Vera Suarez in The Patent Lawyer on Narrowing Scope of Design Patent Claims

November 9, 2021 Vera Suarez

PRACTICES Patents

The Federal Circuit recently held that a design claim is limited to the article of manufacture identified in the claim. In re: SurgiSil, L.L.P. et al., No. 2020-1940, 2021 WL 4515275 (Fed. Cir. Oct. 4, 2021).
The design patent application in SurgiSil claimed an “ornamental design for a lip implant.” During examination, the claimed design was rejected as anticipated by an art “stump” tool.

Art Tool

In its rejection, the Patent Office asserted that the lip implant design was anticipated by the art tool. The Patent Office cited its own Manual of Patent Examining Procedure and a 1956 Court of Customs and Patent Appeals case, In re: Glavas, 230 F.2d 447 (CCPA 1956) to support its assertion that nonanalogous art can be prior art to a design patent claim in an anticipation rejection. SurgiSil argued that the degree to which two articles are analogous should be considered when applying the ordinary observer test, and that the art tool was not analogous enough to anticipate the lip implant. The rejection, however, was maintained.

SurgiSil appealed to the Patent Trial and Appeal Board (“PTAB”). Prior to SurgiSil’s oral argument at the PTAB, the Federal Circuit held in Curver that “claim language can limit the scope of a design patent where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures.” Curver Luxembourg, SARL v. Home Expressions Inc., 938 F.3d 1334, 1340 (Fed. Cir. 2019). In Curver, the Federal Circuit also noted that the “statement about anticipation in Glavas is dictum and thus not binding.” Id. at 1342. Citing Curver, SurgiSil argued that the differences in articles of manufacture are relevant to anticipation and that, because the art stump could not infringe the lip implant, then the art stump could not anticipate the lip implant. The PTAB, however, sustained the rejection, stating that “unlike in Curver, the Figure [of the claimed lip implant] fully defines the invention of the claimed design and it is appropriate to ignore the identification of the article of manufacture in the claim language.” Joint Appendix at Appx001, In re: SurgiSil, L.L.P., et al, No. 2020-1940, 2021 WL 4515275 (Fed. Cir. Oct. 4, 2021).

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