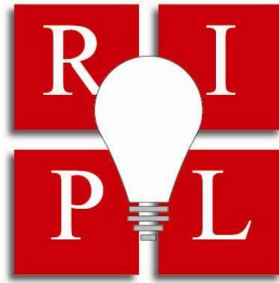


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## DESIGN PATENT LITIGATION: IS “OBVIOUS TO TRY” UNAVAILABLE FOR VALIDITY CHALLENGES UNDER 35 U.S.C. § 103?

SCOTT D. LOCKE

### ABSTRACT

Ten years ago, the United States Supreme Court shook the foundation of U.S. patent law when it announced that a patented invention could be invalidated because the claimed combination of features were “obvious to try.” Regardless of whether one agrees with this standard, which heightened the threshold of patentability relative to the standards that preceded it, the “obvious to try” standard can be justified in the context of utility patents. For those types of patents, the issue of whether a person of ordinary skill in the art would deem a combination of features obvious to try can be measured against a perceived a likelihood of success for achieving a purpose. But the concept does not easily translate to design patents. Those types of patents are directed to ornamental features, which by definition cannot be dictated by functionality, and thus, the success of a combination cannot be measured on an objective scale. This imperfect fit between design patents and the “obvious to try” standard is implicit in case law, which has yet to take a firm position on if and how to apply it in the context of design patents. This article provides an overview of how courts have applied the test of non-obviousness to design patents, their avoidance of the “obvious to try” standard, and practice tips for litigants who wish to challenge or are met with challenges over the validity of design patents.

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SCOTT D. LOCKE\*

I. INTRODUCTION

When, in *KSR Int’l Co. v. Teleflex*, the United States Supreme Court set in motion a tectonic shift of the foundation of patent law by announcing that if a combination of elements in an invention were “obvious to try,” a patent claim that is directed to that invention could be deemed invalid even in the absence of explicit teachings to combine those elements.<sup>1</sup> Prior to *KSR*, a much lower standard for patentability existed, and when challenging another’s patent rights, the challenger needed to establish more than that the various elements were publicly known and “obvious to try.”<sup>2</sup> In *KSR*, however, the Supreme Court raised the bar for patentability and both put at risk many issued patents and made it harder for patent applicants to convince the United States Patent and Trademark Office (“USPTO”) that they were entitled to the issuance of patents for their inventions.

*KSR*, like most patent cases, involved a utility patent. But Congress has made clear that the nonobviousness requirement of patent law also applies to design patents.<sup>3</sup> Further, in *KSR*, the Supreme Court did not make any statements that would limit its shift in how to apply the standard for nonobviousness to utility patents.<sup>4</sup> Nevertheless, *KSR* makes clear that the rationale behind allowing challenges to patent validity based on functional elements being “obvious to try” is an awkward fit for design patents. Perhaps implicitly recognizing this poor fit, neither the Court of Appeals for the Federal Circuit (“CAFC”) nor the Patent Trial and Appeal Board (“PTAB”) has answered whether and if so, to what extent and how *KSR*’s proclamation of the availability of the “obvious to try” basis for invalidating a patent applies to design patents.<sup>5</sup>

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<sup>1</sup> *Teleflex, Inc. v. KSR Int’l Co.*, 550 U.S. 398, 421 (2007).

<sup>2</sup> *In re Kubin*, 561 F.3d 1351, 1358 (Fed. Cir. 2009) (discussing change in standard for obviousness and providing an example of how earlier cases might have come out differently under *KSR* because the claimed invention was obvious to try).

<sup>3</sup> 35 U.S.C. § 171(b) (2012) (“The provisions of this title relating to patents for inventions shall apply to patent for designs, except as otherwise provided.”).

<sup>4</sup> 35 U.S.C. § 103 (2012) (requirement of nonobviousness); *Titan Tire Corp. v. Case New Holland, Inc.* 566 F.3d 1372, 1380 (Fed. Cir. 2009) (“Design patents are subject to the nonobviousness requirement of 35 U.S.C. § 103.”); *Int’l Seaway Trading Corp., v. Walgreens Corp.*, 589 F.3d 1233, 1237 (Fed. Cir. 2009).

<sup>5</sup> *See, e.g., Titan Tire Corp.*, 566 F.3d at 1384-85 (“the [trial] court recognized that the application of *KSR* to design patents was ‘new and untested ground.’ . . . Design patents, like utility patents must meet the nonobviousness requirement of 35 U.S.C. § 103, and it is not obvious that the Supreme Court necessarily intended to exclude design patents from the reach of *KSR*. *With or*

The absence of a formal declaration of the applicability of this aspect of *KSR* to design patents has not relieved the CAFC, the Federal District Courts or the USPTO from having to consider whether a design feature that is generally known would have been obvious to include in an ornamental design. In their analyses, they have tended to avoid considering an “obvious to try” type doctrine and erred on the side of the patentability of designs, which is good news for the design patent applicant and the design patent owner, but not for competitors and accused infringers.

This article provides: (i) a background on design patents; (ii) a summary of the relevant part of *KSR*; (iii) a discussion of how the obviousness standard is currently being applied in design patent cases; and (iv) practice tips given the current standard.

## II. BACKGROUND ON DESIGN PATENTS

“A design patent is directed to the appearance of an article of manufacture.”<sup>6</sup> Thus, design patents protect the ornamental design of a utilitarian article, and they provide the design patent owner with the right to prevent others from making, selling, or using their patented design.<sup>7</sup> They contain a single claim, and its scope is defined by figures.<sup>8</sup>

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*without KSR*, we are not persuaded that the trial court abused its discretion in determining that Titan is unlikely to succeed on the merits of the validity issue.”); *Caterpillar, Inc. v. Miller International, Ltd.*, 2015 WL 4467389, at \*4 (PTAB July 9, 2015) (“Petitioner’s . . . analysis relies fundamentally upon the erroneous assumption that the Supreme Court’s holding in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), has been found applicable to design patent obviousness analysis . . . We are unaware of any case law, nor has Petitioner pointed us to any that confirms the Supreme Court’s holding in *KSR* is germane to an obviousness determination in design patents”); *see also* Jason J. Du Mont and Mark D. Janis, *Virtual Designs*, 17 *STAN. TECH. L. REV.* 107 (2013) (“The Federal Circuit has not yet modified its design patent obviousness rules in view of *KSR*”). By contrast, the District Courts routinely cite *KSR* in design patent cases. *See also* *Yao-Hung Huang v. Marklyn Group, Inc.*, 2014 WL 3559367, at \*5 (D. Colo. 2014); *Solar Sun Rings, Inc. v. Wal-Mart Stores, Inc.*, 2012 WL 5379144, at \*7 (C.D. Cal. 2012); *W.Y. Indus., Inc.*, 2012 WL 3133807, \*2 (D.N.J. 2012); *Grand General Accessories Mfg. v. United Pacific Indus. Inc.*, 732 F. Supp. 2d 1014, 1024 (C.D. Cal. 2010). *3Form, Inc. v. Lumicor*, 2015 WL 9463092 (D. Utah 2015), appeal filed January 29, 2016 (Fed. Cir.) provides an interesting example of the implicit struggle that courts have with application of the “obvious to try” doctrine to design patent cases. In that case, the plaintiff alleged infringement of two utility patents and one design patent. *Id.* at \*1. In the context of challenging one of the utility patents, the defendant explicitly cited the “obvious to try” test. *Id.* at \*14. However, when the court addressed the issue of whether the design patent was obvious, rather than reference *KSR*’s “obvious to try” test, the court discussed that one of the references provided “direction to try” a feature. *Id.* at \*17. This “direction to try” language sounds reminiscent of the TSM test (discussed *infra* Part III) that that Supreme Court rejected in *KSR*, which had a utility patent at issue. In *3Form*, the defendant prevailed in its invalidity challenge based on obviousness of the design. *Id.* Therefore, the defendant also would have prevailed had the court applied a test that required a lower showing of the features at issue being “obvious to try.” The court did not explicitly state whether it was creating a new heightened standard, but if a “direction to try” standard were to be adopted by the CAFC or the PTAB, this would institute a different and arguably lower test for patentability due to non-obviousness for design patents than for utility patents.

<sup>6</sup> *L.A. Gear, Inc. v. Tom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

<sup>7</sup> 35 U.S.C. § 171 (“Whoever invents any new, original and ornamental design of an article of manufacture may obtain a patent therefore, subject to the conditions of this title”); § 271(a) (“Except

The USPTO substantively reviews applications for design patents in order to ensure compliance with the standards for patentability.<sup>9</sup> The resulting patents are truly patent rights in the sense that they provide the patent holder with the right to prevent unauthorized use of the patented design.<sup>10</sup> But the fact that the government grants this same type of right to design patent holders as it does to utility patent holders, does not detract from the fact that the type of innovation that underlies these rights is different.<sup>11</sup> The creativity that leads to the new ornamental designs that form the basis of design patent rights has something in common with the creativity that forms the basis of each of: rights in utility patents, copyright rights, and trade dress rights, but because design patents do not provide rights that are coextensive with any of these other types of intellectual property rights, they have always occupied a unique place in intellectual property law that has led to confusion about their scope and value.<sup>12</sup>

Among the most challenging aspects of design patent law is determining to what degree one design is patentable over another design or over a combination of other designs. In other words, when has the nonobviousness requirement of the patent law been satisfied?<sup>13</sup> For example, one could imagine a system in which, in order for it to be patentable, a new design must differ from the closest art in a minimum number of ways, or one must combine features from a minimum number of different references in order to have arrived at the patented design. Yet neither of these standards has been applied. Instead, as described below, there is a generous standard that requires fairly demanding suggestions in the cited prior art itself to invalidate a patent claim. This standard, which has continued to be applied post-*KSR* is reminiscent of the teach, suggest or motivate (“TSM”) standard of which the U.S. Supreme Court spoke so disparagingly in *KSR*.<sup>14</sup>

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as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”); *L.A. Gear, Inc.*, 988 F.2d at 1123 (“A design patent is directed to the appearance of an article of manufacture”).

<sup>8</sup> *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014); 37 CFR 1.153 (title, description, and claim); U.S. PAT. & TRADEMARK OFFICE, U.S. DEPT OF COMMERCE, MANUAL OF PATENT EXAMINATION AND PROCEDURE § 1503.01 (Elements of a Design Patent). Because design patents contain only a single claim, a design patent is often referred to as valid or invalid, whereas in the case of utility patents, which may contain a plurality of claims, different claims of the same patent may separately be valid or invalid.

<sup>9</sup> 35 U.S.C. § 271(a) (2012).

<sup>10</sup> *See id.*

<sup>11</sup> Evidence in the difference in the nature of the type of creativity and innovation that leads to utility patents as opposed to design patents can be found in the fact that utility patents last for a term that expires twenty years from filing (or filing of a relevant priority patent application), whereas design patents last for fifteen years and the time period is measured from the date of issuance, not the date of filing. *Cf.* 35 U.S.C. §§ 154(a)(2), 173.

<sup>12</sup> Scott D. Locke, *Fifth Avenue and the Patent Lawyer: Strategies for Using Design Patents to Increase the Value of Fashion and Luxury Goods Companies*, 5 J. MARSHALL REV. INTELL. PROP. L. 40, 40 (2005).

<sup>13</sup> 35 U.S.C. § 103 (2012).

<sup>14</sup> The now defunct TSM test has been described in many ways, but in *KSR*, the Supreme Court considered it to be an inappropriate test “under which a patent claims is only proved obvious if the prior art, the problem’s nature, or the knowledge of a person having ordinary skill in the art reveals some motivation or suggestion to combine prior art teachings.” *KSR*, 550 U.S. at 407.

### III. *KSR v. TELEFLEX*

In *KSR Int’l Co. v. Teleflex*, the Supreme Court revisited the issue of nonobviousness for the first time in forty-one years since *Graham v. John Deere Co.*<sup>15</sup> Under the *Graham* precedent, for a traditional analysis of nonobviousness, one must: (1) determine the scope and the content of the prior art; (2) determine the differences between the prior art and the claims at issue; (3) determine the level of ordinary skill in the art; and (4) consider any secondary considerations of nonobviousness, which include but are not limited to “commercial success, long felt but unsolved needs, [and] failures of others.”<sup>16</sup> *KSR* did not change this standard.

When the CAFC applied the *Graham* standard, however, the CAFC implemented it in a way that rendered a patent claim obvious if there was some motivation or suggestion to combine the prior art teachings that could be found in the prior art, the nature of the problem, or the knowledge of a person of ordinary skill in the art.<sup>17</sup> In *KSR*, the Supreme Court expressed its concern that the TSM standard was too low.<sup>18</sup>

In *KSR*, the Supreme Court emphasized the flexibility of the obviousness inquiry, which meant that because creative people are inquisitive by nature, the motivation to combine known elements need not be explicit in prior art that the USPTO or a patent-defendant proffers.<sup>19</sup> Taking this reasoning to the next level, *KSR* held:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, [that success] is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was *obvious to try* might show that it was obvious.<sup>20</sup>

Regardless of whether one agrees with this standard for nonobviousness for utility patents as a policy matter, it is intellectually coherent. But, if one were to consider the Supreme Court’s expressed rationale for allowing “obvious to try” challenges to patentability and apply them to ornamental designs, one would readily see that they do not fit. At the core, the “obvious to try” theory is based on looking for a solution to a problem or a specific invention. By contrast, design patents are directed to aesthetics, which are subjective. Therefore, by definition there are no solutions provided by ornamental designs only choices.

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<sup>15</sup> 383 U.S. § 1 (1966).

<sup>16</sup> *Graham*, 383 U.S. at 17-18.

<sup>17</sup> *KSR*, 550 U.S. at 407 (quoting *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1323-24 (Fed. Cir. 1999)).

<sup>18</sup> *Id.* at 415 (“We begin by rejecting the rigid approach of the Court of Appeals. Throughout this Court’s engagement with the question of obviousness, our cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here.”).

<sup>19</sup> *KSR*, 550 U.S. at 416-420; see also Scott D. Locke and William D. Schmidt, *Protecting Pharmaceutical Inventions in a KSR World*, 50 IDEA 1, 3-5 (2009) (summarizing *KSR*).

<sup>20</sup> *KSR*, 550 U.S. at 398 (emphasis added).

In the context of ornamental designs a “design need” or “market pressure” could each be viewed as an unlimited force because society always wants new designs, or as non-existent, because necessity implies a functionality and if a design patent is dictated by functionality, then it would by definition be invalid, and thus the absence of a design is not a need.<sup>21</sup> Similarly, the issues of finiteness and predictability of solutions would make no sense because they imply a notion of objective success, but with ornamental designs, there are no objective measures of success and there is no standard for better or worse. These points are underscored by the above-referenced quote from *KSR*’s explicit reference to a person’s technical grasp, which is inapplicable for design patents. Therefore, *KSR*’s rationale for dismissing the TSM test would appear not to apply to patents for ornamental designs. Although the courts and USPTO have not undergone this analysis, the case law makes clear that they have reached the same conclusion.

#### IV. STANDARD OF OBVIOUSNESS IN DESIGN PATENT CASES

As noted above, design patents, like utility patents must be nonobvious,<sup>22</sup> and in all challenges to patents based on alleged nonobviousness, there should be underlying factual inquiries that focus on the *Graham* factors.<sup>23</sup> Yet, the ultimate inquiry in the case of a design patent is whether the claimed design would have been obvious to a designer of ordinary skill in the art who designs articles of the type involved.<sup>24</sup> When making this inquiry, one must consider the overall appearance, or the visual effect of the design as a whole.<sup>25</sup> As a practical matter, this issue often collapses to “whether one of ordinary skill in the art would have combined teaching of the prior art to create the same overall visual appearance in the claimed design.”<sup>26</sup>

When considering the issue of obviousness with respect to a design patent, there are three steps. One must: (1) find a single primary reference, which may be referred to as a *Rosen* reference,<sup>27</sup> the design characteristics of which are basically the same as the claimed design; (2) find other reasons such as prior art references to modify the primary reference’s design in order to create a visual appearance that is

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<sup>21</sup> *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1566 (Fed. Cir. 1996) (“if the design claimed in a design is dictated solely by the function of the article of manufacture, the patent is invalid because the design is not ornamental”).

<sup>22</sup> 35 U.S.C. § 171 (“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. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”); *Laughing Rabbit, Inc. v. National Automotive Parts Ass’n*, 2014 WL 556007, at \*4 (W.D. Wash. Feb. 11, 2014) (“Thus, in addition to functionality, design patents are subject to affirmative defenses for anticipation and obviousness under sections 102 and 103 of Title 35”).

<sup>23</sup> *See supra* note 16 and accompanying text; *see also* *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 182 (2014).

<sup>24</sup> *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1312 (2013); *Titan Tire Corp.* 566 F.3d at 1380-81.

<sup>25</sup> *Para Gear Equipment Co., Inc. v. Square One Parachutes, Inc.*, 2005 WL 2266618, at \*4 (N.D. Ill. Sept. 14, 2005).

<sup>26</sup> *Durling v. Spectrum Furniture Co. Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

<sup>27</sup> The designation as a “*Rosen* reference” is derived from *In re Rosen*, 673 F.2d 388, 390 (C.C.P.A. 1982).

the same as that of the claimed design;<sup>28</sup> and (3) if applicable, consider secondary indicia of nonobviousness.<sup>29</sup>

### *A. Step 1: Identifying the Primary Reference*

In order for an accused infringer or declaratory judgment plaintiff to proceed with an assertion of invalidity of a design patent based on obviousness, he or she must: (i) discern the correct visual impression created by the patented design as a whole;<sup>30</sup> and (ii) evaluate the proposed primary reference in order to determine whether it creates basically the same visual impression.<sup>31</sup>

#### *1. Discerning the Visual Impression of the Claimed Design*

When discerning the visual impression for the purpose of a design patent analysis, a court should translate the design into a verbal description that focuses on the purported distinctive visual appearance of the claimed design and that evokes a visual image.<sup>32</sup> This requirement allows a litigant and a reviewing court to determine the reasoning behind a decision, and thus have a basis on which to challenge or to review a determination of obviousness or nonobviousness.<sup>33</sup> A court may arrive at its determination intuitively, but it must nonetheless translate the determination into words.<sup>34</sup> Using only a high level of abstraction instead of translating a visual design into a verbal description is reversible error.<sup>35</sup>

The challenge of translating the figures of a design patent into words has not been lost on the CAFC, which explicitly admitted: “Unlike the readily available verbal description of the invention and of the prior art that exists in a utility patent case, a design patent case presents the judge only with visual descriptions.”<sup>36</sup> When providing a description of the visual impression, a court must find a middle ground between high levels of design concepts and an exhaustive list of details, “focusing on

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<sup>28</sup> *High Point Design*, 730 F.3d at 1311. In addition to this inquiry, one may consider the fourth *John Deere* factor of objective indicia of non-obviousness. *Id.* at 1315.

<sup>29</sup> *MRC Innovations*, 747 F.3d at 1335-36 (looking to secondary considerations); *High Point Design*, 730 F.3d at 1315 (looking to secondary considerations).

<sup>30</sup> *High Point Design*, 730 F.3d at 1311; *Durling*, 101 F.3d at 104.

<sup>31</sup> *High Point Design*, 730 F.3d at 1311.

<sup>32</sup> *Id.* at 1314; *MRC Innovations*, 747 F.3d at 1332 (Fed. Cir. 2014); *OraLabs, Inc. v. Kind Group LLC*, 2014 WL 1630690 (D. Colo. 2014). Notably, the CAFC does not require an elaborate verbal claim construction for the purposes of an infringement inquiry. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 643 F.3d 665, 679 n.1 (Fed. Cir. 2008); *see, e.g., Yao-Hung Huang v. Marklyn Group Inc.*, 2012 WL 4856720, at \*2 (D. Colo. 2012) (court electing not to provide elaborate claim construction).

<sup>33</sup> *MRC Innovations*, 747 F.3d at 1331.

<sup>34</sup> *OraLabs*, 2014 WL 1630690, at \*5.

<sup>35</sup> *High Point Design*, 730 F.3d at 1314 (remanding after court failed to focus on distinctive visual appearance).

<sup>36</sup> *Durling*, 101 F.3d at 104.



design elements that most affect the overall visual impression.”<sup>37</sup> Thus, when creating or proposing a verbal description, one must be careful to supply the appropriate level of detail. If this level of detail is not provided, then there is a danger of interpreting the claimed design too broadly.<sup>38</sup> However, although sufficient detail must be provided, this detail is meant to create the visual impression as a whole, and the patent is not directed towards individual concepts.<sup>39</sup> Thus, “the focus in a design patent obviousness inquiry should be on visual appearances rather than on design concepts.”<sup>40</sup> When done properly, the verbal description should evoke the visual image of the design.<sup>41</sup>

For example, in the seminal case *Durling v. Spectrum*,<sup>42</sup> the CAFC considered whether a design patent for a sectional sofa was invalid based on obviousness over certain prior art. The patent holder sought a reversal of a determination of invalidity arguing that although the art presented by the defendant had the same basic concept as the patented design—being directed to a sofa sectional with integrated end tables—each of the prior art designs would not qualify as a prior art reference because it created a different visual impression than the patented design.<sup>43</sup>

The CAFC agreed, noting that the district court erred by misinterpreting the visual impression created by the patent holder’s claimed design.<sup>44</sup> The district court had described the patented design too broadly.<sup>45</sup> Its description represented the general concept of a sectional sofa with integrated end tables, but it did not speak to the visual appearance that the patented design created.<sup>46</sup>

## 2. Looking for the Primary Reference

When looking for a primary reference, the key is to find “a single reference, ‘as something in existence, the design of characteristics of which are basically the same as the claimed design.’”<sup>47</sup> Then a court must ask whether a purported primary reference disclosed not merely the general concept of the claimed design, but

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<sup>37</sup> *Ashley Furniture Indus. Inc. v. Lifestyle Enterprise Inc.*, 574 F. Supp. 2d 920, 928 (W.D. Wisc. 2008).

<sup>38</sup> *Durling*, 101 F.3d at 104.

<sup>39</sup> *Id.* at 103-04; *Livjo, Inc. v. Deckers Outdoor Corp.*, 2011 WL 12516430, at \*3 (C.D. Cal. Sept 27, 2011).

<sup>40</sup> *Durling*, 101 F.3d at 104.

<sup>41</sup> *Id.* at 104 n.2.

<sup>42</sup> 101 F.3d 100.

<sup>43</sup> *Id.* at 104.

<sup>44</sup> *Id.* at 104.

<sup>45</sup> The district court had described the patented design as: “The look that the patent-in-suit presented is a section sofa with double rolls of upholstery under the seating area which curve arcuately under the end tables. The end tables have the appearance of little vertical support.” The court defined vertical support as “the extent to which the base extends under the end table.” *Id.* at 103-04.

<sup>46</sup> *Id.* at 104; *see also* *Para Gear Equipment., Inc. v. Square One Parachutes, Inc.*, 2005 WL 2266618, at \*4 (N.D. Ill. 2005) (“The focus in a design patent-obviousness inquiry is on the visual appearances, not the design concepts.”).

<sup>47</sup> *Durling*, 101 F.3d at 103 (quoting *In re Rosen*, 673 F.2d at 391); *see also* *High Point Design*, 730 F.3d at 1314.

basically the same distinct visual appearance.<sup>48</sup> As noted above, the court must provide its reasoning for its conclusion.<sup>49</sup> When conducting its analysis, a court should do a side-by-side comparison of the two designs in order to determine whether they create the same commercial impression.<sup>50</sup>

This “basically the same test” requires one to consider the visual impression created by the design as a whole.<sup>51</sup> Litigants must be cognizant that having the same basic design is not the equivalent of being basically the same.<sup>52</sup> For the USPTO and challengers to the validity of a design patent, the “basically the same test” presents a high hurdle. Although the standard could have asked merely whether the basic elements are known, it does not.<sup>53</sup> Instead, one may ask whether the purported primary reference is readily distinguishable from the claimed design.<sup>54</sup> Another way that courts have framed this question is whether “major modifications” would be needed to arrive at the claimed design from the primary reference.<sup>55</sup> However, the term “major” implies a greater difference than is actually needed to survive a challenge to patentability. Instead, major modifications are those that move from design concepts to specific designs.<sup>56</sup> For example, differences in shapes and symmetry have in certain circumstances rendered purported primary references inadequate.<sup>57</sup>

In the infamous and seemingly interminable battle between Apple and Samsung, one of the claims was that Apple’s U.S. Design Patent No. D504,889 (the “889 patent”), which was directed to an ornamental design for a tablet, was invalid due to obviousness and should therefore not be the subject of an injunction.<sup>58</sup> The district court determined that a prior art reference was sufficiently similar to the design of the ‘889 patent because both were rectangular tablets with four evenly rounded corners and a flat reflective surface for the front screen surrounded by a rim on all four sides, and an essentially flat rear surface.<sup>59</sup> After comparing the two designs, Apple’s and the purported primary reference, the CAFC disagreed with the trial court’s analysis, listed a litany of differences,<sup>60</sup> and determined that because

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<sup>48</sup> *Id.*

<sup>49</sup> *High Point Design*, 730 F.3d at 1314.

<sup>50</sup> *Id.* at 1314.

<sup>51</sup> *Id.* at 1331.

<sup>52</sup> *Durling*, 101 F.3d at 103.

<sup>53</sup> *In re Harvey*, 12 F.3d 1061, 1063 (Fed. Cir. 1993).

<sup>54</sup> *Para Gear Equipment*, 2005 WL 2266618, at \* 5.

<sup>55</sup> *In re Harvey*, 12 F.3d at 1063; *Para Gear Equipment*, 2005 WL 2266618, at \*5. In the seminal case *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996), the CAFC discusses the issue from reverse, concluding that the secondary references at issue provided the two design elements that were necessary to bridge what it termed the “small gap” between the primary reference and the claimed design.

<sup>56</sup> *In re Harvey*, 12 F.3d at 1063; *Para Gear Equipment*, 2005 WL 2266618, at \*5.

<sup>57</sup> *See, e.g.*, *ATAS International, Inc. v. Centria*, 2013 WL 6114992, at \*8-11 (PTAB Sept. 24, 2013).

<sup>58</sup> *Apple, Inc. v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1329-30 (2012). The case involved allegations that Samsung’s cellular telephones and tablet computers infringed Apple’s utility patents, design patents, and trade dress rights; the case also involved allegations that Apple’s products infringed Samsung’s patents.

<sup>59</sup> *Id.* at 1330.

<sup>60</sup> The differences includes: (1) the prior art tablet was not symmetrical, whereas Apple’s design is; (2) the prior art frame surrounding the screen contrasts sharply with the screen itself,

Samsung had failed to raise a substantial question as to the validity of the '889 patent, and Apple showed irreparable harm, an injunction should issue with respect to that patent.<sup>61</sup>

Upon remand and in response to a motion for summary judgment, the trial court addressed the issue of obviousness with respect to four of Apple's patents.<sup>62</sup> The court determined that with respect to three of these patents, issues of fact remained.<sup>63</sup> With respect to the fourth patent, however, the alleged primary reference did not qualify as prior art.<sup>64</sup>

Another instructive case, *Livjo, Inc. v. Deckers Outdoor Corp.*,<sup>65</sup> involved an UGG boot design. The plaintiff had designed a crochet boot, and obtained a design patent for that design.<sup>66</sup> Subsequently, Deckers introduced a crochet line. In asserting a claim of obviousness, the defendant pointed to one of its earlier boot designs as a primary reference. The trial court acknowledged that the visual appearance of both the patented design and that of the prior art were of a boot with exposed seaming running the length of the boot and the circumference of the ankle, and that each had a zig-zag patterned tread with three smooth sections at the toe, mid-foot and heel.<sup>67</sup>

However, the patent in suit had a dominant feature of not appearing smooth, and instead appearing crochet-textured with a concentric-oval pattern on the top of the foot.<sup>68</sup> Due to the crocheting, it appeared sleeker and less puffy than the purported primary reference, and consequently, it appeared to be a sweater for the foot, whereas the purported primary reference looked like a sheepskin coat turned shoe.<sup>69</sup> These differences led the court to conclude that the purported primary reference did not depict a design that was basically the same as the claimed design.<sup>70</sup>

Similarly, in *Vitro Packaging v. Saverglass, Inc.*, the Patent Trial and Appeals Board determined that a petitioner's request for an *inter partes* review based on

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whereas Apple's transparent glass front surface covers essentially the entire front face; (3) the prior art design does not contain a thin bezel surrounding the edge of the front side, whereas Apple's design does; (4) one corner of the frame in the prior art design contains multiple perforations, whereas Apple's design does not; (5) the sides of the prior art design are neither smooth nor symmetrical, whereas the side of Apple's design were both smooth and symmetrical; and (6) rear sides of the prior design and Apple's design convey different visual impressions. *Apple*, 678 F.3d at 1330-31.

<sup>61</sup> *Id.* at 1331-32.

<sup>62</sup> *Apple, Inc. v. Samsung Electronics Co., Ltd.*, 2012 WL 2571719 (N.D. Cal. 2012). The four patents were: (1) U.S. Patent Design No. D593,087, *Electronic Device*; (2) U.S. Patent Design No. D618,677, *Electronic Device*; (3) U.S. Patent Design No. D504,889, *Graphical User Interface for a Display Screen or Portion Thereof*; (4) U.S. Patent Design No. D604,305, *Graphical User Interface for a Display Screen or Portion Thereof*. *Id.* at \*20-26.

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> 2011 WL 12516430 (C.D. Cal. 2011).

<sup>66</sup> U.S. Design Pat. No. D561,983.

<sup>67</sup> *Livjo*, 2011 WL 12516430, at \*3.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.*

obviousness of a claimed design did not sufficiently establish a reasonable likelihood of prevailing because the petitioner did not identify an adequate primary reference.<sup>71</sup>

The design was for a bottle<sup>72</sup> that the PTAB described in great detail.<sup>73</sup> The level of detail prevented the petitioners from using a primary reference that depicted a bottle that had only a similar gross morphology.<sup>74</sup> The PTAB deemed the purported primary reference insufficient because the petitioner: (1) only conclusory deemed certain features to be more or less prominent than others; (2) deemed features to be prominent that were distinctly visually different from the claimed bottle with respect to contouring (flat vs. rounded areas and concave vs convex areas); and (3) failed to explain why certain differences were *de minimis*, erroneously equating a slight tapering with the tapering being *de minimis*.<sup>75</sup>

Although the basically the same test presents a high hurdle, that hurdle is not always insurmountable. For example, in *MRC Innovations, Inc. v. Hunter*,<sup>76</sup> at issue was whether a design for a jersey for a dog was obvious. The district court described eight elements of the patented design that provided a clear distinctive visual

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<sup>71</sup> 2015 WL 5766302 (PTAB Sept. 29, 2015); *see also* *Nordock Inc. v. Systems Inc.*, 927 F. Supp. 2d 577, 603 (E.D. Wisc. 2013) (court may consider any identified reference as a primary reference).

<sup>72</sup> U.S. Patent No. D526,197.

<sup>73</sup> *Vitro Packaging v. Saverglass, Inc.*, 2015 WL 5766302, \*3-4 (PTAB Sept. 29, 2015). The PTAB described the design as:

A generally symmetrical transparent bottle having a main body portion including a wall with an exterior surface tapering slightly inwardly from its shoulder to its base. The exterior surface of the base defines a convex punt, and an interior surface of the base, as seen through the transparent wall of the bottle, is concave. Also evident through the transparent wall of the bottle, an interior surface of the wall tapers inwardly at a slightly greater inward taper than the exterior surface of the wall to join contiguously the interior concave surface of the base. Proceeding from the shoulder to the base, the disparate tapering of the interior and exterior walls, and curvedly opposing base features define visually a thickening wall and base portion distinctly juxtaposed with a decreasing overall outer circumference of the bottle wall.

Turning to the upper portion of the bottle, as best illustrated in Figure 2, the shoulder portion of the bottle is substantially flat as it extends diametrically inwardly from a sharply angled intersection with the wall of the main body to a concave transition to the neck of the bottle. The neck extends upwards from the transition to a diametrically larger transfer ring defining an opening to the bottle. Additionally, as seen through the transparent neck of the bottle, an interior surface of the neck depends downwardly from the opening of the bottle and tapers outwardly starting just below the transfer ring providing the interior of the neck with a larger diameter as it continues downward to the concave transition with the shoulder.

*Id.*

<sup>74</sup> The petitioner presented the PTAB with a bottle that the petitioners believed was relevant because of what the petitioner deemed the prominent features of the bottle: (a) the relative height and width of the main body of the bottle; (b) the shape of the upper round shoulder of the main body; (c) the ratio of the body height to the neck height and (d) the shape of the transition from the neck to the top of the main body. *Id.* at \*4.

<sup>75</sup> *Id.*

<sup>76</sup> 747 F.3d 1326 (Fed. Cir.), *cert. denied*, 135 S. Ct. 182 (2014).

appearance.<sup>77</sup> The asserted prior art reference disclosed five of these eight elements, but because the two designs shared the same overall shape, similar fabric and ornamental stitching, they were deemed to be basically the same, and the cited reference qualified as a primary reference.<sup>78</sup>

### *B. Step 2: Reasons to Modify*

After one identifies a primary reference, then one must search for a reason to modify the design disclosed in that primary reference in order to arrive at the claimed design. Typically, the source of the modification comes from secondary references, and according to the CAFC there must be some suggestion in the prior art to modify the basic design of the primary reference with features from the secondary references.<sup>79</sup> This means that the teachings of prior art designs may be combined only when the designs are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.<sup>80</sup> Put another way, “it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design.”<sup>81</sup>

This standard is eerily similar to the TSM standard that the Supreme Court rejected in *KSR*. Yet, this second step in the design patent analysis has consistently been applied after *KSR* and suggests that the design patent nonobviousness requirement was not heightened by *KSR*.

References may be considered sufficiently related when, for example, they are for designs for the same type of articles.<sup>82</sup> Additionally, not all elements need to have been disclosed in the prior art. Insubstantial changes, sometimes called *de minimis*, may be deemed obvious to a skilled designer,<sup>83</sup> which more often may be the case for particularly simple technologies.<sup>84</sup> By way of example, in *Grand General Accessories Mfg. v. United Pacific Indus., Inc.*, the court determined that a patented ornamental design for automotive stop/tail/turn lights that differed from a prior art design only by the number of bulbs was an obvious variant of that design, and thus invalid.<sup>85</sup>

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<sup>77</sup> The common features were: (1) an opening at the collar portion for the head; (2) two openings and sleeves stitched to the body of the jersey for limbs; (3) a body portion on which a football logo is attached; (4) the jersey being made of a mesh and interlock fabric; (5) at least some ornamental surge stitching; (6) a V neck collar, (7) additional ornamental surge stitching on the rear side; and (8) an interlock fabric panel. *MRC*, 747 F.3d at 1332; *MRC Innovations, Inc. v. Hunter MFG., LLP*, 921 F. Supp. 2d 800, 810 (N.D. Ohio 2013), *aff'd* 747 F.3d 1326 (Fed. Cir. 2014).

<sup>78</sup> *MRC Innovations*, 747 F.3d at 1332-33.

<sup>79</sup> *Id.* at 1331.

<sup>80</sup> *Id.*; *see also Durling*, 101 F.3d at 103 (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); *Para Gear Equip.*, 2005 WL 2266618, at \*4.

<sup>81</sup> *MRC Innovations*, 747 F.3d at 1331.

<sup>82</sup> *Id.* at 1334 (primary and secondary references were for jerseys for dogs and either could have served as primary references).

<sup>83</sup> *Id.* at 1334 (although not disclosed in cited art, extension of stitching was deemed obvious).

<sup>84</sup> *3Form, Inc.*, 2015 WL 9463092, at \*17 (“In addition, for particularly simple technologies, obviousness may be a matter of common sense and logic that may not require explicit teachings in published references or resort to expert opinions.”).

<sup>85</sup> 732 F. Supp. 1014, 1024-25 (C.D. Cal. 2010).

### C. Secondary Considerations

After a challenger or a court has identified one or more secondary references that suggest how to modify the primary reference, following steps 1 and 2 discussed above, one must consider secondary indicia of nonobviousness if they are present.<sup>86</sup> Examples of secondary considerations include:

commercial success of a product due to the merits of the claimed invention, a long felt need for the solution that is provided by the claimed invention, unsuccessful attempts by others to find the solution that is provided by the claimed invention, copying of the claimed invention by others, unexpected and superior results from the claimed invention, acceptance by others of the claimed invention as shown by praise from others in the field or from licensing of the claimed invention, and independent invention of the claimed invention by others before or at about the same time as the named inventor thought of it.<sup>87</sup>

When advancing secondary indicia of nonobviousness, one must establish a nexus between the proffered secondary considerations and the patent claim, *i.e.*, the patented design. Thus, “[m]erely because a product is commercially successful is no guarantee that the success was attributable to the patented feature.”<sup>88</sup>

## V. PRACTICE TIPS

The standards described above provide guideposts for cases in which there is an allegation that a design patent is invalid due to obviousness. But even when mindful of the rubric that courts and the USPTO will use, one must pay careful attention to burdens of proof and persuasion, particularly when one is considering presenting or is forced to defend against a challenge of invalidity.

First, one must remember that the question of obviousness is to be viewed from the perspective of the designer of ordinary capability who designs articles of the type at issue.<sup>89</sup> However, this “hypothetical designer is presumed to have perfect knowledge of all pertinent prior art.”<sup>90</sup> Thus, one should conduct an exhaustive prior art search.

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<sup>86</sup> *Degelman Indus., Ltd. v. Pro-Tech Welding and Fabrication, Inc.*, 2011 WL 6754040, at \*22 (W.D.N.Y. May 27, 2011) (“Evidence of secondary considerations must be considered if present.”).

<sup>87</sup> *Solar Sun Rings*, 2012 WL 5379144, at \*8; *see also* *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *see, e.g., Livjo*, 2011 WL 12516430, at \*4 (plaintiff presented evidence of sales over \$600,000 in 2005 and nearly \$1 million in 2006, and also presented evidence copying).

<sup>88</sup> *Degelman Indus.*, 2011 WL 6754040, at \*22 (“Evidence of secondary considerations must be considered if present.”); *see also* *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1443 (Fed. Cir. 1984) (“to be of value, evidence of commercial success must clearly establish that the commercial success is attributable to the design, and not some other fact, such as a better recognized brand name or improved function.”).

<sup>89</sup> *Huang*, 2014 WL 3559367, at \*5; *see also* *Degelman Indus.*, 2011 WL 6754040, at \*20, \*22 (failure to define level of ordinary skill in the art led to denial of motion for summary judgment).

<sup>90</sup> *Grand General Access.*, 732 F. Supp. 2d at 1024; *Solar Rings*, 2012 WL 5379144, at \*8.

Second, when presenting an affidavit from an expert, the expert should analyze the scope of the proffered prior art.<sup>91</sup> He or she should then identify a reason that would have prompted someone in the relevant field to combine the elements in the way that the claimed new invention did and did not merely provide conclusory opinions.<sup>92</sup>

Third, any expert should cite the relevant standard for obviousness.<sup>93</sup> Fourth, a patent owner must be wary of requests for admission (“RFAs”) that focus on comparisons to prior art designs. In *Apple v. Samsung*, Samsung served forty-five pairs of RFAs that asked Apple to admit that pairs of design patents were “substantially the same” and then to admit that the same pairs of design patents were not “substantially the same.”<sup>94</sup> Apple responded with objections including that the RFAs improperly called for legal conclusions.<sup>95</sup>

The court grouped the RFAs into three categories: “1) comparing an asserted design patent to another asserted design patent; 2) comparing an asserted design patent with one of three, earlier-filed Apples design patents; and 3) comparing an asserted patent with one of eleven later-filed Apple design patents.”<sup>96</sup> The court required Apple to respond to the RFAs for the first group because they pertained to factual issues in dispute—whether the patents-in-suit were invalid based on prior art.<sup>97</sup> The court referenced anticipation as being in dispute, but one can imagine defendants arguing that the rationale would likely be extended to obviousness. In contrast, the court did not require responses to the other two categories because they did not pertain to issues in dispute.<sup>98</sup>

## VI. CONCLUSION

By making a conclusion that an invention (of a utility patent) or a design (of a design patent) is obvious, one inherently is applying his or her bias as to what type and degree of creativity and innovation is worthy of patent rights. Throughout American history this pendulum has swung back and forth, and currently American patent law is in a period of raising the nonobviousness bar, which makes obtaining a patent more difficult. Yet, as this bar was raised for utility patents, particularly in the wake of *KSR*, it appears not to have been commensurately raised for design patents.

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<sup>91</sup> *Degelman Indus.*, 2011 WL 6754040, at \*21-22 (failure to establish scope of and content of prior art led to denial of motion for summary judgement).

<sup>92</sup> *Huang*, 2014 WL 3559367, at \*5; *Blackberry Limited v. Typo Products LLC*, 2014 WL 1318689, at \*6 (N.D. Cal. 2014) (expert’s bald assertion that a combination of “any number of prior art designs” and “a multitude of phone with ‘straight keyboards’ ” renders the patent at issue invalid was not sufficient to establish a likelihood of establishing invalidity due to obviousness).

<sup>93</sup> *Huang*, 2014 WL 3559367, at \*5.

<sup>94</sup> 2012 WL 952254, at \*1 (N.D. Cal. 2012). The court grouped the RFAs into three categories: “1) comparing an asserted design patent to another asserted design patent; 2) comparing an asserted design patent with one of three, earlier-filed Apple’s design patents; and 3) comparing an asserted patent with one of eleven later-filed Apple design patents.” *Id.*

<sup>95</sup> 2012 WL 952254, at \*2 (N.D. Cal. 2012).

<sup>96</sup> *Id.* at \*1.

<sup>97</sup> *Id.* at \*4.

<sup>98</sup> *Id.* at \*4.

For the designer who avails himself or herself of patent rights, this is good news because with the exclusivity of patent rights may come an increase in value. Nevertheless, one should expect that some litigant will soon challenge this double standard for design patents and argue that the “obvious to try” rationale that was so quickly applied after *KSR* in the context of utility patents should be adopted and applied to design patents.