

▶ Hupp v. Siroflex of America, Inc.  
C.A.Fed., 1997.

United States Court of Appeals, Federal Circuit.  
Jack T. HUPP and Walkmaker, Inc., Plaintiffs-  
Appellants,

v.


SIROFLEX OF AMERICA, INC., Defendant/Cross-  
Appellant.  
Nos. 95-1268, 95-1289.

Sept. 4, 1997.

Patentee brought action against competitor alleging infringement of **design patent** for **mold** used to make simulated **stone** pathway and alleging trade dress infringement. Following jury trial, the United States District Court for the Southern District of Texas, Kent, J., entered judgment that patent was invalid and not infringed, that patent was unenforceable, and that trade dress was functional, not inherently distinctive, and not infringed. Patentee appealed. The Court of Appeals, [Pauline Newman](#), Circuit Judge, held that: (1) design was primarily ornamental; (2) jury's anticipation finding was not supported by evidence; (3) patentee's submission of sketches to invention agency did not trigger on-sale bar; (4) patent was not invalid for obviousness; (5) ambiguous jury instruction on infringement did not warrant new trial; (6) competitor's **mold** did not infringe patented design; (7) evidence did not support finding of inequitable conduct; (8) trade dress for patentee's **mold** was functional and not inherently distinctive; and (9) competitor was not entitled to amount of security bond posted by patentee in connection with preliminary injunction.

Affirmed in part and reversed in part.

West Headnotes

**[1]** Patents 291  324.55(3.1)

**291** Patents

[291XII](#) Infringement

[291XII\(C\)](#) Suits in Equity

[291k324](#) Appeal

[291k324.55](#) Questions of Fact,  
Verdicts, and Findings

[291k324.55\(3\)](#) Issues of Validity

[291k324.55\(3.1\)](#) k. In General.

[Most Cited Cases](#)

**Patents 291**  324.56

**291** Patents

[291XII](#) Infringement


[291XII\(C\)](#) Suits in Equity

[291k324](#) Appeal

[291k324.56](#) k. Harmless Error. [Most](#)

[Cited Cases](#)

Judgment of patent invalidity must be affirmed if there was substantial evidence, on record as whole, to support findings of fact needed to sustain jury verdict, absent reversible error at trial.

**[2]** Patents 291  312(6)

**291** Patents

[291XII](#) Infringement

[291XII\(C\)](#) Suits in Equity

[291k312](#) Evidence

[291k312\(3\)](#) Weight and Sufficiency

[291k312\(6\)](#) k. Particular Matters,

Sufficiency as To. [Most Cited Cases](#)

Finding that **design patent** for **mold** used to make simulated **stone** pathway was not ornamental, which rendered patent invalid on that basis, was not supported by substantial evidence; other designs had same general use, and aesthetic characteristics of patentee's design were not dictated by function of article. [35 U.S.C.A. § 171](#).

**[3]** Patents 291  28

**291** Patents

[291II](#) Patentability

[291II\(A\)](#) Invention; Obviousness

[291k28](#) k. Designs. [Most Cited Cases](#)

Design or shape that is entirely functional, without ornamental or decorative aspect, does not meet statutory criteria of **design patent**. [35 U.S.C.A. § 171](#).

[\[4\] Patents 291](#) 28

[291](#) Patents

[291III](#) Patentability

[291III\(A\)](#) Invention; Obviousness

[291k28](#) k. Designs. [Most Cited Cases](#)

Fact that article of manufacture serves function is prerequisite of design patentability, not defeat thereof; function of article itself must not be confused with “functionality” of design of article which may defeat patentability on basis that design is not primarily ornamental. [35 U.S.C.A. § 171](#).

[\[5\] Patents 291](#) 28


[291](#) Patents

[291III](#) Patentability

[291III\(A\)](#) Invention; Obviousness

[291k28](#) k. Designs. [Most Cited Cases](#)

In determining whether statutory requirement is met that patented design is “ornamental,” it is relevant whether functional considerations demand only this particular design or whether other designs could be used, such that choice of design is made for primarily aesthetic, nonfunctional purposes. [35 U.S.C.A. § 171](#).

[\[6\] Patents 291](#) 312(6)

[291](#) Patents

[291XII](#) Infringement

[291XII\(C\)](#) Suits in Equity

[291k312](#) Evidence

[291k312\(3\)](#) Weight and Sufficiency

[291k312\(6\)](#) k. Particular Matters,

Sufficiency as To. [Most Cited Cases](#)

Jury's finding that design claimed in patent for **mold** used to make simulated **stone** pathway was described in printed publication more than a year before patent filing date was not supported by evidence, as only publication on which jury might have relied for such finding was newspaper advertisement for ceramic floor tile whose overall design was not identical to patentee's **mold**. [35 U.S.C.A. §§ 102\(a\), 171](#).

[\[7\] Patents 291](#) 76

[291](#) Patents

[291III](#) Patentability

[291III\(E\)](#) Prior Public Use or Sale

[291k76](#) k. What Constitutes Public Sale.

[Most Cited Cases](#)

Patentee's submission to invention agency of sketches and designs of concrete **mold** design for simulated **stone** pathway did not trigger on-sale bar which would render patent containing same designs invalid, as inventor's quest for aid and advice in developing and patenting invention was not on-sale event. [35 U.S.C.A. § 102\(b\)](#).

[\[8\] Patents 291](#) 28

[291](#) Patents

[291III](#) Patentability

[291III\(A\)](#) Invention; Obviousness

[291k28](#) k. Designs. [Most Cited Cases](#)

**Design patent** for **mold** used to make simulated **stone** pathway was not invalid for obviousness, as only possible reference showing similar design was ceramic floor tile, and there was no teaching in prior art whereby one of ordinary skill would look to flooring designs in designing **mold** suitable for making simulated **stone** walkway out of concrete. [35 U.S.C.A. §§ 103, 171](#).

[\[9\] Patents 291](#) 28

[291](#) Patents

[291III](#) Patentability

[291III\(A\)](#) Invention; Obviousness

[291k28](#) k. Designs. [Most Cited Cases](#)

Determination of ultimate question of obviousness of **design patent** is made from viewpoint of person of ordinary skill in field of patented design.

[\[10\] Patents 291](#) 28

[291](#) Patents

[291III](#) Patentability

[291III\(A\)](#) Invention; Obviousness

[291k28](#) k. Designs. [Most Cited Cases](#)

Scope of prior art, for purpose of determining whether **design patent** is obvious, is not universe of abstract design and artistic creativity, but designs of same article of manufacture or of articles sufficiently similar that person of ordinary skill would look to such articles for their designs.

[\[11\] Patents 291](#) 28


[291](#) Patents

[291II](#) Patentability

[291III\(A\)](#) Invention; Obviousness

[291k28](#) k. Designs. [Most Cited Cases](#)

“Primary reference” approach to determining whether **design patent** is obvious is to ascertain whether, upon application of *Graham* factors to invention viewed as whole, same or substantially similar article of manufacture is known to have design characteristics of which design of article as shown in claim is obvious variant; obviousness, in turn, is determined by ascertaining whether applicable prior art contains any suggestion or motivation for making modifications in design of prior art article in order to produce claimed design.

[112](#) Patents 291 323.3

[291](#) Patents

[291XII](#) Infringement

[291XII\(C\)](#) Suits in Equity

[291k323](#) Final Judgment or Decree

[291k323.3](#) k. Relief from Judgment or

Decree. [Most Cited Cases](#)

Allegedly misleading jury instruction in patent infringement trial, which included concept of validity in instruction on infringement, did not warrant new trial, even if jury's finding of noninfringement was thereby influenced by its finding of invalidity, as instruction was not incorrect statement of law, patentee did not object when instruction was given or seek clarification of verdict before jury was dismissed, and there was substantial evidence on which jury could have reached verdict of noninfringement.

[113](#) Courts 106 96(5)

[106](#) Courts

[106II](#) Establishment, Organization, and Procedure

[106II\(G\)](#) Rules of Decision

[106k88](#) Previous Decisions as Controlling or as Precedents

[106k96](#) Decisions of United States Courts as Authority in Other United States Courts

[106k96\(5\)](#) k. Decisions in Other Circuits. [Most Cited Cases](#)

On matters not the exclusive appellate assignment of Federal Circuit, Court of Appeals for the Federal Circuit looks to law and practices of circuit of trial.

[114](#) Patents 291 252

[291](#) Patents

[291XII](#) Infringement

[291XII\(A\)](#) What Constitutes Infringement

[291k252](#) k. Patents for Designs. [Most Cited Cases](#)

To infringe **design patent**, accused article must appropriate features of patented design and its overall appearance; infringement is determined from viewpoint of ordinary observer, whereby observer would be led to believe that article of one producer is that of another because of their similarity in design.

[115](#) Patents 291 252


[291](#) Patents

[291XII](#) Infringement

[291XII\(A\)](#) What Constitutes Infringement

[291k252](#) k. Patents for Designs. [Most Cited Cases](#)

**Design patent** for **mold** used to make simulated **stone** pathway was not infringed by competitor's **mold** for similar item in view of evidence that competitor's **mold** design was not substantially same and did not have substantially same effect as patented design.

[116](#) Patents 291 324.55(1)

[291](#) Patents

[291XII](#) Infringement

[291XII\(C\)](#) Suits in Equity

[291k324](#) Appeal  
[291k324.55](#) Questions of Fact, Verdicts, and Findings

[291k324.55\(1\)](#) k. In General. [Most Cited Cases](#)

On appeal of jury verdict of inequitable conduct which renders patent unenforceable, Court of Appeals reviews proceedings to determine whether there was substantial evidence supporting actual or inferred findings of factual questions of whether there was withholding of information material to patentability with intent to deceive or mislead patent examiner.

[117](#) Patents 291 97

[291](#) Patents

[291IV](#) Applications and Proceedings Thereon

[291k97](#) k. Patent Office and Proceedings Therein in General. [Most Cited Cases](#)  
In order to establish inequitable conduct it was necessary for party asserting inequitable conduct to establish by clear and convincing evidence that there was withholding of information material to patentability, with intent to deceive or mislead patent examiner.

#### [\[18\] Patents 291](#)

##### [291](#) Patents

[291IV](#) Applications and Proceedings Thereon  
[291k97](#) k. Patent Office and Proceedings Therein in General. [Most Cited Cases](#)  
Only when facts of materiality and intent are established, on claim of inequitable conduct which would render patent unenforceable, does decisionmaker exercise its discretion to decide whether, considering all circumstances, inequitable conduct shall be found.

#### [\[19\] Patents 291](#)

##### [291](#) Patents

[291IV](#) Applications and Proceedings Thereon  
[291k97](#) k. Patent Office and Proceedings Therein in General. [Most Cited Cases](#)  
**Design patent** applicant's failure to disclose to Patent and Trademark Office (PTO) newspaper advertisement of ceramic floor tile with design similar to that of **mold** for simulated **stone** pathway which was subject of application did not amount to inequitable conduct, because tile was not analogous prior art and thus was not material to patentability of applicant's design.

#### [\[20\] Patents 291](#)

##### [291](#) Patents

[291IV](#) Applications and Proceedings Thereon  
[291k97](#) k. Patent Office and Proceedings Therein in General. [Most Cited Cases](#)  
**Design patent** applicant's failure to disclose to Patent and Trademark Office (PTO) applicant's submission to invention agency which occurred more than a year before patent filing date did not amount to inequitable conduct, as submission could reasonably have been believed not to start statutory on-sale bar, and there was no evidence whatsoever of culpable

intent in not telling patent examiner of that correspondence. [35 U.S.C.A. § 102\(b\)](#).

#### [\[21\] Trademarks 382T](#)

##### [382T](#) Trademarks

[382TII](#) Marks Protected  
[382Tk1061](#) Form, Features, or Design of Product as Marks; Trade Dress  
[382Tk1062](#) k. In General. [Most Cited Cases](#)  
(Formerly 382k43)  
"Trade dress" is packaging and general presentation of product.

#### [\[22\] Federal Courts 170B](#)

##### [170B](#) Federal Courts

[170BVIII](#) Courts of Appeals  
[170BVIII\(D\)](#) Presentation and Reservation in Lower Court of Grounds of Review  
[170BVIII\(D\)2](#) Objections and Exceptions  
[170Bk630](#) Instructions  
[170Bk630.1](#) k. In General. [Most Cited Cases](#)  
(Formerly 382k724.1)

Producer of **mold** used to make simulated **stone** pathway waived claim that jury instruction on trade dress infringement did not correctly state applicable law, by failing to object to instruction at trial.

#### [\[23\] Trademarks 382T](#)

##### [382T](#) Trademarks

[382TIX](#) Actions and Proceedings  
[382TIX\(C\)](#) Evidence  
[382Tk1620](#) Weight and Sufficiency  
[382Tk1631](#) k. Trade Dress. [Most Cited Cases](#)  
(Formerly 382k589)

Jury's finding that trade dress of **mold** used to make simulated **stone** pathway was functional and not inherently distinctive was supported by substantial evidence, even if trade dress was copied by competitor, in view of conflicting evidence and jury's opportunity to observe actual trade dress of both parties.

#### [\[24\] Patents 291](#)

[291 Patents](#)


[291XII](#) Infringement

[291XII\(C\)](#) Suits in Equity

[291k293](#) Preliminary Injunction

[291k306](#) k. Security Instead of Injunction. [Most Cited Cases](#)

Defendant in patent infringement action was not entitled to amount of security bond posted by patentee in connection with grant of patentee's request for preliminary injunction, after jury returned finding of noninfringement, as district court had discretion with respect to award of injunction bond. [Fed.Rules Civ.Proc.Rule 65\(c\), 28 U.S.C.A.](#)


Patents 291  328(1)

[291 Patents](#)

[291XIII](#) Decisions on the Validity, Construction, and Infringement of Particular Patents

[291k328](#) Patents Enumerated

[291k328\(1\)](#) k. Design. [Most Cited Cases](#) 342,528. Valid but not infringed.

Patents 291  328(2)

[291 Patents](#)

[291XIII](#) Decisions on the Validity, Construction, and Infringement of Particular Patents

[291k328](#) Patents Enumerated

[291k328\(2\)](#) k. Original Utility. [Most Cited Cases](#) [4,354,773](#). Cited as prior art.

\***1459** Nick A. Nichols, Jr., Gunn & Associates, P.C., Houston, TX, argued, for plaintiffs-appellants. [William C. Norvell, Jr.](#), Beirne, Maynard & Parsons, L.L.P., Houston, TX, argued, for defendant/cross-appellant.

Before [NEWMAN](#), Circuit Judge, [SMITH](#), Senior Circuit Judge, and [CLEVINGER](#), Circuit Judge.

[PAULINE NEWMAN](#), Circuit Judge.

Jack T. Hupp and Walkmaker, Inc. (collectively "Hupp") sued Siroflex of America, Inc. in the United States District Court for the Southern District of Texas, for infringement of [United States Design Patent No. 342,528 \(the D'528 patent\)](#) and for trade dress infringement. The jury answered special interrogatories on all disputed issues, and in accordance with these findings the court entered judgment that the [D'528 patent](#) is invalid and not infringed, that the patent is unenforceable due to inequitable conduct in the Patent and Trademark Office, and that Hupp's trade dress is functional, not inherently distinctive, and not infringed. The district court entered judgment accordingly, <sup>FN1</sup> and Hupp appeals. Siroflex cross-appeals the district court's decision not to award it the amount of the injunction bond.

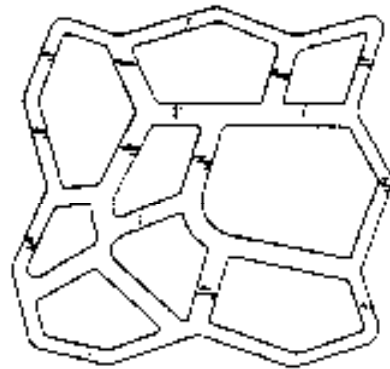
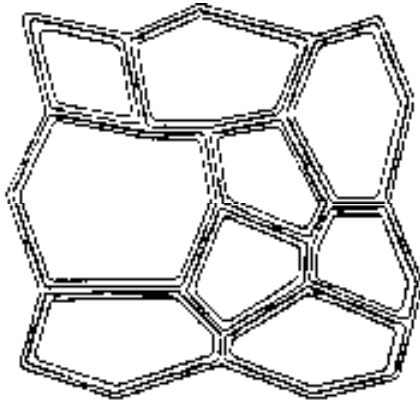
<sup>FN1</sup>. *Hupp v. Siroflex of America, Inc.*, No. G-94-007 (S.D.Tex. Feb. 8, 1995) (Final Judgment); *Hupp v. Siroflex of America, Inc.*, No. G-94-007 (S.D.Tex. Feb. 17, 1995) (Order); *Hupp v. Siroflex of America, Inc.*, No. G-94-007 (S.D.Tex. Feb. 22, 1995) (Order).

We affirm the judgment of non-infringement of the patent and the trade dress, and the ruling concerning the injunction bond. We reverse the judgment of patent invalidity and unenforceability.

I

PATENT VALIDITY

Hupp's patent is for the design of a **mold** that is used to make a simulated **stone** pathway by molding concrete. The ribs of the **mold** fix the shapes of the concrete **stones** and the spaces between the **stones**. Following are two of Hupp's **mold** designs as shown in the [D'528 patent](#):



\*1460 [1] Several grounds of patent invalidity were presented by Siroflex at trial. The judgment of invalidity must be affirmed if there was substantial evidence, on the record as a whole, to support the findings of fact needed to sustain the jury verdict, [Sun Studs, Inc. v. ATA Equipment Leasing, Inc.](#), 872 F.2d 978, 982, 10 USPQ2d 1338, 1341 (Fed.Cir.1989); [Shatterproof Glass Corp. v. Libbey-Owens Ford Co.](#), 758 F.2d 613, 225 USPQ 634 (Fed.Cir.1985), absent reversible error at trial, see [Magnivision Inc. v. Bonneau Co.](#), 115 F.3d 956, 961, 42 USPQ2d 1925, 1930 (Fed.Cir.1997).

#### A. Ornamental v. Functional Design

[2][3] To be patentable a design must be for an article of manufacture, must meet the criteria of being new, original, and ornamental, and must satisfy the other relevant requirements of [Title 35](#):

**35 U.S.C. § 171.** Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

A design or shape that is entirely functional, without ornamental or decorative aspect, does not meet the statutory criteria of a **design patent**. [L.A. Gear, Inc. v. Thom McAn Shoe Co.](#), 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed.Cir.1993). See [Lee v. Dayton-Hudson Corp.](#), 838 F.2d 1186, 1188-89, 5 USPQ2d 1625, 1627 (Fed.Cir.1988) (the **design patent** protects the non-functional aspects of

a useful article); [In re Rosen](#), 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

Although the **design patent** is directed to the ornamental aspect of a useful article, that the design of a particular article is related to the article's use may not defeat patentability. When the design is primarily ornamental, although it also serves a utilitarian purpose, this **design patent** condition is met. As explained in [Bonito Boats, Inc. v. Thunder Craft Boats, Inc.](#), 489 U.S. 141, 148, 109 S.Ct. 971, 976, 103 L.Ed.2d 118, 9 USPQ2d 1847, 1851 (1989), to qualify for **design patent** protection, a design must have an ornamental appearance that is not dictated by function alone. The jury found that the D'528 **design** was "not ornamental." Hupp argues that this finding was not supported by substantial evidence, stating that there was no evidence that this **mold** design was dictated by function alone. See also [L.A. Gear v. Thom McAn](#), 988 F.2d at 1123, 25 USPQ2d at 1917 ("An article of manufacture necessarily serves a utilitarian purpose, and the design of a useful article is deemed to be functional when the appearance of the claimed design is 'dictated by' the use or purpose of the article.") (quoting [In re Carletti](#), 51 C.C.P.A. 1094, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (1964)).

[4] Siroflex stated at trial, and repeats on appeal, that because the D'528 **mold** served a function the design was primarily functional and can not be ornamental. That is incorrect, for the fact that the article of manufacture serves a function is a prerequisite of design patentability, not a defeat thereof. The function of the article itself must not be confused with "functionality" of the design of the article. [Avia Group Int'l, Inc. v. L.A. Gear California, Inc.](#), 853 F.2d 1557, 1563, 7 USPQ2d 1548, 1553

([Fed.Cir.1988](#)) (distinguishing the functionality of the feature from the design of the feature).

[5] In determining whether the statutory requirement is met that the design is “ornamental,” it is relevant whether functional considerations demand only this particular design or whether other designs could be used, such that the choice of design is made for primarily aesthetic, non-functional purposes. [L.A. Gear v. Thom McAn, 988 F.2d at 1123-24, 25 USPQ2d at 1917](#) (“When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.”); \*[1461 In re Carletti, 51 C.C.P.A. 1094, 328 F.2d 1020, 1022, 140 USPQ 653, 654 \(1964\)](#) (determining whether the appearance is “directed by” the use of the article).

The **mold** whose design is the subject of the [D'528 patent](#) serves the function of producing a simulated rock walkway, while the particular design of the **mold** is primarily ornamental. As the prior art shows, a variety of structures and tools, including **molds**, have been used to make concrete shapes, including walkways, of various designs. Since other designs have the same general use, and the aesthetic characteristics of Hupp's design are not dictated by the function of the article, Hupp's design is primarily ornamental within the meaning of the **design patent** law. There was no significant contrary evidence. Indeed, two of Siroflex's witnesses testified that the **mold** design was ornamental. On the correct view of the law, there was not substantial evidence to support the finding that the patented design was not ornamental. Since that finding must be reversed, the judgment of invalidity can not be supported on this ground.

### **B. Anticipation**

[6] The jury answered “yes” to an interrogatory asking whether the claimed design was described in a printed publication or in public use or on sale more than a year before the patent filing date. The interrogatory did not distinguish among these three issues, each of which is a bar to a valid patent. The record shows that the printed publication part of this interrogatory was based on a newspaper advertisement for a ceramic floor tile structure whose overall design was similar, but not identical, to one of Hupp's **mold** designs, while the on-sale issue may

have been based on either the ceramic floor tile advertisement or on Hupp's submission of his idea to an invention agency, as discussed *post*.

In determining whether a **design patent** is invalid based on a description in a printed publication, [35 U.S.C. § 102\(a\)](#), the factual inquiry is the same as that which determines anticipation by prior publication of the subject matter of a utility patent; *see* [35 U.S.C. § 171](#). The publication must show the same subject matter as that of the patent, and must be identical in all material respects. The ceramic floor tile advertised in the Houston newspaper is not identical to Hupp's **mold** for a concrete walkway, and the record shows no other publication on which the jury might have relied. Thus the jury answer to this interrogatory can not be supported on the ground that Hupp's patented subject matter is anticipated by the ceramic floor tile or its advertisement.

### **C. On Sale**

[7] Turning to the “on sale” component of the same interrogatory, evidence was presented concerning Hupp's submission to the Invention Submission Corporation of sketches of various proposed **mold** designs, some of which appear in the [D'528 patent](#). Although it was debated at trial whether and what was submitted and when, the jury could have found, as a matter of credibility, that the submission was made and that this event took place more than a year before the patent's filing date.

The jury instructions described the on-sale bar as arising from “an offer for sale of the design of the **design patent**.” However, organizations that invite inventors to submit their ideas in order to obtain patent services and assistance in development and marketing are not ordinarily “customers” whereby contact with such an organization raises the on-sale bar. An inventor's quest for aid and advice in developing and patenting an invention is not an on-sale event as contemplated by [35 U.S.C. § 102\(b\)](#). The jury's “yes” can not be supported on this ground.

There was not substantial evidence to support a verdict of invalidity based on publication, public use (there was no evidence relating to any purported public use), or on-sale, more than a year before Hupp's patent application filing date. The jury's answer to this interrogatory can not stand, and thus

the judgment of invalidity can not be based thereon.

**\*1462 D. Obviousness**

[8][9] The jury held the D'528 patent to be invalid for obviousness. We review whether there was substantial evidence whereby a reasonable jury could have found the facts necessary to support this verdict. Invalidity based on obviousness of a patented design is determined on factual criteria similar to those that have been developed as analytical tools for reviewing the validity of a utility patent under § 103, that is, on application of the *Graham* factors. *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459 (1966); *L.A. Gear v. Thom McAn*, 988 F.2d at 1124, 25 USPQ2d at 1917. The determination of the ultimate question of obviousness is made from the viewpoint of a person of ordinary skill in the field of the patented design. *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1443, 221 USPQ 97, 109 (Fed.Cir.1984); *In re Nalbandian*, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981).

[10] The scope of the prior art is not the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of articles sufficiently similar that a person of ordinary skill would look to such articles for their designs. The prior art included United States Patent No. 4,354,773 to Noack, a utility patent that shows a **mold** for making simulated **stone** outdoor walkways. The Noack **mold** is the same kind of article of manufacture, and has the same use as that of Hupp—but as shown in the Noack patent it is of a different design. Other references show a variety of devices for shaping concrete into **stone**-like shapes, including **molds**, tools, and templates. None of these references shows a design similar to any of the **mold** shapes of the D'528 patent. However, a design of overall shapes quite similar to the shapes of one of Hupp's **mold** designs was shown in the ceramic tile floor advertisement discussed ante. In that product, ceramic tiles of varying colors and shapes are arranged on a fabric backing to produce sections that fit together to make a tile floor. The illustration does not show a **mold** or a molded product or simulated concrete **stones** in a walkway, but a floor tile structure.

[11] The jury found that the ceramic tile floor was a “primary reference,” defined in the jury instructions

as “having design characteristics which are ‘basically the same’ as the claimed design.” The requirement for a “primary reference” is explained in *In re Rosen*, 673 F.2d at 391, 213 USPQ at 350, as meaning that “there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness.” The correct application of this analytic approach is to ascertain whether, upon application of the *Graham* factors to the invention viewed as a whole, the same or a substantially similar article of manufacture is known to have design characteristics of which the design of the article as shown in the claim is an obvious variant. *Avia*, 853 F.2d at 1563-64, 7 USPQ2d at 1553-54. Obviousness, in turn, is determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. *In re Borden*, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed.Cir.1996) (“In order for secondary references to be considered, however, there must be some suggestion in the prior art to modify the basic design with features from the secondary references.”) (citing *L.A. Gear*, 988 F.2d at 1124, 25 USPQ2d at 1917 and *In re Rosen*, 673 F.2d at 391, 213 USPQ at 350.)

Hupp argues that a **mold** design for a concrete walkway of simulated **stones** is sufficiently different from a flooring of ceramic tiles on a fiber backing that the tile flooring can not be a primary reference. Hupp also argues that even if a reasonable jury could have viewed the ceramic flooring as a primary reference, there is no teaching or suggestion in the prior art whereby one of ordinary skill would look to flooring designs in designing a **mold** suitable for making a simulated\*1463 **stone** walkway out of concrete. Hupp argues that any similarity of **stone** shapes in the final products does not make obvious his design of a **mold** for a concrete walkway. We agree with Hupp that this step is taken only with the hindsight knowledge of Hupp's product. We have been directed to no teaching or suggestion to a person of ordinary skill to look to a floor tile construction and convert it into the design of a **mold** to make a concrete simulated **stone** outdoor walkway. That idea came from Hupp, not from the prior art. We conclude that the jury's presumed findings with respect to the *Graham* factors do not warrant the legal conclusion of obviousness.

The judgment of invalidity is reversed.

II

PATENT INFRINGEMENT

Siroflex's president conceded at the trial that he acquired a sample of the Hupp product at a trade

show and, using the same concept, made the accused Siroflex **mold** for an outdoor walkway of concrete **stones**. The Siroflex position was that its **mold** design was sufficiently changed to avoid infringement. Siroflex pointed out that the use of such **molds** is known in the art, citing the Noack reference, and that the Siroflex **mold** design is different:



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A

[12] The jury found that Siroflex did not infringe the D'528 patent. Hupp argues that the verdict arose from a misleading jury instruction, as follows:

Siroflex of America, Inc. would be liable for infringing Plaintiffs' patent if you find that Plaintiffs have proven by a preponderance of the evidence that Siroflex has used or sold products made according to the design claimed in Plaintiffs' patent *and that Plaintiffs' patent is valid.*

(Emphasis added.) Hupp states that when the jury held the patent invalid, the instruction left the jury no choice but to find non-infringement.

[13] In retrospect, the construction of this instruction is not optimum. Although it is of course a correct statement of law, a jury might have been uncertain as to how to respond, depending on how these issues were presented at trial and argued by counsel.

However, Hupp does not state that he raised this objection when the instruction was given, or that he sought clarification of the verdict before the jury was dismissed. See [Pan Eastern Exploration Co. v. Hufo Oils](#), 855 F.2d 1106, 1124 (5th Cir.1988) (“It seems likely that in the case of a potentially ambiguous general verdict all the complaining party must do to protect his rights is to object to the charge and the submission vel non of the questionable theory or theories; probably he \*1464 need not object to the ambiguity inherent in its submission....”)<sup>FN2</sup>

<sup>FN2</sup>. On matters not the exclusive appellate assignment of the Federal Circuit, we look to the law and practices of the circuit of trial. See [National Presto Indus., Inc. v. West Bend Co.](#), 76 F.3d 1185, 1188 n. 2, 37 USPQ2d 1685, 1686 n. 2 (Fed.Cir.1996).

The now-asserted ambiguity would surely have been apparent when the jury returned its special verdicts of both invalidity and noninfringement. The time to clarify the verdicts, if Hupp was in doubt, was immediately. See [Unit Drilling Co. v. Enron Oil & Gas Co.](#), 108 F.3d 1186 (10th Cir.1997) (“In *Resolution Trust*, we distinguished questioning that is

aimed at discovering what occurred during deliberations, which is prohibited by [Fed.R.Evid. 606\(b\)](#), from questioning aimed at clarifying the verdict, of which we approved.”) The Fifth Circuit permits resubmission of ambiguous or conflicting jury verdicts for clarification. See [Nance v. Gulf Oil Corp.](#), 817 F.2d 1176, 1178 (5th Cir.1987) (“[I]t has long been established in this Circuit that inconsistent special verdict answers may be resubmitted to a jury for clarification of the inconsistency.”)

Any absence of precision in the verdict, flowing directly from absence of precision in the question presented for verdict, has only extremely rarely been remedied by granting a new trial, and then only when the interest of justice plainly so required and a different result would have been likely to ensue. In [Rodrigue v. Dixilyn Corp.](#), 620 F.2d 537, 541 (5th Cir.1980), the court explained that to reverse or vacate a jury verdict for which there was substantial evidentiary support, based on an erroneous or unclear instruction to which no objection was made, “the plaintiff must establish that the instruction was an incorrect statement of law and that it was probably responsible for an incorrect verdict, leading to substantial injustice.”

In this case, the jury found that there was not infringement. If deemed ambiguous the answer could have been clarified, but was not. Although the Fifth Circuit leaves room for the appellate remedy of ordering a new trial when the interest of justice requires, the standards therefor were not here met. The instruction was not an incorrect statement of law, although it bore a potential for ambiguity. Whether the jury would have decided differently on a more precise instruction is indeed speculative, for there was substantial evidence on which the jury could have reached a verdict of non-infringement, as we discuss in Part B *post*. Although clarification was possible at the trial, that remedy is not available when the issue is raised for the first time on appeal. In these circumstances, it is inappropriate to order a new trial.

#### B

[14] A **design patent** contains no written description; the drawings are the claims to the patented subject matter. To infringe a **design patent** the accused article must appropriate the features of the patented design and its overall appearance. [L.A. Gear v. Thom](#)

[McAn](#), 988 F.2d at 1125, 25 USPO2d at 1918; [Litton v. Whirlpool](#), 728 F.2d at 1444, 221 USPO at 109. Infringement is determined from the viewpoint of the ordinary observer, whereby the observer would be led to believe that the article of one producer is that of another because of their similarity in design. [Gorham Co. v. White](#), 81 U.S. (14 Wall.) 511, 528, 20 L.Ed. 731 (1871).

[15] Hupp points to the similar appearance of the Siroflex and his patented articles and their overall effect including size and shape, as well as the similarity of the **mold** designs. Although the design of articles having the identical use need not be identical in order to infringe the patent, see [Gorham](#), 81 U.S. at 530 (“[T]hough variances in the ornament are discoverable, the question remains, is the effect of the whole design substantially the same?”), the designs must be sufficiently similar that a purchaser would be deceived into buying one article thinking it was the other. *Id.* at 528; [Avia](#), 853 F.2d at 1565, 7 USPO2d at 1554. There was substantial evidence at trial of the differences as well as the similarities between the D'528 **mold** design \*1465 and the Siroflex **mold** design. Although there was some evidence of consumer confusion, a reasonable jury could have found that the Siroflex **mold** design was not substantially the same and did not have substantially the same effect, and did not infringe the D '528 [patent](#).

The judgment of non-infringement is affirmed.

### III

#### INEQUITABLE CONDUCT

[16][17][18] The issue of inequitable conduct during prosecution of the D'528 [patent](#) in the Patent and Trademark Office was presented to the jury. Trial courts have followed a variety of procedures for determining this issue during a jury trial. For example, in [Modine Mfg. Co. v. Allen Group, Inc.](#), 917 F.2d 538, 542, 16 USPO2d 1622, 1625 (Fed.Cir.1990) the question of inequitable conduct was submitted for jury verdict with the agreement of the parties, whereas in [General Electro Music Corp. v. Samick Music Corp.](#), 19 F.3d 1405, 1408, 30 USPO2d 1149, 1151 (Fed.Cir.1994), only the factual questions of materiality and intent to deceive were submitted for jury findings. On appeal of a jury

verdict of inequitable conduct, we review the proceedings to determine whether there was substantial evidence supporting actual or inferred findings of the factual questions of (1) whether there was withholding of information material to patentability, (2) with the intent to deceive or mislead the patent examiner. In order to establish inequitable conduct it was necessary for Siroflex to establish these facts by clear and convincing evidence. See [Kingsdown Medical Consultants, Ltd. v. Hollister Inc.](#), 863 F.2d 867, 876, 9 USPQ2d 1384, 1392 (Fed.Cir.1988) (*en banc*) (both materiality and culpable intent must be proved). Only when the facts of materiality and intent are established does the decisionmaker exercise its discretion to decide whether, considering all the circumstances, inequitable conduct shall be found. [Modine Mfg. Co.](#), 917 F.2d at 542, 16 USPQ2d at 1625.

[19] Two areas of assertedly withheld information were presented at trial: (1) the Houston newspaper advertisement of the ceramic floor tile and (2) Hupp's correspondence with the invention submission agency. The verdict form did not ask the jury to state the basis of its verdict. We look first at the evidence based on the newspaper advertisement. Siroflex argued at trial that Hupp must have known of the newspaper advertisement, despite his denials, because it was published at about the time of Hupp's development and because the **stone** shapes are quite similar. Siroflex argued that the advertisement was material to patentability and that Hupp withheld it with intent to deceive the examiner into granting the patent. Hupp argued that it is irrelevant whether he saw the ad, because his invention is the design of a plastic **mold** for a concrete walkway, and that a person of ordinary skill would not view the ceramic tile floor as material to the patentability of a concrete **mold** design. Thus Hupp argued that materiality was not shown by clear and convincing evidence, and that a reasonable jury would not have found otherwise.

As discussed *ante*, the ceramic floor tile is not analogous prior art. As such, it is not material to the patentability of Hupp's design, and the failure to submit the tile advertisement to the Patent Office cannot support a judgment of inequitable conduct.

Intent is an independent element of inequitable conduct in patent prosecution, and must be separately established. [Allied Colloids, Inc. v. American](#)

[Cyanamid Co.](#), 64 F.3d 1570, 1578, 35 USPQ2d 1840, 1845 (Fed.Cir.1995). As discussed in *Kingsdown*, a finding of culpable intent requires evidentiary support, for "the involved conduct, viewed in light of all the evidence, including evidence indicative of good faith, must indicate sufficient culpability to require a finding of intent to deceive." 863 F.2d at 876, 9 USPQ2d at 1392. Assuming that the jury believed that Hupp knew of the floor tile, or even was inspired thereby, knowledge or inspiration does not establish that it was culpably withheld, especially when, as here, the \*1466 undisclosed reference is not material to patentability. See [Allen Organ Co. v. Kimball Int'l, Inc.](#), 839 F.2d 1556, 1568, 5 USPQ2d 1769, 1779 (Fed.Cir.1988) ("knowledge alone is not culpable intent"). Although there may be special circumstances in which intent is appropriately deemed established by inference alone, there must be sufficient evidence to support such inference. See [Northern Telecom, Inc. v. Datapoint](#), 908 F.2d 931, 939, 15 USPQ2d 1321, 1327 (Fed.Cir.1990) ("Given the ease with which a relatively routine act of patent prosecution can be portrayed as intended to mislead or deceive, clear and convincing evidence of conduct sufficient to support an inference of culpable intent is required."); *Kingsdown*, 863 F.2d at 876, 9 USPQ2d at 1392 ("[A] finding that particular conduct amounts to 'gross negligence' does not of itself justify an inference of intent to deceive; the involved conduct, viewed in light of all the evidence, including evidence indicative of good faith, must indicate sufficient culpability to require a finding of intent to deceive.")

There was not substantial evidence of record whereby a reasonable jury could have found, by clear and convincing evidence, the facts necessary to support a holding of inequitable conduct. This verdict can not be sustained based on the Houston newspaper advertisement.

[20] At trial Siroflex argued that Hupp should have told the patent examiner of his submission to the Invention Submission Corporation more than a year before the patent filing date. As discussed in Part I, this was not an on-sale event. Siroflex told the jury that even if the submission were not an on-sale event, it should have been presented to the patent examiner so that the examiner could decide whether it was.

There is no obligation to present the examiner with information that is not material to patentability, on pain of loss of patent rights based on inequitable conduct. The requirement, as clarified in *Kingsdown*, is that information that is known to be material to patentability can not be intentionally withheld from the examiner. Since the correspondence with the Invention Submission Corporation could reasonably have been believed not to start an on-sale bar, and since there was no evidence whatsoever of culpable intent in not telling the patent examiner of this correspondence, the verdict of inequitable conduct can not be sustained on this ground.

Absent sufficient evidentiary basis, the judgment of unenforceability based on inequitable conduct is reversed.

#### IV

#### TRADE DRESS INFRINGEMENT

[21] Trade dress is the packaging and general presentation of a product. [\*Blue Bell Bio-Medical v. Cin-Bad, Inc.\*, 864 F.2d 1253, 1256, 9 USPQ2d 1870, 1872 \(5th Cir.1989\)](#) (“The ‘trade dress’ of a product is essentially its total image and overall appearance.”)

Hupp packages its **mold** in a cardboard sleeve with the ends of the **mold** protruding so that a portion is visible to the customer. On the cardboard sleeve is prominently illustrated a **stone** walkway constructed using the **mold**, and instructions for use. The trademark “WalkMaker” appears in large letters. The Siroflex **mold** is also packaged in a cardboard sleeve with the ends of the **mold** protruding and visible to the customer. On the cardboard sleeve is prominently shown a **stone** walkway, and instructions for using the **mold**. The Siroflex sleeve displays the trademark “Rock ‘N’ **Mold**” in large letters. The packages are of similar size and shape.

[22] The jury was instructed that Hupp must establish that his “trade dress is inherently distinctive, non-descriptive and non-functional,” on the following criteria:

If Plaintiffs' trade dress has a useful function, for example, if it primarily consists of instructions and descriptive matter on how to use the product, or

pictorial diagrams of the product's results, then Plaintiffs' trade dress is functional and not entitled to protection. You may also find that Plaintiffs' \*1467 trade dress is functional if it is one of a limited number of options of design available to competitors of Plaintiffs and the competition would be unduly hindered by affording protection to the Plaintiffs' trade dress. On the other hand, if you find that Plaintiffs' trade dress is primarily arbitrary, fanciful, or suggestive and is solely for the purpose of identification and individuality, then you may find that Plaintiffs' trade dress is nonfunctional.

Hupp does not state that he objected to these instructions.

The jury found by special verdicts that the trade dress for Hupp's package was (1) functional, and (2) not inherently distinctive. Hupp now argues that the instructions do not correctly state Fifth Circuit law, that it is not necessary that the packaging be “solely for the purpose of identification and individuality” to be nonfunctional, and that the presence of descriptive text does not convert a distinctive trade dress into one that is functional. We agree that the instructions that were given did not stress that a distinctive combination of functional features may comprise a distinctive trade dress, *see generally Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992). However, Hupp did not preserve this objection to the jury instructions. Thus although the Fifth Circuit has explained that the variety of available packaging styles weighs against copying a competitor's packaging, *e.g.*, [\*Sicilia Di R. Biebow & Co. v. Cox\*, 732 F.2d 417, 427 n. 7 \(5th Cir.1984\)](#), the objection that is now made to the instruction must be deemed waived.

[23] Hupp argues that the evidence of confusing similarity between the packages was strong, and that the jury findings that his trade dress is functional and not inherently distinctive are unsupported by substantial evidence. He stresses that his trade dress was copied by Siroflex. Siroflex, in turn, points to the conflicting evidence before the jury on the issue of likelihood of confusion, to the opposing expert opinions, to the absence of objection by Hupp to the jury instructions that he now challenges, and to the full exposition of this factual issue at trial.

Both sides' packages were present as exhibits at trial.

Giving appropriate weight to the jury's opportunity to observe the actual trade dress of both parties, and recognizing the factual areas of conflict in the evidence, we conclude that on the instructions at trial there was substantial evidence to support the jury verdict. The verdict of non-infringement of trade dress must be affirmed.

V

#### HUPP'S SECURITY BOND

[24] Hupp's pre-trial request for a preliminary injunction had been granted, and Hupp was required to post a \$10,000 bond pursuant to [Fed.R.Civ.P. 65\(c\)](#), which provides:

**65(c) Security.** No restraining order or preliminary injunction shall issue except upon the giving of security by the applicant, in such sum as the court deems proper, for the payment of such costs and damages as may be incurred or suffered by any party who is found to have been wrongfully enjoined or restrained.

After entering judgment in favor of Siroflex the district court declined to award the bonded amount, stating that Siroflex was "trying to 'gild the lily.'" Siroflex argues on appeal that its injury from the injunction exceeded the amount of the bond, and that it is entitled to the amount of the bond.

To determine the scope of the trial court's discretion with respect to award of an injunction bond, we look to the law of the regional circuit, for this issue is not unique to the Federal Circuit's exclusive assignment. The Fifth Circuit does not make automatic the award of the amount of the injunction bond. In [H & R Block, Inc. v. McCaslin](#), 541 F.2d 1098, 1099 (5th Cir.1976) the court held that the district court was within its discretion in declining to award the injunction bond unless the plaintiff acted in bad faith in obtaining \*1468 the preliminary injunction. Although this ruling has been criticized in some other circuits, e.g., [Coyne-Delany Co. v. Capital Dev. Bd.](#), 717 F.2d 385, 391 (7th Cir.1983), and has not been universally applied in the Fifth Circuit, *H & R Block* has not been overruled. Precedent clearly gave the trial court the discretion that was here exercised. This ruling is affirmed.

No costs.

*AFFIRMED IN PART AND REVERSED IN PART.*

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