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Design Patents: Meeting Obviousness and Novelty Requirements

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Today’s faculty features:

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Anticipation
For Design Patents

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Title 35 – Chapter 16 – Designs U.S.C. Section 102
(PRE-AIA effective prior to March 16, 2013)

- A person shall be entitled to a patent unless—
- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States
Title 35 – Chapter 16 – Designs U.S.C. Section 102
(First to Invent System Effective Mar 16, 2013)

• (a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

• (1) the *claimed invention* was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

• (b) Exceptions.—

• (1) Disclosures made 1 year or less before the effective filing date of the claimed invention.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

• (A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

• (B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.
What is/was the Test?

- Design patent anticipation requires a showing that a single prior art reference is identical in all material respects to the claimed design (IIAMR)

- *Hupp v. Siroflex* (122 F.3d 1456 (Fed. Cir. 1997))
- Prior art was a newspaper advertisement for a ceramic floor tile structure whose overall design was similar, but not identical, to one of Hupp's mold designs
2009…along came Seaway…

- CAFC, without an *en banc* panel, effectively overturned *Hupp*
- Following the *Egyptian Goddess* test, ordinary observer test must "logically" be the sole test for anticipation
- If the prior art reference is "substantially the same" as the claimed design, then the claimed design is anticipated

*International Seaway v. Walgreens*, 589 F.3d 1233 (Fed. Cir. 2009)
Anticipation - Int’l Seaway Trading Corp. v. Walgreens Corp.

Figure 1 of Crocs ‘789 Patent (Prior Art)

Figure 2 of Crocs ‘789 Patent (Prior Art)

Figure 1 of Seaway’s ‘263 Patent

Figure 2 of Seaway’s ‘263 Patent
What is the Test for Anticipation NOW

• Result $\rightarrow$ Potentially competing tests
  – identical in all material respects
  – VERSUS
  – substantially the same (inverse ordinary observer test)

• USPTO follows Seaway
Subtopics

• Does it matter?
• The (il)logic of Seaway
• Europe
• What to do….
Competing Tests – It Matters

- Identical in all material respects vs.
- Substantially the same (ordinary observer)

- Rarely, but it can be critical where, prior art is close but not IIAMR and not obvious (+ other reasons)

Substantially the same

Identical in all material respects

When it is critical

Always patentable

Obvious
Competing Tests – It Matters at USPTO

• USPTO follows *Seaway*
  – substantially the same standard
  – examiners are the gatekeepers
  – appeals take years
  – Unless you want to change the law, it matters
The (il)Logic of Seaway…

- DP law 1871 → infringement = ordinary observer (OOT)
- UP law 1889 → infringement = §102
- UP law 1950 → infringement = literal + DOE
- DP law 1984 → DP infringement = OOT + PON
- DP law 1997 → §102 = IIAMR
- UP law 1987 → literal infringement = §102
  - the 1889 proposition is no longer true, products which later infringe under the DOE would not necessarily anticipate
- DP law 1988 → DP infringement NOT lit & DOE parts
- DP law 2008 → DP infringement = OOT (only)
- Seaway → DP infringement = §102
The (il)Logic of Seaway… #2

- UP law 1889 → infringement = §102
- UP law 1950 → infringement = literal + DOE
- UP law 1987 →
  - the 1889 proposition no is longer true
  - infringement ≠ §102
  - literal infringement = §102

- **Seaway** →
  - We’re following the “no longer true” 1889 proposition
  - DP infringement = §102
The (il)Logic of Seaway… #3

- DP law 1871 → DP infringement = ordinary observer (OOT)
- DP law 1998 → DP infringement = OOT + PON
- DP law 1997 → §102 = IIAMR
- DP law 1988 → DP infringement NOT lit & DOE parts
- DP law 2008 → DP infringement = OOT (only)

- **Seaway** →
  - *EG* forces us to revisit
  - DP and UP law line up exactly here
  - No need for a panel to overturn IIAMR
  - §102 = DP infringement = OOT
The (il)Logic of Seaway… #4

- stale initial proposition
- inapplicable analogy
- flawed logic
- phantom legal support
  (relied on cases applying IIAMR)

Overturned IIAMR and replaced with OOT/STS
WITHOUT “overruling” precedent
(let’s also spoon out bad § 103 dicta too)
US and EU frameworks

- **US**
  - Anticipation/novel (102)
  - Obviousness

- **Europe**
  - Novel
  - Individual character

- *Under Seaway*
  - 102 = infringement

- *Ind. char = infringement*
What to do – at the USPTO

- USPTO follows *Seaway*
  - Argue not substantially the same standard
  - Can argue infringement law from EG
    - Don’t expect examiners to know this
    - Examiners less experienced with art
  - Consider also arguing not identical in all material respects
    - It might be usable to change the law
  - Don’t waste your time if obvious
Competing Tests – at the Courts

• Arguments for legal standards should be considered if applicable
• Arguments could be made for either test
• Expert reports should address both
• Test is a matter of law
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Tips for Responding to §102 Rejections

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MIND + MUSCLE

October 5, 2017
Responding to 102 Rejections
Before the USPTO

Is the reference prior art?

• Inventor’s own work
  • If less than 1 year before, consider filing a declaration under 37 C.F.R. §1.130(a) by an inventor proving the design in the reference was “obtained directly or indirectly” from the inventor(s)
  • Must factually link prior disclosure to Applicant/Inventor
    – For example, inventor’s own work posted on YouTube by a third party giving credit to inventor/applicant
    – Proving disclosure was by Applicant
Responding to 102 Rejections Before the USPTO

Is the reference prior art?

- **Authenticating Internet Art**
  - Reference must be self authenticating (include a publication date)
  - No published PTAB decisions involving internet art that does not have WayBack Machine authentication by Examiner
  - Include lack of WayBack authentication in your response
  - Check source code for publication information
  - Consider asking publisher (on line retailer) to correct publication date if incorrect
Responding to 102 Rejections Before the USPTO

• Is the reference enabling?
  • Are all aspects of the design shown in the reference or are there features of the claimed design which are not shown in or evident from the reference?
    • For example, does the reference only show a front view?
  • This can happen with “prophetic” prior art where someone may be guessing what the next new design for a particular product might look like
  • Advantage – avoids having to characterize the claimed design by attacking the deficiencies in the reference instead
Responding to 102 Rejections Before the USPTO

- Is the design of the reference not “substantially the same” as the claimed design?
  - Best to discuss overall impression of the claimed design rather than distinguishing based on specific details of the design to avoid unnecessarily narrowing the claim scope.
  - Interviews can be very helpful, particularly in person, if comparing physical sample of claimed design with physical sample of prior art design.
    - For example, in generational design cases or
    - Where prior art reference is unclear or subject to differing interpretations.
Design Patents and the Non-Obviousness Requirement

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October 5, 2017
Case law Milestones

1893
Whitman Saddle (1893)

1929
In re Jennings (1950)
In re Glavas (1956)
In re Rosen (1982)

1952 Patent Act

1982
In re Carlson (1992)
In re Harvey (1993)
In re Vanguard (2010)
MRC v. Hunter (2014)

Regional Courts

C.C.P.A.

Federal Circuit
Smith v Whitman Saddle Co.,
148 U.S. 674 (1893)

“Nothing more was done in this instance ... than to put the two halves of these saddles together in the exercise of the ordinary skill of workmen of the trade, and in the way and manner ordinarily done.”
35 U.S.C. § 171 - Patents for designs

(a) In General.— 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.

(b) Applicability of This Title.— The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.
35 U.S.C. § 171 - Patents for designs

(a) In General.— 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.

(b) Applicability of This Title.— The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.
35 U.S.C. 103 (Post-AIA)


A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.
Graham v. John Deere Co.,
383 U.S. 1 (1966)

Graham Factors

1. Determining the scope and content of the prior art;

2. Ascertaining the differences between the claimed invention and the prior art;

3. Resolving the level of ordinary skill in the art; and

4. Evaluating any objective evidence of nonobviousness (i.e., so-called “secondary considerations”).
   (1) The invention's commercial success
   (2) Long felt but unresolved needs
   (3) The failure of others
   (4) Skepticism by experts
   (5) Praise by others
   (6) Teaching away by others
   (7) Recognition of a problem
   (8) Copying of the invention by competitors
In re Rosen
673 F.2d 388 (C.C.P.A. 1982)

Prior Art References

Claimed Design

Is there a primary reference that is “basically the same”??

ANSWER: NO
Design Patent Obviousness

“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.”
Degrees of Identity

“Basically the same”  
(Obviousness)

“Substantially the same”  
(Infringement/Anticipation?)

“Identical in All Material respects”  
(Anticipation?)
In re Rosen
673 F.2d 388 (CCPA 1982)

Prior Art

Reference 1

Reference 2

Reference 3

Design Patent
**In re Rosen**

673 F.2d 388 (CCPA 1982)

### Prior Art

![Prior Art Image]

### Design Patent

![Design Patent Image]

not identical, but basically the same
Obviousness Framework: In re *Rosen* and the "Primary Reference" Requirement

Prior Art References

Claimed Design

Is there a primary reference that is "basically the same"??

**ANSWER: NO**
**In re Rosen Reference?**

*Durling v. Spectrum Furniture* (Fed. Cir. 1996):

Is prior art reference “basically the same”?  

**ANSWER: NO**
In re Rosen Reference?

Titan Tire v. Case New Holland (Fed. Cir. 2009):

Prior Art

Claimed Design

Is a single prior art reference “basically the same”?

ANSWER: YES
In re Rosen Reference?

In re Vanguard (BPAI 2010):

Prior Art

Claimed Design

Is a single prior art reference “basically the same”?

ANSWER: NO
In re Rosen Reference?
Apple Inc. v. Samsung Elec., 678 F.3d 1314, 1330 (Fed. Cir. 2012)

Prior Art Combination


US D504,889

Is there a primary reference?

ANSWER: NO
Obviousness Framework: Combining References

“The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.”

*In re Glavas* (C.C.P.A. 1956)

Rejecting the combination where “modifications of primary reference necessary to achieve [the patented] design would destroy the fundamental characteristics” of the primary reference.”

*In re Rosen* (C.C.P.A. 1982)
“Ordinary Designer” or “Ordinary Observer”

Would the design have been “obvious to a designer of ordinary skill who designs articles of the type involved”?

*Durling v. Spectrum Furniture* (Fed. Cir. 1996)

“Obviousness … requires courts to consider the perspective of the ordinary observer.”

*Int’l Seaway v. Walgreens Corp.* (Fed. Cir. 2009)

“Obviousness is assessed from the vantage point of an ordinary designer in the art…”

*High Point Design v. Buyers Direct* (Fed. Cir. 2013)
“Suggesting” the Modification

*In re Carlson* (Fed. Cir. 1992)

Asymmetry “suggests” symmetry because it is “expected.”

Prior Art

Claimed Design
“Suggesting” the Modification

_In re Carlson_ (Fed. Cir. 1992)

Asymmetry “suggests” symmetry because it is “expected.”
De Minimis Modification

In re Harvey (Fed. Cir. 1993)

“[I]f prior art designs are to be modified in more than one respect to render a claimed design obvious, then those modifications must be ‘de minimis’ in nature and unrelated to the overall aesthetic appearance of the design.”
MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326 (Fed. Cir. 2014)

Prior Art

Patent

Differences
• V-Neck
• Mesh
• Surge Stitching (back)
MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326 (Fed. Cir. 2014)

Prior Art

Patent

Is a single prior art reference “basically the same”?

ANSWER: YES
MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326 (Fed. Cir. 2014)

Prior Art

Patent

PRIMARY

SECONDARY

FED.CIR.: OBVIOUS

front

back
An Approach to Obviousness
Focus on delta between prior art and patented design
An Approach to Obviousness
Focus on \textit{delta} between prior art and patented design

Is the \textit{difference} obvious to DOSITA?
Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008) (en banc)

General Rule:
Verbalizations Should Not Be Attempted
Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008) (en banc)

But see…Footnote 1

“This court has required that in determining obviousness, a district court must attempt to ‘translate [the] visual descriptions into words’ in order to communicate the reasoning behind the court's decision and to enable ‘the parties and appellate courts . . . to discern the internal reasoning employed by the trial court.’ Durling v. Spectrum Furniture Co., 101 F.3d 100, 102 (Fed. Cir. 1996). Requiring such an explanation of a legal ruling as to invalidity is quite different from requiring an elaborate verbal claim construction to guide the finder of fact in conducting the infringement inquiry.’
Tips for Responding to §103 Rejections

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Current Application of §103 by the USPTO

- Rejection of a concept rather than the claim as a whole
- Modifying primary reference to appear more similar to the claimed design
- When is the function of the cited design relevant to what modifications are obvious?
- When is it obvious to modify a primary reference with teaching of a secondary analogous reference?
- Does the “flexible KSR” standard apply to the obviousness analysis of designs in terms of modifying a primary reference to be “basically the same” as the claimed design?
Rejecting a Concept Rather than the Claim

Claimed Design

Cited Design

FIG. 1

FIG. 7
Rejection & Response

• Only difference recognized by the Office was that the ovals of the prior art are less elongate and filled with a diamond grid pattern

• Office rejected the “concept” and overlooked that the claimed ovals are differently shaped, spaced much further apart, create a design with a different “overall visual impression”

• Does claiming less require more similarity?
Modifying Reference to Better Match Claimed Design

Claimed Design

Cited References


References as applied


FIGURE

FIG. 2A
• “Because orientation forms no part of the claimed design, and for ease of visual comparison, Gordon has been rotated […]”
• “It would have been obvious to a designer of ordinary skill […] to modify Gordon by centering a single square below the middle rectangle as taught by Al-Ali.”
Tips for Response

• Applied “created” reference is not “something in existence” or is not “prior” art because did not exist prior to applicant’s filing date

• Most “examiner created” art removes broken lines based on a misinterpretation of In re Zhan, which did not relieve the Office of its obligation under In re Blum to consider the prior art design as a whole for all that it teaches

• Designer of prior art GUI created it to be viewed a certain way on screen, technology turns screen to reorient designs

• Even if you accept that the “created design” is properly “prior art”, consider if it is “basically the same”
Tips for Response

• Demonstrate in words or in images that the combination or prior art results in a design that is different from the claimed design.

• If there are many possible designs that could result from the combination of references, show several of them to make the point that arriving at the claimed design is not the only possibility and therefore, not obvious.

• Consider amending the claimed design to further distinguish the prior art (e.g., add a broken line screen to GUI).
Is the Function of the Cited Design Relevant?

Would it be obvious to modify a keypad to have fewer than a matrix of 3 by 4?
Obvious to Modify?

- What is the necessary showing the examiner must make that a secondary reference is so related to the primary reference “that the appearance of certain ornamental features in one would suggest the application of those features to the other,” as required by Glavas?
  - Glavas only sets the standard for the what is “useable” as prior art
  - Being “usable” as prior art does not make the combination obvious
  - In other words, can an obviousness rejection be properly made without any factual basis for the conclusion that one of skill in the art would have found the proposed modification obvious?
Is there a Flexible KSR Standard for Designs?

The examiner acknowledges that the Blogspot design lacks a significant design characteristic present in the claimed design: the shapes are shown with a single tone solid black fill. However, in the spirit of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007) (hereinafter referred to as KSR), wherein the Supreme Court stated that “...it is error to apply TSM [teaching, suggestion, motivation] test as rigid and mandatory formula that limits obviousness analysis”, and “...a court errs where, as here, it transforms general principle into a rigid rule limiting the obviousness inquiry”, the examiner would like to step away from the rigid application of the common Rosen/Glavas model (*Rosen, supra; In re Glavas*, 125 USPQ 191) normally used for framing a rejection for the obviousness of a design claim, and consider the design herein with “an expansive and flexible approach to the obviousness question.”