

Don't Overreact To Fed. Circ. Design Patent Ruling

By **Mark Vogelbacker** (November 19, 2018, 12:47 PM EST)

The Federal Circuit in *In re Maatita* recently held that a single, two-dimensional plan view of a three-dimensional object in a design patent can satisfy the enablement and definiteness requirements.^[1] Some in the patent bar may have overreacted to this ruling. But before adopting a doomsday view, several points should be considered to appreciate the likely practical impact of this decision.



Mark Vogelbacker

Background

The design patent application in *Maatita* contained a two-dimensional, bottom plan view drawing of the bottom of an athletic shoe. Much of the drawing was excluded from the claim because it was shown in dashed lines. The patent examiner rejected the claim, not because it was anticipated or obvious over the prior art, but because the single drawing allegedly failed the enablement and definiteness requirements of 35 U.S.C. § 112. The Patent Trial and Appeal Board affirmed.

On appeal, the Federal Circuit stated that there is often little difference between definiteness and enablement for design patents. The court held that the proper inquiry on an indefiniteness challenge is whether one skilled in the art, viewing the design as would an ordinary observer, would understand the scope of the design with reasonable certainty based on the claim and visual disclosure. The Federal Circuit explained that the two-dimensional drawing clearly shows the perspective from which the shoe bottom should be viewed to determine infringement, thereby leaving potential infringers no doubt as to how to determine infringement. Thus, the failure to disclose or claim all depth choices of the bottom of the shoe would not preclude an ordinary observer from understanding the claimed design from a two-dimensional drawing. Accordingly, the Federal Circuit reversed the PTAB's decision.

Practical Impact

Putting aside whether the Federal Circuit's decision is legally correct, and assuming the decision is not reviewed by the U.S. Supreme Court, the impact of this decision may be minimal for the following reasons:

1. Enablement Was Never a Major Factor in Design Patents

It may be fair to categorize the *Maatita* decision as all but eliminating the enablement requirement for design patents. But even if true, this has little impact on the ability to obtain or enforce design patents.

Enablement is almost never raised by a patent examiner during examination, at least when formal patent drawings are properly prepared and included with the initial application. Similarly, the issue of enablement is raised infrequently, at best, in a design patent infringement litigation.[2]

2. Broader Claim Scope Should Be Easier to Invalidate

Maatita would appear to make it easier to obtain broad claim scope in a design patent application. Patent applicants now have case law to support an argument to broaden the scope of new design patent applications by including fewer views or perspectives of the claimed design.

But a patent applicant must be careful — claiming more than it has a right to claim could expose the patent to more prior art in a validity trial in district court. In an interesting twist, a broader claim may make it easier for an accused infringer to prevail on invalidity (i.e., an anticipation theory), instead of being stuck in the more complicated obviousness analysis for design patents.[3]

3. Claiming Less Than the Entire Product May Mean Lower Patent Damages

The Maatita decision could be problematic for accused infringers when viewed in the light of 35 U.S.C. § 289, which outlines a patent owner's potential disgorgement of an infringer's total profit. But the U.S. Department of Justice has proposed a test that could be used to limit a patent owner's damages if what is claimed in the design patent is significantly less than the entire product sold by the infringement.[4] If this test is widely adopted, accused infringers would appear to at least have an argument that damages should only be based on the portion of the infringing product that is actually claimed in the design patent.

4. Two-Dimensional Design Patents Are Not New

It may seem radical that the Federal Circuit has condoned using a design patent with a two-dimensional image to cover a three-dimensional product. In practice, however, this is nothing new. The U.S. Patent and Trademark Office has long granted design patents claiming two-dimensional images or surfaces despite the statute arguably implying that design patents are reserved for three-dimensional "articles of manufacture." [5]

For example, the USPTO issued a design patent for the two-dimensional surface of heat reflective material of a three-dimensional sleeping bag or a boot in 2012 as U.S. Patent No. D657,093. Similarly, Nike Inc. was granted a design patent for the two-dimensional design on a three-dimensional sock in 2014 as U.S. Patent No. D700,431. In one sense, Maatita could be viewed as simply approving a design patent practice that the USPTO had condoned for some time.

5. A Continuation of the Pendulum Swing

Most practitioners would agree that patent rights have become more difficult to obtain in recent years. Perhaps starting in 2014 with the Supreme Court's decision in *Alice Corp. v. CLS Bank*, [6] or the creation of the PTAB in 2013 by the America Invents Act, [7] or maybe even in 2007 with *KSR International Co. v. Teleflex Inc.* [8] or 2006 with *eBay Inc. v. MercExchange LLC*, [9], there are significant hurdles to obtaining and enforcing a patent that did not exist little more than a decade ago.

But recently, there are hints that the pendulum has started to swing back. For example, the Federal Circuit seems to have made it more difficult to invalidate a patent under 35 U.S.C. § 101, [10] the commissioner for patents of the USPTO has implemented more

applicant-friendly examination guidelines,[11] and the PTAB just changed its claim construction standard.[12]

The Maatita decision appears to be another win for patent owners in a patent world that has not been particularly kind to patentees for some time.[13]

Practice Adjustment

Design patent applicants likely should not need to make drastic changes to their filing strategy in light of Maatita. It would be wise for applicants to continue to include at least one embodiment with the standard, multiple views of their ornamental design for any three-dimensional product. But now, based on Maatita, applicants should consider including an additional embodiment in any newly filed design patent application that includes only a single, two-dimensional view of the most unique aspect of any three-dimensional object. Adding this embodiment will preserve an applicant's right to pursue the broadest claim scope, without sacrificing the more narrow scope to which an applicant would otherwise be entitled, based on the multiple-view embodiment.

Applicants should continue to use dashed-lines and multiple embodiments to their advantage to pursue varied claim scopes. Maatita reaffirmed this long-used practice technique.

Mark T. Vogelbacker is an associate at Eckert Seamans Cherin & Mellott LLC.

The opinions expressed are those of the author(s) and do not necessarily reflect the views of the firm, its clients, or Portfolio Media Inc., or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.

[1] *In re Maatita* ●, ___ F.3d ___, 2018 WL 3965892, Appeal 2017-2037 (Fed. Cir. Aug. 20, 2018) (DYK, Reyna, Stoll)

[2] E.g., a recent search of district court opinions from 2015 to the present that addressed enablement for a design patent returned four cases.

[3] Compared to utility patents, it can be more difficult to formulate a proper obviousness rejection for design patents.

[4] The DOJ's amicus brief in *Samsung Elecs. Co. Ltd. v. Apple* ●, 137 S. Ct. 429 (2016) is available at: <http://www.scotusblog.com/wp-content/uploads/2016/06/15-777npUnitedStates.pdf> (last visited Oct. 10, 2018).

[5] 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.")

[6] *Alice Corp. v. CLS Bank Int'l* ●, 573 U.S. ___, 134 S. Ct. 2347 (2014)

[7] Former Federal Circuit Chief Judge Randall Rader referred to the PTAB as "death squads, kind of killing property rights" at the AIPLA annual meeting in Oct. 2013.

[8] *KSR Int'l Co. v. Teleflex Inc.* ●, 550 U.S. 398 (2007) (viewed as making it easier to invalidate a patent based on obviousness)

[9] *eBay Inc. v. MercExchange, L.L.C.* ●, 547 U.S. 388 (2006) (holding that an injunction

should not be automatically issued based on a finding of patent infringement)

[10] See, e.g., *Berkheimer v. HP Inc., et al* , Appeal 2017-1437 (Fed. Cir. Feb. 8, 2018) (vacating-in-part district court's determination of ineligibility); *Aatrix Software, Inc. v. Green Shades Software, Inc.* , Appeal 2017-1452 (Fed. Cir. Feb. 14, 2018) (vacating district court's determination of ineligibility).

[11] Memorandum from Robert W. Bahr to the Patent Examining Corps dated April 19, 2018 and entitled Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*), accessible here: <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF>

[12] "Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board," 37 C.F.R Part 42, 83 FR 51340, published 10/11/2018, accessible here: <https://www.federalregister.gov/documents/2018/10/11/2018-22006/changes-to-the-claim-construction-standard-for-interpreting-claims-in-trial-proceedings-before-the>

[13] E.g., former Federal Circuit Chief Judge Randall Rader referred to the PTAB as "death squads, kind of killing property rights" at the AIPLA annual meeting in Oct. 2013.