

Design Patent Case Digest

Z Produx, Inc. v. Make-Up Art Cosmetics, Inc.



Decision Date: November 5, 2013

Court: Central District of California

Patents: [D642, 743](#)

Holding: Make-Up Art Cosmetics' motion for summary judgment of non-infringement is GRANTED

Opinion:

Plaintiff Z Produx, Inc. sued Make-Up Art Cosmetics, Inc. ("MAC") for infringement of U.S. Design Patent D642, 743.

The '743 patent depicts a cosmetic palette with a clear top window and an empty base. The palette has a book-like appearance, with a flat spine and sides that extend beyond the middle part of the palette. It also has a relatively wide rim framing the clear window. Z Produx, the owner of the '743 patent, sells a cosmetic palette called the [Z Palette](#). The Z Palette resembles the design of the '743 patent and is marked as being covered by the '743 patent.

MAC also sells a [cosmetic palette](#) with an empty base and a clear top window. MAC's palette, however, has flush edges, a triangle-shaped hinge, and a narrow rim framing the window.

MAC moved for summary judgment of non-infringement. MAC also moved, in the alternative, for summary judgment of patent invalidity.

Non-Infringement

The court began infringement analysis by determining the scope of the '743 patent. Design patents protect only ornamental features of the design. [OddzOn Products, Inc. v. Just Toys, Inc.](#), 122 F.3d 1396, 1404-05 (Fed. Cir. 1997). If a design patent contains both ornamental and functional elements, the functional elements must be factored out. [Richardson v. Stanley Works, Inc.](#), 597 F.3d 1288, 1293 (Fed. Cir. 2010). Thus, critical to the claim construction of the '743 patent, the court reasoned, is whether the clear top and the empty base of the design are ornamental or functional.

Z Produx argued that the clear window and the empty base are not functional because other palettes are designed without the same features and are able to function as cosmetic palettes. The court disagreed, noting that Z Produx's argument mistakenly focused on the functionality of the device as a whole, rather than the functionality of the individual features.

The court analogized to the Federal Circuit's reasoning in *OddzOn*, in which the court held that the tails and fins of a tossing ball design are functional and not protected by the design patent at issue *Id.* at 1406. The Federal Circuit reasoned that while a tail and fins are not necessary in every tossing ball design, the features are “no less functional simply because ‘tossing balls’ can be designed without them.” *Id.* The tails and fin were deemed functional because they add functionality to the design of the patent at issue. *Id.* Similarly, here, the district court reasoned that the clear top and empty base are functional because they add functionality to the '743 design, even though they are not necessary in every cosmetic palette. The court noted three things evidencing functionality. First, Z Produx emphasized the functionality of the features. Z Produx stated that consumers like the Z Palette because it allows customers to see through the window and customize the palette. Second, the window and the empty base are essential to the functionality they provide. A clear cover is the only way to enable a user to view the palette's contents without opening it and an empty base is the only way to allow users to customize the palette's contents. Third, these identical features are protected by a utility patent.

After factoring out the clear window and empty base, the court found that the MAC palette does not infringe the '743 patent. The court held that an ordinary observer would not be deceived into believing that the MAC palette is the same as the '743 design because the MAC palette has an overall slimmer and non-book-like appearance.

Public Use

The court also held that the patent is valid. Under [35 U.S.C. 102\(b\)](#), a patent is invalid if the invention was in public use more than one year before the filing date of the application. MAC argued that the '743 patent is invalid because a [photograph](#) of the Z Palette was included in a trademark application filed on February 12, 2009, more than one year before the filing of the '743 patent application.

The court disagreed. Prior art must be enabling. Photographs may be sufficiently enabling if they “show all the claimed structural features and how they are put together.” MPEP § [2125](#) (citing [Jockmus v. Leviton](#), 28 F.2d 812 (2d Cir. 1928)). The court held that the picture in the trademark application is not enabling because it only shows a top view of the palette. With the exception of the width of the palette's rim, the photograph does not depict other elements protected by the '743 design. Thus, the court denied MAC's summary judgment motion of invalidity.

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

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