resolving genuine disputes of fact is the factfinder’s role. Fed. R. Civ. P. 56. The plain-dissimilarity test subverts the summary-judgment standard’s proper application, confirming the need for en banc review. See Add24-26.

II. This Court’s Precedent Improperly Assigns To Judges Through Claim Construction The Factual Assessment Of Whether Design Appearance Is Functional Versus Ornamental.

En banc rehearing is warranted also because this Court has improperly assigned to judges a fact-intensive assessment of whether design features are functional versus ornamental. That impinges on the jury’s overall assessment of appearance in adjudicating infringement and validity. The majority’s decision joins this Court’s recent caselaw directing judges to “identify” the functional versus ornamental “aspects of the design” as part of design-patent claim construction, to “factor[] out the functional aspects of [the] design” before the jury “appl[ies] the ordinary observer test.” Add7-8; Add13

(citing *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016); *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010)). But the extent to which a design’s appearance is functional versus ornamental is, under the Seventh Amendment, a question reserved for the jury’s overall assessment of appearance.

Specifically, factfinding regarding functionality belongs to the jury under *Markman*’s Seventh Amendment framework. In *Markman*, the Supreme Court held that the Seventh Amendment’s jury-trial right does not attach to claim construction of “what the words [recited in a utility patent’s] claim mean.” 517 U.S. at 374. From *Markman*’s proposition that textual utility-patent claim construction is “within the province of the court,” the majority uncritically concluded that “factual dispute[s]” regarding whether design elements are functional or ornamental cannot preclude summary judgment. Add7 & n.2 (quoting 517 U.S. at 372). That does not follow. *Markman*’s Seventh Amendment jury-trial-right framework compels the opposite conclusion.

1. For causes of action brought at law at the time of the founding, like intellectual-property infringement, *Markman* first looks to whether the “particular issue ... [was] itself necessarily a jury issue” in founding-

era common law. *Id.* at 376-77. The jury’s historic role in assessing overall appearance has long encompassed judgment about function and form without judicial filtering.

Even before England first recognized an intellectual-property right in an article’s design in 1839, juries assessed overall similarity where form and function overlapped. See Brad Sherman & Lionel Bently, *The Making of Modern Intellectual Property Law: The British Experience, 1760-1911*, at 63-67 (2003). In *Sayre v. Moore*, Chief Justice Mansfield recognized sea charts had utilitarian features unprotected by copyright, but did not parse those features for the jury; instead, he said only “the question of fact to come before a jury is, whether the alteration be colorable or not?” (1785) 102 Eng. Rep. 138, 140 (KB) (Add38-41). Later, in *Cary v. Kearsley*, a jury assessed the “pirating” of a “Book of Roads” that was, the court recognized, full of utilitarian content; yet, without any functional filtering, the court left “the jury ... to say, whether what so taken or supposed to be transmitted from the plaintiff’s book, was fairly done with a view of compiling a useful book.” (1802) 170 Eng. Rep. 679, 679-80 (KB) (Add31-32).

2. *Markman*'s next guidepost, "existing precedent" on design protection itself, 517 U.S. at 384, confirms that juries should assess similarity holistically, without prior judicial filtering.

Take the first design-patent cases. In *Holdsworth v. M'Crea*, the common-law case from which *Gorham* drew its ordinary-observer test, the jury instruction on infringement required assessing overall similarity without prior judicial parsing of functional versus ornamental elements. See Mark D. Janis, *A Closer Look at the "Eye" Test: The British Influence on Early American Design Patent Infringement Law*, 13 IP Theory 56, 65-66 (2023) (reciting jury instruction); *supra* 8-9. United States caselaw was the same. The first case that arose after the 1842 Act granted patent protection for designs involved ornamentation on stoves: "[T]he jury were instructed, if they should find that the defendants had infringed the plaintiff's patent by using, substantially, the same device, as ornamental on the same parts of the stove, they would of course find the defendant guilty." *Root v. Ball*, 20 F. Cas. 1157, 1158 (C.C.D. Ohio 1846). The court thus tasked the jury with assessing whether the accused design appropriated the

ornamental appearance—factfinding that inherently required the jury to distinguish ornamentation from pure functionality.

Tellingly, in modern design-patent cases, juries routinely assess whether function dictates a design in deciding validity. Juries apply the *PHG* factors, including whether alternative designs would adversely affect the article's utility and whether advertising touts utilitarian benefits for particular features. *PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1366 (Fed. Cir. 2006); *see Nordock, Inc. v. Sys. Inc.*, 803 F.3d 1344, 1360-61 (Fed. Cir. 2015) (affirming jury's application of *PHG* factors), *vacated on other grounds*, 580 U.S. 1028 (2016); Final Jury Instructions, *Apple Inc. v. Masimo Corp.*, No. 22-1377 (D. Del. 2022), Dkt. No. 745 at 47-48 (reciting *PHG* factors).

Ironically, this Court directs courts to assess functionality at claim construction via those very factors. Add7-8; Add10. And the factors themselves trace to trade dress's functionality test, which, all agree, the jury applies. *Compare In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982), *with PHG*, 469 F.3d at 1366 (citing *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1455 (Fed. Cir. 1997)); *see* Mark D. Janis & Jason J. Du Mont, *Functionality in Design*

Protection Systems, 19 J. Intell. Prop. L. 261, 281-82 & n.106 (2012); 1 McCarthy on Trademarks and Unfair Competition § 7:71 (5th ed.). More broadly, functionality is treated as a jury question in other intellectual-property contexts. *E.g.*, *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1372 (Fed. Cir. 2012) (trademark registrability).

3. *Markman* also looks to “the relative interpretive skills of judges and juries,” 517 U.S. at 384, 388, which strongly counsel against this Court’s approach. Factfinding regarding design functionality, unlike interpretation of utility-patent text, is not a “construction of written instruments” that “judges often do and are likely to do better than jurors.” *Id.* at 388-89. This “[C]ourt has recognized that design patents ‘typically are claimed as shown in drawings’” and “has not” even “required that the trial court attempt to provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents.” *Egyptian Goddess*, 543 F.3d at 679. And as noted above (at 11-12), the Supreme Court has held that jurors are better at making “factual judgment[s]” about visual “impression” than judges. *Hana*, 574 U.S. at 425 n.2.

Accordingly, a jury is best situated to resolve the fine line between functionality and ornamentation. To start, it is a “question of fact,” *PHG*, 469 F.3d at 1365, and the allocation of “predominantly factual issues ... to the jury” rests “on a firm historical foundation,” *City of Monterey v. Del Monte Dunes*, 526 U.S. 687, 720 (1999). The degree to which a design is functional or ornamental is also inextricable from the jury’s factual assessment of overall appearance in adjudicating infringement and validity. See Christopher V. Carani, *All or Nothing at All: Design Patent’s Ornamentality Requirement and the Failings of Feature Filtration*, 36 Berkeley Tech. L.J. 213, 227-28 (2021). As *Gorham* recognized, “the controlling consideration” for infringement “is the resultant effect”—overall appearance—not individual features. 81 U.S. at 526. Thus, even where features serve functional purposes, they can cognizably “contribute to the overall design,” as the district court recognized. Appx26 n.11. Yet parsing of functional from ornamental aspects at claim construction bled into both the court’s and the majority’s infringement analyses, e.g., Add13; Appx18; Appx20-21; Appx26, where the jury should be making the call through holistic assessment. Finally, juries not only have the right interpretive skills—

they have the experience, applying the same *PHG* factors the Court does in claim construction in their validity assessment. *Supra* 19.

4. Rather than undertake *Markman*'s prescribed analysis, the majority suggested that allowing functional features into a jury's liability assessment of overall appearance would "effectively eliminate[] the step of claim construction." Add13. But removing functionality findings from claim construction would only restore claim construction to its traditional—and sensible—position. Consistent with *Egyptian Goddess*, courts could still "attempt[] to provide a verbal description of the design," "describ[e] the role of particular conventions in design patent drafting, such as the role of broken lines," and "assess[] and describ[e] the effect of any representations that may have been made in the course of the prosecution history." 543 F.3d at 680. And courts could still "distinguish[] between those features of the claimed design that are ornamental and those that are *purely* functional," *id.* (emphasis added), in that courts could instruct juries that pure functionality should be ignored in their holistic assessment of appearance.

But there should be no remit for courts to draw fact-intensive lines between features that are functional, ornamental, or both.

Modesty here is warranted: As this Court has recognized, “a design is better represented by an illustration,” and there are “risks” inherent in issuing a “detailed verbal description of the design.” *Id.* at 679-80.

Saving functionality for the jury’s “ordinary observer” assessment aligns with the design-patent law’s “ultimate question,” which “is not the functional or decorative aspect of each separate feature, but the overall appearance of the article.” *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993); see Shin Chang, *The Proper Role of Functionality in Design Patent Infringement Analysis*, 19 *Tex. Intell. L.J.* 309, 321-24, 329-30 (2011) (calling for reform); Carani, *supra* at 214-15, 223-24 (similar).

This Court should grant en banc review to resolve these two exceptionally important, recurring issues. Design-patent litigation is ascendant; since 2000, cases have nearly tripled, many of them brought by small-to-medium businesses selling their designs in the market. See David L. Schwartz & Xaviere Giroud, *An Empirical Study of Design Patent Litigation*, 72 *Ala. L. Rev.* 417, 421, 451 (2020). The

foundational questions presented here are hugely important to those inventors—and to the economy.

Moreover, course correction is much needed. The interconnected errors here are part of a “larger problem, of [the Court’s] creation,” that this Court should address en banc. Add26.

CONCLUSION

The Court should grant rehearing en banc.

Respectfully submitted,

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April 3, 2026

ADDENDUM

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| Opinion, <i>Range of Motion Products, LLC v. Armaid Company Inc.</i> , No. 23-2427 (Fed. Cir. Feb. 2, 2026)..... | Add1 |
| <i>Cary v. Kearsley</i> , (1802) 170 Eng. Rep. 679 (KB) | Add31 |
| <i>Holdsworth v. M'Crea</i> , (1867) 2 Appeal Cases, House of Lords, 388 | Add33 |
| <i>M'Crea v. Holdsworth</i> , (1870) 6 Chancery Appeal Cases, Law Reports, 418 | Add35 |
| <i>Sayre v. Moore</i> , (1785) 102 Eng. Rep. 138 (KB) | Add38 |

United States Court of Appeals for the Federal Circuit

RANGE OF MOTION PRODUCTS, LLC,
Plaintiff-Appellant

v.

ARMAID COMPANY INC.,
Defendant-Appellee

2023-2427

Appeal from the United States District Court for the District of Maine in No. 1:22-cv-00091-JDL, Chief Judge Jon D. Levy.

Decided: February 2, 2026

JUSTIN TINGER, Lambert Shortell and Connaughton, Boston, MA, argued for plaintiff-appellant. Also represented by DAVID CONNAUGHTON, BRENDAN M. SHORTELL.

JOSHUA JOHN FOUGERE, Sidley Austin LLP, Washington, DC, argued for defendant-appellee. Also represented by CLAIRE HOMSHER, SUSAN K. WHALEY; PETER J. BRANN, STACY O. STITHAM, DAVID SWETNAM-BURLAND, Brann & Isaacson, Lewiston, ME.

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Before MOORE, *Chief Judge*, HUGHES and CUNNINGHAM,
Circuit Judges.

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

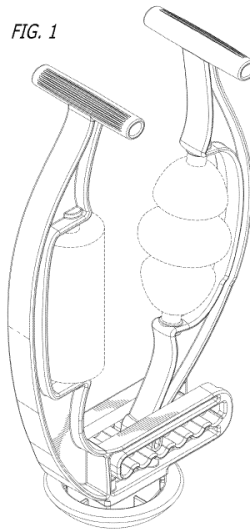
Dissenting opinion filed by *Chief Judge* MOORE.

CUNNINGHAM, *Circuit Judge*.

Range of Motion Products, LLC (“RoM”) appeals the United States District Court for the District of Maine’s grant of summary judgment of non-infringement. *Range of Motion Prods. LLC v. Armaid Co.*, No. 1:22-CV-00091-JDL, 2023 WL 5530768 (D. Me. Aug. 28, 2023) (“*Order*”). For the reasons discussed below, we affirm.

I. BACKGROUND

RoM owns U.S. Design Patent No. D802,155, the patent at issue in this case. *Order at* *2; J.A. 369–70 ¶ 20; J.A. 588 ¶ 20. The D’155 patent is titled “Body Massaging Apparatus” and claims “[t]he ornamental design for a body massaging apparatus, as shown and described.” The patent was filed on May 25, 2016, and issued on November 7, 2017. Figure 1 of the patent is reproduced below:



D'155 patent, Fig. 1.

The parties agree that the “Rolflex,” a device sold by RoM that is aimed at massaging the entire body, embodies the design of the D'155 patent. *Order* at *1–2; Appellant’s Br. 2; Appellee’s Br. 12. The original version of the Rolflex is depicted below:



Order at *1; J.A. 366 ¶ 8; J.A. 587 ¶ 8.

Armaid Company Inc. (“Armaid”) produces and sells the “Armaid2,” the accused product in this case, which is shown below:



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Order at *2; J.A. 370 ¶ 22; J.A. 588 ¶22. Beginning in the 1990s, Armaid manufactured and sold the “Armaid1,” a massaging apparatus for the arms. *Order* at *1; J.A. 364 ¶ 2; J.A. 586 ¶ 2. Terry Cross, the owner of Armaid, obtained U.S. Patent No. 5,792,081, a utility patent that was titled “Limb Massager” and embodied by the Armaid1. *Order* at *1; J.A. 364 ¶ 3; J.A. 586 ¶ 3. A picture of the Armaid1 is below:



Order at *1; J.A. 364 ¶ 2; J.A. 586 ¶ 2.

In April 2021, RoM sued Armaid in the District of Maine, alleging infringement of the claim of the D’155 patent. *Range of Motion Prods. LLC v. Armaid Co.*, No. 1:21-CV-00105-JDL, 2021 WL 3476607, at *3 (D. Me. Aug. 6, 2021). After the district court denied RoM’s preliminary injunction motion, the parties stipulated to dismiss this suit without prejudice. *Id.* at *13; *Order* at *1.

On April 8, 2022, RoM sued Armaid again in the underlying action, alleging infringement of the claim of the D’155 patent. J.A. 71–81. While construing the scope of the claim of the D’155 patent, the district court distinguished between the features of the design that were

functional versus ornamental and concluded that “many, but not all, of the design features in the D’155 patent—which the Rolflex embodied—are driven by function,” *Order* at *7, and that “the overall . . . scope of the claim is accordingly narrow,” *Order* at *8 (alteration in original) (quoting *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1322–23 (Fed. Cir. 2016)); see *Order* at *4–9. With respect to infringement, the district court concluded that no reasonable jury could find the design of the Armaid2 substantially similar to the design claimed in the D’155 patent. See *Order* at *12. On August 28, 2023, the district court granted Armaid summary judgment of non-infringement. *Order* at *1, *12.

RoM timely appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

II. STANDARD OF REVIEW

“We review the district court’s ultimate claim construction of a design patent de novo.” *Sport Dimension*, 820 F.3d at 1320. “We review any factual findings underlying the construction for clear error.” *Id.*

“We review a district court’s grant of summary judgment according to the law of the regional circuit.” *Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337, 1341 (Fed. Cir. 2020). In the First Circuit, summary judgment rulings are reviewed de novo. *McKenney v. Mangino*, 873 F.3d 75, 80 (1st Cir. 2017). “A district court may only grant summary judgment when the record, construed in the light most congenial to the nonmovant, presents no genuine issue as to any material fact and reflects the movant’s entitlement to judgment as a matter of law.” *Id.* (citing Fed. R. Civ. P. 56(a)).

III. DISCUSSION

RoM argues that the district court erred in its claim construction analysis by eliminating entire structural elements from the claimed design. See Appellant’s Br. 8–28.

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RoM also argues that, even if the district court’s claim construction is correct, the designs of the D’155 patent and Armaid2 are substantially similar. *See* Appellant’s Br. 34–37. We address each argument in turn.

A.

On appeal, RoM argues that the district court’s construction “improperly eliminates entire structural elements from the claimed design.” Appellant’s Br. 8. When asked what elements were improperly eliminated, RoM pointed to the district court’s classification of the “shape” of the arms as functional.¹ Oral Arg. 5:05–10:00, 28:06–28:44, 31:06–31:36, https://oralarguments.cafc.uscourts.gov/default.aspx?fl=23-2427_02042025.mp3. We agree with the district court’s conclusion that the shape of the arms is functional and disagree with RoM’s contention that the district court entirely eliminated a structural element. In doing so, we reject RoM’s arguments that the intrinsic evidence in this case unambiguously demonstrates that the shape of the arms is solely ornamental.

i.

“Determining whether a design patent has been infringed is a two-part test: (1) the court first construes the claim to determine its meaning and scope; (2) the fact finder then compares the properly construed claim to the accused design.” *Lanard Toys*, 958 F.3d at 1341. “[A]

¹ To the extent that RoM challenges the district court’s conclusion that the base had functional aspects, *see, e.g.*, Appellant’s Br. 19, we reject RoM’s challenge for the same reasons as those discussed below with respect to the arms. *See, e.g., Order* at *8 (identifying the “inverted mushroom base” as functional); *id.* at *11 (explaining that its infringement analysis only “[f]actor[ed] out the functional aspects of the bases (which are notably different in any event)”).

design is better represented by an illustration ‘than it could be by any description and a description would probably not be intelligible without the illustration.’” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citation omitted). “While it may be unwise to attempt a full description of the claimed design, a court may find it helpful to point out, either for a jury or in the case of a bench trial by way of describing the court’s own analysis, various features of the claimed design as they relate to the accused design and the prior art.” *Id.* at 680 (inner quotation marks and citation omitted). For example, “[w]here a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”² *Sport Dimension*, 820 F.3d at 1320 (quoting *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)). We have previously identified several useful factors for determining whether the patented design is dictated by function, including:

whether the protected design represents the best design; whether alternative designs would adversely affect the utility of the specified article; whether there are any concomitant utility patents; whether the advertising

² No factual dispute about claim construction functionality precludes summary judgment: “[T]he construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996); see *Ethicon*, 796 F.3d at 1333 (Fed. Cir. 2015) (endorsing, at summary judgment, claim construction to remove functional elements from design patents); *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405–06 (Fed. Cir. 1997) (rejecting extrinsic evidence and upholding a summary judgment stage functionality claim construction).

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touts particular features of the design as having specific utility; and whether there are any elements in the design or an overall appearance clearly not dictated by function.

PHG Techs., LLC v. St. John Cos., 469 F.3d 1361, 1366–67 (Fed. Cir. 2006) (quoting *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997) (emphasis omitted)); *see also Sport Dimension*, 820 F.3d at 1322 (“Although we introduced these factors to assist courts in determining whether a claimed design was dictated by function and thus invalid, they may serve as a useful guide for claim construction functionality as well.”).

The evidence in the record supports the conclusion that the shape of the arms is functional. The claims of the ’081 patent cover “limb-massaging apparatus[es]” with arms that “are shaped and dimensioned to adjustably clamp a limb between said first and second massaging members.” ’081 patent col. 3 l. 65 to col. 4 l. 9; *see Order* at *8 (reasoning that the D’155 patent, to the extent it is the ’081 patent’s progeny, inherited these functional aspects). Mr. Cross’s affidavit identified functional aspects of the Rolflex that enabled it to massage the entire body, as opposed to just the arms, such as “the overall clamshell appearance of the arms, including an increased curve of the therapy arm.” *Order* at *8; J.A. 380–82 ¶¶ 12–18. RoM’s marketing materials further explained that Rolflex’s “clam-shaped roller arms provide significant leverage.” *Order* at *8. Based on this record, the district court concluded the “clamshell” shape of the arms was functional, but that other features “appear to be largely ornamental,” such as “the thick ridged outline” of the design (which includes the arms). *Id.*; *see also id.* at 11 n.11; *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1333 (Fed. Cir. 2015). We conclude that the district court did not err in construing the claim to identify the functional versus the ornamental aspects of the arms (and the overall design).

ii.

RoM argues that the intrinsic evidence unambiguously demonstrates that the shape of the arms is ornamental. In doing so, RoM relies on (1) the drawings in the D'155 patent depicting the claimed design in solid lines and depicting “material disclaimed from the invention” using dashed lines, Appellant’s Br. 24–25 (citing J.A. 37 (D'155 patent)); and (2) the '081 patent (and the Armaid1 as its commercial embodiment), which is cited as prior art by the D'155 patent and which RoM argues serves as “intrinsic evidence that provide[s] clear examples of alternative designs for the D'155 patent.” *Id.* at 25–28. We disagree with RoM’s contention that the intrinsic evidence unambiguously demonstrates that the shape of the arms is ornamental.

Contrary to RoM’s assertion, the D'155 patent drawings do not delineate the functional and ornamental aspects of the design. RoM effectively contends that all elements depicted by the solid lines are ornamental, and all elements depicted by the dotted lines are functional. Appellant’s Br. 24–25. RoM’s position that these lines show what aspects are functional and what aspects are ornamental suggests, however, that all design elements must be either completely ornamental or completely functional. Our case law does not support this proposition. *See, e.g., Ethicon*, 796 F.3d at 1333 (“[T]he claim was limited to the ornamental aspects of these functional elements.”). Indeed, RoM recognizes that the elements depicted in solid lines have at least some functional aspects. *See* Appellant’s Br. 17 (identifying “functional or utilitarian features” of the Rolflex, including “a base connected to the bottom of a hinge apparatus” and “two arms connected to the hinge apparatus”).

Moreover, as the district court correctly recognized, RoM’s proposed approach of treating the D'155 patent’s disclaimer of elements as dispositive of the functionality inquiry would have courts blindly accept that “every feature

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depicted in solid lines in design patents [is] *per se* ornamental.” *Order* at *8; *see* Appellant’s Br. 24–28; J.A. 37; D’155 patent at Figs. 1–8. Accepting, without question, the demarcations depicted in a design patent would render meaningless the “helpful” practice of distinguishing between functional and ornamental aspects of the design. *Lanard Toys*, 958 F.3d at 1342. The *PHG* factors similarly would never be used if we treated the design patent drawings as unambiguously and dispositively determining functionality. *See PHG*, 469 F.3d at 1366–67. RoM’s position would also improperly suggest that courts are effectively bound by the examiner’s findings on functionality (as indicated by grant of the design patent). We thus reject RoM’s contention that the D’155 patent drawings unambiguously show that the shape of the arms is ornamental.

We reject RoM’s argument that the district court erred by not treating the existence of alternative designs as a dispositive factor that barred examination of the other *PHG* factors. Appellant’s Br. 15–16, 18; *see Order* at *7–8. RoM’s position is based on a misreading of our case law. The case on which RoM primarily relies, *Ethicon*, does not support the existence of alternative designs as a threshold inquiry. *See* Appellant’s Br. 15. *Ethicon* merely explains that the existence of alternative designs is an important factor that *can* be dispositive of functionality, but that courts may also consider the other relevant *PHG* factors. *Ethicon*, 796 F.3d at 1329–30. Notably, the case that *Ethicon* discusses and relies upon for its proposition, *Berry Sterling*, states that the existence of alternative designs “join[s] the list of other appropriate considerations for assessing whether the patented design as a whole—its overall appearance—was dictated by functional considerations.” *Berry Sterling*, 122 F.3d at 1456.

In any event, we disagree with RoM’s assertion that the ’081 patent clearly serves as a feasible alternative design. *See* Appellant’s Br. 25–28. Notably, the ’081 patent is titled “Limb Massager” while the D’155 patent is titled “Body

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Massaging Apparatus,” suggesting that the devices serve different purposes and have different functional capabilities. *Cf. Ethicon*, 796 F.3d at 1331 (“[T]o be considered an alternative, the alternative design must simply provide ‘the same or similar functional capabilities.’” (citation omitted)). We conclude that the intrinsic evidence does not unambiguously establish that the shape of the arms is solely ornamental, and that therefore the district court did not err by consulting the extrinsic evidence. *See Smartrend Mfg. Grp., Inc. v. Opti-Luxx Inc.*, 159 F.4th 1322, 1330–31 (Fed. Cir. 2025) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc)) (recognizing that for design patents, like for utility patents, district courts may consider extrinsic evidence when the intrinsic evidence is ambiguous). The district court did not commit reversible error with respect to its claim construction, including with respect to its determination that the shape of the arms is functional.

B.

RoM contends that, even if the district court’s claim construction was correct, the designs of the D’155 patent and the Armaid2 are similar enough to withstand summary judgment of non-infringement. Appellant’s Br. 34–37; Oral Arg. 11:09–12:47, 30:30–30:57. We reject RoM’s argument as it is based on the application of an incorrect version of the ordinary observer test.

“Design patent infringement is a question of fact, which a patentee must prove by a preponderance of the evidence.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119, 1129 (Fed. Cir. 2019). Courts analyze design patent infringement under the “ordinary observer” test, which provides: “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.”³ *Egyptian Goddess*, 543 F.3d at 670 (quoting *Gorham Co. v. White*, 81 U.S. 511, 528 (1871)) (cleaned up). “[T]he ‘ordinary observer’ test for design patent infringement requires the fact finder to ‘compar[e] similarities in overall designs, not similarities of ornamental features in isolation.’” *Lanard*, 958 F.3d at 1343 (second alteration in original) (quoting *Ethicon*, 796 F.3d at 1335). This test is performed from the perspective of a hypothetical ordinary observer who is familiar with the designs in the prior art. *Egyptian Goddess*, 543 F.3d at 676–78, 681; *Columbia Sportswear*, 942 F.3d at 1129. “Where the claimed and accused designs are ‘sufficiently distinct’ and ‘plainly dissimilar,’ the patentee fails to meet its burden of proving infringement as a matter of law.” *Ethicon*, 796 F.3d at 1335 (quoting *Egyptian Goddess*, 543 F.3d at 678). “If the claimed and accused designs are not plainly dissimilar, the inquiry may benefit from comparing the claimed and accused designs with prior art to identify differences that are not noticeable in the abstract but would be significant

³ As the dissent highlights, the ultimate question is whether the claimed and accused designs are substantially similar, with *Egyptian Goddess* merely recognizing that in some cases, the claimed and accused designs may be so clearly not similar (or “dissimilar”) as to remove the need to consider the prior art. Dissent at 3–6; see *Egyptian Goddess*, 543 F.3d at 678. However, the district court properly considered both the similarities and differences in assessing the overall similarity of the claimed and accused designs. See *Order* at *7 (highlighting that “both have opposable, curved arms, roller cutouts and handles, with the arms attached to a hinge apparatus with multiple slots for size adjustment”); *Order* at *9–11 (considering the broad similarities between the designs, although noting that many of them were related to function).

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to the hypothetical ordinary observer familiar with the prior art.” *Id.* (citing *Egyptian Goddess*, 543 F.3d at 678).

RoM and the dissent advocate for an approach that fails to respect the limits on a design patent’s scope. Focusing primarily on the shapes of the arms, RoM argued that one need only lay the pictures of the two designs next to each other, or even overlaying one another, to conclude that there is “substantial evidence of infringement.” Oral Arg. at 12:20–12:47, 30:30–30:57 (citing J.A. 48). The dissent takes up this suggestion, comparing the “overall design[]” by briefly comparing two pictures. Dissent at 1–2, 7. Notably missing from this methodology, however, is any attempt to consider claim construction or otherwise separate out functional aspects. By failing to ensure that functional aspects of a design do not play a role in the infringement analysis, the test endorsed by RoM and the dissent improperly seeks “to extend the scope of the patent far beyond the statutorily protected ‘new, original and ornamental design.’” *Lanard Toys*, 958 F.3d at 1345 (quoting 35 U.S.C. § 171). The dissent and RoM would dramatically increase the scope of design patents by precluding summary judgment whenever functional considerations result in two designs sharing similarities. Contrary to our precedent, this approach would render pointless our requirement to construe the claim, including conducting the functional-versus-ornamental inquiry that enables the fact finder to “factor[] out the functional aspects of [the] design” when applying the ordinary observer test. *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010). We reject the proposal to establish what amounts to an oversimplified version of the ordinary observer test that effectively eliminates the step of claim construction.

Here, the district court’s infringement analysis properly focused on the designs’ overall ornamental appearance and whether “the nonfunctional, ornamental aspects of the claimed and accused designs [were] plainly dissimilar.” *Ethicon*, 796 F.3d at 1337; see *OddzOn Prods.*,

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122 F.3d at 1405 (“If . . . a design contains both functional and ornamental features, the patentee must show that the perceived similarity is based on the ornamental features of the design.”). A helpful diagram from the district court’s opinion, comparing the designs of the D’155 patent, the Armaid2, and the Armaid1, is reproduced below.⁴



Order at *6. The district court began by comparing the D’155 patent and the accused Armaid2 side-by-side, noting that they “share a ‘broad design concept’ and ‘at a conceptual level they look quite similar.’” *Order* at *10 (citation omitted). The district court recognized, however, that most of the similarities between the designs were “likenesses [between] the . . . functional features” and correctly explained that these features were only to be considered “to the extent that they contribute to the overall ornamentation.” *Id.*; *see also id.* at *11 n.11 (acknowledging that,

⁴ We reproduce this diagram for the benefit of both the plainly dissimilar and three-way comparison steps of the infringement analysis. This diagram is not meant to suggest that the first step of the infringement analysis involves comparing the claimed and accused designs with designs in the prior art. *See Ethicon*, 796 F.3d at 1335, 1337.

while the clamshell arms were functional, they should still be “consider[ed for] their ornamental aspects and the way they contribute to the overall design”); *Ethicon*, 796 F.3d at 1336 (“Similarity at this conceptual level, however, is not sufficient to demonstrate infringement of the claimed designs.”).

The district court then thoroughly explained the differences that would stand out to an ordinary observer familiar with the prior art. These differences include that (1) “the most noticeable feature” of the D’155 patent was the “fixed arm” while the “semi-rectangular hinge apparatus of the Armaid2 makes up proportionally more of the device and forms the entire base of the product;” (2) the Armaid2 design, unlike the D’155 patent design, had an “overall segmented appearance” because of “the separation of the hinge apparatus” and “the presence of raised interior partitions in the clamshell arms;” (3) “the size-selection slots in the Armaid2 are larger, both on their own and in proportion to the product as a whole;” and (4) “the blunter, less rounded end of the hinge apparatus in the Armaid2” was more eye-catching than “the subtler, rounder curves of the hinge apparatus in the D’155 patent.” *Order* at *11. The district court concluded that, taken together, “[t]hese features contribute to the ‘stylized impression’ conveyed by the Armaid2 . . . in contrast to the ‘robust and workman-like’ impression conveyed by the D’155 patent.” *Id.* (citation omitted); see *Lanard*, 958 F.3d at 1343 (“Under the ‘ordinary observer’ test, a court must consider the ornamental features and analyze how they impact the overall design.”). We conclude that the district court did not commit reversible error in reaching its determination that the design of the Armaid2 and the narrow design protected by the D’155 patent are plainly dissimilar. *Order* at *11; see *Ethicon*, 796 F.3d at 1335 (“Where the claimed and accused designs are ‘sufficiently distinct’ and ‘plainly dissimilar,’ the patentee fails to meet its burden of proving infringement as a matter of law.” (quoting *Egyptian Goddess*,

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543 F.3d at 678)). We affirm the district court’s judgment that the Armaid2 does not infringe the D’155 patent.

Because we agree that the district court did not reversibly err in reaching its plainly dissimilar conclusion, it did not need to reach the three-way comparison step of the infringement analysis. See *Ethicon*, 796 F.3d at 1337. Nonetheless, even if it needed to reach the three-way comparison step, we agree with the district court that a comparison of the D’155 patent and the Armaid2 designs with the Armaid1 design in the prior art further supports the conclusion that no reasonable jury could find that the designs at issue are substantially similar. See *Order* at *11. After accounting for functional aspects, the district court found the most salient differences between the Armaid1 and Armaid2 to be (1) “the shape of the arms,” particularly with respect to “the areas just below the cylindrical handlebars” in the three images shown above in the reproduced diagram; and (2) “the manner in which the fixed arm connects to the hinge apparatus.” *Id.* Considering these features as part of its comparison of the overall similarity of the designs, the district court concluded that it would reach the same conclusion that no reasonable jury could find the claimed and accused designs substantially similar. *Id.* at *11–12. This inquiry was proper under our case law. See *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (“When the differences between the claimed and accused designs are viewed in light of the prior art, the attention of the hypothetical ordinary observer may be drawn to those aspects of the claimed design that differ from the prior art. If the claimed design is close to the prior art designs, small differences between the accused design and the claimed design assume more importance to the eye of the hypothetical ordinary observer . . . depending on the overall effect of those differences on the design.” (citing *Egyptian Goddess*, 543 F.3d at 681)). We conclude that the district court did not reversibly err in its analysis and would therefore also affirm the

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district court's grant of summary judgment of non-infringement on this alternative basis.

IV. CONCLUSION

We have considered RoM's remaining arguments and find them unpersuasive. We affirm the district court's judgment of non-infringement.

AFFIRMED

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

RANGE OF MOTION PRODUCTS, LLC,
Plaintiff-Appellant

v.

ARMAID COMPANY INC.,
Defendant-Appellee

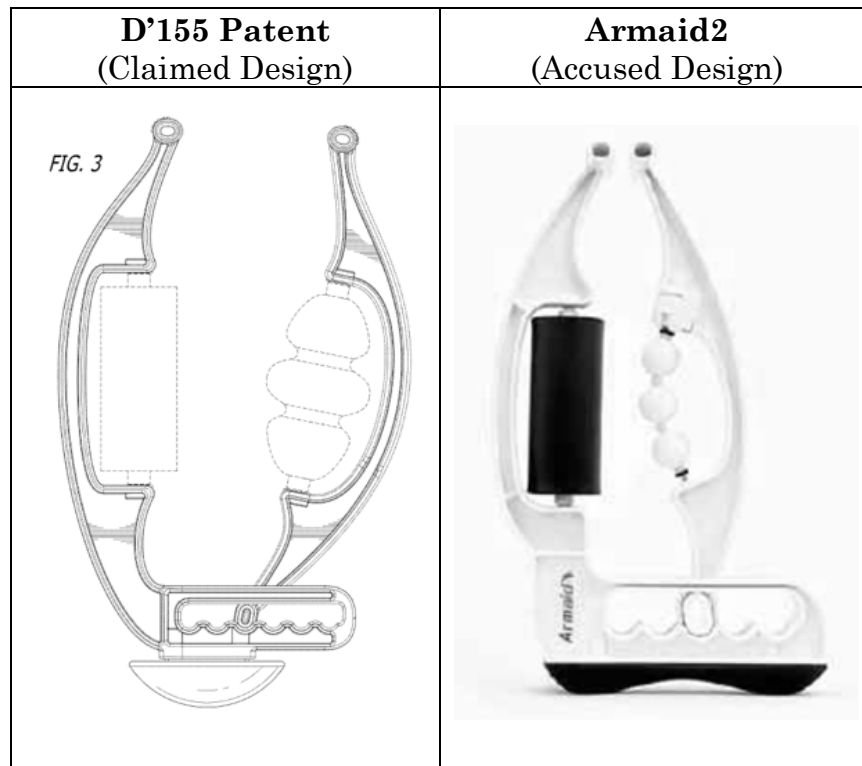
2023-2427

Appeal from the United States District Court for the District of Maine in No. 1:22-cv-00091-JDL, Chief Judge Jon D. Levy.

MOORE, *Chief Judge*, dissenting.

I believe a reasonable jury could find that “in the eye of the ordinary observer, giving such attention as a purchaser usually gives, [the] two designs are substantially the same.” *Gorham Co. v. White*, 81 U.S. 511, 528 (1871). This is, of course, a fact question. I think the district court erred when it took this question away from the jury and granted summary judgement of noninfringement. Here are the two designs at issue:

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It is hard to imagine, looking at the two overall designs, that no reasonable purchaser of handheld massagers could ever find that the overall designs were substantially similar. This decision was not the product of a jury verdict; it was a summary judgment where the judge concluded that no reasonable juror could find that the designs were substantially similar. I confess that I considered ending the dissent here.

But alas, I have more to say. I believe there exists a small and easily solved problem in our design patent law that led the district court astray. A problem, which I confess, has infected several of our cases and which has been the subject of several amicus briefs to our court.

DISCUSSION

I. The Sufficiently Distinct/Plainly Dissimilar Test

In *Gorham*, the Supreme Court made clear the test for infringement is the substantial similarity of the overall designs, explaining “the effect of the whole design,” rather than individual features, controls the inquiry. 81 U.S. at 530. Our predecessor courts long recognized the substantial similarity test as the proper standard for assessing design patent infringement. See, e.g., *Blumcraft of Pittsburgh v. United States*, 372 F.2d 1014, 1016 (Ct. Cl. 1967); *In re Dubois*, 262 F.2d 88, 91 (CCPA 1958).

In *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423 (Fed. Cir. 1984), this court began requiring plaintiffs to prove not only similarity under the ordinary observer test but also that the accused design appropriates the novelty of the claimed design. 728 F.2d at 1444 (“For a design patent to be infringed, however, no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.” (quotation omitted)). In *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc), we overruled the point of novelty test, recognizing the test proved difficult to administer and conflicted with the ordinary observer test laid out in *Gorham*. 543 F.3d at 670–72, 678. We explained the ordinary observer test is “the sole test” for determining infringement and should generally be conducted using the proper “frame of reference” by comparing the claimed and accused designs in light of the prior art. *Id.* at 677–78.

Without realizing it, in *Egyptian Goddess*, we meaningfully changed the substantial similarity test. We changed the frame of reference from whether two designs are substantially similar in overall appearance to whether two designs are “sufficiently distinct” or “plainly dissimilar.” *Egyptian Goddess*, 543 F.3d at 678. Recently, we have received a number of briefs that convincingly explain how

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this linguistic sleight of hand (substantially similar to plainly dissimilar) resulted in a significant change in the law. These briefs explained how there is a real-world difference between the paradigm shift from “substantially similar” to “plainly dissimilar/sufficiently distinct.” See *North Star Tech. Int’l Ltd. v. Latham Pool Prods., Inc.*, No. 23-2138, Dkt. 89 at 2–3, 8–12 (Pet. for Reh’g En Banc), Dkt. 100 at 1–4 (Inst. for Design Sci. & Pub. Pol’y Am. Br.), Dkt. 103 at 1, 3–4 (Oake Law Office, PLLC Am. Br.) (Fed. Cir. 2025). The former causes the fact finder to focus on the similarity of the overall designs whereas the latter forces the fact finder to focus on the differences.

Anyone who has ever done one of the childhood puzzles which asks you to circle the differences between two otherwise seemingly identical pictures can appreciate that focusing on differences makes those differences more significant and causes you to lose sight of the overall similarity.¹



Highlights for Children, Oct. 2016, at 20, available at <https://fliphtml5.com/fwspv/ktmi>.

¹ Google AI states that one important benefit of such childhood find-the-differences games is that they train the brain to focus on and notice small details. Google AI prompt “childhood find the difference game” search performed by Chief Judge Moore on December 10, 2025.

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There are a number of problems with our “plainly dissimilar/sufficiently distinct” test, including the reframing away from similarities and towards differences. *See North Star Tech. Int’l Ltd. v. Latham Pool Prods., Inc.*, No. 23-2138, Dkt. 100 at 1–4 (Inst. for Design Sci. & Pub. Pol’y Am. Br.) (Fed. Cir. 2025).² The results of a recent survey presented to this court demonstrate how impactful this paradigm shift can be. When shown designs from Supreme Court and Federal Circuit cases where infringement findings were upheld and asked whether they were plainly dissimilar, over 60% of ordinary observers polled answered in the affirmative. *Id.* at 3–4.

In the legal field, we have long recognized that the framing of questions matters. *See, e.g., FERC v. Elec. Power Supply Ass’n*, 577 U.S. 260, 297–98 (2016) (Scalia, J., dissenting) (“[A] proper framing of the inquiry is important . . .”); *Madison v. Alabama*, 586 U.S. 265, 278 (2019) (noting that how the court “framed its test” was “most important”); *Urda v. Sokso*, 146 F.4th 311, 314–15 (3d Cir. 2025) (noting that how a court “framed the question of law” “is especially important” and, when framed incorrectly, it can lead to improper results); *Elhady v. Kable*, 993 F.3d 208, 220 (4th Cir. 2021) (noting that “framing” is “important”); *United States v. Hills*, 27 F.4th 1155, 1178 (6th Cir. 2022) (noting that a “question or matter” may turn “on how the pending ‘question’ or ‘matter’ is framed”).

² Amici have also argued that our plainly dissimilar test lacks any standards or guidance making it entirely subjective. And it has resulted in strained summary judgment rulings which have taken this highly factual infringement question away from juries where they belong. *North Star Tech. Int’l Ltd. v. Latham Pool Prods., Inc.*, No. 23-2138, Dkt. 100 at 1–4 (Inst. for Design Sci. & Pub. Pol’y Am. Br.), Dkt. 103 at 1, 3 (Oake Law Office, PLLC Am. Br.) (Fed. Cir. 2025).

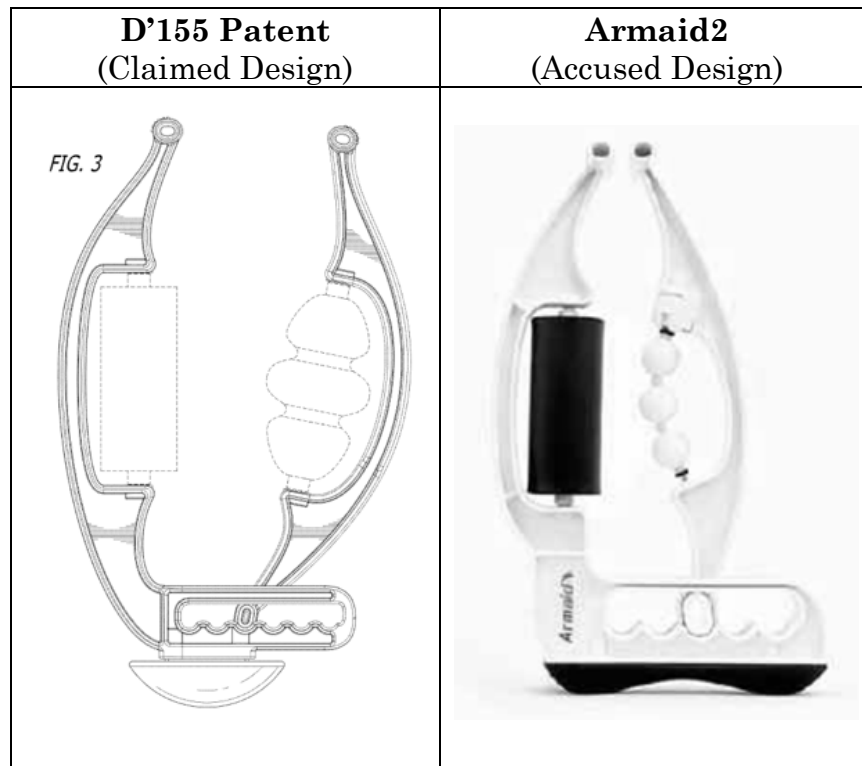
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Psychological literature has likewise documented the impact such framing can have on outcome.³ For example, “judges who engage in similarity testing selectively generate knowledge indicating that the target is similar to the standard, whereas judges who engage in dissimilarity testing selectively generate knowledge indicating dissimilarity.” Thomas Mussweiler, *Comparison Processes in Social Judgment: Mechanisms and Consequences*, 110 PSYCH. R. 472, 479 (2003). “The psychological principles that govern the perception of decision problems and the evaluation of probabilities and outcomes produce predictable shifts of preference when the same problem is framed in different ways.” Amos Tversky & Daniel Kahneman, *The Framing of Decisions and the Psychology of Choice*, 211 SCIENCE 453, 453 (Jan. 1981). In short, framing matters and can meaningfully impact outcome.

I will end this section where I began: Is it really the case that no reasonable juror could find the designs at issue substantially similar?

³ Bart Geurts, *Alternatives in Framing and Decision Making*, 28 MIND & LANGUAGE 1, 1 (Feb. 2013) (“There is a wealth of experimental data showing that the way a problem is framed may have an effect on people’s choices and decisions.”); Sonia Chopra, *The Psychology of Framing and Jury Decision-Making*, J. CONSUMER ATT’YS ASS’N. S. CAL. (Jan. 2020) (“Framing effect’ refers to the phenomenon that how a situation, problem, or choice is posed influences the way we perceive value, make choices, or behave – even when the alternatives are equivalent. Changing the frame can change the preferred outcome or choice.”); Amos Tversky et al., *The Causes of Preference Reversal*, 80 AM. ECON. REV. 204, 215 (1990) (“[A]lternative framings of the same options (for example, in terms of gains vs. losses, or in terms of survival vs. mortality) produce inconsistent preferences . . .”).

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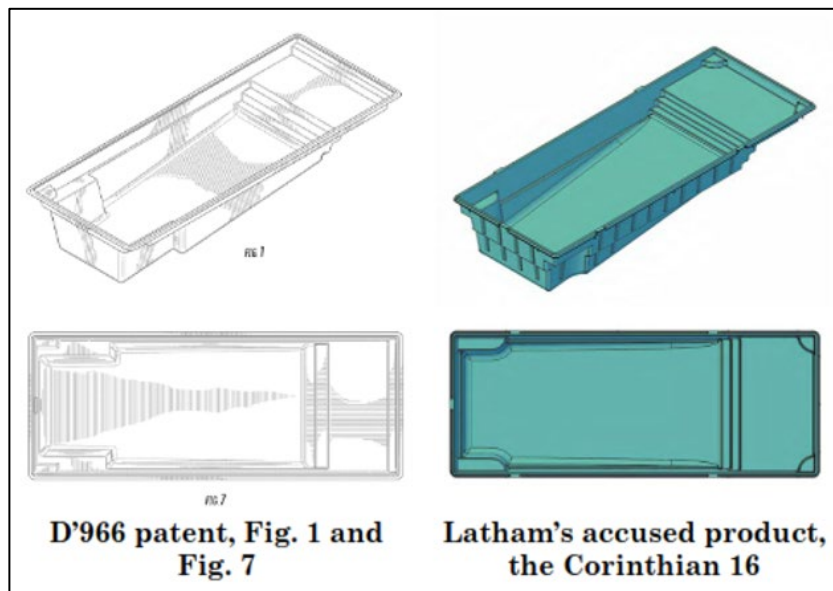
Perhaps the answer is no if the question is about the similarities but yes if the question is instead focused on the differences.

II. Trend in Design Patent Cases

I am even more troubled by the fact that this is not an isolated incident but appears representative of a much broader trend.

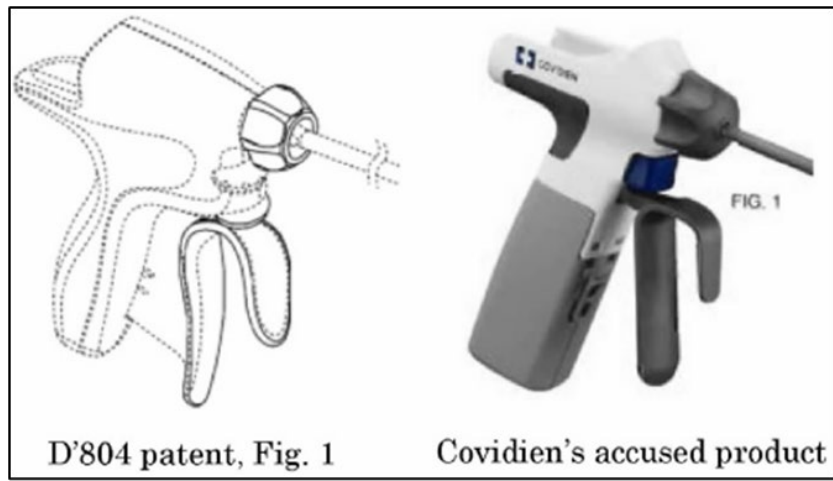
In *North Star*, we affirmed the district court's grant of summary judgment of noninfringement by holding the claimed and accused pool designs (reproduced below) are "plainly dissimilar" as a matter of law. *North Star Tech. Int'l Ltd. v. Latham Pool Prods., Inc.*, No. 23-2138, 2025 WL 1189919, at *1-2 (Fed. Cir. Apr. 24, 2025).

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It is hard for me to look at the patented pool design and the accused product and agree that no reasonable juror could find that their overall appearance is substantially similar. Here too, could the framing “plainly dissimilar” rather than “substantially similar” have impacted the outcome?

In *Ethicon Endo-Surgery*, we affirmed another district court’s grant of summary judgment of noninfringement by holding the claimed and accused designs (reproduced below) “plainly dissimilar.” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1334–37 (Fed. Cir. 2015). We acknowledged the designs were similar at a “general conceptual level” but held that, after excluding functional elements, the designs were “plainly dissimilar” focusing again on particular design differences. *Id.* at 1336–37.



While I do not foreclose the possibility of a jury finding non-infringement on these facts, which I would affirm, I am surprised to learn that no reasonable person could find them so.

I am troubled that such issues are being decided by district courts at summary judgment. It is not just that I disagree with every one of these outcomes, which I do, but that I think there is a larger problem, of our creation. I think there is a meaningful difference between determining whether two things are substantially similar and determining whether they are plainly dissimilar/sufficiently distinct. And I cannot rule out the possibility that this paradigm shift in the law (which we created) may be responsible for these many outcomes which I find troubling.

I think we ought to correct our error in *Egyptian Goddess* and reaffirm that the substantially similar test, announced by the Supreme Court in *Gorham*, is “the sole test.” Accordingly, we would vacate and remand the present case for the district court to reconsider summary judgment, focusing on the overall similarities, as *Gorham* requires, rather than differences. With the proper focus, I find it difficult to conclude that no reasonable juror could find the claimed and accused designs substantially similar in overall design.

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III. Application of the Plainly Dissimilar Test Drives the Result

The district court properly stated the *Gorham* substantially similar standard and found that even design elements which had a functional purpose, still had ornamental features (like the arms), and therefore must be considered in the infringement analysis. The district court went so far as to expressly find that “the D’155 patent and the Armaid2 share a ‘broad design concept’ and at a ‘conceptual level they look quite similar.” *Range of Motion Prods. LLC v. Armaid Co. Inc.*, No. 1:22-CV-00091, 2023 WL 5530768, at *10 (D. Me. Aug. 28, 2023) (“*Decision*”). After this acknowledgement, the district court finds (which it should not do at summary judgment): “when viewing the D’155 patent and the Armaid2 side-by-side, certain features stand out.” *Id.* at *11. The entirety of the district court’s subsequent analysis, much like the children’s find-the-differences game, amounted to identification of minute differences in each element. *See id.* (identifying and discussing each small difference in the appearance of various elements). Finally, after focusing exclusively on these minute differences, the court *finds* (again not its job on summary judgment): “In sum, I **find** that the ornamental aspects of the two designs are plainly dissimilar.” *Id.*

That the district court is making fact findings cannot reasonably be denied. Nor can the fact that its entire analysis is guided by a focus on element-by-element differences. As the above demonstrates, this is not a one-off, and by this court endorsing the primacy of the sufficiently distinct/plainly dissimilar test and affirming this case decided on summary judgment: replication is certain. Our errant language in *Egyptian Goddess* has and will result in the near-complete removal of the jury from its fact-finding role in design patent infringement.

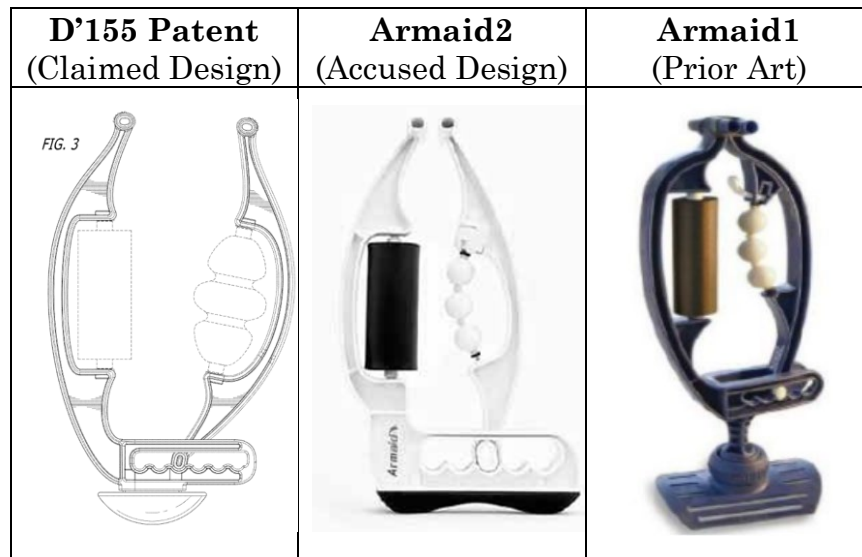
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The majority does not grapple with any of these concerns, which in fairness to the majority, are the result of a pattern of cases and a number of amicus briefs recently filed in our court.

The majority's only defense of the reframing from similarities to differences is that "*Egyptian Goddess* merely recognize[s] that in some cases, the claimed and accused designs may be so clearly not similar (or 'dissimilar') as to remove the need to consider the prior art." Maj. at 12 n.3. But this case is clearly not one of those where the designs are "so clearly not similar" that summary judgment of non-infringement was warranted. Nor was *North Star* or *Ethicon Endo-Surgery*.

When performing the substantial similarity analysis required by *Gorham*, I think the court should *always* "compar[e] the claimed and accused designs in light of the prior art," *Egyptian Goddess*, 543 F.3d at 677, with no special exception for plainly dissimilar designs, which has proved unworkable. As we explained in *Egyptian Goddess*, "a comparison of the claimed and accused designs with the prior art" can benefit resolution of the substantial similarity test, *id.* at 678, and this case demonstrates precisely why. Here, the context provided by the prior art further establishes that the issue of infringement should not have been decided at summary judgment.

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Comparing the Armaid1 prior art to the D'155 patent, my eyes are drawn to the substantial difference in the base as well as the overall shape of the arms. This includes the curvature of the arms, the ridges in the arms, the thickness of the arms, and the vertical positioning of the rollers relative to the arms. These are ornamental features which the district court correctly indicated should not be excluded from consideration of the overall appearance. *Decision*, at *8 (“To be sure, some features of the D'155 patent appear to be largely ornamental, including the hollowness and length of the handles, the thick ridged outline, the precise shape of the connector pivot, and the shape of the portion of the device where the hinge apparatus attaches to the fixed arm.”) The visually dominating base of the Armaid1 with its neck and platform is quite distinguishable from the small base structure of the Armaid2 or D'155 design.⁴ To

⁴ There is some evidence that the inverted mushroom base of the D'155 design had a functional motivation (because it is rounded it can be used at any angle), J.A. 381, but there is no evidence that the substantiality of the base

RANGE OF MOTION PRODUCTS, LLC v. ARMAID COMPANY INC. 13

my consumer eyes, the D'155 design is “deceptively similar to the [Armaid2], even to an observer familiar with [the prior art Armaid1].” *Egyptian Goddess*, 543 F.3d at 677. I do not preclude the possibility that a jury could find otherwise. I do object, however, to taking the question from the fact finder. Just look at the pictures: reasonable minds can differ. If I were on this jury, I would find the Armaid2 is substantially similar in overall ornamental appearance to the D'155 patent taking into account the differences and similarities with the prior art.

CONCLUSION

The district court granted summary judgment concluding: “In sum, I *find* that the ornamental aspects of the two designs are plainly dissimilar, such that ROM cannot show patent infringement as a matter of law.” *Decision*, at *11. While at times the court stated the law correctly, from its analysis and this clear fact finding, the court was focused on differences in individual features rather than similarities in the overall designs. I think the legal frame of reference is askew and believe it infected the analysis. I dissent.

played any functional role. The Armaid1 base seems large and separate from the remainder of the apparatus unlike the D'155 patent and the Armaid2 design. Again, I do not preclude a jury from finding otherwise.

said his name was Horsfall ; and that he explained to him the notice, at the foot of the declaration, to appear.

The defendant had let the plaintiff into possession of the premises ; but no writ of possession had ever been executed after the judgment in ejectment.

Gibbs said, the only question was, Whether the plaintiff could maintain an action of trespass for the mesne profits, without having a writ of possession executed ? That as possession was necessary to maintain trespass, it appeared by the proceedings in the ejectment, that he was not in possession when the ejectment was brought, nor legally so until put into possession under the writ of possession.

Lord Ellenborough.—It has been proved that the plaintiff has been in possession by consent of the party. I hold, That being in possession by the act of the party when he brings this action, that that is sufficient to entitle him to maintain the action.

Garrow and Barrow for the plaintiff.

Gibbs for the defendant.

[168] June 11th.

CARY v. KEARSLEY.

(In an action on the case for pirating a book, it is not sufficient evidence of a general pirating, to shew that there were particular errors and mistakes in the printing of the original work, which were copied verbatim into the pirated edition. The first publisher of a book, even though he has improperly obtained the materials of it, may maintain an action for pirating it. It is not sufficient to support an action for pirating books, that part is found transcribed into another, for it is lawful to use former publications in composing a new work if they are fairly taken, without being made colour for publishing the original work.)

[Applied, *Spiers v. Brown*, 1858, 6 W. R. 352. Discussed, *Scott v. Stanford*, 1867, L. R. 3 Eq. 718. Referred to, *Kelly v. Byles*, 1880, 13 Ch. D. 682 ; *Weatherley & Sons v. International Horse Agency and Exchange, Ltd.*, [1910] 2 Ch. 297 ; *University of London Press, Ltd. v. University Tutorial Press, Ltd.*, [1916] 2 K. B. 601.]

This was an action on the case, for infringing the plaintiff's copy-right, in an Itinerary, or Book of Roads, of which the plaintiff claimed to be the proprietor.

The plaintiff proved, that for nine preceding years he had been employed in taking and preparing surveys and distances on the different roads, to the amount of nine hundred miles, which were embodied into the work ; so that the book was compiled from actual surveys made by himself.

Having proved by this means his right as author to the original work,—to prove that the defendant's book was a piracy of it, he called a witness who had compared them : the names of places and distances generally corresponded ; but he proved that several mistakes and errors, which had crept into the plaintiff's book in the printing, were copied verbatim into the defendant's. These were principally in the names of places, as Filmer Hill for Farmer's Hill ; and in the signs, the Duke of Bolton's Arms for the the Duke of Beaufort's Arms ; from whence he inferred that the defendant's book was a copy from his, and not an original compilation.

Lord Ellenborough said, that he thought that the proof of these errors transmitted into the defendant's book, would not support the declaration for a general printing and pirating of the plaintiff's work ; the defendant was authorised to use a work published as this of the plaintiff's, to make extracts from it into [169] any original work of his own ; and mistaking the names and descriptions, and taking such detached parts, was only using an erroneous dictionary. It was therefore necessary to go further. The sixth count however was found to correspond, in laying the particular injury, that of transcribing without his consent the particular matter.

The counsel for the defendant were examining the witness, who was an officer of the post-office, to the fact of, Whether the survey stated to have made by Cary the plaintiff, was not at the expense of the post-office, professing the object to be, to shew that the copy-right belonged to the post-office, and not to the plaintiff ; so that he could maintain no action for infringing it ?

Lord Ellenborough.—I do not know that that will protect the defendant : at law the first publisher, even though he has abused his trust, by procuring the copy, has a right to it, and to an action against a person who publishes it without authority from him. It may be a ground in equity, as between the person entitled and the person who first published it ; but it does not destroy the right of the latter to sue a person pirating that right.

It appeared, that in the book published by Cary, great quantity of new matter had been added, which had been transcribed into the defendant's book, with additions, and observations had been made on it, and several routs were broken into two ; but it appeared that there was no entire particular paragraph transcribed.

Lord Ellenborough.—If I adopt the works of contemporary writers, and embody them into my own, it makes a new work.

[170] Mr. Erskine. Suppose a man took Paley's Philosophy, and copied a whole essay, with observations and notes, or additions at the end of it, would that be piracy ?

Lord Ellenborough.—That would depend on the facts of, whether the publication of that essay was to convey to the public the notes and observations fairly, or only to colour the publication of the original essay, and make that a pretext for pirating it ; if the latter, it could not be sustained. That part of the work of one author is found in another, is not of itself piracy, or sufficient to support an action ; a man may fairly adopt part of the work of another : he may so make use of another's labours for the promotion of science, and the benefit of the public : but having done so, the question will be, Was the matter so taken used fairly with that view, and without what I may term the *animus furandi* ? such as was the case put by Mr. Erskine of Paley's Philosophy. Look through the book, and find any part that is a transcript of the other ; if there is none such, if the subject of the book is that which is subject to every man's observation ; such as the names of the places and their distances from each other, the places being the same, the distances being the same, if they are correct, one book must be a transcript of the other ; but when, in the defendant's book there are additional observations, and in some part of the book I find corrections of misprinting (his Lordship here pointed out some) while I shall think myself bound to secure every man in the enjoyment of his copy-right, one must not put manacles upon science.

[171] I think great part of the book that I have seen, Mr. Kearsley might fairly avow that he had taken it from Mr. Cary's book. I shall address these observations to the jury, leaving them to say, whether what so taken or supposed to be transmitted from the plaintiff's book, was fairly done with a view of compiling a useful book, for the benefit of the public, upon which there has been a totally new arrangement of such matter,—or taken colourable, merely with a view to steal the copy-right of the plaintiff ?

The counsel for the plaintiff consented to be nonsuited.

Erskine, Garrow, and Holroyd for the plaintiff.

Dallas, Gibbs, and Tomlins for the defendant.

MILWARD, ASSIGNEE OF GATES, v. FORBES.

(Where a person is examined at a private examination before commissioners of bankrupts, and that examination is taken down, it is sufficient if so much only is taken down as is conceived to be necessary to be used in evidence, provided such part has been read over to him, and he has signed it. The whole of his examination need not be taken down, to make that evidence which applies to the matter in dispute.)

This was an action of trover by the assignees of Gates, a bankrupt to recover from the defendant the value of fifteen sacks of flour.

The case stated to charge the defendant was, That after an act of bankruptcy committed, the defendant had taken away from the bankrupt's house the fifteen sacks of flour, and converted them to his own use.

The defendant had been examined before the commissioners of bankruptcy at a private examination : his examination was taken in writing ; it was [172] produced by the solicitor, under the commission signed by the defendant, and offered in evidence.

Garrow, in examining the solicitor who produced the proceedings, interrogated him very particularly, Whether what was then put down, and there produced, was all that had been said by the bankrupt on his examination ? or, Whether only so much was taken down as was sufficient to be made use of on the trial ? contending, that all that had passed at the examination should have been taken down and produced as his deposition ; as the part omitted might give a different colour to the transaction.

The witness said, That the defendant had said more at the examination than what was so taken down ; that he had taken down only what he considered as relevant ;

Holdsworth v M'Crea

(1867) LR 2 HL 380, 36 LJQB 297, 16 WR 226

Court: House of Lords

Judgment Date: 25/06/1867

Catchwords & Digest

EVIDENCE - MODES OF PROOF AND WEIGHT OF EVIDENCE - INSPECTION - OF THINGS - INFRINGEMENT OF TRADE MARKS AND DESIGNS - SIMILARITY IN DESIGN

TRADE MARKS, TRADE NAMES AND DESIGNS - REGISTERED DESIGNS - REGISTRATION OF DESIGNS - REGISTRATION AND ITS DURATION - WHAT REGISTRATION PROTECTS - DESIGN CONSISTING OF SEVERAL PARTS REGISTERED AS WHOLE PATTERN — PARTS NOT SEVERALLY PROTECTED

TRADE MARKS, TRADE NAMES AND DESIGNS - REGISTERED DESIGNS - RIGHTS ON REGISTRATION; INFRINGEMENT AND THREATS ACTIONS - WHAT CONSTITUTES INFRINGEMENT - DESIGN TAKEN IN SUBSTANCE - WHETHER INFRINGEMENT

Now, in the case of those things as to which the merit of the invention lies in the drawing, or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of the identity of the two things, whether, therefore, there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure, and ascertains whether they are or are not the same (Lord Westbury).

(1) The same nicety was not required in registering patterns or designs as in describing inventions sought to be protected under the Patent Laws. The provisions of 5 and 6 Victoria c 100 (repealed) and 21 and 22 Victoria c 70 (repealed) were complied with by a person who left with the Registrar copies of his design, though without any written description specifying precisely what was the extent of his claim. If what he claimed as his design consisted according to the pattern of different parts, any one of which might have been deemed 'a design' his registration of the whole pattern amounted to a claim of the combination, and not to any of the parts thus combined, any one of which, therefore, taken separately

was not protected by the registration. A registered as a 'design,' within class 12, s 3 (repealed) of 5 and 6 Victoria c 100, a pattern of a woven fabric. He gave no written description of his claim. The design consisted of six pointed stars on an Albert chain, arranged in a particular manner, and shaded, and he claimed, in his particulars in the action, 'the particular collocation of the shaded and bordered stars upon the ornamental chain surface, as shown in the registered pattern, thus forming together the ornamentation of the woven fabric': Held the design, in respect of the combination, had been duly registered, and the pattern, as a combination, was protected.

(2) Whether, therefore, there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure, and ascertains whether they are or are not the same (Lord Westbury).

Where a pattern of an article had been registered under 21 and 22 Victoria c 70 s 5 (repealed), the design would be infringed by an article to all appearance the same, though not actually identical.

Cases referring to this case

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Holdsworth v M'Crea

Table1 ([Return to related document text](#))

Le May v Welch, Re Le May's Registered Design

05/11/1884
CA

(1884) 28 Ch D 24, 51 LT 867

Applied

Table1 ([Return to related document text](#))

End of Document

L. C.

M'CREA *v.* HOLDSWORTH.

1870

Nov. 3.

Design—Registration of Pattern—Infringement.

Where a pattern of an article has been registered under 21 & 22 Vict. c. 70, s. 5, the design will be infringed by an article to all appearance the same, though not actually identical.

Observations in *Holdsworth v. M'Cre*a (1) explained.

THIS was a suit to restrain the Defendants from copying a design for ornamenting a woven fabric which had been protected under the *Copyright of Designs Acts* (5 & 6 Vict. c. 100, and 21 & 22 Vict. c. 70, s. 5), by registering a pattern of the article.

The hearing of the suit stood over for the Plaintiff to establish his right at law. He accordingly brought an action against the Defendants, in which the jury found that the Plaintiff's design was a new and original combination, had been registered, and had been infringed; and they gave 40s. damages. The Defendants then obtained a rule to enter the verdict for the Defendants, on the ground that the registration was bad.

The rule was discharged by the Court of Queen's Bench; that decision was affirmed by the Court of Exchequer Chamber, and afterwards by the House of Lords, as reported (1).

The suit was then brought on to be heard before the Vice-Chancellor *James*, who directed an inquiry as to damages, and ordered the Defendants to pay the costs of the suit.

The Defendants appealed.

Mr. *Bristowe*, Q.C., and Mr. *Ince*, for the Appellants:—

The Plaintiff has recovered 40s. damages at law; those are his damages, and he has no right to any more. He has made out no case for more than he has obtained at law.

Moreover, we have not, in fact, infringed. We relied at law on the invalidity of the registration, and *per incuriam* did not seriously dispute the infringement. But now that the case comes before this Court, we maintain that we have not infringed. The Plaintiff has chosen to register his design by furnishing a pattern only,

(1) Law Rep. 2 H. L. 380.

and therefore nothing but that very pattern will be protected. Now, there is a variation between our pattern and that of the Plaintiff, therefore we have not copied the thing which he has chosen to register, and the only thing for which he is entitled to protection. This was clearly the opinion of the learned Lords who decided the case (1); we claim the benefit of that opinion, and maintain that this bill ought to be dismissed with costs; or else, if the Plaintiff disputes the fact, the Court ought, with or without a jury, to try the question.

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Mr. *Kay*, Q.C., and Mr. *C. Hall*, for the Plaintiff, were not called upon.

LORD HATHERLEY, L.C. :—

I think this is really a very idle contention. It seems to me an attempt to give a meaning to some words used in the House of Lords totally opposite to anything that was intended by the noble Lords who used those words.

It has been argued that, when a design of this kind is registered, and the designer, instead of describing the design in words, chooses to place the design itself upon the register in the shape of a part of the article designed, then he is tied down to that identical design so exhibited, and is not at liberty to complain of any person making a thing which is to all outward appearance exactly the same, and which, for all purposes for which the thing is manufactured, is identical. And it has been argued that, if the person who exhibits a design for all practical purposes identical with the registered design is astute enough, as in this case, to turn what is called a "star" in the opposite direction upon the pattern, though it is of exactly the same dimensions and effect to the eye, he may do so with impunity.

The question appears not to have been raised at the trial, where the Judge and the jury considered the articles as identical for the purpose for which they were made; and I imagine that the observations made by some of the learned Lords, and relied upon by the Defendants, were intended to say merely that the design could be protected only as it was represented; and the learned Lords

(1) *Law Rep.* 2 H. L. 384, 387, 398, 390.

L. C.
1870
M'CREA
r.
HOLDSWORTH.

considered that the question whether there was any difference in the effect would be left to the jury. Their Lordships seem to have meant that the designer is not bound, as in a patent case, to distinguish the new from the old, and is allowed to register his pattern without distinguishing what is new from what is old; but if he chooses to put it in that way, it will not be protected as against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner, as I hold they are in this case, and have the same effect, or nearly the same effect, then of course the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the Defendants from the consequences of the piracy.

This case has been twice before a jury. They have found what seems to be clearly established, that this is an invention of the Plaintiff's. It has been established by the decision of the House of Lords, confirming the judgment of the Exchequer Chamber, together with the previous judgments. The novelty is therefore fixed and settled; and we find that the parties, as a matter of common sense, instead of leaving it to the jury to say infringement or not infringement, did not trouble the jury to consider that question, but agreed at once to take that verdict which on both sides was felt to be the proper verdict on that point.

I think that the verdict was entirely right; that the decision of the Vice-Chancellor is also entirely right; and, therefore, that this appeal must be dismissed with costs.

Solicitors: Messrs. *Edwards, Layton, & Jaques*; Messrs. *Emmets, Watson, & Emmet*.

footway, but merely as to the easement of washing sheep, and therefore that the finding of the jury upon the first was mistakenly indorsed on the postea. The learned Judge however rejected this evidence, and the plaintiff obtained a verdict.

Cockell Serjt. in Michaelmas term last obtained a rule, calling on the plaintiff to shew cause why the verdict should not be set aside, and a new trial granted: and in Hilary term the case was shortly touched upon by Law, (now Attorney-General,) who insisted that the record in the former action was admissible in evidence against the present defendant, though no party thereto, the right claimed being for a public footway, which was matter of common notoriety. The case was ordered to stand over till this term: and

Park and Littledale were now called upon to support the rule, who relied principally upon the case of *Lewis v. Clerges* (a)¹ to shew that a verdict could not be given in evidence unless between the same parties; for otherwise a man would be bound by a decision where he had no opportunity to cross examine the witnesses. But though it were admissible, at any rate it was competent to the defendant to shew that the indorsement on the postea was [357] made by mistake of the officer; the matter of that issue respecting the footway having passed sub silentio, and the trial having altogether proceeded upon the issue respecting the easement of washing sheep.

Lord Kenyon C.J. I think the Judge's direction was right upon both points. The record was admissible evidence, though between other parties, as to the finding upon the right to the public footway, which was negatived. The defendants in both cases stood in the same relative situation. In the case of customary commoners, a verdict in an action for or against one is evidence for or against another claiming in the same right. So in other cases (a)² of public prescription. What weight the evidence was entitled to is another question; perhaps not to much; and certainly it was not conclusive. But the evidence offered by the defendant went to impeach the authenticity of the record as to the fact of such a finding, and therefore was not admissible.

Grose J. assented.

Lawrence J. Reputation would have been evidence as to the right of way in this case; a fortiori therefore, the finding of twelve men upon their oaths.

Lord Kenyon C.J. agreed, that reputation was evidence with respect to public rights claimed, as in this case; but not with respect to private rights.

Le Blanc J. assented.

Rule discharged.

[358] CARY *against* LONGMAN AND REES. Saturday, April 25th, 1801. An action lies to recover damages for pirating the new corrections and additions to an old work.

[Referred to, *Walter v. Steinkopff* [1892], 3 Ch. 496.]

This was an action on the case for pirating a book of the plaintiff's. The first count of the declaration stated, that the plaintiff was the author of a certain book intitled, "Cary's New Itinerary, or an Accurate Delineation of the Great Roads both Direct and Cross throughout England and Wales, &c. from an Actual Admeasurement made by Command of His Majesty's Postmaster-General," &c.; and that being the author of the said book within fourteen years last past he had published the same for sale, &c. That the defendants intending to deprive the plaintiff of the profit thereof, and of the benefit of his copy-right, injuriously published and exposed to sale divers copies of a certain book intitled, "A New and Accurate Description of all the Direct and Principal Roads, &c. from a Late Actual Admeasurement made by Command of His Majesty's Postmaster-General," &c. which same book had before that time been wrongfully and injuriously copied from the said book of the plaintiff, without his consent, &c. The second count laid it thus; great part of which said book had been before that time wrongfully and injuriously copied and pirated from the said book of the plaintiff, without his consent, &c. The third count laid, that the plaintiff was the proprietor of Cary's Itinerary, &c. The sixth count laid, that the plaintiff had the sole right of printing certain matters relating to the roads of this kingdom, &c.

(a)¹ A trial at Bar, Easter term 1700, Gilbert's Law of Evidence, 29. Vide *Sherwin v. Clerges*, Bull. Nisi Prius, 332.

(a)² In the case of customary tolls, vide *The City of London v. Clerke*, Carth. 181.

first published within fourteen years last past in a certain book of the plaintiff's called, &c.

At the trial before Lord Kenyon at Westminster, it appeared that the original foundation of both the plaintiff's [359] and defendants' books was a work first published in 1771, by Mr. Patterson, the copyright of which in 1788 (the author being then living) became vested in Mr. Newberry. This work had gone through several editions, the 11th of which was published in 1796. In 1797 the plaintiff was employed by the Postmaster-General to make an actual survey of the principal roads; and the book published by him with their permission contained many material corrections of and additions to the last edition of the original work by Patterson. The principal of these consisted in some corrections of distances by the actual surveys; in an admeasurement of the distances from inn to inn in the several post towns, in addition of those from one town to another; in an index to the roads more copious than the former one; in an additional number of gentlemen's seats by the road side; in a rejection of some routes, and an addition of many others. On the other hand, the work published afterwards by the defendants as the 12th edition of the original work by Patterson appeared to have been copied, nine tenths of it, verbatim from the plaintiff's improvements, and many of the alterations merely colourable. After verdict for the plaintiff,

Gibbs moved for a new trial on the ground that the stat. 8 Ann. c. 19, s. 1, granting the copy-right to authors for a certain time, only enacts, "That the author of any book and his assigns shall have the sole liberty of printing such book for 14 years," &c. And though he could not deny that the defendants had copied the alterations of and additions to the original work, introduced by the plaintiff in his Itinerary, in the same manner as he himself had copied the original work, yet he could not be considered as [360] the author of the book within the meaning of the statute, the greater part of it having been before published by another person, and to which the plaintiff had no title.

Lord Kenyon C.J. Certainly the plaintiff had no title on which he could found an action to that part of his book which he had taken from Mr. Patterson's; but it is as clear that he had a right to his own additions and alterations, many of which were very material and valuable; and the defendants are answerable at least for copying those parts in their book. That the defendants had pirated from the plaintiff's book was proved in the clearest manner at the trial; nine tenths at least of the alterations and additions were copied verbatim. The printed work itself was made use of by the defendants at the press, some of it clipped with scissors, with a few slips of paper containing MS. additions interspersed here and there, and some of these merely nominal and colourable. The Courts of Justice have been long labouring under an error, if an author have no copy-right in any part of a work unless he have an exclusive right to the whole book. I remember it was thought otherwise in the case of Mr. Mason (*Mason v. Murray*). Several of Mr. Gray's poems had been for many years before published, which were collected by Mr. Mason, and published with the addition of several new poems: but though he had not a property in the whole book, yet the defendant having copied the whole, the Lord Chancellor (a) granted an injunction against him as to the publication with the additional pieces. So Lord Hard-[361]-wicke in another case (b) granted an injunction to restrain the defendants from printing Milton's

(a) Qu. Lord Bathurst?

(b) *Tonson v. Walker and Another*, 30th April 1752, cited in *Millar v. Taylor*, 4 Burr. 2325, 2353, and in *Tonson v. Collins*, 2 Blac. 332.

Vide *Motte v. Falkner*, Nov. 1735, before Lord Talbot, cited in 4 Burr. 2353, and in 1 Blac. Rep. 331, and *Carnon v. Bowles*, 2 Bro. Ch. Cas. 80, relative to the original publication in question.

Sayre and Others v. Moore, sittings after Hil. 1785, at Guildhall, cor. Lord Mansfield C.J.—This was an action for pirating sea charts; which are protected by statute 71 Geo. 3, c. 57. The charts which had been copied were four in number, which Moore had made into one large map.

It appeared in evidence that the defendant had taken the body of his publication from the work of the plaintiffs, but that he had made many alterations and improvements thereupon. It was also proved that the plaintiffs had originally been at a great expence in procuring materials for these maps. Delarochett, an eminent geographer and engraver, had been employed by the plaintiffs in the engraving of them. He said

Paradise Lost, with Dr. Newton's Notes; although there was no doubt but that [362] they were at liberty to have published the original work itself without the notes.

Per Curiam. Rule refused.

that the present charts of the plaintiffs were such an improvement on those before in use as made them an original work. Besides their having been laid down from all the charts and maps extant, they were improved by many manuscript journals and printed books and manuscript relations of travellers: he had no doubt the materials must have cost the plaintiffs between 3000l. and 4000l., and that the defendant's chart was taken from these of the plaintiffs, with a few alterations. In answer to a question from the Court, whether the defendant had pirated from the drawings and papers, or from the engravings? he answered, from the engravings. Winterfelt, an engraver, said he was actually employed by the defendant to take a draft of the Gulph Passage (in the West Indies) from the plaintiffs' map.

Many witnesses were called on behalf of the defendant, amongst others a Mr. Stephenson and Admiral Campbell. Mr. Stephenson said he had carefully examined the two publications; that there were very important differences between them, much in favour of the defendant's. That the plaintiffs' maps were founded upon no principle; neither upon the principle of the Mercator, nor the plain chart, but upon a corruption of both. That near the Equator the plain chart would do very well, but that as you go further from the Equator, there you must have recourse to the Mercator. That there were very material errors in the plaintiffs' maps. That they were in many places defective in pointing out the latitude and longitude, which is extremely essential in navigating. That most of these, as well as errors in the foundings, were corrected by the defendant. Admiral Campbell observed, that there were only two kinds of charts, one called a plain chart, which was now very little used; the other, which is the best, called the Mercator, and which is very accurate in the degrees of latitude and longitude. That this distinction was very necessary in the higher latitudes, but in places near the Equator it made little or no difference. That the plaintiffs' maps were upon no principle recognized among seamen, and no rules of navigation could be applied by them; and they were therefore entirely useless.

Lord Mansfield, C.J. The rule of decision in this case is a matter of great consequence to the country. In deciding it we must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded. The Act that secures copy-right to authors guards against the piracy of the words and sentiments; but it does not prohibit writing on the same subject. As in the case of histories and dictionaries: in the first, a man may give a relation of the same facts, and in the same order of time; in the latter an interpretation is given of the identical same words. In all these cases the question of fact to come before a jury is, whether the alteration be colourable or not? there must be such a similitude as to make it probable and reasonable to suppose that one is a transcript of the other, and nothing more than a transcript. So in the case of prints, no doubt different men may take engravings from the same picture. The same principle holds with regard to charts; whoever has it in his intention to publish a chart may take advantage of all prior publications. There is no monopoly of the subject here, any more than in the other instances; but upon any question of this nature the jury will decide whether it be a servile imitation or not. If an erroneous chart be made, God forbid it should not be corrected even in a small degree, if it thereby become more serviceable and useful for the purposes to which it is applied. But here you are told, that there are various and very material alterations. This chart of the plaintiffs' is upon a wrong principle, inapplicable to navigation. The defendant therefore has been correcting errors, and not servilely copying. If you think so, you will find for the defendant; if you think it is a mere servile imitation, and pirated from the other, you will find for the plaintiffs.

Verdict for the defendant.

Dr. Trusler v. Murray, sittings after Mich. 1789, cor. Lord Kenyon.—This was an action for pirating a book of chronology. It was proved by the plaintiff, that though some parts of the defendant's work were different, yet in general it was the same, and particularly from page 20 to 34 it was a literal copy.

Lord Kenyon, C.J. was of opinion, that if such were the fact the plaintiff must

[363] SMITH AND OTHERS, Assignees of Richardson, a Bankrupt, *against* STOKES. Tuesday, April 28th, 1801. After an act of bankruptcy committed by one of two partners, joint effects are sent away, which come to the defendant's hands; then the solvent partner dies, leaving the defendant his executor; and afterwards a commission of bankrupt is taken out against the surviving partner, and his estate assigned to the plaintiffs: Held that they are tenants in common with the solvent partner, and after his decease with his representatives by relation of law from the act of bankruptcy; and cannot therefore maintain trover against the defendant claiming under such solvent partner.

In trover for goods, to which the general issue was pleaded, a verdict was taken for the plaintiffs at the trial before Lord Kenyon C.J. at Westminster, after last Michaelmas term, damages 241l. 4s., subject to the opinion of the Court on the following case.

[364] The bankrupt Richardson and one Strickland were partners in trade. On the 29th January 1800 Richardson committed an act of bankruptcy. On the 31st of the same month the goods in question, being partnership effects, were sent to Monmouth directed to A. and B. and were received by the defendant, and which before the action brought were demanded by the plaintiffs of the defendant, who refused to deliver the same. On the 8th of February 1800 a commission of bankrupt, on the petition of S. G. and others who were creditors of Strickland and Richardson, was issued against Richardson only. On the 14th of the same month of February Strickland died, having made his will, and appointed Stokes and Weston his executors, who have since proved the same. Strickland never committed any act of bankruptcy. On the 7th of March 1800 the commissioners acting under the commission of bankrupt against Richardson executed an assignment of his effects to the plaintiffs, who were duly chosen assignees. The question was, whether the plaintiffs were entitled to recover in this action?

Turnor, for the plaintiffs, admitted, that if the defendant, as the representative of Strickland the deceased partner, stood in the relation of tenant in common of the property with the plaintiffs, the action could not be maintained: but he contended, that upon Strickland's death the whole legal interest in the partnership property, which was before then holden in joint tenancy, survived to the bankrupt his remaining partner, and was upon his bankruptcy transferred by the assignment to the plaintiffs; although by the law merchant they were accountable for a moiety to the representatives of the deceased partner. The pro-[365]-perty was originally vested in the two partners as joint tenants, and nothing happened during the life of Strickland to convert their title into a tenancy in common; for he died before the commissioners' assignment was made, and consequently before the bankrupt laws had attached upon the legal title of the bankrupt so as to destroy the joint tenancy. The act of bankruptcy, which happened before Strickland's death, could not of itself operate to dissolve the joint-tenancy, or sever the title of the parties, and convert it into a tenancy in common. This was evidently the opinion of the Court in *Fox and Others, Assignees, v. Hanbury (a)*; for they there held, that after a secret act of bankruptcy by one partner, the other still continued to have a control over the partnership effects, and might convey a title to a third person: whereas if the act of bankruptcy of one operated so as to convert the joint tenancy into a tenancy in common, the solvent partner could only have made a title to a moiety. Lord Mansfield indeed there said, that the act of bankruptcy of one partner is to many purposes a dissolution of the partnership by virtue of the relation in the bankrupt laws; but that is merely to

recover, though other parts of the work were original. He said Lord Bathurst had been of that opinion, and he thought rightly with respect to the publication of some original poems by Mr. Mason, together with others which had been before published. And the like with respect to an Abridgment of Cook's Voyage Round the World. The main question here was, whether in substance the one work is a copy and imitation of the other; for undoubtedly in a chronological work the same facts must be related. The parties having received his Lordship's opinion, it was agreed to refer the consideration of the two books to an arbitrator, who would have leisure to compare them.

(a) Cowp. 445.

CERTIFICATE OF COMPLIANCE

This petition complies with the type-volume limitation of Fed. R. App. P. 40(d)(3) because this petition contains 3,874 words, excluding the parts of the brief exempted by Fed. Cir. R. 32(b)(2).

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