

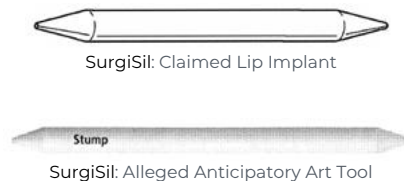
IP Alert | Recital of the Right Title is Vital to the Aim of Your Claim

A Particular Design Patent Application Title Might Avoid Some Prior Art, But It Could Also Limit Claim Scope

By Richard Stockton

Choosing the right title for a US design patent application is critical, especially in view of the Federal Circuit's recent opinion in *In re SurgiSil, L.L.P. et al.*, No. 2020-1940 (Fed. Cir. Oct. 4, 2021).

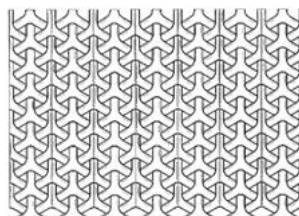
In *SurgiSil*, the US Patent and Trademark Office rejected an application for a lip implant as being anticipated by an art tool:



The single-figure application was titled “Lip Implant” and claimed an “ornamental design for a lip implant as shown and described.”

SurgiSil appealed to the Patent Trial and Appeal Board. *SurgiSil* argued that the art tool “could not anticipate because it disclosed a ‘very different’ article of manufacture [namely an art tool] than a lip implant.” *Id.* at *2. This argument presupposed that the “sole test for anticipation” from *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009) required similarity not only between designs but also the articles embodying those designs.

In support, *SurgiSil* cited cases where the articles (in addition to the designs) mattered for infringement, including *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334 (Fed. Cir. 2019). The design patent in *Curver* was titled “Pattern for a Chair” but—in an “atypical situation”—the chair was not shown in the figures. *Id.* at 1339. The Federal Circuit affirmed a ruling that a basket could not infringe the design patent titled “Pattern for a Chair” as a matter of law, regardless of design similarities.



Curver: Exemplary Patent Figure



Curver: Accused Basket

The Board disagreed. It limited Curver to its “atypical situation,” and thus deemed the “lip implant” references irrelevant. See J.A. at 7. The Board also cited utility patent precedent that “the question whether a reference is analogous art is irrelevant to whether that reference anticipates.” *Id.* (citing *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997)). SurgiSil appealed.

The Federal Circuit held that the Board erred as a matter of law in not limiting the claim to the “identified” article. *SurgiSil*, at *3. It cited Curver in connection with anticipation for the first time—without qualification—and ignored *Schreiber*.^[1] In citing Curver, the Federal Circuit dramatically expanded the reach of Curver’s holding.

First, Curver held that “claim language can limit the scope of a design patent,” not that claim language necessarily limits the scope. *Curver*, 938 F.3d at 1340 (emphasis added). In Curver, the title, claim and figure descriptions were amended from “FURNITURE (PART OF-)” to “Pattern for a Chair.” Guided by principles of prosecution history estoppel, the Federal Circuit found that the amendments limited the claim’s scope. See *id.* at 1341-42. By contrast, the application in *SurgiSil* was never amended, nor was any other explanation given for limiting the claim scope.

Second, as mentioned previously, Curver was limited to the “atypical situation ... where all of the drawings fail to depict an article of manufacture for the ornamental design.” *Id.* at 1339. But in *SurgiSil*, the design is coextensive with the article and clearly depicted (i.e., it is not an “atypical situation”).

SurgiSil creates more issues than it resolves. For example, it remains to be seen whether *SurgiSil*’s unqualified expansion of Curver with regard to anticipation will ricochet back to infringement. If so, design patent applications with identical figures but different titles (e.g., “Car,” “Toy” and “Sculpture”) should become more common as protection is sought for multiple dissimilar articles.

Moreover, an issue arises whether primary references for obviousness, which *In re Rosen*, 673 F.2d 388 (C.C.P.A. 1982) requires to be “basically the same”, must be corresponding articles as well.

Additionally, the scope of limitation is uncertain. While the decision states that “the claim is limited to lip implants and does not cover other articles of manufacture,” it is unclear whether *SurgiSil* is an absolute bar to non-identical articles or whether, e.g., a “makeup pencil” might still anticipate a “lip implant” (because they have analogous properties).

It is also unclear, e.g., whether the Federal Circuit would now rule that a video game can never infringe a design patent for a similar design for a stun gun, as the US District Court for the Eastern District of Arkansas already ruled in *P.S. Prods., Inc. v. Activision Blizzard, Inc.*, 140 F. Supp. 3d 795 (E.D. Ark. 2014).

Currently, petitions for rehearing and rehearing en banc are due on or before November 18, 2021, and any petition for writ of certiorari is due on or before March 3, 2022.

[1] The Federal Circuit did say that it “considered the cases cited by the Director, and they do not support the Director’s position.” *SurgiSil*, at *1. *Schreiber* was cited. See Response Brief at 4.

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