

Design Patent Claims Amendment, Reissue, Validity Challenges: Recent Court Treatment and USPTO Guidance

TUESDAY, JUNE 22, 2021

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

Today's faculty features:

Elizabeth D. Ferrill, Partner, **Finnegan Henderson Farabow Garrett & Dunner**, Washington, DC

George Raynal, Principal, **Saidman DesignLaw Group**, Silver Spring, MD

Richard S. Stockton, Attorney, **Banner Witcoff**, Chicago, IL

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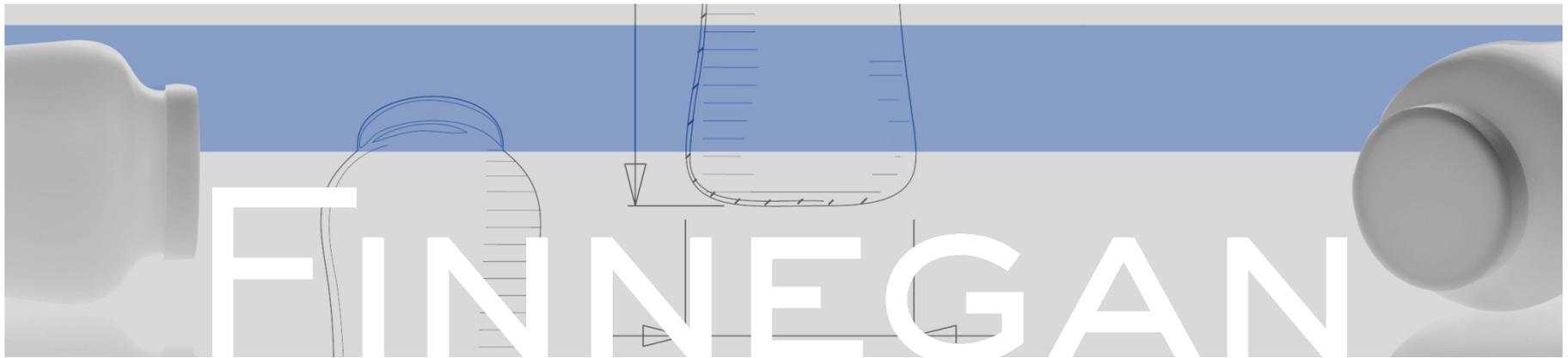
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Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Design Patent Claims Amendments

June 22, 2021

Elizabeth Ferrill

- Relevant statutes and MPEP
- Changing shape or configuration
- Changing surface ornamentation
- Changing illustration style
- Changing the breadth of the claim

(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.

35 U.S.C. § 112 – Definiteness & Enablement

(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.

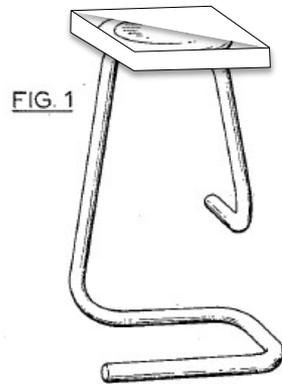
- Specification “shall conclude with one . . . claim[] particularly pointing out and distinctly claiming the subject matter”
 - “as shown” – figures only
 - “as shown and described” – figures and special description (e.g., broken lines, transparency, mirror image), disclaimer, reservation statement
- Inconsistent or unclear figures may fail to “point out and distinctly claim” the subject matter (MPEP 1504.04) depending on the magnitude of the issues

- “An amendment to the claim must have support in the original disclosure. See 35 U.S.C. 132; 37 CFR 1.121(f).”
- “New matter is subject matter which has no support in the original specification, drawings or claim (MPEP § 608.04(a)).” MPEP 1504.04, I.B.

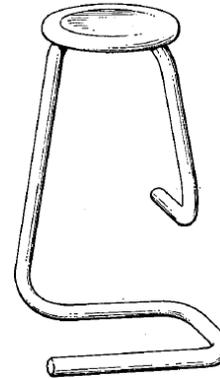
Change in Configuration: *In re Salmon*

In re Salmon, 705 F.2d 1579 (Fed. Cir. 1983)

- Philip Salmon filed:
 - 1st application - square stool design (abandoned)
 - 2nd application - round stool design (patented)



1st Application

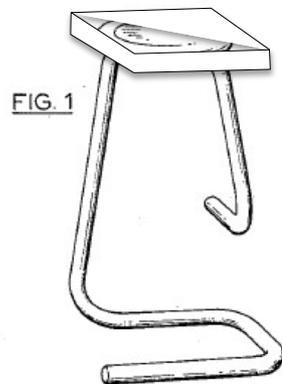


2nd Application

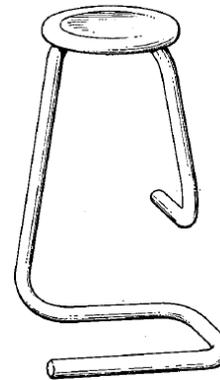
Change in Configuration: *In re Salmon*

In re Salmon, 705 F.2d 1579 (Fed. Cir. 1983)

- The court did not allow priority to be claimed, because the square-stool application did not provide § 112 written-description support for the round-stool design



1st Application



2nd Application

Change in Surface Ornamentation: *In re Daniels*

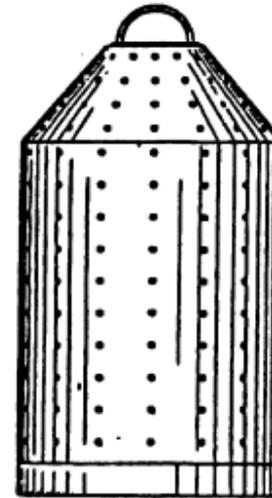
144 F.3d 1452 (Fed. Cir. 1998)

FIG. 1



Original

FIG. 1



Amendment

35 U.S.C. § 112 – Written Description

(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.

Written Description

- Same test for sufficiency as in utility patents:
“[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010)
- From the perspective of the ordinary designer

Racing Strollers v. TRI Industries

878 F.2d 1418, 1420 (Fed Cir. 1989) (*en banc*)

- “[M]eeting the [written description] requirement of § 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein.”

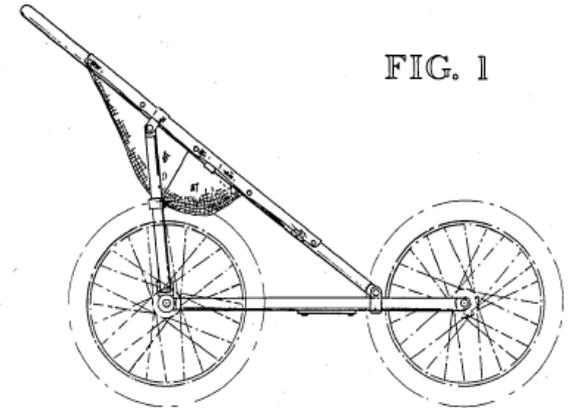


FIG. 1

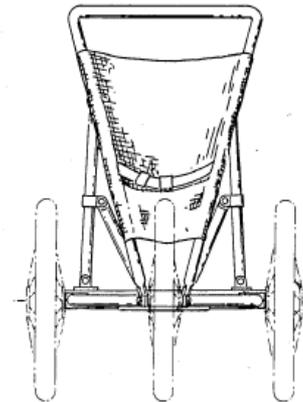


FIG. 2

C&D Zodiac, Inc. v. B/E Aerospace, Inc.

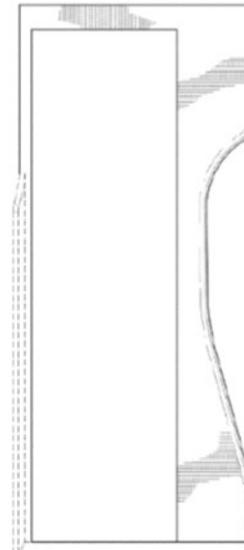
No. PGR2017-00019, (P.T.A.B. Oct 23, 2018)

- **Issues:**
 - Whether the '031 patent could claim priority to the '063 application due to lack of written description
 - Whether the '031 patent was invalid



Prior art reference

FIG. 1



Claimed Design

C&D Zodiac, Inc. v. B/E Aerospace, Inc.

No. PGR2017-00019, (P.T.A.B. Oct 23, 2018)

- C&D Zodiac argued
 - '031 patent contained smoother angles than the '063 application
 - '063 application described a perpendicular intersecting wall

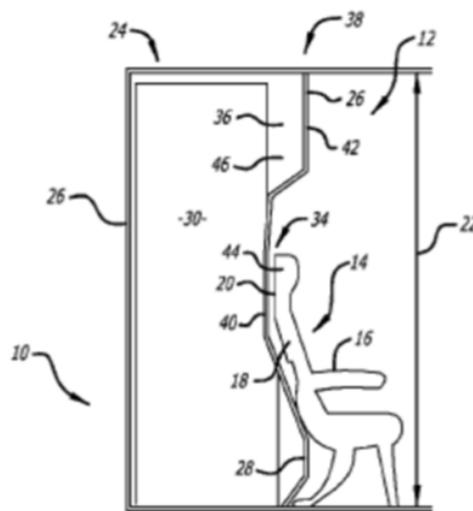


Figure from '063 application

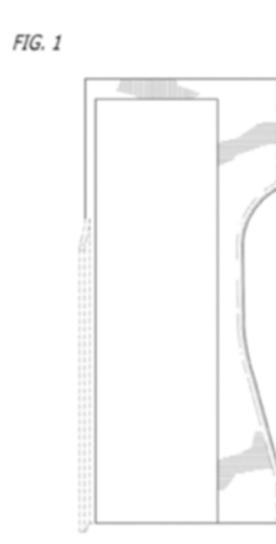


Figure from '031 patent

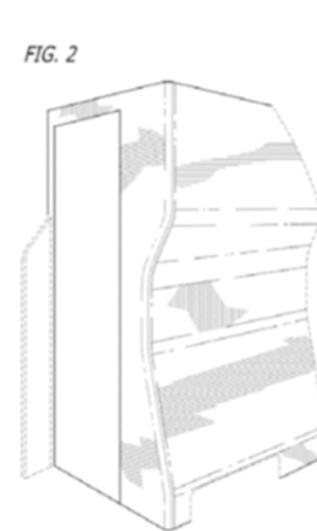


Figure from '031 patent

C&D Zodiac, Inc. v. B/E Aerospace, Inc.

No. PGR2017-00019, (P.T.A.B. Oct 23, 2018)



"Spacewall"

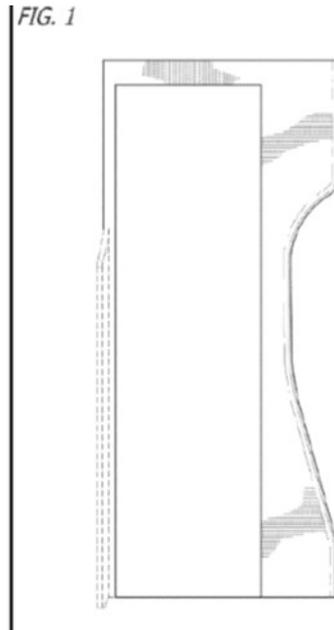


Figure from '031 Patent

- Board agreed with C&D Zodiac
- The '063 patent did not have adequate written description for the '031 patent to claim priority to it; therefore instituted as a PGR
- Invalidated the '031 patent for violating the on-sale bar

Levitation Arts, Inc. v. Flytye LLC

No. PGR2018-00073, (P.T.A.B. Jan. 17, 2019)

- Application claimed priority to EU Community Design filed on November 4, 2015
- Issue:
 - Whether the EU application proved that Flytye possessed “a base and floating light bulb with the horizontally-aligned seven LED Lighting element[s] claimed in the ’100 patent”

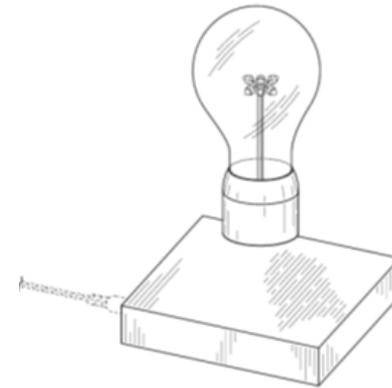
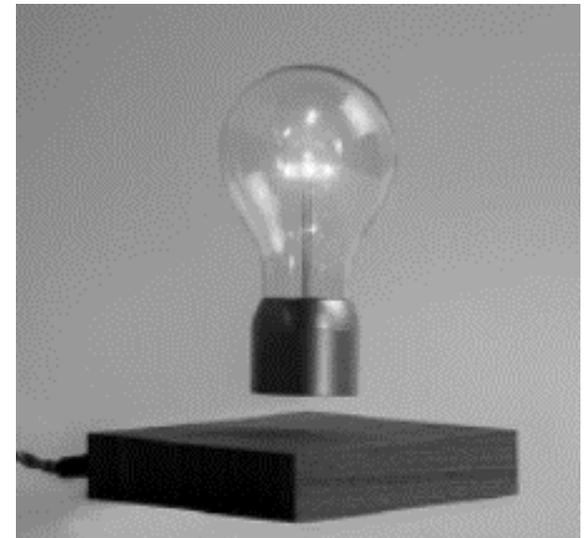


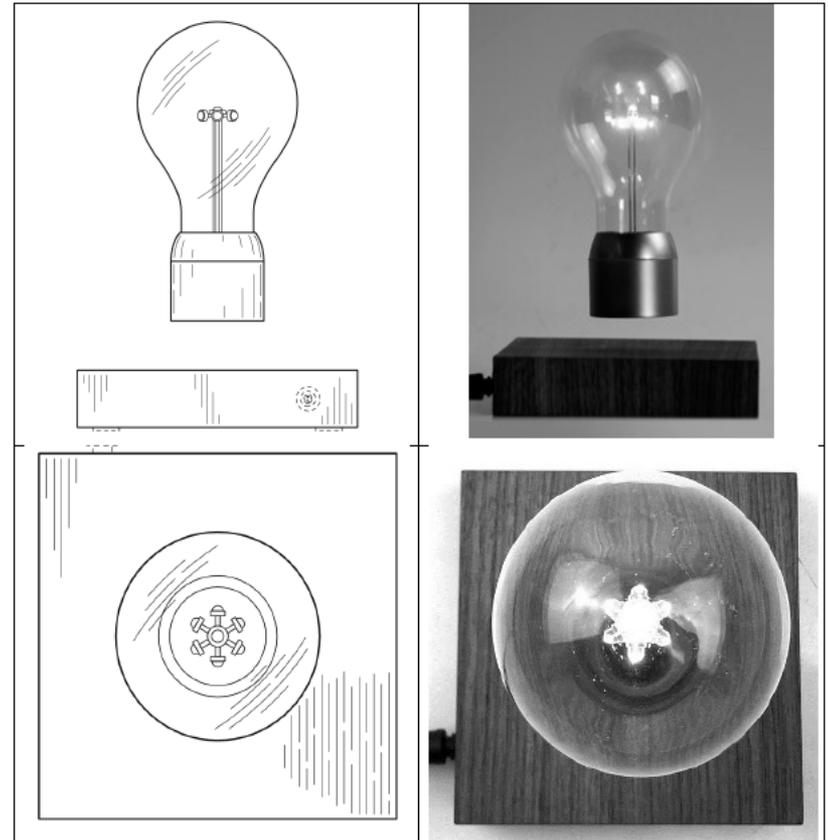
FIG. 1



Levitation Arts, Inc. v. Flytye LLC

No. PGR2018-00073, (P.T.A.B. Jan. 17, 2019)

- Board determined that the EU application proved possession
- Practice tips:
 - Do not conduct a “micro-analysis”
 - Do not distort or enlarge figures



Skechers U.S.A., Inc. v. Nike, Inc.

IPR 2016-00870 (D725,356), Decided September 29, 2016



FIG. 17

Priority Application

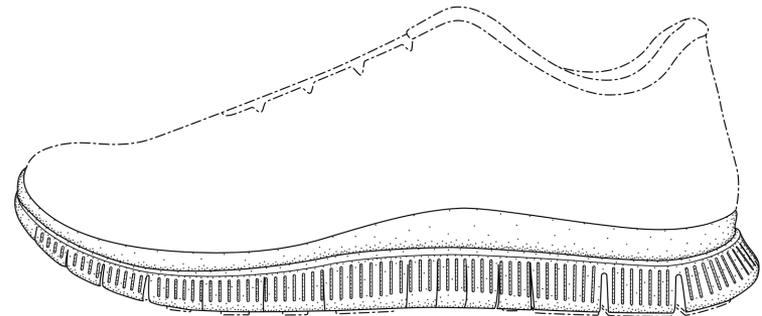


FIG. 2

Child Application

- Photograph to line drawings
- Converting some disclosure to broken lines
- Priority claim upheld (institution denied)

Application No. 29/461,780 (S.C. Johnson & Son)

Appeal 2019-001900, Decided September 17, 2019

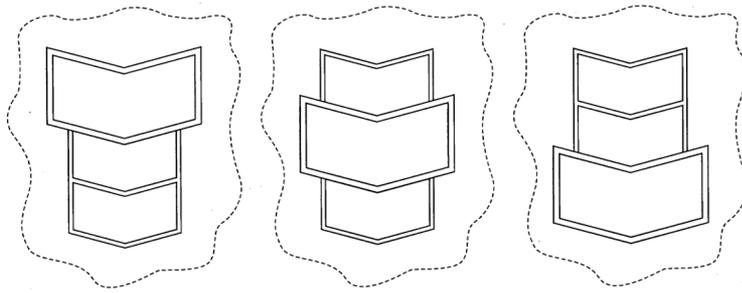


FIG. 1

FIG. 2

FIG. 3

Original Figures

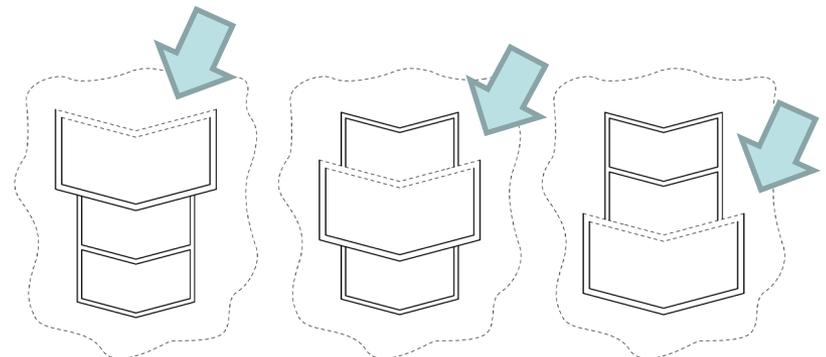


FIG. 1

FIG. 2

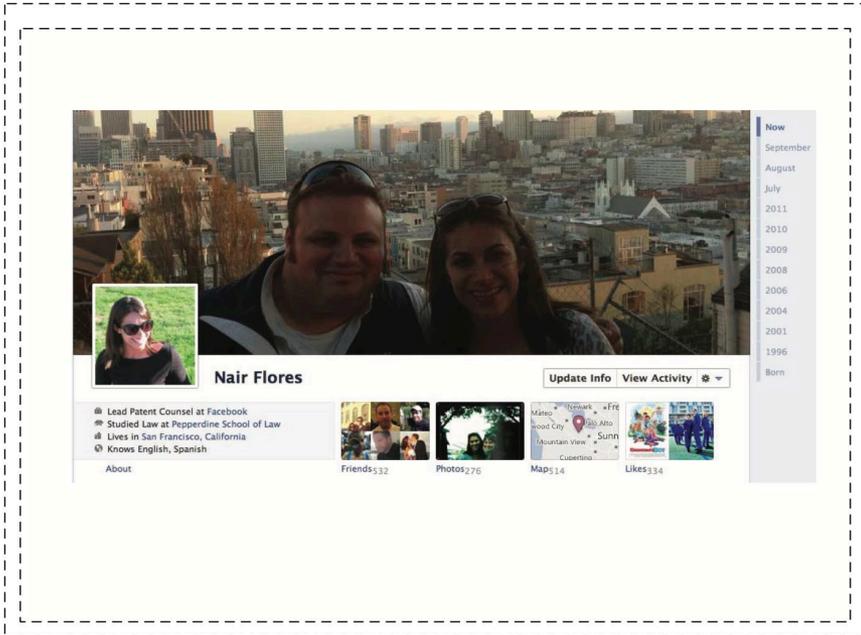
FIG. 3

Replacement Figures

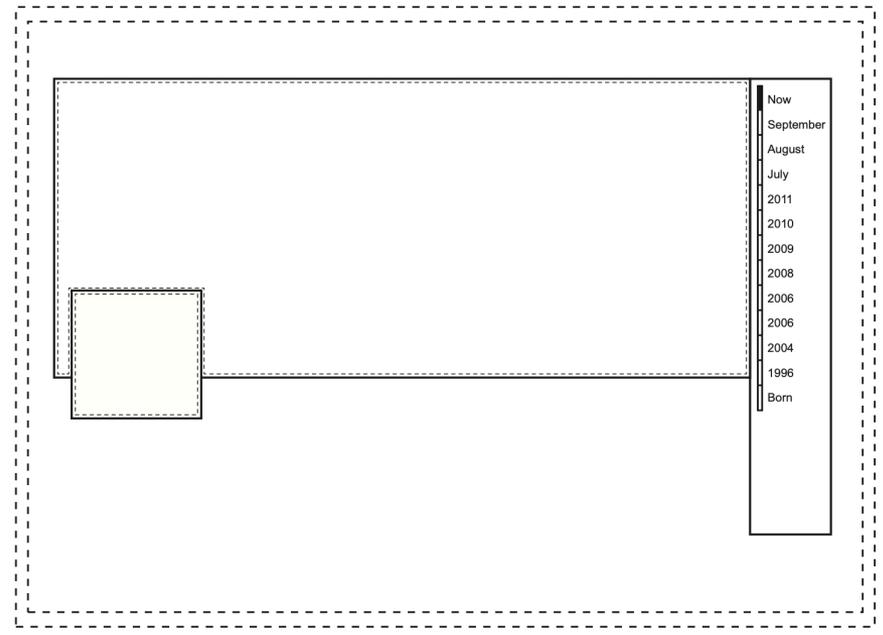
- Rejection reversed by PTAB

Application No. 29/402,215 (Facebook)

Appeal 2019-001900, Decided September 17, 2019



Original Figure



Replacement Figure

- Rejection reversed by PTAB

Application No. 29/447,625 (Fred K. Suzuki)

Appeal 2016-007958, Decided October 2, 2017

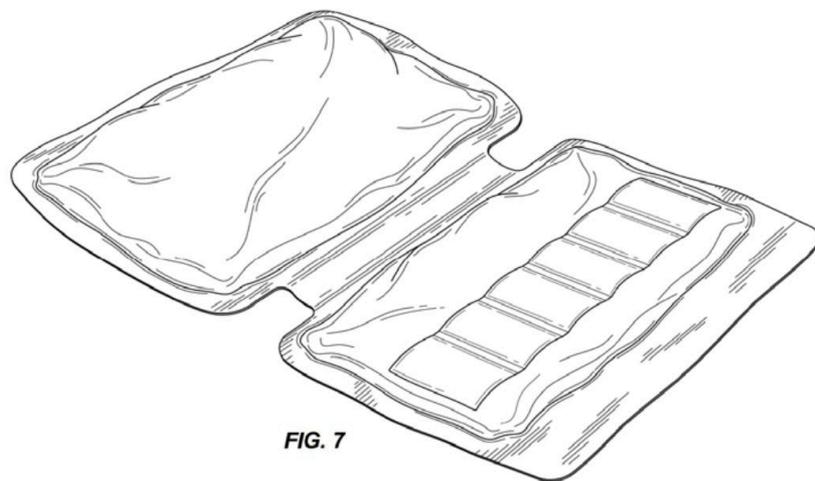


FIG. 7

Original Figure

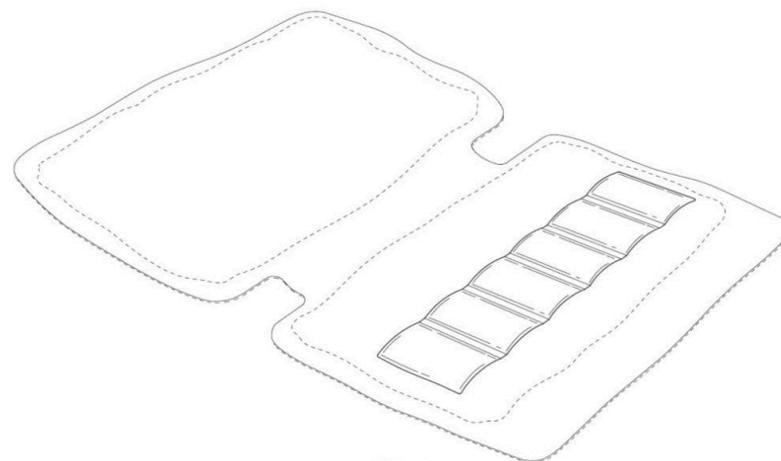


FIG. 1

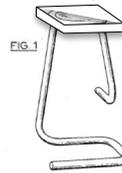
Replacement Figure

- Rejection reversed by PTAB

Federal Circuit Cases

In re Salmon

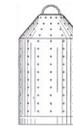
705 F.2d 1579 (Fed. Cir. 1983)



NO

In re Daniels

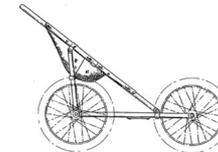
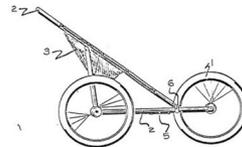
144 F.3d 1452 (Fed. Cir. 1998)



YES

Racing Strollers v. Tri Indus.

878 F.2d 1418 (Fed. Cir. 1989)



YES

Recent PTAB Examples

C&D v. B/E Aerospace

PGR2017-00019 (2018)

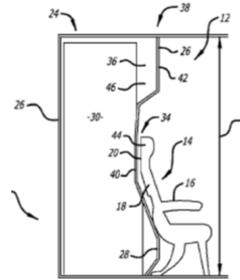


Figure from '063 application

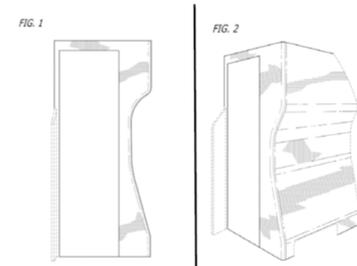


Figure from '031 patent

Figure from '031 patent

NO

Levitation Arts, Inc. v. Flytye

PGR2018-00073, (P.T.A.B. Jan. 17, 2019)

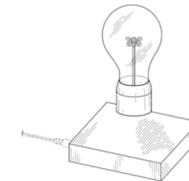


FIG. 1

YES

Skechers U.S.A., Inc. v. Nike, Inc.

IPR 2016-00870 (D725,356), Sept. 29, 2016



FIG. 17



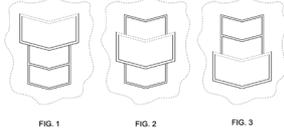
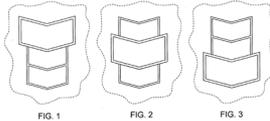
FIG. 2

YES

Design Patent Claim Amendments

S.C Johnson & Son

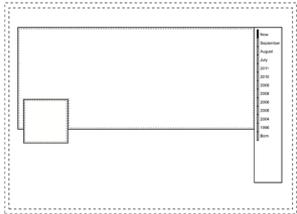
App No. 29/461,780



YES

Facebook

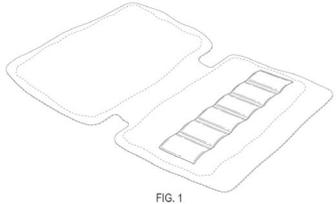
App No. 29/402,215



YES

Fred K. Suzuki

App No. 29/447,625



YES

Thank you

Your Speaker



Elizabeth Ferrill

Elizabeth Ferrill has substantial experience with litigation, prosecution and post-grant proceedings on technologies related to design patent protection. Beth also has a special interest in design protection on a global scale. She is the Editor-in-Chief of *Comparative Global Design Law*, published by Bloomberg in September 2020. Prior to law school, Elizabeth served as a communications officer in the U.S. Air Force.

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+1 202 408 4445

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Design Patent Reissue

Observations about Design Patent Reissue

George Raynal, Principal
SAIDMAN DesignLaw Group, LLC

george.raynal@designlawgroup.com



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Disclaimers:

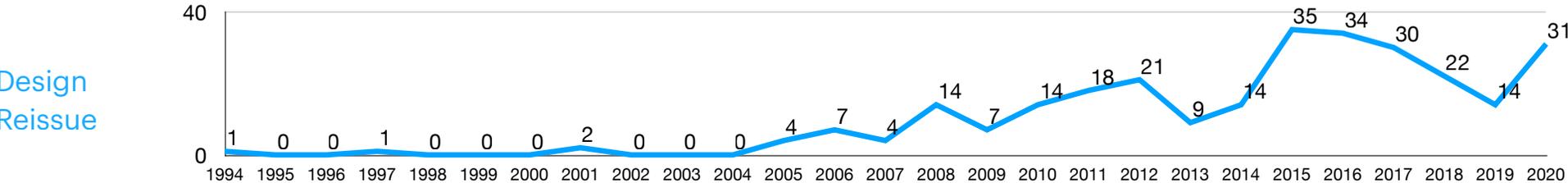
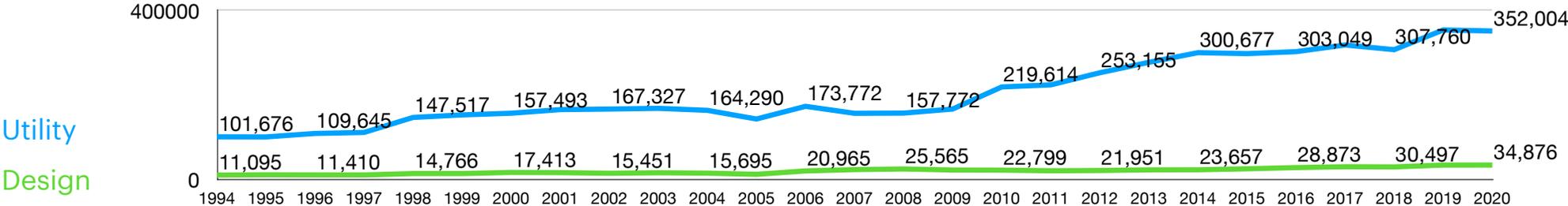
- not legal advice
- no guarantee of accuracy or outcome
- not representative of firm or clients

Design Patent Reissue

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

- by reason of a defective specification or drawing.
- by reason of the patentee claiming more or less than he had the right to claim in the patent.
- by reason of other errors.

Design Patent Reissue



Design Patent Reissue

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NOTICES

Reissue Applications Filed

Reissue Applications Filed

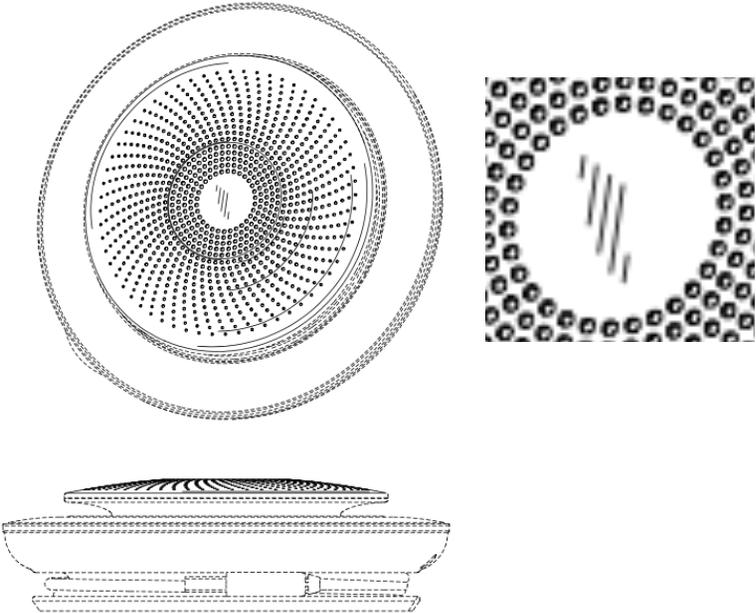
Notice under 37 CFR 1.11(b). The reissue applications listed below are open to public inspection by the general public through the Image File Wrapper (IFW) system (<http://portal.uspto.gov/external/portal/pair>) on the USPTO internet web site (www.uspto.gov), and copies may be obtained by paying the fee therefor (37 CFR 1.19).

[D. 845,924](#), Re. S.N: 29/779,083, Apr. 16, 2021, Cl/Sub: D14/149, SPEAKER PHONE, Rasmus Trudslev Pedersen, Ballerup, DENMARK, Owner of Record: GN Audio A/S, Ballerup, DENMARK, Attorney or Agent: Michael B. Lasky, Ex. Gp: 2913

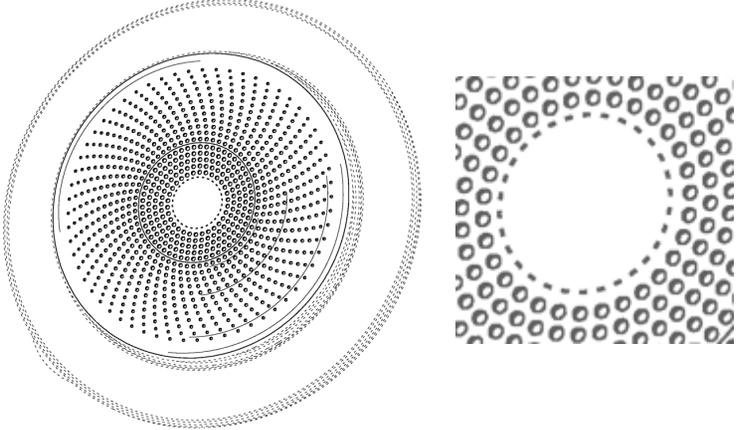
Design Patent Reissue

D845,924

Pending



Full set of views; article shown in broken lines

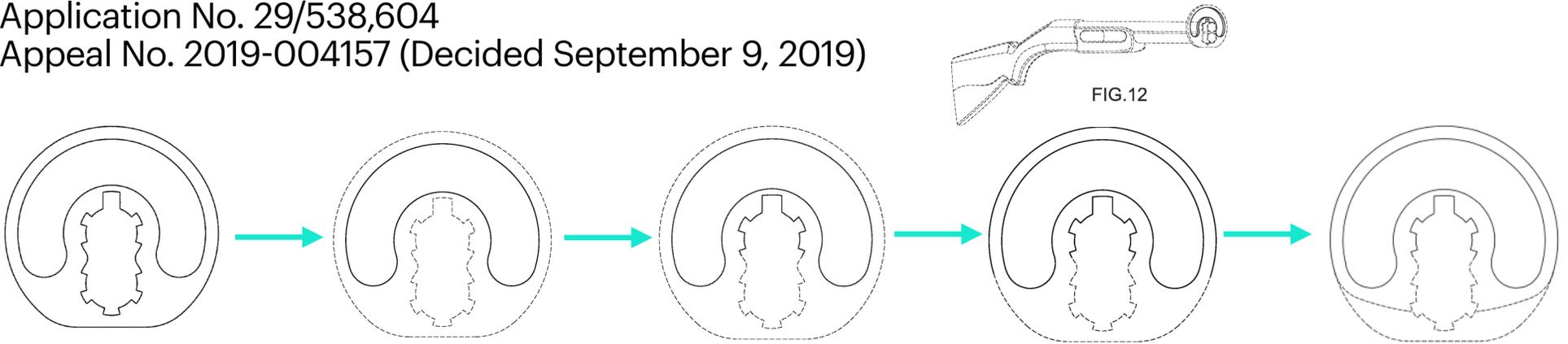


2 views

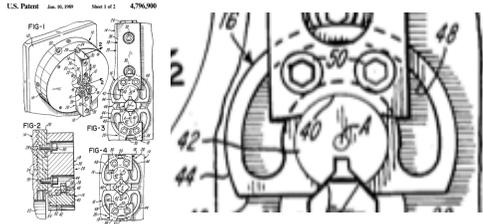
Applicant inadvertently failed to claim the scope of protection as indicated by the amended drawings. These drawings differ from those as originally filed in this application by the inclusion of a boundary line in Fig. 1 and Fig. 3.

Design Patent Reissue

Application No. 29/538,604
Appeal No. 2019-004157 (Decided September 9, 2019)



PTAB affirmed final 112 rejection



Anticipation Rejection

Applicant's Reissue Declaration

The claim of the patent is too narrow to encompass the applicant's invention because it includes within its scope details of the design not necessary to the invention. In particular, the scope of the claim in the patent includes the shape of the outer perimeter of the sight and the shape of the lower aperture of the sight. The claim of the patent is amended in the reissue application to show the outer perimeter and the lower aperture in broken lines and therefore remove these features from the scope of the claimed design.

Design Patent Reissue

ISSUED PATENTS

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Reissues:

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Utility

Subclass	Subgroup	Patent
A61M	5/2033	RE048593
G01V	1/3808	RE048594
G03B	7/003	RE048595
G06F	3/0481	RE048596

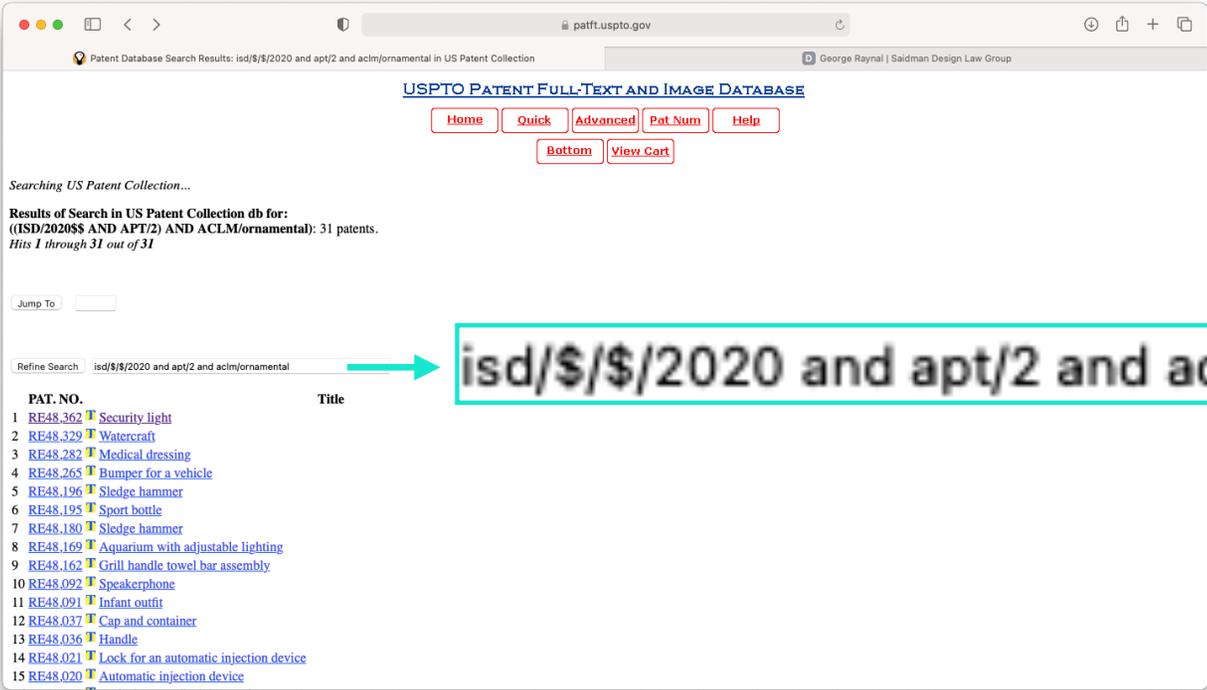
Design and Plant

Class	Subclass	Patent
D26	63	RE048592

US RE48,592 E1
SPOTLIGHT
Goro Terumichi, Tokyo (JP)
Assigned to MODULEX INC., Tokyo (JP)
Filed by ModuleX Inc., Tokyo (JP)
Filed on Oct. 10, 2019, as Appl. No. 29/651,109.
Application 29/651,109 is a reissue of application No. 29/543,367, filed on Oct. 23, 2015, now D800363, issued on Oct. 17, 2017.
Claims priority of application No. 2015-009366 (JP), filed on Apr. 24, 2015.
LOC (13) Cl. 26 - 63

[AMENDED]

Design Patent Reissue



Design Patent Reissue

D800,363

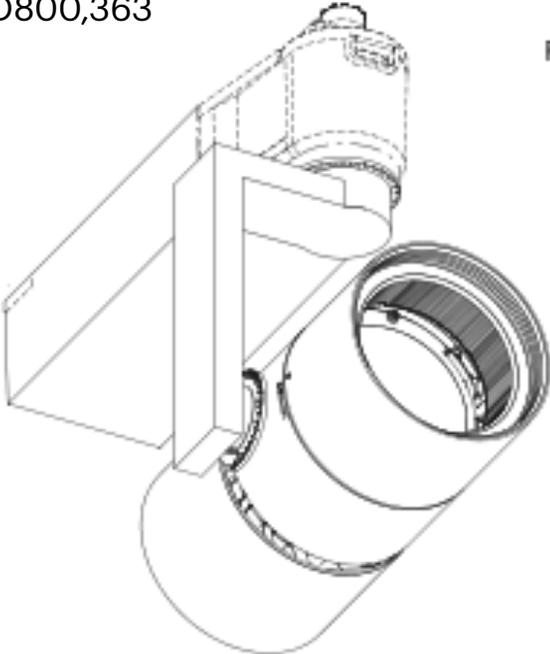


FIG 2

Examiner's Description of Error:

This application is a broadening reissue application of US Design Patent No. D800,363. At least one error being relied upon as the basis of reissue is that the extended articulated arm and portions of the rectangular power box attached above said arm were erroneously illustrated in full solid lines instead of broken lines. This reissue application broadens the scope of the claim to exclude the aforementioned structures by reducing their showing to broken line form.

RE48,362

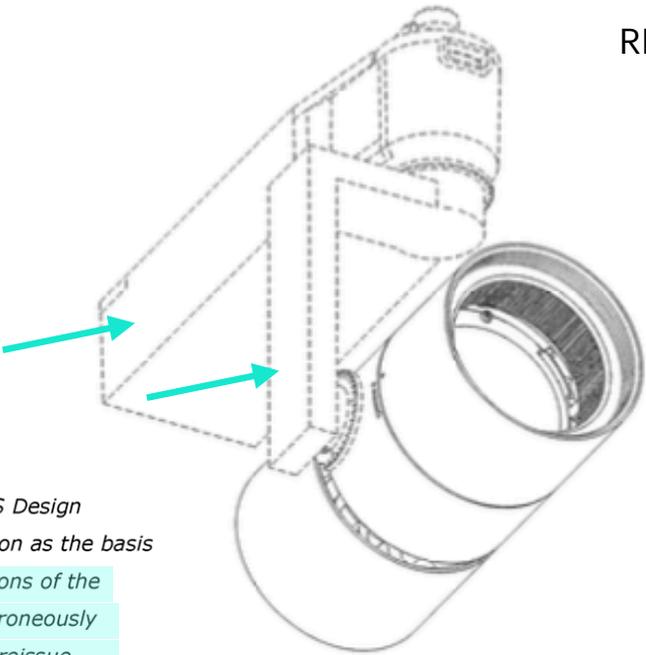


FIG. 2 [AMENDED]

Design Patent Reissue

General Characteristics and Observations

- Prosecution is open to public (raising possibility of 3rd party pre-issuance submission)
- Examiner can issue a prior art rejection
- Examiner might find a new error (which you might not agree is an error)
- Examiner might require a new reissue declaration, e.g., to more specifically describe the error

Design Patent Reissue

General Characteristics and Observations

- Obligations

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which the original patent is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

Design Patent Reissue

General Characteristics and Observations

- Higher Cost - Filing/Search/Exam and Issue Fees and Prosecution
 - Normal: \$1,860
 - Reissue: \$4,540
 - Same filing fee (\$320); increased fees for search (\$700 instead of \$160), exam (\$2,320 instead of \$640) and issue (\$1200 instead of \$740)
- Keeping original claim and obtaining amended claim requires 2 reissue applications
 - A reissue application with the original figures and adding amended figures will be restricted; the amended claim is filed in a divisional reissue application
 - If no error found in original, it is suspended until a divisional reissue is allowed, then recombined, with petition for exception to rule of 1 claim per design patent
 - Examiner might find error in original to avoid recombination
 - Requires 2 issue fees
 - Admission of latent “inoperability” in other patents?

General Characteristics and Observations

Prosecution History Estoppel

- Can't obtain restricted, unelected embodiments
 - Under the doctrine of prosecution history estoppel, surrender occurs upon failure to file a divisional for unelected figures
 - Infringement analysis would evaluate whether the accused design is within the scope of surrender
- Can obtain amended claims which satisfy the written description requirement

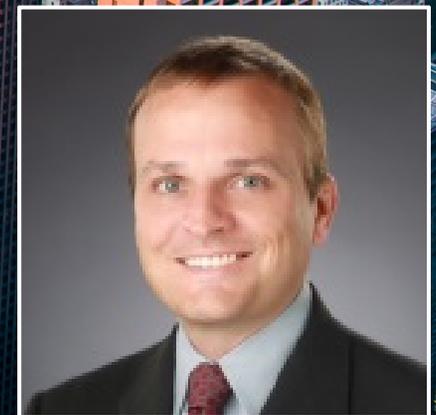
Design Patent Reissue

General Characteristics and Observations

Timing

- Broadening Reissue must be filed within 2 years of issue date
 - If not clear whether a claim change is broadening or narrowing → treated as broadening
- Continuation of a reissue receives benefit of reissue filing date
 - Continuation or Divisional Reissue receives benefit of original priority application filing date

Post-Grant Proceedings for Design Patents



For informational purposes only. The opinions herein are the presenter's personal views in the context of this presentation only, and should not be construed as legal advice.

Post-Grant Proceedings for Design Patents

- Overview, Comparison and Assessment
- 102 and 103
- *Campbell Soup* and *Zodiac*

US DESIGN PATENT (DP) POST-GRANT PROCEEDINGS

	<i>Inter Partes</i> Review (IPR)	Post-Grant Review (PGR)	<i>Ex Parte</i> Reexamination (EPR)
Ineligible DPs	None	Effective filing date before March 16, 2013 (Pre-AIA)	None
Ineligible Requesters	DP owner		None
Anon Filing	Unavailable		Optional
Grounds	Only §§ 102 and 103, patents/printed pubs*	Any	
When	Pre-AIA: after issuance Post-AIA: After PGR period, only within 1 year of civil action	Within 9 months of DP issuance	Between DP issuance and expiration

- **IPR:**
49 Proceedings (2 Pending)
 - Most Recent Petition: 10/8/20

- **PGR:**
20 Proceedings (3 Pending)
 - Most Recent Petition: 6/9/21

DP Post Grant Proceedings are Scarce

- Scant Peer Pressure
 - 69 of >12,000 PGPs, or .6%
 - 1:10 DP/UP grant ratio, or 10%
- IPR: 102/103 Printed Pubs Only*
- Lower Institution Rate
- Higher Relative Cost
- Availability of 12(b)(6) plain dissimilarity

Design Patent IPR Overview

Trial Proceeding Timeline



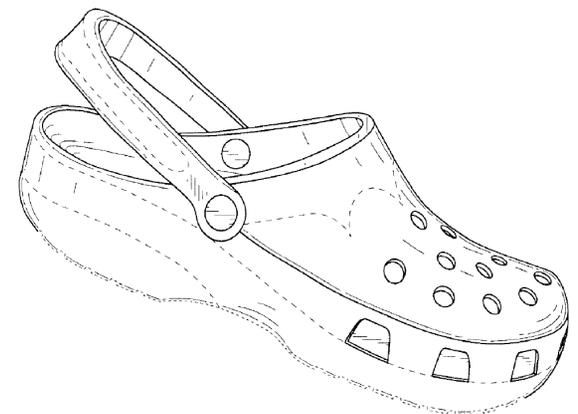
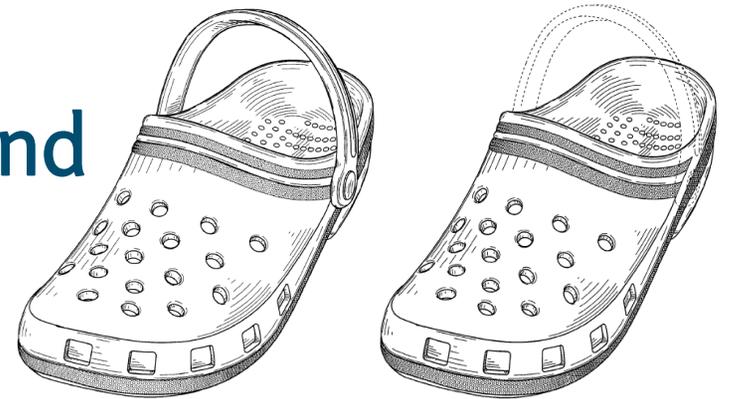
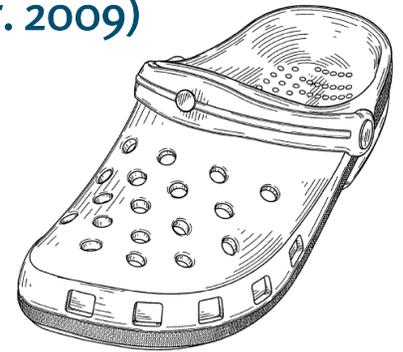
DP IPR Grounds Start with § 171(a)

“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent”

Int'l Seaway v. Walgreens 589 F.3d 1233 (Fed. Cir. 2009)

“In light of
[1] Supreme Court precedent ...
[2] our precedent ... that the same
tests must be applied to
infringement and anticipation, and
[3] our holding in *Egyptian
Goddess* that the ordinary
observer test is the sole test for
infringement, ...

the ordinary observer test must
logically be the sole test for
anticipation as well.”



Gorham: Infringement if...

“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 to deceive such an observer, inducing him ... to purchase one supposing it to be the other ...”



D1440
Spoon and Fork
Handle



Accused
White 1868
INFRINGEMENTS

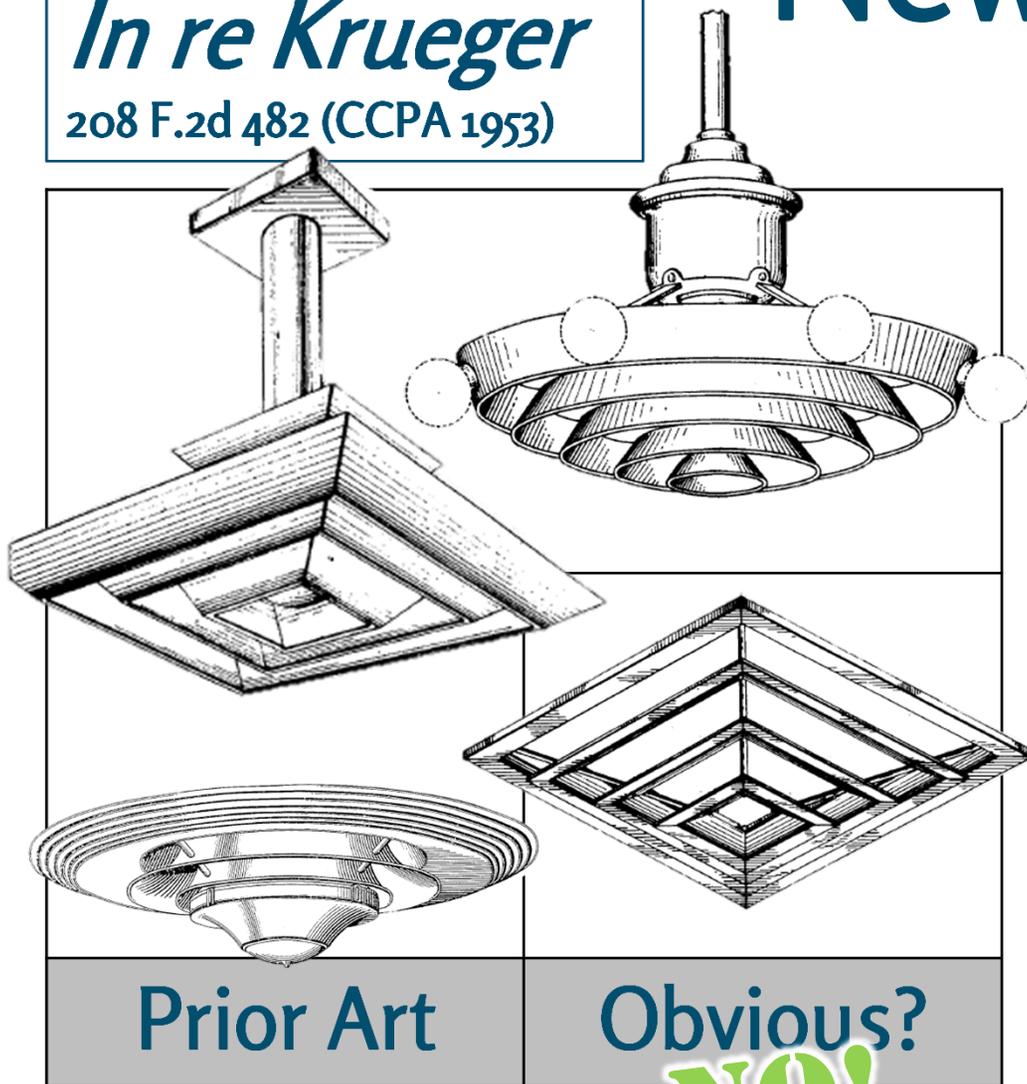
103: New: Obviousness

DP unobtainable “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious ... to a person having ordinary skill in the art”

“New”: Obvious?

In re Krueger

208 F.2d 482 (CCPA 1953)



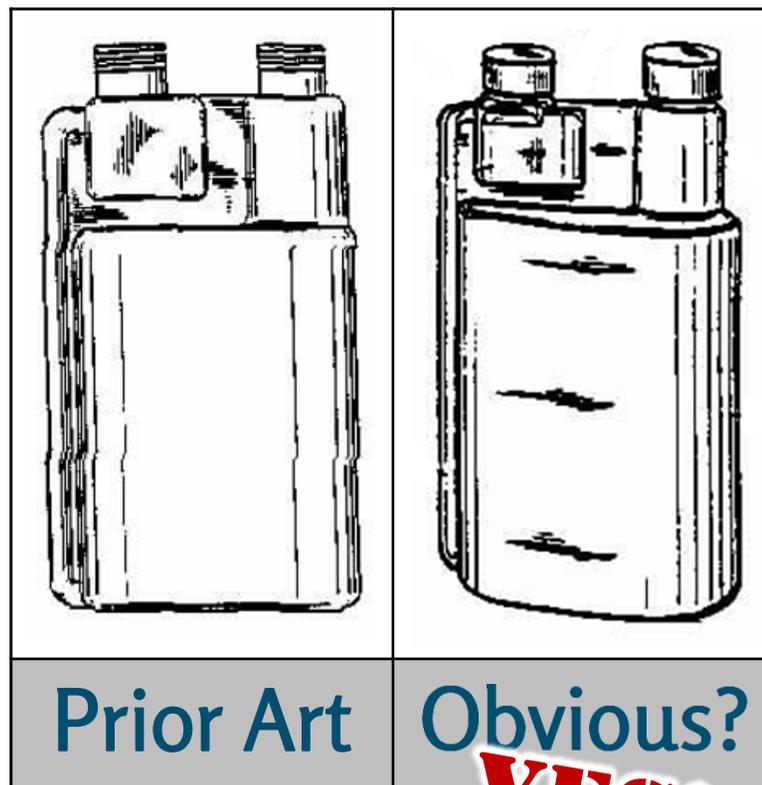
Prior Art

Obvious?

NO!

In re Borden

90 F.3d 1570 (Fed. Cir. 1996)



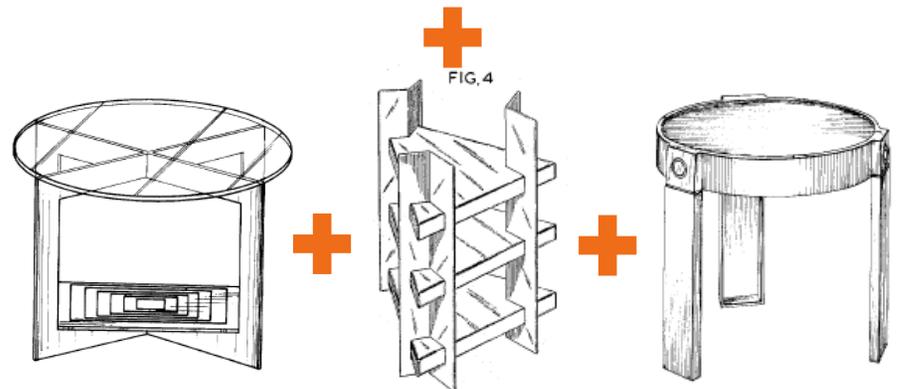
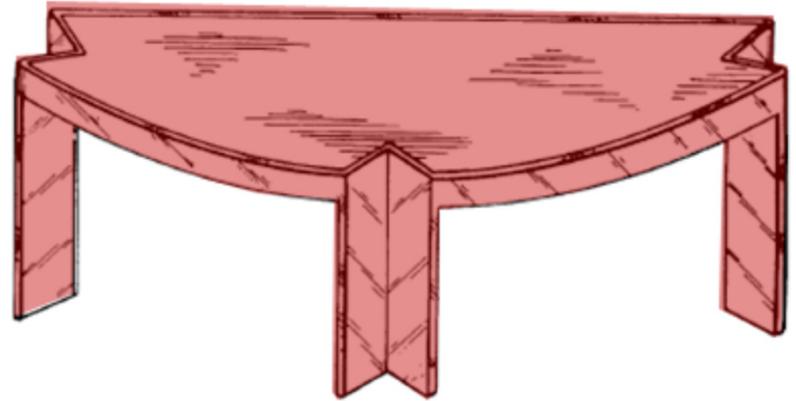
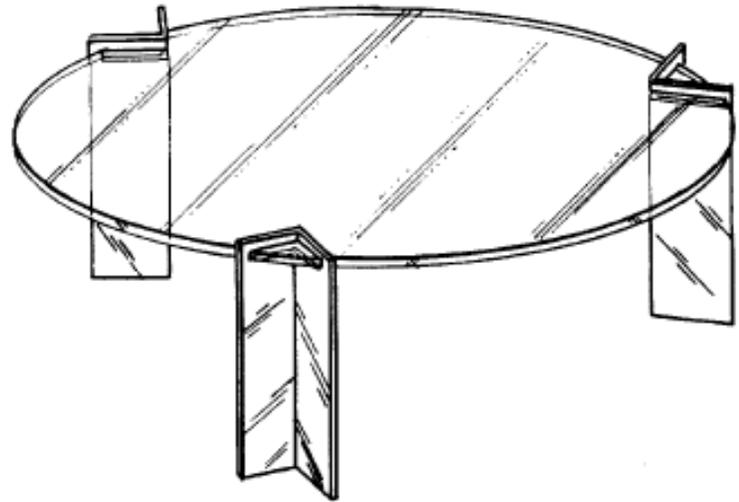
Prior Art

Obvious?

YES!

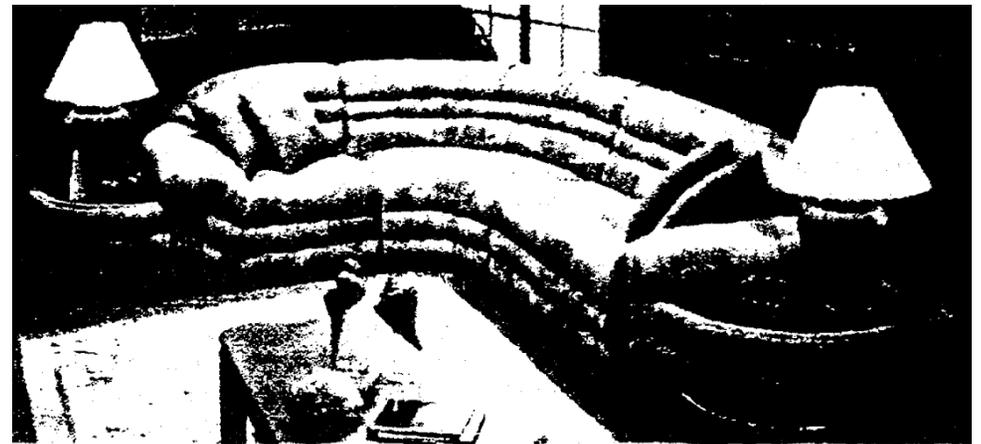
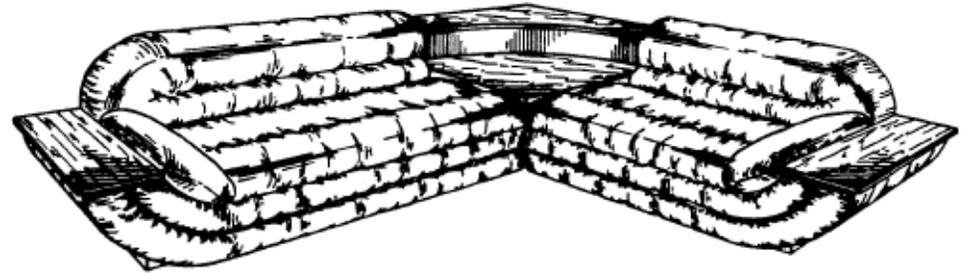
In re Rosen 673 F.2d 388 (CCPA 1982)

103 requires “a reference, a something in existence, the design characteristics of which are basically the same as the claimed design”

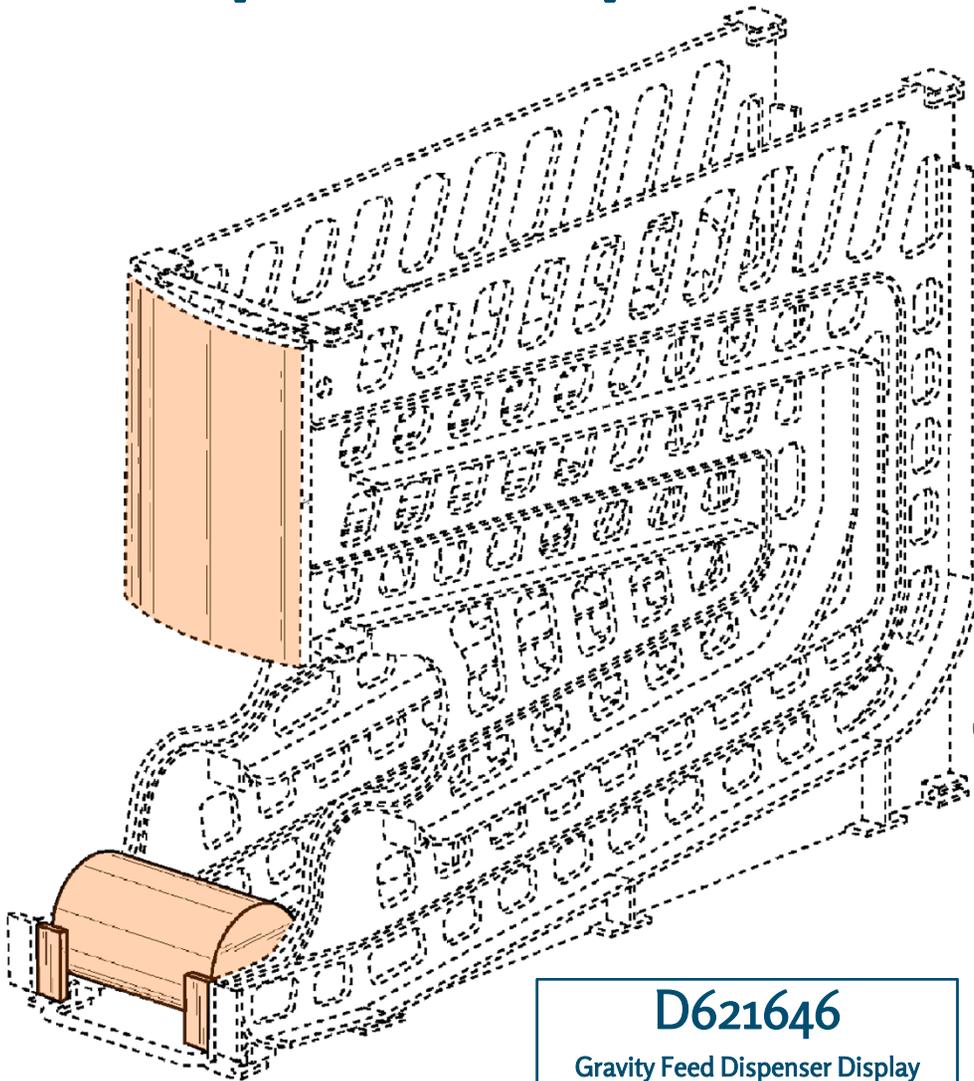


Durling v. Spectrum Furniture 101 F.3d 100 (Fed. Cir. 1996)

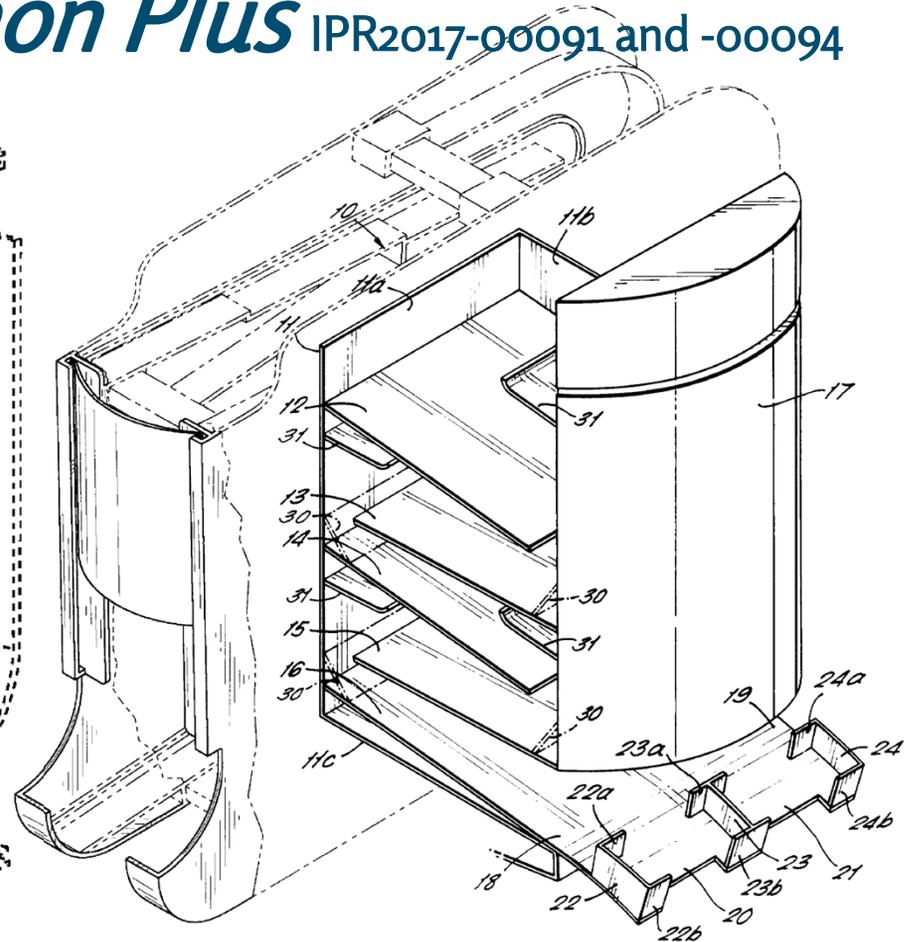
1. Discern correct visual impression of design as a whole.
 2. Determine whether a single reference creates “basically the same” visual impression.
- Must put into “words”



Campbell Soup v. Gamon Plus IPR2017-00091 and -00094



D621646
Gravity Feed Dispenser Display



Linz
D405622
Display Rack

Samway
GB 2303624
Serpentine Dispenser

C&D Zodiac v. B/E Aerospace PGR2017-00019

Additional Comment on Priority and Prior Art...

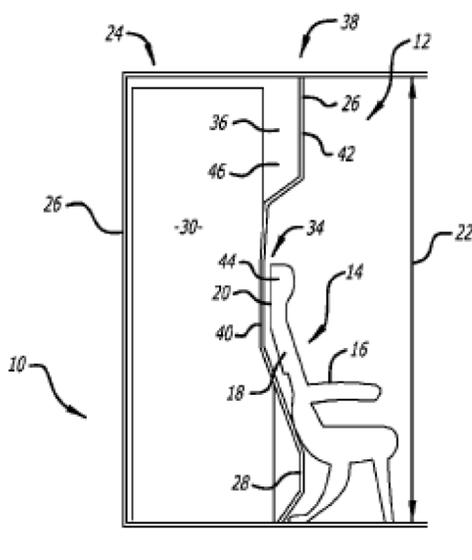


FIG. 1

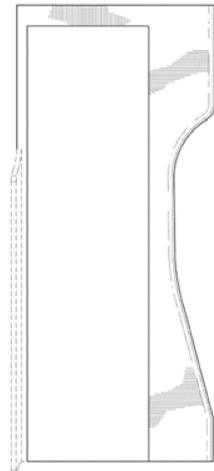
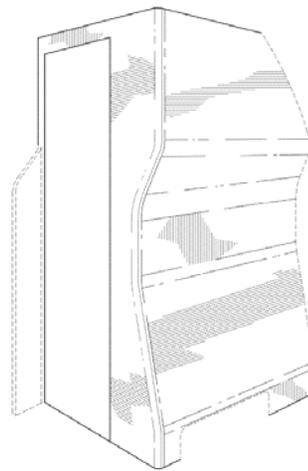


FIG. 2



Alleged Priority/D764031
Aircraft Interior Lavatory

Alleged
Prior Art