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New developments in post-issuance proceedings

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PTAB Denies Institution of *Inter Partes* Review of Design Patent, Noting 35 U.S.C. 171 is Not a Proper Basis for IPR

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September 22, 2014 – In its decision denying institution of two IPRs, the PTAB outlines how allegedly functional elements of a design patent claim are addressed in an IPR obviousness analysis.

[IPR2014-00542](#) and [IPR2014-00555](#) – *Dorman Products, Inc. v. PACCAR, Inc.* (Papers [10](#) and [10](#))

At issue were claims in design patents D526,429S and D525,731S, each directed to the ornamental design of a truck headlamp. In both cases, the petitioner argued that certain features such as facets and a curved bezel of embodiments of the claims result from functional or mechanical considerations and therefore do not form part of the claims. In response, the patent owner argued, and the PTAB agreed, that whether or not such elements are functional, they must be considered and construed as part of the visual impression created by the patented design as a whole.

The PTAB noted that the petitioner conflated invalidity based on functionality under 35 U.S.C. § 171 with invalidity based on obviousness under 35 U.S.C. 103. Under section 171, an ornamental design of an article of manufacture may not be patented if the design is “primarily functional” rather than “primarily ornamental.” According to the petitioner’s line of reasoning, any illustrated feature considered to be “primarily functional” would be excluded from the scope of the claim (under section 171), and thus, the petitioner would not be required to show that allegedly functional feature anticipated or obvious.

The PTAB disagreed with this reasoning, stating that IPRs are limited to invalidity just under sections 102 and 103 (and based only on patents or printed publications). As such, determining whether certain claimed features should be disregarded as functional under section 171 (prior to performing the obviousness analysis under section 103) is beyond the scope of the proceedings. Accordingly, the Board concluded that the “allegedly functional elements identified by petitioner . . . must be considered in an obviousness analysis of the visual impression created by the patented design as a whole.” The Board further held that when including these allegedly functional elements in its analysis, the petitioner failed to show a reasonable likelihood of prevailing in either case.

The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



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