

# Design Patent Case Digest

[MRC Innovations, Inc. v. Hunter Mfg., LLP](#)



**Decision Date:** April 2, 2014

**Court:** U.S. Court of Appeals for the Federal Circuit

**Patents:** [D634,488](#) and [D634,487](#)

**Holding:** N.D. of Ohio's Grant of Summary Judgment of Invalidity AFFIRMED

## Opinion:

Plaintiff MRC Innovations, Inc. is the owner of two design patents claiming ornamental designs for football and baseball jerseys for dogs. MRC previously supplied dog jerseys to Defendant Hunter MFG., LLP. After business relations between MRC and Hunter soured, Hunter turned to another supplier, Defendant CDI International, Inc., for dog jerseys. MRC brought suit against Hunter and CDI alleging infringement of patents D634,488 ([football jersey](#)) and D634,487 ([baseball jersey](#)). Hunter moved for summary judgment on the grounds that the patents were obvious under 35 U.S.C. § 103(a). The district court granted summary judgment to Hunter, holding both patents invalid.

Obviousness determinations are reviewed de novo. Underlying factual questions are reviewed for clear error. A court performing an obviousness analysis considers (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and the prior art, and (4) objective evidence of non-obviousness. The ultimate inquiry in a design patent obviousness determination is "whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved." Answering this inquiry is a two-step process. First, a primary reference must be identified in the prior art. The primary reference must have design characteristics which are "basically the same" as the claimed design. Second, at least one secondary reference must be found. The secondary reference must be sufficiently related to the first reference such that the appearance of an ornamental feature in one reference would suggest the application of that feature to another reference.

MRC asserted that the district court erred in selecting the "[Eagles](#)" pet jersey as the primary reference for the '488 patent because it had significant differences from the '488 patent and thus could not be "basically the same" as the claimed design. Specifically, MRC claimed that (1) the patent disclosed a V-neck collar while the primary reference disclosed a rounded neck, (2) the patent disclosed an interlock fabric panel on the side as opposed to the mesh described in the primary reference, and (3) the patent disclosed additional ornamental surge the primary reference did not. The Federal Circuit concluded that the district court properly pointed to five key similarities between the '488 patent and "Eagles" reference. The Federal Circuit noted that the designs had the same overall shape, similar fabric, and ornamental surge stitching. The court

acknowledged that there were slight differences between the placements of the ornamental stitching. However, the court held that the differences were insufficient to remove the “Eagles” jersey from being the primary reference.

After settling on a primary reference, the district court introduced two secondary references: “V2” and “Sporty K9.” The district court found that both references disclosed the use of a V-neck and non-mesh fabric on the side panels. The district court held that the additional stitching on the claimed design was a “*de minimis* change which would be well within the skill of an ordinary designer in the art.” MRC argued that the district court erred by failing to explain why an artisan would incorporate the features from the second references into the primary reference. The Federal Circuit disagreed with MRC, explaining that “the mere similarit[ies] in appearance provides the suggestion that one should apply certain features to another design.” The court noted that the “striking similarity” in appearance between the three pieces of art would motivate a designer to use features from one design in another. MRC’s final objection to the invalidity of the ‘488 patent was the district court’s use of *de minimis* changes. MRC argued that the addition of any ornamental feature not disclosed in the prior art is more than *de minimis*. Again, the Federal Circuit rejected MRC’s stance. The court held that the addition of the stitching was an “insubstantial change that would have been obvious to a skilled designer.” Rejecting all of MRC’s objections, the Federal Circuit affirmed the invalidity of the ‘488 patent.

The district court undertook a similar analysis of the ‘487 patent. This time, the district court used the “Sporty K9” jersey as the primary reference and the “V2” and “Eagles” jerseys as the secondary references. The Federal Circuit agreed with the district court’s choices of the primary and secondary references. The Federal Circuit noted that the two jerseys had the same “overall visual impression” and that the differences were so minor that only one difference affected the overall visual impression of the design. The Federal Circuit relied on much of its ‘488 patent analysis to bolster its conclusions that the district court did not err and affirmed the invalidity of the ‘487 patent.

In a final attempt to save the validity of the patents, MRC argued that the fourth factor in the obviousness test was strong and that obviousness should therefore not be found. The fourth factor of an obviousness analysis is objective evidence of non-obviousness. This includes commercial success. MRC argued that the district court failed to adequately consider the commercial success as objective evidence of non-obviousness. The Federal Circuit disagreed. The court explained that it was MRC’s burden to demonstrate a nexus between the claimed design and the secondary considerations. The court stated that MRC failed to meet this burden because MRC did not include any evidence of commercial success beyond the conclusory testimony of the inventor himself. Having rejected all of MRC’s arguments, the Federal Circuit affirmed the district court’s grant of summary judgment to Hunter and CDI.

If you have any questions or would like additional information on this topic, please contact:

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