

Design Patents at the PTAB

June 14, 2023

FISH.



Meet the Speakers

Craig Deutsch
Principal



deutsch@fr.com

Grace Kim
Principal



gkim@fr.com

Agenda

I. Latest Statistics

II. Claim Construction

III. Anticipation

IV. Obviousness

V. Indefiniteness

VI. Practice Tips

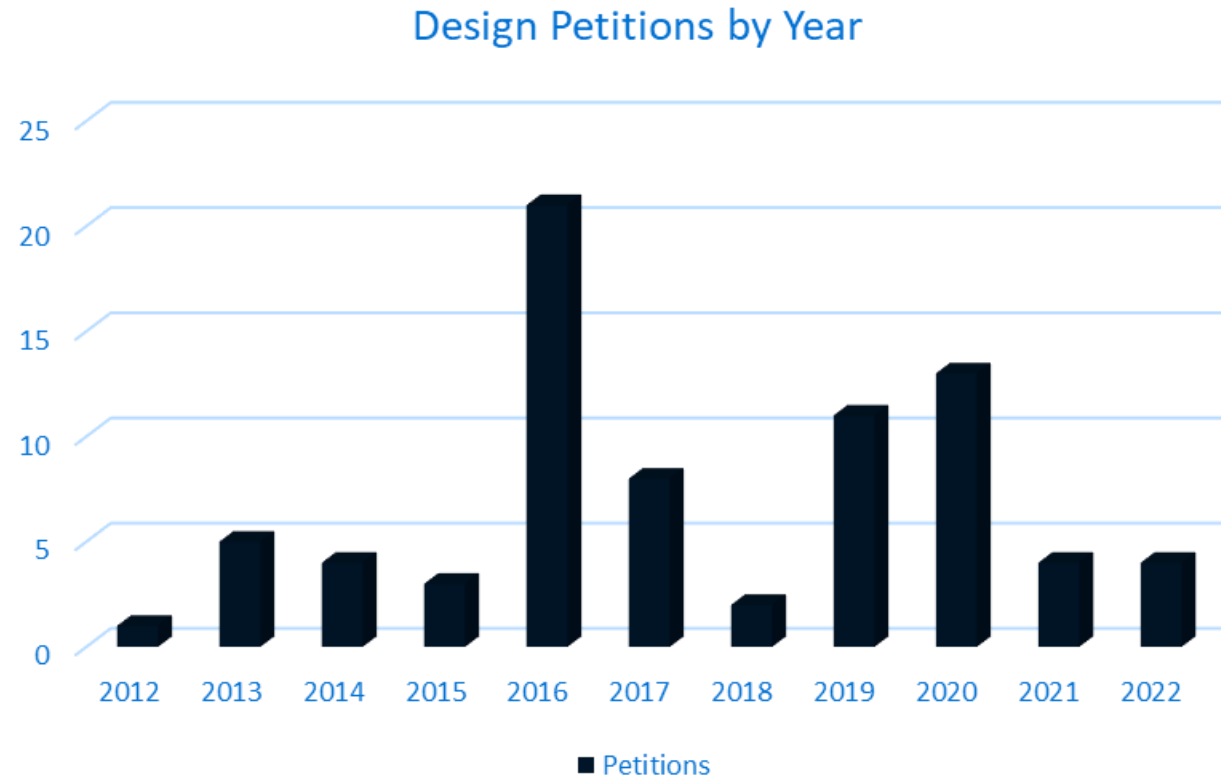
Latest Statistics

FISH.

Relatively Few Filings

81 design Petitions filed

- 57 IPRs
- 24 PGRs

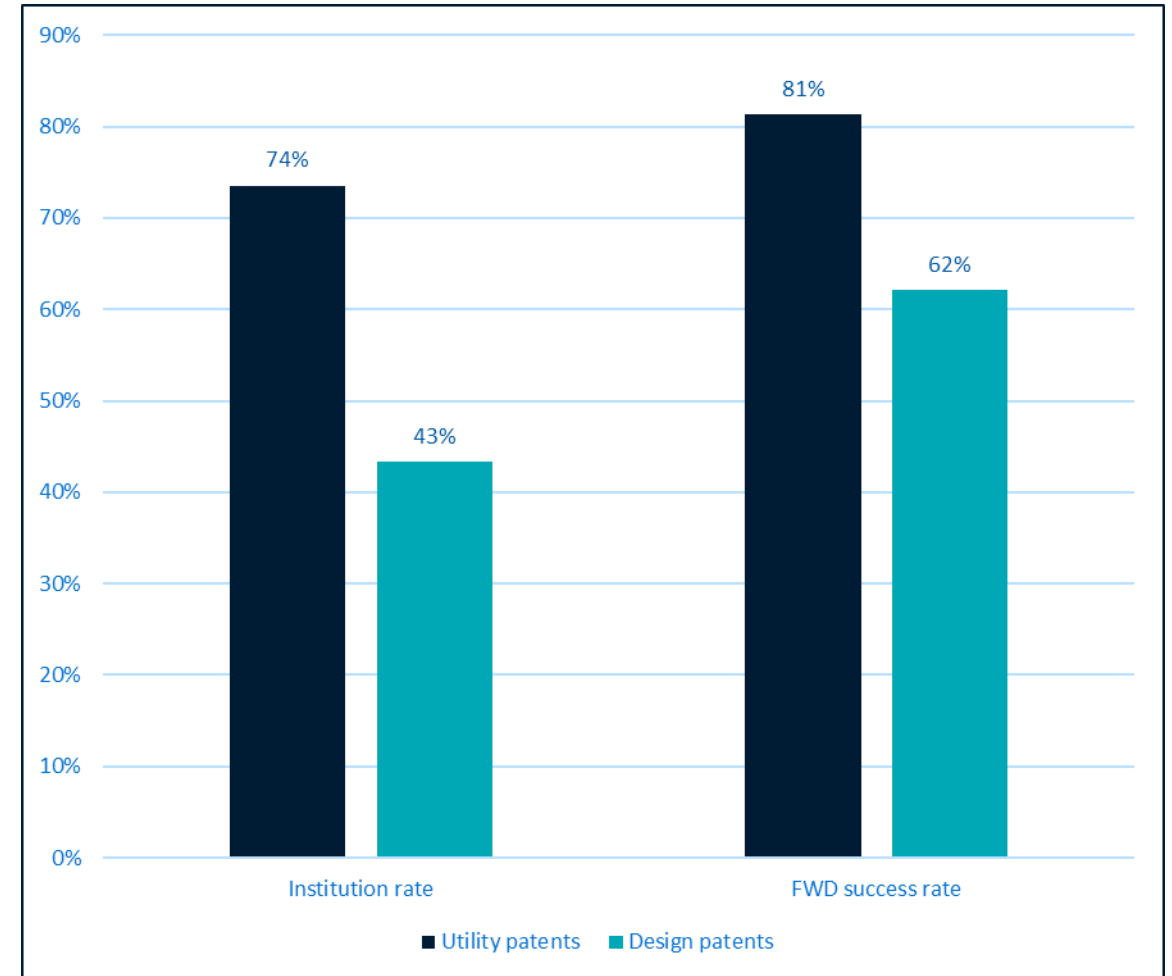


Institution is Difficult

- PTAB has reached decisions on about 67 petitions
 - 43% institution rate
 - 29 petitions instituted
- Petitioner ultimately successful in about 18 cases (~ 25%)
- A handful of instituted cases involved prior art directed to the same product (or predecessor) as the design patent

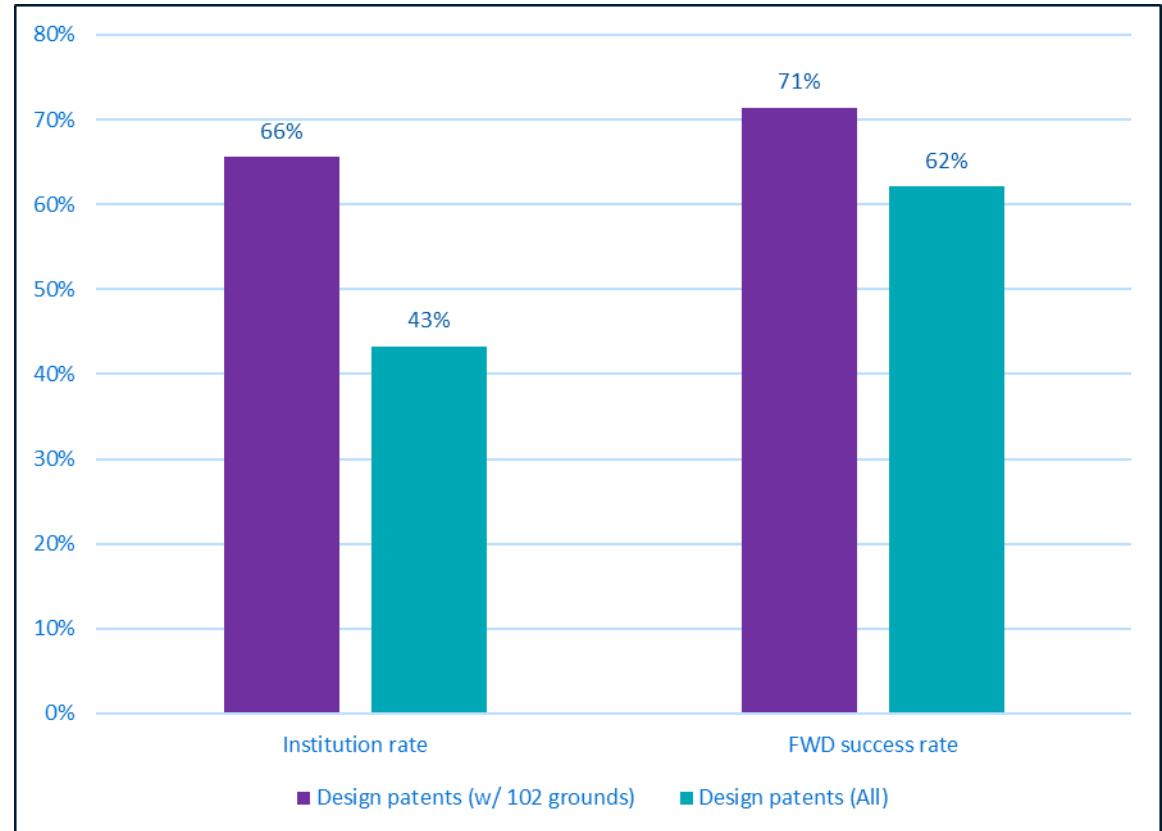
Institution and FWD Success Rate – Utility v. Design Patents

- As a subset of design cases that are instituted, 62% achieve a final written decision finding the design claims unpatentable
- Compared to 81% of utility final written decisions finding at least one claim unpatentable



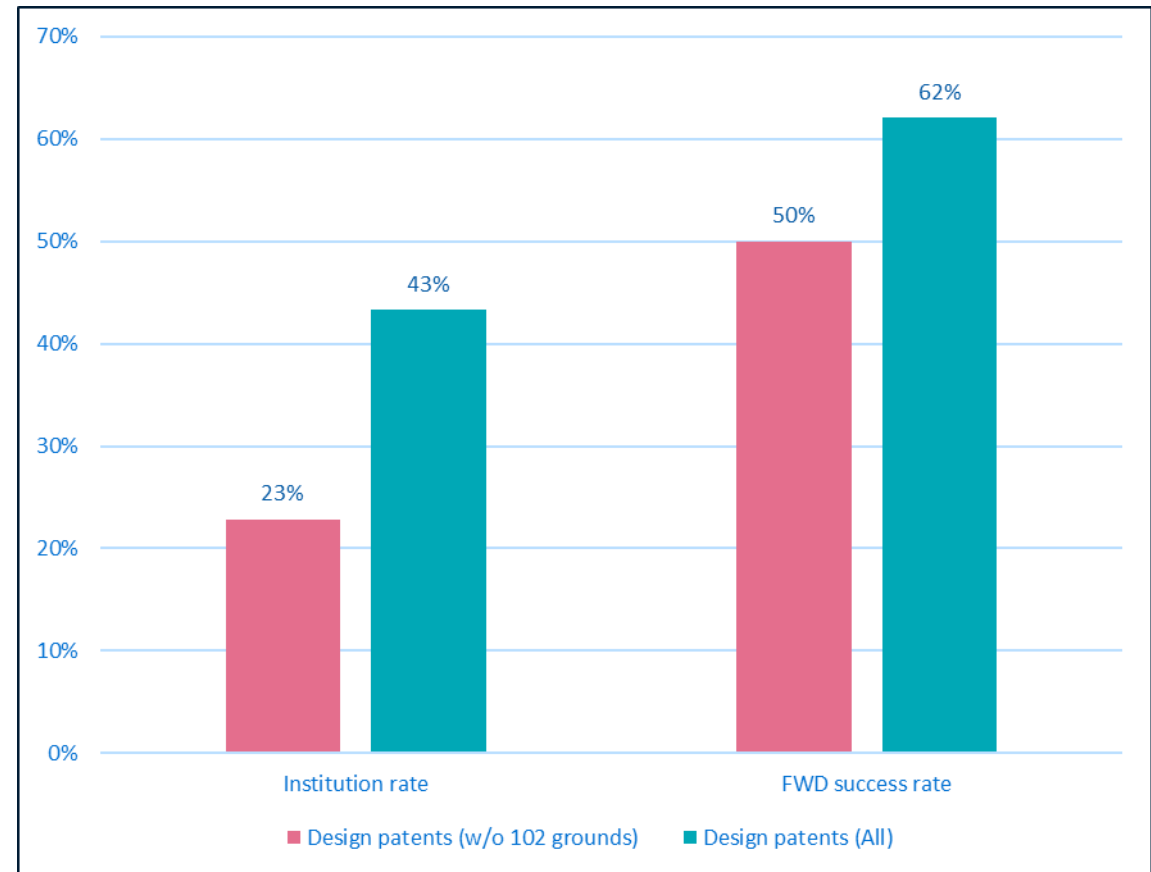
Institution and FWD Success Rate – Design Patents w/ 102 Grounds

- 38 design petitions included Section 102 Grounds
- Success rate of this subset is notably higher than the overall rate
- 2/3rds of petitions were instituted
- Improved odds FWD will find claims unpatentable



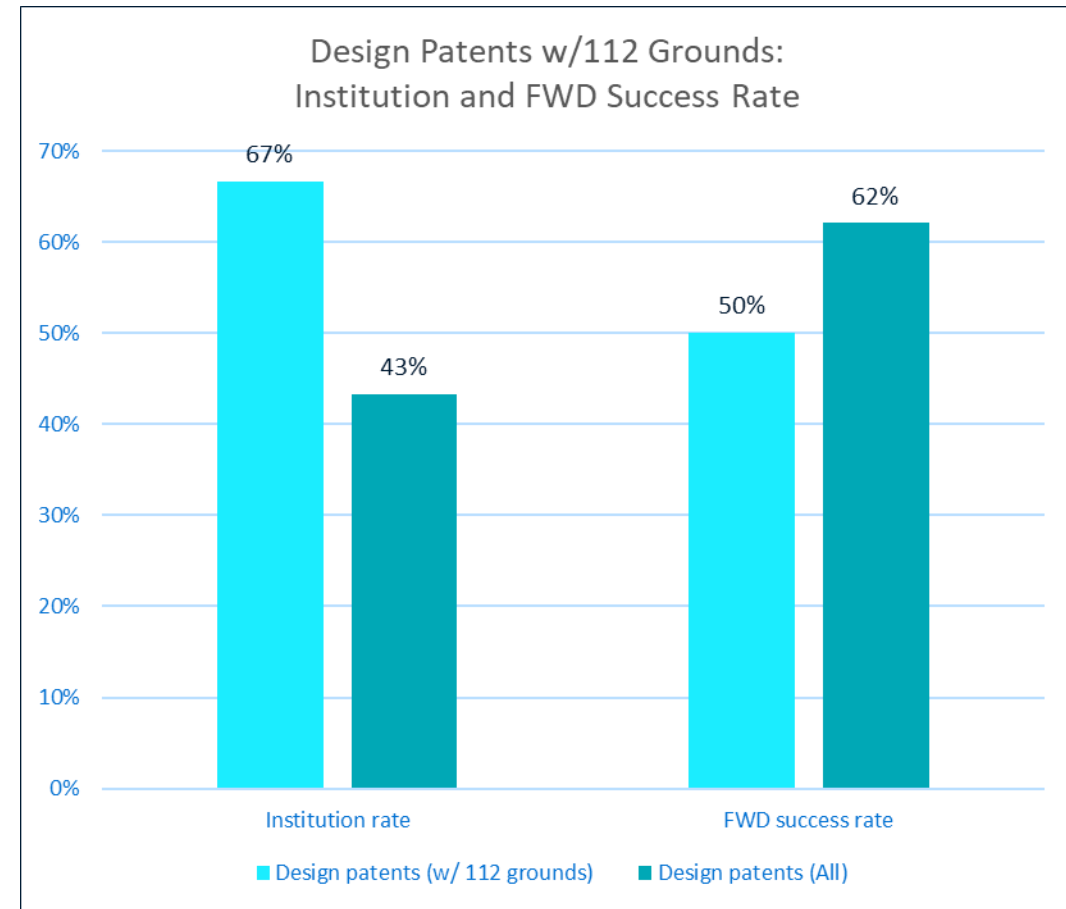
Institution and FWD Success Rate – Design Patents w/o 102 Grounds

- Nearly all design petitions included a Section 103 ground,
- 43 design petitions did not include a Section 102 ground
- Only 23% of petitions without 102 ground were instituted
- Once past institution threshold, success rate remains lower (but sample size is quite small).



Institution and FWD Success Rate – Design Patents w/ 112 Grounds

- Indefinite and enablement issues under Section 112 also present noteworthy distinctions compared to utility patents
- PGR proceedings for design patents involving Section 112 have been relatively rare
- Still offer petitioners viable options for invalidating a patent



Claim Construction Analysis at the PTAB

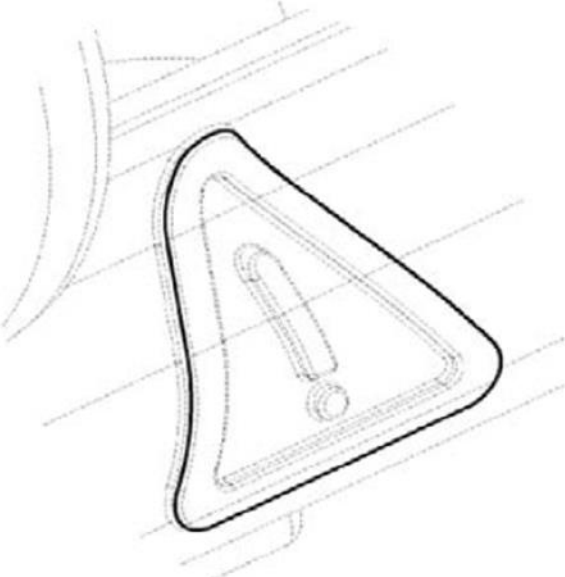
FISH.

Claim Construction

- **A design is represented better by an illustration than a description.** *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)).
- **The trial court must first translate [the design patent's] visual descriptions into words**, so that the parties and appellate courts can discern the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design. See *High Point Design LLC v. Buyer's Direct, Inc.*, 730, F.3d 1301, 1314 (Fed. Cir. 2013).

Caterpillar v. Miller Int'l, Ltd – IPR2015-00416

D673,982 - “Operator-Visible Warning Symbol on a Coupler”

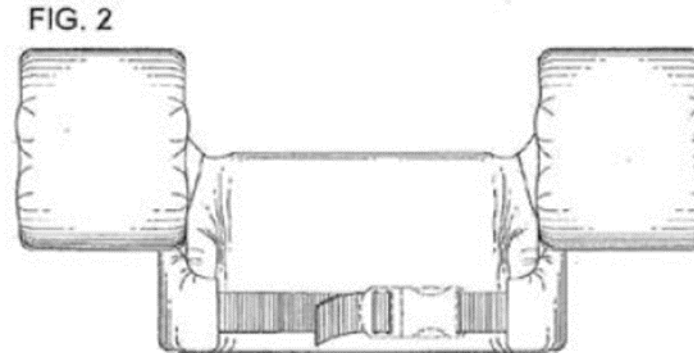
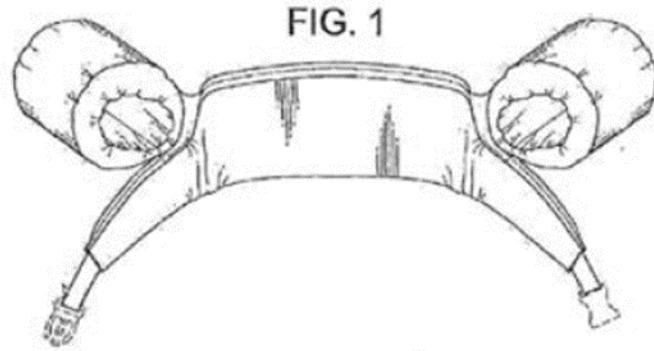
Figure 3	Construction
 <p data-bbox="665 1125 774 1158">FIG. 3</p>	<p data-bbox="1116 501 2117 1129">The ornamental design of the operator visible warning symbol, as illustrated in Figures 1–7, except that the broken lines form no part of the claimed design, and the ornamental design includes an equilateral triangle with rounded corners and a horizontal base that is shaped as if projected onto a laterally extruded “S”-shaped surface, as shown in the solid lines in Figs. 1–7 of the '982 patent.</p>

Johns Manville v. Knauf – IPR2016-00130

- Parties agreed the claimed design was directed to “insulation material” having a “cloud-like appearance,” “variations in a swirl pattern,” and a “variation of distinct hues”
- Petitioner: “color” and “waffle pattern” not part of claim
- Patent Owner: “cream color . . . marbleized throughout with at least a brown color, a chocolate color, a coffee color, an almond color, and a beige color,” and “the marbleizing creates a sandstorm appearance”
- PTAB: The “claimed design depicts an insulation material having a cloud-like appearance with variations in a swirl pattern, a waffle pattern, and colors that sufficiently impart or convey a variation of distinct hues, such as brown and cream.”



Sport Dimension v. Coleman – 820 F.3d 1316



- “[A]s long as the design is not primarily functional, ‘the design claim is not invalid, even if certain elements have functional purposes.’”
- “Where a design contains both functional and nonfunctional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”
- “[T]he armbands and side torso tapering serve a functional purpose, so the factfinder **should not focus on the particular designs of these elements** when determining infringement, **but rather focus on what these elements contribute to the design’s overall ornamentation.**”

The Standard for Anticipation at the PTAB

FISH.

Anticipation

[I]f, in the eye of an **ordinary observer**, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Gorham Co. v. White, 81 U.S. 511 (1871)

The ordinary observer test requires the fact finder to consider all of the ornamental features illustrated in the figures that are visible at any time in the “normal use” lifetime of the accused product, i.e., **“from the completion of manufacture or assembly until the ultimate destruction, loss, or disappearance of the article.”**

Int’l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1238, 1240 (Fed. Cir. 2009)

Ordinary Observer

The ordinary observer is “a person who is either a purchaser of, or sufficiently interested in, the item that displays the patented designs and who has the capability of making a reasonably discerning decision when observing the accused item’s design whether the accused item is substantially the same as the item claimed in the design patent.”

Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1323 (Fed. Cir. 2007).

- Retail consumer or commercial buyer?
- Stand alone device or component of assembly?

Ordinary Observer – Knowledge of Prior Art

The “ordinary observer is considered to be **familiar with prior art designs.**”

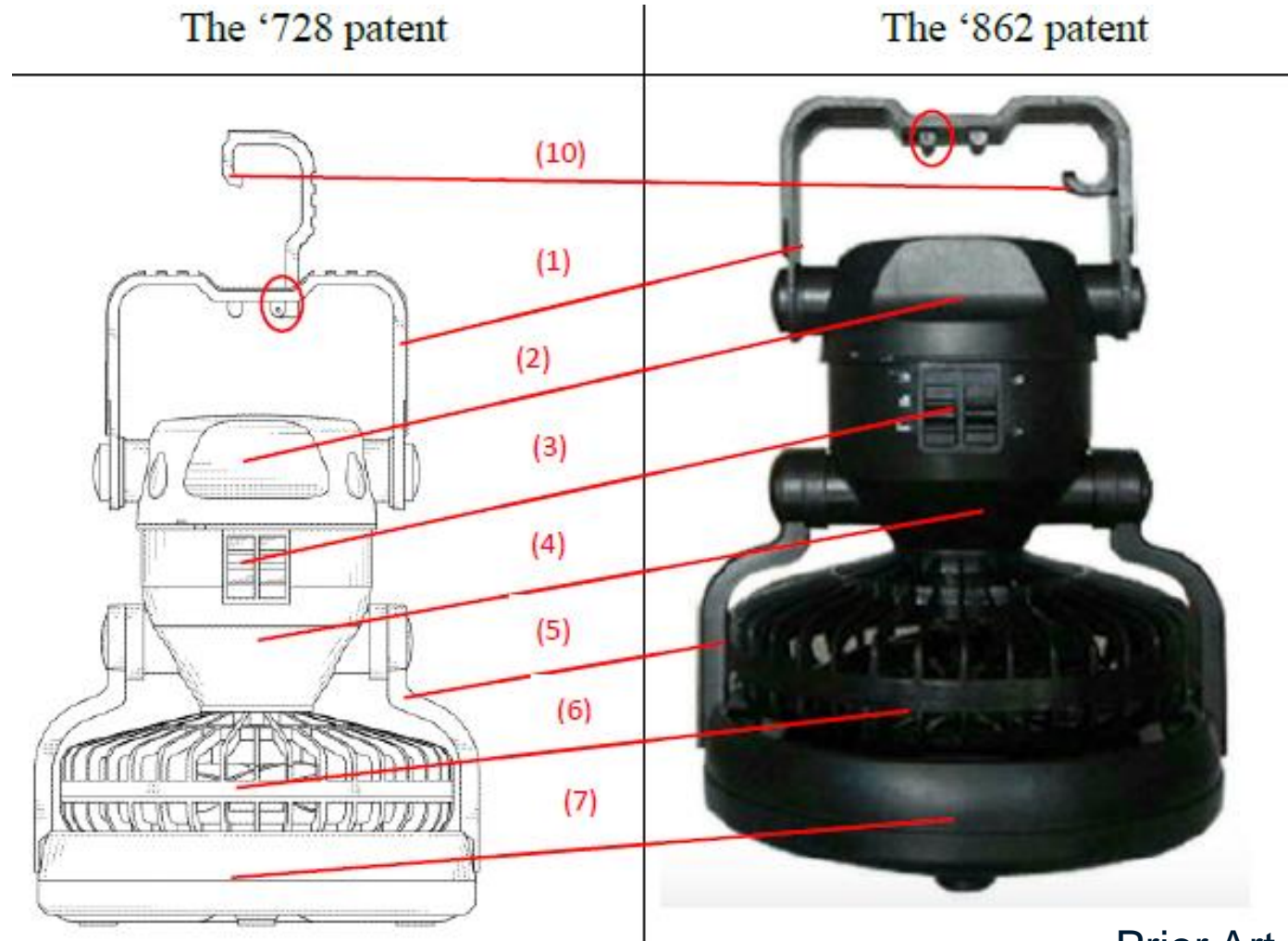
Columbia Sportswear N. Am., Inc. v. Seirus Innovative Access., Inc., 942 F.3d 1119, 1129 (Fed. Cir. 2019).

“[W]hen the claimed design is close to the prior art designs, **small differences** between the accused design and the claimed design are **likely to be important** to the eye of the hypothetical ordinary observer.”

Egyptian Goddess v. Swisa, Inc., 543 F.3d 665, 681 (Fed. Cir. 2008).

Cellpak Inc. v. Mambate USA Inc. - IPR2021-00007

D846,728 – “Led Camping Lantern With Ceiling Fan”



Cellpak Inc. v. Mambate USA Inc. - IPR2021-00007

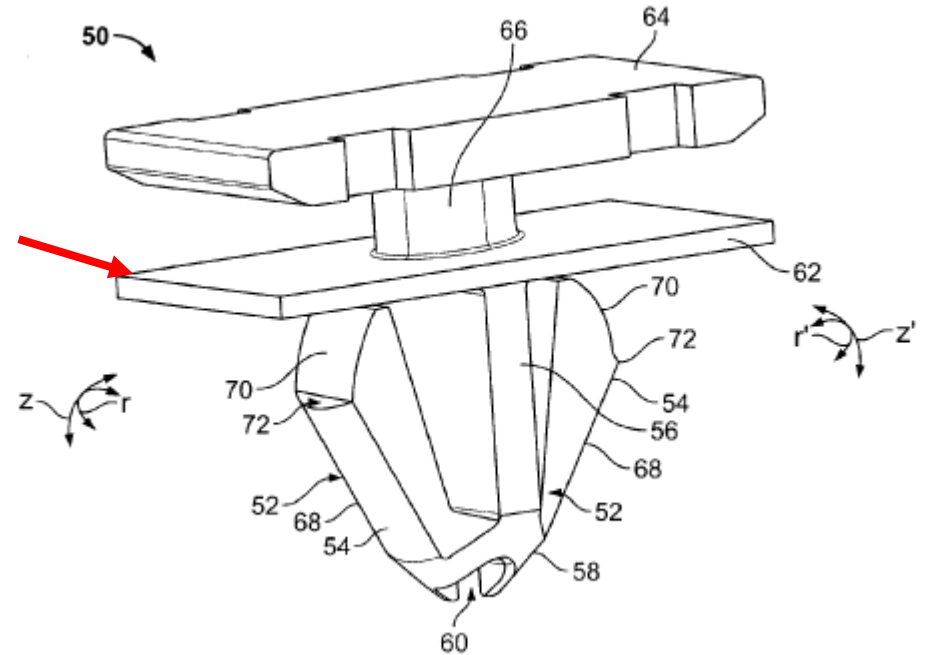
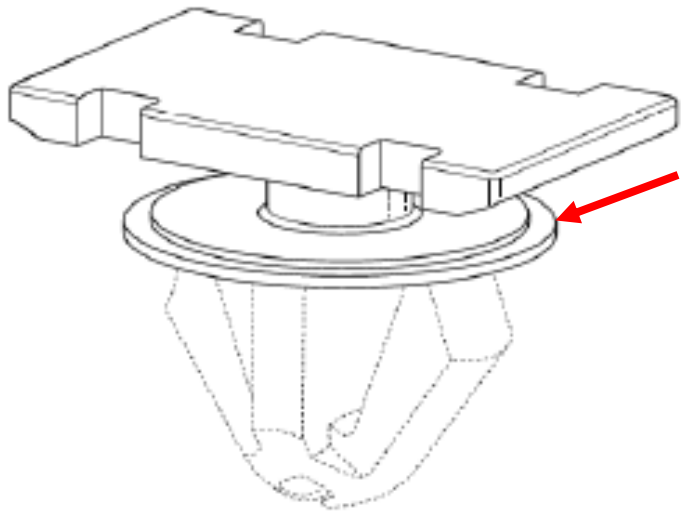
Institution was granted & the patent was held invalid in the Final Written Decision (FWD)

“Based on the substantial similarity of the two designs, Petitioner asserts that ‘an ordinary observer would be induced, giving such attention as a purchaser usually gives, to purchase the camping lantern with ceiling fan claimed in the ’728 patent supposing it to be that in the ’862 patent.’” IPR2021-00007 (Inst. decision), Paper 7, 10 (PTAB Apr. 21, 2021).

“On the present record, we determine that Petitioner has shown sufficiently that there is substantial similarity in the overall appearance of the two designs such that an ordinary observer would be induced to purchase one supposing it to be the other. Accordingly, the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in establishing that the ’862 patent anticipates the design claimed in the ’728 patent.” *Id.*

Termax Company v. Illinois Tool Works Inc. - IPR2022-00106

D897,826 – “Fastener”



Prior Art Reference

Termax Company v. Illinois Tool Works Inc. - IPR2022-00106

Institution denied

“Petitioner’s argument that the claimed design is anticipated by Scroggie is based entirely on the premise that we cannot consider the appearance of the lower platform...Petitioner does not address the design as a whole, to the extent that it includes the appearance of the lower platform, in order to show that an ordinary observer, giving such attention as a purchaser usually gives, would deem the design depicted in Scroggie to have the same overall visual appearance as that claimed in the ’826 patent.” IPR2022-00106 (Inst. decision), paper 7, 22 (PTAB May 12, 2022).

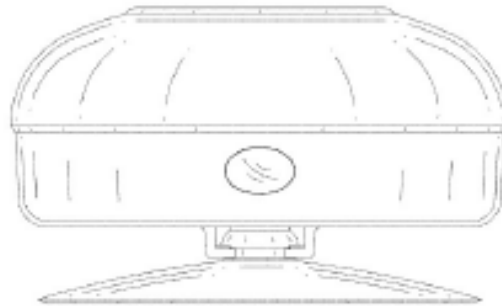
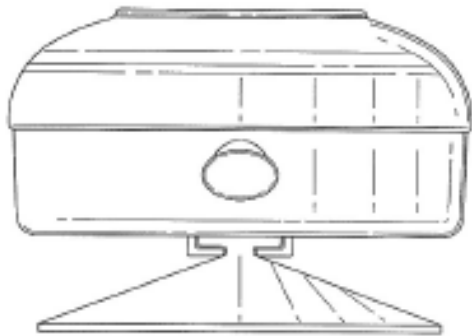
“[W]e agree with Patent Owner that the lower platform is significant to the overall appearance of the fastener design, and thus Petitioner’s analysis is not sufficient on this record. Because we disagree with Petitioner’s premise that the lower platform’s appearance is primarily dictated by function, Petitioner has not established a reasonable likelihood of prevailing as to this ground.” *Id.* at 23.

Laltitude LLC d/b/a Picasso Tiles v. Altus Holdings, Inc.

IPR2022-00155

D719,138

“Circular shower radio with base”



Prior Art Ref. 1 – “Zhao US”



Prior Art Ref. 2 – “Zhao CN”

Laltitude LLC d/b/a Picasso Tiles v. Altus Holdings, Inc.

IPR2022-00155

Institution was granted & the patent was held invalid in the FWD

“As noted above, Patent Owner did not file a response.

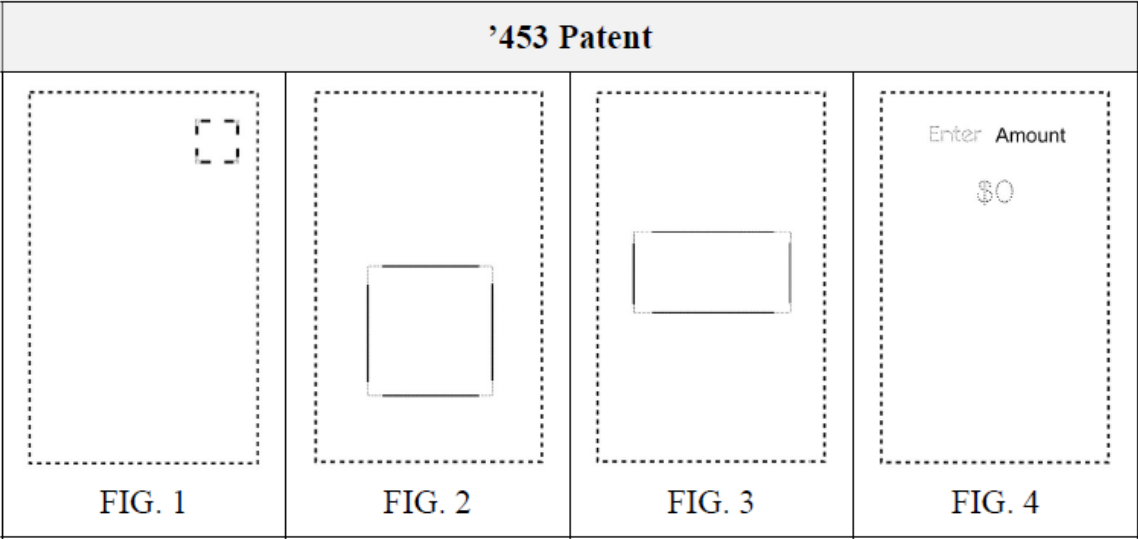
On the record before us, Petitioner has established sufficiently (see Pet. 15–21) that, ‘in the eye of an ordinary observer, giving such attention as a purchaser usually gives,’ Zhao US and the claimed design are substantially the same.... In particular, we agree with Petitioner that “[b]oth designs share a common domed circular body having control buttons on top”; “[b]oth designs share the same shape, order, and position of the control buttons”; “[b]oth designs share the same button on a side of the cylindrical, circular body”; and “[b]oth designs share [a] similar suction cup bottom.” Pet. 20.

Additionally, we find that any differences in the designs (e.g., the precise shape of the suction cup) are minor differences that do not prevent a finding of anticipation.” IPR2022-00155 (FWD), paper 8, 12-13 (PTAB May 10, 2023).

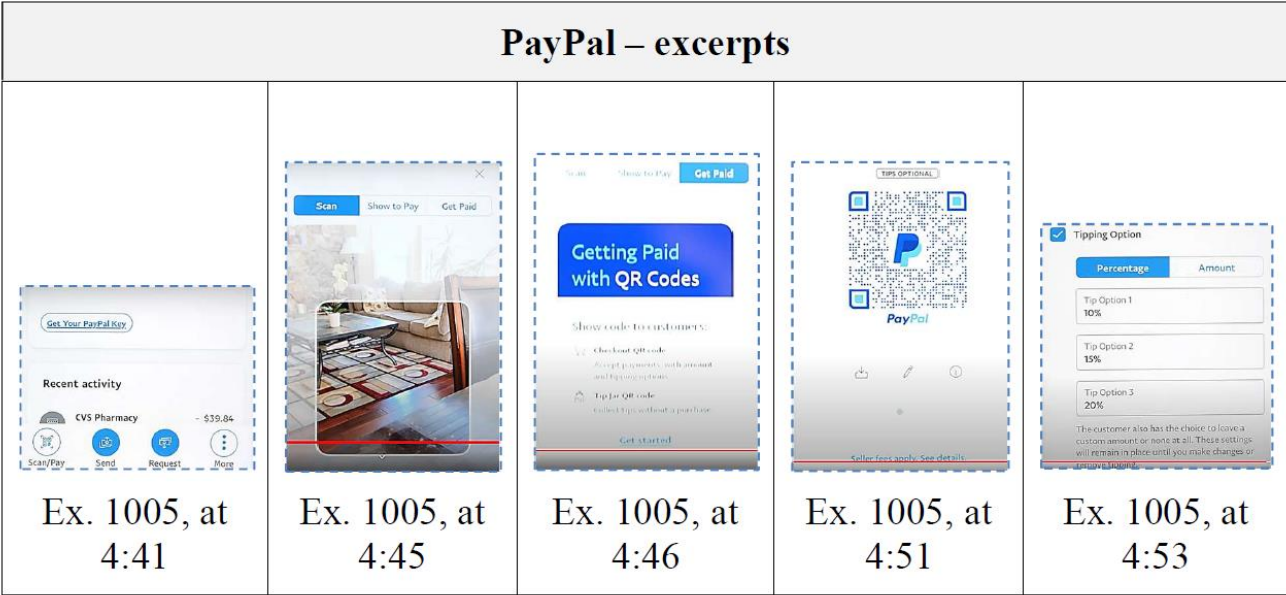
The Board applied substantially similar findings with respect to the anticipatory ground asserting the Zhao CN reference.

Early Warning Services, LLC v. Fintech Innovation Associates, LLC - PGR2022-00046

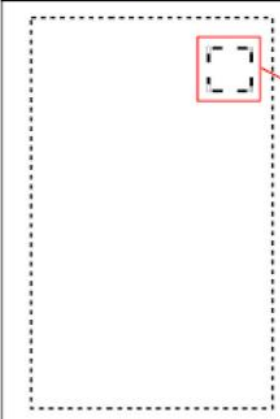
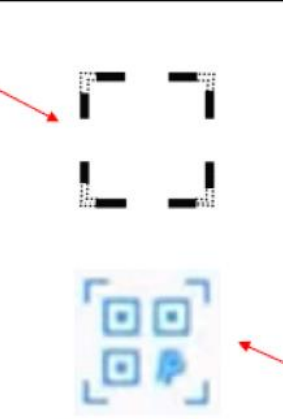
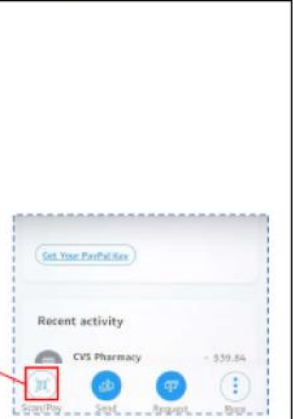
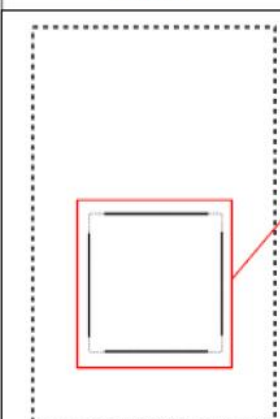
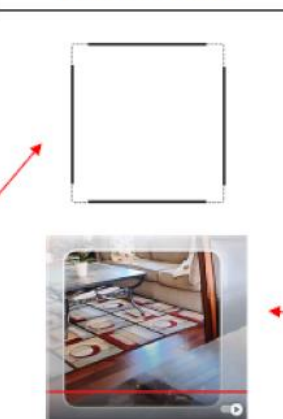
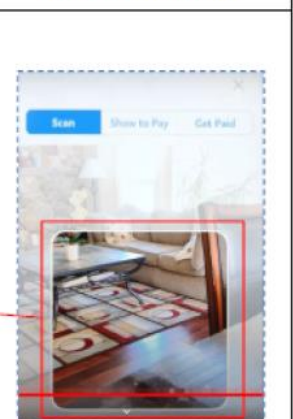
D945,453 – “Display Screen Portion With Animated Graphical User Interface”

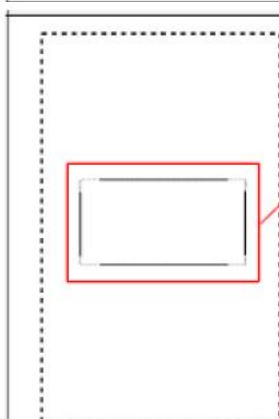


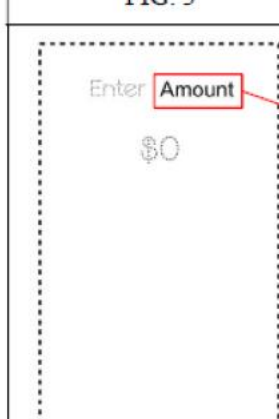
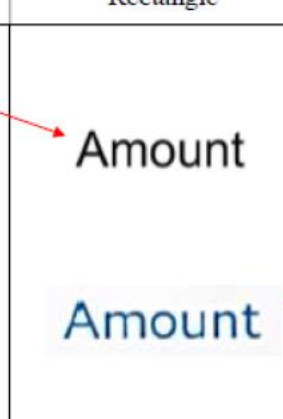
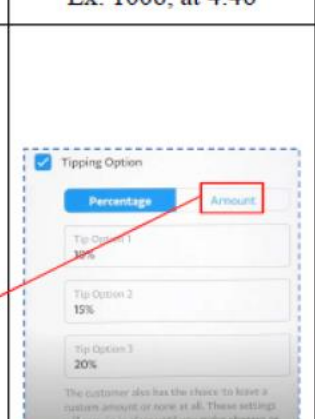


Prior Art Reference 1 (Ex. 1006) (Refs. 2-5 not shown)



Early Warning Services, LLC v. Fintech Innovation Associates, LLC - PGR2022-00046

'453 Patent		PayPal (Ex. 1006)
 <p>FIG. 1</p>	 <p>Corner Brackets</p>	 <p>Ex. 1006, at 4:41</p>
 <p>FIG. 2</p>	 <p>Square</p>	 <p>Ex. 1006, at 4:45</p>

'453 Patent		PayPal (Ex. 1006)
 <p>FIG. 3</p>	 <p>Rectangle</p>	 <p>Ex. 1006, at 4:46</p>
 <p>FIG. 4</p>	 <p>"Amount"</p>	 <p>Ex. 1006, at 4:53</p>

Early Warning Services, LLC v. Fintech Innovation Associates, LLC - PGR2022-00046

Institution granted

“According to Petitioner, “[a]t 4:41 in the video, the PayPal mobile phone GUI displays an image including **four corner brackets**”; “[t]he 4:45 ‘Scan’ image includes a **square**”; “[t]he 4:46 ‘Get Paid’ image includes a **rectangle**”; and “[t]he 4:53 ‘Tipping Option’ image includes the word ‘**Amount.**’” PGR2022-00046, paper 16, 15 (PTAB Jan 5, 2023).

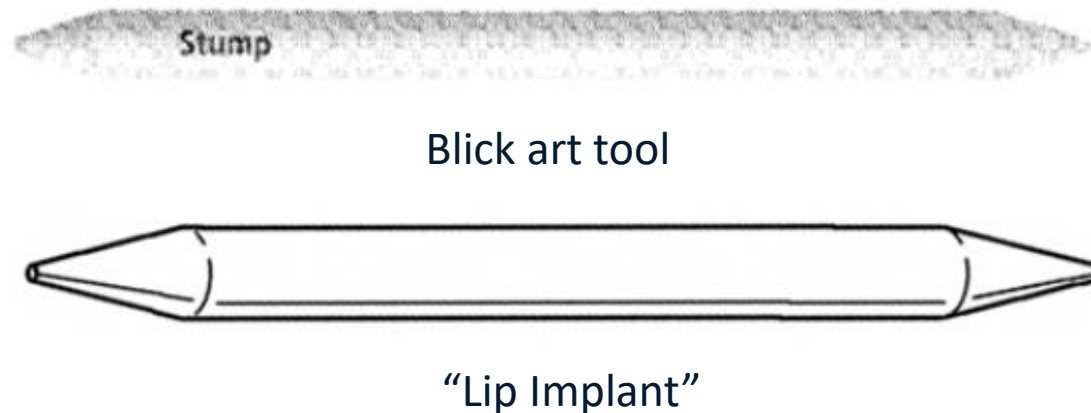
“We have reviewed the figures of the ’453 patent, and preliminarily construe the claim, for purposes of this Decision, as **not precluding intervening images between the claimed design images and determine that the scope of the claim does not require particular sizes or positions of the claimed elements.**” *Id.*, at 17.

“Having reviewed Petitioner’s argument and evidence, Petitioner has sufficiently shown it is more likely than not that the claimed design and PayPal are substantially the same to the ordinary observer.” *Id.*

In re SurgiSil, L.L.P., No. 2020-1940, 2021 WL 4515275 (Fed Cir. 2021)

The title can be limiting in design patents.

- In *SurgiSil*, the relevant test for applicable prior art for anticipation is based upon the “**article of manufacture**” to which the claim applies.



The Standard for Obviousness at the PTAB

FISH.

Obviousness

Whether the claimed design would have been obvious to a **designer of ordinary skill** who designs articles of the type involved. *Apple, Inc. v. Samsung Elecs. Co., Ltd.*, 678 F.3d 1314,1329 (Fed. Cir. 2012).

Two step obviousness analysis:

1) Identify *Rosen* reference:

- “[T]here 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. *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)
- “Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.” *Id.*

2) Modify *Rosen* reference to arrive at same overall appearance as the claimed design.

Obviousness

1) Identify *Rosen* reference:

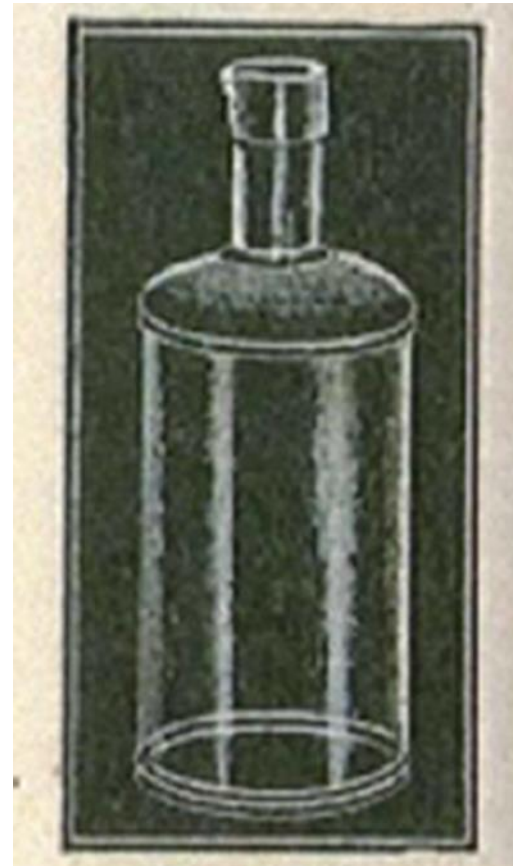
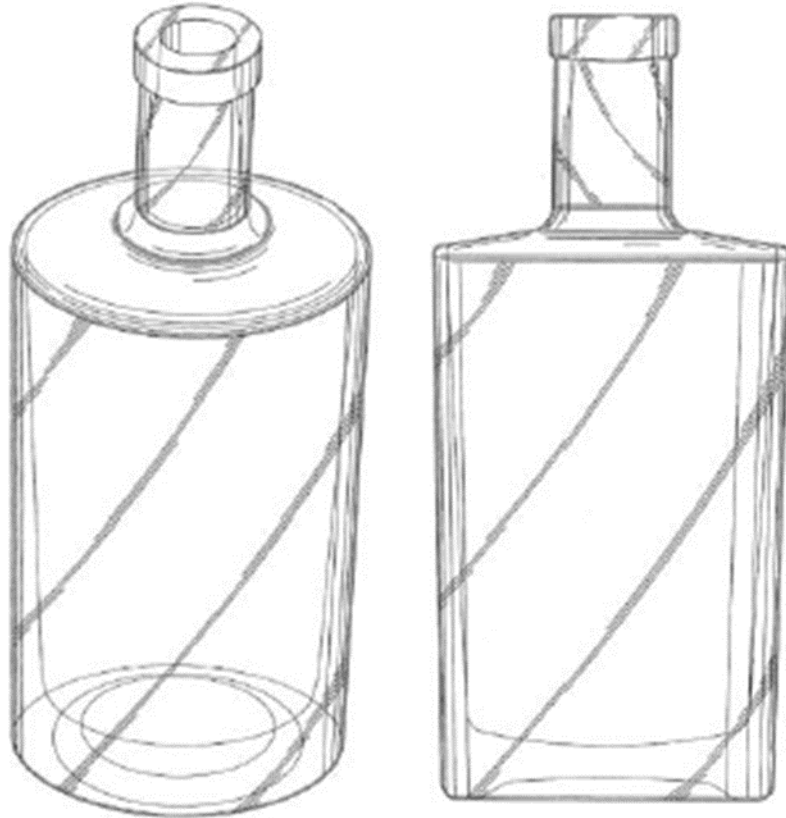
- (i) “Discern the correct visual impression created by the patented design as a whole.”
- (ii) “Determine whether there is a single reference that creates ‘basically the same visual impression.’”

2) Modify *Rosen* reference:

- In the second step, the primary reference may be modified by secondary references to create a design that has the same overall visual appearance as the claimed design. See *High Point Design* at 1311 (Fed. Cir. 2013).
- However, the “secondary references may only be used to modify the primary reference if they are ‘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.’” *Durling v. Spectrum Furniture Co*, 101 F.3d 100, 103 (Fed. Cir. 1996).

Vitro Packaging v. Saverglass – IPR2018-00947

D526,197 – “Bottle”



Vitro Packaging v. Saverglass – IPR2018-00947



“Our observations, based on a side-by-side comparison of the claimed design and the Round Ink Bottle, are consistent with Patent Owner’s positions and well-articulated comparisons of the overall appearance of the claimed design with the Round Ink Bottle.”

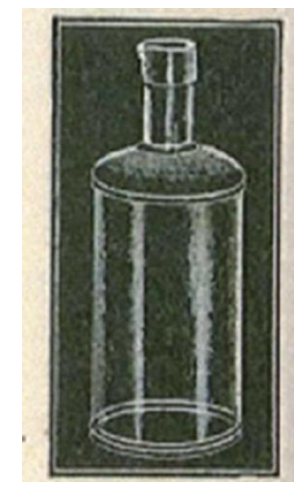
- Inwardly tapering interior/exterior surfaces versus constant diameter
- Thickened, double concave base versus flat, planar base
- Flat shoulder versus bulbous rounded shoulder
- Smooth concave transition to neck versus raised convex bead at transition

Vitro Packaging v. Saverglass – IPR2018-00947

Institution denied

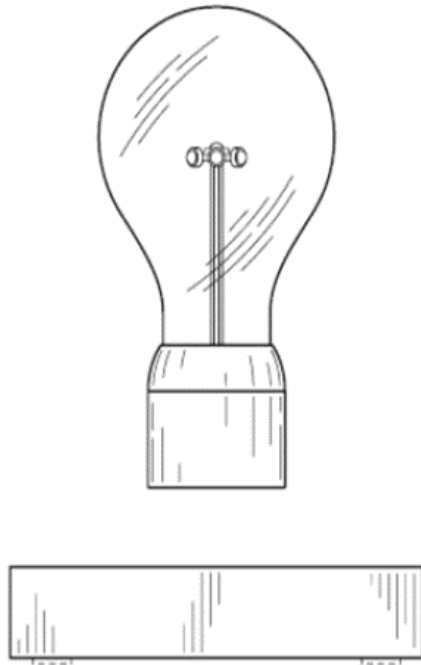
“Based on these visually distinct differences, we are not persuaded that the Round Ink Bottle creates the same visual impression as the claimed bottle design, and accordingly determine that the Round Ink Bottle is not an appropriate primary reference.

On this record, we need not reach the second step of the obviousness analysis for Petitioner’s first and second grounds because Petitioner has failed to show persuasively the existence of a primary reference. See *Rosen*, 673 F.2d at 391 (‘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.’).”

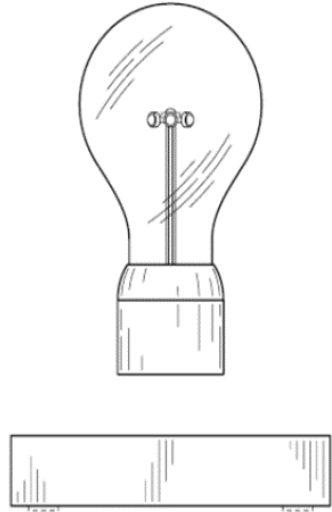


Levitation Arts v. Flyte – PGR2018-00073

D799,100 – “Levitating Bulb and Base”



Levitation Arts v. Flyte – PGR2018-00073



“The claimed design includes ornamental features that are entirely absent or significantly different in the Lieberman design, and which contribute to the overall appearance of the design.”

- Cylindrical cap portion at base versus tapering and threading on end of bulb
- Transparent bulb with visible internal parts versus opaque bulb

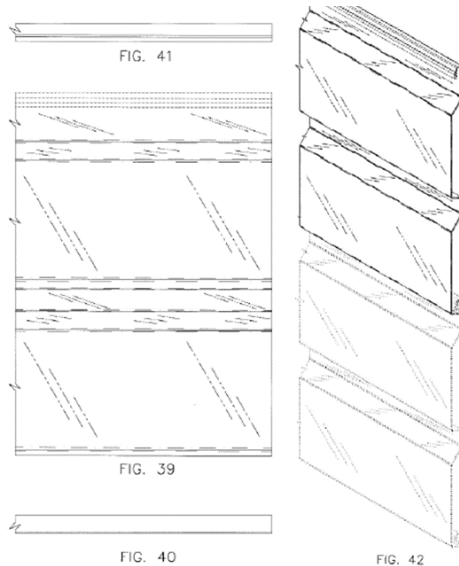
Levitation Arts v. Flyte – PGR2018-00073

Institution denied

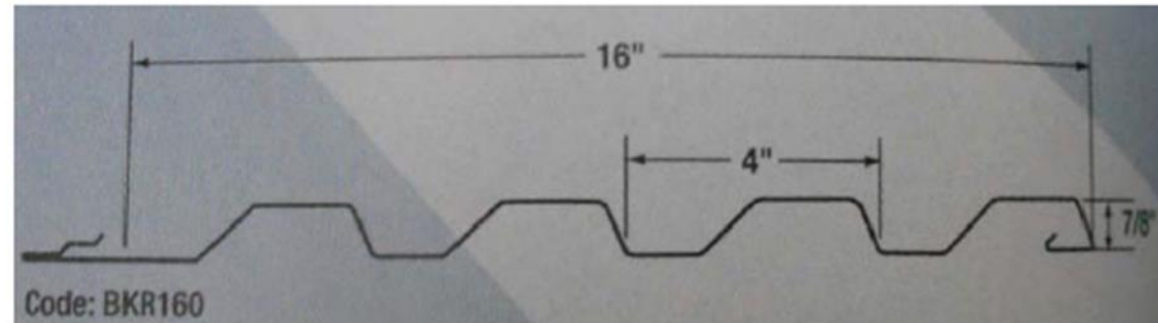
“Petitioner fails to identify ‘a single reference that creates ‘basically the same’ visual impression’ as the patented design. *Durling*, 101 F.3d at 103. Given that failure, we do not reach the second step of the obviousness inquiry, which involves assessing whether the additional references are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other. *In re Rosen*, 673 F.2d at 391; *In re Glavas*, 230 F.2d 447, 450 (CCPA 1956).”

ATAS Int'l, Inc. v. Centria – IPR2013-00259

D527,834 – “Building Panel”



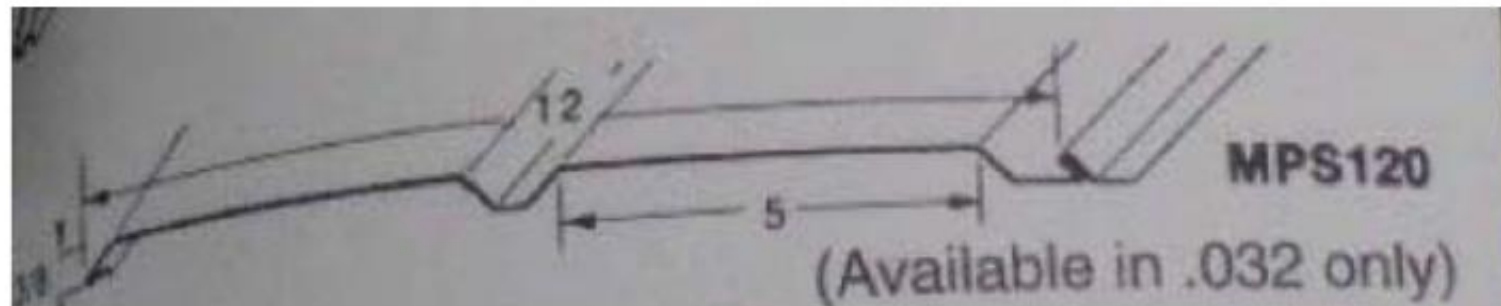
Institution denied



“[T]he overall appearance of the two panels is noticeably different because BKR160 is symmetric and regularly repeating, while the claimed design is asymmetric and irregular. We are, therefore, not persuaded that BKR160 is ‘basically the same’ as the claimed design. See *High Point Design* at *12; *Rosen*, 673 F.2d at 391.”

ATAS Int'l, Inc. v. Centria – IPR2013-00259

Institution denied



Prior Art

Termax Company v. Illinois Tool Works Inc. - IPR2022-00106

Institution denied

Analysis directed to whether references are “so related” in **appearance**—not on utilitarian motivations to combine:

“We cannot agree with Petitioner’s interpretation of the law that ‘other aspects,’ other than the ornamental appearance of two designs as a whole, are relevant to what would have been suggested to an ordinary designer.”

“For design patents, however, the Federal Circuit has made clear that the motivation to modify one design with another is **limited to whether the articles are ‘so related’ (i.e., so similar in appearance)** that an ordinary designer would be naturally led to incorporate the features of one in the other.

Modifications cannot change the fundamental characteristics of the analysis:

“Further, the notably consistent symmetrical nature of both designs would not suggest that a skilled designer would destroy that symmetry by using a rounded platform with a rectangular platform. See *Apple*, 678 F.3d at 1331 (quoting *Rosen*, 673 F.2d at 391, as holding that “rejecting the primary reference where ‘modifications of [it] necessary to achieve [the patented] design would destroy the fundamental characteristics’ of that reference,” when finding a secondary reference “so different in visual appearance from the [primary] reference that it does not qualify as a comparison reference under [the so related] standard”).

Indefiniteness

FISH.

35 U.S.C. §112

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

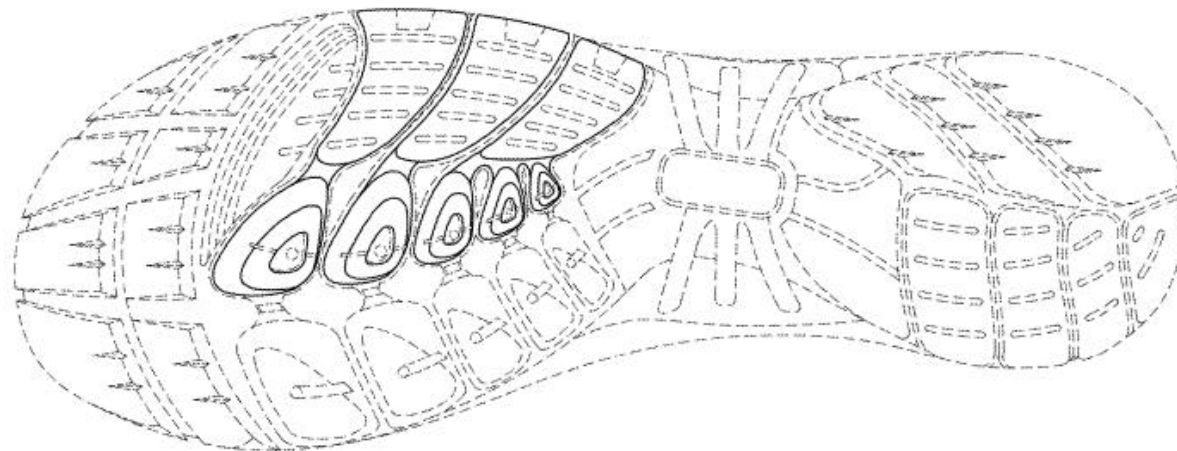
(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

Indefiniteness

“[A] design patent is indefinite under § 112 if **one skilled in the art, viewing the design as would an ordinary observer**, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure.”

In re Maatita, 900 F.3d 1369, 1377 (Fed. Cir. 2018)(clarifying the standard for design patent indefiniteness in view of *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014)).

FIG. 1



D861,302 - “Shoe Bottom”

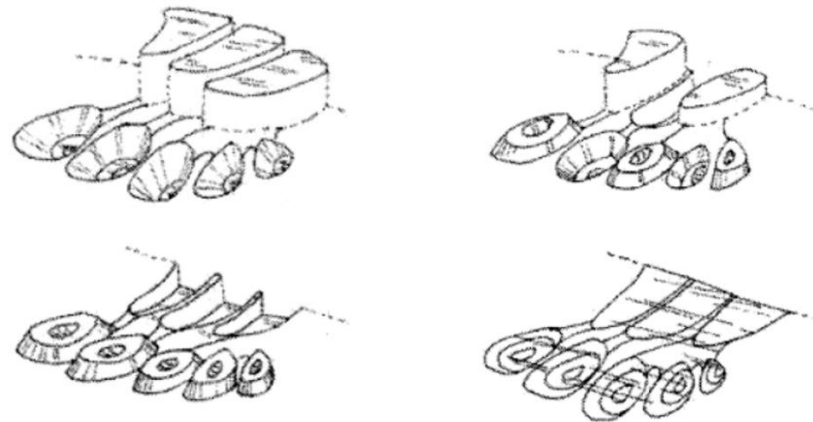
Indefiniteness

“A visual disclosure may be inadequate—and its associated claim indefinite—if it includes multiple, internally inconsistent drawings” that “preclude the overall understanding of the drawing as a whole.”

Maatita, 900 F.3d at 1375–76.

The purpose of indefiniteness in design cases is not to nitpick the draftsman, but to “ensure that the disclosure is clear enough to give potential competitors (who are skilled in the art) notice of what design is claimed – and therefore what would infringe.”

Id. (citing *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902); see also *Ex Parte Asano*, 201 U.S.P.Q. 315, 315 (B.P.A.I. 1978).



Ideavillage Products Corp. v. Koninklijke Philips NV

PGR2021-00116

Petitioner argues that the challenged design claim (D905,346) is indefinite due to “many individual inconsistencies” between figures. PGR2021-00116, Paper 1 (Pet.), 80.

D905,346 – “Blade set”

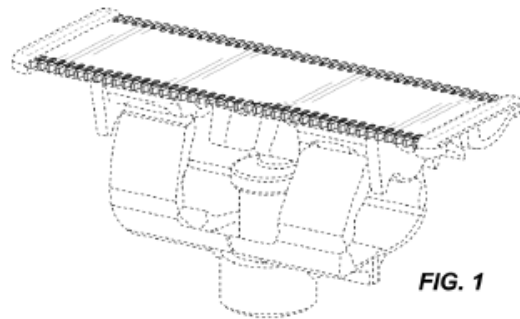
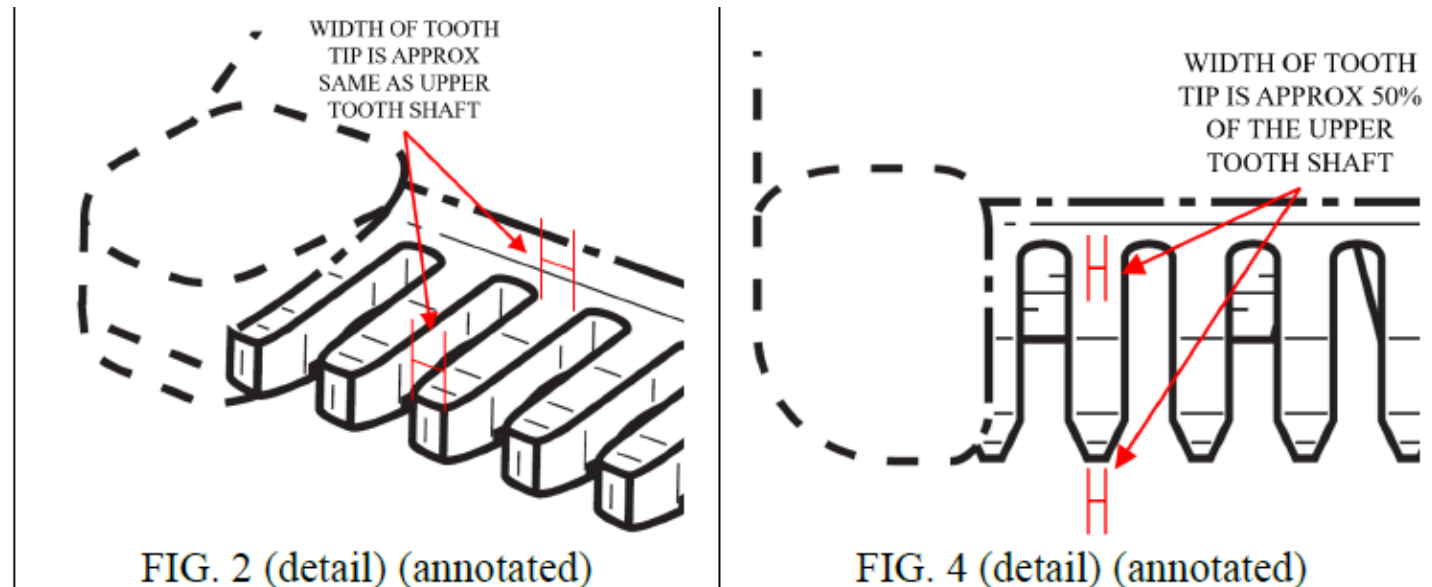


FIG. 1

The shapes of the tips of the teeth are inconsistent between the views

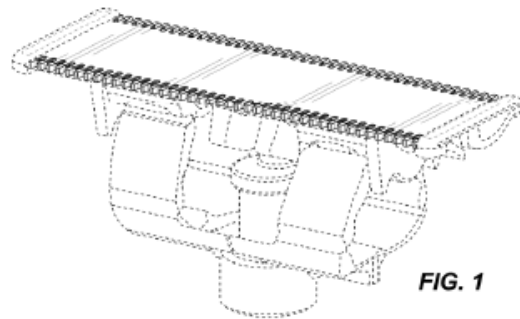


Ideavillage Products Corp. v. Koninklijke Philips NV

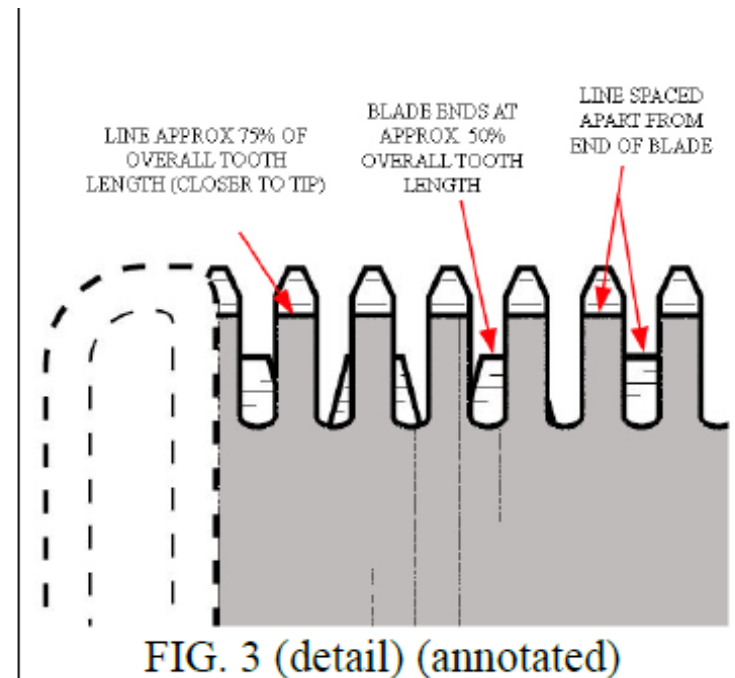
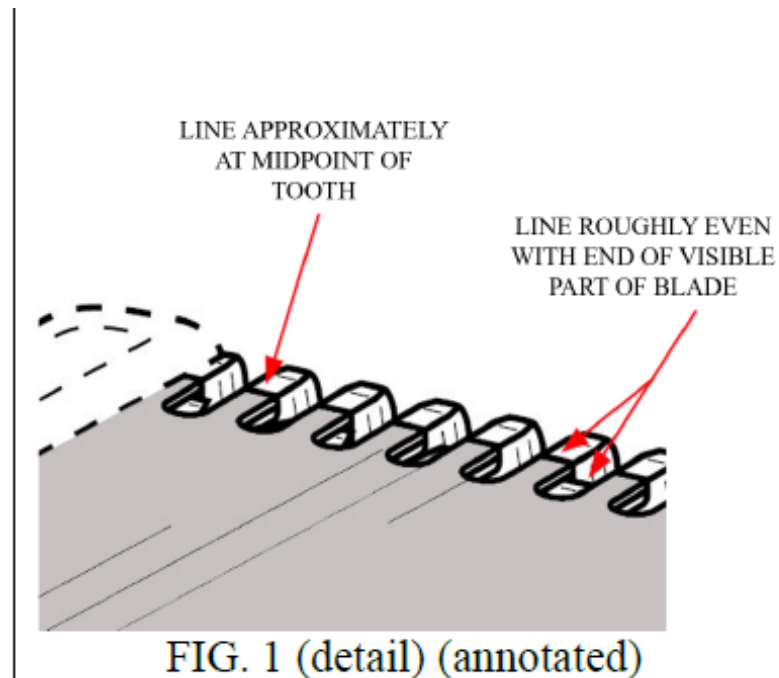
PGR2021-00116

Petitioner argues that the challenged design claim (D905,346) is indefinite due to “many individual inconsistencies” between figures. PGR2021-00116, Paper 1 (Pet.), 80.

D905,346 – “Blade set”



The length of the teeth and corresponding length of the center structure is inconsistent between the figures



Ideavillage Products Corp. v. Koninklijke Philips NV

PGR2021-00116

Institution denied

Analysis directed to the proper standard for review

“Our reviewing court explains that “a design patent is indefinite under § 112 **if one skilled in the art, viewing the design as would an ordinary observer**, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure.” *In re Maatita*, 900 F.3d at 1377.

Although Petitioner purports to apply the *Maatita* standard...Petitioner’s analysis at least once refers to the individual purported inconsistencies from the perspective of the ordinary designer **without accounting for the designer viewing the design as would an ordinary observer**....When Petitioner does refer to the perspective of the ordinary designer, viewing the design as would an ordinary observer, **Petitioner relies on the testimony of Mr. Fletcher, which, in contrast, utilizes the “POSITA.”** IPR2021-00116 (Inst. decision), paper 6, 19-20 (PTAB Mar. 24, 2022).

“Mr. Fletcher does not refer to the perspective of the ordinary observer (or even one skilled in the art, viewing the design as would an ordinary observer) in his opinions regarding indefiniteness....” *Id.* at 21.

Ideavillage Products Corp. v. Koninklijke Philips NV

PGR2021-00116

Institution denied

Indefiniteness analysis needs to be performed under the required perspective:

“**Neither Petitioner nor Mr. Fletcher asserts** that the pertinent hypothetical person—one skilled in the art, viewing the design as would an ordinary observer—**would engage in the magnification exercise or would have detected the purported inconsistencies absent such.** [citing *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871) and *In re Maatita*, 900 F.3d at 1377].” IPR2021-00116 (Inst. decision), paper 6, 21 (PTAB Mar. 24, 2022).

“We determine that Petitioner has not demonstrated that it is more likely than not that the challenged claim is unpatentable as indefinite.” *Id.*, at 22.



Practice Tips

FISH.

Takeaways for Design Patent PTAB Trials

- Likely to see design patents challenged at the PTAB more frequently, but they will continue to represent a small minority of cases.
- It's about the prior art.
- Demonstrating a proper *Rosen* reference can be difficult.
- Don't overlook the importance of claim construction.
- IPR/PGR provides opportunities, even short of final decision of unpatentability.

Takeaways for Protecting Designs

- Always confirm design not anticipated by client publication.
- Imagine the verbal description of your claim scope.
- Draft with varied claim scope in mind.
 - Take advantage of written description.
- Carefully consider the right title for your design as it will impact both patentability and enforcement.
- For critical designs, “picture claims.”



Craig Deutsch
Principal
deutsch@fr.com



Grace Kim
Principal
gkim@fr.com

Thank You!

Please send your NY/NJ CLE forms to email@fr.com

Any questions about the webinar, contact the Events team @ eventsteam@fr.com

A replay of the webinar will be available for viewing at fr.com/webinars

Copyright 2023 Fish & Richardson P.C. The opinions expressed are those of the authors and do not necessarily reflect the views of Fish & Richardson P.C., any other of its lawyers, its clients, or any of its or their respective affiliates. This presentation is for general information purposes and is not intended to be and should not be taken as legal advice and does not establish an attorney-client relationship.

FISH.

These materials may be considered advertising for legal services under the laws and rules of professional conduct of the jurisdictions in which we practice. Legal advice of any nature should be sought from legal counsel. Unsolicited e-mails and information sent to Fish & Richardson P.C. will not be considered confidential and do not create an attorney-client relationship with Fish & Richardson P.C. or any of our attorneys. Furthermore, these communications and materials may be disclosed to others and may not receive a response. If you are not already a client of Fish & Richardson P.C., do not include any confidential information in this message. For more information about Fish & Richardson P.C. and our practices, please visit www.fr.com.