

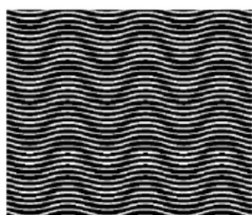
# Another remand in the eight-year Columbia Sportswear saga

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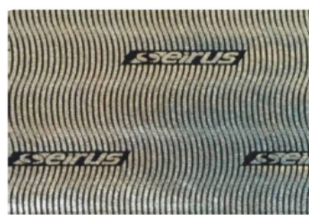
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On Friday, September 15, 2023, the Federal Circuit issued its latest opinion in the design patent dispute between Columbia Sportswear North America, Inc. (“Columbia”) and Seirus Innovative Accessories, Inc. (“Seirus”).<sup>1</sup> This is the second time the Federal Circuit reviewed a finding regarding infringement in the case — and the second time the Federal Circuit reversed and remanded.

Over eight and a half years ago — on January 12, 2015 — Columbia sued Seirus claiming that Seirus’s HeatWave products infringe Columbia’s U.S. Patent No. D657,093 for “Heat Reflective Material.” The patent claims “[t]he ornamental design of a heat reflective material, as shown and described.”<sup>2</sup> The design claimed in the ’093 patent and Seirus’s accused HeatWave design are reproduced below.<sup>3</sup>



‘093 patented design



Seirus’s accused HeatWave design

In 2016 the district court granted summary judgment of infringement, and in 2017 a jury awarded Columbia more than \$3 million in damages.<sup>4</sup> Seirus appealed.<sup>5</sup> On that prior appeal, the Federal Circuit vacated the district court’s grant of summary judgment of infringement and remanded for further proceedings.<sup>6</sup>

The Federal Circuit concluded that the district court “erred in granting summary judgment of infringement for two reasons: (1) the court improperly declined to consider the effect of Seirus’s logo in its infringement analysis and (2) the court resolved a series of disputed fact issues, in some instances relying on an incorrect standard, that should have been tried to a jury.”<sup>7</sup> Among these fact issues was the impact of Seirus’s comparison prior art — prior art used to determine the scope of the patent — on the infringement analysis.<sup>8</sup>

On remand, the district court limited admissible comparison prior art to “wave patterns on fabric.”<sup>9</sup> The district court precluded Columbia from trying to distinguish the alleged comparison prior art references as not disclosing *heat reflective material*, which Columbia argued was

a requirement given the claim language.<sup>10</sup> The jury returned a verdict of non-infringement.<sup>11</sup> Columbia appealed.

Columbia challenged (among other things) the jury instructions with regard to (1) whether comparison prior art is limited to designs that are applied to the same article of manufacture recited in the claim (here, heat reflective materials) and (2) the role that likelihood of consumer confusion should play in the design patent infringement analysis (including the role a party’s logo should play).<sup>12</sup> The Federal Circuit addressed each issue in turn.

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First — regarding comparison prior art — the Federal Circuit reaffirmed the use of comparison prior art in a design patent infringement analysis, citing the district court’s opinion, which stated that the “ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art,” and “when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.”<sup>13</sup>

However, the court said the question before it — whether a prior design must involve the same article of manufacture that is recited in the claim in order to qualify as comparison prior art — is an issue of first impression.<sup>14</sup>

In resolving that issue of first impression, the Federal Circuit held that Columbia was correct that the scope of comparison prior art should be limited to the article of manufacture recited in the design patent claim and that the district court erred by not instructing the jury accordingly.<sup>15</sup> Thus, on this basis, the Federal Circuit vacated the

non-infringement judgment and remanded the case to the district court for further proceedings.<sup>16</sup>

The holding regarding the scope of comparison prior art is consistent with prior Federal Circuit opinions limiting both anticipating prior art<sup>17</sup> and infringing articles<sup>18</sup> to the article of manufacture recited in the claim. In response to Seirus’s argument that such a holding improperly reads functionality into a design patent claim, the Federal Circuit stated that an *article’s* function must not be confused with whether the *design* of the article provides functionality.<sup>19</sup>

The question before the court was not whether the design claimed in Columbia’s patent is dictated by function, but rather whether the article of manufacture recited in the claim must be the same type of article of manufacture in the asserted comparison prior art and to do this, knowing the function of the article is helpful.<sup>20</sup>

Second — regarding likelihood of confusion — the Federal Circuit began by confirming that (unlike in trademark infringement) likelihood of confusion as to the source of the goods is not an appropriate factor to consider in design patent infringement.<sup>21</sup> Regarding the role a party’s logo plays in the infringement analysis, the Federal Circuit noted that while design patent infringement is not automatically avoided by applying a label or logo, labels and logos are “hardly irrelevant” to the infringement analysis.<sup>22</sup>

The court stated that “just because a logo’s potential to eliminate confusion as to *source* is irrelevant to design-patent infringement, its potential to render an accused *design* dissimilar to the patented one — maybe even enough to establish non-infringement as a matter of law — should not be discounted.”<sup>23</sup>

Turning to the specific instructions given to the jury, the Federal Circuit found no legal error in the district court’s instruction, which stated that the jury did not need to find that any purchasers were actually deceived or confused by the appearance of the accused products.<sup>24</sup> The Federal Circuit disagreed with Columbia that the district court erred by not adding that consumer confusion as to source is irrelevant for design patent infringement or that likelihood of confusion (in addition to actual confusion) need not be found.<sup>25</sup>

The case is now heading back to the district court. Time will tell if the third time will be the charm for Columbia.

## Notes

<sup>1</sup> See *Columbia Sportswear N. Am. Inc., v. Seirus Innovative Accessories Inc.*, Nos. 2021-2299 and 2021-2338, 2023 WL 5988026 (Fed. Cir. Sept. 15, 2023) (“Columbia II”).

<sup>2</sup> *Id.* at 2.

<sup>3</sup> *Id.* at 3.

<sup>4</sup> See *Columbia Sportswear N. Am. Inc., v. Seirus Innovative Accessories Inc.*, 942 F.3d 1119 (Fed. Cir. 2019).

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> *Id.* at 1130-31.

<sup>8</sup> *Id.* at 1130.

<sup>9</sup> See *Columbia II*, at 7.

<sup>10</sup> See *id.* at 8.

<sup>11</sup> See *id.* at 12.

<sup>12</sup> See *id.* at 17.

<sup>13</sup> *Columbia II*, at 5 (quoting *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676 (Fed. Cir. 2008) (en banc)).

<sup>14</sup> See *id.* at 20.

<sup>15</sup> *Id.* at 24.

<sup>16</sup> *Id.* at 28.

<sup>17</sup> *In re Surgisil LLP*, 14 F.4th 1380, 1382 (Fed. Cir. 2021).

<sup>18</sup> *Curver Luxembourg SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1336, 1340, 1343 (Fed. Cir. 2019).

<sup>19</sup> *Columbia II*, at 25.

<sup>20</sup> See *id.* at 25-26.

<sup>21</sup> See *id.* at 29.

<sup>22</sup> *Id.* at 30.

<sup>23</sup> *Id.*

<sup>24</sup> *Id.* at 31-32.

<sup>25</sup> *Id.*

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