

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IDEAVILLAGE PRODUCTS CORP.,
Petitioner,

v.

KONINKLIJKE PHILIPS N.V.,
Patent Owner.

PGR2021-00116
Patent D905,346 S

Before KEN B. BARRETT, GRACE KARAFFA OBERMANN, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

A. *Background and Summary*

IdeaVillage Products Corp. (“Petitioner”)¹ filed a Petition requesting post-grant review of U.S. Design Patent No. D905,346 S (“the ’346 patent,” Ex. 1001). Paper 1 (“Pet.”). The Petition challenges the patentability of the sole claim of the ’346 patent. Koninklijke Philips N.V (“Patent Owner”)² did not file a Preliminary Response to the Petition.

A post-grant review may be instituted only if “the information presented in the petition . . . demonstrate[s] that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a) (2018). For the reasons set forth below, we deny institution.

B. *Related Proceedings*

One or both parties identify, as a matter involving or related to the ’346 patent, *Koninklijke Philips N.V. v. IdeaVillage Products, Corp.*, Case No. 2:21-cv-08706, in the U.S. District Court for the District of New Jersey. Pet. 4; Paper 5, 2.

Additionally, it is our understanding that the ’346 patent is or was involved in *Koninklijke Philips NV f/k/a Koninklijke Philips Electronics NV v. 10793060 Canada Inc. et al.*, 2-21-cv-01910, in the U.S. District Court for the Eastern District of New York.

¹ Petitioner identifies IdeaVillage Products Corp. as the real party-in-interest. Pet. 4.

² Patent Owner identifies Koninklijke Philips N.V. as the real party-in-interest. Paper 5, 2.

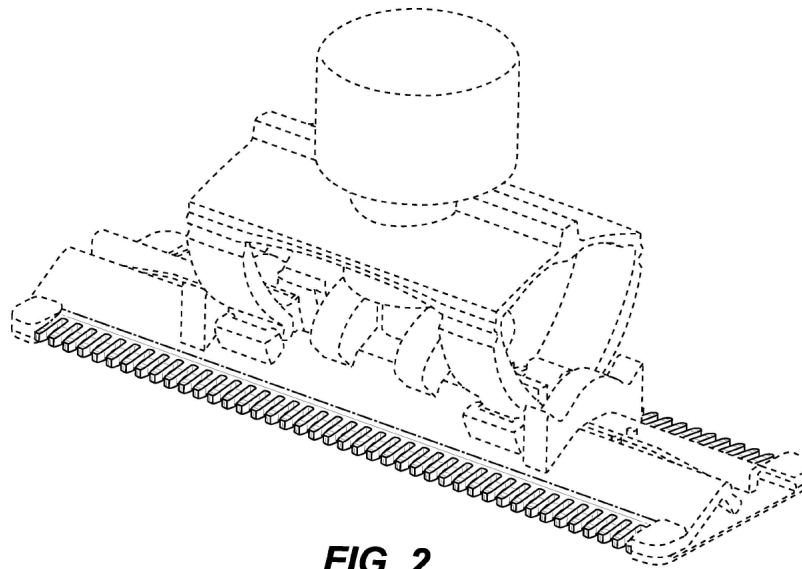
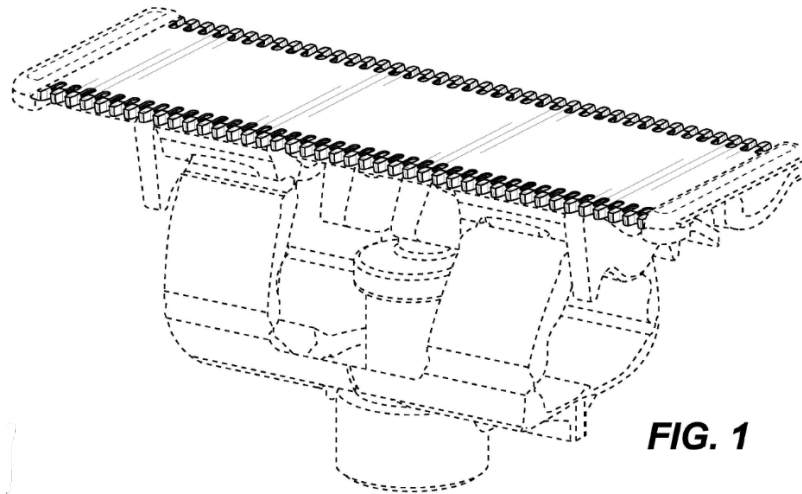
C. The '346 Patent and the Claim

We apply the same claim construction standard used in district courts, namely that articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.200(b) (2020). With regard to design patents, it is well-settled that a design is represented better by an illustration than a description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although a design patent claim is preferably not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Id.* at 679–80; *cf. High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to the district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”).

The '346 patent is titled “Blade Set,” and issued December 15, 2020, from U.S. Application No. 29/713,946, filed November 20, 2019.³ Ex. 1001, codes (21), (22), (54). The claim recites “[t]he ornamental design for a blade set, as shown and described.” *Id.*, code (57). The drawings of the claim depict the claimed blade set mounted on a shaver head, with certain unclaimed aspects of the blade set and shaver head illustrated by broken lines. *See id.* (“The broken lines of even length illustrate portions of the blade set that form no part of the claimed design. The broken lines of

³ Because the earliest possible effective filing date for the '346 patent is after March 16, 2013 (the effective date for the first inventor to file provisions of the America Invents Act) and the Petition was filed within 9 months of its issue date, the '346 patent is eligible for post-grant review. *See* 35 U.S.C. § 321(c).

uneven length illustrate the boundary of the claimed design and form no part thereof.”). The '346 patent contains eight figures, which are reproduced below.



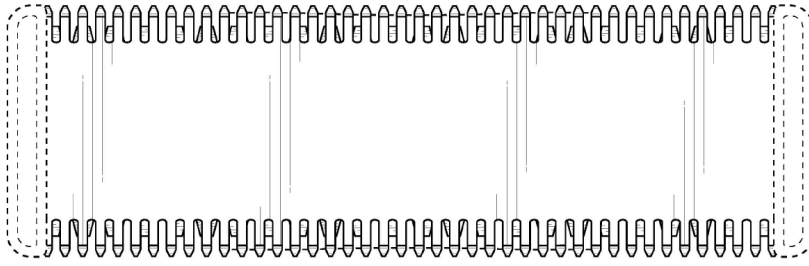


FIG. 3

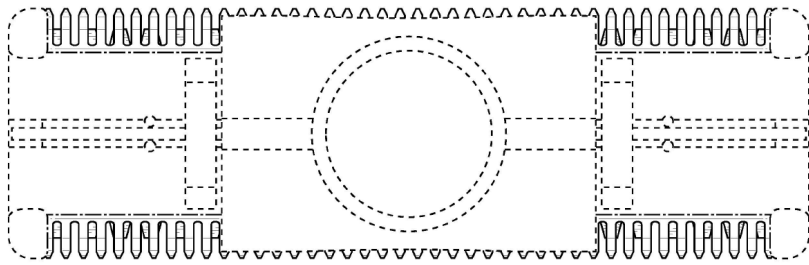


FIG. 4

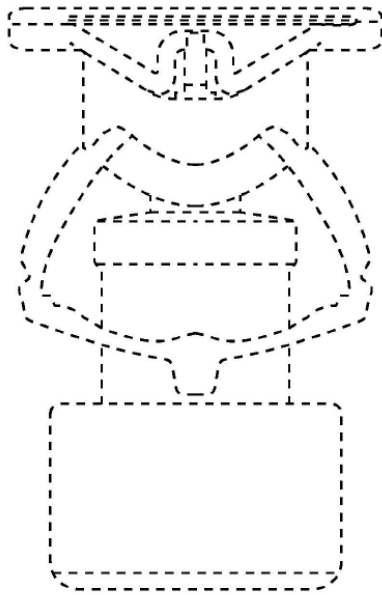


FIG. 5

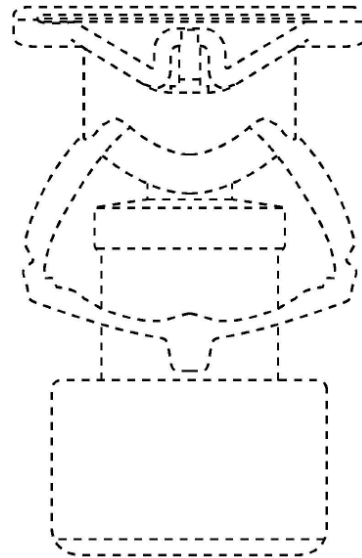


FIG. 6

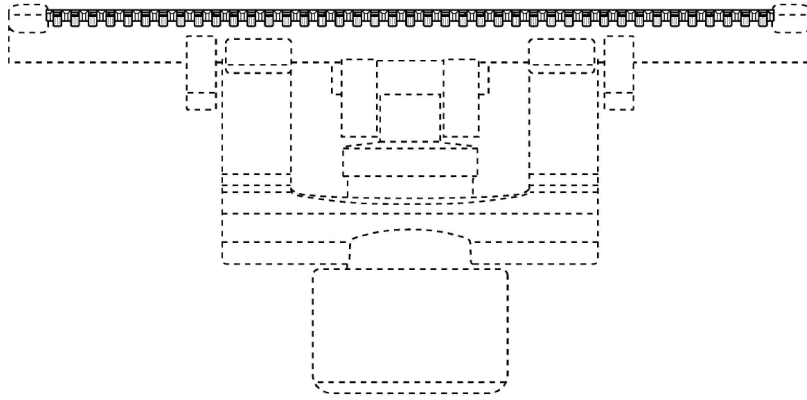


FIG. 7

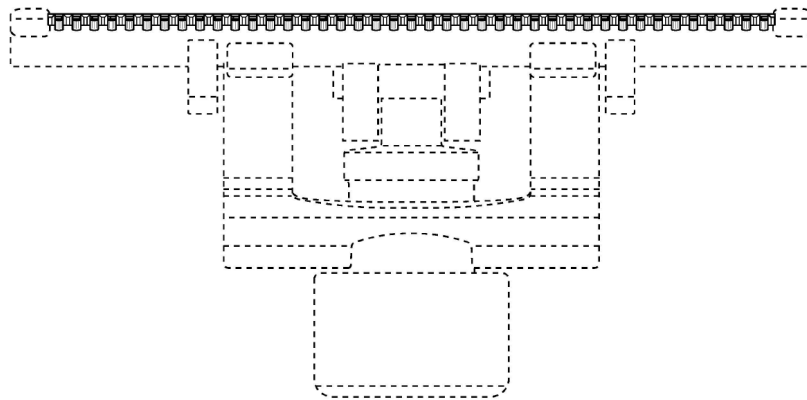


FIG. 8

Ex. 1001. Figures 1–8 above depict, respectively, the following views of the claimed blade set design: (1) a top, front, right perspective view; (2) a bottom, rear, left perspective view; (3) a top plan view; (4) a bottom plan view; (5) a right side elevation view; (6) a left side elevation view; (7) a rear elevation view; and (8) a front elevation view. *Id.*, code (57).

In the Petition’s claim construction section, Petitioner turns to the written description in a U.S. Patent Application Publication of a utility patent application (U.S. Application No. 15/301,428, “the ’428 application”) that is the grandparent of the challenged design patent. Pet. 26–28 (citing Ex. 1010); *see* Ex. 1001, code (60). Petitioner argues that the utility patent

application “points out the various features comprising the overall appearance of the design claimed in the D’346 patent.” Pet. 26; *but see id.* at 46 (Petitioner arguing that “the figures filed in . . . the ’428 application . . . do not adequately disclose the design of the D’346 patent.”). Petitioner, with reference to the elements of an embodiment in the utility patent application, characterizes the claimed design of the ’346 patent as follows.

The D’346 patent has disclaimed nearly the entire shaving head of the blade set, reducing the claimed subject matter to rows of teeth, the gaps formed by the teeth, a front central component (thin metal component 40 – cover plate), a portion of the rear central surface (portion of plastic component 38), and glimpses of the cutting blade visible in the gaps (movable cutter blade 24). The overall appearance of the claimed subject matter is informed by the characteristics of these individual elements (teeth, gaps, and front central component) and the proportional relationship of the elements to each other.

Id. at 28; *see also id.* at 91. Petitioner’s witness, Mr. Fletcher, testifies that “the D’346 Patent has reduced the claimed subject matter to a specific ornamental arrangement of various elements related to the appearance of the teeth, disclaiming the lateral protecting elements, the major design aspects of the rear housing and rear mounting structure.” Ex. 1003 ¶ 60.

On this record and for purposes of this decision, we determine that no express verbal description of the claimed design is necessary. *Cf. Egyptian Goddess*, 543 F.3d at 679–680 (“[I]n deciding whether to attempt a verbal description of the claimed design, the court should recognize the risks entailed in such a description, such as the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.”).

D. Evidence

Petitioner relies on the following references and other evidence in support of its challenges:

Reference	Exhibit No.
Complaint for Design Patent Infringement, dated Apr. 8, 2021, <i>Koninklijke Philips N.V. v. IdeaVillage Products, Corp.</i> , Case No. 2:21-cv-08706 (D.N.J.)	1004
Philip’s Press Release, “Philips produces one hundred millionth blade for its OneBlade, the product that disrupted the grooming market,” dated Apr. 20, 2021	1005
US D776,878 S; filed Aug. 3, 2015; issued Jan. 17, 2017 (“Andersson US”)	1006
EU RCD 002627372-0002; registered Feb. 5, 2015 (“Philips RCD”)	1007
WO 2016/134979 A1; filed Feb. 11, 2016; published Sept. 1, 2016 (“Stapelbroek PCT”)	1008
EP 2 857 158 B1; filed Oct. 1, 2013; published Apr. 8, 2015 (“Stapelbroek EP”)	1009
US 2017/0113361 A1; filed Oct. 3, 2016; published Apr. 27, 2017 (“Feijen US”)	1010
WO 2015/158923 A1; filed Apr. 20, 2015; published Oct. 22, 2015 (“Feijen PCT”)	1011

Petitioner also relies on the declaration of Timothy P. Fletcher (Ex. 1003) in support of its arguments. Petitioner also relies on other exhibits as discussed below.

E. Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claim is unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	102(a)(1)	Philips OneBlade
1	103	Andersson US
1	103	Philips RCD
1	103	Stapelbroek PCT
1	103	Stapelbroek EP
1	103	Feijen US
1	103	Feijen PCT
1	112(b)	Indefiniteness
1	171(a)	Lack of Ornamentality

II. ANALYSIS

A. Principles of Law

1. Priority and the Effective Filing Date

“[A] patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) (quoting *In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995)); see *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013).

The test for sufficiency of the written description, which is the same for either a design or a utility patent, has been expressed as “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the

filing date.” . . . In the context of design patents, the drawings provide the written description of the invention.

In re Owens, 710 F.3d at 1366 (citations omitted).

2. *The On-Sale Bar*

The America Invents Act (“AIA”) version of Section 102 provides

A person shall be entitled to a patent unless . . . the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

35 U.S.C. § 102(a)(1).

[T]he on-sale bar applies when two conditions are satisfied before the critical date. First, the product must be the subject of a commercial offer for sale. . . . Second, the invention must be ready for patenting.

Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67 (1998); *see also Junker v. Med. Components, Inc.*, 25 F.4th 1027, 1032 (Fed. Cir. 2022) (applying *Pfaff* in the context of a design patent).

For anticipation to be found, the allegedly anticipating reference must be compared to the properly construed design claim and it must be found that the two designs are substantially the same. *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1312–13 (Fed. Cir. 2001) (citing *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871)). “Two designs are substantially the same if their resemblance is deceptive to the extent that it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design supposing it to be the other.” *Id.* at 1313.

3. *Obviousness*

“In addressing a claim of obviousness in a design patent, the ultimate inquiry is whether the claimed design would have been obvious to a designer

of ordinary skill who designs articles of the type involved.” *Apple, Inc. v. Samsung Elec. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (internal quotation and citations omitted); *see also High Point Design*, 730 F.3d at 1313. This obviousness analysis generally involves two steps: first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.” *High Point Design*, 730 F.3d at 1311 (internal quotation and citations omitted).

4. *Indefiniteness*

“[A] design patent is indefinite under § 112 if one skilled in the art, viewing the design as would an ordinary observer, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure.” *In re Maatita*, 900 F.3d 1369, 1377 (Fed. Cir. 2018); *see id.* (“So long as *the scope of the invention is clear with reasonable certainty to an ordinary observer*, a design patent can disclose multiple embodiments within its single claim and can use multiple drawings to do so.” (emphasis added)); *id.* at 1378 (“Even under the correct test, which looks to how the ordinary observer would interpret the drawing actually included in the application . . .”).

5. *Lack of Ornamentality*

Section 171(a) of Title 35 of the United States Code provides: “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.” 35 U.S.C. § 171(a) (2018) (emphasis added). “[A] design patent can be declared invalid if the claimed design is primarily

functional rather than primarily ornamental, i.e., if the claimed design is dictated by the utilitarian purpose of the article.” *High Point Design*, 730 F.3d at 1315 (internal quotations and citations omitted). “An article of manufacture necessarily serves a utilitarian purpose, and the design of a useful article is deemed to be functional when the appearance of the claimed design is dictated by the use or purpose of the article.” *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (citation omitted).

“[T]he utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent.” *Id.* “In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.” *Id.*

The U.S. Court of Appeals for the Federal Circuit has provided a list of “appropriate considerations for assessing whether the patented design as a whole—its overall appearance—was dictated by functional considerations.” *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997).

Consideration of alternative designs, if present, is a useful tool that may allow a court to conclude that a challenged design is not invalid for functionality. . . . Other appropriate considerations might include: whether the protected design represents the best design; whether alternative designs would adversely affect the utility of the specified article; whether there are any concomitant utility patents; whether the advertising touts particular features of the design as having specific utility;

and whether there are any elements in the design or an overall appearance clearly not dictated by function.

Id.; see also *PHG Techs., LLC v. St. John Companies, Inc.*, 469 F.3d 1361, 1366–67 (Fed. Cir. 2006) (approvingly quoting *Barry*'s list of considerations).

B. The Designer of Ordinary Skill in the Art

Petitioner proposed a definition for the person of ordinary skill in the art (“POSITA”), specifically asserting the following:

The POSITA relating to the subject matter of the D’346 patent would possess [a] Bachelor’s degree in industrial design (or a related or equivalent field) and at least ten (10) years of research or work experience related to designing, developing, specifying, testing or analyzing multi-component consumer products (or supervising the same), with experience related to handheld consumer electronic products.

Pet. 14. For purposes of this decision, we assume Petitioner is referring to the designer of ordinary skill in the art. See *In re Nalbandian*, 661 F.2d 1214, 1216 (CCPA 1981) (“In design cases we will consider the fictitious person identified in § 103 as ‘one of ordinary skill in the art’ to be the designer of ordinary capability who designs articles of the type presented in the application.”). Patent Owner has not filed a preliminary response and therefore, at this stage, does not disagree or propose a different definition of the designer of ordinary skill in the art.

Based on the limited record in front of us, we determine that Petitioner’s definition is consistent with the level of ordinary skill reflected in the prior art references of record. See *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (recognizing that the prior art itself may reflect an appropriate level of skill in the art). For purposes of this decision, we apply Petitioner’s definition of the designer of ordinary skill in the art.

C. The Effective Filing Date and the Alleged Break in the Priority Chain

Petitioner contends that there is a break in the chain of priority and that the '346 patent is entitled to an effective priority date no earlier than June 28, 2019, the filing date of the parent design patent application No. 29/696,507, now U.S. Design Patent No. D870,972 (the "D'972 patent"). Pet. 43. Petitioner further contends that the relied-upon references qualify as prior art if, as it argues, the effective priority date is June of 2019. *See, e.g., id.* at 1 ("[W]ithout benefit of priority to the '428 application and [Application No. PCT/EP2015/058486 ("the '486 PCT application")], the D'346 patent is anticipated by the OneBlade shaver."). Thus, according to Petitioner, "[t]his break in the chain of priority provides the underlying basis for grounds 1–7." *Id.* at 43. For the reasons discussed below, we determine Petitioner, regardless as to the effective priority date, has not demonstrated that it is more likely than not that Petitioner would prevail in those seven challenges—the anticipation (on-sale bar) and obviousness grounds. Therefore, we need not and do not reach Petitioner's contentions regarding a purported break in the priority chain.

D. Ground 1: The On-Sale Bar

Petitioner contends that the claimed design is unpatentable due to the on-sale bar. Pet. 64–67. Specifically, Petitioner contends that "[t]he Philips OneBlade launched in 2016" and "the launch and sale of the OneBlade anticipates the D'346 patent." Pet. 64 (citing Ex. 1004 ¶¶ 9, 15; Ex. 1005). The two relied-on documents, a complaint filed in a related district court action and a press release, are dated 2021. *See* Ex. 1004; Ex. 1005.

Petitioner's theory is premised on the assertion that "Patent Owner admitted in the currently pending District Court litigation, that the OneBlade

shaver head was introduced in 2016” and that “Patent Owner admitted that the D’346 patent covers the design of the OneBlade.” Pet. 16 (citing Ex. 1004 ¶¶ 9, 15); *see id.* at 16 n.1 (Petitioner asserting that “Patent Owner likewise admitted that the Oneblade was launched in 2016, in a recent April 20, 2021 press release”).

To trigger the on-sale bar, a product embodying the challenged claim must have been, prior to the bar date, the subject of a commercial offer for sale and the design must have been ready for patenting. *Pfaff*, 525 U.S. at 67. Petitioner has not presented evidence adequate to show that it is more likely than not that the claimed design was on-sale, within the meaning of § 102(a)(1), in 2016.

The allegation in the complaint that the Philips “OneBlade product” was “[i]ntroduced in 2016” is ambiguous and is not evidence from which we reasonably could find that the product was the subject of a commercial offer for sale in 2016. *See* Ex. 1004 ¶ 9. The press release stating that the OneBlade was “launch[ed]” in 2016 similarly is unavailing. *See* Ex. 1005, 1. Petitioner does not address adequately the “ready for patenting” prong. *See* Pet. 16–19, 64–67.

Additionally, Petitioner has not shown adequately that the product introduced in 2016 embodies the claimed design. Petitioner does not, for example, assert that the appearance of the OneBlade has remained unchanged since 2016, and Petitioner has not shown that the images of the OneBlade reproduced in the Petition are of the same apparatus introduced in 2016. The images that comprise Petitioner’s “side-by-side visual comparison, which [allegedly] shows the substantial similarity between the Philips OneBlade and the D’346 patent” are undated and the Petition lacks

citation to any exhibit supporting the images, and we discern no other support for those images in the evidence of record. *See* Pet. 65–66; *see also id.* at 19 (uncited and undated images). The allegation in paragraph 15 of the complaint—that, “[t]o protect the ornamental appearance of Philips’ unique blade design for the OneBlade shaver, Philips obtained U.S. Design Patent . . . D905,346”—is not, as Petitioner implies, adequate proof that the patent covers the product introduced in 2016, and does not discharge Petitioner’s burden to show that a product embodying the claimed design was on sale in 2016, as Petitioner alleges. *See* Ex. 1004 ¶ 15.

We determine that Petitioner has not demonstrated that it is more likely than not that the challenged claim is unpatentable under the on-sale bar.

E. Grounds 2–7: Obviousness

Petitioner presents several single-reference obviousness challenges, arguing that the claimed design would have been obvious: over Andersson US, over Philips RCD, over Stapelbroek PCT, over Stapelbroek EP, over Feijen US, and over Feijen PCT. Pet. 67–80 (Grounds 2–7).

An obviousness analysis involves two steps; first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.” *High Point Design*, 730 F.3d at 1311 (internal quotation and citations omitted). Even when secondary references are not used, the analysis still requires an explanation as to how and why the primary reference (something having design characteristics basically the same as the

claimed design) would be modified to arrive at a design that has the same overall visual appearance as the claimed design. *See, e.g., In re Nalbandian*, 661 F.2d at 1217 (involving single-reference obviousness rejection and addressing the differences between the reference and the claimed design); *In re Lamb*, 286 F.2d 610, 611 (CCPA 1961) (affirming the Board in a case involving a single-reference obviousness rejection where “the board observed that it is conventional to use relatively slimmer handles with slim blades and that therefore, ‘it would be expected that a designer skilled in the cutlery art would use a somewhat narrower or slimmer handle with a slim blade.’”).

The articulations of Petitioner’s obviousness challenges all follow a similar pattern. *See* Pet. 67–80 (citing Ex. 1003 ¶¶ 79–84). For each ground, Petitioner argues that “[t]he below side-by-side visual comparison shows that [the subject reference] is basically the same as the D’346 patent,” followed by a group of images that constitute the visual comparison. Pet. 67, 70, 72, 74, 76, 78. Thus, at this point in its analysis, Petitioner has only alleged that it has presented an appropriate primary reference, one with design characteristics basically the same as the claimed design. For Grounds 3–5, Petitioner’s analysis ends at that point. *See, e.g., id.* at 70–71 (the Philips RCD ground). Mr. Fletcher’s testimony lacks an adequate explanation for his conclusory opinion of obviousness. *See, e.g., Ex. 1003 ¶¶ 79–84; see, e.g., id.* ¶ 80 (“It is my opinion that Philips RCD redners [sic] the D’346 patent invalid as obvious. I have prepared the below side-by-side visual comparison [that] shows that Philips RCD is basically the same as the D’346 patent.”).

For Ground 2, Petitioner asserts (without citation to the record) that, during prosecution of the *parent application* (that issued as the D’972 patent), Patent Owner was required to file a terminal disclaimer due to similarities with Andersson US, and that, during the prosecution of the application for the ’346 patent, Patent Owner was required to file a terminal disclaimer due to similarities with its parent application. *See* Pet. 67. From this, Petitioner concludes that “[a]ll three designs in Andersson US, the [parent] D’972 patent, and the D’346 patent are visually similar and—when the chain of priority is correctly broken—result in Andersson US acting as invalidating prior art to the D’972 and D’346 patents.” *Id.* at 67–68; *see also id.* at 2 (Petitioner implying that this logic also extends to Philips RCD, a document in the priority chain of Andersson US). The corresponding paragraph in the Fletcher declaration does not contain the assertion that all three are visually similar. *See* Ex. 1003 ¶ 79. Petitioner’s mere reference to the prosecution history without supporting citations and the accompanying conclusory assertion that three designs are visually similar is not an adequate substitute for the necessary explicit obviousness analysis that should have been made in the Petition.

For Ground 6, Petitioner argues that, “[e]ven though Feijen US contains visual differences that mean that the D’346 cannot rely on the content of Feijen US (the ’428 application) for priority due to lack of written description support, these differences are *de minimis* in the obviousness context.” Pet. 76 (citing Ex. 1003 ¶ 83). For Ground 7, which relies on Feijen PCT, Petitioner makes a similar argument. *Id.* at 78 (citing Ex. 1003 ¶ 84). Mr. Fletcher makes the same assertion that “these differences are *de minimis*.” Ex. 1003 ¶¶ 83–84. Neither Petitioner nor Mr. Fletcher explains

why a designer of ordinary skill in the art would consider “these differences” to be *de minimis*. *Cf., e.g.,* Pet. 57 (Petitioner arguing for a break in the priority chain because “[t]he relative size and shape of the [tooth structure] parts are all different between [the Feijen priority applications and] the D’346 patent, resulting in a different ornamental appearance.”).

All of Petitioner’s obviousness grounds are inadequate as they fail to include, for example, an adequate discussion of the differences between the challenged claim and the asserted prior art reference along with an explanation as to why it would have been obvious to modify the reference to arrive at a design that has the same overall visual appearance as that of the challenged claim. *See High Point Design*, 730 F.3d at 1311.

We determine that Petitioner has not demonstrated that it is more likely than not that the challenged claim is unpatentable as obvious over the relied-on references.

F. Ground 8: Indefiniteness

Petitioner argues that the challenged design claim is indefinite due to “many individual inconsistencies” between figures. Pet. 80.

Our reviewing court explains that “a design patent is indefinite under § 112 if one skilled in the art, viewing the design as would an ordinary observer, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure.” *In re Maatita*, 900 F.3d at 1377.

Although Petitioner purports to apply the *Maatita* standard in its summary argument (Pet. 80), Petitioner’s analysis at least once refers to the individual purported inconsistencies from the perspective of the ordinary designer without accounting for the designer viewing the design as would an

ordinary observer. *See, e.g., id.* at 82 (arguing that “an ordinary designer would not be able to ascertain the bounds of the claim given this inconsistency.”). When Petitioner does refer to the perspective of the ordinary designer, viewing the design as would an ordinary observer, Petitioner relies on the testimony of Mr. Fletcher, which, in contrast, utilizes the “POSITA.” *See, e.g., id.* at 85 (citing Ex. 1003 ¶ 40); Ex. 1003 ¶ 40 (“A POSITA would be unable to understand the claimed design with reasonably certainty because of the inconsistencies in the figures above.”).

Mr. Fletcher’s testimony not only suggests that he utilized the incorrect standard, but also lacks credibility because it is internally inconsistent with other parts of his testimony. Mr. Fletcher testifies that it is his understanding that indefiniteness is viewed through the perspective of the ordinary observer, stating the following:

I understand that an *ordinary observer* must be able to understand the scope of an invention with reasonable certainty. If not, a design is indefinite under 35 U.S.C. § 112. It is my understanding that errors and inconsistencies between drawings of a design patent can be indefinite, and thus invalid, if an *ordinary observer* cannot discern the overall appearance of the claimed design without resorting to conjecture or speculation.

Ex. 1003 ¶ 27 (emphasis added). However, his opinions regarding indefiniteness all are in terms of the “POSITA.” Ex. 1003 ¶¶ 32–58; *see, e.g., id.* ¶ 32 (“The D’346 Patent is indefinite due to the inclusion of conflicting views, which would prevent a POSITA from understanding the claimed design as drawn. . . . A POSITA cannot discern from the D’346 Patent figures what design is actually being claimed.”). Casting further doubt on the reliability of his testimony, Mr. Fletcher does not articulate any definition for the POSITA, which is a necessary foundation for his

opinions.⁴ Mr. Fletcher does not refer to the perspective of the ordinary observer (or even one skilled in the art, viewing the design as would an ordinary observer) in his opinions regarding indefiniteness (Ex. 1003 ¶¶ 32–58), and we decline to assume his references to the unadorned “POSITA” implicitly encompass the perspective of the ordinary observer. Thus, Mr. Fletcher’s testimony regarding indefiniteness is unhelpful because it utilizes the incorrect perspective.

Furthermore, many of Petitioner’s indefiniteness contentions involve the use of greatly magnified images of the figures of the ’346 patent in arguing that there are inconsistencies between figures. *See, e.g.*, Pet. 84. Neither Petitioner nor Mr. Fletcher asserts that the pertinent hypothetical person—one skilled in the art, viewing the design as would an ordinary observer—would engage in the magnification exercise or would have detected the purported inconsistencies absent such. *See Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871) (holding that design patent infringement is viewed from “the eye of an ordinary observer, giving such attention as a purchaser usually gives”), cited in *In re Maatita*, 900 F.3d at 1377 (“[I]t is clear that the standard for indefiniteness is connected to the standard for infringement.”)). The opportunities for dramatic disparities in Mr. Fletcher’s POSITA-perspective and in that of the ordinary designer viewing through the lens of the ordinary observer are highlighted by the figures reproduced below—Mr. Fletcher’s enlarged view of Figure 1 and an image of the purported commercial embodiment in use.

⁴ At one point, Mr. Fletcher refers to “an [sic] POSITA (or ordinary designer),” leaving it unclear as to whether he equates the two or considers them to be different and alternative perspectives. Ex. 1003 ¶ 44.



Above, on the left is Mr. Fletcher’s enlarged image from Figure 1 of the ’346 patent with his annotations in the form of “red dimension lines in order to show the relative proportions of these [tooth end profile and tooth] elements.” Ex. 1003 ¶ 49. On the right is an image from a document identified by Petitioner as “Philips OneBlade Information Guide,” with the image depicting the entire blade set as approximately only two fingers wide. Ex. 1013. Mr. Fletcher opines that “[t]he importance of relative proportions is crucial for a POSITA attempting to be informed of the overall claimed design [and] . . . the POSITA would study the relative proportions between elements [such as the thickness of the Tooth End Profile]. Ex. 1003 ¶ 48. However, Mr. Fletcher does not opine, and we decline to find, that one skilled in the art, viewing the design as would an ordinary observer, would perform the same study or would even notice the purported proportional discrepancies of the teeth.

We determine that Petitioner has not demonstrated that it is more likely than not that the challenged claim is unpatentable as indefinite.

G. Ground 9: Lack of Ornamentality

Petitioner argues that the challenged design claim is unpatentable under § 171 due to a lack of ornamentality. Pet. 89–94.

A design claim is unpatentable if the claimed design is primarily functional rather than primarily ornamental. *High Point Design*, 730 F.3d at 1315.

Petitioner contends that, “[w]hen considered as a whole, the design of the D’346 patent is dictated by its function to cut hair in any direction while reducing skin irritation,” and “because the individual design elements including the teeth, teeth slots, and cutting blade, and the combination thereof forming the claimed design of the D’346 patent as a whole have no nonfunctional, ornamental features, the D’346 patent is invalid.” Pet. 89–90. Petitioner discusses various considerations for assessing whether the patented design as a whole—its overall appearance—was dictated by functional considerations. *Id.* at 90–94 (citing *PHG Techs., LLC*, 469 F.3d at 1366). Mr. Fletcher testifies similarly. Ex. 1003 ¶¶ 85–88. Mr. Fletcher concludes his testimony in this regard with: “It is further my opinion that the [sic] because all of the individual design elements including the teeth, teeth slots, and cutting blade, and the combination thereof forming the claimed design of the D’346 patent as a whole lack ornamentality (*i.e.*, they have no nonfunctional, ornamental features) the D’346 patent is invalid.” *Id.* ¶ 88.

This ground presents a closer case than the others. On the one hand, it appears that Petitioner and its witness may have used, at least in part, an analysis that has been held to be incorrect—breaking the design down into various elements and then arguing that those elements are functional. *See* Pet. 91; Ex. 1003 ¶¶ 86–87 (“The claimed design of the D’346 patent has been reduced to three distinct features. . . . The ‘428 [utility patent] application clearly specifies a functional purpose of each aspect of the

claimed subject matter of the D’346 Patent.”); *L.A. Gear, Inc.*, 988 F.2d at 1123 (“[T]he utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. . . . [T]he ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article.”); *High Point Design LLC*, 730 F.3d at 1316 (reversing the lower court because, “[i]nstead of assessing whether the claimed design was ‘primarily functional’ or ‘primarily ornamental,’ . . . the district court [incorrectly] interpreted this court’s case law to require it to determine whether the design’s ‘primary features’ can perform functions.”).

Additionally, Petitioner’s witness testified somewhat ambiguously regarding ornamental aspects of the claimed design. Mr. Fletcher, early in his declaration, asserts that the priority chain is broken because certain aspects of the ’346 patent are not disclosed in the grandparent utility patent application. *See* Ex. 1003 ¶¶ 59–60. In that regard, Mr. Fletcher opines:

[T]he D’346 Patent has reduced the claimed subject matter to a *specific ornamental arrangement* of various elements related to the appearance of the teeth, disclaiming the lateral protecting elements, the major design aspects of the rear housing and rear mounting structure. *Since the claimed subject matter is directed to the ornamental arrangement of a series of teeth, the ornamental construction of each individual tooth is important as it contributes to the overall appearance.*

Id. ¶ 60 (emphasis added). This testimony is in contrast to that concerning the alleged unpatentability under Section 171, where Mr. Fletcher—in absolute terms—opines that the claimed design, including the teeth elements, has no ornamentality. *See id.* ¶ 86 (“The design claimed by the D’346 patent which is made up of these three features, lacks ornamentality.”); *id.* at 88 (“[B]ecause all of the individual design elements

including the teeth, teeth slots, and cutting blade, and the combination thereof forming the claimed design of the D’346 patent as a whole lack ornamentality (*i.e.*, they have no nonfunctional, ornamental features) the D’346 patent is invalid.”).

On the other hand, Petitioner and its witness do refer to the design as a whole, which aligns with the correct standard. Pet. 89–90, 93; Ex. 1003 ¶ 88; *L.A. Gear, Inc.*, 988 F.2d at 1123 (“In determining whether a design is primarily functional or primarily ornamental *the claimed design is viewed in its entirety*, for the ultimate question is not the functional or decorative aspect of each separate feature, but *the overall appearance* of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.” (emphasis added)). And, Mr. Fletcher provides testimony, which is unchallenged on this record, that “the subject matter claimed in the ‘346 [patent] has been reduced to the point where the subject matter is primarily functional rather than ornamental.” Ex. 1003 ¶ 85. Further, given that Patent Owner has not filed a preliminary response, the record does not include any argument from Patent Owner describing the appearance of the overall design or identifying anything ornamental about that design.

On this record, we find that Petitioner’s showing with respect to this ground is marginal, at best. In the next section, we consider whether institution of review is warranted under the circumstances, where Petitioner advances eight grounds that do not meet the threshold showing necessary to support trial institution, and one ground that is marginal, at best.

H. Discretionary Denial

Institution of post-grant review is discretionary. *See* 35 U.S.C. § 324(a); *see also SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018)

("[Section] 314(a) invests the Director with discretion on the question whether to institute review" (emphasis omitted)); *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), "the PTO is permitted, but never compelled, to institute an IPR proceeding").⁵

Under the Office Guidance, "if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition." Guidance on the Impact of *SAS* on AIA Trial Proceedings (April 26, 2018).⁶ When a petition fails to satisfy the "more likely than not" institution standard as to some challenges, the Board evaluates "all the challenges and determine[s] whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied." Patent Trial and Appeal Board Consolidated Trial Practice Guide⁷ 64 (Nov. 2019) (citing 37 C.F.R. §§ 316(b), 326(b)).

Here, Petitioner advances nine challenges against the claim of the '346 patent. Pet. 8. As discussed above, we determine that, on this record, Petitioner has not met its burden for institution under eight grounds—an on-sale bar ground, six obviousness grounds, and an indefiniteness ground. Additionally, we determine that the ninth ground—the challenge based on the alleged lack of ornamentality—is marginal, at

⁵ We acknowledge that *SAS* and *Harmonic* address *inter partes* reviews, but see no reason to interpret differently § 324(a), the statute governing post-grant reviews.

⁶ Available at <https://www.uspto.gov/patents/ptab/trials/guidance-impact-sas-aia-trial>.

⁷ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>

best. Based on the particular facts of this proceeding, instituting a trial with respect to all grounds based on evidence and arguments directed only to the one ornamentality ground would not be an efficient use of the Board's time and resources. *Cf. Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9, 10–11 (PTAB Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019) (informative). Thus, we do not institute a post-grant review.

III. ORDER

For the foregoing reasons, it is
ORDERED that the Petition is *denied* and no post-grant review is
instituted.

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