

DESIGN LAW 2016

ANTICIPATION

George Washington University Law School

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Perry J. Saidman

SAIDMAN **DESIGNLAW** GROUP, LLC

www.designlawgroup.com







Black Letter Law

A claim is anticipated only if *each and every element* as set forth in the claim *is found*, either expressly or inherently described, *in a single prior art reference*.

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)

Black Letter Law

“The *identical invention must be shown* in as complete detail as is contained in the ... claim.”

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added).

Black Letter Law

Under 35 U.S.C. 102... *to anticipate a claim, the disclosure must teach every element of the claim.*
(emphasis added).

M.P.E.P. 2131

Black Letter Law

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 ... (emphasis added).

35 U.S.C. 103

Hupp v. Siroflex
122 F.3d 1456 (Fed. Cir. 1997)

As with a utility patent, design patent anticipation requires a showing that a single prior art reference is **identical** in all material respects to the claimed design.

And then ... along came ...

International Seaway v. Walgreens
589 F.3d 1233 (Fed. Cir. 2009)

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589 F.3d 1233 (Fed. Cir. 2009)

The worst decision
from the Federal
Circuit...

International Seaway v. Walgreens

589 F.3d 1233 (Fed. Cir. 2009)

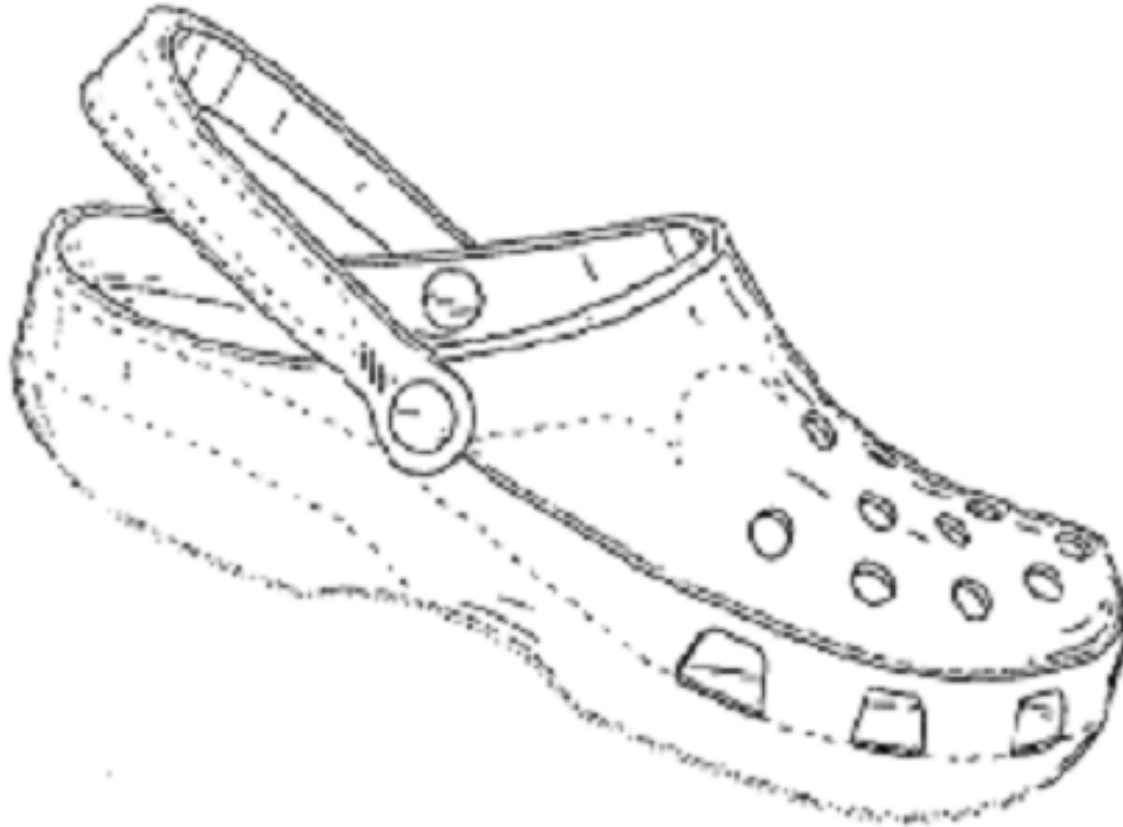
The worst decision
from the Federal
Circuit... *literally.*





International Seaway v. Walgreens

589 F.3d 1233 (Fed. Cir. 2009)



International Seaway v. Walgreens

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“... The ordinary observer test must logically be the sole test for anticipation”...

International Seaway v. Walgreens

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Ordinary Observer Test:

If in the eye of an ordinary observer, two designs are substantially the same, then there's infringement (*Gorham, Egyptian*)

Court: [This] “must logically be the sole test for anticipation”...

International Seaway v. Walgreens

589 F.3d 1233 (Fed. Cir. 2009)

Translation:

If the prior art is “substantially the same” as the claimed design, then the claimed design is anticipated by that prior art.

To anticipate a claim:

pre-Seaway: the prior art must be identical to the claimed design.

To anticipate a claim:

pre-Seaway: the prior art must be identical to the claimed design.

Seaway: the prior art must be substantially the same as the claimed design.



International Seaway v. Walgreens

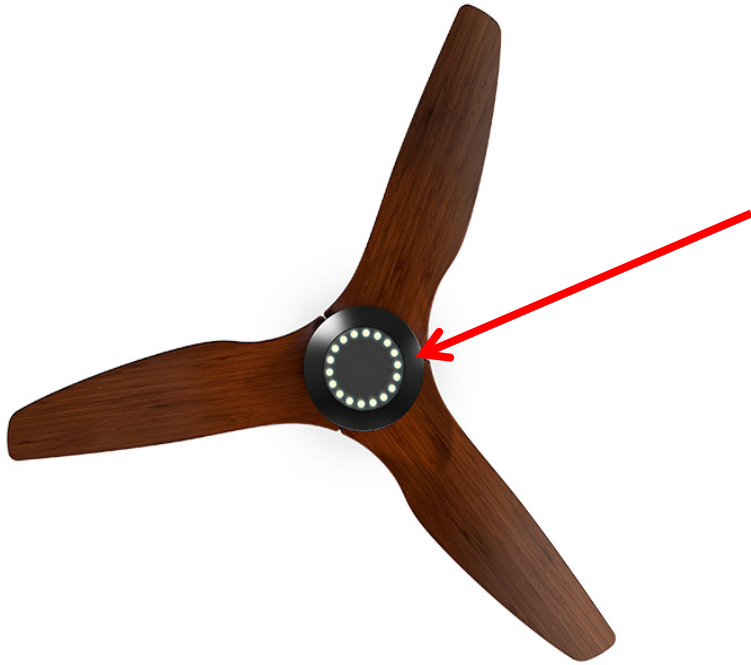
589 F.3d 1233 (Fed. Cir. 2009)



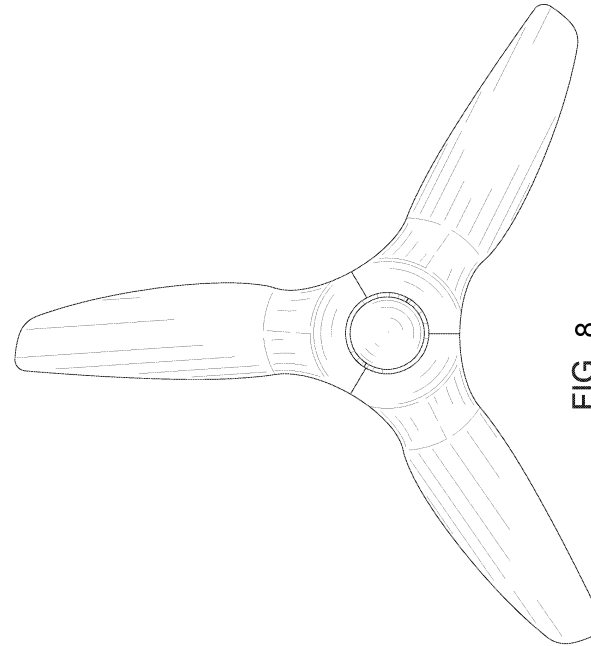
NO BIG DEAL



I. Actual 102 Rejection by USPTO



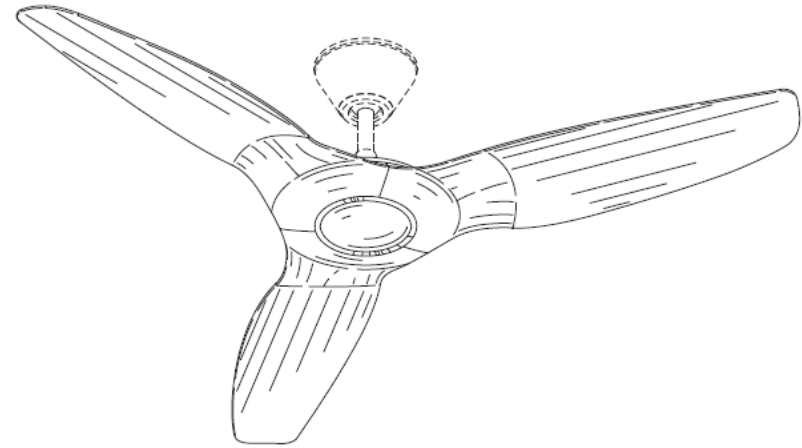
Prior Art #1



Claimed Design



Prior Art #1



Claimed Design

USPTO Logic in 102 Rejection

“The appearance of the [Prior Art #1] fan is *substantially the same* as that of the claimed design. The ordinary observer test is the sole test for anticipation.” [citing *Seaway*]

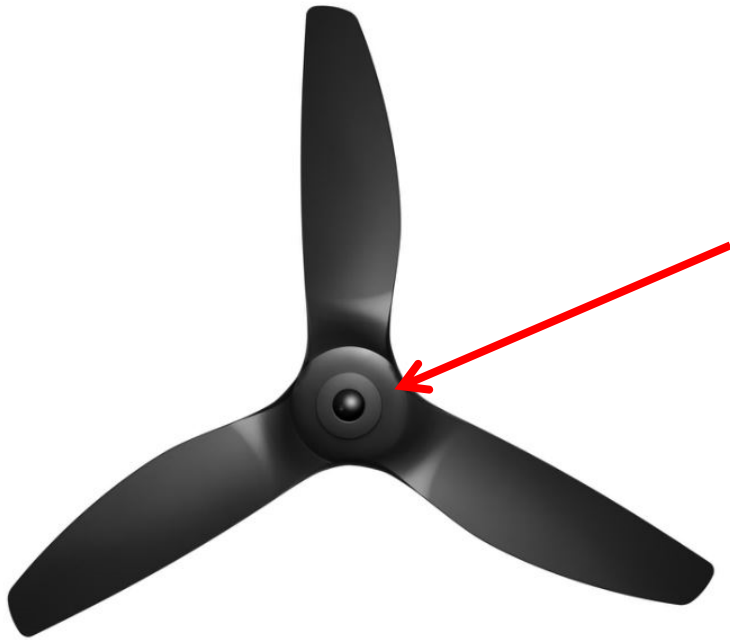
USPTO Logic in 102 Rejection

“Two designs are *substantially the same* if their resemblance is deceptive to the extent that it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design supposing it to be the other.” [citing *Gorham v. White*]

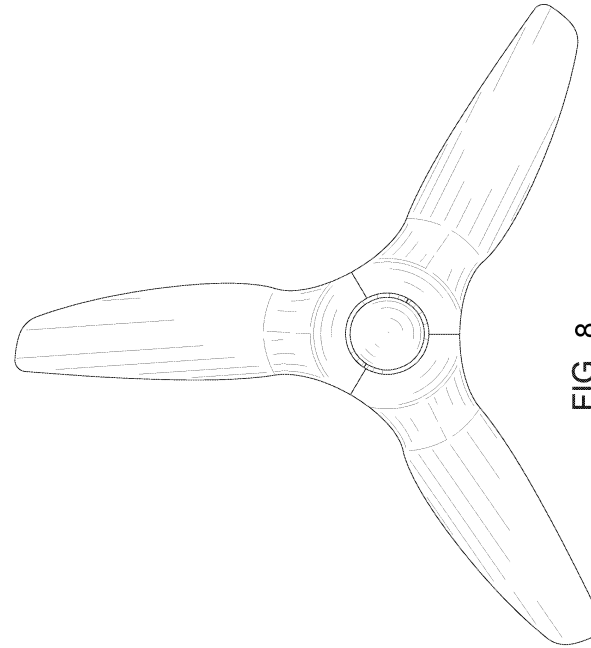
USPTO Logic in 102 Rejection

“The mandated overall comparison is a comparison taking into account significant differences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another. Just as ‘minor differences between a patented and an accused article’s design cannot, and shall not, prevent a finding of infringement’, so too minor differences cannot prevent a finding of anticipation.’ [citing *Seaway*].

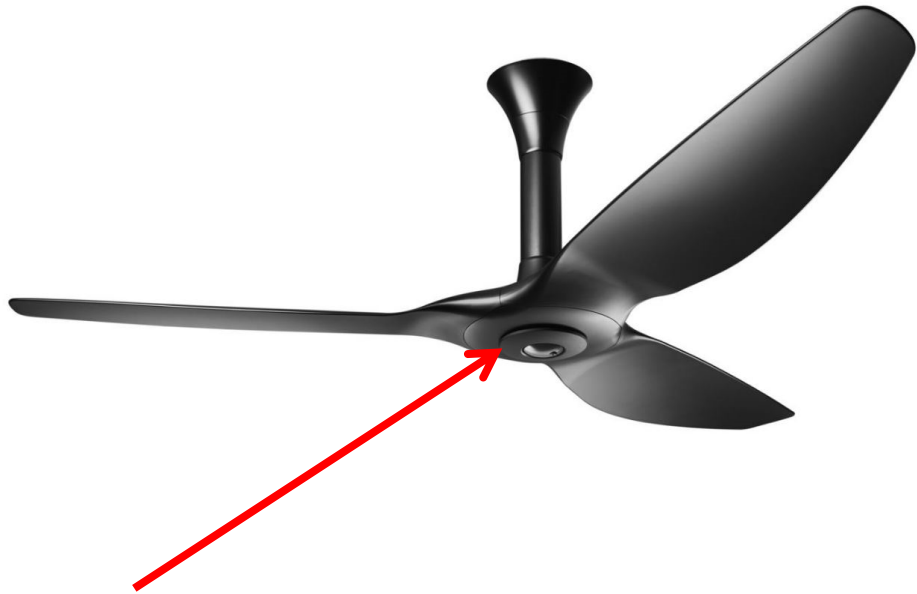
2. Actual 102 Rejection by USPTO



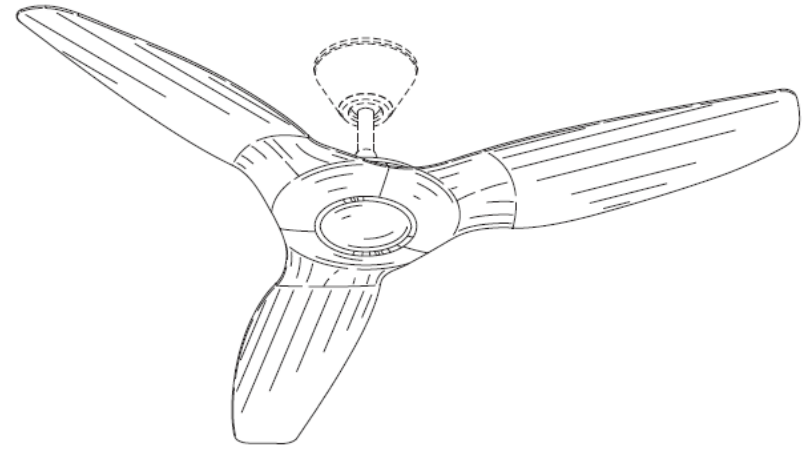
Prior Art #2



Claimed Design

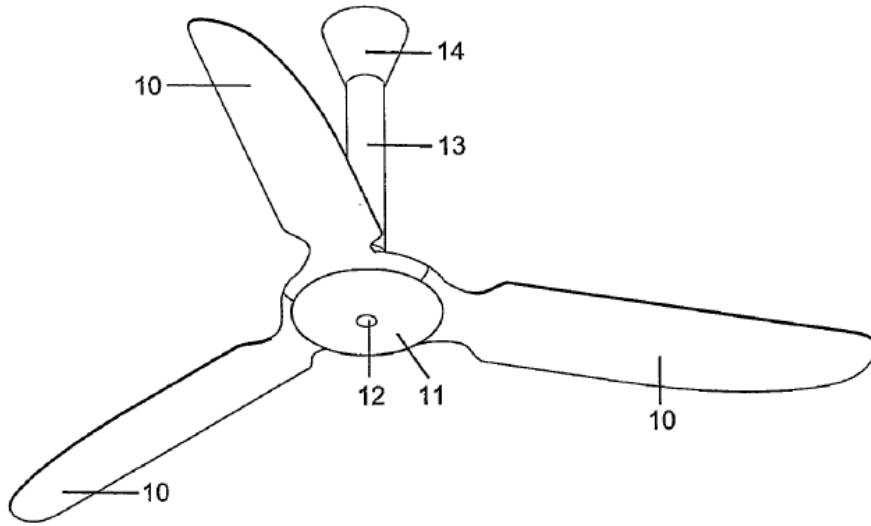


Prior Art #2



Claimed Design

3. Actual 102 Rejection by USPTO



Prior Art #3

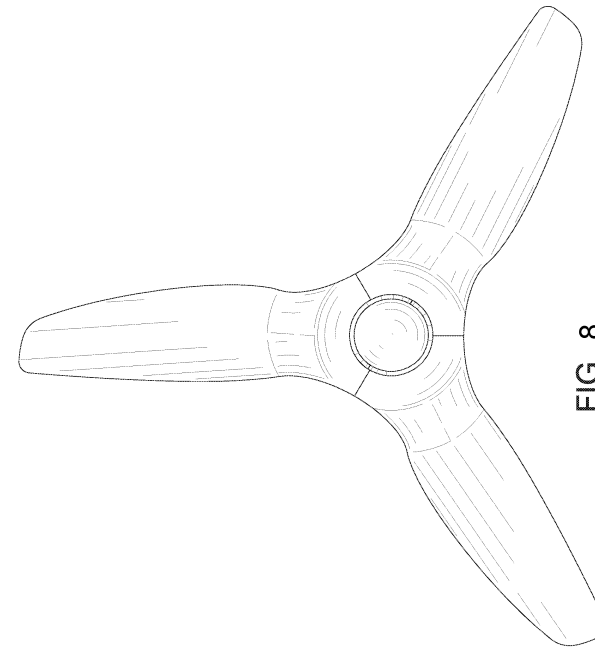
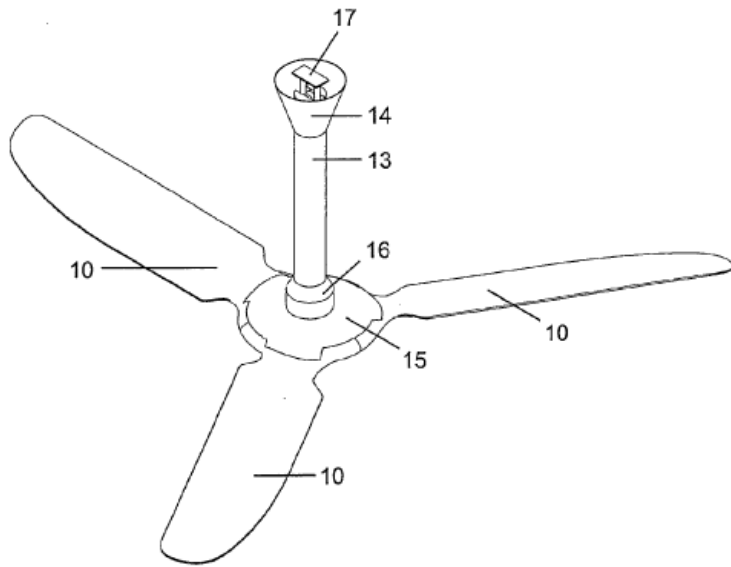
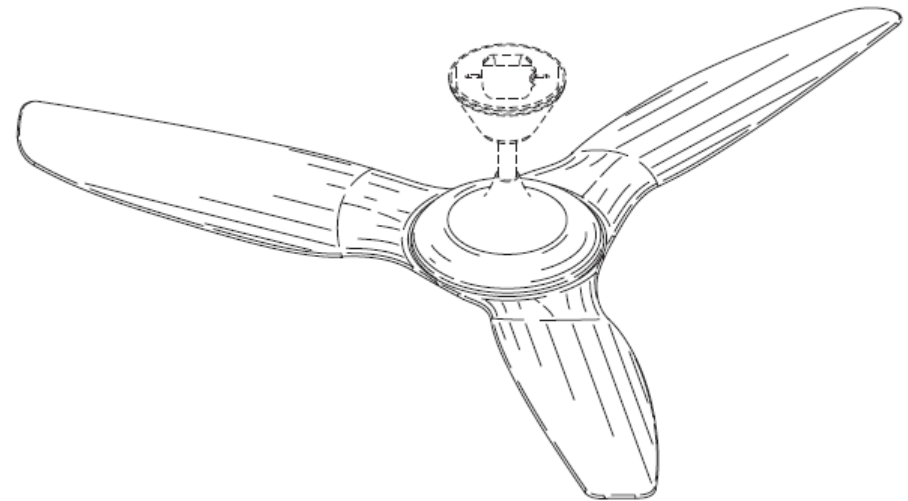


FIG. 8

Claimed Design



Prior Art #3



Claimed Design





Net Effect in USPTO

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1. More 102 rejections than ever before.

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Net Effect in USPTO

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3. *Alice in Wonderland* effect: 102 rejections without 103 rejections.
4. PTO in effect deciding infringement.
5. 102 traversal reduced to arguing differences between prior art and claimed design – morphing into 103 analysis.
6. PTO is avoiding 103's rigorous tests for primary and secondary references.

Egyptian Goddess v. Swisa

543 F.3d 665 (Fed. Cir. 2008)

In evaluating infringement, the ordinary observer is deemed to view the differences between the patented design and the accused product *in the context of the prior art.*

Egyptian Goddess v. Swisa

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In evaluating anticipation, the ordinary observer is deemed to view the differences between the claimed design and the anticipating reference *in the context of the prior art.*

Egyptian Goddess v. Swisa

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In evaluating anticipation, the ordinary observer is deemed to view the differences between the claimed design and the anticipating reference *in the context of the prior art.*

So, USPTO must evaluate anticipation by a prior art reference in light of its prior art.



WHERE DID WE GO WRONG?





What is the basis for *International Seaway?*

Peters v. Active Mfg. Co.
129 U.S. 530 (1889)

MAXIM:
“That which
infringes, if
later, would
anticipate, if
earlier”.



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Peters v. Active Mfg. Co.
129 U.S. 530 (1889)

If the accused design infringes the claim, then the accused design would anticipate the claim if it were prior art.

Graver Tank v. Linde Air Products

339 U.S. 605 (1950)

Doctrine of Equivalents:

Even if there's no literal infringement, infringement may nevertheless be found if the accused product performs “*substantially the same function, in substantially the same way, to produce the same result.*” (emphasis added)

Lewmar Marine v. Barient

827 F.2d 744 (Fed. Cir. 1987)

Federal Circuit: We need to adjust the *Peters v. Active* maxim to take the DoE into account:

“[t]hat which would *literally* infringe if later in time anticipates if earlier than the date of invention”

Lewmar Marine v. Barient

827 F.2d 744 (Fed. Cir. 1987)

A product which infringes via the doctrine of equivalents – by definition a product that is different in one or more respects than the claimed invention – would not necessarily anticipate the claimed invention were it to be prior art.

Lewmar Marine v. Barient

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A product which infringes via the doctrine of equivalents – by definition a product that is different in one or more respects than the claimed invention – would not necessarily anticipate the claimed invention were it to be prior art.

In modern jurisprudence the “maxim” only makes sense in cases of literal infringement, since anticipation requires that each and every element of the claimed invention be found in a single prior art reference and literal infringement requires that each and every element of the claimed invention be found in the accused product.

Lee v. Dayton-Hudson
838 F.2d 1186 (Fed. Cir. 1988)

“While [*Graver Tank*] is not directly applicable to design patents, it has long been recognized that the principles of equivalency are applicable under *Gorham* which uses *substantially the same* as the measure for infringement ...” (emphasis added)

Lee v. Dayton-Hudson
838 F.2d 1186 (Fed. Cir. 1988)

The test for design patent infringement is a doctrine of equivalents (DoE) test.

Peters v Active (modified by *Lewmar*)

anticipates  literal infringement

Peters v Active (modified by Lewmar)

anticipates  literal infringement

anticipates  DoE infringement

Lee v. Dayton-Hudson
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The test for design patent infringement is a doctrine of equivalents (DoE) test.

Peters v Active (modified by Lewmar)

anticipates  literal infringement

anticipates  DoE infringement

Seaway (design patents)

anticipates  DoE infringement

Seaway is wrong because:

It failed to take Lewmar's "literally" modifier into account.



HIS FAULT

HER FAULT

THEIR FAULT

NOT ME

*Let us return to those
thrilling days of
yesteryear...*





HULTON ARCHIVE/GETTY IMAGES/FILE

Hupp v. Siroflex
122 F.3d 1456 (Fed. Cir. 1997)

As with a utility patent, design patent anticipation requires a showing that a single prior art reference is **identical** in all material respects to the claimed design.

