

MRC INNOVATIONS, INC v. HUNTER MFG., LLP, Appeal No. 2013-1433 (Fed. Cir. April 2, 2014). Before Rader, Prost and Chen. Appealed from N.D. Ohio (Judge Gaughan).

### Background:

MRC owns two design patents (the '487 and the '488 patents) directed to sports jerseys for dogs. After a business relationship between MRC and Hunter deteriorated, Hunter began seeking proposals from other companies to manufacture and supply it with pet jerseys like the ones described in the two MRC design patents. MRC then sued Hunter and its supplier, CDI, for willful infringement of both its design patents. The district court granted summary judgment in favor of Hunter and CDI on the grounds that both of MRC's design patents are invalid as obvious under 35 U.S.C. §103(a). MRC appealed.

### Issue/Holding:

Did the district court err in granting summary judgment based on a finding of obviousness? No, affirmed.

### Discussion:

On appeal, the Federal Circuit stated that in order to determine whether a claimed design would have been obvious to a designer of ordinary skill in the art, a court must first determine "whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design." Citing *In re Rosen*, the Federal Circuit stated that in order to make this determination, a court must first identify a single reference, the design characteristics of which are *basically the same* as the claimed design. Once a primary reference has been identified, other secondary references may be used to modify the primary reference to create a design that has the same overall visual appearance as the claimed design.

With regard to the '488 patent, the Federal Circuit found that the district court correctly used an "Eagles" pet jersey (previously manufactured by MRC) as the "primary reference" in its obviousness analysis. The Federal Circuit noted that although there are some differences between the design of the '488 patent and the Eagles jersey, the district court was correct in finding that the characteristics of the '488 design created "basically the same" overall visual impression as the Eagles jersey. In addition, the Federal Circuit noted that "slight differences in the precise placement of the interlock fabric and the ornamental stitching does not defeat a claim of obviousness."

Next, the Federal Circuit found that the district court was correct in finding that another reference, known as the "Sporty K9" jersey, could serve as a secondary reference. In response to MRC's argument that the district court erred by failing to explain *why* a skilled artisan would have combined the two references, the Federal Circuit (citing *In re Borden*) stated that the requirement for suggestion or motivation may be met when the "designs are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." In other words, it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design. The Federal Circuit also clarified that designs are sufficiently "related" when the secondary reference is "closely akin" to the claimed design. For example, the Federal Circuit noted that the secondary reference relied on by the district court was also a football jersey to be worn by dogs. Thus, the Federal Circuit found that sufficient motivation to combine the references existed.

