

Clarifying Multi-Embodiment And Single-View Design Filings

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Judicial determinations related to design law seem to occur infrequently; so, whenever an updated holding is released, practicing attorneys and patent law scholars alike are eager to review the opinion and issue their response. Most recently, two cases have provided some clarity on two polar opposite issues: the consequences related to filing multiple embodiments in a design application, and the consequences related to filing only a single view in a design application.

Recent Case Law in the Application of Prosecution History Estoppel

Advantek Marketing Inc. v. Shanghai Walk-Long Tools Co.

Filing a design patent application with multiple embodiments requires great caution and careful strategy. This practice can indeed avail the applicant to some advantages, such as maintaining a specific priority date for several embodiments. Yet, multiple embodiments may place the patentee in a complicated and potentially detrimental position. The U.S. Court of Appeals for the Federal Circuit's holding in *Pacific Coast Marine v. Malibu Boats*, and the more recent application of that holding in *Advantek Marketing v. Shanghai Walk-Long Tools*,^[1] demonstrates the potential downsides of filing multiple embodiments in a single application.

In *Pacific Coast*, the applicant originally filed drawing figures corresponding to seven embodiments of a marine windshield.^[2] During prosecution, the examiner issued a restriction requirement identifying five patentably distinct groups of designs. In response, the applicant elected one embodiment of the design and received a patent based on the elected embodiment. And, the applicant obtained a design patent for one other embodiment disclosed in the original application. But, the applicant did not file applications to any of the other nonelected embodiments.^[3] *Pacific Coast* brought suit against *Malibu Boats* alleging infringement. The district court determined that the accused design was within the scope of the designs that *Pacific Coast* surrendered during prosecution, and, therefore, *Pacific Coast* was estopped from claiming that *Malibu Boats'* design infringed that patent.^[4]

The Federal Circuit reversed the district court's holding. First, the Federal Circuit confirmed that prosecution history estoppel applies to design patents. Then the Federal Circuit focused on three main issues: (1) whether there was surrender during prosecution; (2) whether the surrender was for reasons of patentability; and (3) whether the accused design was in the scope of the surrender.^[5] Regarding issues one and two, the Federal Circuit found in the affirmative. Regarding issue three, the Federal Circuit held that prosecution history estoppel did not bar *Pacific Coast's* infringement claim because *Malibu Boats'* accused design was not within the scope of the claim surrendered during prosecution.^[6]



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The recent holding in *Advantek* applied the concept of surrender in prosecution history estoppel developed in *Pacific Coast*, albeit requiring a nuanced approach.[7] *Advantek* designed a portable, gated pet kennel having the visual impression of a gazebo. The originally filed application included drawing figures showing two embodiments of the design: One embodiment showed the design without a cover, and one embodiment showed the design with a cover. During prosecution, the applicant received a restriction requirement and in response, proceeded by electing the embodiment of the pet gazebo design shown without a cover and cancelling the embodiment of the design shown with a cover.

After securing the design patent (US D715,006), *Advantek* sought to enforce protection against *Shanghai Walk-Long Tools* in the U.S. District Court for the Central District of California, alleging patent infringement based on *Walk-Long's* pet kennel gazebo design, which included a cover. *Advantek* argued that an ordinary observer would find its product and the defendant's product to be substantially the same. And, they did not deliberately surrender any scope of the design to secure a patent when cancelling the cover embodiment.[8]

The district court was not persuaded by these arguments, finding that the ordinary observer analysis is barred where prosecution history estoppel applies.[9] And, the district court determined that in the applicant's cancellation of the embodiment of the pet gazebo with a cover during prosecution, it had surrendered the covered version of the design, and found no infringement.

On appeal, however, the Federal Circuit found that prosecution history estoppel was not applicable in this case.[10] The Federal Circuit's determination centered on the third prong of the test established in *Pacific Coast*: whether the accused design is within the scope of the claim surrendered during prosecution.[11] Here, *Advantek's* claim was directed to the structural design of the kennel. The structural design of *Advantek's* kennel is present in *Walk-Long's* accused product, regardless of whether *Walk-Long's* product is provided with a cover or not. As such, the Federal Circuit reversed and remanded the district court's decision. Specifically, the Federal Circuit held that since *Walk-Long's* accused design included the structural claim of *Advantek's* '006 patent, which was not surrendered during prosecution, *Advantek* was not estopped by prosecution history from asserting the '006 patent against *Walk-Long*. [12] In a sense, *Advantek* distinguished *Pacific Coast* on the ground that the cancelled embodiment was the same as the pursued embodiment with a cover added, and that prosecution history estoppel should not apply in such "subset"-type situations.

For practitioners, the holdings in *Pacific Coast* and *Advantek* demonstrate the importance of careful strategy when filing design applications including multiple embodiments. Including multiple embodiments in a single design application should not be viewed simply as an easy cost-saving alternative to filing more than one application. Rather, multiple-embodiment design applications are a filing approach that is client- and product-specific. For instance, a furniture company may decide to file an application showing variations of a chair design that they plan to publicly disclose in a month, with the intent of only pursuing the best-selling variation(s). The prosecution history estoppel risk is that unelected but similar-looking embodiments, if restricted but not pursued in divisional applications, might be subject to prosecution history estoppel if they are not considered "subset"-type embodiments as in

Advantek.

In the situation where multiple embodiments are pursued in a single application, the next best strategy for a practitioner is to quickly file a preliminary amendment to cancel any other embodiments showing the chairs that are not commercially successful prior to receipt of a restriction requirement.

Recent Case Law in the Adequacy of Views Provided in a Drawing Disclosure

In re Maatita

In re Maatita[13] illustrates that a single two-dimensional drawing can provide enough support for a design claim. In a three-judge panel decision, Judge Timothy Dyk, writing for the panel, reversed the U.S. Patent and Trademark Office enablement and indefiniteness rejections of a single-drawing design patent. The USPTO rejected Maatita's design patent application because the claim was open to multiple interpretations regarding the depth and contour of the claim features.[14]

In a rejection by the USPTO, the examiner prepared and included four three-dimensional renderings showing different possible interpretations of Maatita's design.[15]

Despite differing interpretations, the panel reversed the USPTO's decision.[16] The court reasoned that like utility patents, definiteness and enablement of design patents are measured from the perspective of one skilled in the art.[17] And, the court explained that the purpose of the definiteness requirement is to ensure that claims are clear enough to persons skilled in the art such that the scope of the claim can be understood and what would infringe.[18] The court cited a few examples of where design claims were held indefinite due to inconsistencies in the drawings, but distinguished these cases on the basis that no inconsistencies existed in Maatita's drawing.[19] The court opined that the sufficiency of the disclosure for purposes of definiteness depends on whether a drawing can adequately disclose the design of the article.[20] For instance, the designs for an entire shoe or a teapot are three-dimensional and would not be capable of being understood with a single plan-view drawing.[21] The court found that although a shoe bottom can have three-dimensional aspects, that does not change the fact that a shoe bottom is capable of being understood with a two-dimensional plan-view drawing akin to rugs and place mats, which can be understood through a two dimensional plan-view drawing.[22]

Thus, the court found it is possible for a single two-dimensional plan-view drawing to convey sufficient detail to understand a claim to a three-dimensional structure such as a shoe bottom.[23] And, because a person of ordinary skill in the art could make the necessary comparisons for infringement based on the two-dimensional depiction, Maatita's claim meets the enablement and definiteness requirements.[24] As of the publication date of this article, there has been no rehearing request at the Federal Circuit. It is unclear, although doubtful, whether the USPTO will file a petition for certiorari before the upcoming deadline of Dec. 19, 2018.

The holding in *Maatita* could be construed narrowly to apply only to single-view applications. While this approach might be considered too wooden, if adopted by the USPTO, it would sharply limit the effect of *Maatita* because in general, most design patent practitioners file more than one view where the invention is a three-dimensional design (and when they do file a single figure, it is often for graphical user interfaces, or GUIs, where having the protection of multiple depths may not be relevant). The standards that arose in *Maatita* were essentially themed on the fact that there was only a single figure to examine. As a result, the court merged an enablement and definiteness analysis, and then connected the definiteness standard to design patent infringement. Albeit, practitioners should not feel encouraged (or enabled) to file a single view in design applications of a three-dimensional invention. At the very least, *Maatita* serves as an obvious reminder that single-view designs are highly prone to invite argument from the USPTO and beyond. That being said, options can be limited and there may be instances where a single drawing is all that is available to the applicant. For instance, if the applicant needs to claim priority to a utility application in order to overcome a prior disclosure, there may be limited drawings in the utility filing. Or, if there is an infringer that only misappropriates a single face or pattern of the claimed article, filing a continuation with one view may be the applicant's only option. And, *Maatita* validates these options to the applicant.

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[1] *Advantek Marketing Inc. v. Shanghai Walk-Long Co.*, 898 F.3d 1210 (Fed. Cir. 2018)

[2] *Pacific Coast Marine Windshields Ltd. V. Malibu Boats LLC*, 739 F.3d 694, 109 USPQ2d 1225 (Fed. Cir. 2014).

[3] *Id.* at 698-99.

[4] *Id.* at 700.

[5] *Id.* at 702.

[6] *Id.* at 705.

[7] *Advantek Mktg. Inc. v. Shanghai Walk-Long Tools Co.*, No. CV 16-3061-R, 2016 WL 9178079 (C.D. Cal. Nov. 3, 2016).

[8] *Advantek Mktg. Inc. v. Shanghai Walk-Long Tools Co. Ltd.; Neocraft Tools Co. Ltd.*

Orion Factory Direct, and Does 1-10 inclusive, Defendants., 2016 WL8231355 (C.D. Cal.) (Trial Motion, Memorandum and Affidavit).

[9] Advantek, No. CV 16-3061-R at 2.

[10] Advantek Mktg., Inc. v. Shanghai Walk-Long Tools Co., Ltd. 898 F.3d 1210 (Fed. Cir. 2018).

[11] Id. at 1215.

[12] Id. at 1216-17.

[13] In re Maatita, Appeal No. 2017-2037 (Fed. Cir. Aug. 20, 2018)

[14] See id. at 13.

[15] See id. at 5.

[16] See id. at 13.

[17] See id. at 9.

[18] See id.

[19] See id. at 8.

[20] See id. at 12.

[21] See id.

[22] See id. at 13.

[23] See id.

[24] See id.