

Design Patent Case Digest

Young v. Stone



Decision Date: August 28, 2014

Court: N.D. Illinois

Patent: [D442,661](#)

Holding: Defendant's motion for judgment on the pleadings of non-infringement
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Opinion:

Plaintiff Roger Young sued Anne Stone, Inc. for infringement of U.S. Design Patent No. D442,661, entitled "Golf Putting Practice Hole Simulator." Anne Stone, Inc. manufactures and sells the "[Putt-A-Round](#)" as a practice target for golf putting. Anne Stone, Inc. moved for judgment on the pleadings under Rule 12(c), arguing that Young's claim for design patent infringement failed as a matter of law based on the facts stated in the pleadings.

In considering motions under Rule 12(c), courts accept all well-pled allegations in the complaint as true and draw all reasonable inferences in the plaintiff's favor. Notably, the court here referenced the *Twiqbal* standard for dismissal, requiring that a plaintiff must plead sufficient facts to state a claim of relief that is plausible on its face.

Applying the two-step test for design patent infringement, the court first construed the patent—distinguishing between the functional elements and those that are ornamental. The court noted that it is proper to separate the functional and ornamental aspects, because the scope of the design claim "must be construed in order to identify the non-functional aspects of the design as shown in the patent." *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010).

Here, the court found that the spaced disks of the patented design and the pole that separates the disks are functional. But it noted "that the differences in the mechanisms that trap the golf ball may be evaluated as part of the ornamental design because they contribute to the overall impression of the product." The court also construed the extended flagpole as ornamental and resolved the contested construction of the base element by interpreting it as ornamental. While Anne Stone, Inc. argued that the base of its product was ornamental, Young argued that where a feature is concealed or obscured in the normal use of the device, it is not "a matter of concern" in the design patent context. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1379 (Fed. Cir.2002)(overruled on other grounds by *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed.Cir.2008)). The court accepted Anne Stone, Inc.'s position that the underside of the device is visible during the normal use of the product, particularly at the point of sale and whenever a purchaser moves the device to reposition it.

The court then turned to the second step of the infringement test, where the court must determine in comparing the patented design to the alleged infringing product "whether an ordinary

observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design." *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 672 (Fed.Cir.2008). The court acknowledged that it should not "focus[] on whether the accused design has appropriated a single specified feature of the claimed design," but rather should evaluate "whether the accused design has appropriated the claimed design as a whole." *Id.* at 677. As an initial matter, the court considered relevant prior art submitted by the parties, expressly referencing U.S. Patent No. [1,297,055](#), entitled "Golf-cup," where a flexible trapping disk is positioned just below the upper disk to capture the golf ball, and U.S. Patent No. [2,899,207](#), entitled "Device for Golf Putting Practice," where both disks are tapered to capture the golf balls. The court noted that all the prior art references feature a pole of some length extending from the top disk.

Next, the court focused on what it considered to be obvious differences between the products:

- Young's patented design has a flat lower base, while the lower disk on the Putt-A-Round is noticeably inclined. The court concluded that this "difference is readily apparent upon even a casual view of the two products."
- The rounded cap on Young's flagpole is substantially different from the tapered insert on the Putt-A-Round's flagpole.
- The suggested flag in Young's patent (which is not a part of the patented design) appears to attach to the pole well below the cap in question, leaving the top of the flagpole visible, while the flag of the Putt-A-Round covers the top of the flagpole.
- The patented design features a smooth surface on the underside of the base, while there are multiple elements on the Putt-A-Round that stand out, including a prominent central bolt and three small, round feet.

Young made an unsuccessful argument based on trademark law that the ordinary observer will pay less attention when evaluating the product because it is inexpensive. The court emphasized that the ordinary observer standard articulated in *Egyptian Goddess* controls, but that "even if a consumer gave the products a less in-depth review, the overall appearances of the products are sufficiently dissimilar to obviate any confusion between the products."

Under the ordinary observer test, the court concluded that the two products are "so plainly dissimilar that defendant is entitled to judgment as a matter of law," and that "even disregarding the marked difference in the functional elements of the products, the appearances of the products are dissimilar enough to conclude that an observer familiar with the prior art would not confuse the products." Accordingly, the court granted Anne Stone, Inc.'s motion for judgment on the pleadings of non-infringement.

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

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