

Expert Methodology Critical in Denial of Preliminary Injunction

Hangzhou Chic Intel. Tech. Co. v. Gyroor, No. 20-cv-04806 (N.D. Ill. Dec. 12, 2022)

By: Edward Runyan & Daniel Zhang | January 9, 2022

The United States District Court for the Northern District of Illinois recently denied a renewed motion for a preliminary injunction seeking to prohibit sales of Defendants’ hoverboards that allegedly infringed Plaintiffs’ design patents (exemplary comparison pictured below):



The renewed motion came after the Court had previously issued a preliminary injunction, but the injunction was vacated by the Federal Circuit. The Court found that the patentee had failed to establish a sufficient likelihood of success on the merits, stating that “a reasonable jury could find that the accused products are not substantially similar to the patents in suit, such that an ordinary observer would not be deceived into believing that the accused products are the same as the patented design.”

In making its decision, the Court relied heavily on the Defendants’ expert’s opinion, a prior design patent examiner of 32 years, stating that the expert “conducted the proper analysis,” while simultaneously rejecting the Plaintiffs’ expert’s analysis. The Court reasoned that the Plaintiffs’ expert “failed to conduct an analysis of whether [] features [shared by both patents in suit and accused products] are substantially similar in the manner of their design, which is where the ‘focus’ of the analysis must be.” And because certain features, like shape, were similar across the prior art, the patents in suit, and the accused products, the Court found that “the overall impression is embodied in the details” and “it is impossible to consider a design’s overall impression without examining its details.” The Court found that the Plaintiffs’ expert “ignore[d] the details,” and that his analysis would “fail to gain a proper perspective on the overall impression of [the] design.”

Importantly, the Defendants’ expert and the Court pointed out numerous design differences between the claimed invention and the accused product, including the shape and extension of the wheel covers, the texture of the ribs on foot pads, the orientation of the LED lights, and branding text present on the accused products. Further, the Court agreed with the Defendants’ expert that because the patent claimed the bottom side of the hoverboard, any differences between the bottoms, which are not normally visible, must also be considered for infringement. These differences included vent holes, angles, and slopes.

In sum, the Court found that the Plaintiffs failed to carry their burden of showing a likelihood of success on the merits based on differences Plaintiffs claimed to be minor and not sufficiently centered on an “overall visual impression.” While the Court’s finding is not dispositive on the issue of infringement, it is unlikely that the Court’s focus on the “details” will shift in a field with crowded prior art.