

Morning Session 2:

The Current State of the Law Under 35 U.S.C. §§ 102, 103 and 112 #designlaw16







The Panelists

- Perry J. Saidman
 - Principal | Saidman DesignLaw Group, LLC
- Elizabeth Ferrill
 - Partner | Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
- Bill LaMarca
 - Special Counsel for Intellectual Property Litigation | USPTO, Office of the Solicitor

§ 112: New Guidelines?

- Update on new written description guidelines:
 - PTO still processing comments received. Find them at:
 - https://www.uspto.gov/patent/laws-and-regulations/comments-public/comments-application-written-description-requirement
 - PTO expects to issue a notice to the public responding to the comments within the next few months.

§ 112: Skechers v. Nike (IPR)

 Skechers sought invalidation of a Nike patent, alleging noncompliance with the written description requirement by the introduction of new matter.



§ 112: Skechers v. Nike (IPR)

- Board found § 112 satisfied, and denied institution of the IPR.
 - "we are not persuaded by Skechers's comparative micro-analysis of the drawings ... and the photographs ... e.g., comparisons detailing minor drawing inconsistencies, slight shading variations, and use of broken lines ... that 'Nike has claimed an entirely new design...'" from what was disclosed in the photographs.
- "Range of reasonableness"
 - The Board found the photographs to "fall within a range of reasonableness required for providing sufficient written description."
 - Skechers "[over-emphasized] fairly trivial inconsistencies."

§ 112: Skechers v. Nike (IPR)

"Show and delineate"

- The shoe upper was reduced to broken lines, which Skechers argued introduced new matter.
- "we are not persuaded that the photographs ... fail to clearly show and delineate the claimed midsole elements of the design in addition to the upper and outsole elements, showing that the inventor had possession of the invention..."



§ 102

Obviousness Framework

Primary Reference

Design characteristics of which are *basically the same as* the claimed design

- (1) discern the *correct visual impression* created by the patented design as a whole;
- (2) single reference that creates "basically the same" visual impression

Secondary Reference

Can modify the primary reference "to create a design that has the *same overall visual appearance* as the claimed design."

Appearance of certain ornamental features in one would *suggest the application of those features* to the other

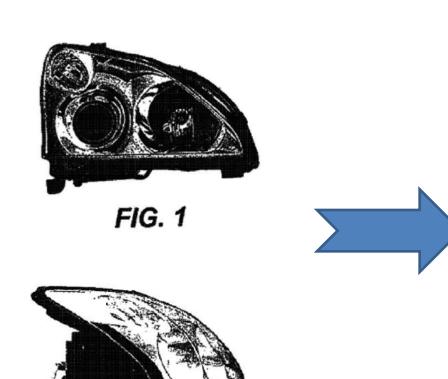


FIG. 3

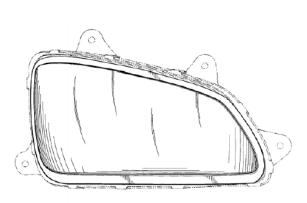


Fig.9.

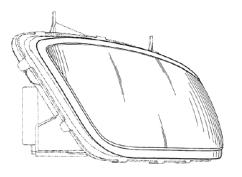
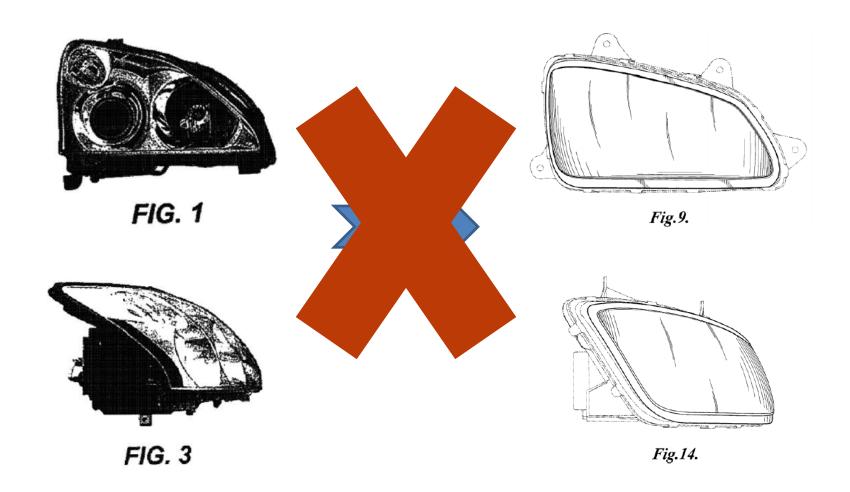


Fig.14.



- Different visual impressions
- Relative length of sides, angles between sides

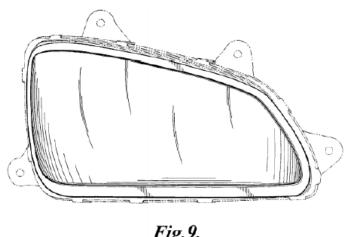


Fig.9.

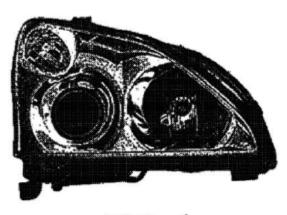


FIG. 1

Claimed Design

Kobayashi

IPR2014-00555 (Sept. 5, 2014)

- Different visual impressions
- Relative length of sides, angles between sides

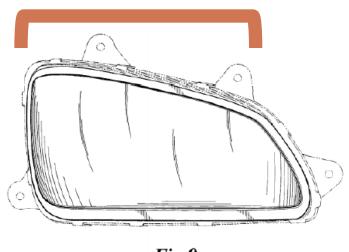


Fig.9.

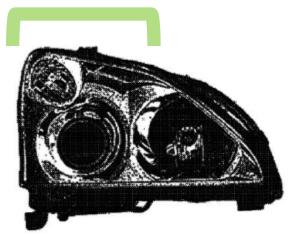


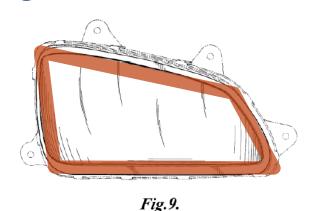
FIG. 1

Claimed Design

Kobayashi

IPR2014-00555 (Sept. 5, 2014)

 D429 gives the visual impression of a four-sided trapezoid, while Kobayashi gives the impression of a right triangle with a hypotenuse formed by its top and right sides.



Claimed Design

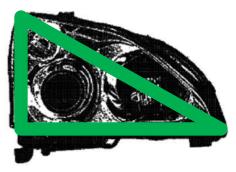
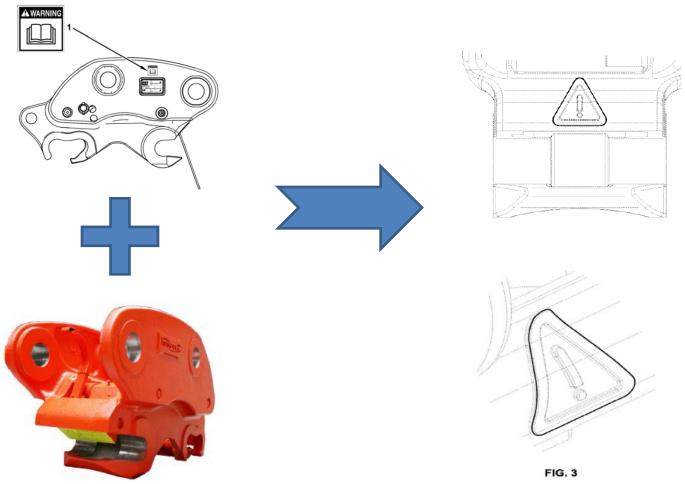
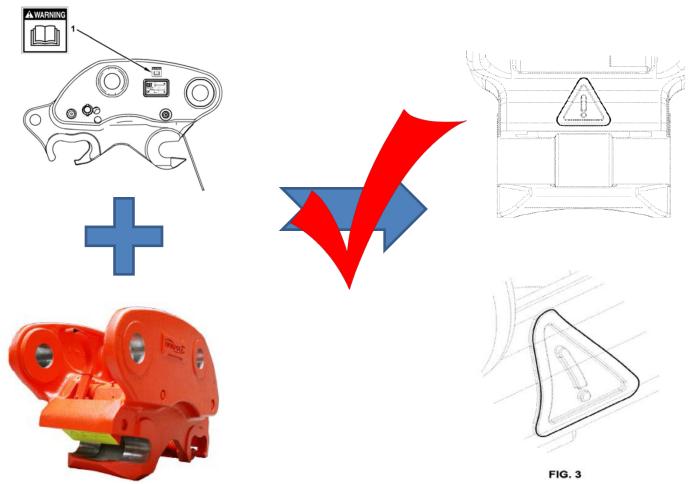


FIG. 1

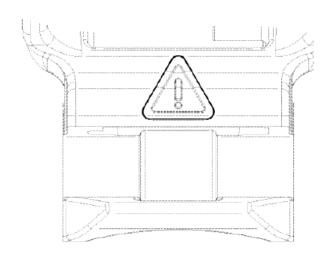
Kobayashi

IPR2014-00555 (Sept. 5, 2014)

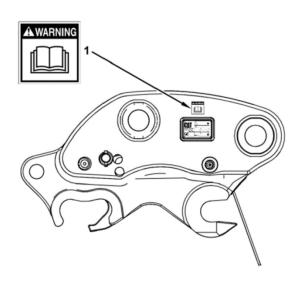




 "The Coupler Manual is a suitable primary reference because the Coupler Manual warning symbol gives the same overall visual impression when compared to the claimed warning symbol design as a whole."

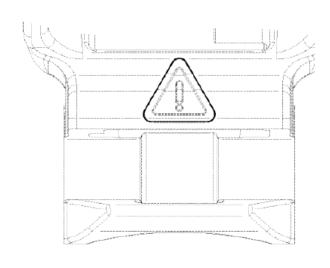


Claimed Design

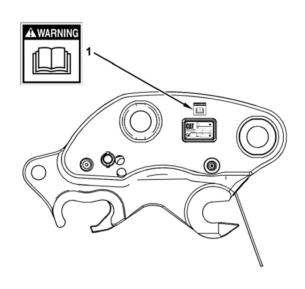


Coupler Manual

 "The requirement that the design characteristics of the proposed primary reference be the same as the claimed design does not imply that the appearance of the prior art article must be identical to the claimed design."

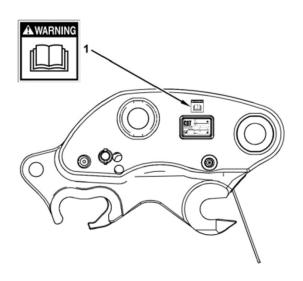


Claimed Design



Coupler Manual

 "Hub is a suitable secondary reference because Hub, like the Coupler Manual, also discloses a coupler for an earthmoving machine."



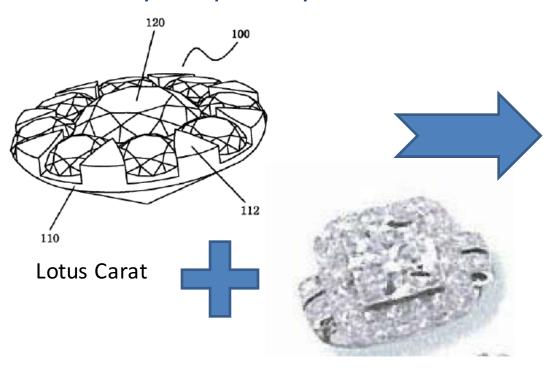
Coupler Manual



Hub

Premier Gem v. Wing Yee Gems

 Not shown that POSITA would have used the reference to modify the primary



Heritage Art Deco

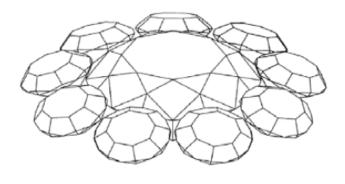


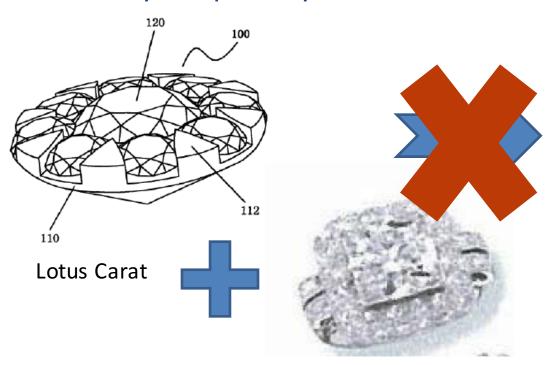
FIG. 1

Claimed Design

IPR2015-00416 (July 5, 2016)

Premier Gem v. Wing Yee Gems

 Not shown that POSITA would have used the reference to modify the primary



Heritage Art Deco

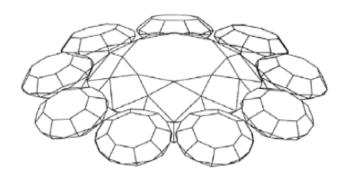


FIG. 1

Claimed Design

IPR2015-00416 (July 5, 2016)

Premier Gem v. Wing Yee Gems

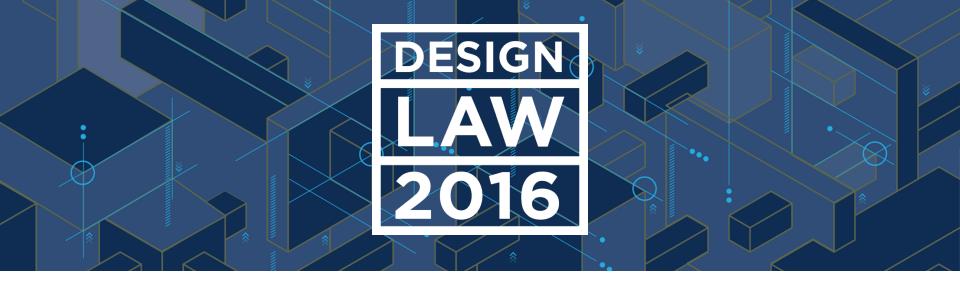
- "Petitioner appears to have selectively chosen certain design features of the secondary references (the mixing of stones of different cuts) while deliberately ignoring other design features of those references just so the claimed design would result."
- "This selective use of the design characteristics of the prior art suggests that it is driven by a hindsight reconstruction of the invention rather than the objective teachings of the references."

IPR2015-00416 (July 5, 2016)

Summary of PTO Design Appeals to CAFC

Summary of PTO Design Appeals to CAFC over last 15 years:

- In re Hardy, 600 Fed. Appx. 773 (Fed. Cir. 2015) (§103 obviousness, R.36)
 - o claim directed to a wire mesh basket design
- In re Alsabah, 621 Fed. Appx. 659 (Fed. Cir. 2015) (§171 "article of manufacture," R.36)
 - o claim directed to teaching aid for teaching Arabic in the form of a table of information
- *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013) (§112, 1st and §120 priority)
 - o claim directed to a bottle design
- Vanguard v. Kappos & Bank of America, 407 Fed. Appx. 479 (Fed. Cir. 2011) (§103 obviousness in context of an IP reexamination. R.36)
 - o claim directed to a design for a data card with rounded edges, a black strip and aperture
- In re Hardy, 202 F. Appx. 459 (Fed. Cir. 2006) (§103 obviousness, R.36) o claim directed to a wire mesh basket design
- In re Hardy, 106 Fed. Appx. 46 (Fed. Cir. 2004) (§103 obviousness, dismissed)
 - o claim directed to a wire mesh basket design
- In re Haruna, 249 F.3d 1327 (Fed. Cir. 2001) (§103 obviousness, reversed)
 - o claim directed to an optical disc design
- In re Harvey, 12 F.3d 1061 (Fed. Cir. 1993)(§103 obviousness, reversed)
 - claim directed to ornamental designs for a vase



Thank you!

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