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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

PERFORMANCE DESIGNED
PRODUCTS LLC,

Plaintiff,

v.

MAD CATZ, INC. a Delaware
corporation; and DOES 1-10,
inclusive,

Defendants.

CASE NO. 16cv629-GPC(RBB)

**ORDER GRANTING
DEFENDANT’S MOTION TO
DISMISS**

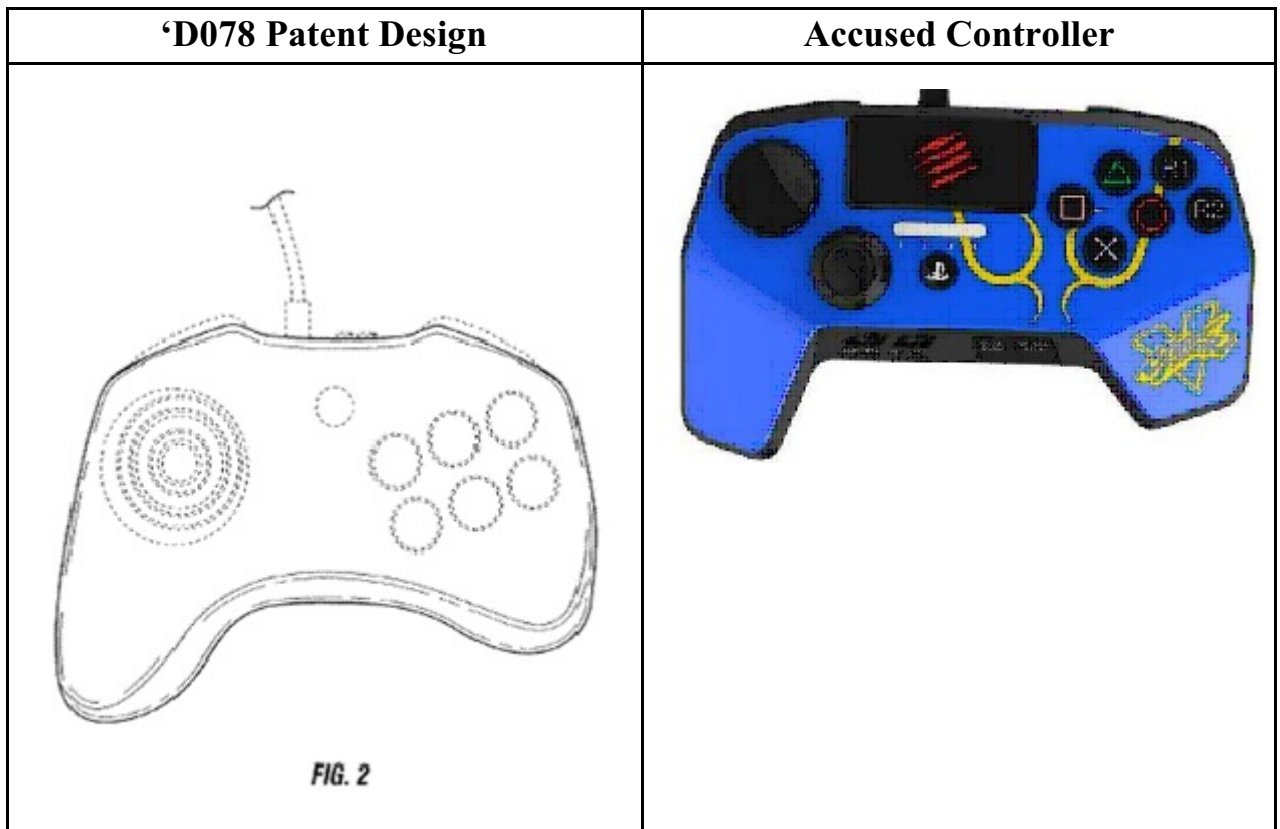
[Dkt. No. 14.]

Before the Court is Defendant’s motion to dismiss the complaint for failing to state a claim. (Dkt. No. 14.) An opposition and reply were filed. (Dkt. Nos. 16, 17.) The Court finds the matter suitable for resolution without oral argument pursuant to Local Civil Rule 7.1(d)(1). After a review of the complaint, briefing by the parties, and the applicable law, the Court GRANTS Defendant’s motion to dismiss with prejudice.

Background

Plaintiff Performance Designed Products LLC (“PDP”) is a company, based in Burbank, California, that designs and manufactures video game accessories. (Dkt. No. 1, Compl. ¶ 8.) PDP has been providing video game accessories to the world market for over a decade. (Id.) PDP is an innovator in the field of video game accessories and holds multiple patents, including ‘D078, a design patent (“D078 Patent Design”). (Id.; Ex. A.)

1 Defendant Mad Catz, Inc. (“Mad Catz”) is a worldwide provider of video game
2 accessories and sells its products throughout the United States, including California.
3 (Id. ¶ 9.) According to the Complaint, Mad Catz sells the “Fight Pad Pro Controller”
4 (“Accused Controller”), which infringes the ‘D078 Patent. (Id. ¶ 10.)



21 PDP claims that Mad Catz’s Fight Pad Pro Controller has an overall appearance
22 that is confusingly similarly and substantially the same, in view of the prior art and in
23 the eyes of an ordinary observer. (Id. ¶ 11.) PDP alleges one cause of action for
24 infringement of design patent ‘D078 pursuant to 35 U.S.C. § 271(a). Mad Catz now
25 moves to dismiss the Complaint pursuant to Federal Rule of Civil Procedure 12(b)(6).

26 Discussion

27 A. Legal Standard on Federal Rule of Civil Procedure 12(b)(6)

28 Federal Rule of Civil Procedure (“Rule”) 12(b)(6) permits dismissal for “failure

1 to state a claim upon which relief can be granted.” Fed. R. Civ. P. 12(b)(6). Dismissal
2 under Rule 12(b)(6) is appropriate where the complaint lacks a cognizable legal theory
3 or sufficient facts to support a cognizable legal theory. See Balistreri v. Pacifica Police
4 Dep’t., 901 F.2d 696, 699 (9th Cir. 1990). Under Rule 8(a)(2), the plaintiff is required
5 only to set forth a “short and plain statement of the claim showing that the pleader is
6 entitled to relief,” and “give the defendant fair notice of what the . . . claim is and the
7 grounds upon which it rests.” Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 555
8 (2007).

9 A complaint may survive a motion to dismiss only if, taking all well-pleaded
10 factual allegations as true, it contains enough facts to “state a claim to relief that is
11 plausible on its face.” Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (quoting Twombly,
12 550 U.S. at 570). “A claim has facial plausibility when the plaintiff pleads factual
13 content that allows the court to draw the reasonable inference that the defendant is
14 liable for the misconduct alleged.” Id. “Threadbare recitals of the elements of a cause
15 of action, supported by mere conclusory statements, do not suffice.” Id. “In sum, for
16 a complaint to survive a motion to dismiss, the non-conclusory factual content, and
17 reasonable inferences from that content, must be plausibly suggestive of a claim
18 entitling the plaintiff to relief.” Moss v. U.S. Secret Serv., 572 F.3d 962, 969 (9th Cir.
19 2009) (quotations omitted). In reviewing a Rule 12(b)(6) motion, the Court accepts as
20 true all facts alleged in the complaint, and draws all reasonable inferences in favor of
21 the plaintiff. al-Kidd v. Ashcroft, 580 F.3d 949, 956 (9th Cir. 2009).

22 Where a motion to dismiss is granted, “leave to amend should be granted ‘unless
23 the court determines that the allegation of other facts consistent with the challenged
24 pleading could not possibly cure the deficiency.’” DeSoto v. Yellow Freight Sys., Inc.,
25 957 F.2d 655, 658 (9th Cir. 1992) (quoting Schreiber Distrib. Co. v. Serv-Well
26 Furniture Co., 806 F.2d 1393, 1401 (9th Cir. 1986)). In other words, where leave to
27 amend would be futile, the Court may deny leave to amend. See Desoto, 957 F.2d at
28 658; Schreiber, 806 F.2d at 1401.

1 **B. Design Patent Infringement**

2 Plaintiff owns a design patent, ‘D078, which claims an “ornamental design for
3 an asymmetrical game controller”, (Dkt. No. 1-2, Compl., Ex. A), and claims that the
4 Accused Controller infringes its design patent.

5 A “design patent, unlike a utility patent, limits protection to the ornamental
6 design of the article.” Richardson v. Stanley Works, Inc., 597 F.3d 1288, 1293 (Fed.
7 Cir. 2010) (citation omitted). It protects the “novel, ornamental features of the patented
8 design.” OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997)
9 (citing KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc., 997 F.2d 1444, 1450
10 (Fed. Cir. 1993) (design patent protects the “non-functional aspects of an ornamental
11 design as shown in a patent.”)).

12 The Federal Circuit in Egyptian Goddess, abandoned the prior “point of novelty”
13 test in the analysis of a claim of design patent infringement. Egyptian Goddess, Inc. v.
14 Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008) Rather, the court held that the
15 “ordinary observer” test would be the sole test for determining whether a design patent
16 has been infringed. Id. Under the “ordinary observer” test, infringement will not be
17 found unless the accused article “embod[ies] the patented design or any colorable
18 imitation thereof.” Id. (quoting Good Year Tire & Rubber Co., 162 F.3d 1113, 1116-
19 17 (Fed. Cir. 1998)). An accused product infringes a design patent when “an ordinary
20 observer, familiar with the prior art designs, would be deceived into believing that the
21 accused product is the same as the patented design.” Crocs, Inc. v. Int’l Trade
22 Comm’n, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (citing Egyptian Goddess, Inc., 543
23 F.3d at 681). The Federal Circuit explained that in some cases, “the claimed design
24 and the accused design will be sufficiently distinct that it will be clear without more
25 that the patentee has not met its burden of proving the two designs would appear
26 ‘substantially the same’ to the ordinary observer.” Egyptian Goddess, Inc., 543 F.3d
27 at 678. In other cases, “when the claimed and accused designs are not plainly
28 dissimilar, resolution of the question whether the ordinary observer would consider the

1 two designs to be substantially the same will benefit from a comparison of the claimed
2 and accused designs with the prior art.” Id. When a hypothetical ordinary observer is
3 conversant with the prior art, “the differences between the claimed and accused designs
4 that might not be noticeable in the abstract can become significant.” Id.

5 The “ordinary observer” test involves a two tiered approach. The threshold
6 question is whether, “without review of the prior art, the claimed and accused designs
7 are sufficiently similar and, if so, the next level entailing a comparison to the prior art.”
8 Great Neck Saw Mfgs., Inc. v. Star Asia U.S.A., LLC, 727 F. Supp. 2d 1038, 1051-52
9 (W.D. Wash. 2010); see also Anderson v. Kimberly-Clark Corp., 570 F. App’x 927,
10 933-34 (Fed. Cir. 2014) (affirming district court’s granting defendant’s motion for
11 judgment on the pleadings and reviewing the two tiered analysis of the district court);
12 Wing Shing Prods. (BVI) Co. Ltd. v. Sunbeam Prods., Inc., 665 F. Supp. 2d 357, 365
13 (S.D.N.Y. 2009) (two level infringement analysis involves “a level-one or ‘threshold’
14 analysis to determine if comparison to the prior art is even necessary, and a second
15 level analysis that accounts for prior art in less obvious cases.”) In conducting its
16 analysis, the court conducts a side-by side visual comparison. See Crocs, 598 F.3d at
17 1306-07; Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312, 1335 (Fed. Cir.
18 2015).

19 “Differences . . . must be evaluated in the context of the claimed design as a
20 whole, and not in the context of separate elements in isolation.” Ethicon Endo-
21 Surgery, Inc., 796 F.3d 1312, 1335 (Fed. Cir. 2015). “It is the appearance of a design
22 as a whole which is controlling in determining infringement. There can be no
23 infringement based on the similarity of specific features if the overall appearance of the
24 designs are dissimilar.” OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405
25 (Fed. Cir. 1997).

26 In Ethicon, the Federal Circuit agreed with the district court that the claimed and
27 accused designs of an ultrasonic surgical device were plainly dissimilar and noted that
28 the most notable difference was the “the overall contoured shape” of the claimed

1 design and the “overall linear shape” of the accused design and went on to discuss
2 differences in the ornamentation of the trigger, torque knob and button elements of
3 both designs. Id. at 1336.

4 “[M]inor differences between a patented design and an accused article’s design
5 cannot, and shall not, prevent a finding of infringement.” Litton Sys., Inc. v. Whirlpool
6 Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984). But “[w]here the claimed and accused
7 designs are ‘sufficiently distinct’ and ‘plainly dissimilar,’ the patentee fails to meet its
8 burden of proving infringement as a matter of law.” Ethicon Endo-Surgery, Inc., 796
9 F.3d at 1335.

10 **1. Side-by-Side Comparison of ‘D078 Patent and Accused Controller**

11 Mad Catz contends that in a side-by-side view comparison between the Accused
12 Controller and the ‘D078 Patent Design, the designs are not “substantially similar” but
13 “plainly dissimilar” because the Accused Controller lacks the most prominent
14 ornamental features, and does not remotely resemble the ‘D078 Patent Design.

15 In response, PCP argues that Mad Catz improperly focuses on minor and trivial
16 differences between the ‘D078 Patent Design and the Accused Controller and fails to
17 look at the overall similarity between the two designs. PCP asserts that both designs
18 share the following overall similarities that strongly support a finding of infringement.

19 These are:

- 20 • the controllers are both significantly asymmetric in design;
- 21 • the left handgrip extends farther from the body of the controller
than the right handgrip;
- 22 • both handgrips gradually taper to a blunt ending;
- 23 • the taper of the left handgrip is more gradual than the taper of
the right hand grip; and
- 24 • the body of the controller outside of the handgrips is
substantially trapezoidal with straight edges meeting at rounded
25 corners and an indentation at the top of the controllers where the
controller connects to a cord to the video game console.

26 (Dkt. No. 16 at 9¹.) These similarities focus on the general asymmetric design and the
27 trapezoidal shape of the body.

28 ¹Page numbers are based on the CM/ECF pagination.

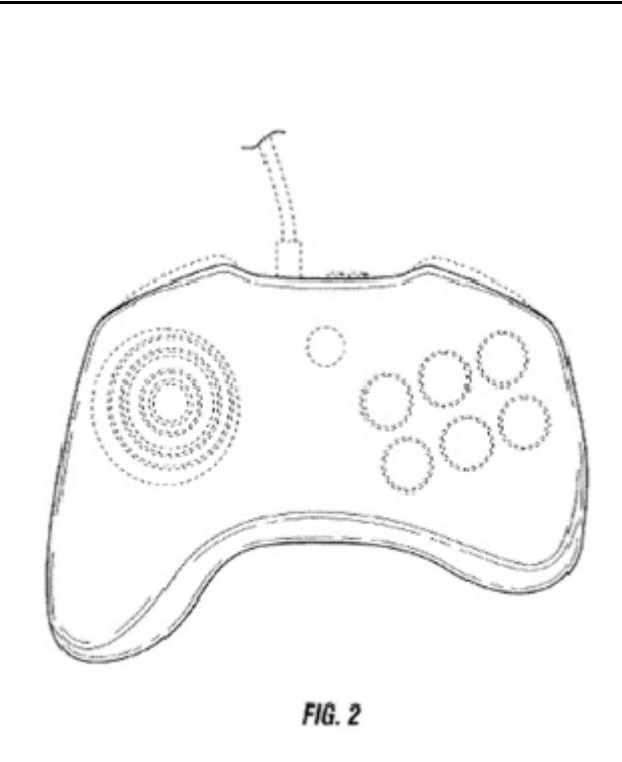

1 In Payless, the Federal Circuit noted that the district court improperly articulated
2 only one difference between the two different footwear designs in the heel pieces as
3 opposed to the entirety of the patented design. Payless Shoesource, Inc. v. Reebok
4 Intern'l Ltd., 998 F.2d 985, 990 (Fed. Cir. 1993). By noting only one difference in the
5 heel, the Federal Circuit held that the district court erred by failing to “consider the
6 ornamental aspects of the design as a whole and not merely isolated portions of the
7 patented design.” Id. at 991.

8 In a case cited by PDP, Internat'l Seaway Trading Corp. v. Walgreens Corp., 589
9 F.3d 1233, 1243 (Fed. Cir. 2009), involving casual, lightweight footwear also known
10 as clogs, the district court concluded that “slight variations on the number and position
11 of the circular holes on the top of the shoe, the rectangular holes on the toe of the shoe
12 as well as the design of different shaped rectangles on the sole of the shoe” are minor
13 and should not be considered as part of the overall comparison, for purposes of
14 anticipation and applying the ordinary observer test. Id. at 1243. “The mandated
15 overall comparison is a comparison taking into account significant differences between
16 the two designs, not minor or trivial differences that necessarily exist between any two
17 designs that are not exact copies of one another.” Id.

18 In another case involving a design patent for cellular telephone handsets, the
19 Federal Circuit affirmed the district court’s grant of summary judgment of non-
20 infringement. Kyocera Wireless Corp., v. President Elecs., Ltd., 116 F. App’x 282,
21 284-85 (Fed. Cir. 2004). The differences noted by the district court between one of the
22 accused products and the claimed designed was that the accused products “do not have
23 as pronounced a curvature, have additional buttons, taller screens, and different arrays
24 of holes in the earpiece.” Id. at 285.

25 After a side-by-side comparison of the Accused Controller and the ‘D078 Design
26 Patent, the Court concludes that, viewing the overall differences, the two designs are
27 not “substantially the same” and an ordinary observer would not be deceived into
28 believing that the accused product is the same as the patented design. See Egyptian

1 Goddess, Inc., 543 F.3d at 678. As a starting point, a notable difference between the
 2 two designs is that the ‘D078 Patent Design is curved and rounded without angles
 3 while the Accused Controller is straight and squared with many angles giving it a boxy
 4 look. The Court now addresses the additional overall differences between the two
 5 designs from the different views as presented in the ‘D078 Design Patent.²

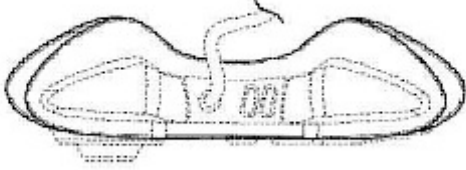
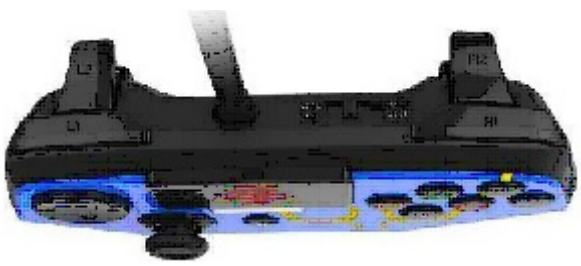
Front Elevational View	
‘D078 Patent Design	Accused Controller
 <p style="text-align: center;">FIG. 2</p>	

22 The face surface of the ‘D078 Design Patent is flat, level, and has a uniform

23
 24 ²These views are copied from Mad Catz’ moving papers as they were able to be
 25 copied for the Court’s use in its order and these pictures in Mad Catz’ moving papers
 26 come from the ‘D078 Design Patent attached to the Complaint as Exhibit A, (Dkt. No.
 27 1-2 at 2), and photographs of the Accused Controller attached to the Marshall
 28 Declaration as Exhibit C. (Dkt. No. 14-5, Marshall Decl., Ex. C.). The parties do not
 dispute that the Court may consider the photographs that are not attached to the
 Complaint and consider them on a motion to dismiss. See Andersen v. Kimberly-Clark
 Corp., 570 F. App’x 927, 932 (9th Cir. 2014) (no error by district court relying on
 patent, the prior art publication and photographs of the accused product attached to
 defendant’s motion as they were all central to the complaint of design patent
 infringement and authenticity had not been called into question).



1 plane. The sides of the ‘D078 Design Patent slowly indent inward in a straight line
 2 from bottom to top. In contrast, the face of the Accused Controller slopes down at an
 3 angle from the upper portions to the handgrips. The sides of the Accused Controller
 4 slopes outward until an angled point at the middle that alters the direction inward.

5 In addition, the handgrips of the ‘D078 Design Patent both extend from the body,
 6 with the left handgrip extension longer than the right handgrip. Also, the left and right
 7 handgrips of the ‘D078 Design Patent come to a rounded, egg-shaped curved arc. The
 8 underneath portion of the left and right handgrips are bulbous and the inner portions
 9 of both handgrips are curved and rounded. As to the Accused Controller, the extension
 10 of the left handgrip is longer than the right handgrip similar to the ‘D078 Design
 11 Patent; however, the left and right handgrips of the Accused Controller are straight
 12 with edges and right angles and square-like features. Moreover, the underneath and
 13 inner portion of the left and right handgrips are flat and straight.

Top Plan View	
‘D078 Design Patent	Accused Controller
 <p data-bbox="565 1459 620 1486">FIG. 6</p>	

24 Starting from the left side, the top side of the ‘D078 Patent inclines upward, and
 25 then it curves downward and inward to form an indentation, and then curves upward
 26 and then declines to the end of the right side while the top side of the Accused
 27 Controller follows a straight path across the top of the body with a slight indentation
 28

1 or angle on the top side.³

Bottom Side/Bottom Plan View	
'D078 Design Patent	Accused Controller
 <p>FIG. 7</p>	

11 The bottom line of the 'D078 Patent is arched and curves from the left handgrip
12 to the right. In contrast, the bottom line of the Accused Controller does not curve but
13 creates sharp angles from the left, then continues straight in a flat line, and then creates
14 another sharp angle on the right.

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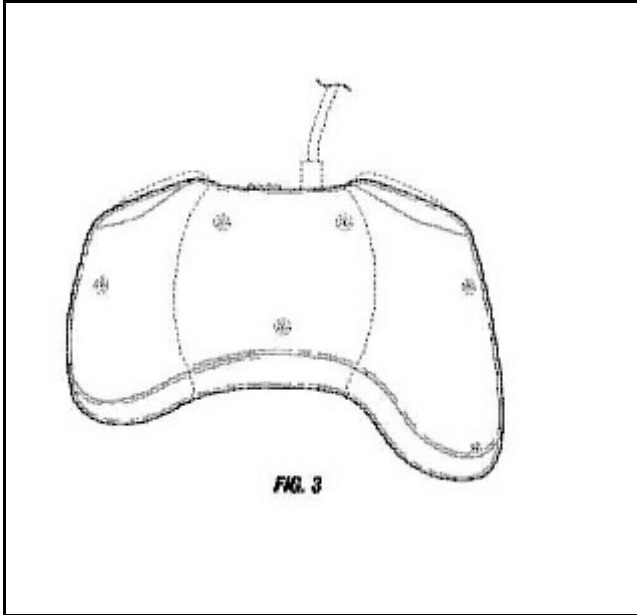

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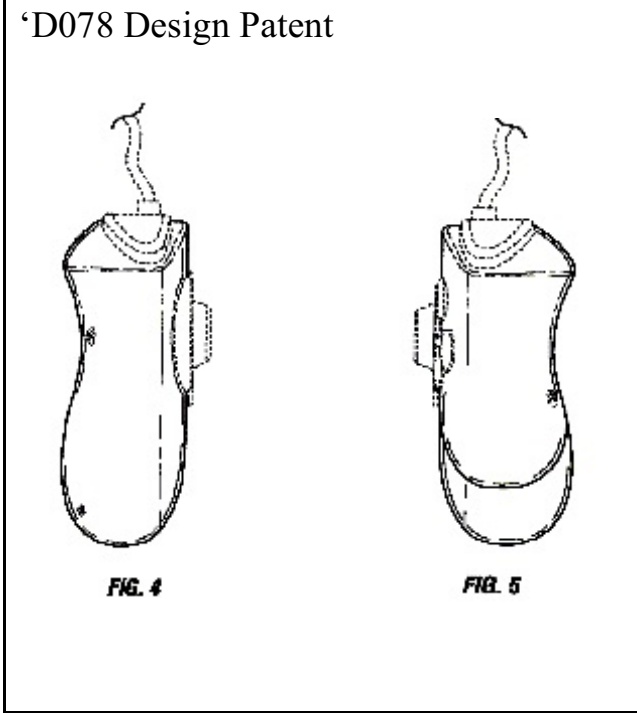

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23 ³The parties dispute whether there is an indentation on the Accused Controller
24 on the top side. Mad Catz describes the top side as having “no indentation or angles.”
25 (Dkt. No. 14-2 at 16.) In opposition, PDP states that Mad Catz’ statement that the top
26 of the Accused Controller is flat is an erroneous misstatement because the pictures
27 show a visible indentation where the cord connects to the controller. (Dkt. No. 16 at
28 10 n. 5.) In reply, Defendant maintains that if one looks at Exhibit C to the Marshall
Declaration, it is obvious that the top does not have an indentation and also notes that
the functional buttons on the top right left and right are disclaimed by the patent. (Dkt.
No. 17 at 9 n. 7.) The top side of the 'D078 Design Patent is curved and has a notable
deeper indentation than the Accused Controller. The Accused Controller has a straight
top; however, there is a slight indentation formed by the functional buttons on the right
and left top corner.

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Underneath /Rear Elevational View	
'D078 Design Patent	Accused Controller
 <p>FIG. 3</p>	

The underneath portion of the 'D078 Patent is a flat, smooth uniform surface without ridges, angles, reliefs, and protrusions while the underneath portion of the Accused Product has pronounced ridges, angles, relief and protrusions.

Left and Right Side Elevational View	
'D078 Design Patent	Accused Controller
 <p>FIG. 4 FIG. 5</p>	

1 The left and right sides of the body of the ‘D078 Patent Design are curved or
2 rounded in a uniform fashion. The left and right sides of the body of the Accused
3 Controller are straight with an angled bent in the middle.

4 While PCP argues that the differences asserted Mad Catz are trivial and minor,
5 it does not dispute the differences asserted by Mad Catz.⁴ As highlighted above, there
6 are numerous differences between the ‘D078 Design Patent and the Accused Controller
7 and when viewing the design as a whole, it would be clear to an ordinary observer that
8 the two designs are “plainly dissimilar.” See Egyptian Goddess, 543 F.3d at 678. The
9 similarities solely based on the asymmetric design and the trapezoidal shape noted by
10 PDP require the Court to look at these ornamental features in isolation, which is
11 procedural error. See Ethicon Endo-Surgery, Inc., 796 F.3d at 1335.

12 The Court concludes that PDP’s infringement claim is facially implausible, and
13 the Court GRANTS Mad Catz’ motion to dismiss the claim for patent infringement.
14 Because the Court concludes that the Accused Controller and ‘D078 Design Patent are
15 plainly dissimilar, it does not need to compare the two designs with the prior art. See
16 Ethicon Endo-Surgery, Inc., 796 F.3d at 1337 (“comparing the claimed and accused
17 designs with the prior art is beneficial only when the claimed and accused designs are
18 not plainly dissimilar.”)

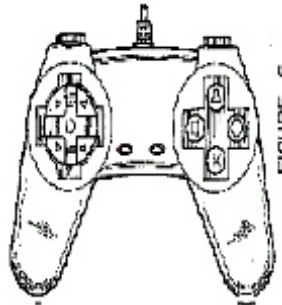



19 **2. Side-by-Side Comparison with Prior Art**

20 However, even if the Court concluded that the ‘D078 Design Patent and Accused
21 Controller appear substantially the same, consideration of the prior art would reveal
22 that an ordinary observer would not be deceived into believing the Accused Controller
23 is the same as the ‘D078 Design Patent.

24
25 ⁴PDP argues that contrary to Mad Catz description, its patent design is “not
26 completely curved but also includes straight edges running at angles along both sides,
27 and straight edges at the top on either side of the indentation.” (Dkt. No. 16 at 10.)
28 Also, the top outside corners of both designs are rounded on both designs. (Id.)
Moreover, PDP concedes there are angular differences along the sides of both designs
but those constitute minor differences. (Id. at 10-11.) These differences, asserted by
PDP, merely dispute the characterization of the design by Mad Catz as opposed to
highlighting significant similarities between the two designs.

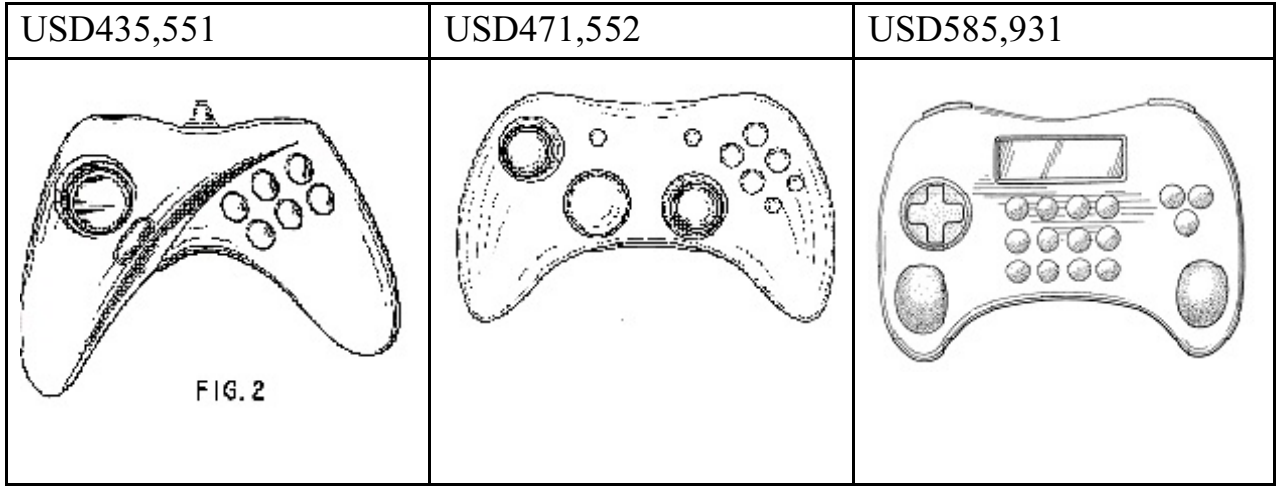
1 “The second step requires that the patentee establish that an ordinary observer,
 2 familiar with the prior art designs, would be deceived into believing the accused
 3 product is the same as the patented product.” Seirus Innovative Accessories, Inc. v.
 4 Cabela’s Inc., 827 F. Supp. 2d 1150, 1155 (S.D. Cal. 2011) (citing Egyptian Goddess,
 5 643 F.3d at 672). “If the accused design has copied a particular feature of the claimed
 6 design that departs conspicuously from the prior art, the accused design is naturally
 7 more likely to be regarded as deceptively similar to the claimed design, and thus
 8 infringing.” Egyptian Goddess, 643 F.3d at 676. In addition, “strong similarities
 9 between the accused design and the prior art are an indication of non-infringement.”
 10 Wing Shing Prods., 665 F. Supp. 2d at 368. In Wing Shing Products, the district court
 11 rejected the plaintiff’s argument that summary judgment cannot be granted because the
 12 accused product is “closer to the patented design than the prior art” and stated that the
 13 key question is whether an ordinary observer familiar with the prior art would believe
 14 that the accused product is the same as the patented design. Id.

15 Mad Catz produces four prior arts that are four design patents owned by it
 16 below:

USD380783S	USD410,914	USD415,752	USD425,047
 <p data-bbox="544 1375 560 1491">FIGURE 6</p>	 <p data-bbox="711 1512 766 1528">FIG. 5</p>	 <p data-bbox="1019 1543 1079 1560">FIG. 2</p>	 <p data-bbox="1339 1543 1399 1560">FIG. 8</p>

27 Mad Catz also produces three additional prior arts listed in ‘D078 Patent Design
 28 as prior art below:

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Mad Catz contends when viewing the numerous prior art references for video game controllers, the differences between the ‘D078 Patent Design and the Accused Controller become more apparent. It contends that an observer would notice that the appearance of the Accused Controller is more similar to the design in prior patents and products. PDP opposes arguing that the Accused Controller “differs more greatly from the prior art than from the ‘D078 Patented Design, and is in fact strikingly similar to the ‘D078 Patented Design.” (Dkt. No. 16 at 12.) More specifically, PDP points out that one conspicuous feature of the ‘D078 Patent Design that is different from the prior art is the significantly lower left handgrip compared with the shorter right handgrip. (Id. at 13.) PDP notes that six of the seven prior arts do not have an asymmetrical handgrip while USD435,551 shows a slight asymmetrical shape but the asymmetry is not as pronounced as the ‘D078 Patent Design and the Accused Controller. In reply, Mad Catz argues that PDP concedes that a prior art discloses the same asymmetry and the degree of asymmetry is not relevant to the analysis. It also notes that PDP has failed to identify a single similarity between the Accused Controller and the ‘D078 Patent Design that is also not found in the prior art.

The question before the Court is whether an ordinary observer, familiar with the seven prior arts pictured above would be deceived into believing that the Accused Controller is the same as the ‘D078 Design Patent. See Egyptian Goddess, 543 F.3d

1 at 681.

2 PDP asserts the asymmetrical design is a unique feature of its ‘D078 Design
3 Patent. However, prior art, USD435,551 has an asymmetrical feature where the left
4 handle is slightly longer than the right handle. This demonstrates that the unique
5 asymmetric feature of the ‘D078 Design Patent that PDP asserts was infringed by the
6 Accused Controller, does not depart conspicuously from the prior art. See Egyptian
7 Goddess, 643 F.3d at 676. Therefore, no infringement can be found based on the prior
8 art. See id.

9 **C. Dismissal on Motion to Dismiss**

10 Mad Catz has presented a number of cases where district courts have granted
11 motions to dismiss design infringement claims based on the ordinary observer test. See
12 SCG Characters LLC v. Telebrands Corp., CV-15-00374 DDP (AGRx), 2015 WL
13 4624200, at *6 (C.D. Cal. Aug. 3, 2015); Anderson v. Kimberly-Clark Corp., 570 F.
14 App’x 927, 931-34 (Fed. Cir. 2014); Colida v. Nokia, Inc., 347 F. App’x 568, 570
15 (Fed. Cir. 2009) (affirming district court’s dismissal design patent infringement claims
16 because “dissimilarities far exceed the similarities”).

17 PDP argues that the Court should not dismiss the Complaint because the
18 ordinary observer test is a question of fact and cites to cases that assert the proposition
19 that the test for ordinary observer is a factual inquiry. However, PDP cites to cases
20 involving summary judgment motions where summary judgment was denied because
21 of the existence of issues of fact for the jury. These cases do not change the fact that
22 it is clear without more that PDP has failed to prove that the two designs are
23 “substantially the same to the ordinary observer.” Egyptian Goddess, Inc., 543 F.3d
24 at 678.

25 Finally, the Court notes that other district courts have also granted motions to
26 dismiss based on non-infringement of a design patent. See Silverman v. Leombruni,
27 15 Civ. 2260 (PAC), 2016 WL 715735, at *2-3 (S.D.N.Y. Feb. 19, 2016); Legler v.
28 Exxel Outdoors, Inc., No. 13-C-668, 2014 WL 3727566, *2-5 (E.D. Wis. July 29,

1 2014); MSA Products, Inc. v. Nifty Home Products, Inc., No. 11cv5261 (WJM), 2012
2 WL 2132464, *3-4 (D.N.J. June 12, 2012) (“Although generally correct that
3 infringement is usually a question of fact, MSA is wrong that the Court cannot
4 determine infringement as a matter of law at the motion to dismiss stage. While not
5 necessarily common, many courts have dismissed claims of design infringement on
6 Rule 12(b)(6) motions where, as a matter of law, the court finds that no reasonable fact-
7 finder could find infringement.”) (citing cases).


8 Here, the Court finds that the ‘D078 Design Patent and the Accused Controller
9 are plainly dissimilar, and as a matter of law, the Court may grant a motion to dismiss.
10 See id.; Ethicon Endo-Surgery, Inc., 796 F.3d at 1335.

11 **Conclusion**

12 Based on the above, the Court GRANTS Defendant’s motion to dismiss with
13 prejudice as leave to amend would be futile. See Desoto, 957 F.2d at 658.

14 IT IS SO ORDERED.

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16 DATED: June 29, 2016

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18 HON. GONZALO P. CURIEL
19 United States District Judge
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